

***I MINA'TRENTAI SINGKO NA LIHESLATURAN GUÅHAN***  
**Informational Briefing/ Oversight Hearing / Roundtable Hearing**

STANDING COMMITTEE / SENATOR	HEARING	COMMITTEE REPORT	HEARING DATE	DATE COMMITTEE REPORT FILED	NOTES
Committee on Heritage and the Arts, Parks, Guam Products, Hagåtña-Revitalization, Self-Determination, and Regional Affairs	Roundtable Hearing	Guam Trademark Commission Monthly Meeting for December 16, 2019.	12/16/19 8:30 a.m.	5/27/20 9:10 a.m.	



# Senator Kelly Marsh (Taitano), PhD.

Chairwoman of the Committee on Heritage and the Arts, Parks, Guam Products, Hagatna Revitalization, Self-Determination, and Regional Affairs  
Assistant Majority Leader  
*I Mina' Trentai Singko Na Liheslaturan Guåhan*

March 3, 2020

### Committee Membership

Overall Vice-Chair:  
Speaker Tina Muña  
Barnes

Heritage and the Arts  
Vice-Chair:  
Senator Amanda L.  
Shelton

Self-Determination Vice-  
Chair:  
Senator Jose "Pedro"  
Terlaje

Regional Affairs Vice-  
Chair:  
Senator Clynt E. Ridgell

Senator Régine Biscoe  
Lee

Senator Joe S. San  
Agustin

Senator Therese M.  
Terlaje

### Contact Details

989-5681/3

[office.senatorkelly@guamlegislature.org](mailto:office.senatorkelly@guamlegislature.org)

Guam Congress  
Building  
163 Chalan Santo Papa  
Hagåtña, GU 96910

**The Honorable Régine Biscoe Lee** *RBL*  
Chairperson, Committee on Rules  
*I Mina' trentai Singko Na Liheslaturan Guåhan*  
Guam Congress Building  
163 Chalan Santo Papa  
Hagåtña, Guam 96910

**Re: Committee Report for December 16, 2019, Guam Trademark Commission, Regular Monthly Meeting**

*Buenas Yan Håfa Adai:*

The Committee on Heritage and the Arts, Parks, Guam Products, Hagatna Revitalization, Self-Determination, and Regional Affairs, hereby transmit the Committee Report of the **December 16, 2019, Guam Trademark Commission, Regular Monthly Meeting.**

*Si Yu'us Ma'åse,*

  
**Kelly G. Marsh (Taitano), Ph.D.**

Attachments



2020 MAR 27 AM 9:10 P.T.

**Senator Kelly Marsh (Taitano), PhD.**

Chairwoman of the Committee on Heritage and the Arts, Parks, Guam Products,  
Hagatna Revitalization, Self-Determination, and Regional Affairs  
*I Mina'trentai Singko Na Liheslaturan Guåhan*

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**COMMITTEE REPORT**

**Regular Monthly Meeting**  
**Guam Trademark Commission**  
**Monday, December 16, 2019**  
**by**  
**Senator Kelly Marsh (Taitano) PhD.**



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**First Notice – Guam Trademark Commission, Monthly Meeting, Monday, December 16, 2019, 8:30 am**

5 messages

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**Office of Senator Kelly Marsh (Taitano), PhD.** <office.senatorkelly@guamlegislature.org> Tue, Dec 10, 2019 at 9:27 AM

To: phnotice@guamlegislature.org

Cc: Dafne.Shimizu@revtax.guam.gov, AnnMarie Arceo <annmarie.arceo@dca.guam.gov>, Pilar Laguana <Pilar.laguana@visitguam.org>, Melanie Mendiola <mel.mendiola@investguam.com>, "Leevin T. Camacho" <law@guamag.org>, Francis Guerrero <fguerrero671@aol.com>, Speaker's Office <speaker@guamlegislature.org>, Louise Muna <senatorlouise@gmail.com>, guampedia.rpn@gmail.com, "Laura M.T. Souder" <souder@betances.com>, Jacqueline Balbas <jacqueline.balbas@caha.guam.gov>, jzcruz@guamag.org, mperez@guamag.org, Matthew Baza <mbaza@investguam.com>, Frank Rabon <frankguahan@yahoo.com>, albert.perez@revtax.guam.gov

**FOR IMMEDIATE RELEASE**

December 10, 2019

**MEMORANDUM**

**To: All Senators, Stakeholders, Media**

**From: Senator Kelly G. Marsh (Taitano), Ph.D.**

Chairperson, Committee on Heritage and the Arts, Parks, Guam Products, *Hagåtña* Revitalization, Self-Determination, and Regional Affairs

**Subject: First Notice – Guam Trademark Commission, Monthly Meeting, Monday, December 16, 2019, 8:30 am**

*Buenas yan Håfa adai!* In accordance to §8103 and §8107 of Title 5 Guam Code Annotated, the Chair of the Committee on Heritage and the Arts, Parks, Guam Products, *Hagåtña* Revitalization, Self-Determination, and Regional Affairs ("Committee") will convene the monthly meeting of the **Guam Trademark Commission** on **December 16, 2019, at 8:30 am**, at *I Liheslaturan Guåhan's* Public Hearing Room. You may request from the Committee a copy of the agenda through the contact information provided within this notice.

Inquiries may be directed to the Office of Senator Kelly Marsh (Taitano), Ph.D., at 163 Chalan Santo Papa, *Hagåtña*, Guam 96910 or via email to office.senatorkelly@guamlegislature.org. The Guam Trademark Commission Meeting will broadcast on local television, GTA Channel 21, Docomo Channel 117/60.4 and streamed online at www.guamlegislature.org through *I Liheslaturan Guåhan's* live feed.

Individuals requiring special accommodations, auxiliary aids, or services may contact and submit their request to the office of Senator Kelly Marsh (Taitano), Ph.D., at 163 Chalan Santo Papa, *Hagåtña*, Guam 96910, by phone at 989-5681-3, or by email at office.senatorkelly@guamlegislature.org.

The Guam Trademark Commission meeting is a public meeting. *Un Dångkolo Na Si Yu'os Ma'àse'!*



**Committee on Heritage and the Arts, Parks, Guam Products,  
Hagåtña Revitalization, Self-Determination, and Regional Affairs**  
*I Mina'trentai Singko na Liheslaturan Guåhan* | 35th Guam Legislature  
Guam Congress Building, 163 Chalan Santo Papa, Hagåtña, Guam 96910  
Telephone: (671) 989-5681/2



12.06.19.pdf  
2011K

**Tom Unsiog** <sgtarms@guamlegislature.org>

Tue, Dec 10, 2019 at 10:32 AM

To: "Office of Senator Kelly Marsh (Taitano), PhD." <office.senatorkelly@guamlegislature.org>

Notice is now placed on the legislature's website calendar....tom

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**Thomas J. Unsiog**  
Sergeant at Arms

35th Guam Legislature  
*I Mina'trentai Singko na Liheslaturan Guåhan*

Tel: (671) 969-3514

Email: sgtarms@guamlegislature.org

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**Pilar Laguana** <pilar.laguana@visitguam.org>

Tue, Dec 10, 2019 at 11:50 AM

To: "Office of Senator Kelly Marsh (Taitano), PhD." <office.senatorkelly@guamlegislature.org>

Cc: AnnMarie Arceo <annmarie.arceo@dca.guam.gov>, Dafne Shimizu@revtax.guam.gov, Francis Guerrero

<fguerrero671@aol.com>, Frank Rabon <frankguahan@yahoo.com>, Jacqueline Balbas

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Mendiola <mel.mendiola@investguam.com>, Speaker's Office <speaker@guamlegislature.org>,

albert.perez@revtax.guam.gov, guampedia.rpn@gmail.com, jzcruz@guamag.org, phnotice@guamlegislature.org,

rpmpez@guamag.org

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Si Yu'os Ma'åse'

Pilar Laguaña  
President & CEO

**GUAM VISITORS BUREAU**

401 Pale San Vitores Road | Tumon, Guam USA 96913 | (671) 646-5278

pilar.laguana@visitguam.org | www.visitguam.org



Office of Senator Kelly Marsh (Taitano), PhD. <office.senatorkelly@guamlegislature.org>

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## Second Notice – Guam Trademark Commission, Monthly Meeting, Monday, December 16, 2019, 8:30 am

3 messages

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Office of Senator Kelly Marsh (Taitano), PhD. <office.senatorkelly@guamlegislature.org> Fri, Dec 13, 2019 at 10:25 AM

To: phnotice@guamlegislature.org

Cc: Dafne.Shimizu@revtax.guam.gov, AnnMarie Arceo <annmarie.arceo@dca.guam.gov>, Pilar Laguana <Pilar.laguana@visitguam.org>, Melanie Mendiola <mel.mendiola@investguam.com>, "Leevin T. Camacho" <law@guamag.org>, Francis Guerrero <fguerrero671@aol.com>, Speaker's Office <speaker@guamlegislature.org>, Louise Muna <senatorlouise@gmail.com>, guampedia.rpn@gmail.com, "Laura M.T. Souder" <souder@betances.com>, Jacqueline Balbas <jacqueline.balbas@caha.guam.gov>, jzcruz@guamag.org, rmperez@guamag.org, Matthew Baza <mbaza@investguam.com>, Frank Rabon <frankguahan@yahoo.com>, albert.perez@revtax.guam.gov

### **FOR IMMEDIATE RELEASE**

December 13, 2019

#### **MEMORANDUM**

**To: All Senators, Stakeholders, Media**

**From: Senator Kelly G. Marsh (Taitano), Ph.D.**  
Chairperson, Committee on Heritage and the Arts, Parks, Guam Products,  
*Hagåtña* Revitalization, Self-Determination, and Regional Affairs

**Subject: Second Notice – Guam Trademark Commission, Monthly Meeting,  
Monday, December 16, 2019, 8:30 am**

*Buenas yan Håfa adai!* In accordance to §8103 and §8107 of Title 5 Guam Code Annotated, the Chair of the Committee on Heritage and the Arts, Parks, Guam Products, *Hagåtña* Revitalization, Self-Determination, and Regional Affairs ("Committee") will convene the monthly meeting of the **Guam Trademark Commission on December 16, 2019, at 8:30 am, at I Liheslaturan Guåhan's Public Hearing Room**. You may request from the Committee a copy of the agenda through the contact information provided within this notice.

Inquiries may be directed to the Office of Senator Kelly Marsh (Taitano), Ph.D., at 163 Chalan Santo Papa, *Hagåtña*, Guam 96910 or via email to office.senatorkelly@guamlegislature.org. The Guam Trademark Commission Meeting will broadcast on local television, GTA Channel 21, Docomo Channel 117/60.4 and streamed online at www.guamlegislature.org through *I Liheslaturan Guåhan's* live feed.

Individuals requiring special accommodations, auxiliary aids, or services may contact and submit their request to the office of Senator Kelly Marsh (Taitano), Ph.D., at 163 Chalan Santo Papa, *Hagåtña*, Guam 96910, by phone at 989-5681-3, or by email at office.senatorkelly@guamlegislature.org.

The Guam Trademark Commission meeting is a public meeting. *Un Dångkolo Na Si Yu'os Ma'åse'!*

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Office of Senator Kelly Marsh (Taitano), PhD  
Committee on Heritage and the Arts, Parks, Guam Products,  
*Hagåtña* Revitalization, Self-Determination, and Regional Affairs  
*I Mina'trentai Singko na Liheslaturan Guåhan* | 35th Guam Legislature



## Senator Kelly Marsh (Taitano), PhD.

Chairwoman of the Committee on Heritage and the Arts, Parks, Guam Products,  
Hagatna Revitalization, Self-Determination, and Regional Affairs

Assistant Majority Leader

*I Mina'trentai Singko Na Liheslaturan Guåhan*

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Shelton

Self-Determination Vice-  
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Senator Jose "Pedo"  
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Regional Affairs Vice-  
Chair:  
Senator Clynt E. Ridgell

Senator Régine Biscoe  
Lee

Senator Joe S. San  
Agustin

Senator Therese M.  
Terlaje

### Contact Details

989-5681

[office.senatorkelly@guamlegislature.org](mailto:office.senatorkelly@guamlegislature.org)

Guam Congress  
Building  
163 Chalan Santo Papa  
Hagåtña, GU 96910

## Agenda

### Guam Trademark Commission Public Hearing Room – Guam Congress Building Monday, December 16, 2019, 8:30 am

#### I. CALL TO ORDER

#### II. NEW BUSINESS

- a. Informational Resources in creating the framework and scope necessary in drafting the "Guam Cultural Trademark Act" and the "Guam Trademark and Intellectual Property Rights Act."

#### III. OLD BUSINESS

- a. Continuing Discussions on the Formation of the Guam Trademark Commission Committees:
  - i. Delineation of Committees
  - ii. Committee Duties and Responsibilities
    1. Responsibilities and Duties
    2. Reporting to Commission on Activities and Action
    3. Creation of Subcommittees

#### IV. OPEN DISCUSSION

#### V. ADJOURNMENT



**GUAM TRADEMARK COMMISSION**  
*I Mina'trentai Singko Na Liheslaturan Guåhan*  
**Committee on Heritage and the Arts, Parks, Guam Products,**  
**Hagåtña Revitalization, Self-Determination, and Regional Affairs**  
 Meeting Sign-in Sheet

**Regular Meeting Public Sign-In Sheet**

Monday, December 16, 2019, 8:30 A.M. • Guam Congress Building Public Hearing Room

NAME (Please Print Legibly)	AGENCY OR ORGANIZATION (If Any)	CONTACT NUMBER	EMAIL ADDRESS
Dee Hernandez	GNB	646-5278	dee.hernandez@visitguam.org
Laura Souder	Kumision + Fino' Chamoru	689-6909	souder@betorces.com
Albert Perez	ReTax		
Ann Mai P. Jones	PCA	482-4630	
Rita P. Navin	Encyclopedia / Sphe Offi	68791113	rpnavin@gmail.



**GUAM TRADEMARK COMMISSION**  
*I Mina'trentai Singko Na Liheslaturan Guåhan*  
**Committee on Heritage and the Arts, Parks, Guam Products,**  
**Hagåtña Revitalization, Self-Determination, and Regional Affairs**  
 Meeting Sign-in Sheet

**Informational Resource Packet Sign-Out Sheet**

Monday, December 16, 2019, 8:30 A.M. • Guam Congress Building Public Hearing Room

NAME (Please Print Legibly)	AGENCY OR ORGANIZATION (If Any)	CONTACT NUMBER	EMAIL ADDRESS
Laura MT Soudry	Commission	-	-
Rita P. Nauch	Guangediu / Office of the Spk		
Dee Hernandez	GVP		dee.hernandez@visitguam.com
Albert Perez	RevTax		
Amy M. B. Buis	DCA		



## Senator Kelly Marsh (Taitano), PhD.

Chairwoman of the Committee on Heritage and the Arts, Parks, Guam Products,  
Hagatna Revitalization, Self-Determination, and Regional Affairs

Assistant Majority Leader

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Senator Régine Biscoe  
Lee

Senator Joe S. San  
Agustin

Senator Therese M.  
Terlaje

### Contact Details

989-5681

[office.senatorkelly@guamlegislature.org](mailto:office.senatorkelly@guamlegislature.org)

Guam Congress  
Building  
163 Chalan Santo Papa  
Hagåtña, GU 96910

## Document Resource Listing

### Guam Trademark Commission Public Hearing Room – Guam Congress Building Monday, December 16, 2019, 8:30 am

1. Alaska Silver Hand Program\_from Legislature
2. Indigenous IP Rights overview\_Taiwan (1) IP\_Copyright law overview\_Taiwan
3. IP\_Enforcement overview\_Taiwan
4. IP\_Trademark law overview\_Taiwan
5. Guidelines\_Pacific Model Law\_2002
6. Native Hawaiian Cultural Trademark & IP Study
7. NZ-Maori-Culture-and-Intellectual-Property-Law
8. ROP Copyright
9. The-Protection-of-Samoas-Traditional-Knowledge-Expressions-of-Culture-Issues-Paper
10. US PL 101-644\_1990
11. WIPO iptk\_ge\_15\_presentation\_mere\_falamaka (1)  
Overview of Intellectual Property Laws  
<https://fairuse.stanford.edu/overview/introduction/intellectual-property-laws/>

## Chapter 58 **Silver Hand and "Made In Alaska" Programs**

**3 AAC 58.005. Purpose** This chapter implements the silver hand handicrafts and "Made in Alaska" products programs authorized under AS 45.65.010 - 45.65.070.

**3 AAC 58.020. Silver hand program** (a) The silver hand program is designed to identify authentic Alaska Native handicrafts. (b) The official Native handicraft symbol is the silver hand seal. The seal must meet the requirements of AS 45.65.030. The seal consists of a black oval containing a hand in silver and the words "Authentic Native Handicraft from Alaska." The seal is of the following design: [CLICK TO VIEW SEAL](#) (c) A permit to use the silver hand seal on the handicrafts the applicant produces will be issued to an Alaska Native who (1) applies to the commissioner or a silver hand agent on a form approved by the department, unless the applicant was certified to be eligible by the silver hand agent; (2) documents that the applicant is an Alaska Native with a blood quantum of one-fourth or greater; documentation proving eligibility includes (A) a United States Department of the Interior, Bureau of Indian Affairs Certificate of Indian Blood; (B) an official letter from a village or regional corporation established under 43 U.S.C. 1606 - 1607 (Alaska Native Claims Settlement Act of 1971, sections 7 and 8); or (C) an official letter from a village council or tribe in which the applicant is a member; (3) certifies on the application that the applicant will affix the silver hand seal only on a handicraft that was or will be made (A) entirely by the applicant; (B) within this state; and (C) in whole or of significant part of natural materials. (d) A permit to use the silver hand seal is valid for two years from the date the permit is issued. The permit may be renewed by submitting a completed permit renewal application on a form approved by the department within 30 days of the end of the two-year period. (e) The commissioner or a silver hand agent must approve or disapprove an application or renewal application to use silver hand seals within 30 days from the date of receipt of a completed application.

**3 AAC 58.025. Use of the silver hand seal or representation** (a) A permit holder, other than a silver hand agent, may use the representation of a silver hand seal on catalogs, letterheads, business cards, in-store and other advertising, and for other similar purposes related to the permit holder's handicrafts. The permit holder, other than a silver hand agent, may use a representation of the silver hand symbol only in advertising of that permit holder's handicrafts. (b) The silver hand agent may use a representation of the silver hand symbol only on letterheads, business cards, and other advertising solely for the purposes of identifying that person as a silver hand agent and fulfilling that agent's duties under AS 45.65.010 - 45.65.070 and this chapter. (c) The silver hand seal or a representation of that seal may not be used in a manner that is false or

misleading. The silver hand seal or a representation of that seal may only be used without any modification to the design specified in 3 AAC 58.020(b). (d) The silver hand seal or a representation of that seal may not be incorporated into a business, company, or product logo or label. (e) The silver hand seal or a representation of that seal may not be sold as art or as a dominant feature of a handicraft unless approved by the commissioner in writing. (f) A permit holder may obtain 150 silver hand seals annually from the department at no cost. Additional seals may be purchased from the department at the cost of printing and distribution of the seals.

**3 AAC 58.030. Silver hand agent permits** (a) The commissioner will issue a permit for an agent for the silver hand program if the person pays the application and permit issuance fees and certifies on an application form approved by the department that the applicant (1) is a resident of the state; and if regions are established by the commissioner, the region identified in the permit; (2) has sufficient knowledge about the handicrafts, customs, and populace of the state, or if applicable, the region identified in the permit; and (3) has a current Alaska business license, if required under AS 43.70. (b) The commissioner will, in the commissioner's discretion, require a silver hand agent or applicant for an agent permit to attend a training session provided by the department on the silver hand program. (c) A silver hand agent permit is valid for three years from the date that the permit is approved by the commissioner. The silver hand agent permit may be renewed by (1) completing an agent permit renewal application on a form approved by the department; and (2) paying the renewal fee. (d) The commissioner will approve or disapprove an application or a renewal application for a silver hand agent within 30 days from the date of receipt of a completed application.

**3 AAC 58.035. Duties of a silver hand agent** The duties of a silver hand agent include (1) providing information to the public on the silver hand program, such as application and eligibility requirements for permits, availability of silver hand seals, and similar activities; (2) distributing application forms and instructions for a permit to use silver hand seals; (3) determining the eligibility of applicants for a permit to use the silver hand seal in accordance with AS 45.65.010 - 45.65.070 and 3 AAC 58.020(c) by approving or disapproving applications, or by certifying the eligibility of a Native craftsperson; (4) submitting on a quarterly basis on or before January 1, April 1, July 1, and October 1, of each year (A) a copy of each application and the action taken on the application during the period; and (B) information requested by the department about each Native craftsperson that the agent certified as eligible to use silver hand seal during that period; the agent shall supply the information on a form approved by the department; (5) distributing seals to the permit holder in accordance with 3 AAC 58.025(f) or personally affixing the seal on eligible handicrafts; (6) assisting the commissioner in the renewal process for silver hand permits as specified in 3 AAC 58.020(d); (7) assisting the department in marketing, promoting, and advertising the silver hand

program to the general public; (8) submitting other information and reports as required by the commissioner; and (9) reporting any alleged violations of AS 45.65.010 - 45.65.070 and this chapter to the commissioner.

**3 AAC 58.040. "Made in Alaska" program** (a) The "Made in Alaska" program is designed to promote products made or manufactured in the state and handicrafts produced by both Native and non-Native craftspersons. (b) The official emblem for the "Made in Alaska" program depicts a mother bear and her cub in a rectangular format with the words "Made in Alaska" underneath. The "Made in Alaska" emblem has no established colors. The emblem is of the following design: CLICK TO VIEW SEAL (c) Except as provided in (i) of this section, a person who makes or manufactures a product or produces a handicraft in the state may apply to the commissioner or a "Made in Alaska" agent for a permit to use the "Made in Alaska" emblem on the product. (d) A separate permit is required for each handicraft type or product line of the applicant. (e) A permit to use the "Made in Alaska" emblem will be issued to an applicant who (1) locates and maintains the handicraft or product making or manufacturing operation within the state; (2) produces a handicraft in the state or a product in which the value-added processes were accomplished in the state; (3) uses Alaska resources and materials in the manufacturing or production of the product or handicraft, or provides documentation that the raw resources and materials do not exist within the state either in the form, quality, or quantity required for the production of the product or the handicraft; (4) has a current Alaska business license if required by AS 43.75; (5) submits a completed application on a form approved by the department and the required annual fees; (6) permits the inspection of the production or manufacturing site by the commissioner or a "Made in Alaska" agent; and (7) complies with the requirements of AS 45.65.010 - 45.65.070 and this chapter to determine the eligibility of the product. (f) A finished product that is only partially manufactured within the state may be authorized to use the "Made in Alaska" emblem if (1) the producer demonstrates that no manufacturing facility exists in this state with the capacity or expertise to do the work being accomplished outside the state; the commissioner or "Made in Alaska" agent will not consider cost alone as a valid justification for using out-of-state manufacturing facilities; and (2) the majority of the value-added processes are accomplished in the state. (g) A permit to use the "Made in Alaska" emblem is valid for one year from the date the permit is issued. A permit may be renewed by (1) submitting a completed permit renewal application on a form approved by the department; and (2) paying the required fees. (h) The commissioner or a "Made in Alaska" agent must approve or disapprove an application or renewal application to use "Made in Alaska" emblems within 30 days of the date of receipt of a completed application. (i) The printing industry is not eligible for a permit to use the "Made in Alaska" emblem for routine printing projects which involve printing or duplication of items or writings not created by the printer.

**3 AAC 58.045. Use of the "Made in Alaska" emblem or representation** (a) A permit holder, other than a "Made in Alaska" agent, may use a representation of the "Made in Alaska" emblem on labels, letterheads, business cards, in-store and other advertising, and for other similar purposes. (b) The "Made in Alaska" agent may use a representation of the "Made in Alaska" emblem only on letterheads, business cards, and other advertising solely for the purpose of identifying that person as a "Made in Alaska" agent and to fulfill that agent's duties under AS 45.65.010 - 45.65.070 and this chapter. (c) The "Made in Alaska" emblem or a representation of that emblem may not be used in a manner that is false or misleading. The "Made in Alaska" emblem or a representation of that emblem may only be used without any modification to the design specified in 3 AAC 58.040(b). (d) The "Made in Alaska" emblem or a representation of that emblem may not be incorporated into any business, company or product logo or label. (e) The "Made in Alaska" emblem or a representation of that emblem may not be sold as art or as a dominant feature of a product, unless approved by the commissioner in writing. (f) The permit holder may obtain "Made in Alaska" emblems from any source so long as they conform to the requirements of AS 45.65.010 - 45.65.070 and this chapter.

**3 AAC 58.050. "Made in Alaska" agent permits** (a) The commissioner will, in the commissioner's discretion, issue a permit to an agent for the "Made in Alaska" program if the applicant pays the required application and permit issuance fees and certifies on an application form approved by the department that the applicant (1) is a resident of the state; and (2) has a current Alaska business license, if required under AS 43.75. (b) The commissioner will, in the commissioner's discretion, require that a "Made in Alaska" agent or applicant attend a training session provided by the department on the "Made in Alaska" program. (c) A "Made in Alaska" agent permit is valid for three years from the date that the permit is approved by the commissioner. A "Made in Alaska" agent permit may be renewed by (1) submitting a completed permit renewal application to the commissioner, on a form approved by the department; and (2) paying the required renewal fee. (d) The commissioner will approve or disapprove an application or renewal application to be a "Made in Alaska" agent within 30 days from the receipt of a completed application.

**3 AAC 58.055. "Made in Alaska" agent duties** The duties of the "Made in Alaska" agent include (1) promoting and advertising the "Made in Alaska" program; (2) providing information to the public on the "Made in Alaska" program such as application and eligibility requirements for a permit, the availability of application forms, where to obtain information and assistance, and other similar duties; (3) distributing application forms and instructions for a permit to use the "Made in Alaska" emblems; (4) receiving and recording completed application forms, collecting any required application fees, maintaining proper fiscal procedures to account for all fees collected, and depositing all fees with the department within two weeks of their receipt; (5) performing site inspections or taking other action to verify the accuracy of information

on the application; (6) determining if the product meets the eligibility requirements under 3 AAC 58.040(e) and either approving or disapproving the application; submitting a copy of each application and the action taken to the commissioner within 30 days from the date of the action; (7) submitting other information and reports as required by the commissioner; (8) assisting the commissioner in the renewal process for permits to use the "Made in Alaska" emblem under 3 AAC 58.040(g); and (9) reporting alleged violations of AS 45.65.010 - 45.65.070 or this chapter to the commissioner.

**3 AAC 58.060. Permit fees** The fees for permit applications for the silver hand and the "Made in Alaska" programs are as follows: (1) silver hand agent permit application fee, \$50 (2) silver hand agent permit issuance fee, \$150 (3) silver hand agent permit triennial renewal fee, \$150 (4) "Made in Alaska" permit: (A) annual fee per handicraft type or product line, \$25 (B) annual maximum fee per permit holder, \$75 (5) "Made in Alaska" agent permit application fee, \$50 (6) "Made in Alaska" agent permit issuance fee, \$150 (7) "Made in Alaska" agent permit triennial renewal fee, \$150.

**3 AAC 58.070. Application review** (a) Within 30 days after receiving notification of denial of an application or renewal for authorization to use the silver hand seal, to use the "Made in Alaska" emblem, or to become an agent for either the silver hand or the "Made in Alaska" program, the applicant may request reconsideration by the commissioner. (b) The request for reconsideration must specify grounds that would support reversal of the denial. (c) Within 30 days after receipt of a completed request for reconsideration, the commissioner will issue a written decision. The commissioner's decision on reconsideration constitutes final administrative action by the department.

**3 AAC 58.075. Revocation and debarment** (a) The permit of a person authorized to use the silver hand seal or the "Made in Alaska" emblem or to act as an agent for either the silver hand or the "Made in Alaska" program who is convicted of an offense under AS 45.65.060 is automatically revoked as of the date of the conviction. (b) Any person who is convicted of an offense under AS 45.65.060 is barred from any further participation in either the silver hand or the "Made in Alaska" program. (c) After notice and opportunity for hearing, the commissioner will, in the commissioner's discretion revoke a permit for failure to comply with the requirements of AS 45.65.010 - 45.65.070 including the payment of fees, and this chapter.

**3 AAC 58.080. Transaction** Repealed

**3 AAC 58.900. Definitions** In this chapter (1) "commissioner" means the commissioner of the Department of Commerce, Community, and Economic Development; (2) "department" means the Department of Commerce, Community, and Economic Development; (3) "handicrafts" means products that are produced for sale by a skilled craftsperson, usually as a home occupation or in a small shop; each product requires

individual attention, is produced in small quantities, and utilizes a minimum of power tools; (4) "Made in Alaska" agent means a person who holds a valid permit issued under this chapter to serve as an agent for the "Made in Alaska" program; (5) "manufactured product" means a product that is built, formed, fabricated, or assembled from raw or semi-finished material which is changed in character in the final product; (6) "natural material" means material produced or existing in nature, not artificial or manufactured, and derived from lands, plants, animals or other natural resources; (7) "product line" means a product or group of products that is manufactured utilizing similar materials and manufacturing processes and producing a finished product that is similar in form, content, and use; (8) "silver hand agent" means a person who holds a valid permit issued under this chapter to serve as an agent for the silver hand program; (9) "value-added process" means a process that changes a raw material or a basic industrial material into a more finished product or alters the function, shape, or appearance resulting in a product with increased value; (10) "handicraft type" means a handicraft or a group of handicrafts that is crafted utilizing similar materials and crafting processes and producing a finished product that is similar in form, content, and use.

## **Intellectual Property Rights of the Aboriginal Peoples of Taiwan**

Yvonne Lin Mei-Jung

Translated by Martin Williams

### **1. Introduction**

World Intellectual Property Organisation (WIPO) regulations regard intellectual property rights to apply to property produced on the basis of intellectual creation, particularly inventions and works of literature or art. "Property rights" pertain to situations in which inventions or creative works with copyright protection may only be utilised with the agreement of the inventor, author or other "owner of rights".

The Aboriginal peoples of Taiwan - there are currently nine groups officially recognised - are a crystallisation of rich and highly diverse human knowledge, and were the objects of general curiosity during the Dutch and Japanese periods of rule in Taiwan. However, having suffered the impact of several hundred years of colonial rule, the earliest inhabitants and original masters of Taiwan have been unable to secure the dignity to which they are entitled by relying on the resources of their anthropological and cultural heritage, agricultural practices, botanical heritage and genetics, traditional lifestyles, traditional medicine and biological diversity, or even on the research of the Human Genome Diversity Project (HGDP) conducted in recent years.

What do we associate with "intellectual property rights"? How are they related to Taiwan's Aboriginal peoples? What about the general concept in the international context? And what is it understood to mean in Taiwan? Before we can guarantee the intellectual property rights of Taiwan's Aboriginal peoples we must determine what action ought to be taken. The goal of this paper is to discuss the issue of intellectual property rights of Taiwan's Aboriginal peoples before a wider audience.

## 2. The meaning of intellectual property rights

There are some disparities between Taiwan and the international community regarding the concept of intellectual property rights. What do intellectual property rights refer to? Cultural heritage? "Mental" property? Or industrial property?

The WIPO definition of "intellectual property rights" is as follows: "Intellectual Property means property rights in intellectual creations, particularly inventions and literary and artistic works. Intellectual property rights exist also in registered trademarks and industrial designs, integrated circuits, trade names and geographical indications and relate to the repression of unfair competition, including the protection of undisclosed information. 'Property' implies that protected inventions, works under copyright protection, and other objects of protection, can be used only with the consent of the inventor, author or other owner of rights." **(NOTE 1)**

"Intellectual property rights" are defined in the 1967 WIPO Convention (Article 2 (viii)) as relating to: "(1) literary, artistic and scientific works, (2) performances of performing artists, phonograms, and broadcasts, (3) inventions in all fields of human endeavor, (4) scientific discoveries, (5) industrial designs, (6) trademarks, service marks, and commercial names and designations, (7) protection against unfair competition, and (8) all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields".

Put most simply, creations of the human intellect, such as inventions, designs, poetry, prose, drama, patterns and symbols, computers, software, cartoon characters such as Mickey Mouse and Donald Duck, or fictional human characters such as Asia the Invincible, fall under the definition of intellectual property (Feng Chen-yu 1994). **(NOTE 2)**

The South American indigenous movement "Tupay Katari" points to traditional indigenous artistic heritage in their conception of intellectual property, including: (1) forms of oral expression such as folktales, legends, poetry and riddles, (2) forms of musical expression such as songs and instrumental folk music, (3) forms of physical expression such as folk dances, plays and ceremonies, (4) forms of tangible expression such as drawings, paintings, sculptures, pottery, woodwork, jewellery and basketry, and (5) musical instruments and architectural works. These categories refer back to the essence of a report by the Group of Experts on the International Protection of Expressions of Folklore by Intellectual Property convened in October, 1984 by UNESCO and WIPO. That report also stated: "States [shall] recognise as the permanent traditional artistic heritage of indigenous communities, the body of

artistic works created within indigenous territories by anonymous authors, and transmitted from generation to generation". (NOTE 3)

Anthropologists in Taiwan point out that indigenous ecological wisdom (or "intellect") is a collective resource for cultural and biological diversity and a precious form of "environmental wealth" or "natural capital" (Wang Chun-hsiu 1998). (NOTE 4) Wang advances the argument that the symbiotic relationship between indigenous people and the land generates a philosophy of ecology that is most worthy of study. Compared to the Western notion that "culture develops through the agency of man", the indigenous view that "culture develops through the agency of the land" is much more in character with the idea of the "unity of people and nature". "Thus, ecological wisdom becomes a common resource for cultural and biological diversity and even moreso a cultural theme of flourishing biological diversity." (NOTE 5).

**Wang divides the study of indigenous ecological wisdom into the two general categories of thought and conduct, the former category including the pronouncements of the world's indigenous peoples, and the latter including indigenous methods of ecological management. Wang's investigations into how Taiwan's Aboriginal peoples practice agriculture, how they fish and hunt, and into the nature of their ceremonies and taboos are a valuable record of ecological wisdom within the conduct of Taiwan's Aboriginal people. Wang proposes that an Aboriginal-controlled "community trust" will rectify deficiencies in the present "state trust" method and will also entrust Aboriginal people with the role of "ecological guardians" in managing national parks and nature reserves.**

### 3. Taiwan case studies

(a) When portions of the "Elders' Drinking Song", as sung by the Amis Aborigines Difang (Chinese name: Kuo Ying-nan) and his wife Igay (Chinese name: Kuo Hsiu-chu), were first broadcast on Taiwan television as part of a short film promoting the 1996 Atlanta Olympics, many did not realise that the sounds were in fact those of the Amis people of Taitung in southeast Taiwan. Indeed, the singers themselves were not aware of their inclusion in the material. On the eve of the Olympics, the former mayor of Taipei, Chen Shui-bian, and the former head of the Taipei City Council of Aboriginal Affairs, Kao Cheng-shang, invited Difang and Igay to Taipei to hold a press conference entitled "The Return of the Original Music"; "the goal was to draw attention to the issue of securing the intellectual property rights of indigenous

people". **(NOTE 6)** A lawyer, Huang Hsiu-lan, then received instructions from Difang to take legal action over the matter. The incident had its origins in 1988 when an academic, Hsu Chang-huei, led a group of Aboriginal people - including Difang - to perform in France. A recording of their performance was then transferred to compact disc by the Maison des Cultures du Monde (Institute for World Cultures) and given a limited release. The German rock group Enigma remixed the performance and this was used as the Olympic Games promotional song. Subsequent mediation and negotiation by Hsu Chang-huei saw the French pay out a symbolic 15,000 francs, which was given to the France-based Folk Arts Foundation in trust. The problem of who owns copyright to this Amis song has not been resolved, and so the money has not been passed on to the members of the Aboriginal group who travelled to Europe. What Hsu Chang-huei is fighting for on behalf of Difang and other Aboriginal people is not only the recording's copyright, but also copyright relating to musical arrangement.

(b) During the period of Japanese rule in Taiwan (1895-1945), the musicologist Kurosawa Takatomo travelled to more than one hundred and fifty Aboriginal communities and compiled nearly one thousand songs, producing more than twenty phonograph records. Further, in 1952, the material was presented to UNESCO and Kurosawa published a thesis introducing the revelation that was "ethnic music". This was the first time that Taiwan Aboriginal music had been placed on the world stage, and to this day it has been very influential in facilitating the detailed research of Aboriginal music by musicologists. **(NOTE 7)**

These examples lead us to the following points:

(a) In fighting for compilation, transcription and arrangement copyright, is it a just situation for intellectual property rights to become copyrighted to an individual when those rights originally belonged to an entire ethnic grouping? Some have proposed that "shared control" property rights be returned to the original ethnic group, requiring that half of any money or other gifts obtained be deposited with an organisation along the lines of an "Aboriginal Culture Foundation". The case of Kurosawa Takatomo demonstrated respect and affirmation in the recording of Aboriginal culture; the struggle over copyright in the case of the Olympic Games promotional film arose, however, from conduct relating to commercial profit. There is still much work to be done in addressing the relationship between commercial profit, the protection and promotion of culture, and where intellectual property rights apply.

(b) The songs of Aboriginal people are orally transmitted and their sources cannot be traced. They are a collective creation and therefore do not have an “original author”. For this reason the former head of the Taipei City Council of Aboriginal Affairs, Kao Cheng-shang, made a general appeal that there should be a different approach to the intellectual property rights of Taiwan’s Aboriginal people. He has proposed that a “Intellectual Property Rights Foundation for Taiwan Aboriginal Collective Works” be established to deal with this issue.

Apart from the example of music, the distribution of commemorative coins and postage stamps and the digitalisation of embroidery patterns have complicated the issue of intellectual property rights. Under the impact of modern technology, the question of who retains the rights to intellectual property such as the “totems” of each Aboriginal community - symbolic patterns, handicrafts and so on - has suddenly become very urgent.

#### **4. Local laws and safeguards**

In general, the commercial sector’s concern for intellectual property focuses on patents, trademarks, copyright and the protection of undisclosed information. Less stringent concern is afforded to the layout of publications and computer circuits. Naturally, the intellectual property rights of Aboriginal people are not of concern to mainstream society in this kind of framework. The range of applicable laws and safeguards currently in force in Taiwan are set out below:

(a) Laws which cover distinguishing markings of industries or goods: These are the *Trademark Law* for trademarks and logos, the *Company Law* for company names, the *Commercial Registration Law* for names of other commercial entities, and the *Trade Law* and *Measures for the Administration of Goods for Export* for indicating place(s) of production and names of original place(s) of production. Regarding the *Trademark Law*, protection of commercial reputation and customer support services is available to those goods that are distinctive, practical and which have a fixed application. The period of protection for such products is ten years; first applicants will receive protection and may, without restriction, apply for extensions of ten years at a time.

(b) Laws which protect the creative product of the human intellect: These are the *Patents Law* covering applications for inventions or new models; the *Botanical Seeds*

*Law* for new microorganisms, industrial designs and new botanical types; the *Integrated Circuit Protection Law* for semi-conductor wafers; and with regard to undisclosed information protection there is the *Trade Secrets Law* covering specialised skills. The *Patents Law* provides protection for new inventions with industrial value, but requires them to be of a novel, practical and creative nature and sufficiently specialised. The period of protection for new inventions is twenty years, new patterns twelve years, and new models twelve years. In principle these cannot be extended. Protection of medical goods and pesticides, however, may be extended from two to five years. Protection of undisclosed information and specialised skills applies to all specialised skills and data; they must be of a confidential nature and have commercial value. Where undisclosed information exists it will then receive protection; if undisclosed information is developed and not leaked it is then protected. Extensions do not apply. The *Integrated Circuit Protection Law* protects integrated circuits if they are an original creation and not of a general nature. The period of protection is ten years with no extension possible and requires registration, as unregistered products will not receive protection.

(c) The *Copyright Law* which protects works in the cultural, artistic, scientific and academic spheres and which covers rights to both the *character* of a work and rights to a work as *property*. The law is conceptual in that it protects creativity; protection expires fifty years after an individual's death or, in the case of corporate entities, fifty years after the date of first publication. The law also embraces the creative aspect in that once a creative work is completed it is protected. No extensions are possible.

(d) Laws which prevent unfair competition: These are the *Fair Trading Law*, the *Trademark Law* and the *Consumer Protection Law*.

## **5. Taiwan's Aboriginal peoples and intellectual property rights: difficulties and challenges**

(a) Establishing the boundaries of Aboriginal intellectual property rights.

(b) Making laws to protect Aboriginal intellectual property rights prior to entering the World Trade Organisation (WTO) according to its regulation that all member states must pass laws protecting information with commercial value and which has yet to be publicly disclosed, even if that information does not qualify to attract

royalties or for patent protection. This regulation is much broader than the concepts of "undisclosed information" or "technique" mentioned previously, and is sufficient to cover the many creeds, ceremonies, songs, dances and designs regarded as sacred and secret by Aboriginal people but which are under threat of commercial use. Therefore, the Republic of China, in entering and becoming a member nation of the WTO, should make laws to protect the cultural heritage and intellectual property rights of our nation's Aboriginal peoples by employing legal safeguards of an international standard.

(c) Not neglecting the rights and interests of Taiwan's Aboriginal peoples when applying to enter international organisations (such as the World Health Organisation).

(d) Legislating standards for patentisation and commercialisation in regard to the Human Genome Diversity Project. It is understood that since 1992 Taiwan has undertaken genetic research on its Aboriginal peoples. In that year the University of Tokyo, through the Mackay Memorial Hospital in Taipei, took 900 blood samples as part of "systematic anthropological research". From 1992 to 1996, Shuntien Hospital in Taichung in collaboration with the Academia Sinica took 4,000 samples. In 1995 the Mackay Memorial Hospital undertook the collection of a further 1,000 samples. These nearly six thousand blood samples are likely to have undergone DNA sampling or else have been placed in long-term storage. Legal standards relating to this problem are urgently required.

Consent form for extraction of blood from the Aboriginal peoples of Taiwan

Dear friend from the \_\_\_\_\_ tribe,

Hello! We are [staff] **from** \_\_\_\_\_ Hospital. We would like to visit you to collect a blood sample and conduct a health test. We are researching the uniqueness of your people's heredity as well as looking further into the origins of your people and how they migrated. We also want to make comparisons with the heredity of other Aboriginal people on the island [Taiwan]. You will also be offered a free blood test and check-up.

Our plan is to collect fifty samples from members of your tribe who are "full-blood" and not from the same family. In order to investigate and measure more characteristics of your heredity we will need about 20 millilitres of blood [about three tubes of blood] as well as about 5 millilitres of blood for your free blood test and check-up. The results of your examination will be sent to you shortly afterwards. We hope that all [Aboriginal people] who are interested in their ethnic group's origins will answer some simple questions below about themselves and their parents. We will be at the local church at \_\_\_\_\_am/pm to collect blood and to conduct our courtesy examinations. We invite everyone to support this worthy project.

Yours sincerely,

\_\_\_\_\_ Date: / /

The above is a blood extraction consent form featured at the beginning of a paper by an Academia Sinica researcher discussing that institution's project entitled "Using hereditary characteristics in researching blood relations between Taiwan's Aboriginal peoples". In the paper she mentions her discovery during the research that some Aboriginal people already tested had not had their examination reports or research results sent back to the community (**NOTE 8**). It may also be seen from this that human genes in Taiwan are conceived mainly in terms of recognition of ethnicity. It has been said however that acknowledging blood as belonging to either the Shao or the Tsou peoples or to the Taroko people has no relation to acknowledgement of ethnicity by academia or the government; the latter is in fact a separate issue. (**NOTE 9**) There is not yet any evidence, however, demonstrating that the blood of Taiwan's Aboriginal ethnic groups has been subject to patent applications or used to devise new pharmaceutical products or that a general plan has been implemented. The latter requires careful recording of data from three generations of a given ethnic group, and of data relating to congenital conditions, the immune system, general constitutional circumstances and so on. Only in this way can basic data be compiled for reaching conclusions relating to genetic influence. However, the government must look carefully at the taking of blood samples for the purposes of DNA sampling or placing cells in long-term storage. Organisations and conferences around the

world are now advocating the halting of such research to protect Aboriginal intellectual property rights. Aboriginal people believe that blood is bestowed, a sacred thing that cannot be violated, something that cannot be sold. Such patentising leads to the loss of Aboriginal legal and political rights.

## 6. Conclusion

In Taiwan, the concept of intellectual property rights is still confined to trademarks and copyright which are narrowly related to commercial profit. It is as if holders of intellectual property rights are unable to make any profit if they do not labour to *commercialise* those rights. The right to intellectual property is an intangible form of property right, so how are we to affirm its existence and value when, like the dignity and autonomy of the Aboriginal people themselves, these precious common products of humanity - the culture, traditional skills and traditional medicines of the Aboriginal ethnic groups on Taiwan and Lanyu - have been ignored, discriminated against and even belittled?

An investigation of intellectual property rights which bears in mind the dignity and humanity of Aboriginal people leads to the following proposals:

- (i) That there be active acknowledgement of the dignity and autonomy of Aboriginal people.
- (ii) That legal benchmarks for the intellectual property rights of all Taiwan's Aboriginal peoples be implemented according to the standards of international law currently practiced.
- (iii) That the Aboriginal concept of "collective property" be respected and measures drawn up protecting intellectual property rights and returning economic benefits to Aboriginal people. That the different "collective property" of each Aboriginal people be respected and that corresponding organisations in the manner of a "Foundation for the Promotion of Intellectual Property of the [tribal name] Aborigines" be established with government assistance with the board of directors made up of people from the said Aboriginal people who shall administer benefits from and use of collective property.

(iv) That a national "Museum of Aboriginal Peoples" be established at the highest administrative level to preserve the material intellectual property of Aboriginal peoples.

(v) That recording and transcription of oral accounts be actively undertaken using resources provided by a state organ of the highest level, and that cultural and other intellectual property, regardless of form of expression, be recorded using contemporary language or technology and preserved in a "Museum of Aboriginal Peoples".

(vi) That young Aboriginal people be trained to record their intellectual property using modern forms and the latest technology. That funds be allocated encouraging young Aboriginal people resident in traditional communities to participate in international exchanges and conferences, and that human resources be provided to aid language communication in these arenas.

#### **Notes:**

1. The WIPO was formed in 1970, and in 1974 became a specialised organisation within the United Nations. However, its roots date to 1883, when the Paris Convention for the Protection of Industrial Property was adopted, followed by the Berne Convention for the Protection of Literary and Artistic Works in 1886. The two conventions had established secretariats with separate regulations, but in 1893 the two secretariats merged and after many years of development this structure became the WIPO (World Intellectual Property Organisation information sheet, undated).

2. Feng Chen-yu (1994): *Understanding Intellectual Property Rights*. Taipei: Yungjan, p17. Feng is a professor in the Department of Financial Economic Law, Chungyuan University.

3. United Nations Economic and Social Council Report E/CN.4/Sub.2/1996/22, p6.

4. Wang Chun-hsiu (1998): "Global Transformation and Aboriginal Ecological Wisdom: The Environmental Justice Perspective". Paper presented to the National Science Council Social Affairs Division Symposium on Globalisation, 16-17 January, 1998. Wang is a professor in the Department of Anthropology, National Tsing Hua University.

5. *Ibid.*

6. See Jackie Chen (Chen Shu-mei)(1997): "Ami sounds scale Olympian heights", tr. Phil Newell. In: Cheng Yuan-ching, Sinorama Magazine (eds): *The struggle for renaissance: Taiwan's indigenous culture, Volume III*. Taipei: Sinorama Magazine, pp44-59.

7. *Ibid.*

8. Chen Shu-cho (1997-1998): "Aborigines in a test tube". *Yiwang zazhi* (Medical Hope), 23, 45-47.

9. *Translator's note*: There is dispute over the ethnic status of the officially unrecognised Shao people, who number only a few hundred people and are resident in the Sun Moon Lake area in Nantou County. The dispute is largely over whether they are "assimilated" to the extent that they cannot be regarded as Aboriginal. Cultural similarities to the adjacent and officially recognised Tsou people, resident around the greater Alishan area (including Nantou, Chiayi and Kaohsiung counties), have also seen disputes over whether the Shao are actually "part of" the Tsou, and so on. The Shao themselves assert a separate identity despite these doubts. The Taroko people on the other hand are part of the officially recognised Atayal people, and are resident in the region of the famed Taroko Gorge; the argument has been put forward by certain members of the Taroko that they should be regarded as a distinct ethnic group.

# Intellectual Property Enforcement in Taiwan

With offices in the United States and Taipei, Wang & Wang helps clients enforce their intellectual property rights in Taiwan. In most cases, an intellectual property rights holder starts enforcing his rights with an investigation, and then must determine which of the following methods of enforcement best protects his intellectual property rights in Taiwan.

- [Investigations](#)
- [Raids](#)
- [Preliminary Injunction](#)
- [Indictment and Trial](#)
- [Cease and Desist Letter - Negotiation and Settlement](#)

## Investigations

An investigation of a target can determine the scope and level of infringement, and can also provide evidence for filing a complaint or instigating a police raid. It generally takes two to three weeks to obtain such evidence. No meaningful discovery procedure exists in Taiwan, thus the amount and quality of evidence of infringement we can present during litigation has a direct bearing on our chances of success. Moreover, any additional evidence revealed during such investigations puts us in a stronger position to proceed with the issuance of a cease and desist ("CD") letter and settlement negotiations in lieu of proceeding with a raid and civil or criminal litigation. Investigations help to determine the following:

- Whether the infringer exports the goods
- Whether the infringer manufactures and/or sells the goods
- The volume of infringing goods produced/sold
- The dollar value of the infringing goods compared to the price of the legitimate goods
- The location of the goods, such as in a warehouse, or distribution center

Depending on the results of the investigations, we can determine whether to proceed with raid actions, filing a lawsuit, or merely issuing CD letters.

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## Raids

With evidence in hand, we can prepare a complaint and begin raid coordination with the police. The Public Prosecutor generally asks the court to issue a search warrant within ten days of our commencing preparation meetings with the police.

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## Preliminary Injunction

Although the Court may issue a preliminary injunction, if petitioned to do so, the Court has ample discretion to determine the provisional measures it deems appropriate to each case. In addition, the petitioner must file a civil suit within a period specified by the Court, which is usually about one week. In the case of a provisional seizure for a monetary claim, the defendants may request that the Court order the plaintiff to post a bond, usually somewhere between one third to one half of the plaintiff's claim, to cover defendant's potential damages. However, in the case of provisional measures for a non-monetary claim, such as a claim for ceasing infringement, the court may request the plaintiff to post a bond for the full damages that may be suffered by the defendant. If the plaintiff loses the civil suit, it is liable for the defendant's actual damages, not limited solely to the bond posted. Damages could include injury to the corporate reputation.

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## Indictment and Trial

Following a raid, the Public Prosecutor's Office holds indictment hearings. These usually take three to six months, and consist of a series of four to five hearings. If an indictment is filed, there is another series of hearings for the criminal trial. This set of hearings usually lasts another three to six months. The trial process generally costs a similar amount, but varies with the complexity of the case and the defense.

With an indictment secured, we generally file an ancillary civil suit. One advantage of a piggy-back civil suit is that a plaintiff avoids the requirement to post court costs. The costs the plaintiff must post are generally a percentage of the damages or the value of the injunction claimed. These costs may be assessed at up to 4% of the value of the damages or injunction claimed, depending on various factors. Some non-binding cases based on infringement that have set precedent hold that the value of the injunction claim may be 20% of the paid-in capital of the infringing company. However, some judges tend to have the Trademark or Service mark and relevant factors evaluated by an appraiser to determine the value of such claim. The court costs operate as a strong incentive to not claim damages, and put the plaintiff in a civil suit at a financial risk.

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## Cease and Desist Letter - Negotiation for Settlement

For some infringers, the threat of criminal and civil liability is sufficient incentive to halt infringing activities and negotiate a settlement. The letter and negotiation approach can prove to be a cost-effective manner of stopping infringement, especially for retailers and small targets not meriting the effort of a law suit. A CD letter demands that infringers immediately stop the production and sale of any and all infringing goods, and deliver or destroy all infringing goods already produced and/or distributed.

## Trademark Law in Taiwan

With an office in Taipei, Wang & Wang is able to assist international clients with the registration and protection of trademarks in Taiwan. Exclusive rights to the use of a trademark in Taiwan requires registration of the mark. The exception is that famous marks, even if unregistered, may be protected by Taiwan's Fair Trade Law, and may block the registration of similar marks in Taiwan, provided that the owner of the famous mark can prove that the mark was well-known in Taiwan before the application date of the similar mark. Generally, U.S. trademark owners are eligible for trademark registration in Taiwan.

Trademark owners must apply separately for registration of a mark in each class in which it is to be used.

- Registration Procedure
- Term of Protection
- Types of Trademarks
- Unregistrable Marks
- Use Requirements
- Licensing
- Actions to Prevent or Revoke Registration of Similar Marks
- Paths of Appeal

### Registration Procedure

A trademark applicant must file an application with Taiwan's Intellectual Property Office ("TIPO"). Normally, the TIPO renders a decision within six months after it receives all supporting documents. If the application is approved, the mark will be published and registered after the applicant pays registration fees within two months upon receiving the approval notice.

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### Term of Protection

The term of protection is ten years from the date of registration. The trademark may be renewed for additional ten year terms within six months of the expiration date of the mark's present term. There is also a six-month grace period following expiration of a mark.

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## Types of Trademarks

Taiwan law distinguishes among three types of trademarks:

- **Principal Mark** - Including word, drawing, symbol, color, sound, three-dimensional shape, or combination thereof
- **Group Mark** - A mark used by members of a cooperative or association, such as by union members (these marks are generally used on goods not sold directly by members of the group)
- **Certification Mark** - A mark used to identify the quality or characteristics of products as meeting the criteria of a certifying body, but not the particular source of goods (certification marks will not be registered if they are descriptive)

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## Unregistrable Marks

Several types of trademarks are not granted registration in Taiwan. Among these are marks that are identical or similar to national flags; marks that are identical with or similar to other registered marks for the same or similar merchandise; marks that are likely to lead the public into misidentification or misconception in respect of the characteristics, quality, or place of origin of the merchandise; marks that are descriptive of the merchandise to which they are applied; marks that are identical or similar to another person's famous mark thus causing the public to confuse or misidentify it or diluting the identification or reputation of the famous mark; and marks that are not distinctive. Suggestive marks are generally considered to be "descriptive" by TIPO examiners. For more specific information on marks barred from registration, please contact our office.

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## Use Requirements

Use of a trademark by the registrant or his registered licensee is mandatory. Non-use for three years immediately following registration, or continuous suspension from use for three years may result in cancellation of the registration or deletion of goods listed on the registration but not actually used. To satisfy TIPO use requirements, the mark must be used "as a whole," as registered.

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## Licensing

Failure to record a trademark license agreement with the TIPO may result in cancellation of the trademark registration. However, the new trademark law states that TIPO will notify the trademark owner in writing and give the trademark owner an unspecified period in which to cure the defect. It should be noted, however, that the licensee will have no right to enforce the trademark rights until the license is recorded.

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## Actions to Prevent or Revoke Registration of Similar Marks

Trademark registration may be prevented or revoked in certain situations:

- **Oppositions** - Filed within three months after a trademark has been registered and published, usually on the grounds that the mark is similar to either another registered mark for the same or similar merchandise, or to a mark well-known in Taiwan.
- **Invalidations** - Filed after a mark has been granted registration, on substantially the same grounds as for oppositions, but not where the same arguments have previously failed in opposition to the same mark.
- **Cancellations** - Filed after a mark has been granted registration, on the grounds that the trademark owner violated certain trademark regulations following registration. Such violations might include any of the following: (1) lack of use of the mark; (2) alteration of, or addition to, the mark; (3) failure to attach appropriate distinctive symbols under Article 36; (4) a mark's becoming descriptive of the name or shape of the designated goods or services; (5) unrecorded licensing of the mark; (6) a mark that is likely to lead the public into misidentification or misconception in respect of the characteristics, quality, or place of origin of the merchandise; or (7) a court judgment finding infringement of another person's copyright, new design patent, etc., by the trademark.

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## Paths of Appeal

In the event that the TIPO returns an unfavorable decision on an application, opposition, invalidation, or cancellation action, the following paths of appeal may be available:

- Appeal to Ministry of Economic Affairs ("MOEA")
- Administrative Suit filed with Administrative High Court

- Appeal to Administrative Supreme Court

**Guidelines for developing national legislation for the protection  
of traditional knowledge and expressions of culture based on the  
Pacific Model Law 2002**

**SECRETARIAT OF THE PACIFIC COMMUNITY  
NOUMEA, NEW CALEDONIA**

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# FOREWORD

In September 2002, I was fortunate to attend the first Pacific Island Regional Meeting of Ministers of Culture, held in Noumea, New Caledonia. A key item on the agenda was the presentation and subsequent endorsement of a Regional Framework for the Protection of Traditional Knowledge and Expressions of Culture (also known as the Pacific Model Law), which had been developed under the leadership of the Secretariat of the Pacific Community (SPC). As the New Zealand Government gives further consideration to traditional knowledge issues, I continue to be inspired by the enthusiasm of our discussions and the progress that is being made in terms of cultural heritage preservation and promotion in the Pacific Islands.

I am delighted that New Zealand has been given this opportunity to work with SPC on developing a set of guidelines designed to assist policy-makers in Pacific communities in the development of national legislation for the protection of traditional knowledge and expressions of culture. Based on the Pacific Model Law, the guidelines move Pacific communities one step closer towards the implementation of a regional framework for protecting traditional knowledge and expressions of culture. It is a resource that will help traditional knowledge holders identify potentially applicable protection mechanisms in the current intellectual property rights regime.

Internationally, issues relating to traditional knowledge have received increasing attention due to concerns such as the rapid loss of traditional knowledge and cultural diversity, illicit uses and misappropriation of traditional knowledge with little or no sharing of benefits with traditional communities, and interest in harnessing the potential of traditional knowledge for sustainable development.

Many countries and communities are considering how to best address these issues and concerns. The Pacific Model Law recognises that a 'one-size-fits-all' or 'universal' template to protect expressions of culture is not likely to be workable in terms of accommodating national priorities, the legal and cultural environment and the needs of traditional communities. Instead, a broad and holistic approach to issues relating to traditional knowledge is taken in order to find the best way to enable policy solutions to fit seamlessly together and work in a complementary manner.

The preservation, protection and promotion of traditional knowledge are of crucial importance for Pacific communities. Traditional knowledge forms an integral part of the lives of Pacific peoples and plays a critical role in their health, culture, identity, education, food security and natural resources management. It is therefore vital to the future well-being and sustainable development of Pacific communities.

**Hon. Judith Tizard**  
Associate Minister for Arts, Culture and Heritage  
Associate Minister of Commerce  
Government of New Zealand

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We acknowledge the author of the Guidelines, Anne Haira, for her commitment to this project and traditional knowledge issues generally, particularly within the Pacific region.

Lastly, SPC would like to acknowledge the work of the World Intellectual Property Organization (WIPO), and in particular Wend Wendland for his continual support of this project. The Guidelines draw from documents, publications and other materials prepared for the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC), particularly WIPO documents WIPO/GRTKF/IC/7/3, WIPO/GRTKF/IC/7/4, WIPO/GRTKF/IC/8/4 and WIPO/GRTKF/IC/9/4. These documents, which summarise the key legal and policy issues and suggest draft objectives, guiding principles and substantive provisions for the protection of traditional cultural expressions and traditional knowledge, draw from national and regional experiences and are based directly on extensive deliberations within the WIPO Committee among the diverse range of stakeholders who participate in sessions of the Committee, as well as on comments submitted by them through open commenting processes. At the same time, these materials are informing national and regional developments in many parts of the world and are a useful resource for policy-makers, legislators, communities and others. For further information, see <http://www.wipo.int/tk/en/index.html>.

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## **ACRONYMS AND ABBREVIATIONS**

<b>ADR</b>	<b>alternative/appropriate dispute resolution</b>
<b>IP</b>	<b>intellectual property</b>
<b>IPRs</b>	<b>intellectual property rights</b>
<b>NZAID</b>	<b>New Zealand International Aid &amp; Development Agency</b>
<b>PIC</b>	<b>prior and informed consent</b>
<b>PICTs</b>	<b>Pacific Island countries and territories</b>
<b>SPC</b>	<b>Secretariat of the Pacific Community</b>
<b>SPREP</b>	<b>Pacific Regional Environment Programme</b>
<b>TKECs</b>	<b>traditional knowledge and expressions of culture</b>
<b>TRIPS</b>	<b>Trade-Related Aspects of Intellectual Property Rights</b>
<b>UNCTAD</b>	<b>United Nations Conference on Trade and Development</b>
<b>UNESCO</b>	<b>United Nations Educational, Cultural and Scientific Organization</b>
<b>WIPO</b>	<b>World Intellectual Property Organization</b>
<b>WIPO IGC</b>	<b>WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore</b>
<b>WPPT</b>	<b>WIPO Performances and Phonograms Treaty</b>
<b>WTO</b>	<b>World Trade Organization</b>

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# PREFACE

Traditional knowledge and expressions of culture are the foundation of Pacific Island societies. Values and practices strengthen identities and build cohesion among communities, as well as being a rich, diverse source of creativity and innovation. Strong identities, social cohesion and the opportunity to be innovative and creative are essential in the face of rapid changes taking place in the Pacific Community, including increasing migration and urbanisation, commercial and media exploitation, and growing material aspirations. Culture is the key to a successful future for Pacific Islanders.

The heightened global competition for new products, processes and services brought about by the globalisation of trade and advances in information technology has unfortunately triggered widespread appropriation of the cultural and social identity of Pacific Island peoples. In many Pacific Island countries and territories, handicrafts and souvenirs have been replicated and imported for sale to an unknowing tourism industry. Music and images are recorded for publication without the permission of traditional owners. Medicines and plants have been patented with few benefits being returned to communities.

As manifestations of intellectual creativity, traditional knowledge and expressions of culture deserve to be accorded the same legal protection that is provided to other forms of intellectual property. Robust measures need to be taken to guarantee the status of and economic support for the clans, groups or communities that are the creators, repository, custodians and trustees of traditional knowledge and expressions of culture, which have collective ownership, are held in perpetuity from generation to generation, are incremental and informal, and change over time.

The Secretariat of the Pacific Community, in partnership with the Pacific Islands Forum Secretariat and UNESCO and through extensive consultations with stakeholders, has been working to establish the legal protection of traditional knowledge and expressions of culture through the Regional Framework for the Protection of Traditional Knowledge and Expressions of Culture (the Pacific Model Law). Designed to ensure that legitimate forms of commercialisation take place, where Pacific Island peoples consent to and profit from any commercialisation of their traditional knowledge and expressions of culture, the Model Law was endorsed at the first Pacific Island Regional Meeting of Ministers of Culture.

SPC is the lead regional agency in efforts to develop a legal protection regime for Pacific Island traditional knowledge and expressions of culture. It works with and values the contributions of its stakeholders and partners in achieving its goal. Working together is essential to success of our vision for the region: a secure and prosperous Pacific Community, whose people are healthy and manage their resources in an economically, environmentally and socially sustainable way.

**Dr Jimmie Rodgers**  
Director-General  
Secretariat of the Pacific Community

# ABOUT THE GUIDELINES

## Objective

The Guidelines are intended to provide technical assistance to policy-makers in Pacific Island countries and territories (PICTs) in the development of national legislation for the protection of traditional knowledge and expressions of culture (TKECs) based on the Model Law for the Protection of Traditional Knowledge and Expressions of Culture (the 'Pacific Model Law').

The Guidelines have been designed to align with the areas in which PICTs have indicated they require assistance:

- guidance on an effective policy process that could be followed when using the Pacific Model Law as the basis for developing national legislation;
- guidance on the policy questions that need to be considered when developing the legal elements of protection in the legislation; and
- guidance on implementation options when using the Pacific Model Law as the basis for developing national legislation.

## Scope

The Guidelines cover only the policy development portion of developing legislation for the protection of TKECs. The Guidelines do not extend to the parliamentary process, as this will differ between countries and has not been a matter on which PICTs have indicated that they require technical assistance.

Additionally, as is the case with the Pacific Model Law, the Guidelines cover only the legal protection of TKECs. 'Protection' in these Guidelines refers to protection of the creativity, innovation and distinctiveness embodied in TKECs against their unauthorised, unfair and derogatory use – in short, their misappropriation and misuse. This is distinct from, but complementary to, 'preservation', 'conservation' and 'safeguarding' of TKECs (see next paragraph). Comprehensive protection is likely to require going beyond legislation to a range of proprietary and non-proprietary tools such as customary and Indigenous laws and protocols, trade practices and marketing laws, contracts and licences, and cultural heritage registers and databases. These measures are not mutually exclusive options, and each may have a role to play in a comprehensive approach to protection. A *sui generis* system should not replace the need for such measures and programmes.

The Guidelines also do not cover the important and closely related themes of safeguarding and preservation of cultural heritage and expressions. These would need to be addressed through complementary policy measures, such as cultural heritage preservation laws and programmes and handicrafts promotion and development programmes.

## Structure

The Guidelines are structured according to the broad stages of policy development when developing legislation of this nature. In respect of the legal elements of protection, the Guidelines group this process into thematic areas rather than follow the structure of the Pacific Model Law itself.

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## Approach

The Guidelines:

- are voluntary and should not be interpreted as affecting the sovereign rights of countries;
- do not seek to promote any particular outcome nor to express any preference, but simply aim to catalogue and describe the available options to address issues;
- acknowledge that the forms of traditional expression and customary means of regulating their use, transmission, protection and preservation are diverse;
- reflect the understanding that different countries have varied interests and concerns in respect of TKECs and also that countries' positions may be based on different assumptions and ideological standpoints;
- recognise that a 'one size fits all' or universal template to protect TKECs is not likely to be workable in terms of accommodating national priorities, the legal and cultural environment and the needs of traditional communities;
- acknowledge that complementary measures, such as intellectual property (IP) laws, contracts and customary laws, will also be needed to provide comprehensive legal protection; and
- are intended to be reviewed and accordingly revised and improved as experience is gained in the legal protection of TKECs.

## Use of terms

For the purposes of the Guidelines, the use of the following terms should be interpreted as follows:

- the legislation: refers to legislation that is being developed by policy-makers in PICTs for the protection of TKECs based on the Pacific Model Law with reference to the Guidelines;
- protection: means that protection typically provided by IP laws to provide legal means to restrain third parties from undertaking certain unauthorised acts that involve the use of protected material. Protection refers to all matters affecting the availability, acquisition, scope, management and enforcement of rights and interests relating to TKECs, and is distinguished from the concepts of 'conservation' and 'preservation' but should not be construed as suggesting these are less important;
- traditional communities: encompasses both Indigenous and local communities and cultural communities;
- traditional knowledge holders: encompasses those who hold traditional knowledge from traditional communities in accordance with traditional or customary law and practices. The term 'holders' is intended to convey the relationship between a community and its traditional knowledge, often seen as custodianship or responsibility, and is considered more appropriate than the term 'owners';
- traditional knowledge and expressions of culture: means expressions of culture of traditional communities and the traditional knowledge underpinning those expressions.

## Presumptions

The focus of the Guidelines on the development of national legislation based on the Pacific Model Law presupposes the following:

- i. PICTs have reached a stage in the policy development process where the lack of legal protection for TKECs has been identified as a problem;
- ii. *sui generis* approaches have been identified as necessary, as existing mechanisms (legal and non-legal) are not sufficient to meet the objectives of protection; and
- iii. of the possible *sui generis* approaches, new *sui generis* legislation has been identified as necessary (most likely as one of many tools needed) to achieve some or all of the identified objectives of protection for TKECs.

It is beyond the scope of the Guidelines to provide a comprehensive discussion of the work that would precede this point. However, the Traditional Knowledge Toolkit being compiled by SPC includes a 'Policy Map' that has been prepared as a complementary measure to the Guidelines. It is designed to assist policy-makers in PICTs to progress through the process of developing a broad legal and policy framework for the preservation, protection and promotion of traditional knowledge, of which legislation would form part.

# THE POLICY DEVELOPMENT PROCESS

Some PICTs have expressed process-related difficulties with using the Pacific Model Law as the basis for developing national legislation. For the most part, this can be attributed to the Pacific Model Law being a type of 'end product'. As it is a high-level framework to guide the development of national legislation, countries will need to progress through the standard policy development process to 'flesh out' matters of detail and determine which aspects of the Pacific Model Law are appropriate to their circumstances. This can be challenging, however, as it involves policy-makers proceeding backwards through the policy development cycle.

With this in mind, this section outlines a possible process for developing the policy component of legislation for the protection of TKECs. It is recognised that countries may redefine these steps in order to meet their own needs and requirements. In addition, process principles to guide the policy development process are discussed.

## Organisation of work

The following suggested policy process would ideally form part of a broader process of developing a legal and policy framework for traditional knowledge generally. This could include workstreams such as preservation initiatives and the development of core IP legislation, as appropriate.

### A possible policy development process

- Part I:** Review the approach of the Pacific Model Law and determine whether or not it is an appropriate means to address some or all of the problems identified and/or the objectives of protection. Seek appropriate ministerial approval for this approach to form the basis of the new legislation.
- Part II:** Develop the overarching policy framework of the legislation, that is, the policy objectives and guiding principles. Determining objectives is a key early step. Seek appropriate ministerial approval.
- Part III:** Determine the content or scope of the legal elements of protection and seek appropriate ministerial approval.
- What is the subject matter of protection?
  - What are the criteria for protection?
  - Who are the beneficiaries of protection?
  - What is the scope of protection?
  - What are the exceptions and limitations regarding rights?
  - How will rights be managed?
  - What is the term of protection?
  - What are the formalities for protection?
  - What are the legal proceedings for taking action (including remedies and penalties)?
  - How will rights be enforced?
  - What processes can be used for dispute resolution?
  - What is the relationship with IP protection?
  - How will international and regional protection be addressed?
- Part IV:** Translate the legal elements of protection into legislative language.
- Part V:** Develop additional legislative features such as transitional measures and regulatory making powers.
- Part VI:** Develop secondary legislation (regulations).

## Process principles

Prior to commencing policy development, policy-makers may wish to consider whether it would be useful to develop process principles to guide the process. These are sometimes referred to as 'behavioural principles' and can be a useful means of ensuring that policy-makers exhibit a specified level of behaviour. They can also serve as a benchmark for all decisions taken by policy-makers, where appropriate, during the policy development process.

It is important to note that in the context of developing legislation for the protection of TKECs, the relationship between policy-makers and traditional communities is critical. It is, therefore, essential that policy-makers operate to a high standard in their engagement with traditional communities.

If countries wish to establish behavioural principles, policy-makers may wish to draw on the following points that are commonly emphasised.

- Recognise that the broad and active participation of traditional communities throughout the process is critical in order to ensure that their rights as traditional knowledge holders are fully and effectively protected.
- Acknowledge that policy development should be guided by aspirations and expectations expressed directly by traditional communities as well as by the nature, specific characteristics and forms of traditional cultures, expression and creativity.
- Respect the rights of traditional communities, including Indigenous peoples, under national and international law.

# PART 1. ASSESSING THE PACIFIC MODEL LAW APPROACH

The Pacific Model Law is a tool for PICTs that have determined that new, *sui generis* legislation is necessary and that require assistance with developing such legislation. From the outset, it should be noted that the Pacific Model Law is only one approach that can be used. There are, of course, others.

It is not the intention of the Guidelines to advocate that the Pacific Model Law will meet some or all of a country's objectives of protection. Countries will need to individually assess the approach of the Pacific Model Law as to whether it is a suitable means for doing so. To assist countries in this regard, this section explains the various dimensions of the Pacific Model Law approach. These dimensions can be broadly characterised by nature, subject matter, and legal form of protection. An additional dimension is the application of the *sui generis* system: countries can elect to develop a national system shaped according to their particular circumstances or opt to implement a regional approach (such as the Pacific Model Law) or an international approach.

If a country is to use the Pacific Model Law as the basis for national legislation, it will need to firstly adopt the approach of the Pacific Model Law as this sets the framework for the legal elements of protection (discussed in Part 3). It is fully recognised that a country may elect to take a different approach from that of the Pacific Model Law. If so, the Guidelines may be of limited assistance, although policy-makers may obtain useful guidance on generic matters.

## 1.1 Nature of the *sui generis* system

Existing *sui generis* systems for the protection of TKECs against misappropriation and misuse can be loosely grouped by nature into two areas. They both provide protection of an IP nature (the focus of these Guidelines).

- i. *Sui generis* systems with an explicit IP focus that contain new IP, or IP-like, rights – often referred to as *sui generis* IP protection. The WIPO–UNESCO Model Provisions for National Laws on the Protection of Expressions of Folklore Against Illicit Exploitation and Other Prejudicial Actions 1982 (the 'Model Provisions 1982') provide *sui generis* IP protection for expressions of folklore/traditional cultural expressions. Other examples are the Tunis Model Law on Copyright for Developing Countries 1976 (the 'Tunis Model Law 1976') and the Special Intellectual Property Regime Governing the Collective Rights of Indigenous Peoples for the Protection and Defence of Their Cultural Identity and Their Traditional Knowledge of Panama 2000 and the related Executive Decree of 2001 (the 'Panama Law 2000'). Further examples are found in several national copyright laws that contain *sui generis* provisions for the protection of traditional cultural expressions (sometimes referred to in such laws as 'expressions of folklore'). These laws very often follow the Model Provisions 1982 and/or the Tunis Model Law 1976 referred to above.
- ii. *Sui generis* systems that have been developed within a different policy area or context but nonetheless provide IP-like protection. This can often refer to systems of protection based on the customary laws/traditional protocols of traditional knowledge holders and bearers of cultural traditions. Examples also include cultural heritage preservation and marketing and consumer protection laws that sometimes have provisions aimed at the protection of TKECs against misappropriation and misuse.

The Pacific Model Law is an IP-based *sui generis* system (so it falls into the first category described above). It creates new IP, or IP-like, rights. Wide experience has shown that the IP protection of traditional cultural expressions involves legal doctrines closest to those underpinning the copyright and related rights systems. Accordingly, the Pacific Model Law addresses the protection of TKECs against the illicit uses and misappropriations that IP protection (primarily copyright) usually addresses, while taking into account the particular nature and characteristics of traditional creativity and cultural

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expressions, including their communal nature. Customary laws and traditional protocols have also been incorporated into the Pacific Model Law, but within an IP framework.

As noted previously, the Pacific Model Law addresses only the protection of TKECs at the IP interface; other aspects of protection would need to be addressed with other policy measures.

## 1.2 Subject matter of the *sui generis* system

Existing national *sui generis* systems of protection have taken different approaches to what subject matter will be covered. While traditional knowledge holders have frequently stressed that they view traditional knowledge holistically, many countries have opted not to incorporate all traditional knowledge into a single system. Possible reasons for this include the subject matter being too diverse, which raises practicality questions. In addition, the design of regimes with a broad scope or that are applicable to a wide range of beneficiary communities requires the drafting of rules that, due to their generality, may not be adequate when applied to specific types of subject matter or particular types of communities (Correa 2003: 34–36). Cultural expressions, medicinal methods, etc. may require different legal treatments in view of their different nature, as is the case under IP law (Correa 2003: 34–36).

The subject matter of *sui generis* systems can be grouped into three areas:

- i. traditional cultural expressions or expressions of culture – examples include the Tunis Model Law 1976 and Panama Law 2000;
- ii. biodiversity-related traditional knowledge – examples include the Peru Law of 2002 Introducing a Protection Regime for the Collective Knowledge of Indigenous Peoples Derived from Biological Resources (the ‘Peru Law 2002’) and Brazil’s Provisional Measure No. 2186-16 of 2001 Regulating Access to the Genetic Heritage, Protection of and Access to Associated Traditional Knowledge; and
- iii. all traditional knowledge – an example is the Philippines’ Indigenous Peoples Rights Act 1997 (the ‘Philippines Law 1997’).

The Pacific Model Law covers TKECs. This is because Indigenous and traditional communities generally regard expressions of their traditional cultures as inseparable from the systems of traditional knowledge underpinning those expressions. The Pacific Model Law does not, however, extend to other dimensions of traditional knowledge, such as knowledge related to biological resources. The nature and scope of protection it offers, including the exceptions, build most directly upon copyright principles and are therefore most directly applicable to literary, musical and artistic expressions of cultural heritage. It is worthwhile noting that a model law is also being developed under the auspices of the Pacific Regional Environment Programme (SPREP) for the protection of traditional ecological knowledge.

## 1.3 Legal form of protection

Existing laws for the protection of traditional cultural expressions utilise a wide range of legal doctrines and mechanisms. Some extend a true exclusive right while others do not, focusing rather on regulating use of the protected traditional cultural expressions.

The range of existing approaches to the legal form of protection includes:

- i. exclusive property rights: giving the right to authorise or prevent others from undertaking certain acts in relation to TKECs. An exclusive rights approach would be one way of giving effect to the principle of prior and informed consent (PIC). Exclusive rights are provided for in the Tunis Model Law 1976, Model Provisions 1982, Panama Law 2000, Pacific Model Law 2002 and Philippines Law 1997;

- ii. entitlements under a scheme for equitable remuneration: providing for some form of equitable return to rights holders for use of their TKECs, without creating an exclusive right in the TKECs. This approach has been used in some systems for protection of TKECs, often through a *domaine public payant* system;
- iii. a moral rights approach: normally providing the rights of attribution of ownership; not to have ownership falsely attributed; not to have the protected materials subjected to derogatory treatment; and, at least in some jurisdictions, the right to publish or disclose (the right to decide if, when and how the protected materials ought to be made accessible to the public) (Lucas-Schloetter 2004: 298). The integrity right that protects the reputation of creators may address anxiety over inappropriate use of expressions of culture by preventing distortion, alteration or misrepresentation of creators' works. This may provide redress against culturally inappropriate treatment of expressions of culture. The publication right is the creator's right to decide when, where and in what form a work will be published. It may be effective in providing communities with a degree of control over the publication or disclosure of sacred works and thus reduce the possibility of inappropriate use. Furthermore, it could potentially be coupled with a breach-of-confidence action if the sacred information was communicated in confidence (Palethorpe & Verhulst 2000: 31). A number of *sui generis* systems for the protection of expressions of culture provide for moral rights, including the Model Provisions 1982, Pacific Model Law 2002 and Copyright Act of Nigeria 1992;
- iv. an unfair competition approach: providing a right to prevent various acts that constitute 'unfair competition' broadly speaking, such as misleading and deceptive trade practices, unjust enrichment, passing off and taking of undue commercial advantage. This approach underlies the US Indian Arts and Crafts Act 1990, which prevents the marketing of products as 'Indian made' when the products are not made by Indians as they are defined by that legislation; and
- v. a penal sanctions approach: where certain acts and omissions are treated as criminal offences. The Model Provisions 1982 and Pacific Model Law 2002 provide for criminal offences.

These options are not necessarily mutually exclusive, and can be combined. One option may, for example, be more relevant or suited to a particular form of cultural expression than another. Most *sui generis* systems include at least one of these options.

Exclusive property rights in TKECs and IP-type mechanisms in general should complement and be carefully balanced and coordinated with other non-IP measures, to reflect the characteristics of traditional forms and processes of creativity, the stakeholder interests involved, customary uses and practices associated with such forms and processes, and community social structures and practices. It should also be noted that exclusive private property rights in TKECs, even if they are held by communities, may run counter to the characteristics of traditional forms and processes of creativity and may induce unforeseen side-effects, such as competition within and between communities. Among the many countries that have already enacted specific protection for TKECs, few provide for genuine exclusive property rights in TKECs; most aim rather at the regulation of their exploitation.

The Pacific Model Law combines some of the approaches above and provides:

- i. for exclusive property rights by providing that particular uses of TKECs require the PIC of the traditional owners;
  - ii. that the traditional owners of TKECs are the holders of moral rights in the TKECs, which comprise the right of attribution of ownership in relation to their TKECs, the right not to have ownership of TKECs falsely attributed to them, and the right not to have their TKECs subject to derogatory treatment; and
  - iii. for certain criminal offences in relation to traditional cultural rights, moral rights, sacred–secret material and importation and exportation.
-

The Pacific Model Law requires equitable benefit-sharing arrangements (monetary or non-monetary compensation) with the traditional owners where a derivative work, traditional knowledge or an expression of culture is used for a commercial purpose. However, this differs from the 'entitlements under a scheme for equitable remuneration/compensatory liability' approach, where the entitlement is not based on the creation of an exclusive property right.

In addition, while there are no specific provisions in the Pacific Model Law regarding unfair competition, it is still possible to utilise common law remedies for passing off, unjust enrichment and the like, as well as trade practices.

## 1.4 Application of the *sui generis* system

Countries can elect to develop their own national system or opt to implement a regional approach (such as the Pacific Model Law) or an international approach. Each has its own advantages and disadvantages.

- i. **National approach:** The benefit of developing a national system 'from scratch' is that it enables a country to develop measures that reflect and respond to its particular circumstances. However, the disadvantage is that in the absence of bilateral or multilateral agreements providing protection in foreign jurisdictions, protection is limited to within the particular country. This may, for example, lead to situations where a protection system in a country is circumvented by the use of the same or similar traditional knowledge in another country that does not have the necessary system of protection in place.
- ii. **Regional approach:** A regional framework can provide more effective protection than a national system. A framework approach, such as the Pacific Regional Framework for the Protection of Traditional Knowledge and Expressions of Culture (of which the Pacific Model Law forms part), can achieve harmonisation across national systems through the use of minimum substantive standards while providing flexibility for countries to modify and adapt matters of detail to suit their particular circumstances. In this sense, a 'regional approach' means a regional framework that guides national laws and ensures a certain level of similarity between them. The national laws remain, however, national, and their application is limited to their respective territories. A 'regional system' can also refer to a more integrated approach that could enable, for example, mutual recognition of rights between joining territories, reciprocal enforcement of rights in territories of the region, and a regional mechanism for the resolution of disputes. This is especially useful where particular TKECs are not confined to one country, as is the case in the Pacific and other regions.
- iii. **International approach:** It is often suggested that comprehensive protection can only be achieved by way of an international system. Such a system is likely to consist of norms and principles, such as those developed in WIPO IGC, with matters of detail left to national and regional levels. This is important given the world's cultural diversity as well as jurisprudential diversity. It is also realistic, given the varied interests and concerns of countries with positions based on quite different assumptions and ideological standpoints concerning traditional knowledge and traditional knowledge-holding groups. Nonetheless, any international regime that provides effective international legal protection will require a degree of harmonisation, and this can be achieved via norms and principles adopted at international level. An international system has as its main and most attractive feature the facility to enforce rights regarding TKECs of one ratifying country in another ratifying country (such as the international protection for copyright provided by the Berne Convention 1971). Discussions are continuing at WIPO IGC on the development and adoption of such a system. As noted, at the international level there are diverse interests at stake and a wide range of perspectives on the issues. The development of the Pacific Model Law has contributed valuably to the international discussions at WIPO, and the discussions serve to inform further consideration of the Model Law 2002 and, above all, its implementation in PICTs.

The Pacific Model Law is a hybrid of the national and regional approaches. It sets out a high-level framework for national legislation and leaves matters of detail or implementation to be determined by policy-makers in accordance with their national laws and systems. It has also been designed with the circumstances of PICTs in mind, with the expectation that it will form the basis of a harmonised legal framework for the regional protection of TKECs.

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## PART 2. DEVELOPING THE POLICY FRAMEWORK

If a country has elected to develop legislation based on the Pacific Model Law, including acceptance of the general approach of the Pacific Model Law, the next step is to develop the policy framework that will guide the development of the legislation, that is, the policy objective and the guiding principles. In a similar way to Part 1, countries will need to agree, at a general level, to the policy objective and guiding principles of the Pacific Model Law. There is, nonetheless, flexibility to articulate matters differently and to elaborate the objective and principles in more detail as appropriate. This section explains the policy objective and guiding policy principles of the Pacific Model Law and provides guidance on possible implementation options.

Depending on countries' policy processes, it may be beneficial to obtain the appropriate ministerial approvals regarding the policy framework before proceeding to the development of the legal elements of protection in Part 3. This will ensure that policy-makers have clear guidance on ministers' preferences and expectations as they progress through this stage of the process. The approvals could be obtained at the same time as seeking approval for the approach of the legislation in Part 1.

### 2.1 Policy objective

The way in which a protection system is shaped and defined will depend to a large extent on the objectives it is intended to serve. In developing the legislation, it is paramount that it has clear objectives and that careful consideration is given to the objectives sought.

An important initial step, therefore, is to determine the policy objective or objectives. This is not necessarily akin to the overarching objectives of protection of a legal and policy framework for traditional knowledge. These overarching objectives are likely to extend beyond the protection that can be achieved via this legislation to include matters such as the prevention of the granting of erroneous IP rights over TKECs. The policy objective, in this case, concerns the aim of the legislation and what it is seeking to achieve. It would form part of, and contribute to, the overarching objectives of protection of a broad legal and policy framework for traditional knowledge.

The policy objective of the Pacific Model Law is to 'protect the rights of traditional owners in their TKECs and permit tradition-based creativity and innovation, including commercialisation thereof, subject to prior informed consent and benefit sharing'.<sup>1</sup> It has four components:

- i. to protect the rights of traditional owners in their TKECs;
- ii. to permit tradition-based creativity and innovation, including commercialisation;
- iii. to ensure that the use of TKECs (in terms of tradition-based creativity and innovation) takes place with the PIC of the traditional owners; and
- iv. to ensure the sharing of benefits derived from the use of TKECs (in terms of tradition-based creativity and innovation) with the traditional owners.

Regarding drafting, the policy objective is purposely high level, in keeping with the approach of the Pacific Model Law that matters of detail are left to be determined at the national level. Countries can transfer the policy objective of the Pacific Model Law in its existing form or develop more specific policy objectives as they see fit, recalling that the core substance of the policy objective would need to be retained. Within that constraint, there is flexibility to articulate the policy objective as desired and to develop more detailed objectives and sub-objectives specific to a country's needs.

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<sup>1</sup> The Pacific Model Law does not contain matters of legislative detail such as a preamble, of which a policy objective would typically form part. The policy objective is found in its Explanatory Memorandum.

## 2.2 Guiding policy principles

Generally, the guiding policy principles of a law are designed both to promote the policy objective of the law and, at a practical level, to provide guidance for policy-makers as they develop its substance (in this case, the legal elements of protection). Where there is uncertainty as to the intent of a particular provision, the courts, government agencies, traditional knowledge holders and others can refer to the guiding policy principles for assistance. Whether a country includes provisions articulating the principles that have guided a law's development often depends on national legislative practices. The Pacific Model Law does not contain a provision stating the guiding policy principles of the legislation, but to assist policy-makers, the guiding policy principles have been extracted as follows.

- i. Recognise that traditional cultures comprise frameworks of creativity and innovation that benefit traditional communities as well as all humanity.
- ii. Recognise that traditional communities are the owners, rights holders and custodians of TKECs and the primary decision-makers regarding their use.
- iii. Respect and give effect to the right of traditional communities to control access to their TKECs, especially those of particular cultural or spiritual significance, such as sacred–secret TKECs.
- iv. Ensure measures and procedures for the protection of TKECs are fair and equitable, accessible, transparent and not burdensome for holders of traditional knowledge, while safeguarding legitimate third-party interests and the interests of the general public.
- v. Recognise that the benefits of protection should accrue to traditional communities rather than individuals, while individual rights (including conventional IP rights) for innovators or creators of original works will be able to be recognised in other systems.
- vi. Encourage the use of customary laws and systems and traditional governance and decision-making systems as far as possible, and recognise that communities will always be entitled to rely exclusively or in addition upon their own customary and traditional forms of protection against unwanted access, which might be the most effective in practice.
- vii. Recognise that the continued uses, exchange, transmission and development of TKECs within the customary context by the relevant traditional community, as determined by customary laws and practices, should not be restricted or interfered with.
- viii. Recognise that the state has a role in the protection of TKECs, including providing assistance to traditional communities in the management and enforcement of their rights in TKECs.
- ix. Strike an appropriate balance between the rights and interests of traditional communities, users and the broader public, including taking international human-rights standards into account and striking balances between, for example, the protection of TKECs on the one hand, and artistic and intellectual freedom, the preservation of cultural heritage, the customary use and transmission of TKECs, the promotion of cultural diversity, the stimulation of individual creativity, access to and use of TKECs and freedom of expression, on the other.
- x. Recognise that special protection for TKECs should be complementary to, and not replace or prejudice the acquisition of, any applicable conventional IP protection and derivatives thereof.
- xi. Ensure enforcement and dispute-resolution mechanisms are accessible, appropriate and adequate in cases of breach of the protection for TKECs.

There is flexibility to adapt the articulation of the guiding principles and to add additional principles if desired. However, as with the policy objective, as countries have elected to develop legislation based on the Pacific Model Law, the thrust of the guiding principles needs to be retained.

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# **PART 3. DEVELOPING THE LEGAL ELEMENTS OF PROTECTION**

In developing IP-based legislation for the protection of TKECs, a number of legal elements of protection need to be addressed:

- i) What is the subject matter of protection?
- ii) What are the criteria for protection?
- iii) Who are the beneficiaries?
- iv) What is the scope of protection?
- v) What are the exceptions and limitations?
- vi) How will rights be managed?
- vii) What is the term of protection?
- viii) What are the formalities for protection?
- ix) What are the legal proceedings for taking action (including remedies and penalties)?
- x) How will rights be enforced?
- xi) What processes can be used for dispute resolution?
- xii) What is the relationship with IP protection?
- xiii) How will international and regional protection be addressed?

This section of the Guidelines provides technical information on each of these elements. The nature of each element is detailed along with why the element needs to be addressed. Guidance is provided on the policy questions that need to be considered for each element and implementation options in this regard. Where relevant, the Guidelines identify important policy considerations for policy-makers.

## 3.1 Subject matter of protection

The subject matter of protection is simply that which will be protected under the legislation. As the Guidelines are concerned with the development of legislation for the protection of TKECs, the general subject matter is obvious.

However, there is an important distinction between the subject matter in general and the protectable subject matter. It is only the latter that will receive protection under the legislation.

In order to demarcate the protected subject matter, policy-makers can progress through a two-step process. This first step is to develop a description of the subject matter that should be protectable. Policy-makers may find it useful to consider this exercise as that of defining the scope of the protectable subject matter. It is commonplace for the scope of the protectable subject matter to be determined at national level rather than at regional or international level. Therefore, the Pacific Model Law should be viewed as indicative only. The second step is to develop a more precise delimitation of those TKECs that are eligible for protection under the legislation. This is addressed under the element 'The criteria for protection'.

### 3.1.1 Policy questions

The following questions are intended to assist policy-makers to identify the protectable subject matter of the legislation that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### a) Which expressions of culture should receive protection?

The legislation should identify as clearly as possible which TKECs will be protectable, or the scope of the subject matter may appear too wide and imprecise.

In developing a description of the expressions of culture for which protection is sought, policy-makers may find it useful to work through the following list:

- verbal expressions, such as names, stories, chants, epics, legends, poetry, riddles and other narratives, histories, words, signs, indications and symbols;
- musical expressions, such as songs and instrumental music;
- expressions by actions, such as dances, plays, ceremonies, rituals and other performances, whether or not reduced to a material form; and
- tangible expressions, such as drawings, designs, paintings (including body-painting), carvings, sculptures, pottery, terracotta, mosaic, woodwork, metalware, jewellery, baskets, needlework, textiles, glassware, carpets, costumes, handicrafts, musical instruments and architectural forms.

Policy-makers may also wish to refer to clause 4 of the Pacific Model Law and the definition of 'expressions of culture'. This definition is a non-exhaustive list intended to provide a basis for discussion. Countries can adapt it as desired. As well, these expressions of culture are only

#### Expressions of culture include:

- a. names, stories, chants, riddles, histories and songs in oral narratives; and
- b. art and craft, musical instruments, sculpture, painting, carving, pottery, terracotta mosaic, woodwork, metalware, painting, jewellery, weaving, needlework, shell work, rugs, costumes and textiles; and
- c. music, dances, theatre, literature, ceremonies, ritual performances and cultural practices; and
- d. the delineated forms, parts and details of designs and visual compositions; and
- e. architectural forms.

#### Pacific Model Law, Clause 4

examples of this particular subject matter, bearing in mind the diversity of culture within the Pacific region. It is not expected that all of these examples will be applicable to all PICTs.

In countries with a number of distinct traditional communities, policy-makers should consider whether the description adequately accommodates that diversity. It is not necessary to have separate definitions for each traditional community. It will be sufficient if the collective scope of the subject matter captures the various expressions.

## **b) What terminology should be used to describe the subject matter?**

Flexibility regarding terminology is important, and many international IP standards defer to the national level for determining such matters. Accordingly, the Pacific Model Law has left detailed decisions on terminology to be determined at national level. For example, there is an option to use the term 'traditional cultural expressions' or another term that may be appropriate rather than 'expressions of culture'. Existing laws show diversity in the terms used to refer to this subject matter. For example, the Tunis Model Law 1976 refers to 'folklore' and the Panama Law 2000 refers to 'traditional expressions of Indigenous communities'.

In addition, a country may wish to use vernacular terms to describe the expressions themselves, such as waiata, the Maori word for 'song' in New Zealand, or tivaevae, meaning 'quilts' in the Cook Islands.

## **c) Should the legislation cover both tangible and intangible expressions?**

**Expressions of culture** mean any way in which traditional knowledge appears or is manifested, irrespective of content, quality or purpose, whether tangible or intangible ...

**Pacific Model Law, Clause 4**

Many expressions of culture are preserved and passed between generations by oral means and are traditionally never written down. Under the Pacific Model Law (clause 8), TKECs are protected regardless of the form or mode of their expression. Fixation would therefore not be a requirement for protection. Of note is that fixation is not a mandatory element of international copyright law and many countries,

especially those following the civil law tradition, extend protection to works that are not fixed in material form.

In terms of drafting, if a country considers it appropriate to cover both tangible and intangible expressions, policy-makers may wish to also include the words 'or combinations thereof' to demonstrate that TKECs can be both tangible and intangible and have both tangible and intangible components.

## **d) How should the relationship with traditional knowledge be treated?**

Protectable subject matter under the Pacific Model Law includes both expressions of culture and the traditional knowledge underpinning those expressions. The rationale for this is that many traditional communities regard their expressions of culture and traditional knowledge systems as parts of an inseparable whole: the expression of culture is the manifestation of the traditional knowledge. Traditional knowledge holders have stressed that the two should not be treated separately.

Therefore, the traditional knowledge that will form part of the protectable subject matter of the legislation will be determined by which expressions of culture a country elects to protect. It will be the traditional knowledge underpinning those expressions of culture that will be protected.

Policy-makers may wish to note that since the Pacific Model Law was developed in 2002, WIPO IGC has explored further the relationship between expressions of culture and the underlying traditional knowledge in terms of legal protection. WIPO notes that while expressions of culture and traditional knowledge are inextricably linked and part of a holistic cultural heritage and identity of traditional communities in daily life, from a legal protection point of view each raises some distinct policy issues and is relevant to different aspects of the IP system and other policy areas. This is not to suggest that they should be artificially distinguished in the daily community context. WIPO suggests that distinct

legal tools and a different set of policy questions typically arise when IP is applied to protect expressions of culture on the one hand, and technical knowledge on the other. For example, the IP-like protection of expressions of culture involves legal doctrines and policy questions closest to those underpinning the copyright and related rights systems, and the relevant broader policy context includes laws and programmes related to the safeguarding and preservation of cultural heritage, respect for freedom of expression and the promotion of cultural diversity. Certain forms of cultural expression are already protected by international copyright and related rights law, such as performances of 'expressions of folklore', which are protected internationally by the WIPO Performances and Phonograms Treaty (WPPT) 1996. It is these legal and policy aspects that come into play when considering the enhanced protection of traditional cultural expressions. When it comes to knowledge and know-how as such, however, it is the principles of patent law and the considerations relating to conservation of the environment and biodiversity, as well as health and agricultural policies, that make up the relevant legal and policy context. The specific solutions for the *legal protection* of expressions of culture and traditional knowledge may, therefore, differ. WIPO suggests that it is important that the forms of protection provided for expressions of culture be inspired and shaped by appropriate legal and cultural policies. A good solution might be to protect both expressions of knowledge and culture and the knowledge itself in one law, but have distinct chapters for each area that deal with the detailed substance of protection (like a country can have an intellectual property law with different chapters for copyright, patents, trademarks, etc.).

As the Pacific Model Law is an IP-based law, PICTs are encouraged to give WIPO's observations due consideration. It is, of course, a matter for individual countries to determine whether the traditional knowledge underlying the expressions of culture will also form part of the protected subject matter. In developing legislation based on the Pacific Model Law, there is flexibility to make this determination. The above discussion is intended to assist countries to make an informed decision in this regard. Countries may wish to consider this matter in the context of their respective objectives of protection.

### **e) Should the protectable subject matter be treated equally under the legislation?**

In many traditional communities, some TKECs are considered to hold greater cultural or spiritual significance than others. There are also expressions that are sacred–secret where access and use are highly restricted. Therefore, in developing a description, countries may wish to make reference to different layers or levels of TKECs.

Recognising these distinctions can be critically important from a protection perspective, particularly in respect of the term of protection, the scope of protection and formalities. Varying and multiple levels and forms of treatment may be appropriate for different kinds of expressions. For example, expressions of particular cultural or spiritual significance may be the subject of strong forms of protection, while for other expressions, especially those that are already publicly available or accessible, the focus could be on regulation of their use.

Under the Pacific Model Law, TKECs are treated in two 'layers'. There is a stronger degree of protection for sacred–secret material.<sup>2</sup> All other TKECs are treated equally. WIPO IGC has identified three layers or groupings of expressions: secret, confidential or undisclosed expressions; expressions of particular cultural or spiritual value to a community; and other expressions. This approach takes an additional step to the Pacific Model Law and identifies two layers within non-sacred–secret expressions: those of particular cultural or spiritual value, and others.

It is important for policy-makers to consider whether all expressions should be treated uniformly or whether their treatment should reflect differences, where they exist. If a country determines that there should be different treatment, consideration will need to be given to which TKECs would fall into the

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<sup>2</sup> 'Sacred–secret' means any TKEC that has a secret or sacred significance according to the customary law and practices of the traditional owners concerned (clause 4). Clause 28 establishes a criminal offence for non-customary use of sacred–secret material.

various layers. Implementation options regarding varying layers of treatment are considered under the elements 'Scope of protection', 'Term of protection' and 'Formalities'.

### **3.1.2 Further information**

Another source of information regarding the subject matter of protection is:

- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 6 provides information on the subject matter of protection in copyright.

## 3.2 Criteria for protection

Having developed a description of the subject matter generally, the next step is to formulate a more precise delimitation of those TKECs that are eligible for protection under the legislation. This is because within an IP-based *sui generis* system such as the Pacific Model Law, it is conceivable that not all TKECs are the subject of protection.

In order to distinguish between expressions that form part of the subject matter in general and those that are eligible for protection under a specific legal measure, laws typically stipulate the substantive criteria that subject matter should display in order to be protectable.

The Pacific Model Law does not include explicit criteria for protection. In developing national legislation, countries could benefit from developing explicit criteria for protection and linking them with the description of protectable subject matter.

### 3.2.1 Policy considerations

In identifying the characteristics that TKECs should possess in order to be protectable, an important policy consideration is the balance between protection imperatives and the promotion of creativity. If a criterion is too rigorous, the level of protection will be reduced. However, if a criterion is relatively loose, it could have a negative impact on the public domain, which is likely to impact on innovation and creativity.

Another consideration is that of extra-territorial protection. While generous and flexible criteria may provide protection for more expressions nationally, lesser protection may be available in other jurisdictions that do not take such a broad approach. A difficulty for countries is that there is currently no international standard regarding criteria for protection of expressions of culture. That being the case, countries could take guidance from provisions developed within WIPO IGC that have the potential, in their existing or modified form, to evolve into a form of international norm or standard.

### 3.2.2 Policy questions

The following questions are intended to assist policy-makers to develop criteria for protection that are appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### **a) To be protected, should expressions be required to be the result of creative human intellectual activity?**

To be protectable as IP, subject matter should be the result of creative human intellectual activity, including collective creativity.<sup>3</sup> Examples of this principle include the 'originality' requirement of copyright works and the 'novel' requirement in patent laws. However, existing *sui generis* systems for the protection of TKECs do not generally require the protected TKECs to be 'original' or 'new' because such a requirement would protect only contemporary TKECs.<sup>4</sup> WIPO has also suggested that an 'originality' requirement would be out of step with evolving practice and would exclude significant amounts of TKEC subject matter (WIPO 2005 Annex: 11–15).

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<sup>3</sup> The Convention Establishing the World Intellectual Property Organization 1967 defines IP by reference to rights relating to: literary, artistic and scientific works; performances of performing artists, sound recordings and broadcasts; inventions in all fields of human endeavour; scientific discoveries; industrial designs; trademarks, service marks and commercial names and designations; protection against unfair competition; and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic field.

<sup>4</sup> This includes contemporary interpretations, arrangements, adaptations or collections of pre-existing cultural materials made by an identifiable individual or individuals, and not those materials themselves and mere recreations and imitations of them.

This raises the question of what an appropriate principle might be for the protection of TKECs that is in a manner inspired by IP. WIPO has suggested that a focus on 'intellectual creativity' may be appropriate as a substantive criterion for protectable expressions of culture (WIPO 2005 Annex: 11–15). TKECs are the products of creative and intellectual processes and this criterion would acknowledge the creative and intellectual value of the material.

Similarly to 'originality' in copyright, 'creativity' is not susceptible to precise and detailed definition at the international level. If a country considers it appropriate to include a 'creative' criterion, it should be noted that conformity would need to be determined by relevant judicial authorities on a case-by-case basis with due regard to the nature of TKECs and guided as appropriate by customary practices and the cultural context of the relevant community that identifies with the TKEC.

A subject of discussion at WIPO and elsewhere is whether or not individual creativity taking place within a traditional context (such as the contemporary but tradition-based art of a traditional community member) can qualify as a 'traditional' cultural expression and therefore benefit from *sui generis* protection. On the one hand, some argue that because such contemporary creativity is protectable under copyright, it should not also be able to get additional *sui generis* protection, and that allowing this causes an uneasy overlap between conventional copyright and *sui generis* systems. On the other hand, it is argued that even individual creativity can be 'traditional' when it is recognised as such by the artist's community and is undertaken within a customary and traditional context.

## **b) To be protected, should expressions be required to have an association with a traditional community?**

Most, if not all, existing systems for the protection of TKECs establish a criterion requiring some form of linkage between the TKEC and the community, often to distinguish between 'authentic' and 'non-authentic' TKECs to prevent the misleading marketing and sale of imitations. This linkage can be embodied by a possible criterion that TKECs should be 'characteristic' of a distinct cultural identity and heritage of a particular community.

There is some overlap between the criteria of 'authenticity' and 'characteristic'. Both seem aimed at establishing that only TKECs that have some true linkage with a community should be protectable. However, a number of issues have been identified with the use of the term 'authentic', particularly in folkloristics. The term 'characteristic' may therefore be a less problematic option, particularly as 'authenticity' is implicit in the requirement that the expressions, or elements of them, must be 'characteristic': expressions that become generally recognised as characteristic are, as a rule, authentic expressions, recognised as such by the tacit consensus of the community concerned.

Some *sui generis* systems and measures circumscribe the qualities that the makers of TKECs should display. For example, the US Indian Arts and Crafts Act 1990 provides protection only to arts and crafts that are 'Indian products' and the Indian Arts and Crafts Board registers trademarks of genuineness and quality; Australia's Label of Authenticity may be used only by 'Certified Indigenous Creators', as defined (Janke 2003: 134–158); and the *toi iho*<sup>TM</sup> 'maori made' mark of New Zealand, a registered trademark 'of authenticity and quality for Maori arts and crafts', is licensed to artists of 'Maori descent to be used on works produced by them which comprise an explicit or implicit Maori referent' (Arts Council of New Zealand n.d.).

Existing approaches are neutral regarding the physical residence of an individual TKEC holder or performer or community. In other words, a TKEC held or performed by an individual or a community living outside of his, her or its traditional geographical place of origin may still qualify as a protectable TKEC provided it remains 'characteristic' of the community's identity and heritage.

Policy-makers also need to consider whether expressions that characterise more recently established communities or identities will be covered.

### **c) To be protected, should there be a requirement that expressions be maintained or used by a community?**

An unfortunate reality is that some TKECs are no longer maintained or used by traditional communities. This raises a policy question of whether protection should be extended to TKECs that, although once characteristic of a traditional community, are no longer maintained or used by the community or by individuals having the responsibility to do so. Recalling the policy consideration of balancing protection with the promotion of creativity, countries may wish to consider whether there would be benefits in including a criterion that a TKEC be maintained, used or developed by a community, or by individuals having the right or responsibility to do so in accordance with the customary law and practices of that community. If this criterion is not met, then the TKEC would not be protectable even if it is the result of 'creativity' and 'characteristic' of a traditional community.

While this may appear to promote fairness, it is important to bear in mind that many PICTs are in the process of developing cultural preservation and revitalisation programmes to address the loss of cultural practices. If a 'maintenance or use' criterion were instituted, it might effectively exclude many expressions that have not been utilised in recent times.

### **3.2.3 Further information**

Another source of information regarding the development of criteria for protection is:

- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 7 provides information on the criteria of protection in copyright.

## 3.3 Beneficiaries

Traditional knowledge is generally understood to be a collective product of a traditional knowledge-holding community (even though individual innovators or traditional knowledge holders may have distinct personal rights or entitlements within the community structure). Any rights and interests in this material are commonly considered to be those of communities rather than individuals.

This is reflected in a guiding principle of the Pacific Model Law, which states that the benefits of protection should accrue to traditional communities rather than individuals while recalling that individual rights (including conventional IP rights) for innovators or creators of original works will be able to be recognised in other systems. The development of this element involves elaborating this principle in more detail.

### 3.3.1 Policy questions

The following questions are intended to assist policy-makers to develop a substantive policy regarding beneficiaries of protection that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### **a) What groups or communities should benefit from the protection of TKECs?**

TKECs are held by a range of communities, including Indigenous peoples, tribal peoples, local communities and other cultural communities. In the Pacific region, there is likely to be a range of traditional knowledge-holding communities within one particular country. An initial question for countries is which groups or communities should benefit from protection and whether this should extend to all traditional knowledge-holding communities or only specific groups.

Existing laws for the protection of TKECs utilise a range of approaches. In some cases protection is limited to knowledge held by Indigenous communities,<sup>5</sup> while in others the concept of beneficiaries is much broader and involves knowledge held by Indigenous as well as local communities or populations.<sup>6</sup> WIPO IGC has developed a draft provision that establishes that protection of TKECs should be for the benefit of Indigenous peoples and traditional and other cultural communities (WIPO 2005 Annex: 16). It also contemplates that more than one type of community may qualify for protection of their TKECs. Under the Pacific Model Law, the beneficiaries of protection are the 'traditional owners' of TKECs, which is sufficiently broad to encompass the range of traditional knowledge-holding communities.

In regard to identifying which groups or communities should benefit from conferred communal rights and interests in their TKECs, including considering whether or not to delimit the possible beneficiary groups, a country's objectives of protection should be instructive. There may also be moral or historical reasons that justify particular groups benefiting from protection ahead of other groups.

If a country considers it appropriate to delimit the possible beneficiary groups, it could include specific criteria in the legislation that beneficiary groups have to meet, such as being an Indigenous or local community of the country in question.

#### **b) How should beneficiary groups be described?**

The Pacific Model Law describes the beneficiaries of protection as 'traditional owners' – a broad term intended to cover the variety of traditional knowledge-holding communities. There is flexibility for countries to use an alternative term to describe the beneficiary group(s) in the legislation. Dependent

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<sup>5</sup> For example, the Panama Law 2000.

<sup>6</sup> Examples include laws in Bangladesh, Brazil and Portugal.

on the decision taken in section 3.3.1(a) above, it may be considered appropriate to refer to, for example, 'Indigenous people' or 'local communities'.

As well, some countries may prefer an alternative term to 'owners'. The term 'holders' is often considered to be more appropriate than 'owners'. It is used to convey the relationship between a community and its traditional knowledge, which is often seen as being more akin to custodianship.

In addition, existing laws for the protection of traditional knowledge do not necessarily identify beneficiaries as holders of distinct intangible property rights as such, although some have elected to establish distinct rights. Some laws identify the rights holders through the term 'local communities' or 'Indigenous peoples', or a combination thereof. Others do not identify rights holders, but define that 'benefit claimers' shall include 'creators and holders of knowledge and information relating to biological resources'. Other laws contain open definitions such as 'those who have registered their IPRs on traditional medical intelligence'. The Costa Rican law provides that the title holder of *sui generis* community intellectual rights shall be determined by a participatory process.

### **c) Should particular linkages be required between the beneficiaries of protection and the protected TKECs?**

The establishment of required linkages between the beneficiaries of protection and the protectable subject matter can be used for several purposes. If a form of 'relationship linkage' is required between the beneficiary group and the TKEC, this can be useful in ensuring that the appropriate groups benefit from protection. It can also promote greater certainty and transparency within the regime. The linkage could be demonstrated by reference to customary law or community practices. In the absence of such a linkage, a traditional community could potentially claim rights and interests in an expression of culture that is, in actual fact, held by another traditional community.

Relationship linkages can also be useful in scenarios where a small group within a broader community holds a TKEC that other parts of the particular community do not. In this situation, it may be considered appropriate for the group to benefit from protection rather than the community as a whole. The group could use the relationship linkage to demonstrate that it has the relationship required in order to benefit from the protection of the expression(s) in question.

In terms of linkages that could be used, two possibilities are:

- those to whom the custody, care and safeguarding of the TKEC are entrusted in accordance with customary law and practices; and
- those who maintain, use or develop the TKEC as characteristic of their cultural and social identity and cultural heritage (or simply 'as being characteristic of their traditional cultural heritage').

Traditional owners of TKECs are defined as:

- a) the group, clan or community of people, or
- b) the individual who is recognised by a group, clan or community of people as the individual

in whom the custody or protection of the TKECs are entrusted in accordance with the customary law and practices of that group, clan or community.

**Pacific Model Law, Clause 4**

### **d) How should the beneficiary group be represented?**

Having clarified the beneficiary group or groups in name or description, the next step is to consider whether or not the legislation will prescribe how these groups may or should be represented to receive benefits under the legislation (and to assert their rights). Existing laws for the protection of traditional cultural expressions use a range of approaches to address this issue, including the following.

- Requiring the beneficiary group to have a legal personality: For the purpose of legal procedures such as enforcing rights, a country may require the beneficiary group to have some form of legal

personality. The legislation could prescribe a particular form or provide that the beneficiary group must designate a distinct legal person (such as an association, a legal representative or a trustee) as rights holder in trust. Countries may wish to draw on existing legal models in their domestic law and experience with any community-held IP, such as collective marks, and on applicable customary law. For example, in the Panama Law 2000, existing models are utilised so that the relevant Indigenous communities may be represented by their general congresses or traditional authorities.

- Determining representation through a process such as registration or certification: A registration or certification process could be used to ensure there is a distinct entity to represent the beneficiary group. While it would require state involvement, it would be without the formalities of obtaining and maintaining a legal personality. This approach could also be used to support communities' own rules and customary practices by providing that beneficiary groups determine their representative(s) according to customary practices and notify the appropriate state body for registration or certification purposes. Alternatively, the legislation could specify the criteria to be met in order for a community to register as a beneficiary group. Such criteria could reflect any required linkages between a community and a TKEC. In Thailand, the PVP Law 1999 stipulates that 'a sui juris person, residing and commonly inheriting and passing over culture continually, who takes part in the conservation or development of the plant variety ... may register as a community under this Act'. In Portugal, the representation claimed by any private or public entity for registration of a local plant variety must be certified by a competent municipal chamber.
- Not prescribing a representation requirement: It is not imperative that the beneficiary group be identified as distinct 'owners'. The legislation could be silent in respect of representation requirements, thereby leaving the matter open to all forms of representation. IP need not be separately owned by distinct rights holders. Some forms of IP protection, such as geographical indications, do not need to have distinct 'owners' and may be administered by the state on behalf of groups of eligible producers. Collective marks and certification marks may be protected on behalf of a group of beneficiaries. Where the 'right' is essentially an entitlement to seek certain legal remedies and injunctions, there may not be a need to identify a specific right holder, and it may be possible to define aggrieved or interested parties who have standing to take action. There would be implications for international protection if the beneficiary group were to be granted rights in foreign jurisdictions and there were no distinct rights holders.<sup>7</sup> The Pacific Model Law does not prescribe how 'traditional owners' may or should be represented for the purposes of legislation. This is not a policy of the Pacific Model Law but, rather, reflects its approach that it is a high-level framework and a matter such as representation should be determined at national level. There is flexibility to institute a representation requirement if desired or to leave the matter open. If the latter approach is taken, a prospective user wishing to use TKECs would apply to the Cultural Authority established under the legislation, which would then follow a prescribed process to identify the relevant traditional owners.

## **e) Should the state have a beneficiary role?**

While it is well established that the beneficiaries of protection should be the communities that hold the TKECs, in some cases it may be considered appropriate for the state to have a beneficiary role as well. For example, where there are difficulties in identifying which groups have rights over specific expressions, particularly expressions that are shared across communities, the state could receive the benefits of protection on behalf of these communities and then apply the proceeds towards initiatives that are for the betterment of all the communities concerned. In existing laws that take this approach, proceeds from the granting of such rights are applied towards national heritage, social welfare and culture-related programmes for the general benefit of traditional communities but without transferring the proceeds directly to the communities. In addition, if there are issues with transferring the benefits

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<sup>7</sup> Although, in respect of collective marks, the Paris Convention provides for the protection of collective marks belonging to associations 'the existence of which is not contrary to the law of the country of origin, even if such associations do not possess an industrial or commercial establishment' (Article 7*bis*).

of protection to the beneficiary group, the state could act as a conduit and receive the benefits on their behalf, then transfer the benefits to the beneficiary group.

If the state assumes a beneficiary role, policy-makers may wish to consider whether the state should also have a role in the management and enforcement of rights, which are often a heavy burden for traditional communities to bear (see the elements 'Management of rights' and 'Enforcement').

#### **f) How can the relationship between a beneficiary group and an individual creator be addressed?**

Where an individual has developed a tradition-based creation within his or her customary context, it is regarded from a community perspective as the product of communal creative processes. This aligns with the essential characteristics of 'traditional' creations: they contain motifs, a style or other items that are characteristic of and identify a tradition and a community that still bears and practises them. The creation is not 'owned' by the individual but 'controlled' by the community according to customary legal systems and practices. This is what marks such a creation as 'traditional' and provides a policy rationale for providing benefits under the legislation at collective rather than individual level.

In terms of how the interests of individual creators should be addressed within their communities, the Pacific Model Law takes the approach that this is a matter for customary law and practices to address. Customary law often establishes the attribution of rights and benefits within a community, including individual interests in traditional knowledge. This will also be relevant for individual rights that may accrue under existing IP laws. There is, of course, flexibility for countries to incorporate measures that regulate the relationship between individual creators and their community. However, the use of such measures is not commonly recognised as being desirable.

#### **g) Can there be two or more beneficiary groups in particular TKECs?**

In some cases, two or more traditional communities in a country may share the same or similar TKECs. As well, communities in different countries and even regions may lay claim to the same or similar TKECs. This can result in potentially overlapping rights in the same or similar expressions, and therefore it will be necessary to clarify the allocation of rights or distribution of benefits among those communities. As this is not a question of whether the groups should benefit, but rather how the benefits should be distributed, the issue is addressed under the element 'Management of rights'. For the purposes of the present element, it is useful to note that there may be two or more beneficiary groups in some TKECs and that policy measures will be needed to address these multiple interests.

### **3.3.2 Further information**

Another source of information regarding beneficiaries of protection is:

- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 5 provides information on the beneficiaries of protection in copyright.

## 3.4 Scope of protection

The protection of TKECs is a central component of the legislation. As the Guidelines focus on the development of an IP-based *sui generis* system (based on the Pacific Model Law), the protection afforded by the legislation is that which IP usually addresses – that is, illicit uses and misappropriations.<sup>8</sup> It is important to recall that this conception of protection reflects a strong IP focus. It is acknowledged that expectations regarding protection are likely to extend beyond illicit uses and misappropriations. Therefore, general background information is provided in this section to illustrate where the legislation may sit in a broader framework of protection.

The form of protection in the Pacific Model Law draws on legal doctrines similar to copyright and related rights. It consists of:

- i. exclusive property rights<sup>9</sup> where particular uses of TKECs require the PIC of the traditional owners. Failure to obtain the PIC of traditional owners where required will constitute an illicit use and/or misappropriation; and
- ii. the moral rights of traditional owners in their TKECs.

The development of this element entails clarifying the scope of these rights – that is, the uses, appropriations and omissions that should be prohibited, should require authorisation or should be regulated in other ways. It also involves consideration of whether different types of protection should be applied to different layers, where appropriate, of TKECs.

### 3.4.1 Background

#### **a) What uses, appropriations and omissions regarding TKECs are frequently identified as being of concern to traditional communities?**

From the outset, it is acknowledged that traditional communities are diverse and are likely to have a range of views in this area. It would be useful for policy-makers to progress through a problem-definition process to develop a localised understanding of the uses, appropriations and omissions that are of concern to traditional communities in their particular country.

The uses, appropriations and omissions regarding TKECs that are frequently identified as being of concern to traditional communities include, but are not limited to:

- a) unauthorised reproduction, adaptation and subsequent commercialisation of TKECs, with no sharing of economic benefits. This could include the recording of traditional music, the reproduction of paintings, and the taking of photographs of traditional beadwork and attire worn by Indigenous and traditional persons;
- b) appropriation of traditional languages, such as Indigenous and traditional words, symbols and other distinctive signs being used by non-community members outside the traditional context;
- c) use of TKECs that is insulting, degrading and/or culturally and spiritually offensive. This could include, for example, the modification of an expression to suit foreign markets or the performance of a ritual in an inappropriate context or setting;

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<sup>8</sup> As noted previously, the legislation only covers protection at the IP interface, not protection generally, and is distinguishable from the related concepts of 'safeguarding' and 'preservation' of cultural heritage.

<sup>9</sup> The legal form of protection will have been agreed upon when assessing the approach of the Pacific Model Law in Part 1 of the Guidelines.

- d) failure to acknowledge the traditional source of a tradition-based creation or innovation. Examples could include the use of traditional music as part of a 'world music' album without acknowledging the source of the music;
- e) appropriation of the reputation or distinctive character of TKECs in ways that evoke an authentic traditional product by use of misleading or false indications as to authenticity or origin, or adoption of their methods of manufacture and 'style'. This could include the marketing of fake traditional souvenir items as 'Indigenous', 'Indian-made' or 'authentic';
- f) unauthorised access to and disclosure and use of sacred–secret materials. This could refer to, for example, disclosure to the public at large of secret and/or culturally sensitive materials such as tribal sites and objects of deep religious and cultural significance;
- g) unauthorised fixation of live performances of TKECs, and subsequent acts in relation to those fixations. For example, the photographing of live performances of songs and dances by Indigenous persons, and the subsequent reproduction and publication of the photographs on DVDs, tape cassettes, postcards or the Internet;
- h) granting of erroneous IP rights over TKECs and derivatives thereof. For example, a patent has been granted over a process for the formation of the Caribbean steel pan musical instrument; and
- i) the exploitation of derivative works created by individuals (particularly those not connected with the traditions and cultural materials they adapted or were inspired by) and the acquisition of IP rights over derivations and adaptations of TKECs and representations.

## **b) What policy measures can be used to address these concerns?**

It is apparent that the majority of concerns related to uses, appropriations and omissions are the type that are typically addressed through IP rights measures. It is acknowledged that there are likely to be additional concerns other than uses, appropriations and omissions regarding TKECs, such as the loss of knowledge. These would need to be addressed through additional policy measures.

Given the breadth of the abovementioned concerns, it is also apparent that a range of policy responses will be needed. It is also evident that protection would need to include not only the protection of the expressions themselves but also of the reputation or distinctive character associated with them and/or the method of production (in the case of handicrafts and textiles, for example). Some of these concerns can be addressed via existing IP rights such as copyright, trademarks, designs, patents and unfair competition, while others will require the use of new IP-type rights by way of a *sui generis* law such as the Pacific Model Law.

Table 1 illustrates policy options that could be used to address the concerns of traditional communities regarding uses, appropriations and omissions relating to TKECs. These options are not mutually exclusive.

**Table 1: Policy measures for addressing the concerns of traditional communities regarding uses, appropriations and omissions relating to TKECs**

Traditional communities' concerns	Policy measures	Examples
<p>a. Unauthorised reproduction, adaptation and subsequent commercialisation of TKECs, with no sharing of economic benefits</p>	<p>TKECs that meet the criteria for copyright protection can be protected under existing copyright laws.</p>	<p>Examples of copyright laws in the Pacific region include New Zealand's Copyright Act 1994, Australia's Copyright Act 1968, Fiji's Copyright Act 1999 and Samoa's Copyright Act 1998.</p>
	<p>For TKECs that do not meet the criteria for copyright protection, <i>sui generis</i> laws can be used that establish typical copyright-type exclusive rights over TKECs. These rights can extend to acts such as reproduction, adaptation, public performance, distribution, public recitation, communication to the public, the making of derivative works, and importation of unauthorised copies and adaptations under the law of the importing country.</p>	<p>Examples of <i>sui generis</i> laws that establish copyright-type exclusive rights over expressions of culture include the Pacific Model Law 2002, Tunis Model Law 1976 and Panama Law 2000.</p>
	<p>Regarding handicrafts in particular, explicit protection can be provided for designs as tangible expressions of culture.</p>	<p>Examples include New Zealand's Designs Act 1953 and Australia's Designs Act 2003.</p>
<p>b. Appropriation of traditional languages, such as Indigenous and traditional words, symbols and other distinctive signs being used by non-community members outside the traditional context</p>	<p>Defensive protection measures can prevent third parties obtaining IP rights over traditional words, symbols, etc. They will not prevent the use itself, but can act as a deterrent.</p>	<p>The Trade Marks Act 2002 in New Zealand includes a provision to prevent the registration of trademarks that would be likely to offend a significant section of the community, including Maori (section 17).</p>
<p>c. Uses of TKECs that are insulting, derogatory and/or culturally and spiritually offensive</p>	<p>Moral rights principles in copyright law can be used to prevent insulting, derogatory and culturally and spiritually offensive uses of TKECs.</p>	<p>New Zealand's Copyright Act 1994 contains provisions relating to moral rights, as does the Pacific Model Law 2002.</p>
<p>d. Failure to acknowledge the traditional source of a tradition-based creation or innovation</p>	<p>Moral rights principles in copyright law can be used to protect against failure to acknowledge source or misleading indications as to source.</p>	<p>The Model Provisions 1982, the Pacific Model Law 2002 and many copyright-based systems for the protection of expressions of culture provide rights and remedies in respect of failure to acknowledge source.</p>

Traditional communities' concerns	Policy measures	Examples
<p>e. Appropriation of the reputation or distinctive character of TKECs in ways that evoke an authentic traditional product, by use of misleading or false indications as to authenticity or origin, or adoption of their methods of manufacture and 'style'. This could include the marketing of fake traditional souvenir items as 'Indigenous', 'Indian-made' or 'authentic'.</p>	<p>The protection of reputation (the distinctiveness, 'style' and 'authenticity') of TKECs and prevention of false and misleading claims to 'authenticity', origin or link or endorsement by a community can be achieved through options such as:</p> <ul style="list-style-type: none"> <li>- certification trademarks;</li> <li>- geographical indications; and</li> <li>- unfair competition or trade practices.</li> </ul>	<p>Examples of certification trademarks include 'Toi Iho', the Maori Made Mark in New Zealand, and the Label of Authenticity in Australia.</p> <p>There are examples of geographical indications regarding TKECs in Portugal, Mexico and the Russian Federation.</p> <p>Regarding unfair competition or trade practices law, in an Australian case a company was prevented from continuing to describe or refer to its range of hand-painted or hand-carved Indigenous-oriented souvenirs as 'Aboriginal art' or 'authentic' unless it reasonably believed that the artwork or souvenir was painted or carved by a person of Aboriginal descent.</p>
<p>f. Unauthorised access to and disclosure and use of sacred-secret materials</p>	<p>The prevention of exploitation of sacred-secret materials can be achieved through the use of principles dealing with unfair competition, undisclosed and confidential information, breach of trust and confidence, and related areas.</p>	<p>In the Australian case of <i>Foster v Mountford</i>,<sup>10</sup> the common law doctrine of confidential information was used to prevent the publication of a book containing culturally sensitive information. The court held that the publication of the book could disclose information of deep religious and cultural significance to Aborigines that had been supplied to the defendant (an anthropologist) in confidence and that the revelation of such information amounted to a breach of confidence.</p>
<p>g. Unauthorised fixation of live performances of TKECs, and subsequent acts in relation to those fixations</p>	<p>The WIPO Performances and Phonograms Treaty 1996 provides for the protection of the moral and economic rights of performers of expressions of culture.</p>	<p>New Zealand is not a party to the WPPT. New Zealand does, however, have performers' rights provisions in its Copyright Act 1994 (Part 9) and provides performers with certain limited rights to control the exploitation of their performances where they have not given consent to that exploitation. However, there is no concept of group ownership, and members of a group do not have collective rights in a group's performance.</p>

<sup>10</sup> 1976. 29 FLR 233.

Traditional communities' concerns	Policy measures	Examples
h. The acquisition by third parties of erroneous IP rights over TKECs	Defensive protection measures can be used to prevent the granting of erroneous IP rights over TKECs, such as prevention of the unauthorised registration of Indigenous signs, symbols and other marks as trademarks.	The Trade Marks Act 2002 in New Zealand includes a provision to prevent the registration of trademarks that would be likely to offend a significant section of the community, including Maori (section 17).
i. Exploitation of derivative works created by individuals (particularly those not connected with the traditions and cultural materials they adapted or were inspired by) and the acquisition of IP rights over derivations and adaptations of TKECs and representations	<p>The right of adaptation refers to the right of an author or authors to control transformation of their work into another type of presentation, for instance, by translation or by changing a novel into a film script. Arguably, all adaptations involve reproduction where the essential features of the adapted work are used. However, in many national laws, the right of adaptation is viewed separately from that of reproduction.</p> <p>Within WIPO IGC, it has been noted that some key policy and legal questions pivot on the adaptation right, the right to make derivative works and the setting of appropriate exceptions and limitations in this regard. It is often the adaptation and commercialisation of traditional materials by 'outsiders' that cause the most cultural offence and economic harm. Suggestions have been made for communal regulation of the exploitation of derivative works created by individuals, particularly those individuals not connected with the traditions and cultural materials they adapted or were inspired by. The suggestion has also been noted that copyright and other IP rights should not be recognised in such tradition-based creations made by outsiders. Yet it has also been proposed that rights in derivative works should be fully recognised and respected and remain unencumbered by such obligations, since recognising such rights encourages and promotes tradition-based creativity. This is precisely how, some argue, the IP system is intended to work – not to reward the preservation of the past, but rather to revitalise it and incentivise tradition-based creativity for economic growth. Any copyright in the derivative work attaches only to new materials and leaves the underlying materials unaffected.</p>	<p>The Model Provisions 1982, the Tunis Model Law 1976, the Bangui Agreement, and other <i>sui generis</i> systems and national laws do not generally regulate the exploitation of derivative works. The Model Provisions 1982 contain no right of adaptation and have a wide 'borrowing exception'.</p> <p>The Pacific Model Law regulates how derivative works may be exploited and places certain obligations upon the creators of derivative works towards the relevant community. It requires benefit-sharing arrangements providing for equitable monetary or non-monetary compensation to the traditional owners where a derivative work or TKEC is used for a commercial purpose. It also requires the creator to respect the moral rights of the relevant community in the underlying traditions and heritage used, including acknowledging the community.</p> <p>Within WIPO IGC, the suggestion has been made for an adaptation right in respect of TKECs of particular cultural or spiritual value subject to prior registration or notification. In respect of other TKECs, there would be no adaptation right as such; nor would there be prevention of the obtaining of IP rights in the derivative work by its creator. Nor would, in either case, mere 'inspiration' be prevented, as is also the case in copyright law, in line with the idea/expression dichotomy. However, there would be regulation of how derivative works may be exploited.</p>

### **c) What protection measures can be provided under the legislation?**

It is useful to consider where the protection that can be achieved from a *sui generis* law such as the Pacific Model Law sits within a broader framework of protection. Based on Table 1, a country can utilise a combination of existing IP laws, adapted existing IP laws (through the addition of *sui generis* measures) and IP-based *sui generis* systems (such as legislation based on the Pacific Model Law) as well as common law principles (such as breach of confidence) to achieve a broad framework of protection.

The scope of protection that can be provided by legislation based on the Pacific Model Law includes:

- rights to authorise or prevent the unauthorised reproduction, adaptation and subsequent commercialisation of TKECs;
- appropriation of traditional languages, such as Indigenous and traditional words, symbols and other distinctive signs being used by non-community members outside the traditional context;
- uses of TKECs that are insulting, derogatory and/or culturally and spiritually offensive;
- failure to acknowledge the traditional source of a tradition-based creation or innovation; and
- exploitation of derivative works created by individuals outside of the traditional context.

These measures are similar to the protection usually provided by copyright and related rights, that is, protection against illicit uses, misappropriations and omissions.

### **3.4.2 Policy questions**

The following questions are intended to guide policy-makers through the issues relevant to developing a substantive policy on the scope of protection that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### **a) What acts regarding TKECs should be regulated?**

A central element of protection is the scope of acts that will be regulated. Typical copyright-type exclusive rights extend to acts such as reproduction, adaptation, the making of derivative works and importation. Many existing national laws for the protection of TKECs provide these copyright-style economic rights because the protection for TKECs has been conceived within copyright. In determining which uses should require the PIC of traditional communities, policy-makers may wish to refer to the following list of uses that are regulated in existing laws for the protection of TKECs:

- reproduction;
- adaptation;
- public performance;
- distribution;
- public recitation;
- communication to the public;
- the making of derivative works; and
- importation (of unauthorised copies and adaptations under the law of the importing country).

Policy-makers may also wish to refer to clause 7(2) of the Pacific Model Law:

The following uses of TKECs require the prior and informed consent of the traditional owners:

- a. to reproduce the traditional knowledge or expressions of culture;
- b. to publish the traditional knowledge or expressions of culture;
- c. to perform or display the traditional knowledge or expressions of culture in public;
- d. to broadcast the traditional knowledge or expressions of culture to the public by radio, television, satellite, cable or any other means of communication;
- e. to translate, adapt, arrange, transform or modify the traditional knowledge or expressions of culture;
- f. to fixate the traditional knowledge or expressions of culture through any process such as making a photograph, film or sound recording;
- g. to make available online or electronically transmit to the public (whether over a path or a combination of paths or both) traditional knowledge or expressions of culture;
- h. to create derivative works;
- i. to make, use, offer for sale, sell, import or export traditional knowledge or expressions of culture or products derived therefrom;
- j. to use the traditional knowledge or expressions of culture in any other material form;

if such use is a non-customary use (whether or not of a commercial nature).

**Pacific Model Law, Clause 7(2)**

It is useful to briefly mention at this point that the legislation should specify the context within which acts will be regulated. For example, in the Pacific Model Law the regulated acts only apply to non-customary use. Therefore, protection is extended only to uses of TKECs outside the traditional or customary context whether or not for commercial gain. This aligns with a guiding principle of the Pacific Model Law that provides that traditional and customary uses, exchanges and transmissions of TKECs, as determined by customary laws and practices and whether or not of a commercial nature, should not be restricted or interfered with by the legislation. This is discussed further under the element 'Exceptions and limitations'.

## **b) What acts should be excepted from regulation?**

It is commonplace for some acts to be exempted from regulation, referred to as 'exceptions' or 'limitations'. This is addressed under the next element, 'Exceptions and limitations'.

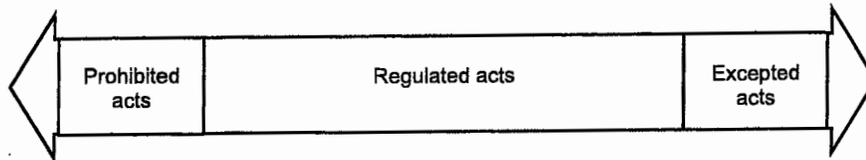
## **c) Should any acts in relation to TKECs be prohibited?**

It is likely that traditional communities may consider that some acts should not be undertaken in any circumstances. Policy-makers should refer to customary laws and practices for guidance in this regard. Prohibiting particular acts not only provides a stronger degree of protection where desirable, it also provides some clarity for prospective users on the boundaries of possible uses.

The Pacific Model Law prohibits any non-customary use of sacred–secret TKECs (clause 28).

#### d) What is the relationship between prohibited, regulated and excepted acts?

While this is not strictly a policy question, it may assist policy-makers to clarify the matter.



Both prohibited and exempted acts are excluded from the requirement to obtain the PIC of traditional communities, but at opposite ends of the spectrum and in differing ways. Prohibition bars a particular use altogether and therefore the PIC requirement does not apply. Excepted acts, on the other hand, provide that particular uses do not have a PIC requirement and can occur, usually on the proviso that particular conditions are met.

#### e) What moral rights regarding TKECs should be established?

Moral rights relate to the protection of the personality of the creator or author, the integrity of the work, and similar matters (Sterling 1998: 279). While the scope of moral rights differs in different jurisdictions, certain features are fairly common: moral rights are almost invariably treated in national legislation separately from those sections dealing with economic rights; moral rights are not assignable although they may descend to heirs or successors; and moral rights have the same term of protection as economic rights or a longer term. Also, in civil law jurisdictions, where moral rights and economic rights clash, the moral right is likely to prevail (Sterling 1998: 279).

In determining what moral rights should be established, policy-makers may wish to note that the following types of moral rights frequently appear in both national laws for the protection of TKECs and copyright law:

- the right not to have TKECs subject to insulting, derogatory, cultural and spiritually offensive uses;
- the right of attribution of source in relation to TKECs; and
- the right not to have ownership of TKECs falsely attributed.

There are other types of moral rights, such as the divulgation right (the right to decide when, where and in what form the work will be divulged to any other person or persons) and the retraction right (the right of an author to withdraw a work from publication because of changed opinion), but these do not commonly appear in national laws for the protection of traditional cultural expressions.

#### f) How should acts regarding TKECs be regulated?

Having determined what should be regulated, the next step is to consider how these acts should be regulated. This has largely been predetermined by:

- the legal form of protection in the Pacific Model Law of exclusive property rights, which enable rights holders to authorise or prevent others from undertaking certain acts; and
- the guiding principle of the Pacific Model Law that traditional communities are the owners, holders and custodians of TKECs and the primary decision-makers regarding their use.

Based on these factors, the Pacific Model Law regulates acts regarding TKECs by establishing that particular uses require the **prior and informed consent** of the traditional owners. This is referred to as a '**traditional cultural right**'. Failure to obtain the PIC of traditional owners to use expressions of culture where required will constitute an illicit use and/or misappropriation (or, for the purposes of

legal proceedings, an 'infringement'). Therefore, in order to undertake a regulated act, a prospective user would need to obtain the PIC of the traditional community concerned.

At an operational level, the Pacific Model Law establishes an elaborate process regarding how the PIC of the relevant traditional community should be obtained. In terms of the requirement to obtain the PIC of the traditional communities (recalling that sacred–secret TKECs are excluded from the operation of the regime as they cannot be used outside their customary context), the Pacific Model Law treats all TKECs in the same manner. However, there is flexibility for countries to take a different approach if desired. For example, a country may not wish to impose a PIC requirement for all TKECs and may instead prefer that some expressions be more 'lightly' regulated. This is usefully illustrated by the 'three layers of protection' approach developed in WIPO IGC.

The three 'layers' of protection are (in descending order of strength):

- i. sacred–secret, confidential or undisclosed TKECs: legal and practical measures could ensure that communities have the means to prevent the unauthorised disclosure, subsequent use of and acquisition and exercise of intellectual property rights over sacred–secret TKECs;
- ii. TKECs of particular cultural or spiritual value to a community: legal and practical measures could ensure that the relevant traditional community can prevent specified acts taking place without its free, prior and informed consent; and
- iii. other TKECs: legal and practical measures could take a softer approach to ensure that:
  - i. the relevant traditional community is identified as the source of any work or other production adapted from TKECs;
  - ii. any distortion, mutilation or other modification of, or other derogatory action in relation to, a TKEC can be prevented and/or is subject to civil or criminal sanctions;
  - iii. any false, confusing or misleading indications or allegations that, in relation to goods or services that refer to, draw upon or evoke the TKECs of a community, suggest any endorsement by or linkage with that community can be prevented and/or are subject to civil or criminal sanctions; and
  - iv. where the use or exploitation is for gainful intent, there should be equitable remuneration or benefit-sharing on terms determined by a competent authority (where appropriate) in consultation with the relevant community.

**Based on WIPO IGC document WIPO/GRTKF/IC/9/4, Article 3: 'Acts of Misappropriation (Scope of Protection)'**

The 'three layers' approach is intended to provide supple protection that is tailored to different forms of cultural expression and the various objectives associated with their protection. It reflects a combination of exclusive and equitable remuneration rights and a mix of legal and practical measures.

Policy-makers may wish to note the following regarding this approach.

- Sacred–secret, confidential or undisclosed TKECs would receive the strongest form of protection drawing on existing protection for confidential or undisclosed information, building also upon case law to this effect.<sup>11</sup>

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<sup>11</sup> *Foster v. Mountford*. 1976. 29 FLR 233.

- TKECs of particular cultural or spiritual value to a community would receive strong protection in the form of the right of 'free, prior and informed consent', but not as strong as that for sacred–secret TKECs. The right of 'free, prior and informed consent':
  - is akin to an exclusive property right in IP terms and could apply to the kinds of acts usually covered by IP laws;
  - would grant a community the right to either prevent or authorise, on agreed terms including regarding benefit-sharing, the use of a TKEC; and
  - could be subject to prior notification or registration in a public register, depending on decisions taken under the element 'Formalities' (recalling that the use of registration or notification is only an option and for decision by relevant communities).
- Other TKECs (which could be those not registered or notified, depending on the decision taken under 'Formalities') would receive the softest protection and would not be subject to prior authorisation. Instead, protection would concern *how* the TKECs were used. The TKECs could be used – as a source of creative inspiration, for example – without the need for prior consent or authorisation, in furtherance of creativity and artistic freedom. However, *how* they are so used would be regulated, drawing mainly upon moral rights and unfair competition principles as well as the payment of equitable remuneration or equitable benefit-sharing, to be determined by a competent authority. This approach is akin perhaps to a compulsory licence or equitable remuneration approach, found in national *sui generis* laws concerning TKECs as well as in conventional copyright law concerning musical works already fixed in sound recordings.<sup>12</sup>

### 3.4.3 Further information

Other sources of information regarding the scope of protection include:

- WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Geneva: WIPO. Pages 19–23 of the Annex discuss the 'three layers of protection' approach.
- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapters 8 and 9 provide information on the types of moral rights and economic rights respectively used in copyright law.

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<sup>12</sup> Article 13, Berne Convention, 1971.

## 3.5 Exceptions and limitations

It is generally recognised that in certain cases, restrictions should be placed on the exercise or scope of established rights, referred to as 'exceptions' or 'limitations'. Exceptions and limitations provisions can stipulate that a right is not infringed by the doing of certain acts, the right does not subsist in relation to a particular class of subject matter, the right does not apply to things done by the right holder, and/or the right does not apply to certain categories of work.

Restrictions on the exercise or scope of established rights may also occur through the application of legal or other principles that are separate from the law of intellectual property, such as freedom of speech or international human rights standards. The rationale for such restrictions can include consideration of the public interest and prevention of monopoly control.

In the context of protecting TKECs, many traditional knowledge holders have stressed that any IP-type protection should be subject to certain limitations so as not to interfere with the use of TKECs by traditional communities. This is reflected in a guiding principle of the Pacific Model Law that recognises that the continued use, exchange, transmission and development of TKECs within the customary context by the relevant traditional community, as determined by customary laws and practices, should not be restricted or interfered with.

The development of this element involves identifying the exceptions that will be provided for in the legislation regarding uses of TKECs (i.e. uses that are exempt) as well as defining the limitations on the scope of protection.

For simplicity, the Guidelines use 'exceptions' to describe those uses that are excepted from the need to seek authorisation, and 'limitations' to describe limits on the scope of protection. There is, however, no definition in international instruments of the difference between an exception and a limitation. Sometimes what is called a limitation in one law is referred to as an exception in another. 'Exceptions and limitations' is often used to cover all types of restrictions on the exercise or scope of established rights.

### 3.5.1 Policy considerations

At the national level, a number of factors may influence the determination of the exceptions and limitations to be introduced. Of particular significance will be the basic philosophy of a country regarding the rationale of copyright. This will be relevant in setting the parameters of restrictions at both the legislative stage and in litigation before the courts (Sterling 1998: 376). It is apparent from existing national laws that different countries have different concepts as to what restrictions should be admitted and the extent of such restrictions. For example, in the United States, while copyright law is considered to secure a fair return for an author's creative labour, its ultimate aim is to provide an incentive to stimulate the creation of useful works for the general public good.<sup>13</sup> In contrast, the French system is based on the concept of the pre-eminent position of the individual author and the recognition of the principle that the author's right is a right of personality that must be accorded the highest respect.

At the international level, Article 9(2) of the Stockholm Act of the Berne Convention introduced what is commonly known as the 'three-step test', which, in general, governs the way in which exceptions and limitations are to be applied. Countries are able to make their own decisions, within certain parameters, regarding the restrictions to be imposed.

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<sup>13</sup> See *Twentieth Century Music Corp. v. Aiken* 422 US at 156, 186 USPQ at 67, quoted in *Harper and Row*, supra, 471, US at 558.

The three conditions that must be observed in the introduction of any limitation on or exception to the reproduction right are:<sup>14</sup>

- i. the limitation or exception can only apply in certain special cases (indicating that general limitations and exceptions to the reproduction right would not be permissible);
- ii. the limitation or exception must not conflict with normal exploitation of the work (covering the unauthorised making of reproductions in areas that are usually within the control of the right holder); and
- iii. the limitation or exception must not unreasonably prejudice the legitimate interests of the author (covering restrictions that would prevent the author from participating in the economic benefits flowing from the use of the work).

Of course, these conditions apply to the development of copyright law, and even then only if a country is party to the Berne Convention (also referred to as a Union country). However, policy-makers may find this test to be useful. Policy-makers may also wish to note that Article 13 of the TRIPS Agreement (the Agreement on Trade-Related Aspects of Intellectual Property Rights – Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, 1994) extended the application of the ‘three-step test’ from the reproduction right to any of the exclusive rights guaranteed under the TRIPS Agreement (Sterling 1998: 356).

In the context of protecting TKECs, a core policy consideration is striking an appropriate balance between protection against misappropriation and misuse of TKECs, and the freedom and encouragement of further development and dissemination of expressions of culture. As well, expressions of culture form a living body of human culture, and therefore a key policy consideration is ensuring that they are not protected too rigidly.

### 3.5.2 Policy questions

#### a) What uses of TKECs should be excepted from the PIC requirement under the legislation?

In copyright law, exceptions and limitations introduced by national laws and international and regional instruments cover a range of activities and vary considerably from country to country. Some general categories frequently appear: private use; criticism or review; education (e.g. libraries and research); and use of computer programs and databases. National laws may, of course, contain other or additional restrictions on the exercise of rights. Examples include reporting of current events, photography of artistic works on public display, and administrative and judicial procedures.

The Pacific Model Law contains typical copyright exceptions that restrict the exercise or scope of ‘traditional cultural rights’. These are not obligatory exceptions and are intended only to provide guidance for policy-makers.

The Pacific Model Law provides that PIC is not required for any of the following uses:

- a. face-to-face teaching;
- b. criticism or review;
- c. reporting news or current events;
- d. judicial proceedings; and
- e. incidental use.

**Pacific Model Law 2002, Clause 7(4)**

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<sup>14</sup> Article 9(2) reads ‘It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.’

Within WIPO IGC, the following have been identified as possible excepted uses:

- illustration for teaching and learning;<sup>15</sup>
- non-commercial research or private study;
- criticism or review;
- reporting news or current events;
- use in the course of legal proceedings;
- the making of recordings and other reproductions of TKECs for inclusion in an archive or inventory for non-commercial cultural heritage safeguarding purposes;<sup>16</sup> and
- incidental uses.

Further exceptions could be drawn from existing IP principles, in particular, copyright exceptions. However, not all typical copyright exceptions may be appropriate as they may undermine customary rights under customary laws and protocols. An example could be an exception that allows a sculpture or work of artistic craftsmanship permanently displayed in a public place to be reproduced in photographs or drawings and in other ways without permission (McDonald 1997: 44). Similarly, national copyright laws often allow public archives, libraries and the like to make reproductions of works and keep them available for the public. However, doing so in respect of copyrighted cultural expressions may raise cultural and spiritual issues.

## **b) Should conditions be established for the application of the exception?**

In some cases, national laws provide that an exception is only applicable when certain conditions or procedures are observed. Other national laws do not: the defendant in an action for infringement must show that the conduct in question falls within the scope of a statutory exception.

In the context of protection of TKECs, countries can include conditions that must be met in order for the exception to be applicable. For example, there could be a condition that in each case a use must be compatible with fair practice, the relevant community is acknowledged as the source where practicable and possible, and such uses would not be offensive to the relevant community. The Pacific Model Law provides that the user must make sufficient acknowledgement of the traditional owners by mentioning them and/or the geographical place from which the TKECs originated.

A user of traditional knowledge or expressions of culture mentioned in clause 7(4)(a)–(d) must make sufficient acknowledgement of the traditional owners by mentioning them and/or the geographical place from which the traditional knowledge or expressions of culture originated.

**Pacific Model Law, Clause 7(5)**

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<sup>15</sup> While exceptions for teaching purposes are sometimes limited to 'face-to-face' teaching such as in the Pacific Model Law, special exceptions for distance learning may also be appropriate. The term 'teaching and learning' could be used to encompass both scenarios.

<sup>16</sup> National copyright laws in some cases allow public archives, libraries and the like to make, for non-commercial safeguarding purposes only, reproductions of works and expressions of folklore and keep them available for the public (an example is the UK's Copyright, Designs and Patents Act 1988). In this respect, appropriate contracts, IP checklists and other guidelines and codes of conduct for museums, archives and inventories of cultural heritage are under development by WIPO.

### **c) What limitations should be applied on the scope of protection of the legislation?**

As noted previously, many traditional knowledge holders have stressed that any intellectual property-type protection of TKECs should be subject to certain limitations so as not to protect them too rigidly. Overly strict protection may stifle creativity and cultural exchanges, as well as be impracticable in its implementation, monitoring and enforcement.

In terms of defining the limitations of the scope of protection, it is widely acknowledged that protection should not prevent communities themselves from using, exchanging and transmitting amongst themselves expressions of their cultural heritage in customary ways and in developing them by continuous re-creation and imitation. This is reflected in a guiding principle of the Pacific Model Law that states that the continued use, exchange, transmission and development of TKECs within the traditional and customary context by members of the relevant traditional community, as determined by customary laws and practices, should not be interfered with or restricted by the legislation.

Stated differently, this means that protection will extend only to utilisations of TKECs taking place outside the traditional or customary context (*ex situ* uses), whether or not for commercial purposes. As it is utilisations outside the traditional or customary context that have caused most concern to traditional communities, this type of limitation is a useful way of achieving a balance between protection and ongoing use and development of TKECs by traditional communities.

The legislation could provide that all members of a community, or even all nationals of a country, would be allowed, in accordance with traditional or customary practice, unrestricted use of TKECs, or certain of them so specified.

### **3.5.3 Further information**

Other sources of information regarding exceptions and limitations include:

- WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Geneva: WIPO. Pages 26–28 of the Annex discuss exceptions and limitations.
- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 10 provides information on exceptions and limitations in copyright law.

## **3.6 Management of rights**

Having progressed through the development of rights regarding TKECs, the next step is to consider how those rights will be managed. Under copyright law, this would involve consideration of whether the rights holder will exercise the rights, or assign or license their use, or confide their administration to another (Sterling 1998). In the context of the protection of TKECs, it is generally considered that the scope needs to be much broader.

There is, of course, the standard exercising of rights and consideration of how and to whom prospective users apply to use TKECs. However, there are also a number of additional measures that can be used to support the management process, such as the provision of technical assistance and training to traditional communities as well as awareness-raising and cultural sensitisation programmes with industry and the general public. Consequently, the phrase 'management of rights' is purposely used to convey that this element requires broader consideration than the typical 'exercise of rights' under copyright law.

This broad approach is particularly critical from a prevention perspective. Prevention is an important component of protection. Traditional communities frequently emphasise that when their TKECs are misappropriated, the damage is often of a spiritual nature that cannot be remedied through monetary compensation or, in some cases, at all. It is therefore important that a proactive approach is taken to try to minimise the incidence of infringement as much as possible.

Given this broad conception of the management of rights, it becomes apparent that the state will have to play a role in the process. This is reflected in a guiding principle of the Pacific Model Law that recognises the role of the state in providing assistance to traditional communities in the management and enforcement of their rights in TKECs. The use of a state body also provides an identifiable point for prospective users of TKECs to engage with that can promote certainty. Under the Pacific Model Law, a state body – referred to as the Cultural Authority – is established to fill this role. The nature of assistance and guidance will be for individual countries to determine.

The development of this element involves clarifying what the management of rights will consist of and who will carry out the various aspects, including consideration of the respective roles of the state and traditional communities. It is also useful to note at this point that matters of policy relating to the management of rights should be included in the legislation, while matters of detail should be included in delegated or secondary legislation.

### **3.6.1 Policy considerations**

Key policy considerations in this area include striking a balance between acknowledging the rights of traditional communities to control access to and use of their TKECs on the one hand, and on the other hand recognising the capacity and resourcing constraints that many communities face and the need to provide assistance in this regard.

### **3.6.2 Policy questions**

The following questions are intended to assist policy-makers to develop a framework for the management of rights under the legislation. It should be noted that there may be additional questions for policy-makers to consider.

#### **a) What should the 'management of rights' consist of?**

Given that the management of rights has a broader scope than the typical 'exercise of rights' under copyright law, policy-makers will need to consider what should be encompassed within that scope, based on their national circumstances and other relevant factors.

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At a minimum, the management of rights involves the administration of rights, including consideration of how and to whom prospective users apply to use TKECs. Additional measures and initiatives that can form part of the management of rights include:

- the provision of technical assistance to traditional communities (such as capacity building, training and education programmes);
- maintaining relationships with regional or government bodies in other countries within the region with responsibilities for the protection of TKECs; and
- undertaking prevention work with industry and the general public (such as developing a code of ethics for industry groups, and conducting public awareness campaigns and cultural sensitisation activities).

In determining the scope of the management of rights, policy-makers may find it useful to consider the aforementioned measures and initiatives as well as clause 37 of the Pacific Model Law. It is important to bear in mind that the functions listed in clause 37 are intended to be indicative only. Policy-makers may also find it useful to proceed on the basis of identifying what needs to be done and then identifying who will carry out those tasks as appropriate.

#### **Functions of the Cultural Authority**

The functions of the Cultural Authority may include the following:

- (a) to receive and process applications under Part 4;
- (b) to monitor compliance with authorised user agreements and to advise traditional owners of any breaches of such agreements;
- (c) to develop standard terms and conditions for authorised user agreements;
- (d) to provide training and education programmes for traditional owners and users of TKECs;
- (e) to develop a Code of Ethics in relation to use of TKECs;
- (f) to issue advisory guidelines for the purposes of this Act;
- (g) to liaise with regional bodies in relation to matters under this Act;
- (h) to maintain a record of traditional owners and/or knowledge and expressions of culture;
- (i) if requested to do so, to provide guidance on the meaning of customary use in specific cases;
- (j) such other functions as are conferred on it by this Act.

#### **Pacific Model Law, Clause 37**

## **b) Who will carry out the management of rights?**

Once a country has determined what measures will be encompassed within the scope of the management of rights, the next step is to consider who will carry out the various measures. Given the guiding principle of the Pacific Model Law, which recognises the role of the state in providing assistance to traditional communities in the management of their rights, there is an expectation that the state will have a role. Countries will therefore need to establish a body, or assign an existing body. While there is this requirement, countries have considerable flexibility to determine what roles and

functions the state body will have and what roles traditional communities will have. In some countries, there may be additional bodies, such as pan-tribal organisations, that should have a role as well.

Some management measures, such as technical assistance and capacity-building work with traditional communities, would most likely be carried out or supported by the state, as would bilateral and regional relationship management. Prevention work through awareness campaigns and the development of codes of ethics may be more suitably progressed as joint initiatives between traditional communities and the state, depending on resourcing constraints.

However, the administrative aspect of the management of rights is not so straightforward. A complex policy question needs to be addressed: *To whom should prospective users have to apply to use TKECs?*

Two guiding principles of the Pacific Model Law are instructive in this regard:

- recognise that traditional communities are the owners, rights holders and custodians of TKECs and the primary decision-makers regarding their use; and
- respect and give effect to the right of traditional communities to control access to their TKECs, especially those of particular cultural or spiritual value or significance, such as sacred–secret TKECs.

Under the Pacific Model Law, authorisation can be obtained only from the relevant traditional community or communities.<sup>17</sup> Prospective users have the option of applying to a state body (the Cultural Authority) that then performs an intermediary function between the prospective user and the community, or applying directly to the traditional community. However, in some circumstances traditional communities may not wish to or cannot exercise rights directly. In this case, a state body, such as an agency, authority or statutory body, may be designated to act at all times at the request of and on behalf of relevant communities.

In identifying to whom prospective users would have to apply to use TKECs, countries may find the following approaches, which are used in existing laws for the protection of traditional cultural expressions, to be instructive:

- i. the relevant traditional community; or
- ii. a state body (whether existing or specially created); or
- iii. both a state body and the relevant traditional community; or
- iv. a collective management organisation.

An explanation of each approach follows.

#### *Option i: The relevant traditional community*

Under this option, a prospective user would apply directly to the relevant traditional community for authorisation to use the expression and the underlying traditional knowledge concerned. This approach could be considered to be the ideal arrangement as traditional communities themselves will decide whether or not to grant authorisation. It therefore gives recognition to the principle that traditional communities are the primary decision-makers regarding their TKECs.

However, at a practical level a number of limitations have been identified with this approach. For example, there are often capacity issues within communities that can negatively impact on the

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<sup>17</sup> There is an exception where no traditional owners can be identified or no agreement has been reached about ownership (clause 19, Pacific Model Law).

negotiation of a fair and equitable agreement. Moreover, communities may face resourcing constraints that hamper their ability to obtain external advice on the proposed use and the terms and conditions of the agreement.

#### *Option ii: A state body*

Where the relevant communities are not able or do not wish to exercise rights directly, a state body may be designated to act at all times at the request of and on behalf of the communities. In this case, the rights holder would confide the administration of their rights to the state body so that the body could grant authorisation, where appropriate, on behalf of the traditional community concerned.

Many Indigenous peoples, however, have expressed serious reservations about any state body acting on their behalf. This underscores the need for any state body to derive its entitlement to act from the explicit wishes and authority of the community concerned.

An existing office, authority or society could be used and it could be governmental, quasi-governmental or non-governmental. Many national laws providing *sui generis* protection for traditional cultural expressions utilise this approach. For example, the Tunisian Copyright Act 1994 provides that '... any transcription of folklore with a view to exploitation for profit shall require authorisation from the Ministry responsible for culture against payment of a fee for the benefit of the welfare fund of the Copyright Protection Agency established pursuant to this Law'.<sup>18</sup> The Nigerian Copyright Act 1997 vests the right to authorise acts in relation to folklore in the Nigerian Copyright Commission.<sup>19</sup> The Indigenous Peoples Rights Act of 1997 of the Philippines also uses this approach.

This approach may also be useful where there are shared expressions across a number of traditional communities in the same country and it is difficult to agree upon an equitable way to distribute benefits received across the communities involved. The agency could collect the benefits and transfer them to an initiative that benefits all the communities.

If this approach is taken, policy-makers will need to address a number of questions, including the following.

- What consultation, if any, should the state body have with the relevant traditional community? While this approach is based on the rights holder confiding the administration of their rights to a state body, it may not be preferable to grant the body an absolute power in this regard. For example, a country may wish to include a provision establishing that where authorisations are granted by an agency, such authorisations should be granted only in appropriate consultation with the relevant community, in accordance with their traditional decision-making and governance processes.
- What authorisations can be granted by the state body? It may not be desirable for the body to have an absolute power to grant authorisations, and some parameters may be necessary. At a minimum, it could be expected that authorisations should comply with the scope of protection provided for the TKECs concerned. A provision could also be included specifying that in order to act on behalf of a community, a state body would need to negotiate the scope of its authority with the community. This may, for example, include specified restricted uses that require consultation with the community concerned.
- What should the authority do with the benefits received? The state body may receive benefits for the use of particular TKECs. A country may wish to include a provision specifying that monetary or non-monetary benefits collected by the authority for the use of expressions of culture should be provided directly by the authority to the community concerned.

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<sup>18</sup> Section 7, Tunisian Copyright Act 1994.

<sup>19</sup> Section 28, Nigerian Copyright Act 1997.

This body could also carry out various tasks associated with the management of rights. These other functions are discussed further in this section of the Guidelines.

*Option iii: Both a state body and the relevant traditional community*

Under this option, the state body plays a primarily administrative role in the authorisation process, although in some instances it can grant authorisation. Both the state body and the relevant traditional community have specified roles in the authorisation process. The state body, whether existing or specially created, acts as a contact point for prospective users and receives applications for authorisation to use TKECs if communities are not able to, and then forwards the applications to the relevant communities. The state body acts in the interests of the relevant communities and mediates between the communities and users. This is the approach taken in the Peru Law 2002, which provides for a 'Competent National Authority' and an 'Indigenous Knowledge Protection Board', each having various specific duties. Prospective users are also able to apply directly to the relevant traditional community if desired, although the state body will carry out a 'watchdog' role to ensure that the interests of the community are appropriately promoted.

The Pacific Model Law takes a similar approach and provides for the establishment of a 'Cultural Authority' to which application can be made by prospective users of particular TKECs to obtain the PIC of the 'traditional owners'. The prospective user can also apply directly to the community concerned. Where an application is made to the Cultural Authority, the Cultural Authority has to identify the traditional owners and act as a liaison between the prospective user and traditional owners, including resolving uncertainties or disputes as to ownership. If no 'traditional owners' can be found or there is no agreement as to ownership, the Cultural Authority can be determined to be the traditional owner. In cases where the prospective user deals directly with the traditional owners, the Cultural Authority still has a role in providing advice on the terms and conditions of the agreement.

If this approach is taken, policy-makers will need to address a number of questions, including the following.

- What authorisations can be granted by the state body? The Pacific Model Law provides that where no 'traditional owners' can be found or there is no agreement as to ownership, the Cultural Authority can be determined to be the traditional owner. It can then grant authorisations, if appropriate. For countries using this approach, it is important that any authority of a state body to act is obtained from the traditional communities. In some countries, it may not be appropriate that a state body grant authorisations in any situation. A provision could be included in the legislation specifying that in order to act on behalf of a community, a state body needs to negotiate the scope of its authority with the community concerned.
  - Should the state body have a role in determining whether PIC has been obtained? Under the Pacific Model Law clause 7(2), uses of TKECs are regulated through a requirement to obtain the PIC of the traditional owners. Countries may wish to consider whether indicators of what constitutes PIC are needed. Clause 23(1) of the Pacific Model Law provides that if an authorised user agreement is entered into, traditional owners are deemed to have given their PIC. Some of the characteristics of PIC that are often identified are: all members of the communities affected consent to the decision; consent is determined in accordance with customary processes; there is full disclosure of the intent and scope of the proposed activity; and decisions are made in a language and process understandable to the communities.
  - Should the state body have a role in determining equitable compensation and, as appropriate, facilitating and administering the payment and use of equitable compensation?
  - How should prospective users make application to use TKECs? Having determined who prospective users make application to, the secondary question is how this is done. Matters of operational detail in this regard would typically form part of secondary legislation rather than primary legislation. However, as this issue forms part of the broader framework of the management of rights, it is useful to make brief reference to the types of issues that would need to
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be addressed. They include guidance on procedures for applications for authorisations; the information any application for authorisation has to contain; allowing for the collecting of fees, if any, for authorisations and the purpose for which the collected fees must be used; public notification procedures; and the terms and conditions upon which authorisations may be granted by the authority.

*Option iv: A collective management organisation*

Another option is the use of a collective management organisation, which is potentially the most practical means of administering rights in TKECs. Systems of collective administration and management of IP rights are well developed for copyright and certain related rights. Increasingly, the exercise of rights is being confided to collecting societies that have the resources and expertise to act effectively for the rights holder (Sterling 1998: 393). Typically, the organisation is registered as a legal entity (company, etc.) under the relevant law. There is often a board, consisting of, for example in the case of authors, representatives of authors and publishers.

In the case of TKECs, rights holders are compensated for use of their material through licence schemes. For example, through these schemes approved collecting organisations would be paid for the reproduction of expressions. The collecting society would then be responsible for distribution of the money to their members. Alternatively, a national trust fund could be established, into which part of any funds obtained from licences granted in relation to TKECs are paid. The fund could be used to, for example, assist the preservation of cultural practices within traditional communities.

### **3.6.3 Further information**

Another source of information regarding the management of rights is:

- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 12 provides information on the exercise of rights in copyright law.

## 3.7 Term of protection

It is commonplace for IP laws, such as copyright and patent law, to establish a term of protection following which the protected subject matter enters the public domain for the common good, thereby facilitating and encouraging disclosure of innovation. Copyright generally provides for a term of protection based on the life of the author plus a fixed term of years. For the related rights of performers, producers, broadcasters, etc., protection is usually determined on the basis of a fixed term of years beginning at a certain point in time.<sup>20</sup>

However, many traditional communities desire indefinite protection for at least some aspects of expressions of their traditional cultures, and in this instance, most branches of the IP system do not meet their needs.<sup>21</sup> On the other hand, it is generally seen as integral to the balance within the IP system that the term of protection not be indefinite so that works ultimately enter the 'public domain'.

The development of this element involves determining the term of protection in relation to the nature of TKECs, particularly where different layers of TKECs have been identified. It also involves consideration of whether particular conditions should be invoked in order to maintain the term of protection.

### 3.7.1 Policy considerations

A fundamental policy consideration is striking an appropriate balance between traditional knowledge holders' desire for indefinite protection and that of the promotion of the public domain for the general public good.

### 3.7.2 Policy questions

The following questions are intended to assist countries to develop a policy regarding the term of protection that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### a) Should all TKECs receive the same term of protection?

Depending on decisions taken under the element 'Subject matter of protection', a country may have determined that there are different layers of TKECs and that for the purposes of protection, the layers should be treated differently. Under the element 'Scope of protection', different strengths of protection were discussed for different layers (referred to as the 'three layers of protection' approach).

It may be considered inappropriate that a single term of protection be used to cover all TKECs. Therefore, in determining the term of protection, countries may need to consider whether different terms of protection are necessary to accommodate different layers of TKECs. For example, indefinite protection could be used only for sacred–secret expressions, while those expressions of significance to a traditional community could also qualify for indefinite protection but only if particular conditions are met and maintained.

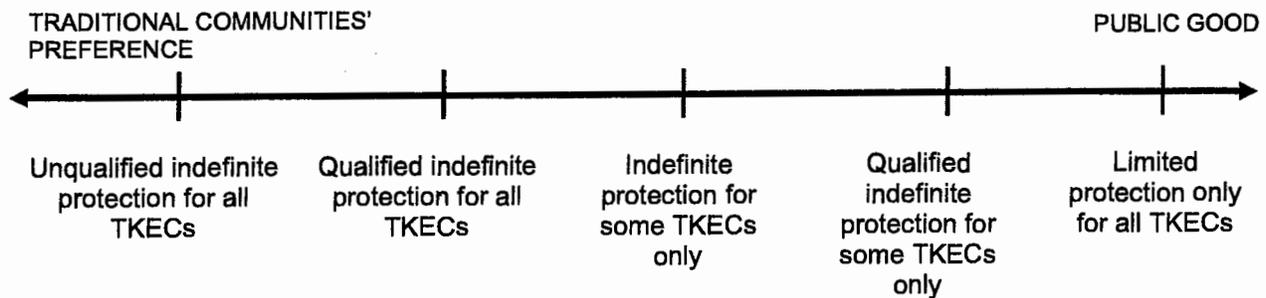
The Pacific Model Law does not establish a time limit. Clause 9 provides that traditional cultural rights continue in perpetuity. This is a matter that countries have the flexibility to change if desired. The

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<sup>20</sup> The general international term of protection for authors' rights is the life of the author plus 50 years (by virtue of the Berne Convention and the TRIPS Agreement) and the fixed term of protection is 50 years for the related rights. See Sterling 1999: 380.

<sup>21</sup> Trademarks are renewable, and unfair competition protection is indefinite. Extended protection in the copyright domain is also not entirely without precedent. While the Berne Convention and the TRIPS Agreement stipulate 50 years as a minimum period, countries are free to protect copyright for longer periods.

range of options regarding the possible terms of protection for TKECs can be loosely illustrated using a spectrum, as follows.



Each of these options caters for the interests of traditional communities and the public good in a different way.

- i. Unqualified indefinite protection for all TKECs: All TKECs would receive indefinite protection and protection would not be linked to any conditions. This is the approach taken in the Pacific Model Law as well as the Model Provisions 1982.
- ii. Qualified indefinite protection for all TKECs: This option provides the same coverage of protection for TKECs but qualifies the protection with conditions that must be met in order for protection to be maintained.
- iii. Indefinite protection for some TKECs only: The policy rationale here is that it may be inappropriate that a single term of protection be used to cover all TKECs.
- i. Qualified indefinite protection for some TKECs only: Indefinite protection would be available for some TKECs provided particular conditions were met. Such conditions could be the criteria for protection established under the legislation.
- ii. Limited protection only for all TKECs: No distinction would be drawn between different layers of TKECs.

## **b) Should the term of protection be linked to particular conditions?**

If an expression of culture and its underlying traditional knowledge receive indefinite protection, one means for ensuring that the protection remains valid is to impose conditions that must be met for protection to continue. For example, such conditions could be that the expression continues to be maintained and used by, and is characteristic of, the relevant community. This would entail a trademark-like emphasis on current use, so that once the community that the TKEC is characteristic of no longer uses the TKEC or no longer exists as a distinct entity, protection for the TKEC would lapse (Scafidi 2001: 793).

Such an approach has the merit of giving effect to customary laws and practices and drawing upon the very essence of the subject matter of protection. When a TKEC ceases to be characteristic of and ceases to identify a community, it ceases by definition to be a TKEC for the purposes of protection under the legislation, and it follows that protection should lapse. This general line of thinking is reflected in the US Indian Arts and Crafts Act 1990, which excludes from protection products that are no longer 'Indian' because, for example, they have become 'industrial products'. This act sets out in some detail what constitutes an 'Indian product'. The Panama Law 2000 seems to link the term of protection to the protected subject matter continuing to display the characteristics that qualified it for protection in the first place (as protection is indefinite rather than unlimited).

If any notification or registration requirements (discussed in 'Formalities' below) are considered useful, and depending also on their legal effects, the period of protection may also be linked to the maintenance of registration.

### **3.7.3 Further information**

Another source of information regarding the term of protection is:

- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 11 provides information on the term of protection in copyright.

## 3.8 Formalities

This element concerns how protection will be acquired and maintained under the legislation, referred to as 'formalities'. This should not be confused with how authorisation to use TKECs will be obtained.

The Pacific Model Law does not contain a formalities provision. Automatic protection is granted without formalities. The policy rationale for this is that the imposition of formalities has been identified by traditional knowledge holders as having a significant bearing on the accessibility of protection. There is flexibility to modify this policy if countries wish to incorporate greater certainty and precision.

The development of this element involves identifying how protection will be acquired under the legislation.

### 3.8.1 Policy considerations

Important considerations for policy-makers include the need for practically feasible formalities and avoiding excessive administrative burdens for rights holders and administrators alike. At the same time, it is important to be cognisant of the need for transparency and certainty, particularly for external researchers and other users of TKECs in their relations with traditional communities.

### 3.8.2 Policy questions

The following questions are intended to assist countries to develop a policy regarding formalities that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### a) How should protection be acquired?

There are three broad approaches that are used across existing laws for the protection of traditional cultural expressions regarding how protection is acquired:

- i. automatic protection without formalities: Protection is provided automatically without formalities so that it is available as of the moment an expression is created, similar to copyright. As noted above, examples of this approach include the Pacific Model Law 2002 and the Model Provisions 1982;
- ii. a registration or notification system: An alternative to automatic protection is to provide for some kind of registration, possibly subject to formal or substantive examination. A registration or notification system is often used to provide greater transparency and certainty, which can be important for users of TKECs and researchers. Existing laws that utilise this approach include the Panama Law 2000 and the Peru Law 2002. A registration system may merely have declaratory effect, in which case proof of registration would be used to substantiate a claim of ownership, or it may constitute rights; and
- iii. a hybrid of automatic protection and registration: This approach reflects the general principle that TKECs should be protected without formality following copyright principles and in an endeavour to make protection as easily available as possible, but requiring some form of registration or notification for those expressions that would receive strong protection, that is, sacred-secret expressions (ensuring, though, that registration should not entail the inappropriate disclosure of such material) and expressions of particular cultural or spiritual significance for which strong PIC-based protection would be applicable. This approach also provides different treatment for different layers of TKECs.

If automatic protection is considered appropriate, policy-makers may wish to consider whether or not it would be beneficial to add a specific provision to the legislation clarifying this.

If registration or notification is considered appropriate, policy-makers would need to consider further questions of implementation. Secondary legislation or administrative measures could provide guidance on issues such as:

- the manner in which applications for notification or registration should be made;
- to what extent and for what purposes applications are examined by the registration office;
- measures to ensure that the registration or notification of TKECs is accessible and affordable;
- public access to information concerning which TKECs have been registered or notified;
- appeals against the registration or notification of TKECs;
- the resolution by the registration office of disputes relating to which community or communities should be entitled to benefit from the protection of a TKEC, including competing claims from communities from more than one country; and
- the legal effect of notification or registration.

While a notification or registration system may have initial application at the national level, thus implying national registers or other notification systems, eventually some form of regional and international register could form part of regional and international systems of protection. Such an international system of notification/registration could perhaps draw from existing systems such as Article 6*ter* of the Paris Convention or the registration system provided for in Article 5 of the Lisbon Agreement for the International Registration of Appellations of Origin 1958.

If a country prefers the hybrid approach, the implementation questions outlined regarding notification and registration would also be applicable. There would be no need to register or notify sacred–secret expressions as these would be separately protected. The registration option would be applicable only in cases where communities wished to obtain strict, PIC protection for TKECs that were already known and publicly available and of particular cultural or spiritual value or significance. Policy-makers may wish to note the following regarding how this approach could be implemented.

- Only a community that claims protection of a particular expression and the underlying traditional knowledge may register or notify, or, in cases where the community is not able to do so, a competent authority with rights management responsibilities can do so, acting at the request of and in the interests of the community.
  - Registration or notification need not be an obligation: protection could remain available for unregistered expressions. The registration option is applicable only in cases where communities wish to obtain strict, PIC protection for expressions that are already known and publicly available.
  - Registration or notification can be declaratory only and not constitute rights. This is for individual countries to determine. Without prejudice thereto, entry in the register could presume that the facts recorded therein are true unless proven otherwise, and also not affect the rights of third parties.
  - To the extent that such registration or notification may involve the recording or other fixation of the TKECs concerned, any IP rights in such recordings or fixations could vest in or be assigned to the relevant community.
  - Information on and representations of the TKECs that have been so registered or notified could be made publicly accessible at least to the extent necessary to provide transparency and certainty to third parties as to which TKECs are so protected and for whose benefit.
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- The competent authority receiving such registrations or notifications could resolve any uncertainties or disputes as to which communities – including those in more than one country – should be entitled to registration or notification or should be the beneficiaries of protection, using customary laws and processes, alternative dispute resolution and existing cultural resources, such as cultural heritage inventories, as far as possible. In so far as taking existing cultural resources into account, the authority could refer also to cultural heritage inventories, lists and collections such as those established under the UNESCO Convention for the Safeguarding of the Intangible Cultural Heritage 2003. There may, more broadly, be some opportunities for developing synergies between inventories established or being established for cultural heritage preservation purposes (such as States Parties are obliged to do under the UNESCO Convention referred to) and the kind of registers or notification systems suggested here. Indeed, measures could be developed to ensure that cultural heritage inventories, lists and collections reinforce, support and facilitate the implementation of *sui generis* provisions for the protection of TKECs (UNESCO 2005). To this end, WIPO is developing IP protocols and best practices for the recording and digitising of intangible cultural heritage.<sup>22</sup> These protocols and best practices will be of assistance to communities, museums, archives, cultural agencies and others who collect, record, make inventories of, digitise and make available elements of intangible cultural heritage. They will help such parties to identify IP issues, clarify IP options and develop IP strategies that further their overall safeguarding objectives.

### 3.8.3 Further information

Other sources of information regarding formalities include:

- WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Geneva: WIPO. Pages 32–36 of the Annex provide information on formalities.
- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell.

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<sup>22</sup> See <http://www.wipo.int/tk/en/folklore/culturalheritage/index.html>.

## 3.9 Legal proceedings (sanctions and remedies)

It is common for countries to have civil remedies as well as criminal sanctions for copyright infringement. Similarly, in the context of the protection of traditional cultural expressions, it has been broadly acknowledged that both civil and criminal actions should be available where the rights of traditional communities have been breached. The development of this element involves prescribing the civil and criminal legal proceedings in this regard.

### 3.9.1 Policy questions: civil proceedings

Civil law is not primarily concerned with punishment; this is the domain of criminal law. The remedies provided by civil law have other purposes, such as compensation, the remedying of wrongs and stopping unlawful conduct. There are exceptions to this general principle, in particular the civil remedy of exemplary damages (designed to inflict punishment rather than compensate) and the sentence of reparation (designed to compensate the victim rather than punish the offender).

The following questions are intended to assist countries to clarify the civil proceedings for infringement.

#### a) What constitutes an infringement?

During the development of the element 'Scope of protection', countries will have determined the types of acts relating to TKECs that will be regulated under the legislation. Countries may wish to consider including a specific provision linking these regulated acts to what constitutes an infringement under the legislation. For example, there could be a provision that states that 'traditional cultural rights in TKECs are infringed by a person who does any restricted act'. The provision could also clarify whether the doing of the restricted act had to be to the work as a whole to constitute infringement or whether the doing of the restricted act to any substantial part of the work is sufficient. It could also clarify whether the doing of a restricted act includes both direct and indirect acts.

The Pacific Model Law does not include a provision specifying what amounts to infringement under the legislation on the basis that this will be determined at national level.

#### b) When may infringement proceedings be brought?

The legislation will need to clarify when proceedings can be brought. Typically, it will state that an infringement under the legislation is actionable.

Under the Pacific Model Law, infringement proceedings may be instituted in two situations:

- i. where traditional cultural rights are infringed – that is, if a person makes a non-customary use of a TKEC (whether or not such use is of a commercial nature), and the traditional owners have not given their PIC to that use (clause 30(1)); and
- ii. where moral rights are infringed – that is, if a person does an act or makes an omission in relation to a TKEC that is inconsistent with the moral rights of the traditional owners of that TKEC, and the traditional owners have not given their PIC to the act or omission (clause 30(2)).

Countries may wish to also clarify when infringement proceedings may not be brought. For example, the legislation may include a provision stating that no person may bring proceedings for the infringement of unregistered rights (if a registration or notification system is adopted), where relevant.

In addition, policy-makers may wish to consider whether an action may be brought when there is a strong likelihood that rights may be infringed. For example, under the Peru Law 2002 an action may be brought if imminent danger exists that rights may be violated. Also, under the Panama Law 2000 Indigenous communities or the country or regional governor may take preventative action (Article 22).

This 'precautionary'-type approach is important given the spiritual and cultural damage that frequently occurs when expressions of culture are misappropriated. In some cases, the damage to particular individuals and/or traditional communities is irreversible. It is therefore preferable to prevent infringements before they occur rather than wait until after the fact to take an action.

### **c) Who may institute infringement proceedings?**

It is important to specify who may institute infringement proceedings. This will be determined largely by the decisions taken under the element 'Enforcement', regarding the role of the state in enforcement.

A guiding principle of the Pacific Model Law is that 'traditional communities are the owners, holders and custodians of TKECs and the primary decision-makers regarding their use'. It follows, therefore, that the legislation would make provision for traditional communities to be able to take an action to enforce their rights. This is reflected in clause 30 of the Pacific Model Law, which provides that traditional owners may institute civil proceedings. It is also the case in many *sui generis* laws for the protection of traditional cultural expressions.

However, policy-makers may wish to consider whether it is necessary for the legislation to make provision for other individuals or bodies to be able to take an action. For example, under the Panama Law 2000, apart from the affected Indigenous communities, the regional or country governor may take preventative action (Article 22). In the Peru Law 2002, infringement actions may also be brought *ex officio* by decision of INDECOP (the competent national authority).

There is also a possibility that some traditional communities may wish a state body to enforce their rights on their behalf while other communities in the same country may not wish to do so. The legislation would need to be able to accommodate the relevant scenarios while ensuring consistency with the guiding principle that traditional communities are the owners, holders and custodians of TKECs and the primary decision-makers regarding their use.

Policy-makers may also wish to address whether the legislation should include limitations on who can take an action, to prevent erroneous or non-mandated actions. For example, the legislation may provide that only a mandated representative of a traditional community can bring an action rather than individual members of a community.

### **d) Where may infringement proceedings be brought?**

The legislation should specify which court infringement proceedings would need to be brought to. The Pacific Model Law purposely leaves the court blank as this should be determined at national level.

However, a secondary question arises: Are the ordinary courts an appropriate body for legal proceedings relating to TKECs? Given that the majority of PICTs are small countries with limited resources, the Pacific Model Law does not establish new institutions for the purposes of legal proceedings. It uses ordinary courts but does not prescribe what type of court, leaving this to be determined at national level.

When the Pacific Model Law was being developed, it was recognised that the procedural character of the ordinary courts process may not be appropriate. New or existing institutions other than the ordinary courts may be better able to manage matters requiring resolution under the legislation because of the need for specialist knowledge, the desirability of less formality in proceedings than is the practice of the ordinary courts and the desirability of different fact-finding procedures or other procedures such as mediation that may not be available through the ordinary courts. Indeed, traditional communities have widely criticised the use of the Western judicial system and called for more appropriate processes, including greater recognition of customary law processes.

There are numerous examples that countries can draw on for guidance if they wish to establish a dedicated body under the legislation for civil proceedings rather than use the formal and adversarial

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processes of the ordinary courts. In terms of specialised bodies on Indigenous issues, there are the Maori Land Court and the Waitangi Tribunal in New Zealand. In respect of less formality and different fact-finding procedures, many countries have family courts. Regarding IP models, some countries provide that proceedings can be taken to commissioners (such as the Commissioner of Trade Marks) in addition to the ordinary courts. Copyright tribunals are also used in Australia and New Zealand.

### e) Should there be a penalty for bringing unjustified proceedings?

In order to provide a deterrent for vexatious claims, policy-makers may wish to consider whether it is appropriate to incorporate a penalty in the legislation for bringing unjustified proceedings. While not a typical feature of copyright law or laws for the protection of traditional cultural expressions, it does appear in New Zealand's copyright and trademark legislation as well as Fiji's copyright law.

An example of an unjustified proceedings provision from New Zealand's copyright legislation is provided below.

- 1) Where a person brings proceedings alleging an infringement of copyright, a court may, on the application of any person against whom the proceedings are brought:
  - a. make a declaration that the bringing of proceedings was unjustified;
  - b. make an order for the payment of damages for any loss suffered by the person against whom the proceedings are brought.
- 2) A court shall not grant relief under this section if the person who brought the proceedings proves that the acts in respect of which proceedings were brought constituted, or would have constituted if they had been done, an infringement of the copyright concerned.
- 3) Nothing in this section makes a barrister or solicitor of the High Court of New Zealand liable to any proceedings under this section in respect of any act done in his or her professional capacity on behalf of a client.

#### Section 130, Copyright Act 1994 (New Zealand)

### f) What types of remedies should be available for infringement?

Common remedies that are available under copyright laws and legislation for the protection of traditional cultural expressions are injunctions, damages and account of profits. Often, a general provision is also included that enables the court to grant additional relief as it considers appropriate. Of particular importance in the prevention of infringement is the availability of judicial procedures that enable speedy recourse to the courts for relief pending trial of the action (such as the issuing of injunctions to prevent the further distribution of the defendant's product).

In the context of infringements regarding TKECs, traditional communities often argue that the remedies available under current law may not provide for damages equivalent to the degree of cultural and non-economic damage caused by the infringing use. While in some cases damages awarded by courts have taken cultural issues into account,<sup>23</sup> when TKECs are misappropriated and/or used offensively the primary damage is often not monetary in nature, but cultural. Consequently, monetary remedies will have very limited effect in addressing the cultural harm caused to traditional communities. Forms of cultural redress are therefore critical. Existing customary law practices will be instructive in this regard.

Policy-makers can refer to clause 31 of the Pacific Model Law to assist them in identifying what remedies may be appropriate. It may also be useful to note the following regarding clause 31.

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<sup>23</sup> See the Australian case of *George M\*, Payunka, Marika and Others v. Indofurn Pty Ltd* 30 IPR 209.

- It includes civil remedies that are commonly available, such as injunctions, damages and account of profits.
- It includes additional remedies, such as a public apology and a declaration that the traditional cultural rights of the traditional owners have been contravened (clauses 31(1)(c) and (d)).

- It provides that the court can make an order that infringements of moral rights cease or be reversed (clause 31(1)(e)).
- It provides that the court may grant an order for the seizure of any object made, imported or exported contrary to the Act. Policy-makers should consider whether to provide greater clarification for the courts in the legislation on this matter. Such provisions could clarify matters such as the ability of the court to be able to order erasure, removal, obliteration, delivery up and to whom (owner or other person the court thinks fit), and also disposal. It could also clarify whether those with an interest in the infringing objects will be served with notice, and whether those with an interest in the infringing objects have any rights and what those rights are. Policy-makers may wish to refer to existing copyright legislation for further guidance on this matter (clause 31(1)(g)).

The Court may grant all or any of the following remedies in relation to civil claim proceedings:

- an injunction;
- damages for loss resulting from the unauthorised use;
- a declaration that the traditional cultural rights of the traditional owners have been contravened;
- an order that the defendant make a public apology for the contravention;
- an order that any false attribution of ownership, or derogatory treatment, of the traditional knowledge or expression of culture cease or be reversed;
- an order for an account for profits;
- an order for the seizure of any object made, imported or exported contrary to the legislation;
- such other orders as the Court considers appropriate in the circumstances.

**Pacific Model Law, Clause 31**

- It provides that the court may grant any such orders as it considers appropriate in the circumstances. This could be used to provide cultural redress in respect of cultural and non-economic damage caused by the infringing use. However, countries may wish to provide greater clarity in this regard through the inclusion of a specific remedy. If there is some uncertainty as to application of a remedy, specific legislative provision is desirable (clause 31(1)(h)).

Once it has been determined which remedies should be available, policy-makers will need to consider these against the various civil remedies of general application that are available under the common law and the general statute law in their country, and assess their adequacy. The outcomes of this assessment may result in one or more of the following.

- Existing civil remedies are considered to be sufficient.
- It is considered that some remedies require modification for the purposes of the legislation: it may be necessary to vary some aspect of a remedy to make it effective in the particular context of protecting TKECs. An example of a modification to an existing civil remedy is contained in section 81 of the Commerce Act 1986 in New Zealand, which specifies a range of circumstances in which the High Court may grant an injunction to restrain certain behaviour. The section enlarges the range of circumstances in which the existing remedy would be available under the common law, and clarifies the application of the remedy.
- It is considered necessary to create new remedies: this may arise in circumstances such as if there is a demonstrated inadequacy of existing civil remedies in achieving the desired policy objective or there are difficulties in modifying existing remedies to improve their utility. If policy-makers are considering a new remedy, it is wise to undertake prior consultation with persons knowledgeable in the operation of the remedy to ascertain the likely pitfalls, and consider whether

the proposed remedy will create anomalies or inconsistencies in the operation of the law generally (i.e. whether the innovation is desirable in principle as well as effective in practice).

### **g) What matters should be considered by the court?**

It is common for legislation to specify criteria for the court to consider when making a decision regarding relief. This can vary from precise rules of law to very broad standards (such as the public interest or the welfare of a child).

In developing criteria, policy-makers may wish to refer to clause 31(2) of the Pacific Model Law, which specifies what the court must take into account when considering the relief to be granted. This criterion is indicative only and countries can adapt as desired.

The [ ] court in deciding what relief is to be granted may take into account all or any of the following:

- a) whether the defendant was aware or ought reasonably to have been aware of the traditional cultural rights and moral rights of the traditional owners;
- b) the effect on the honour or reputation of the traditional owners resulting from the unauthorised use;
- c) anything done by the defendant to mitigate the effects of the unauthorised use;
- d) any cost or difficulty that may have been associated with identifying the traditional owners;
- e) any cost or difficulty in ceasing or reversing any false attribution of ownership, or derogatory treatment, of the traditional knowledge or expression of culture;
- f) whether the parties have undertaken any other action to resolve the dispute.

**Clause 31(2), Pacific Model Law**

## **3.9.2 Policy questions: criminal proceedings**

### **a) Is it necessary to create a criminal offence?**

Most legal systems draw a distinction between conduct that is treated as a criminal offence and conduct that, while regarded as wrongful, is regulated only by the civil law. A primary question, therefore, for policy-makers to address is whether or not particular conduct requires the intervention of the criminal law or whether civil remedies are adequate and appropriate for the purposes of enforcement. Understandably, rights holders are in a stronger position where both civil and criminal penalties are available. In some countries, the same act of infringement can bring about liabilities for damages, etc. under a civil action, and for fines and/or imprisonment under criminal provisions.

In determining whether there should be criminal offences under the legislation, it is important to note that the criminal law is concerned with the punishment of offenders and the deterrence of others from wrongdoing. Generally, it is not concerned with compensation, which is the province of the civil law. The criminal law is intended to punish only conduct that is in some way blameworthy. The notion of blameworthiness is an integral feature of the criminal process (Legislation Advisory Committee 2001: 141).

Policy-makers may wish to consider the following questions when determining whether to create a criminal offence (Legislation Advisory Committee 2001: 143).

- Will the conduct in question, if permitted or allowed to continue unchecked, cause substantial harm to individual or public interests?

- Would public opinion support the use of the criminal law, or is the conduct in question likely to be regarded as trivial by the general public?
- Is the conduct in question best regulated by the civil law because the appropriate remedies are those characteristic of the civil law (e.g. compensation, restitution)?
- Is the use of the criminal law being considered solely or primarily for reasons of convenience rather than as a consequence of a decision that the conduct itself warrants criminal sanctions?
- If the conduct in question is made a criminal offence, how will enforcement be undertaken, who will be responsible for the investigation and prosecution of the offence, and what powers will be required for enforcement to be undertaken?
- If the new offences in question are unlikely to be enforced, or likely to be enforced only rarely, the question of whether a criminal sanction is warranted should be examined carefully, because creating offences that are not going to be enforced will bring the law into disrepute. If enforcement of the new law is going to be left to the police as part of their general duty to enforce the law, it may be useful to make prior enquiries of the police as to the likely priority to be given to the new offence or offences being created.
- Would it be more economic or practicable to regulate the conduct in question through the use of existing or new civil law remedies?
- Is the conduct that is to be categorised as a criminal offence able to be defined with precision?

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***The following policy questions are relevant only if a country decides that the intervention of the criminal law is required.***

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## **b) What should constitute an offence?**

Where a country has determined that the intervention of the criminal law is required, it will need to identify what constitutes an offence.

Some existing laws for the protection of TKECs provide that particular acts in relation to TKECs are offences. For instance, under the United States Code, Title 18, Part I, Chapter 53, it is unlawful, and subject to fines or imprisonment, to imitate any government trademark used or devised by the Indian Arts and Crafts Board (Section 1158: Counterfeiting Indian Arts and Crafts Board trademark), and to offer or display for sale or sell any good in a manner that falsely suggests it is Indian produced, an Indian product, or the product of a particular Indian or Indian tribe or Indian arts and crafts organisation resident within the United States (Section 1159: Misrepresentation of Indian-produced goods and products).

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Policy-makers may wish to refer to the Pacific Model Law for guidance in identifying what constitutes an offence.

The Pacific Model Law establishes offences in relation to:

- **traditional cultural rights:** if a person makes non-customary use of a TKEC (whether or not such use is of a commercial nature) and the traditional owners have not given their PIC to that use, the person is guilty of an offence (clause 26);
- **moral rights:** if a person does an act or makes an omission in relation to a TKEC that is inconsistent with the moral rights of the traditional owners of that TKEC, and the traditional owners have not given their PIC to the act or omission, the person is guilty of an offence (clause 27);
- **sacred–secret material:** if a person uses sacred–secret TKECs other than in accordance with a customary use, the person is guilty of an offence (clause 28);
- **importation:** if a person imports an article or other thing into [ ] that relates to TKECs of that country, and the person knew, or ought reasonably to have known, that the article or thing would have contravened the traditional cultural rights or the moral rights of the traditional owners had it been created in [ ]; the person is guilty of an offence (clause 29(1)); and
- **exportation:** if a person exports TKECs and the export is a non-customary use (whether or not such use is of a commercial nature) and the traditional owners have not given their PIC to the export of the TKECs, the person is guilty of an offence (clause 29(2)).

Under the Pacific Model Law, the same act in relation to traditional cultural rights (i.e. non-customary use without the PIC of traditional owners) constitutes a criminal offence and an infringement under civil law. As well, the same act or omission in relation to moral rights constitutes a criminal offence and an infringement under civil law. Therefore, a traditional community could potentially take a civil action for damages, etc. and also for fines and/or imprisonment under criminal provisions. As noted previously, some countries' copyright laws provide that the same act of infringement can bring about liabilities for damages under a civil action, and for fines and/or imprisonment under criminal provisions.

The Pacific Model Law establishes three additional acts as offences: the use of sacred–secret material, importation of TKECs and exportation of TKECs. Policy-makers may find it useful to consider these acts against the list of questions in section 3.9.2(a) above to determine whether the acts are sufficiently blameworthy in their national context to constitute a criminal offence.

If a country has determined that some types of TKECs will be treated differently (such as TKECs of high spiritual value), policy-makers may wish to consider whether it is appropriate for infringing uses in relation to those TKECs to carry more severe consequences. For example, the use of sacred–secret material under the Pacific Model Law is a criminal offence.

### **c) When may criminal proceedings be commenced?**

It is commonplace for legislation to establish when criminal proceedings may be commenced, and countries may wish to include a provision clarifying this matter. There is no provision in the Pacific Model Law in this regard.

In the case of IP laws, criminal proceedings can generally only be commenced after the matter arises. For example, trademark legislation may provide that no proceeding may be commenced for any offence that was committed before the actual date of registration of the trademark concerned.

Similarly to civil proceedings, policy-makers may also wish to consider whether an action may be brought when there is a strong likelihood that rights may be infringed. As previously discussed,

'precautionary'-type approaches are used in Peru and Panama that allow rights holders to bring a preventative action, as sometimes the damage to particular individuals and/or traditional communities from infringing acts is irreversible.

#### **d) Who should be responsible for bringing criminal proceedings?**

As it can take considerable resources to bring criminal proceedings, policy-makers may wish to consider this in light of the traditional communities in their country and whether assistance is needed in this regard. This is considered in further detail under the element 'Enforcement'. It may be necessary to explicitly provide for a particular agency to be responsible for bringing criminal proceedings (such as the police or a state body). If it is not the police, and instead a state body is to be used, policy-makers will need to give consideration to including provisions in the legislation that grant the agency appropriate powers to gather information (such as search warrants) as well as establishing offences for not cooperating with such investigation.

#### **e) What should be the penalties for offences?**

When considering penalties, it is important to recall that the criminal law is concerned with the punishment of offenders and the deterrence of others from wrongdoing, rather than compensation.

There are no rules in international or regional instruments on copyright and related rights specifying the penalties that are to be applied, nor are there rules at these levels in respect of traditional knowledge. Criminal penalties vary widely from country to country, both in respect of the amount of fines that may be imposed and possible terms of imprisonment (Sterling 1999: 432).

The Pacific Model Law provides that those persons found guilty of an offence are punishable on conviction by a fine or a term of imprisonment. Neither the amount of the fine nor the term of imprisonment is specified, as this is left to the enacting country to determine. As individual countries are likely to have conventions relating to appropriate penalties, further discussion on this matter is not included here.

If a country considers that the use of fines is appropriate, a secondary question that policy-makers may wish to consider is how the proceeds of fines should be used. The proceeds could be treated in the same way as other funds received by the government and form part of the consolidated fund for general purposes. An important policy consideration is that penalties are imposed for the purposes of punishment, not compensation – although there are some exceptions to this principle. If it is considered appropriate, the proceeds could be channelled into a fund for promoting and safeguarding national culture, for example.

#### **f) Should the court be able to grant orders for delivery up?**

Similarly to civil proceedings, policy-makers may wish to consider whether the legislation should include provisions regarding orders for delivery up in relation to criminal offences. The Pacific Model Law does not contain a provision in this regard. If it is considered desirable, policy-makers will need to consider:

- when the orders may be made;
  - matters to be considered by the court;
  - the rights of persons with interest in the goods or other object; and
  - whether goods will be returned where no order is made.
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### **g) What types of defences should be provided for?**

The Pacific Model Law provides that it is a defence to a criminal offence if a determination has been published and the traditional owners specified in that determination have given their PIC to the use in question. This is the only defence established under the Pacific Model Law. Policy-makers may wish to consider whether this is sufficient or whether additional defences are appropriate.

### **3.9.3 Further information**

Other sources of information regarding civil and criminal proceedings include:

- Legislation Advisory Committee. 2001. *Guidelines on Process and Content of Legislation*. Wellington: Ministry of Justice. Chapters 11 and 12 provide information on remedies and criminal offences respectively.
- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 13 provides information on infringement in copyright law.

## 3.10 Enforcement

Enforcement is an important and often overlooked aspect of the protection of traditional knowledge. As with other IP laws, while rights can be established via legislation, whether effective protection is achieved will depend to a significant extent on enforcement. However, while comprehensive rights may be recognised in TKECs in the legislation, the intended beneficiaries may be unable to enforce them – due to cultural or economic reasons, for example (Correa 2003: 38).

Many laws for the protection of traditional cultural expressions provide for the state to have a role in the enforcement of the rights of traditional communities. This approach is reflected in a guiding principle of the Pacific Model Law that 'recognises that the state should have a role in the protection of TKECs, including providing assistance to traditional communities in the management and enforcement of their rights in TKECs'.

The development of this element involves consideration of what role the state should have in enforcing the rights of traditional communities.

### 3.10.1 Policy considerations

In terms of supporting the enforcement process, there may be national policies or laws that provide a context for the state to have a role in this regard, particularly in the context of Indigenous communities.

From a practical perspective, it is important to be cognisant of the costs and resources associated with enforcement. These can be significant depending on factors such as the size of a country and the extent of use of TKECs. Policy-makers should consider whether there are adequate resources available for the state to play a particular role in the enforcement of rights.

### 3.10.2 Policy questions

The following questions are intended to assist countries to develop a policy regarding enforcement that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### **a) What role should the state have in enforcing the rights of traditional communities?**

The role of the state pivots primarily on the traditional communities concerned. It would be useful for policy-makers to examine the capacity of traditional communities to enforce their rights under the legislation. If it is considered that enforcement by traditional communities may be hampered by particular factors such as capacity and resources, it may be appropriate and/or necessary for the state to have a role in the enforcement of rights under the legislation.

In existing national laws, the role of the state takes a range of forms regarding enforcing IP rights as well as rights in TKECs, including the following.

- i. **Monitoring:** In the context of enforcing IP rights, some countries have established specialised IP enforcement units, such as an interagency anti-piracy taskforce.<sup>24</sup> They work closely with industry groups as well as crime and investigation authorities to monitor and enforce against illegal activities. Some countries have established channels or official routes to assist rights owners in informing them when suspected infringements or evidence of suspected infringing

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<sup>24</sup> Examples include the Intellectual Property Rights Branch of the Criminal Investigation Bureau in Singapore, and the Intellectual Property Strategy Headquarters in Japan.

activity takes place. The US Indian Arts and Crafts Act 1990 vests various rights and responsibilities in an 'Indian Arts and Crafts Board', which has a specific role in monitoring violations of the Indian Arts and Crafts Act in the US. The Pacific Model Law includes a monitoring function for the Cultural Authority.

- ii. Legal proceedings: The state can have a role in both civil and criminal matters, if desired. This role can vary from assisting traditional communities, where appropriate, in enforcing their rights regarding their TKECs through the provision of technical advice or providing financial assistance through dedicated legal funds, to having full responsibility for enforcement. The precise role is likely to be influenced by traditional communities' needs and aspirations.

Policy-makers may wish to consider whether a specialist institution or agency needs to be created to oversee or assist in enforcement of the legislation, such as investigating and prosecuting infringements. Some existing laws use national authorities to ensure effective protection. A specific role may be envisaged for a state body in enforcing protection for traditional knowledge. In respect of criminal proceedings, a country may consider it appropriate for a state body to have a role in enforcement in addition, or as an alternative, to the police. This may be necessary if the police in a country do not see themselves as taking a lead role in investigating and prosecuting what they view as 'regulatory offences'. Within WIPO IGC, it has been acknowledged that a state body could be tasked with, among other things, advising and assisting communities with regard to the enforcement of rights and with instituting civil, criminal and administrative proceedings on their behalf when appropriate and requested by them (WIPO 2005).

The US Indian Arts and Crafts Act 1990 contains extensive enforcement provisions. While Indian tribes, Indian arts and crafts organisations and individual Indians have the right to bring civil suits under the act, the Indian Arts and Crafts Board can also receive complaints and act upon them, including by way of referring criminal matters to the Federal Bureau of Investigation and the US Attorney General. For example, a person who sells a product falsely suggesting it is Indian produced can be subject to very heavy fines and imprisonment, with penalties escalating for repeat infringement.

- iii. Enforcement training: Effective enforcement may require enhanced awareness of infringement by police and customs officials, which can be improved through training and cooperative relationships between the officials and traditional communities. Ongoing training is important for enforcement officials.
- iv. Border control: Enforcement issues in relation to TKECs often concern the importation of infringing product. The strengthening of border measures in a region can assist with this problem. The above-mentioned training for customs officials can be useful. Also, in some countries, customs and enforcement authorities have procedures to notify rights holders in order to carry out verification procedures for IP rights-infringing products.
- v. Public education and outreach: Many countries recognise the contribution of IP rights to their economy and have enacted national policies and public education measures, and in some cases established agencies, to promote respect for these rights. This is closely related to but distinct from the education programmes and awareness campaigns discussed under the element 'Management of rights'. These measures are more prevention focused, to try to minimise the incidence of infringements. Enforcement-related campaigns are often directed towards promoting awareness of respect for the rights of others and encouraging consumers to refuse to buy pirated or counterfeit goods. There are also reward schemes for the provision of information by the public about illegal activity or border infringements.

It may not be necessary or appropriate for the state to carry out all of these roles. Policy-makers should draw guidance from their domestic circumstances and the needs of traditional communities. Moreover, some of these enforcement measures would not necessarily require legislative backing

and could therefore operate alongside the legislation (such as the public education and training measures and the enforcement training).

In addition, copyright experience has shown that even with extensive enforcement campaigns, infringements may still continue. Consequently, effective enforcement involves constant review of current procedures and adaptation to deal with the methods devised by infringers to circumvent the law.

### **3.10.3 Further information**

Other sources of information regarding enforcement include:

- Legislation Advisory Committee. 2001. *Guidelines on Process and Content of Legislation*. Wellington: Ministry of Justice. Chapters 11 and 12 provide information on remedies and criminal offences respectively.
- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 13 provides information on infringement in copyright law.

## 3.11 Dispute resolution

The desirability of alternative dispute resolution mechanisms in cases relating to traditional knowledge is frequently emphasised. Alternative dispute resolution or ADR<sup>25</sup> is a 'catch-all' term that describes a number of methods used to resolve disputes out of court, such as negotiation, conciliation, mediation and the many types of arbitration. In matters involving Indigenous and traditional communities, ADR can be considered to encompass the use of customary laws, or customary laws can be considered to be an additional approach to ADR.

Common characteristics of ADR methods are that they are faster, less formal, cheaper and often less adversarial than a court trial. The general principle is that if disputes and conflicts can be resolved without recourse to the courts, this should be encouraged as a preferable alternative to reliance on the general legal system.

In the context of the protection of TKECs, customary laws and decision-making processes will generally be the means by which traditional communities are regulated and controlled. It follows, therefore, that these are likely to be the preferred means of dispute resolution as traditional communities will be accustomed to these practices. Many existing national laws for the protection of traditional knowledge make explicit reference to the use of customary laws and/or ADR. For example, in the Philippines, the Indigenous Peoples Rights Act 1997 provides that 'when disputes involve Indigenous cultural communities/Indigenous peoples, customary laws and practices shall be used to resolve the dispute'.<sup>26</sup> Clause 33 of the Pacific Model Law specifies that disputes may be resolved using mediation, ADR procedures and customary law and practices.

For the purposes of the legislation, where ADR methods (including customary law and practices) are utilised, they would generally occur as alternatives to civil and criminal proceedings under the legislation. In such cases, detailed provisions relating to ADR may not be necessary and countries may take the approach of the Pacific Model Law and simply confirm that ADR is an available option.

Alternatively, countries may consider it necessary to establish a specific process in the legislation for resolving disputes. An important policy consideration in this context is that customary laws used for social control within traditional communities vary greatly. For example, policy-makers should not assume that the role of elders is the same or that similar procedures for resolving disputes are in use across different communities. Close consultation with traditional communities will be critical to ensure that any ADR process established under the legislation is an appropriate means to achieve reconciliation (Wichard & Wendland 2006).

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<sup>25</sup> In recent years, the term ADR has come to mean 'appropriate dispute resolution' to emphasise that ADR methods stand on their own as effective ways to resolve disputes and should not be seen simply as alternatives to a court action.

<sup>26</sup> Section 65, Primacy of Customary Laws and Practices.

## 3.12 Relationship with intellectual property protection

There is a generally accepted principle that new forms of protection for TKECs should be complementary to any applicable conventional IP protection. This is often referred to as 'filling the gap' and is reflected in a guiding principle of the Pacific Model Law that states that 'special protection for TKECs should be complementary to, and not replace or prejudice the acquisition of, any applicable conventional IP protection and derivatives thereof'.

In both developing and implementing the legislation, there are at least two important relationships that policy-makers should be familiar with: firstly, the relationship between the protection available for TKECs under conventional IP laws and the protection that will be provided by the legislation; and secondly, the relationship between the legislation and conventional IP laws in terms of the protection available for works derived from TKECs (derivative works). Having a clear understanding of these relationships is critical, particularly when the legislation is promulgated to stakeholders: policy-makers should expect interested parties to enquire about the interface between the legislation and conventional IP laws. Information regarding the relationship with IP laws is provided in the 'Background' section below, as it does not strictly relate to policy questions.

There is, however, an important policy question for policy-makers to address. The abovementioned guiding principle of the Pacific Model Law specifies that special protection should be complementary to, and not replace or prejudice the acquisition of, any applicable IP protection. In other words, the policy question of whether IP rights in works derived from TKECs (derivative works) should be recognised has already been determined. However, this recognition can be qualified by the imposition of terms and conditions on the creator of a derivative work. This is the approach taken in the Pacific Model Law (see clause 12). In developing this element, policy-makers will need to consider whether terms and conditions should be imposed, in what circumstances, and what the nature of those terms and conditions might be.

### 3.12.1 Background

#### a) What is the relationship between the legislation and existing IP laws in terms of the protection provided to TKECs?

Some of the needs of traditional communities regarding the protection of TKECs may be met by solutions existing already within current IP laws, including through appropriate extensions or adaptations of those laws. For example:

- copyright and industrial design laws can protect contemporary adaptations and interpretations of pre-existing TKECs, even if made within a traditional context;
- copyright law may protect unpublished works of which the author is unknown;
- the *droit de suite* (resale right) in copyright allows authors of works of art to benefit economically from successive sales of their works;
- performances of expressions of culture may be protected under WPPT 1996;
- traditional signs, symbols and other marks can be registered as trademarks;
- traditional geographical names can be registered as geographical indications; and
- the distinctiveness and reputation associated with traditional goods and services can be protected against 'passing off' under unfair competition laws and/or the use of certification trademarks.

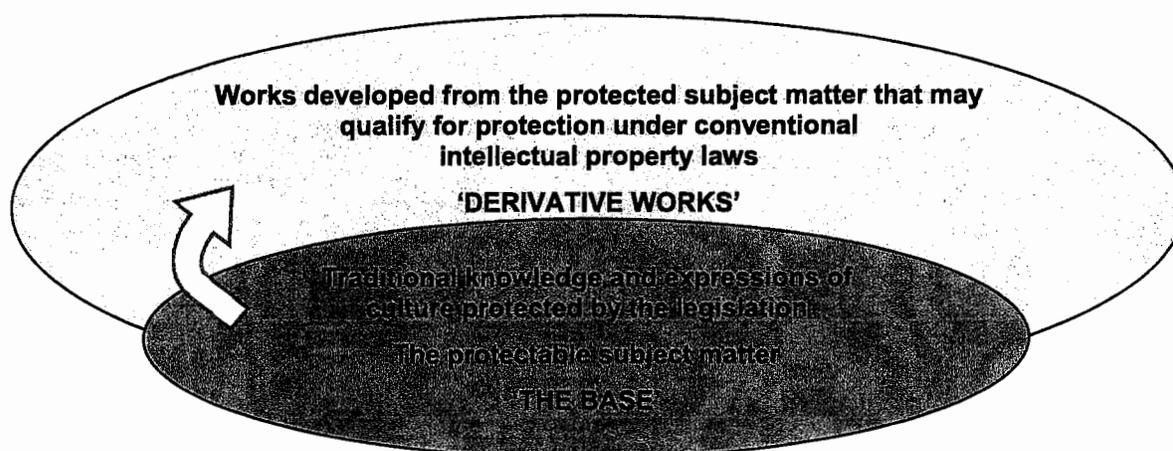
The Pacific Model Law was developed to provide forms of protection for TKECs not currently available under conventional IP laws. Policy-makers may wish to refer to the background section of

the element 'Scope of protection' for further information on the relationship between the protection provided under the legislation and protection available under existing IP laws.

## b) What is the relationship between the legislation and existing IP laws in terms of the protection provided to derivative works?

Many national laws distinguish between TKECs (referred to as 'pre-existing' or 'the base') and contemporary expressions, adaptations and interpretations derived therefrom. The former generally require *sui generis* protection, while the latter may qualify for conventional copyright or other IP protection. For example, the Tunis Model Law 1976 protects 'works derived from national folklore' as original copyright works, whereas folklore itself – described as 'works of national folklore' – is accorded a *sui generis* type of copyright protection because it is unprotected by copyright. The Model Provisions 1982 make a similar distinction, as do national laws in Hungary, Indonesia and many others.

Figure 1 illustrates the relationship between the protectable subject matter (the 'base'; Wendland 2002), which is protected under the legislation, and derivative works, which could be protected under conventional IP laws.



**Figure 1: Relationship between the 'base' and derivative works**

The relationship is usefully explained through the following fictitious example.

Tom is an Australian living in Noumea. He would like to create a sculpture work that draws substantially on particular carvings of the local Kanak community. He intends to sell the work upon completion. As the proposed use is non-customary in nature, under the Pacific Model Law the PIC of the community is required in order to use the cultural expression to create a derivative work. Tom obtains authorisation from the community to create a work that draws on the TKECs of the Kanak community.

This authorisation is set out in an agreement between Tom and the community. The agreement does not contain any terms or conditions regarding the future use of the work in terms of the community's interests. The agreement provides that as the creator of the work, any copyright, trademark, design or other IP right that exists in the work vests in Tom.

After the work is completed, Tom sells the work for a considerable sum of money. Several years later, he is approached by a major publishing company that wants to use an image of the sculpture for the cover of a book. As Tom is the copyright holder, he negotiates an agreement with the publishing company that provides for Tom to receive an initial payment of \$10,000 along with a percentage of sales.

Tom has received a fair return for his creative labour and, arguably, the availability of IP rights has provided an incentive for innovation and creativity. However, this example also raises a

number of issues regarding the relationship between the rights of the community concerned and Tom's IP rights. While Tom has made his own creative contribution, he drew primarily on, and benefited from, the TKECs of the local Kanak community, who did not benefit commercially. This highlights a key issue regarding the protection of a traditional community's rights and interests in derivative works and is discussed in further detail under the 'Policy questions' section below.

### **3.12.2 Policy questions**

The following questions are intended to assist policy-makers to develop a policy on the regulation of derivative works that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### **a) Should terms and conditions be imposed regarding derivative works?**

The imposition of terms and conditions regarding derivative works can be a means of appropriately recognising the prior relationship, rights and interests of traditional communities with the TKECs that underpin those works. In the absence of terms and conditions within an agreement to ensure the community concerned has ongoing rights and interests in derivative works, a user can enjoy the benefits of IP rights without a requirement for benefits to be shared with the community concerned.

Such an approach is not uncommon, particularly in the context of traditional knowledge associated with genetic resources. Under Article 8(j) of the Convention on Biological Diversity, parties are required to encourage the equitable sharing of the benefits arising from the utilisation of traditional knowledge, innovations and practices. At a practical level, there have been a number of examples where users (e.g. companies, collectors, researchers) have entered into agreements with Indigenous and traditional communities in this regard. Agreements have included provisions that in exchange for using and applying the traditional knowledge of traditional communities and being able to obtain IP rights over research outcomes, the user will fairly and equitably share the benefits that accrue from that utilisation with the communities concerned.

It is a policy decision for individual countries as to whether it is appropriate to impose terms and conditions in this regard. The Pacific Model Law establishes terms and conditions that an authorised user agreement must contain (see clause 12).

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***The following policy questions are relevant only if a country decides that it will impose terms and conditions regarding derivative works.***

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#### **b) In what circumstances should terms and conditions be imposed?**

The imposition of terms and conditions on the creator of a derivative work may be necessary only in particular circumstances. For example, if an individual wanted to develop a derivative work for their own personal use with no commercial intentions, it may not be appropriate to require this individual to meet conditions such as benefit-sharing.

Under the Pacific Model Law, terms and conditions are only imposed where a derivative work is to be used for a commercial purpose. Policy-makers may wish to consider whether this is an appropriate circumstance in which to impose terms and conditions or whether alternative or additional scenarios are appropriate, such as a non-customary use.

Secondary questions to consider include whether the terms and conditions should be imposed in all cases, and whether all terms and conditions must be satisfied or whether it is sufficient to meet one or more of the conditions.

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### c) What types of terms and conditions should be imposed?

The types of terms and conditions to be imposed should be developed in close consultation with traditional communities. In terms of the available options, as mentioned previously, it is not uncommon to impose a condition for benefit-sharing; there are international standards in this regard. Other options include acknowledging the community from which the work is derived and moral rights-type provisions specifying that the work will not be subject to derogatory treatment.

Policy-makers may wish to refer to clause 12(2) of the Pacific Model Law for guidance:

If a derivative work ... is to be used for a commercial purpose, the authorised user agreement must:

- (a) contain a benefit-sharing arrangement providing for equitable monetary or non-monetary compensation to the traditional owners; and
- (b) provide for identification of the TKECs on which the derivative work is based in an appropriate manner in connection with the exploitation of the derivative work by mentioning the traditional owners and/or the geographical place from which it originated; and
- (c) provide that the TKECs in the derived work will not be subject to derogatory treatment.

#### **Clause 12, Pacific Model Law**

Continuing on with the fictitious example of 'Tom', the following scenario is intended to illustrate how terms and conditions can operate in practice.

After the work is completed, Tom is approached by a major publishing company, which wants to use an image of the sculpture on the cover of a book. As Tom is the copyright holder, he negotiates an agreement with the publishing company that provides for him to receive an initial payment of \$10,000 along with a percentage of sales.

The agreement between Tom and the community includes several terms and conditions regarding the use of the sculpture for a commercial purpose, as follows.

- In recognition of the fact that Tom's work was derived from the TKECs of the community, the agreement contains a benefit-sharing arrangement whereby the community will receive 20% of any monetary compensation that Tom accrues.
- Any reproduction of the derivative work will make explicit reference to the fact that the work is based on the TKECs of the particular Kanak community of New Caledonia.
- The TKEC will not be subject to derogatory treatment in the derivative work.

Based on these terms and conditions, Tom transfers 20% of the initial payment he receives from the publishing company to the community and advises them that he will transfer 20% of the percentage sales he receives. The description of the work on the inside cover of the book makes explicit reference to the Kanak community of New Caledonia and acknowledges that the work is derived from their cultural expression.

This example shows how a balance can be struck between appropriately addressing the rights and interests of a traditional community and allowing the creator of a derivative work to enjoy the benefits of his or her IP rights. Where this balance sits within countries will of course be influenced by the local context and circumstances.

### **3.12.3 Further information**

Other sources of information regarding the relationship with IP protection include:

- the website of the Convention on Biological Diversity, Article 8(j): Traditional Knowledge, Innovations and Practices Portal, contains a considerable amount of information on benefit-sharing and traditional knowledge; and
  - WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Geneva: WIPO. Pages 42–44 of the Annex provide information on the relationship with IP laws.
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## 3.13 International and regional protection

Intellectual property has long had an international dimension, reflecting agreement in the mid-nineteenth century that effective and appropriate protection was dependent on a degree of international coordination and cooperation (WIPO 2004c: 2). This is equally the case for the protection of TKECs.

The first major question that was dealt with at the international IP level was the recognition of foreign rights holders as having access to national IP systems on a par with domestic nationals. Generally, but not exclusively, this was resolved by the national treatment principle (or the ‘right of assimilation’). Practical mechanisms were also created to facilitate the obtaining and administration of IP rights, particularly when foreign rights holders faced difficulties (leading to recognition of rights of priority, and the elaboration of international application and registration systems). Another aspect of the international dimension has seen the progressive development of substantive standards, setting international standards for how IP should be protected at national level (such as minimum standards for protection) and how other interests, such as third parties and the general public, should be safeguarded (such as through exceptions to IP rights and remedies for the abuse of IP rights).

Regarding the development of substantive standards within international forums regarding TKECs, such as WIPO IGC, and the potential impact on national laws for the protection of TKECs, it is likely that such international standards will continue to respect national discretion as has been the case with existing international IP laws. Countries are likely to have wide discretion in giving effect to any international standards that emerge.

In developing this element, policy-makers will need to consider the recognition of the rights of foreign rights holders regarding TKECs in national systems of protection, including in what circumstances foreign rights holders would have access to national protection systems and the nature and extent of rights granted to foreign nationals. Practical mechanisms to facilitate the obtaining and administration of rights regarding TKECs may need to be addressed if foreign rights holders experience difficulties. This may be difficult to anticipate prior to the legislation coming into force.

### 3.13.1 Background

IP is essentially protected through rights recognised and exercised under national laws (regional laws may also apply, and for the sake of simplicity in this document any reference to national laws also refers to applicable regional laws). As a rule, it is at the national level that rights holders are recognised as having legal identity (or legal personality), that they are given standing to take legal action, and that they are considered entitled to be granted or to hold an IP right. It is ultimately under national law that IP rights are legally recognised (though international arrangements can facilitate applying for rights, can facilitate their registration and recording and, in some jurisdictions, can form the basis for rights directly exercised by individual rights holders), and national legal mechanisms allow IP rights holders to take action to restrain infringement of their rights and to secure other remedies such as damages. Contracts and agreements that affect the ownership of, licensing of and other dealing in IP rights are also concluded and enforced under national laws (WIPO 2004c: 4).

Similarly, the protection of TKECs – whether through conventional IP rights, *sui generis* adaptations or extensions of IP rights, or distinct *sui generis* systems such as the Pacific Model Law – ultimately takes place at national level. Any general approach to the IP protection of this subject matter, including its international dimension, involves consideration of what legal tools and mechanisms are required at national level, how they should operate, and what legal and operational contributions the international dimension can make to protection at national level. It also requires a shared understanding of the role, and the limits on the role, of international mechanisms, whether they are legal, policy, administrative or capacity-building mechanisms. This is not to diminish the international dimension of IP protection, but to set it in a practical and operational context (WIPO 2004c: 5).

Nonetheless, even if its protection ultimately hinges on the operation of national laws, the nature of IP has long demanded international cooperation, including through international legal instruments, but

also through a wide range of other international systems and processes. In fact, it has been considered necessary to craft an international dimension to IP protection since the mid-nineteenth century, first through a series of bilateral trade and IP agreements, and then through the first multilateral treaties on IP (the Paris Convention on the Protection of Industrial Property concluded in 1883, and the Berne Convention for the Protection of Literary and Artistic Works in 1886<sup>27</sup>) (WIPO 2004c: 5).

The initial driver towards these landmark multilateral treaties on IP came in part from recognition of the need for consistent recognition of foreign rights holders in national jurisdictions, and the consequent desire for a multilateral framework to allow reasonable non-discriminatory access to the IP system for foreign rights holders. Accordingly, a major effect of the creation of the Paris and Berne unions was to ensure that countries in each union provided non-discriminatory access to their industrial property or copyright systems for nationals of all other countries (WIPO 2004c: 5).

### **3.13.2 Policy considerations**

Coordination and clarification of linkages with related elements of international law is important. With respect to TKECs, these areas would include cultural heritage, education, creative industries, tourism promotion, human rights, labour standards, Indigenous peoples' issues, and trade and industry (small business development, arts and crafts promotion). International legal instruments of particular relevance to TKECs include those administered or under development by UNESCO (such as the Convention for the Safeguarding of the Intangible Cultural Heritage, and the Convention on the Protection of the Diversity of Cultural Contents and Artistic Expressions).

### **3.13.3 Policy questions**

#### **a) How can the rights and interests of foreign holders of rights be recognised?**

One of the cornerstone elements of the international dimension of the conventional IP system is the mechanism for establishing the entitlement of foreign nationals to receive protection (enabling nationals of one country to enjoy IP rights in a foreign jurisdiction). As a rule, the international standard is for relatively open access to IP systems for foreign nationals (provided that they are nationals of a country with relevant treaty commitments) – a rule that dates back to the first international conventions in the 1800s. By virtue of the obligations under the Paris Convention, the Berne Convention, TRIPS and other IP treaties, the principle of national treatment applies to most categories of IP protection (subject to certain exceptions). In addition, World Trade Organization (WTO) members are required (also subject to certain exceptions) to apply the most-favoured-nation principle at least in relation to the IP protection required under the WTO TRIPS Agreement. Some specific aspects of IP protection (such as the duration of term of copyright protection) may also be determined in certain circumstances by the principle of reciprocity.

The protection of foreign holders of rights in TKECs is, however, a complex question, particularly where different customary laws are at play and also where TKECs are part of the shared cultural heritage of countries. Moreover, while international mechanisms for enabling nationals of one country to enjoy IP rights in a foreign jurisdiction are one of the foundational elements of the general international dimension of IP law, there is currently no international instrument establishing obligations and undertakings regarding the recognition of the rights and interests of foreign holders of rights

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<sup>27</sup> Article 5 of the Berne Convention provides that 'Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention', and that 'protection in the country of origin is governed by domestic law. However, when the author is not a national of the country of origin of the work for which he is protected under this Convention, he shall enjoy in that country the same rights as national authors'.

regarding TKECs. Existing TKEC *sui generis* national laws either do not protect foreign rights holders at all or show a mix of approaches. Some systems of registration and recognition of *sui generis* rights in TKECs appear to be focused on rights holders who are nationals of the country of protection, or that are communities recognised in that country. One model that has been applied has been for reciprocal protection to apply. For example, the Panama Law 2000 and the Pacific Model Law provide for protection of foreign materials. The Model Provisions 1982 provide protection for TKECs of foreign origin either according to a reciprocity principle or on the basis of international treaties (Section 14).

On the presumption that countries will determine that foreign rights holders should be entitled to protection (on the basis that the Pacific Model Law forms part of a regional framework agreed to at the Regional Ministers of Culture meeting in 2002), and recognising that there are also likely to be important exceptions and limitations present, policy-makers may find it useful to refer to the following approaches for guidance on how this could be implemented.

- i. **National treatment:** The question of how rights and interests of foreign holders of rights in TKECs could be recognised in national laws has been resolved, broadly speaking, in existing IP laws by reference to the principle of 'national treatment', although this principle can be subject to some important exceptions and limitations. National treatment can be defined as granting the same protection to foreign rights holders that are granted to domestic nationals, or *at least* the same form of protection. Examples include the Berne Convention, the Rome Convention 1961<sup>28</sup> and WPPT 1996.<sup>29</sup>
- ii. **Reciprocity:** Instead of national treatment, or supplementing national treatment, other international legal mechanisms have been used to recognise the IP rights of foreign nationals. Under 'reciprocity' (or reciprocal recognition), whether a country grants protection to nationals of a foreign country depends on whether that country in turn extends protection to nationals of the first country; the duration or nature of protection may be determined by the same principle. Under a 'mutual recognition' approach, a right recognised in one country would be recognised in a foreign country by virtue of an agreement between the two countries. Another, related mechanism for affording access to a national system is 'assimilation' to an eligible nationality by virtue of residence. For example, the Berne Convention provides that authors who are not nationals of one of the countries of the [Berne] Union but who have their habitual residence in one of them shall, for the purposes of the Convention, be assimilated to nationals of that country.<sup>30</sup>
- iii. **Most-favoured-nation:** Also of potential application to the recognition of rights of foreign rights holders is the 'most-favoured-nation' principle. The TRIPS Agreement provides (subject to exceptions) that with regard to the protection of IP, any advantage, favour, privilege or immunity granted by a [WTO] member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other members.

While a national treatment approach would, in light of precedent and past experience in the IP field, appear to be an appropriate starting point, the very nature of TKECs suggests that national treatment should be supplemented by certain exceptions and limitations or other principles, such as mutual recognition, reciprocity and assimilation, especially when this concerns the legal status and customary laws of beneficiaries of protection.

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<sup>28</sup> Article 2 of the Rome Convention 1961, in so far as performers are concerned, provides that: 'For the purposes of this Convention, national treatment shall mean the treatment accorded by the domestic law of the Contracting State in which protection is claimed: (a) to performers who are its nationals, as regards performances taking place, broadcast, or first fixed, on its territory; National treatment shall be subject to the protection specifically guaranteed, and the limitations specifically provided for, in this Convention.'

<sup>29</sup> WPPT 1996 states that: 'Each Contracting Party shall accord to nationals of other Contracting Parties, as defined in Article 3(2), the treatment it accords to its own nationals with regard to the exclusive rights specifically granted in this Treaty, and to the right to equitable remuneration provided for in Article 15 of this Treaty.'

<sup>30</sup> Article 3(2), Berne Convention.

For example, it is broadly accepted that the beneficiaries of protection should be the traditional communities in whom the custody, care and safeguarding of TKECs are entrusted in accordance with the customary laws and practices of the communities. Under one strict conception of national treatment, a foreign court in the country of protection would have recourse to its own laws, including its own customary laws, to determine whether a foreign community qualifies as a beneficiary. This may not satisfactorily address the situation from the community's viewpoint; the community would, reasonably, wish for its own customary laws to be referred to. Under mutual recognition and assimilation principles, a foreign court in the country of protection could accept that a community from the country of origin of the TKECs has legal standing to take action in country A as the beneficiary of protection because it has such legal standing in the country of origin. Thus, while national treatment might be appropriate as a general rule, it may be that mutual recognition, for example, would be the appropriate principle for addressing certain issues, such as legal standing.

In considering which approach to use, policy-makers may wish to refer to the Pacific Model Law, which uses the reciprocal approach. By way of example only, if Fiji and the Cook Islands have a reciprocal arrangement, the beneficiaries of protection in Fiji will enjoy the same rights and interests regarding their TKECs in the Cook Islands as they do under Fiji's law, and vice versa. The legislation could specify that the rights and benefits arising from the protection of TKECs under the legislation should be available to all eligible beneficiaries who are nationals or habitual residents of a prescribed country, depending on whether a national treatment or reciprocity approach is taken.

#### **Recognition of other laws**

In accordance with reciprocal arrangements, this Act may provide the same protection to TKECs originating in other countries or territories as is provided to TKECs originating in the [enacting country].

**Pacific Model Law, Clause 39**

## **b) What should recognition of the rights of foreign nationals consist of?**

Access by foreign rights holders regarding TKECs to national *sui generis* protection systems may entail various forms of recognition. For instance, it may concern:

- recognition as eligible Indigenous or local communities, or recognition of the legal identity of a collective or community as rights holder;
- entitlement to be granted a right relating to TKECs, including entitlement for TKECs or related subject matter to be entered on a register, where applicable;
- participation in any official mechanisms for the collective administration of rights;
- participation in benefit-sharing arrangements or other funds concerning the exploitation of TKECs; and
- entitlements concerning enforcement of rights, including *ex officio* enforcement action taken by national authorities or public prosecutors.

Under some national laws, rights in TKECs may be specifically reserved for certain classes of individuals or communities identified and recognised under domestic law – for example, 'Indians' in the US Indian Arts and Crafts Act 1990, or certain local or Indigenous communities. Hence, the availability of such rights to foreign individual or collective claimants may also be dependent on their compliance with similar or adapted criteria to be eligible rights holders. This may entail clarifying whether eligibility of foreign rights holders for rights or benefits reserved for particular categories of TKECs holders would be assessed according to the laws of the country of origin, or the laws of the country in which protection is claimed.

### **c) How should practical impediments, if any, to foreign rights holders be addressed?**

The practical exercise and enforcement of IP rights can pose major difficulties for rights holders, especially when multiple jurisdictions are involved and when rights holders have limited resources. This has given the administration of IP rights an international dimension. If the validity of a patent, trademark or industrial design right depended on the timely filing of applications, then applicants would face considerable hurdles in securing the early filing date necessary to safeguard their rights in countries other than their own. Hence the notion of a right of priority was introduced into the Paris Convention for such industrial property rights, so that a filing date in one country would have effect in another Paris Union country provided an application was filed within a certain period of time. International systems such as the Madrid and Hague international registration systems and the Patent Cooperation Treaty are, in essence, developments of this important mechanism, motivated by the recognition that seeking IP rights in multiple jurisdictions creates practical burdens both for applicants and for national authorities, and entails considerable duplication of administrative activities by various authorities. Such developments provide public benefits by reducing the investment of public resources in duplicative administration and the checking of formalities, and creating more effective and useful public information resources. There is, similarly, an international dimension to the question of making more practicable the exercise of IP rights covering TKECs for the benefit of traditional communities.

The difficulty of enforcement of IP rights in multiple jurisdictions has also led to the development of quasi-international mechanisms for alternative dispute resolution. ADR procedures respond in part to practical difficulties with conventional litigation for parties in more than one jurisdiction, and the international aspect of disputes over such IP-related subject matter as Internet domain names.

As the Pacific Model Law and the regional framework have introduced a comparatively new approach to the protection of TKECs, and in the absence of practical experience regarding its implementation, it is difficult to gauge at this point whether administrative measures are needed to address practical impediments. Even so, the development of cooperative mechanisms would most likely occur at regional level for subsequent implementation at national level. If and when it occurs, countries wishing to implement measures to address practical impediments may need to make amendments to their legislation for the protection of TKECs.

#### **3.13.4 Further information**

Another source of information regarding the relationship with international and regional protection is:

- WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Pages 45–48 of the Annex provide information on the relationship with international and regional protection.

# **PART 4. DEVELOPING ADDITIONAL LEGISLATIVE FEATURES**

Following the development of the legal elements of protection of the legislation, there are a number of additional legislative features that policy-makers will need to address. The majority of these features will be shaped by national legislative practices. The Guidelines focus only on complex matters in which policy-makers are likely to require assistance: the development of transitional measures and the development of regulatory making powers.

## **4.1 Transitional measures**

### **4.1.1 Policy questions**

The following questions are intended to assist policy-makers to develop a policy on transitional measures that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### **a) Should protection operate retroactively or prospectively?**

Most countries have general transitional provisions, but these provisions may not provide the result intended in the context of TKECs. A key issue for policy-makers is whether protection should operate retroactively or prospectively, and in particular how to deal with utilisations of TKECs that are continuing when the legislation enters into force and that had lawfully commenced before then.

In terms of policy considerations, it is an accepted principle that laws should respect, as far as possible, rights previously lawfully acquired. That said, it has also been noted that prior and ongoing uses of TKECs should be regulated as far as possible within a certain period of protection measures coming into force (WIPO 2005: 40).

Existing laws utilise a range of approaches, as follows (WIPO 2005: 40).

- i. Retroactivity of the law, which means that all previous, ongoing and new utilisations would become subject to authorisation under the new law or regulation.
  - ii. Non-retroactivity, which means that the only new utilisations that would come under the law or regulation would be those that had not been commenced before the law or regulation's entry into force. For example, the Panama Law 2000 provides that rights previously obtained shall be respected and not affected by the legislation. The US Indian Arts and Crafts Act 1990 only operates prospectively (as from 1935, when the predecessor Act came into force).
  - iii. An intermediate solution, in terms of which utilisations that become subject to authorisation under the law or regulation, but were commenced without authorisation before the entry into force, should be brought to an end before the expiry of a certain period (if no relevant authorisation is obtained by the user in the meantime, as required).
-

### **Application**

- (1) This Act applies to TKECs that:
  - (a) were in existence before the commencement of this Act; and
  - (b) are created on or after that commencement.
- (2) This Act does not affect or apply to rights that exist immediately before the commencement of this Act, including intellectual property rights.
- (3) This Act does not affect or apply to contracts, licences or other agreements entered into by traditional owners before the commencement of this Act in relation to the use of TKECs.

### **Clause 3, Pacific Model Law**

The Pacific Model Law follows in general the intermediate solution. Clause 3 sets out the general application of the Act and specifies that the Act does not affect or apply to rights that exist immediately before the commencement of the Act.

As well, clause 35 establishes a period of 60 days (referred to as the 'application period') within which a person making a non-customary use of protectable TKECs before the commencement of the Act must obtain the PIC of the traditional owners to continue to use the particular TKEC.

### **Procedure for transitional arrangements**

- (1) ... this section applies to a person if, immediately before the commencement of this Act, the person was making a non-customary use of a TKEC.
- (2) The provisions of this Act do not apply to the person during the period of 60 days (the 'application period') starting on the commencement of this Act.
- (3) During the application period, the person must apply ... to the Cultural Authority to obtain prior and informed consent from the traditional owners to continue to use the TKEC.
- (4) If the person does not apply to the Cultural Authority ... the Act applies to the person on and after the end of the application period.
- (5) If a person has applied to the Cultural Authority ... the Act continues not to apply to the person until the traditional owners reject the application or enter into an authorised user agreement with the person, whichever first occurs.

### **Clause 35, Pacific Model Law**

Countries are able to modify these provisions as desired. Policy-makers may also wish to consider whether it would be beneficial for the purpose of clarity to include a linkage to the criteria for protection, such as 'the Act applies to all TKECs that ... after that commencement that fulfil the criteria for protection'.

## **4.1.2 Further information**

Another source of information regarding transitional measures is:

- WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Pages 39–41 of the Annex provide information on transitional measures.

## 4.2 Regulatory making power

There is a general principle that matters of policy should be included in the empowering statute (primary legislation) while matters of detail should be left to delegated legislation (secondary legislation). This interface has been characterised as that between the principle and the detail, between policy and its implementation (Legislation Advisory Committee 2001: 125).

As there is a considerable operational dimension to the protection approach taken in the Pacific Model Law, secondary legislation will be needed to provide guidance on these matters. In order to make secondary legislation, a regulatory making power will need to be developed for inclusion in the primary legislation (referred to as an 'empowering clause'). This segment of the Guidelines provides guidance in this regard.

### 4.2.1 Policy questions

#### a) Who is the appropriate person to make the delegation to?

The empowering clause will need to delegate power to an appropriate person to make regulations. The person to whom the power is given should have an appropriate degree of responsibility. Within central government, law-making powers are often delegated to the governor-general, ministers or officials. Law-making powers can also be given to professional bodies to regulate particular industries.

If the law-making power will potentially impact on individual rights and liberties, careful consideration must be given to the person that will exercise the power. It may be appropriate for the governor-general or an equivalent to exercise the power (Legislation Advisory Committee 2001: 126). If the law-making power involves prescribing technical matters that will not impact upon individual rights, an official may be the appropriate person to exercise the power.

For the purposes of the legislation, the matters prescribed will relate mostly to procedural matters rather than matters that could impact on individual rights and freedoms. Therefore, it may be appropriate for a minister rather than a governor-general to exercise the law-making power, recognising that this is a matter for individual countries to determine based on their national circumstances and practices.

The empowering clause in the Pacific Model Law is contained in clause 38. It delegates the law-making power to the minister responsible for the Act. The responsible minister is a matter for countries to determine.

#### **Regulations**

The Minister may make regulations prescribing all matters:

- (a) required or permitted by this Act to be prescribed; or
- (b) necessary or convenient to be prescribed for carrying out or giving effect to this Act.

**Clause 38, Pacific Model Law**

## b) What should be the scope of the delegation?

Within the empowering clause, the limits of the law-making power should be specified as clearly as possible. It is common for countries to have standard wording providing for the making of regulations and the specific purposes for the regulations are simply inserted. In terms of the legislation, the scope of the delegation will be influenced by the policy decisions taken in Part 3. It is, therefore, difficult to define the necessary scope in the Guidelines. The following non-exhaustive list is intended to provide guidance to policy-makers on the types of matters that could be covered in regulations.

- Management of rights
  - Procedures for applications for authorisation
  - Information any application for authorisation has to contain
  - Fees, if any, that the state body may charge for its services
  - Purpose for which the collected fees must be used
  - Public notification procedures
  - Terms and conditions upon which authorisations may be granted by the state body
  - Resolution of disputes
- Formalities<sup>31</sup>
  - The manner in which applications for notification or registration should be made
  - To what extent and for what purposes applications are examined by the registration office
  - Measures to ensure that registration or notification is accessible and affordable
  - Public access to information concerning which TKECs have been registered or notified
  - Appeals against the registration or notification of particular TKECs
  - Resolution by the registration office of disputes relating to which community or communities should be entitled to benefit from the protection of an expression of culture and its underlying traditional knowledge, including competing claims from communities from more than one country
  - The legal effect of notification or registration

### 4.2.2 Further information

In developing the actual regulations, policy-makers can obtain detailed guidance from Part 4 of the Pacific Model Law. It contains provisions that would typically form part of regulations. Other sources of information regarding regulatory making powers include:

- Legislation Advisory Committee. 2001. *Guidelines on Process and Content of Legislation*. Wellington: Ministry of Justice. See Chapter 10, 'Delegation of Lawmaking Power', which provides information on empowering clauses.
- WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Pages 39–41 of the Annex provide information on transitional measures.

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<sup>31</sup> These matters would be relevant if a decision were made to use a registration or notification approach.

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SIXTH OLBIIL ERA KELULAU

RPPL NO. 6-38

First Regular Session, January 2001 (Intro. as HB No. 6-2-1S, HD1, SD3, CD1)

AN ACT

To provide for copyright protection of original works and for protection of performers' rights; and for related purposes.

THE PEOPLE OF PALAU REPRESENTED IN THE OLBIIL ERA KELULAU DO ENACT AS FOLLOWS:

Section 1. Purpose; short title. The purpose of this Act is to protect the owners and creators of original works, including literary works, musical works, dramatic works, choreographic works, graphic works, architectural works, audiovisual works, computer programs, and sound recordings. This Act has the further purpose of protecting the rights of performers in their performances. This Act shall be known as the "Republic of Palau Copyright Act of 2003."

Section 2. Definitions. As used in this Act:

(a) "Anonymous work" means a work for which no natural person is identified as the author.

(b) "Audiovisual work" means a work that consists of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the work is embodied.

- (c) "Author" means the natural person who created the work.
- (d) "Collective work" means a work, such as a periodical, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.
- (e) "Compilation" means a work formed by the collection and assembling of pre existing materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. "Compilation" includes collective works.
- (f) "Copies" means material objects, including but not limited to phonorecords, in which a work is fixed by any method and from which a work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a device. The term "copies" includes the material object in which the work is first fixed.
- (g) " Copyright owner" with respect to any one of the exclusive rights comprised in a copyright, means the owner of that particular right.
- (h) "Created" means fixed in a copy or phonorecord for the first time. Where a work is prepared over a period of time, the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work.
- (i) "Derivative work" means a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship, is a derivative work.

(j) "Display" means to show a copy of a work, either directly or by means of a film, slide, television image, or any other device.

(k) "Fixed": A work is "fixed" in a tangible medium of expression when its embodiment in a copy or phonorecord is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.

(l) "Joint work" means a work that is prepared by two or more authors whose contributions are merged into inseparable or interdependent parts of a unitary whole.

(m) "Literary work" means a work, other than an audiovisual work, that is expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material object, such as a book, periodical, manuscript, phonorecord, film, tape, or card, in which it is embodied.

(n) "Minister" means the Minister of Community and Cultural Affairs of the Republic of Palau.

(o) To "perform" or "display" a work "publicly" means to recite, render, play, dance, or act, either directly or through the means of any device or, in the case of a motion picture or other audiovisual work, to show its images in any sequence or to make the sounds accompanying it audible, at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered; or to transmit or otherwise communicate a performance or display of the work to a place specified in the foregoing or to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive it in the same place or in separate places and at the same time or at different times.

(p) "Phonorecord" means a material object in which the sounds, other than those accompanying an audiovisual work, are fixed by any method, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. A Phonorecord includes the material object in which the sounds are first fixed.

(q) "Pictorial, graphic, and sculptural works" mean two-dimensional and three dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, technical drawings, diagrams, and models.

(r) "Pseudonymous work" means a work for which the author is identified under a fictitious name.

(s) "Publication" means the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership or by rental or lease. The distribution of copies or phonorecords to a person or group of persons for public performance or public display constitutes publication.

(t) "Residence" means the legal residence of a natural person and the domicile or jurisdiction of incorporation of a legal entity.

(u) "Sound recording" means a work that results from the fixation of a series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material object, such as a disk, tape, or

other phonorecord, in which the sounds are embodied.

(v) "Transfer of copyright ownership" means an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright or of any of the exclusive rights comprised in copyright, whether or not it is limited in time or place or effect, but not including a nonexclusive license.

(w) "Work" means any form of creative expression.

(x) "Work made for hire" means (1) a work prepared by an employee within the scope of his or her employment; or (2) a work specially ordered or commissioned for a particular use if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

## PART 11- COPYRIGHT

### Section 3. Subject matter of copyright; generally.

(a) Copyright protection arises, in accordance with this Act, in original works of authorship fixed in any tangible medium of expression from which those works can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a device including:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) architectural works;
- (7) motion pictures and other audiovisual works;
- (8) computer programs;
- (9) sound recordings;
- (10) speeches, lectures, addresses, and other oral works;

(11) illustrations, maps, plans, sketches, and three-dimensional works relative to geography, topography, architecture, or science; and

(12) works of applied art.

(b) In no case does copyright protection for an original work of authorship extend to the following:

(1) any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work;

(2) official public legislative, administrative or legal texts, or any official translations thereof, and

(3) speeches, lectures, addresses, and other oral works given by a government official in his or her official capacity.

Section 4. Same; compilations and derivative works.

(a) The subject matter of copyright as specified by Section 3 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright exists does not extend to any part of the work in which such material has been used unlawfully.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or existence of any copyright protection in the preexisting material.

Section 5. Same, national origin.

(a) Unpublished works. The works specified by Sections 3 and 4, while unpublished, are subject to protection under this Act without regard to the nationality or citizenship of the author.

(b) Published works. The works specified by Sections 3 and 4, when published, are subject to protection under this chapter if:

(1) on the date of first publication, one or more of the authors is a national or resident of the Republic;

(2) the work is initially published in the Republic of Palau;

(3) the work is initially published in another country and also published in the Republic of Palau within 30 days thereafter, irrespective of the nationality or residence of the author;

(4) the work is an audiovisual work, the producer of which is a resident of Palau; or

(5) the work is an architectural work erected in the Republic of Palau or is an artistic work incorporated into a building or other structure located in Palau.

(c) Any copyright owner who is the bona fide owner of a copyright, or the owner of a transferred copyright as described under section (2)(w) of this Act, which is not subject to the protections and limitations of section 5(b) herein, shall be subject to the same protections provided the owner thereof, provided he or she registers the work or works with the Office of the Attorney General and pays the requisite fee. The Attorney General shall charge a fee of \$200.00 per work registered, or \$ 2,000.00 for 10 or more works registered to the same owner. For persons or businesses registering 10 or more works, additional works may be

added at no charge during the same calendar year. For registration of new copyright in future calendar years, the same fees shall apply. The Attorney General shall promulgate rules and regulations pursuant to the Administrative Procedure Act, 6 PNC Chapter 1, for the administration of this section.

(d) Protection under this chapter shall also apply to works that are eligible for protection in the Republic of Palau by virtue of and in accordance with any international convention or other international agreement to which the Republic of Palau is a party.

Section 6. Exclusive rights in copyrighted works.

(a) Economic rights. Subject to the provisions of this Act, the owner of a copyright under this Act has the exclusive right to do, and to authorize another or others to do, any of the following:

- (1) reproduce the copyrighted work;
  - (2) prepare derivative works based upon the copyrighted work;
  - (3) distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental or lease;
  - (4) perform the copyrighted work publicly;
  - (5) display the copyrighted work publicly;
  - (6) have the copyrighted work translated;
  - (7) adapt, arrange, or otherwise transform the copyrighted work;
- and

(8) broadcast the copyrighted work and otherwise communicate the copyrighted work to the public.

(b) Moral rights. Independent of economic rights, and even where the author is no longer the owner of the economic rights to a copyrighted work, the author of the work shall have the right:

(1) to have his or her name indicated prominently on the copies and in connection with any public use of the work, as far as practicable;

(2) to not have his or her name indicated on the copies and in connection with any public use of the work, and the right to use a pseudonym; and

(3) to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the work which would be prejudicial to his or her honor or reputation.

None of the foregoing moral rights shall be transferrable during the life of the author, but shall be transferrable by testamentary disposition or by operation of law following the death of the author. The author may waive any of the moral rights enumerated in this section.

Section 7. Private reproduction for personal purposes.

(a) Notwithstanding the provisions of section 6, the private reproduction of a single copy of a published work shall be permitted without the authorization of the author or copyright owner, where the reproduction is made by a natural person for his or her own personal purposes.

(b) The permission provided in subsection (a) shall not extend to reproduction:

- (1) of a work of architecture in the form of a building or other construction;
- (2) in the form of reprography of the whole or a substantial part of a book or of a musical work in the form of notation;
- (3) of the whole or a substantial part of a database in digital form;
- (4) of a computer program, except as otherwise provided in this Act; and
- (5) of any work in cases where reproduction would conflict with a normal exploitation of the work or would otherwise unreasonably prejudice the legitimate interests of the author or owner of the copyright.

Section 8. Quotation. Notwithstanding the provisions of section 6, the reproduction, in the form of quotation, of a short part of a published work shall be permitted without authorization of the author or copyright owner; provided, that the reproduction is compatible with fair practice and does not exceed the extent justified by the purpose. The quotation shall be accompanied by an indication of the source and name of the author, if his or her name appears in the work from which the quotation is taken.

Section 9. Reproduction for teaching. Notwithstanding the provisions of section 6, the following acts shall be permitted without authorization of the author or copyright owner:

- (a) the reproduction of a short part of a published work for teaching purposes by way of illustration, in writings or sound or visual recordings, provided that such reproduction is compatible with fair practice and does not exceed the extent justified by the purpose;

(b) the reprographic reproduction, for face-to-face teaching in educational institutions, the activities of which do not serve direct or indirect commercial gain, of published articles, other short works or short extracts of works, to the extent justified by the purpose, provided that:

(1) the act of reproduction is an isolated act occurring, if repeated, on separate and unrelated occasions, and

(2) there is no collective license offered by a collective copyright management organization of which the education institution is or should be aware, under which such reproduction can be authorized.

(c) The source of the work reproduced and the name of the author shall be indicated as far as practicable on all copies made under this section.

Section 10. Reprographic reproduction by libraries and archives.

Notwithstanding the provisions of section 6, any library or archive whose activities are not for commercial gain may, without the authorization of the author or copyright owner, make a single copy of a work by reprographic reproduction under the following circumstances:

(a) where the work reproduced is a published article, other short work, or a short extract of a work, and where the purpose of the reproduction is to satisfy the request of a natural person, provided that:

(1) the director of the library or archive, or his or her authorized agent, is satisfied that the copy will be used solely for the purposes of study, scholarship, or private research;

(2) the act of reproduction is an isolated act occurring, if repeated, on separate and unrelated occasions; and

(3) there is no collective license offered by a collective administrative organization of which the management of the library or archive is or should be aware, under which such reproduction can be authorized;  
or

(b) where the copy is made in order to preserve and, if necessary, to replace a copy that has been lost, destroyed, or rendered unusable in the permanent collection of another similar library or archive, provided that it is impossible to obtain such a copy under reasonable conditions, and provided further that the act of reprographic reproduction is an isolated case occurring, if repeated, on separate and unrelated occasions.

Section 11. Reproduction broadcasting, and other communication to the public for information purposes. Notwithstanding the provisions of section 6, the following acts shall be permitted in respect to a work without the authorization of the author or copyright owner, subject to the obligation to indicate the source and the name of the author so far as practicable:

(a) the reproduction in a newspaper or periodical, or the broadcasting or other communication to the public, of an article published in a newspaper or periodical on current economic, political, or religious topics or of a broadcast work of the same character; this permission shall not apply where the right to authorize reproduction, broadcasting, or other communication to the public is expressly reserved on the copies by the author or copyright owner, or in connection with broadcasting or other communication to the public of the work;

(b) for the purpose of reporting current events, the reproduction and the broadcasting or other communication to the public of short excerpts of a work seen or heard in the course of such events, to the extent justified by the purpose; and

(c) the reproduction in a newspaper or periodical, the broadcasting, or other communication to the public of a political speech, a lecture, address, sermon, or other work of a similar nature delivered in public, or a speech delivered during legal proceedings, to the extent justified by the purpose of providing current information.

Section 12. Reproduction and adaptation of computer programs.

(a) Notwithstanding the provisions of section 6, the reproduction, in a single copy, or the adaptation of a computer program by the lawful owner of a copy of that computer program shall be permitted without the authorization of the author or copyright owner, provided that the copy or adaptation is necessary:

(1) for use of the computer program with a computer for the purpose and extent for which the computer program has been obtained; or

(2) for archival purposes and for the replacement of the lawfully owned copy of the computer program if the lawfully owned copy of the computer program is lost, destroyed, or otherwise rendered unusable.

(b) No copy or adaptation of a computer program may be used for any purpose other than those specified in subsection (a), and any such copy or adaptation shall be destroyed if continued possession of the copy of the computer program ceases to be lawful.

Section 13. Display of works.

Notwithstanding the provisions of section 6, the public display of originals or copies of works shall be permitted without the authorization of the author or copyright owner, provided that the display is made other than by means of a film, slide, television image or otherwise on screen and provided further that the work has been published or the original or the copy displayed has been sold, given away, or otherwise transferred to another person by the author, copyright owner, or their successors in title.

Section 14. Ownership of copyright.

(a) Initial ownership. Copyright in a work protected under this Act vests initially in the author or authors of the work. The authors of a joint work are co-owners of copyright in the work.

(b) Works made for hire. In the case of a work made for hire, the employer is the author for purposes of this Act and, unless the parties have expressly agreed otherwise in a written instrument signed by them, the employer owns all of the rights comprised in the copyright. In the case considered in section 2(y)(2), the person who has ordered or commissioned the work is the copyright owner.

(c) Contributions to compilations. Copyright in each separate contribution to a compilation is distinct from copyright in the compilation as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the compilation is presumed to have acquired only the privilege of reproducing, distributing, or communicating to the public the contribution as part of that particular compilation, any revision of that compilation, and any later compilation in the same series.

(d) Audiovisual works and sound recordings. Copyright in an audiovisual work or sound recording vests initially in the producer of such work, unless otherwise specified by contract. The co-producers of an audiovisual work or sound

recording and the authors of the pre existing works included in or adapted for the audiovisual work or sound recording shall maintain their copyrights in the contributions or pre-existing works, to the extent those contributions or pre-existing works can be subject to copyright protection separately from the audiovisual work or sound recording.

(e) Anonymous and pseudonymous works. Copyright in an anonymous or pseudonymous work vests initially in the publisher whose name appears on the work, who shall be presumed to represent the author. This presumption ceases to apply when the author reveals his or her identity.

(f) Transfer of ownership.

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(1) The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law or may be bequeathed by will; provided, that in the absence of the foregoing means of transfer, ownership of a copyright shall pass as personal property under the laws and customs of the jurisdiction where the owner resides.

(2) Any of the exclusive rights comprised in a copyright, including any subdivision of any of the rights specified by Section 6 of this Act, may be transferred as provided by paragraph (1) of this subsection and owned separately. The owner of any particular exclusive right is entitled, to the extent of that right, to all of the protection and remedies accorded to the copyright owner by this Act.

(g) The natural person whose name is indicated as the author on a work in the usual manner shall, in the absence of proof to the contrary, be presumed to be the author of the work. This provision shall be applicable even if the name is a

pseudonym, where the pseudonym leaves no doubt as to the identity of the author.

Section 15. Ownership of copyrights as distinct from ownership of material object. Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied. Transfer of ownership of any material object, including the copy or phonorecord in which the work is first fixed, does not of itself convey any rights in the copyrighted work embodied in the object; nor, in the absence of an agreement, does transfer of ownership of a copyright or of any exclusive rights under a copyright convey property rights in any material object.

Section 16. Duration of copyright.

(a) Copyright in a work created on or after the effective date of this Act exists from its creation and, except as provided by the following subsections, endures for a term consisting of the life of the author and 50 years after the author's death. Copyright in a work created before the effective date of this Act shall begin on the effective date of this Act and, except as provided by the following subsections, endures for a term consisting of the life of the author and 50 years after the author's death.

(b) In the case of a joint work prepared by two or more authors who did not work for hire, the copyright endures for a term consisting of the life of the last surviving author and 50 years after such last surviving author's death.

(c) In the case of an anonymous work, a pseudonymous work, or a work made for hire, the copyright endures for a term of 75 years from the year of its first publication, or a term of 100 years from the year of its creation, whichever expires first. If, before the end of such term, the identity of one or more of the authors of an anonymous or pseudonymous work is revealed the copyright in the work endures for the term specified by subsections (a) and (b) of this section.

(d) In the case of an audiovisual work or collective work, the copyright endures for a term of 75 years from the year of its first publication, or 100 years from the year of its creation, whichever expires first.

### PART III-- PROTECTION OF PERFORMERS

#### Section 17. Scope of application.

(a) The provisions of this Part shall apply to:

(1) performers who are nationals or residents of the Republic of Palau; and

(2) performers whose performances take place in the territory of the Republic of Palau or are incorporated in sound recordings that are protected under this Act.

(b) The provisions of this Part shall also apply to performers that are eligible for protection by virtue of and in accordance with any international convention or other international agreement to which the Republic of Palau is a party.

#### Section 18. Acts requiring authorization of performers.

(a) Subject to the provisions of subsection (e), a performer shall have the exclusive right to carry out or to authorize any of the following acts:

(1) the broadcasting or other communication to the public of his or her performance, except where the broadcasting or the other communication is made from a fixation of the performance or is a rebroadcasting made or authorized by the organization initially broadcasting the performance; provided, that a fixation made pursuant to subsection (e) or otherwise made without the authorization of the

performer may not be broadcast or communicated to the public without the express authorization of the performer;

(2) the fixation of his or her unfixed performance;

(3) the direct or indirect reproduction of a fixation of his or her performance,

(4) the distribution to the public by sale or other transfer of ownership, of a fixation of his or her performance, or copies thereof, that have not already been subject to a distribution authorized by the performer;

(5) the rental to the public of a fixation of his or her performance, or copies thereof; irrespective of the ownership of the copy rented or lent; and

(6) the making available to the public of his or her fixed performance, by wire or wireless means, in such a way that members of the public may access them from a place or at a time individually chosen by them.

(b) Independently of the performer's economic rights, and even after the transfer of those rights, the performer shall, as regards his or her performance, have the right to be identified as the performer of his or her performances, except where omission is dictated by the manner of the use of the performance, and to object to any distortion, mutilation, or other modification of his or her performance that would be prejudicial to his or her reputation. The provisions of subsection 6(b) shall apply to the rights granted under this subsection.

(c) Nothing in this section shall be construed to deprive performers of the right to agree by contract on terms and conditions more favorable for them with respect to their performances.

(d) The rights under this section shall be protected until the end of the 50<sup>th</sup> calendar year following the year in which the performance was fixed in a phonogram, or in the absence of such fixation, from the end of the year in which the performance took place.

(e) Subsection (a) shall not apply in cases where, under Part I of this Act, a work can be used without the authorization of the author or copyright holder.

(f) Once the performer has authorized the incorporation of his or her performance in an audiovisual fixation, the provisions concerning his exclusive rights shall have no further application.

#### PART IV -- ENFORCEMENT OF RIGHTS

##### Section 19. Infringement; civil remedies.

Anyone who violates any of the exclusive rights of the copyright or the rights of performers provided under this Act is an infringer of copyright or performers' rights, as the case may be, and shall be liable:

(a) to an injunction restraining such infringement;

(b) to pay the copyright owner or performer the greater of:

(1) statutory damages of \$1,000; or

(2) the actual damages suffered by the owner or performer and any profits of the infringer that are attributable to the infringement and are not taken into account in computing the actual damages;

(c) to pay the copyright owner or performer punitive damages, if imposed by the court;

(d) to be subject to a court order for the disposal or destruction of the infringing goods; and

(e) to pay the copyright owner or performer reasonable costs associated with enforcement, including attorneys' fees.

Section 20. Infringement; criminal offense; fraud.

(a) Every person who intentionally or recklessly infringes a copyright or the rights of a performer for the purpose of commercial advantage or private financial gain shall be fined not less than \$5,000 nor more than \$25,000.

(b) When any person is convicted of any violation under subsection (a) the court in its judgment of conviction, in addition to the penalty therein prescribed, may order the forfeiture and destruction or other disposition of all infringing copies or phonorecords and devices used in the manufacture of such infringing copies or phonorecords.

(c) Every person who, with fraudulent intent, places on any article a notice of copyright or words of the same purpose that such person knows to be false, or who, with fraudulent intent, publicly distributes or imports for public distribution any article bearing such notice or works that such person knows to be false, shall be fined not more than \$2,500.

(d) Every person who, with fraudulent intent, removes or alters any notice of copyright appearing on a copy of a copyrighted work shall be fined not more than \$2,500.

(e) Every person who is convicted of violating any of the provisions of this section for a second time shall be fined not more than \$30,000, imprisoned for

not more than one year, or both. Any subsequent conviction shall subject the violator to a fine of not more than \$50,000, imprisonment for not more than two years, or both, for each subsequent offense.

**Section 21. Infringement; provisional and preventative measures.**

In addition to any other penalty or remedy provided by this Act, the Supreme Court shall have the authority, in accordance with applicable laws, regulations, and rules of the Republic, and on such terms as it may deem reasonable:

(a) to grant injunctions to prohibit the committing, or continuation of committing, of infringement of any right protected under this Act; and

(b) to order the impounding of copies of works or sound recordings upon a showing that the copies were made or imported without the authorization of the owner of any right protected under this Act where the making or importation of copies is subject to such authorization, as well as the impounding of the packaging of, the implements that could be used for the making of, and the documents, accounts, or business papers referring to such copies.

**Section 22. Infringement; circumvention of copyright protection devices**

(a) The following acts shall be unlawful and, in the application of sections through 21 of this Act, shall be considered infringements of the rights protected under this Act:

(1) the manufacture or importation for sale or rental of any device or means designed or adapted to circumvent any device or means intended to prevent or restrict reproduction of a work or performance or to impair the quality of the copies made;

(2) the manufacture or importation for sale or rental of any device or means that enables or assists in the reception of any encrypted program, which is broadcast or otherwise communicated to the public, including by satellite, by those who are not entitled to receive the program;

(3) the removal or alteration of any electronic rights management information without authority; and

(4) the distribution, import for distribution, broadcasting, communication to the public or making available to the public, without authority, of works, performances, knowing or having reason to know that electronic rights management information has been removed or altered without authority.

(b) In the application of sections through 21, any illicit device or means mentioned in subsection (a) and any copy from which rights management information has been removed, or in which such information has been altered, shall be considered infringing copies of works, and any illicit act referred to in subsection (a) shall be treated as an infringement of copyright or neighboring rights to which the civil and criminal sanctions provided under this Act are applicable.

#### PART V - TRANSITIONAL AND FINAL PROVISIONS

Section 23. Regulations. The Attorney General shall promulgate regulations pursuant to the Administrative Procedure Act, 6 PNC Chapter 1, to carry out the purposes of this Act.

Section 24. Public education and awareness. Within 180 days from the effective date of this Act, the Ministry of Community and Cultural Affairs, in conjunction with the Attorney General, shall, through a combination of written



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# The New Hawaiian Model: The Native Hawaiian Cultural Trademark Movement and the Quest for Intellectual Property Rights to Protect and Preserve Native Hawaiian Culture

## **Keywords**

trademark, traditional knowledge

# The New Hawaiian Model: The Native Hawaiian Cultural Trademark Movement and the Quest for Intellectual Property Rights to Protect and Preserve Native Hawaiian Culture

by Nina Mantilla\*

## I. INTRODUCTION

In 2002, Disney released the animated movie *Lilo & Stitch*, which told the story of an orphaned Hawaiian girl and a marooned alien she mistakes for a dog. Native Hawaiians were disturbed to find that the movie contained two mele inoa, traditionally used to honor King Kalākaua and Queen Lili'uokalani, two rulers in the 19<sup>th</sup> century known for their strong national and ethnic identity and role in the Hawaiian counterrevolution.<sup>1</sup> Mele inoa are sacred name chants that utilize a person's name to honor them. These two mele inoa, traditionally viewed as a source of Native Hawaiian pride, were performed as a single song and renamed for the orphaned character, Lilo.<sup>2</sup> Disney subsequently copyrighted the song for the movie's soundtrack.<sup>3</sup> The inaccurate and culturally insensitive presentation of these mele inoa in the movie misappropriated traditional Native Hawaiian culture and, along with growing incidences of bioprospecting, sparked Native Hawaiians to come together at the Ka 'Aha Pono '03: Native Hawaiian Intellectual Property Rights Conference to address the growing problem of misappropriation of traditional knowledge and culture.<sup>4</sup>

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1. See Amy K. Stillman, *History Reinterpreted in Song: The Case of the Hawaiian Counterrevolution*, 23 HAWAIIAN J. OF HIST. 1, 13 (1989) <http://evols.library.manoa.hawaii.edu/bitstream/10524/346/2/JL23007.pdf> (translating to mean name chants).

2. See R. Hōkūleil Lindsey, *Responsibility with Accountability: the Birth of a Strategy to Protect Kanaka Maoli Traditional Knowledge*, 48 HOW. L.J. 763, 766 (2005) (quoting a notable Hula instructor stating that Disney "has no right to sell our collective intellectual properties and traditional knowledge."); Stillman, *supra* note 1, at 13 (describing and defining the types of traditional chants).

3. See U.S. Copyright No. PA0001101452 (registered July 2, 2002) (listing the title of the copyright as "He mele no Lilo," and the owner as Walt Disney Music Company).

4. See Lindsey, *supra* note 2, at 766-69 (describing bioprospecting as the process by which large corporations gain exclusive rights to scientific discoveries appropriated from traditional knowledge holders, listing examples to include the transformation of the Hawaiian Genome Project into an issue of intellectual property rights, rather than the original focus on social responsibility, and the patenting of traditional knowledge by mainland biotech companies).

This Article argues that a new solution is needed to address the specific needs of Native Hawaiians, and it can be created by borrowing elements from other successful cultural trademark programs. Part II examines the development of the Native Hawaiian Intellectual Property Rights movement and also examines the current legal barriers to indigenous intellectual property protection.<sup>5</sup> Part III argues that the common goals of self-determination in intellectual property rights between the Native Hawaiian and other indigenous peoples globally allow Native Hawaiians to borrow elements of other existing intellectual property models to find a solution to the Native Hawaiian context.<sup>6</sup> Part III also proposes a new model of protection, the New Hawaiian model, that combines elements of the New Zealand model and the Alaska model to create a solution for protecting indigenous forms of artistic expression that is uniquely tailored to the Native Hawaiian context.<sup>7</sup> This Comment concludes that this New Hawaiian model provides a customized solution for protection of traditional cultural expressions for Native Hawaiians, but acknowledges that the model is an incremental step in what should be a larger movement in Hawaii to protect and preserve all aspects of Native Hawaiian culture.

## II. BACKGROUND

### A. The Native Hawaiian Cultural Trademark Movement

The use of the mele inoa in Disney's *Lilo & Stitch* was not the first time Native Hawaiians dealt with misappropriation of their native culture. Other examples of misappropriation included the Dodge Kahuna, a cartoonish concept car that crossed a minivan with a surf buggy.<sup>8</sup> In Hawaiian, a kahuna is a

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5. See *infra* Part II (outlining the current legal context in Hawaii and the current status of indigenous intellectual property rights in the United States and globally).

6. See discussion *infra* Part III (analyzing current models from which Native Hawaiians can, and should, borrow from).

7. See *infra* Part III (describing how this new model incorporates elements that will work for the specific needs of the Native Hawaiian context).

8. See *Dodge Kahuna Concept Car (2003)*, CAR BODY

person who participates in religious ceremonies; Native Hawaiians found the use of the word in that way offensive.<sup>9</sup> A recent study conducted by the Hawaii Tourism Authority found that a majority of Native Hawaiians felt the tourism industry in Hawaii is inauthentic and distorts their traditional culture.<sup>10</sup>

Commercial misappropriation of Native Hawaiian culture affects the ability of Native Hawaiian artists to make a living from their crafts.<sup>11</sup> The combination of cultural misappropriation and unfair competition in the marketplace is what Native Hawaiians have sought to protect themselves against through adoption of the Paoakalani Declaration at the Ka 'Aha Pono '03 Conference.<sup>12</sup>

The Ka 'Aha Pono '03 Conference took place in 2003, and brought together Native Hawaiian artists, elders, individuals experienced in spiritual and ceremonial practice, and individuals skilled in traditional healing and plant knowledge, among many others.<sup>13</sup> After Disney's misappropriation of traditional name chants and other incidences of cultural misappropriation, Native Hawaiians began preliminary work towards a solution that would provide legal protection for their traditional cultural expressions (TCEs) and traditional knowledge by first asserting their rights over Hawaiian TCEs and

traditional knowledge.<sup>14</sup> The Ka 'Aha Pono '03 Conference produced the Paoakalani Declaration as its final product.<sup>15</sup> The Paoakalani Declaration asserted the self-determination rights of Native Hawaiians over their TCEs and advocated the creation of a sui generis system that would empower Native Hawaiians to have complete control over TCEs.<sup>16</sup> The Hawaiian State Legislature adopted the Paoakalani Declaration, and then funded a study to determine the best legal solution to the problem.<sup>17</sup>

The Native Hawaiian Cultural Trademark Study (Study) was sponsored by the Office of Hawaiian Affairs (OHA).<sup>18</sup> The Study found that the majority of Native Hawaiian artists surveyed favored the use of a cultural trademark program<sup>19</sup> to protect against misappropriation and to provide public recognition of Native Hawaiian cultural arts.<sup>20</sup>

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DESIGN (May 29, 2007), <http://www.carbodydesign.com/archive/2007/05/29-2003-dodge-kahuna-concept/> (advertising the car as embodying "California coastal culture," rather than acknowledging the Hawaiian origin of the name).

9. See John Book, *Name for the new model of Dodge car is offensive to Hawaiians and the Hawaiian culture*, <http://www.petitiononline.com/Kahuna04/> (last visited Nov. 14, 2010); see also *Definition of kahuna*, <http://www.websters-online-dictionary.org/definitions/kahuna> (last visited Jan. 3, 2011) (stating that there are more than forty types of kahunas, including healing professions, and other cultural practitioners).

10. See Herbert A. Sample, *Native Hawaiians say tourism industry distorts their culture*, (Feb. 15, 2010, 5:00pm), [http://www.usatoday.com/travel/destinations/2010-02-15-hawaii-tourism-survey\\_N.htm](http://www.usatoday.com/travel/destinations/2010-02-15-hawaii-tourism-survey_N.htm) (noting that sixty percent of the Native Hawaiians surveyed disagreed that the tourism industry "helps to preserve Native Hawaiian language and culture").

11. See Heidi Chang, *Native Hawaiians seek cultural trademark for art*, PACIFIC BUSINESS NEWS (Nov. 14, 2004, 12:00am HST), <http://www.bizjournals.com/pacific/stories/2005/11/14/story4.html> (explaining that imitators flood the market with cheaper fake versions of authentic Native Hawaiian crafts, such as native drums and leis).

12. See KA 'AHA PONO '03: NATIVE HAWAIIAN INTELLECTUAL PROPERTY RIGHTS CONFERENCE, PAOAKALANI DECLARATION 2 (Oct. 3-5, 2003), <http://kaahapono.com/PaoakalaniDeclaration05.pdf> [hereinafter PAOAKALANI DECLARATION] (asserting that the creative cultural expressions of Native Hawaiians are misappropriated and commercialized in violation of their rights as cultural owners).

13. See PAOAKALANI DECLARATION, *supra* note 12, at 1 (including non-Hawaiians experienced in indigenous intellectual property protection).

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14. See WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO) INTERGOVERNMENTAL COMMITTEE, REVISED DRAFT PROVISIONS FOR THE PROTECTION OF TRADITIONAL CULTURAL EXPRESSIONS/EXPRESSIONS OF FOLKLORE 1, 3 (2010), [http://www.wipo.int/edocs/mdocs/tk/en/wipo\\_grtkf\\_ic\\_17/wipo\\_grtkf\\_ic\\_17\\_4.pdf](http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_17/wipo_grtkf_ic_17_4.pdf) (borrowing the term "traditional cultural expressions," or "TCEs" from the WIPO Draft Provisions, designed to be all encompassing, and include any form of traditional cultural expression, tangible or intangible).

15. See PAOAKALANI DECLARATION, *supra* note 12, at 2 (incorporating the statements of previously-produced unifying statements, such as the Mataatua Declaration and the Kari-Oca Declaration).

16. See *id.* at 3 (defining self-determination to include the right to freely determine political status and freely pursue economic, social, and cultural developments and stating that because traditional knowledge is dynamic, it cannot be adequately protected by rigid western intellectual property laws).

17. See S. CON. RES. RECOGNIZING NATIVE HAWAIIANS AS TRADITIONAL, INDIGENOUS KNOWLEDGE HOLDERS AND RECOGNIZING THEIR COLLECTIVE INTELLECTUAL PROPERTY RIGHTS, S. Con. Res. 167, 22nd Leg. (Haw. 2004), *available at* [http://www.capitol.hawaii.gov/session2004/bills/SCR167\\_.htm](http://www.capitol.hawaii.gov/session2004/bills/SCR167_.htm) (recognizing that the western intellectual property system does not address the protection of indigenous peoples' rights to their collective traditional knowledge); Committee Minutes, Office of Hawaiian Affairs Comm. on Beneficiary Advocacy and Empowerment (Mar. 17, 2004) (on file with author) (offering financial funding to support the OHA commission to address the bioprospecting and intellectual property rights of Native Hawaiians).

18. See NATIVE HAWAIIAN CULTURAL TRADEMARK STUDY, FINAL REPORT 1, 3 (January 2007) <http://hawaiiantrademarkstudy.org/Media/TrademarkStudyReport.pdf> [hereinafter STUDY] (including collaboration on the final study from legal professionals, master artists, and academics).

19. See *id.* (defining a cultural trademark program as one that uses a designator or symbol, on certain products to certify their authenticity).

20. See *id.* at 3, 9 (determining further that a cultural trademark would distinguish authentic Native Hawaiian arts from imitations in the marketplace).

## B. The Legal Context of Indigenous Intellectual Property Rights in the United States

Intellectual property law protects copyrights, patents, and trademark. Trademark is most relevant to the Native Hawaiian context because the Study, and therefore Native Hawaiians themselves, concluded that the most effective solution for protecting and preserving Native Hawaiian TCEs is through the use of a cultural trademark.<sup>21</sup>

### 1. Federal Statutes

The following subsections will outline current United States federal and state law applicable to indigenous intellectual property rights, noting potential areas in the law that might provide protection to Native Hawaiian TCEs.

#### a. *The Lanham Act and Native American Tribal Insignia Database*

The Lanham Act is the federal trademark statute.<sup>22</sup> The purpose behind the Lanham Act is to protect goods and services used in trade, and to prevent consumer deception in the marketplace.<sup>23</sup> The Lanham Act limits registration to marks that are to be used in commerce.<sup>24</sup> Registration is not allowed under § 1052(a) for trademarks “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[.]”<sup>25</sup> This section seems to offer potential protection to indigenous peoples against cultural misappropriation and provides for the creation of the National American Tribal Insignia Database.<sup>26</sup>

The Native American Tribal Insignia Database is a collection of insignia that the United States Patent and Trademark Office (USPTO) refers to when determining if new trademark applications attempt to trademark the symbol of a federally or state recognized Native American tribe.<sup>27</sup> However, the USPTO specifically

notes that registering an insignia does not provide any affirmative legal rights akin to those of registering a trademark; rather, the purpose of registering an insignia is merely to prevent others from registering a trademark.<sup>28</sup>

#### b. *Lanham Act Litigation*

As demonstrated by *Pro-Football, Inc. v. Harjo*, the burden to bring action under § 1052(a) of the Lanham Act rests on Native Americans.<sup>29</sup> In *Pro-Football, Inc.*, Native Americans brought a claim under § 1052(a) to cancel six trademarks of the Washington Redskins team, alleging that the marks “may disparage” Native Americans or “bring them into contempt, or disrepute.”<sup>30</sup> On cross-motions for summary judgment to review the decision of the Trademark Trial and Appeal Board (TTAB), the court ruled in favor of the defendants, *Pro-Football*.<sup>31</sup> The holding requires Native Americans to actively monitor forthcoming trademark applications for any offensive marks, and additionally to bring a claim in a timely fashion against the offensive trademark.<sup>32</sup>

#### c. *Indian Arts and Crafts Act*

In addition to the Lanham Act, the Indian Arts and Crafts Act (IACA), enacted in 1935, is a second potential way indigenous peoples can protect TCEs.<sup>33</sup> The IACA authorizes a federally-recognized Indian tribe to bring an action against a person who “directly or indirectly, offers or displays for sale or sells a good . . . in a manner that falsely suggests it is Indian produced[.]”<sup>34</sup> Although the IACA has specific criteria for protection, the IACA does not have the same effect as intellectual property rights and only confers upon Native Americans a cause of action against those who

21. See *id.* at 3 (finding that the majority of Native Hawaiian artists surveyed over the course of a 12-month period favored the use of a cultural trademark program).

22. 15 U.S.C. §§ 1051 et seq. (2006).

23. See J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:2 (4th ed.) (expounding on the two goals behind any trademark statute).

24. See § 1051(a)(2) (stating that applications must include the date on which the applicant first used the mark in commerce).

25. § 1052(a).

26. See *id.* (suggesting a connection with particular institutions that is false, deceptive, or disparaging is a valid reason for rejection of a trademark application).

27. See *Native American Tribal Insignia Database—FAQs*, USPTO, <http://www.uspto.gov/trademarks/law/tribal/index.jsp>, (last visited July 31, 2010, 1:14 PM) (explaining how federally recognized tribes can submit an insignia to the database and the effect of that submission).

28. See *id.* (noting further that the USPTO does not inquire into the validity of a tribe’s insignia, and accepts the insignia as authentic so long as a federally recognized tribe submits it).

29. See *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 123 (D.D.C. 2003) (stating that registrant has presumption that trademark is valid and burden shifts to contestant).

30. See *id.* at 99 (bringing evidence of expert testimony and survey results alleging that the term “redskin” was a derogatory, offensive reference to Native Americans).

31. See *id.* at 144 (focusing on the issues of evidence and timing of the claim rather than the appropriateness of Native American imagery used in team names).

32. See *id.* at 145 (stating that a delayed claim makes it difficult for a fact-finder to determine if trademarks are disparaging).

33. See 25 U.S.C. § 305a (2010) (declaring the function of the Act is to “promote the economic welfare of the Indian tribes . . . through the development of Indian arts and crafts and the expansion of the market for the products of Indian art and craftsmanship”).

34. See *id.* § 305e(a)(4)(b)-(d) (defining which parties may bring a cause of action).

falsely suggest Native Americans made their products.<sup>35</sup> Similarly to the Lanham Act's disparaging mark cause of action, the burden still rests on Native Americans to protect their TCEs.<sup>36</sup>

In 2000, Senate Report 452 stated that the IACA had not yet had a successful prosecution, and although a decade has passed since that statement, House Report 397, published in 2010, reported the same conclusion.<sup>37</sup> Although many claims have been filed, none have progressed past a motion to dismiss.<sup>38</sup> However, this may change with the filing of a recent claim in *Native American Arts, Inc. v. Contract Specialties, Inc.*<sup>39</sup> Plaintiff Native American Arts, Inc. alleged that defendant Contract Specialties, Inc. violated IACA by selling goods in a manner that falsely suggested these products are authentic Indian-made goods.<sup>40</sup> The court denied the defendant's motion to dismiss, and the final outcome of NAA's claim, as based on the merits, is pending.<sup>41</sup>



## 2. State Trademark Law and Alternative Solutions

The Alaska Silver Hand Program is a state trademark law<sup>42</sup> which uses identification seals to certify authentic Alaskan Native Art.<sup>43</sup> The Alaska Silver Hand Program is only available to Native Alaskans who are part of a federally or state recognized village or tribe, and living within the state of Alaska.<sup>44</sup> The program issues a two-year permit for the use of the identification seal, and the permit can be renewed indefinitely.<sup>45</sup>

An alternative model for intellectual property protection at the local level is the example of the Gee's Bend Quilters of Gee's Bend, Alabama.<sup>46</sup> The Quilters

of Gee's Bend found a solution for protecting their TCEs through a relationship with the Tinwood Alliance, an Atlanta-based non-profit organization dedicated to promoting vernacular art.<sup>47</sup> Tinwood Alliance contracted with the Gee's Bend Quilters for the intellectual property rights to all their quilts made prior to 1984, and then began displaying the quilts in museums across the country.<sup>48</sup> A licensing program controls the rights to the quilts and has led to the use of the Gee's Bend aesthetic in all kinds of

35. See *id.* (requiring that the product must be Indian-made, produced after 1935, and the producer of the Indian product must be a resident in the United States and including only civil causes of action); Protection of Products of Indian Art and Craftsmanship, 68 Fed. Reg. 35,164, 35,169 (June 12, 2003) (to be codified at 25 C.F.R. pt. 309) (defining "made by an Indian" as "that an Indian has provided the artistic or craft work labor necessary to implement an artistic design through a substantial transformation of materials to produce the art or craft work").

36. See § 305e(d) (requiring either the Attorney General, an Indian tribe, an Indian, or an Indian arts and crafts organizations to bring a claim).

37. See S. REP. NO. 106-452, at 3 (2000); see also H.R. REP. NO. 111-397, at 3 (2010) (expanding the IACA criminal actions and sanctions in response to the lack of current successful claims).

38. See H.R. REP. NO. 111-397, at 2 (estimating that although "very few cases relating to the sale of counterfeit Indian goods are investigated each year[,] almost seventy-five percent of the merchandise sold as authentic is not).

39. See *Native Am. Arts, Inc. v. Contract Specialties, Inc.*, 754 F. Supp. 2d 368, at 369 (D.R.I. 2010) (noting this is the first IACA case in the First District, and one of the few to survive a motion to dismiss).

40. See *id.* at 368 (commenting that NAA has filed between ninety and 120 claims since Congress amended the IACA in 2000, allowing Indian arts and crafts organizations to bring claims).

41. See *id.* at 373 (ruling that IACA did not violate the first amendment because IACA does not restrict artistic work, rather it regulates the way such art is marketed and that IACA passes rational basis review).

42. ALASKA STAT. § 45.65.010(a) (West 2010).

43. See tit. 3, § 58.020(a)-(b); see also ALASKA STATE COUNCIL ON THE ARTS, *Time Line Silver Hand Permit Program and Related Events*, <http://www.eed.state.ak.us/akscal/pdf/SilverHandProgramHistory.pdf> (Jan. 28, 2010) [hereinafter *Time Line Silver Hand*] (tracking the history of the program, beginning around 1972, with the first uses of the Silver Hand trademark).

44. See § 45.65.010(a) (stating that only those who meet these requirements may affix the identification seal to original Alaska Native art or handicrafts).

45. See tit. 3, § 58.020(d) (placing no explicit limit on the number of times a permit may be renewed).

46. See generally Victoria F. Phillips, *Commodification, Intellectual Property and the Quilters of Gee's Bend*, 15 AM. U. J. GENDER SOC. POL'Y & L. 359 (2007) (arguing that the story of the Gee's Bend quilters can contribute to current debates regarding commodification and intellectual property laws).

47. See *id.* at 365-66 (recounting that the partnership was spearheaded by the owner of Tinwood Alliance, William Arnett, after he was fascinated by the quilts from a photo in a book).

48. See *id.* at 366 (telling how the success of the quilts in museum exhibitions sparked spin-off projects based on the quilts including music, documentary films, and books).

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homewares.<sup>49</sup> With the help of Tinwood Alliance, the Quilters of Gee's Bend have formed a collective that is owned, operated and run by the Gee's Bend women.<sup>50</sup> In addition to helping the Quilters form a collective to produce the quilts, Tinwood Alliance pays a royalty to the community of Gee's Bend on all licensed uses for the quilts made before 1984.<sup>51</sup>

## C. The Legal Context in Hawaii

The following subsections outline the current legal context of Hawaiian state law with respect to Indigenous intellectual property rights, as well as attempts by Hawaiians to change federal law with respect to such rights.



*Photograph entitled "Makanani" by Kim Taylor Reece, showing a traditional hula pose.*

had taken a famous photograph entitled "Makanani," which was an image of a hula dancer kneeling on a beach in a traditional pose.<sup>54</sup> Reece first published the image in 1988 as a poster and then broadened the image's distribution, including use on greeting cards and as picture frame inserts in Wal-Mart and Kmart stores.<sup>55</sup> Reece brought a copyright action against the native artist who created the allegedly infringing stained glass artwork "Nohe" as well as the art gallery displaying the work.<sup>56</sup> The sacred nature of hula in Native Hawaiian culture is best demonstrated by the expert testimony presented at trial, in which Mapauna De Silva stated, "[h]ula is not just the images, the motions, and the feet. It is the whole culture – the



*Stained-glass portrait in dispute in Reece v. Island Treasures Art Gallery. Created by Marylee Leialoha Colucci.*

### 1. Recent Case Law

Currently, Hawaiian state law does not offer much protection to Native Hawaiians. In fact, recent case law suggests the opposite.<sup>52</sup> In *Reece v. Island Treasures Art Gallery, Inc.*, a non-native photographer brought a copyright infringement case against a Native Hawaiian artist.<sup>53</sup> Reece was a professional photographer who

people, the places, stories, and names given to all those things[.]”<sup>57</sup> The court failed to recognize that the

49. See *id.* at 367 (listing products based on the quilts, and approved through licenses, including bedding, pillows, and pet-proof rugs).

50. See *id.* at 368 (noting that the Gee's Bend collective serves as the only source of the quilts currently made by the women).

51. See *id.* at 366 (explaining that Tinwood Ventures purchased the rights to all quilts made prior to 1984).

52. See *Reece v. Island Treasures Art Gallery, Inc.*, 468 F. Supp. 2d 1197 (D.Haw. 2006) (ruling on narrow issues of copyright infringement rather than addressing misappropriation of a Native Hawaiian cultural art).

53. See *id.*; Danielle M. Conway, *Indigenizing Intellectual Property Law: Customary Law, Legal Pluralism, and the Protection of Indigenous Peoples' Rights, Identity, and Resources*, 15 TEX. WESLEYAN

L. REV. 207, 245 (2009) (proposing that the Native Hawaiian context demonstrates that legal pluralism is needed to protect traditional culture).

54. See *Reece*, 468 F. Supp. 2d at 1200 (depicting a hula dancer performing the hula kahiko tradition, an ancient style of hula in which all the movements are standard).

55. See *id.* at 1200, 1204 (citing the widespread visibility of the photograph as evidence that the defendant had reasonable opportunity to view it, an important factor in determining copyright infringement).

56. See *id.* at 1200 (describing the work as a stained glass depiction, containing over 200 pieces of glass, including a far greater variety in color than Reece's sepia tone photograph).

57. See Decl. of Mapauna De Silva at ¶¶ 15, 20, 27, *Reece v. Island Treasures Art Gallery, Inc.*, 468 F. Supp. 2d 1197 (D.Hawai'i 2006) (No. 06CV00489), 2007 WL 6344621 (remarking that not only is it impossible to have a hula "pose" because of the fluid nature of hula movements, but that it is repugnant to suggest that an individual can claim ownership over a hula movement).

cultural art of hula belongs to Native Hawaiians or recognize that no other judicial remedies are available to Native Hawaiians to protect their cultural art; rather, the court ruled on the narrow issue of protectable elements within the photograph.<sup>58</sup>

## 2. Proposed Legislation: The Akaka Bill

The low-level of protection currently available to Native Hawaiians for TCEs is largely because Native Hawaiians do not qualify for federal tribal recognition, and therefore do not have access to the same programs that Native Americans do.<sup>59</sup> Daniel K. Akaka, United States Senator for Hawaii, introduced the Native Hawaiian Government Reorganization Act in 2009, often referred to as the Akaka bill, which never made it out of the Senate in the last congressional session.<sup>60</sup> The Act would have allowed Native Hawaiians the same federally-recognized tribal status as Native Americans.<sup>61</sup> Despite wide support, the bill faced opposition in the Senate.<sup>62</sup> The Akaka bill was reintroduced on March 30, 2011, as was a companion bill in the House of Representatives.<sup>63</sup> This session of Congress has been

58. See *Reece*, 468 F. Supp. 2d at 1207 (ruling that protectable elements of the photograph included lighting, camera angle, and perspective, and that when these elements are isolated it is clear that the “Nohe” stained glass artwork did not infringe on *Reece*’s copyright); see also Conway, *supra* note 53, at 245 (pointing out that the court “could have provided a more meaningful analysis of the copyright infringement dispute launched by a non-Native Hawaiian copyright holder against a Native Hawaiian artist who herself was raised and trained in the cultural art of hula, a traditional dance that . . . communicates the identity of Native Hawaiians.”).

59. See STUDY, *supra* note 18, at 33 (noting that federal law requires a native group to be “continuously organized and governed under a quasi-sovereign entity” in order to be recognized as a tribal entity).

60. See Native Hawaiian Government Reorganization Act, H.R. 2314, S. 1011, 111th Cong. (2010) (placing the bill on the Senate calendar for this session); see also Daniel Kahikina Akaka, U.S. Senator of Hawaii: Native Hawaiian Federal Recognition, <http://akaka.senate.gov/issue-native-hawaiian-federal-recognition.cfm> [hereinafter *Akaka, 111<sup>th</sup> Congressional Session*] (last visited Jan. 25, 2011) (detailing the purpose, content, and status of the bill).

61. See *Akaka, 111<sup>th</sup> Congressional Session*, *supra* note 60 (correcting false accusations by assuring that the bill would not allow Native Hawaiians to secede from the United States, allow private lands to be taken, or authorize gaming in Hawaii).

62. See *Akaka Speaks on Senate Floor, Reaffirming his Commitment to the Native Hawaiian Government Reorganization Act*, <http://akaka.senate.gov/pressreleases.cfm?method=releases.view&id=717cdf0e-c354-4019-a1d4-d223c7f5e747> (Dec. 22, 2010) (stating that the bill is supported by Indigenous leaders and communities across the United States, including American Indians, Native Alaskans, and the American Bar Association, which has written a statement affirming the Constitutional basis for the bill).

63. Daniel Kahikina Akaka, U.S. Senator of Hawaii: Native Hawaiian Federal Recognition, <http://akaka.senate.gov/issue-native-hawaiian-federal-recognition.cfm> [hereinafter *Akaka, 112<sup>th</sup> Congressional Session*] (last visited Oct. 16, 2011).

more favorable to the bill and on April 7, 2011, the Akaka bill was ordered to be reported out of the Senate Committee on Indian Affairs, favorably and without amendment; however, the Senate must still vote on the bill.<sup>64</sup>

## D. The Current Legal Context of Indigenous Intellectual Property Rights Globally

There is a wide array of international models for establishing indigenous intellectual property rights. However, when considering the Native Hawaiian context, it is best to draw upon sui generis models.<sup>65</sup> Models that attempt to protect TCEs within existing intellectual property regimes are inappropriate for several reasons.<sup>66</sup> Existing intellectual property protection, particularly trademark law, is designed to protect the sign or symbol as it interacts with the marketplace.<sup>67</sup> This presents two problems for indigenous expressions. First, protecting a sign or symbol does not address that often with TCEs, the underlying knowledge or cultural values are in need of protection.<sup>68</sup> Second, traditional cultural expressions are either forced into the category of signs and symbols used in commerce, or faced with non-protection.<sup>69</sup> For the foregoing reasons, the following sui generis models provide the best answers to borrow or learn from for the Native Hawaiian context.

64. *Id.*

65. See generally *Legislative Texts on the Protection of Traditional Cultural Expressions*, WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO) (Jan. 3, 2011), <http://www.wipo.int/tk/en/laws/folklore.html> (defining sui generis as “special laws and measures which specifically address the protection of traditional cultural expressions/expressions of folklore” as opposed to working protection into existing laws).

66. See Danielle Conway-Jones, *Safeguarding Hawaiian Traditional Knowledge and Cultural Heritage: Supporting the Right to Self-Determination and Preventing the Commodification of Culture* 48 How. L.J. 737, 739 (2005) (asserting that Native Hawaiians will not benefit from intellectual property laws that promote the commodification of culture).

67. See Susy Frankel, *Trademarks and traditional knowledge and cultural intellectual property*, in TRADEMARK LAW AND THEORY 433, 445 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008) (pointing out the TRIPS Agreement requires that trademarks must be “capable of distinguishing the goods or services of one undertaking from those other undertakings[.]” and further noting other inherent goals of trademark law include enhancing competition and reducing consumer search costs).

68. See *id.* at 445 (arguing that it is only an inadvertent side-effect of the symbol protection that the underlying cultural values are protected from misrepresentation by third parties).

69. See *id.* (additionally noting that the use of a trademark in commerce must often be maintained or the trademark owner will lose the registration for non-use of the symbol).

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## 1. *The SPC Framework and Guidelines*

The Secretariat of the Pacific Community (SPC) published Guidelines (SPC Guidelines) and a Framework (SPC Framework) in 2002 to assist Pacific Island countries and territories seeking to establish legal protection for TCEs.<sup>70</sup> The SPC Guidelines provide a step-by-step guide for any group seeking intellectual property protection by posing both policy and legal questions for consideration.<sup>71</sup> The SPC Framework provides a model law for protection of traditional knowledge and expressions of culture that countries can adopt or from which they can borrow when creating their own protection regime.<sup>72</sup> The SPC Guidelines and SPC Framework are tailored for small island countries and territories with relatively homogenous traditional cultures.<sup>73</sup>

## 2. *The Panama Model*

Another example of a *sui generis* law from which Native Hawaiians can borrow is Panama Law No. 20, enacted in 2000, and corresponding Executive Decree No. 12, enacted in 2001 (Panama model).<sup>74</sup> The Panama model stands out from other *sui generis* models because it focuses exclusively on protection of TCEs that are capable of commercial use.<sup>75</sup>

70. See REGIONAL FRAMEWORK FOR THE PROTECTION OF TRADITIONAL KNOWLEDGE AND EXPRESSIONS OF CULTURE, SECRETARIAT OF THE PACIFIC COMMUNITY Background Page (2002), [http://www.wipo.int/export/sites/www/tk/en/laws/pdf/spc\\_framework.pdf](http://www.wipo.int/export/sites/www/tk/en/laws/pdf/spc_framework.pdf) [hereinafter SPC FRAMEWORK] (collaborating to create the framework with the United Nations Educational, Scientific and Cultural Organization (UNESCO), Forum Pacific Island member countries and territories, and the Council of Pacific Arts).

71. See GUIDELINES FOR DEVELOPING NATIONAL LEGISLATION FOR THE PROTECTION OF TRADITIONAL KNOWLEDGE AND EXPRESSIONS OF CULTURE BASED ON THE PACIFIC MODEL LAW 2002, SECRETARIAT OF THE PACIFIC COMMUNITY 14 (2006), <http://www.wipo.int/wipolex/en/details.jsp?id=6712> [hereinafter SPC GUIDELINES] (listing questions to consider including: what the subject matter of protection should be, who the beneficiaries of such protection are, how should rights be formalized and managed, and what processes should be used for dispute resolution).

72. See SPC FRAMEWORK, *supra* note 70, at background page (recognizing that the model law is merely a starting point from which countries should customize elements in accordance with their own experiences, and further, that the model law is meant to provide only national protection).

73. See *id.* (explicitly stating that the SPC Framework and Guidelines were developed to assist Pacific Island countries and territories).

74. See Act No. 20, *Gaceta Oficial*, June 26, 2000, <http://www.wipo.int/wipolex/en/details.jsp?id=3400> (naming the act the Special System for the Collective Intellectual Property Rights of Indigenous Peoples); Executive Decree No. 12, Ministry of Trade and Industries, Mar. 20, 2001, <http://www.wipo.int/wipolex/en/details.jsp?id=3397> (regulating Act No. 20 of Jun. 26, 2000).

75. See Act No. 20 at art. 1 (planning to protect TCEs suitable for commercial use via a registration system designed to

## 3. *The New Zealand Toi Iho Program*

The *toi iho* cultural trademark program of New Zealand has become a model for many other countries seeking indigenous intellectual property protection.<sup>76</sup> The *toi iho* program uses trademarks to certify artwork that is of high quality and expresses traditional Māori culture.<sup>77</sup> The program has the support of well-known Māori master artists, and their public support of the program, as well as their knowledge of Māori art, is crucial in setting The *toi iho* program's high standards of quality.<sup>78</sup>

### III. ANALYSIS

Ideas from existing models for protecting indigenous intellectual property rights should be borrowed in a way that creates a tailor-made solution that addresses the unique needs of Native Hawaiians. The demands of Native Hawaiians for self-determination in intellectual property rights are similar to those echoed throughout the world by other indigenous peoples.<sup>79</sup> Because they share numerous goals with other indigenous groups fighting for intellectual property rights, Native Hawaiians should borrow from these other models.<sup>80</sup>

promote and market the TCEs); see also COMPARATIVE TABLE ON SUI GENERIS LAWS ON TRADITIONAL CULTURAL EXPRESSIONS/ EXPRESSIONS OF FOLKLORE, WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO) 3 (Jan. 3, 2011), [http://www.wipo.int/export/sites/www/tk/en/laws/pdf/suigeneris\\_folklore.pdf](http://www.wipo.int/export/sites/www/tk/en/laws/pdf/suigeneris_folklore.pdf) [hereinafter WIPO COMPARATIVE TABLE].

76. See STUDY, *supra* note 18, at 30 (describing the Māori Toi Iho program as the best model for a Native Hawaiian cultural trademark program).

77. See *Te Puia—Treasuring Māori Arts and Crafts*, NEWZEALAND.COM (last visited Oct. 30, 2011), [http://www.newzealand.com/travel/media/features/maori-culture/maori-culture\\_te-puia-maori-arts-crafts\\_feature.cfm](http://www.newzealand.com/travel/media/features/maori-culture/maori-culture_te-puia-maori-arts-crafts_feature.cfm) (establishing that the trademark is used to “promote and sell authentic, quality Māori arts and crafts” as well as to “authenticate exhibitions and performances of Māori arts”).

78. See STUDY, *supra* note 18, at 28-29 (arguing that participation of these master artists was crucial to obtain national and Māori “buy-in” for the program).

79. See PAOAKALANI DECLARATION, *supra* note 12, at 2 (supporting the statements made in the Kari-Oca Declaration, Indigenous Peoples’ Earth Charter, and Mataatua Declaration on Cultural and Intellectual Property Rights of Indigenous Peoples, among others).

80. See STUDY, *supra* note 18, at 26-33 (analyzing existing solutions to determine which are most relevant to the Native Hawaiian context); see also MATAATUA DECLARATION ON CULTURAL AND INTELLECTUAL PROPERTY RIGHTS OF INDIGENOUS PEOPLES, FIRST INTERNATIONAL CONFERENCE ON THE CULTURAL & INTELLECTUAL PROPERTY REGIMES OF INDIGENOUS PEOPLES 2 (June 12-18, 1993), available at [http://www.wipo.int/tk/en/databases/creative\\_heritage/indigenous/link0002.html](http://www.wipo.int/tk/en/databases/creative_heritage/indigenous/link0002.html) (stating that indigenous peoples of the world have a “commonality of experiences relating to the exploitation of their cultural and intellectual property” and the right to self-determination and exclusive ownership of their TCEs).

In addition to sharing goals with indigenous peoples internationally, Native Hawaiians also share goals with Native Americans in the United States, and should borrow from the intellectual property protection given to Native Americans.<sup>81</sup> Native Hawaiians and Native Americans share the identical goal of safeguarding their culture and communities through preserving and protecting their TCEs, and therefore Native Hawaiians can gain much by borrowing from the current solutions proposed for the Native American context.<sup>82</sup>

There is no one-size-fits-all solution to protecting indigenous intellectual property rights. However, the shared goals of self-determination and protection of traditional culture necessitates that Native Hawaiians borrow from existing models, both within and outside of the United States, to create a new model that works specifically for the Hawaiian context.

#### A. Current International Solutions Do Not Address the Specific Needs of the Native Hawaiian Context

Examining current sui generis models that other countries have enacted provides strategies and ideas that Native Hawaiians should apply to their situation. However, as demonstrated by the following subsections, none of the current international solutions should be applied without some modifications to the Native Hawaiian context.<sup>83</sup>

##### 1. The SPC Framework Will Only Work in Smaller, Non-Diverse Populations Where a Coherent Cultural Community Exists

The SPC Framework allows for flexibility in legal ownership by providing for individual or communal ownership of TCEs, and looks to the group or clan's customary law and practices to determine who is entrusted with these ownership rights.<sup>84</sup> The SPC Framework creates a new set of "traditional cultural rights," giving traditional owners control over the uses

of traditional knowledge or expressions of culture.<sup>85</sup> It offers an incredibly high level of legal protection for TCEs by creating rights that last indefinitely and by requiring prior informed consent from the traditional owners before third-party use is permitted.<sup>86</sup> Unfortunately, the SPC Framework is only able to offer such high levels of protection in exchange for relatively little flexibility as to the type of community to which the rights can apply.<sup>87</sup> Therefore, it is likely to work only in the smaller island nations for which it was initially developed, where traditional owners are more easily identified and a more coherent cultural community exists.<sup>88</sup>

##### 2. The Panama Model's Market-Driven Focus and Restriction to Communal Ownership Does Not Provide Enough Flexibility for The Native Hawaiian Context

The Panama model provides another example of sui generis protection that could be useful to Native Hawaiians.<sup>89</sup> It aims to offer protection of TCEs that are capable of commercial use by implementing a system to register, promote, and market the rights.<sup>90</sup> This distinct emphasis on the ability of the TCEs to be capable of commercial use differentiates the Panama model from other models.<sup>91</sup> However, the market-focused nature of the Panama model does not provide protection to those TCEs which are not meant, or which the artists do not want, to be

81. See S. REP. NO. 106-452, at \*2 (2000) (describing the TCEs of Native Americans as "an extension of their heart and soul," expressing a spiritual, intangible nature to these TCEs, echoing the way Native Hawaiians describe their TCEs).

82. See *id.* at \*1-2 (reporting that of the more than \$1 billion in revenue for Indian-made goods, \$400-500 million of the demand is being met by inauthentic and imitation products, demonstrating the detrimental financial effects of inauthentic goods).

83. See generally *Legislative Texts on the Protection of Traditional Cultural Expressions (TCEs)*, *supra* note 65 (listing a full and comparative list of sui generis laws).

84. See SPC FRAMEWORK, *supra* note 70, at 4 (noting further that "the customary use of traditional knowledge or expressions of culture does not give rise to civil or criminal liability").

85. See *id.* at 5 (defining traditional cultural rights as exclusive control over publishing, reproducing, performing or displaying, recording, photographing, or translating any traditional knowledge or expressions of culture).

86. See *id.* at 6-8 (explaining that a prospective user must either get prior and informed consent from traditional owner or ask the Cultural Authority, which utilizes a public application process in which traditional owners are given an opportunity to object to third-party use).

87. See SPC GUIDELINES, *supra* note 71, at 1-2 (acknowledging that the Guidelines are based on the needs of Pacific Island communities, and that other countries may have different ideological standpoints and cultural assumptions).

88. See STUDY, *supra* note 18, at 26 (arguing that the more intact a cultural community has remained, the more likely the SPC Framework will work, unlike communities that have become diverse through colonization and democratic rule such as Hawaii).

89. See Act 20, GACETA OFICIAL (Jun. 26, 2000), available at <http://www.wipo.int/wipolex/en/details.jsp?id=3400>; Executive Decree No. 12, Ministry of Trade and Industries (Mar. 20, 2001), available at <http://www.wipo.int/wipolex/en/details.jsp?id=3397>.

90. See Act 20 at art. 1 (stating that this registration and promotion system aims to guarantee social justice for indigenous cultures).

91. See WIPO COMPARATIVE TABLE, *supra* note 75, at 5-7 (listing the additional requirements of the Panama model: must be based upon tradition, must fit within the classification system established by Article 3 of the Decree, and must be "collective").

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used in commerce, as is often the case among Native Hawaiians.<sup>92</sup> The Panama model confers rights similar to other models: the right of exclusion, the right to use in commercialization and reproduction, and the right to prevent third-party usage.<sup>93</sup> However, the Panama model lacks flexibility in ownership of the rights by only allowing for collective ownership, ruling out protection for individual artists.<sup>94</sup> Allowing only for communal ownership does not provide the flexibility that individual artists seeking protection for their TCEs need, as is the case in Hawaii.<sup>95</sup> The Panama model, in which the collective indigenous community functions as if it were a single owner, does not offer protection to smaller collectives of artists or individual artists.<sup>96</sup>

## B. Current National Solutions Fail to Offer Ideas to Native Hawaiians

The potential legal solutions present seemingly promising solutions to Native Hawaiians in their pursuit of TCE protection. Unfortunately, none of these federal programs are available to Native Hawaiians because Native Hawaiians do not qualify as a federally recognized tribe.<sup>97</sup> Native Hawaiians are not listed under the 564 tribal entities that are federally recognized and eligible to receive funding and services from the Bureau of Indian Affairs.<sup>98</sup> The Akaka bill seeks to address this inequality; however, even if the Akaka bill passes, none of the federally-funded options provide workable solutions for the Native

Hawaiian context.<sup>99</sup> Rather, it is the state trademark program from Alaska which offers the best example of indigenous intellectual property rights protection to Native Hawaii.<sup>100</sup> United States federal law, including the Lanham Act, the Native American Insignia Database, and the IACA, will not work for the Native Hawaiian context.

### 1. *Current Federal Statutes and Programs Place Too Much of a Burden on the Indigenous Population to Protect Traditional Cultural Expressions*

The following subsections identify the shortcomings in current federal statutes and programs for protecting TCEs, concluding that current United States federal law places too high a burden on Indigenous populations to protect their own TCEs.

#### a. *The Lanham Act is Inadequate Because Its Commercial Focus Does Not Address the Specific Needs of Native Hawaiians*

The Lanham Act requires that a trademark be used in commerce to qualify for registration.<sup>101</sup> Emphasizing only commercial use of a trademark does not address the Native Hawaiian's desire to have a specifically cultural trademark, with a dual focus of protecting TCEs in commerce and also preserving traditional Native Hawaiian culture.<sup>102</sup> Additionally, the Lanham Act provides no answer to the issue of communal ownership.<sup>103</sup> Further, the Act places a heavy burden on Native Americans to defend their TCEs, which is demonstrated by the real-world operation of both the Native American Tribal Insignia Database and section 1052(a), the disparaging mark section, of the Lanham Act.<sup>104</sup>

92. See Decl. of Mapuana De Silva at ¶¶ 18, 19 *Reece v. Island Treasures Art Gallery, Inc.*, 468 F. Supp. 2d 1197 (D.Hawaii 2006) (No. 06CV00489), 2007 WL 6344621 (remarking that hula is not meant to be recorded or photographed for teaching purposes, that hula is meant to be passed down orally).

93. See Act 20 at arts. 2, 15, 20 (explaining that the authority to grant third-party usage rests exclusively with the indigenous peoples).

94. See Executive Decree No. 12 at arts. 5-6 (making no mention of the potential for individual as well as communal ownership).

95. See STUDY, *supra* note 18, at 12-16 (surveying individual artists about their intellectual property needs).

96. See Act 20 at art. 16 (explaining that general congresses, or traditional authorities, of a community are treated as the owner of the rights and the congress creates rules as a single unit regarding regulation of the rights).

97. See STUDY, *supra* note 18, at 33 (explaining that, unlike other states, which can recognize state tribes, Hawaii does not have state tribal recognition powers, because it is not within the continental United States).

98. See Indian Entities Recognized and Eligible To Receive Services From the United States Bureau of Indian Affairs, 75 Fed. Reg. 60,810 (Oct. 1, 2010), available at <http://www.bia.gov/idc/groups/xraca/documents/text/idc011463.pdf> (listing a separate section that includes native entities within the state of Alaska eligible to receive services from the U.S. Bureau of Indian Affairs).

99. See STUDY, *supra* note 18, at 17 (pointing out the problems that Native American have had with over-reliance on federal government programs).

100. See ALASKA ADMIN. CODE tit. 3, § 58.020 (2010) (outlining the basic components of the Alaska Silver Hand program under state trademark law).

101. See 15 U.S.C. § 1051(a)(2) (2010) (requiring the applicant include the date of first use of the mark in commerce and the goods in connection with which the mark is used, in addition to a drawing of the mark).

102. See STUDY, *supra* note 18, at 9 (expressing that a cultural trademark program would provide public recognition of master Native Hawaiian artists and therefore preserve cultural traditions by encouraging teaching and mentoring of new generations of Native Hawaiian artists).

103. See § 1051(a) (referring only to applicants in terms of a singular "person" or "owner" of the trademark).

104. See *Native American Tribal Insignia Database—FAQs*, *supra* note 27 (requiring that Native Americans arrange to have their insignia submitted to the database).

*i. The Native American Tribal Insignia Database is Insufficient Because the Database Confers No Legal Rights Akin to Intellectual Property Rights*

The Native American Tribal Insignia Database is a passive stance to protection of indigenous culture on the part of the federal government. First, the Native American Tribal Insignia Database places the burden for protection on Native Americans by requiring Native Americans to register their tribal insignia with the government.<sup>105</sup> Second and more importantly, the Database confers no legal rights to the registration of an insignia.<sup>106</sup> It explicitly states that registration does not provide any positive legal rights, such as the right to bring an infringement claim or to exclusive use of the insignia, as would be the rights under a trademark registration.<sup>107</sup>

*ii. The IACA is Inadequate to Address the Needs of Native Hawaiians Because it Only Creates a False Attribution Cause of Action that Native Hawaiians Do Not Qualify to Use*

The IACA is not applicable to Native Hawaiians, but would also not be a good source from which to borrow concepts for protecting TCEs because the IACA only addresses inauthentic marketing of goods claiming to be Indian-made. It attempts to address a hole in the Lanham Act for Native Americans' ability to protect their TCEs by offering a cause of action for false attribution.<sup>108</sup> However, the right to bring a false attribution claim only gives a cause of action against people who falsely attribute their work to a source, and does not grant separate affirmative rights to the TCE in question.<sup>109</sup> In contrast, intellectual property law offers the right to exclusive use and the right to bring a claim for infringement, which the

105. See *id.* (listing the following requirements to registration: a written request, depiction of the insignia at or near the center of 8.5x11 paper, the name and address of the tribe for correspondence purposes, a copy of the tribal resolution adopting the depiction as the official insignia, and a signed statement by an official with authority to bind the tribe).

106. See *id.* (stating explicitly the database is merely a tool to aid the USPTO examiners in evaluating new trademark applications).

107. Compare *id.* (stating that registration with database does not confer any positive legal rights), with 15 U.S.C. §1114 (2010) (listing the private causes of action available to an owner of a registered trademark against third-party infringement, as well as available remedies).

108. See 25 U.S.C. § 305e (2010) (explaining what parties may bring a cause of action, the availability and limits on damages, and what a party must establish to prevail in a cause of action).

109. See § 305e (granting no affirmative rights to contesting parties).

IACA does not.<sup>110</sup> The IACA does not stop a third party from copying the design of a Native American and then selling it, so long as it is not labeled in any way that would indicate that it is "Indian-made."<sup>111</sup> In addition to not addressing the limited rights the IACA confers on Native Americans, it also does not address the main concern of Senate Report 452: mass-productions of Indian-imitation products undercutting the legitimate, authentic Indian-made market.<sup>112</sup> The IACA is only a regulation on the labeling of products, an issue often brought up in the IACA suits.<sup>113</sup> The complete absence of any successful prosecutions under IACA demonstrates that the legislation has been an unsuccessful solution for Native Americans, and therefore not a solution from which Native Hawaiians should borrow.<sup>114</sup> The recent case of *Native American Arts, Inc. v. Contract Specialties, Inc.*, may offer some new potential for Native Americans implementing the IACA to protect their TCEs, but the limited rights and singular cause of action available under the IACA will not meet the needs of Native Hawaiians.<sup>115</sup>

*b. The Lanham Act Litigation Demonstrates That the Indigenous Populations Have Not Been Able to Use the Disparaging Mark Cause of Action as a Means to Protect Traditional Cultural Expressions*

Although the text of section 1052(a) of the Lanham Act seems to offer promise to indigenous peoples, the way courts have applied the section as seen in *Pro-Football, Inc.*, operates as a kind of passive aid on the part of the federal government.<sup>116</sup> In *Pro-*

110. Compare 15 U.S.C. §1114 (2010) (listing causes of action available to an owner of a registered trademark against third-party infringement), with § 305e(b) (allowing only an action to be brought against a person who sells a product and "falsely suggests it is Indian produced").

111. See § 305e(b) (listing no other available causes of actions).

112. See S. REP. NO. 106-452, at \*2 (2000) (arguing that mass-production of imitation arts and crafts at a fraction of the cost has required traditional Indian artists to either reduce their prices and profit margin, or retire).

113. See *Native American Arts, Inc. v. Contract Specialties, Inc.*, 754 F. Supp. 2d 386, at 388 (D. Rhode Island 2010) (describing the IACA as a truth-in-advertising statute aimed at preventing counterfeit products).

114. See S. REP. NO. 106-452, at \*3 (stating there has never been a successful civil or criminal suit under the IACA); see also H.R. REP. NO. 111-397, at 1 (2010) (describing that the continually low amount of cases actually investigated under IACA prompted Congress to implement amendments to the Act).

115. See *Native American Arts, Inc.*, 754 F. Supp. 2d, at 387 (denying defendant's motion to dismiss, allowing case to proceed forward on the merits).

116. See *Pro-Football, Inc. v. Harjo* 284 F. Supp. 2d 96, 99 (D.C. 2003) (avoiding the public policy implications of the case

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*Football, Inc.*, the defendant Native Americans lost on cross-motions for summary judgment for two reasons.<sup>117</sup> First, the court questioned whether the aggregate number of Native Americans would find the Washington Redskins' trademarks offensive or disparaging.<sup>118</sup> The court reasoned that although the term "redskins" is a derogatory term to refer to Native Americans, that mere use of the word by a professional football team in various trademarks does not mean that the trademarks are offensive.<sup>119</sup> The court's logic separates the everyday use of a disparaging word from the use of the same disparaging word in a registered trademark, even though the latter would seem to be more offensive since registration is an implicit endorsement of the disparaging word by the federal government.<sup>120</sup>

The second reason the Native Americans lost the motion for summary judgment was because of the doctrine of laches, the delayed bringing of a claim.<sup>121</sup> The court incorrectly infers that because Native Americans did not bring a claim when the marks were first registered in the 1960s, Native Americans must not have been truly offended by the trademarks, ignoring that perhaps Native Americans lacked the legal and financial resources to bring such claims.<sup>122</sup> This ruling suggests that even if a mark is deemed offensive or disparaging, a court will not order cancellation of the trademarks if the claim is brought several years after the mark is used in commerce.<sup>123</sup> The court's emphasis on

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and focusing on the narrow issue of reviewing the TTAB's decision and the laches defense).

117. *See id.* at 145 (stating that although this is "undoubtedly a 'test case' that seeks to use federal trademark litigation to obtain social goals. . . . By waiting so long to exercise their rights, Defendants make it difficult for any fact-finder to affirmatively state that in 1967 the trademarks were disparaging.>").

118. *See id.* at 121, 122 (pointing to the fact that the survey on which TTAB based its opinion used surveyed only twelve states and this could not be representative of the majority opinion of Native Americans).

119. *See id.* at 133 (deciding that the derogatory connotation of the word does not extend to the use of the term "redskins" in connection with Pro-Football's entertainment services).

120. *See id.* at 124 (explaining the meaning of the word "disparaging" takes the ordinary meaning, which is that the mark may "dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison").

121. *See id.* at 140 (pointing out that plaintiffs had known about the Redskins trademarks for at least a decade each and had not brought a claim in a timely fashion); *see also id.* at 136 (stating that in trademark, a laches defense is used to argue that the plaintiff "fumbled away its trademark rights through inattention").

122. *See id.* at 140 (stating that the court's finding of laches correlates with the court's findings that the TTAB's decision did not meet evidentiary standards).

123. *See id.* at 139 (reasoning that it would be both inequitable and undermine the place of trademark in the free market economy to allow Pro-Football's trademarks to be subject to

timing of a claim requires Native Americans to monitor forthcoming applications to ensure that offensive or disparaging marks are not registered.<sup>124</sup> Overall, the burden the Lanham Act places on indigenous peoples to bring a claim is too high for such people to successfully pursue a claim.

### c. *The Gee's Bend Solution is a Small-Scale Solution Entirely Dependent on Private Funding and Will Not Work for the Large and Diverse Native Hawaiian Population*

The Gee's Bend Quilters solution demonstrates how a tailor-made program for protection of TCEs, specific to the needs of the group involved, works well, although it is an inappropriate model for Native Hawaiians.<sup>125</sup> The success of the Gee's Bend solution is dependent on the fact that a private actor had both a genuine interest in promoting the quilters' cultural arts and the financial ability to do so.<sup>126</sup> The solution works in a very small-scale, close-knit community, and depends entirely on private funding.<sup>127</sup> This small-scale, privately-funded solution is not a realistic possibility for an entire population of native peoples, such as Native Hawaii, encompassing numerous art forms and numerous island communities.<sup>128</sup>

Native Hawaiians should not borrow from the currently available national solutions because they are either not narrowly tailored enough to the address the needs of Native Hawaiians, or Native Hawaiians do not have legal access to the solutions.

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attack at any point after registration).

124. *See id.* at 122 (demonstrating that the burden of proving that a mark is disparaging rests on the party seeking cancellation).

125. *See Phillips, supra* note 46, at 376 (noting how the partnership with Tinwood Alliance has allowed an ongoing dialogue of the needs of the quilters and their community).

126. *See id.* at 365-66 (describing the relationship between the well-connected art scholar, William Arnett, and the Gee's Bend Quilters as collaborative in nature, and based on Arnett's genuine desire to promote the quilts as forms of artistic expression, rather than exploit the quilts through cheap imitations).

127. *See id.* at 359, 370 (explaining how the profits of the Tinwood Ventures licensing activities are reinvested in the Gee's Bend Community, a remote bend on the Alabama River).

128. *See STUDY, supra* note 18, at 26 (describing the Native Hawaiian community as diverse and spread out over the islands of Hawaii, requiring a solution with more flexibility).

### C. The Toi Iho Program in New Zealand and the Alaska Silver Hand Program Contain Elements that Best Address the Unique Needs of Native Hawaiians Seeking a Cultural Trademark Program

The following subsections identify workable elements from The toi iho program of New Zealand and the Alaska Silver Hand Program that would be beneficial to the Native Hawaiian context.

#### 1. *The Toi Iho Program in New Zealand is the Best International Model for Native Hawaiians to Borrow From for Their Own Model*

Native Hawaiians should borrow heavily from New Zealand's toi iho program because The toi iho program allows for indigenous self-determination, flexible ownership options, and art standards based on quality of art rather than ethnicity of the artist.<sup>129</sup> The program sets itself apart from other models through its emphasis on a high-level quality of artwork.<sup>130</sup> The two goals articulated by the program are to "maintain the integrity of the Māori art culture" and "promote Māori art and artists nationally and internationally."<sup>131</sup> The dual goals of the Māori program protect all forms of traditional cultural expression by protecting those forms of art that enter the marketplace, as well as preserving those forms of art that are not meant for commercial uses.<sup>132</sup> The program is able to maintain its high standards of quality by requiring artists to register annually to continue to use The toi iho trademark.<sup>133</sup>

There are three main reasons The toi iho program

has achieved greater success than other models and should be used as a guide for the Native Hawaiian context. First, the program is based on the right of indigenous peoples' to self-determination.<sup>134</sup> The rules of The toi iho program name the Te Waka Toi as the guardians of the marks, and that this indigenous council will administer the rules of the program.<sup>135</sup> The implementation and administration of The toi iho program acknowledges that indigenous peoples often need government funding to get such a program started, but also that indigenous people have the right to run the program autonomously in accordance with their cultural traditions.<sup>136</sup>

The second reason for the success of The toi iho program is the program's focus on the quality of artwork it certifies, rather than the ethnicity of the artist.<sup>137</sup> The focus on quality rather than ethnicity keeps the mark from becoming diluted through usage on common or low-quality products and prevents the "potentially divisive system of registering persons as being of Māori descent or blood quantum."<sup>138</sup>

Finally, The toi iho program's flexibility addresses the modern reality that artists often collaborate and create art in collective form.<sup>139</sup> The toi iho program contains three different trademarks to ensure flexibility in ownership: Māori Made, Mainly Māori, and Māori Co-Production.<sup>140</sup> The variety of cultural trademarks available to artists acknowledges that Māori artists may collaborate with non-Māoris and still create works of authentic Māori expression, thereby allowing

134. See *id.* (stating that the indigenous peoples are the guardians of the trademarks and responsible for administration of the rules and the program).

135. See *id.*; see generally The Arts Council of New Zealand Toi Aotearoa Act 1994 No 19 §§ 13, 14(1)(e)-(i) (2009) [http://www.legislation.govt.nz/act/public/1994/0019/latest/whole.html?search=ts\\_act\\_Education\\_resel](http://www.legislation.govt.nz/act/public/1994/0019/latest/whole.html?search=ts_act_Education_resel) (creating the Te Waka Toi and stating they are responsible for administering all aspects of funding and guidelines for Māori arts).

136. See *STUDY*, *supra* note 18, at 28 (describing the amount of funding given to Māori arts programs but also that Māoris are given leading positions in the arts programs).

137. See *MĀORI MADE RULES*, *supra* note 129, at 4 (requiring that the artwork be a work of high quality in addition to proving Māori descent of artist).

138. See *STUDY*, *supra* note 18, at 29 (arguing that programs based on ethnicity of the artist are unsuccessful because poor-quality works dilute the distinctiveness of a cultural trademark).

139. See *id.* at 31 (arguing that the success of The toi iho program is aided by the fact that it does not isolate itself within the Māori community, but enlists support from the broader non-native public including art vendors, purchasers, and non-native artists).

140. See *toi iho > About us*, *supra* note 77 (reserving Māori made for artists of proven Māori descent, Mainly Māori for use by a group of artists, most of whom are of Māori descent, and Māori Co-Production for use by collaborations between Māori and non-Māori artists).

129. See THE ARTS COUNCIL OF NEW ZEALAND TOI AOTEAROA, RULES GOVERNING THE USE BY ARTISTS OF THE TOI IHO MĀORI MADE MARK, 1 (Nov. 4, 2009), <http://www.toiiho.com/Apply/Rules/tabid/273/Default.aspx> [hereinafter *MĀORI MADE RULES*] (describing the fundamentals of The toi iho program). But see TOI IHO (Nov. 14, 2011), <http://toiiho.blogspot.com/> (The New Zealand government divested funding of the toi iho program in 2009 and the program is currently in a state of transition to a new, Māori-controlled entity: TIKI- Toi iho Kaitiaki Incorporated Trust. TIKI is currently rebuilding the database of Māori artists and expects to have an update website in the near future.).

130. See *STUDY*, *supra* note 18, at 29 (comparing The toi iho program to less successful models in which certification is based on ethnicity of the artist).

131. *MĀORI MADE RULES*, *supra* note 129, at 1 (administering these two goals will include the maintenance of a registry of artists currently using any toi iho marks); see also RULES GOVERNING THE USE BY ARTISTS OF THE TOI IHO MAINLY MĀORI MARK, THE ARTS COUNCIL OF NEW ZEALAND TOI AOTEAROA (Nov. 4, 2009), <http://www.toiiho.com/Apply/Rules/tabid/273/Default.aspx>.

132. See *MĀORI MADE RULES*, *supra* note 129, at 2 (protecting artwork in electronic form or other media, as well as performance art in either live, electronic form, or other media).

133. See *id.* at 1 (requiring that the artist(s) continue to create quality works of authentic Māori expression).

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performance art, and other group-oriented cultural arts, protection within the program.<sup>141</sup>

The *toi iho* program allows the Māori the right to self-determination because the Māori set the standards of quality.<sup>142</sup> The *toi iho* program also allows for great flexibility through the use of several trademarks to protect all varieties of indigenous cultural expressions.<sup>143</sup> Finally, the program's focus on quality, rather than ethnicity, addresses the reality of diversity and fluidity in cultural heritage.

Given the popularity and success of the program, it came as a shock to many Māori when, in 2009, the New Zealand government cut funding for The *toi iho* program, stating that the program had not delivered the financial benefits to indigenous artists it had originally hoped for.<sup>144</sup> The New Zealand government stated that many Māori artists were receiving high recognition and sales for their artwork without the need of The *toi iho* trademark.<sup>145</sup> Despite the official statement by the New Zealand government that The *toi iho* program was not successful, Māori artists were outraged at the government's decision to cut funding and demanded the government transfer the program to Transition Toi Iho Foundation (TTIF), a group comprised of *toi iho* artists.<sup>146</sup> The overwhelming response from Māori after the government's announcement, and subsequent reclamation of the program, demonstrates that this program not only plays a critical role in the preservation and protection of indigenous art in New Zealand, but is also a source of cultural pride and

identity for the Māori.<sup>147</sup>

## 2. *The Alaska Silver Hand Program is the Best Current National Solution and Contains Key Structural Elements to Borrow When Developing a Solution for the Native Hawaiian Context*

The Alaska Silver Hand Program is a state trademark law that issues renewable identification seals to Native Alaskan artists to verify that their works of art are authentic, original, and made in the state of Alaska, and is the most appropriate national model for Native Hawaiians to borrow from.<sup>148</sup> The benefit of utilizing a state trademark program is that garnering state support for such a program is easier than attempting to get federal support.<sup>149</sup> The Alaska model is structured well, but the ways in which these structural aspects have been implemented present some problems.

The structural aspects of the Alaska model that stand out include the way the program is funded, the use of a state arts council to administer the program, and the mandatory renewal process for use of the identification seals.<sup>150</sup> The program is self-funded with application fees to offset costs, which addresses the difficulty of gaining sufficient government funding.<sup>151</sup> However, starting a brand new program, as would be the case in Hawaii, would require initial government funding before the program could self-fund through application fees.<sup>152</sup> The use of a state arts council to administer the program provides implicit government support and keeps the use of the trademarks centralized and regulated.<sup>153</sup> The Alaska State Council on the

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141. See MĀORI MADE RULES, *supra* note 129, at 2 (defining performance as any artistic presentation performed live, or reproduced in electronic form or other media).

142. See *id.* at 4 (granting and renewing of licenses to use the marks requires approval by a panel of persons with special knowledge of Māori artforms).

143. See *toi iho > About us*, *supra* note 77 (providing for four different trademarks to choose from, depending on the applicant).

144. See *Creative New Zealand statement on disinvestment in toi iho*, CREATIVENZ.GOV.TZ.NZ, <http://www.creativenz.govt.nz/en/news/creative-new-zealand-statement-on-toi-iho> (last visited Nov. 14, 2011) (stating that while the ideas behind The *toi iho* brand have remained important, the program has not met the goals of increasing sale of Māori art).

145. See *id.* (explaining that for many artists, "the quality of their work speaks for itself" and that artists have not needed the use of the trademark to the extent originally thought).

146. See *Māori Reclaim Toi Iho Trade Mark*, VOXY.CO.NZ (Dec. 15, 2009), <http://www.voxy.co.nz/national/maori-reclaim-toi-iho-trade-mark/5/33358> (reporting that outrage followed the announcement that New Zealand government planned to "disinvest" in The *toi iho* program); see also *Creative NZ agrees to transfer Māori Trademark – toi iho*, THE BIG IDEA – TE ARIA NUI (May 27, 2010), <http://www.thebigidea.co.nz/news/industry-news/2010/may/70176-creative-nz-agrees-to-transfer-maori-trademark-toi-iho> (describing the formalities of the transfer from the New Zealand government to the TTIF and expecting the transition to be complete by June 2010).

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147. See *Māori Reclaim Toi Iho Trade Mark*, *supra* note 146 (disagreeing with the government's assessment that the program has been unsuccessful, reporting that artists feel that the program has been very successful and a source of pride and cultural identity).

148. See *Alaska State Council on the Arts Silver Hand Program & Permit Application*, ALASKA STATE COUNCIL ON THE ARTS (AKASCA), <http://www.eed.state.ak.us/aksca/Forms/individuals/SI.pdf> (last visited Jan. 25, 2011) (explaining the operation of the program and instructions for a permit).

149. See *STUDY*, *supra* note 18, at 11 (determining that trying to get federal support for a program to benefit Native Hawaiians would require too much time and too many resources).

150. See ALASKA ADMIN. CODE tit. 3, § 58.020(a)-(d) (2010) (stating the requirements for certification under the program).

151. See *Time Line Silver Hand*, *supra* note 43 (implementing a small twenty dollar fee for a two year permit to solve funding issues).

152. See *Panel Discussions*, KEOMAILANI HANAPI FOUNDATION, [http://www.khfnativehawaiianarts.com/PDF/2004\\_Panel\\_Hawaiian\\_Art\\_Transcript.pdf](http://www.khfnativehawaiianarts.com/PDF/2004_Panel_Hawaiian_Art_Transcript.pdf) (pointing out that government funding has allowed cultural trademark programs in other countries to get off the ground).

153. See *Alaska State Council on the Arts Silver Hand Program & Permit Application*, *supra* note 148 (providing all arts education, development, and services under one state agency ensures that there

Arts is the agency that runs the Silver Hand program and issues permits to use the identification seals, and the governor appoints members of this council.<sup>154</sup> However, there are no requirements that Native Alaskan artists sit on the council, and consequently, those issuing identification seals for native artwork are not necessarily knowledgeable about Native Alaskan art.<sup>155</sup> Additionally, although the mandatory renewal process seems to keep the use of identification seals current, the renewal period does not require artists to demonstrate that they are still making authentic works of art.<sup>156</sup> The permits are also based on membership in an Alaskan tribe rather than the quality of the work, which could lead to dilution of the Silver Hand trademark.<sup>157</sup>

#### D. Combining Elements from Both the Alaska Model and the New Zealand Model Creates a Custom Solution to Address the Unique Needs of the Native Hawaiian Context

Native Hawaiians favor the use of a cultural trademark program in order to protect and promote the Native Hawaiian cultural arts, and the best solution will consider the unique needs of the Native Hawaiian context and create a tailor made cultural trademark program.<sup>158</sup> This article proposes a solution entitled the New Hawaiian model, which combines elements of both the Alaska model and the New Zealand model. Combining elements of these two successful programs will give Native Hawaiians a critical tool to use in protecting and preserving the Native Hawaiian cultural arts.<sup>159</sup> The New Hawaiian model is a state trademark

is no confusion for artists and consumers).

154. See *AKASCA – Mission and History*, AKASCA, <http://www.eed.state.ak.us/aksca/about.htm> (last visited Jan. 25, 2011) (defining the council's missions to foster "the development of the arts for all Alaskans through education, partnerships, grants and services").

155. See *AKASCA – Council Members*, AKASCA, <http://www.eed.state.ak.us/aksca/about3.htm> (last visited Jan. 25, 2011) (stating that the council is made up of eleven volunteer members all serving staggered three-year terms).

156. See ALASKA ADMIN. CODE tit. 3, § 58.020(d) (2010) (listing the only criteria for renewal as submission of a renewal application within thirty days of the end of the two-year permit period).

157. See tit. 3, § 58.020(c)(1)-(3) (requiring only that applicant is certified Alaskan Native and living in the state of Alaska); see also *STUDY*, *supra* note 17, at 29 (using the Australia model as an example of how programs based on ethnicity rather than quality will fail).

158. See *STUDY*, *supra* note 18, at 43 (confirming that the Native Hawaiian community favors implementation of a cultural trademark program in Hawaii).

159. See *id.* at 40 (arguing that the similar worldviews of Native Hawaiians and the Māori facilitates borrowing from the Māori example).

program which emphasizes self-determination for Native Hawaiians through the use of a Native Hawaiian arts council, focuses on quality of art over ethnicity to prevent dilution of the trademark, and allows flexibility in ownership and in trademark use.

The New Hawaiian model would fit under Hawaiian state trademark law, much like the Alaska Silver Hand program.<sup>160</sup> As the Alaska model demonstrates, it is easier to initiate a cultural trademark program in the state legislature where the needs of local indigenous peoples are better understood and supported.<sup>161</sup> Native Hawaiians understand how difficult it is to have federal legislators consider the unique circumstances of Native Hawaiians.<sup>162</sup> The Office of Hawaiian Affairs already supports the plight of Native Hawaiian artists, and funding would be more readily available from the Hawaiian state government than the federal government.<sup>163</sup> Despite this initial government funding, the New Hawaiian model, like the New Zealand model, would be administered by an indigenous peoples' arts council after the initial phases of the program.<sup>164</sup> Native Hawaiian artists advocate limited government involvement in the administration and regulation of a cultural trademark program but also understand that government funding is a necessary tool to initiate the program.<sup>165</sup> Providing for administration and regulation of the program by a Native Hawaiian arts council would ensure that Native Hawaiians are assured the right of self-determination over the protection and preservation of traditional culture.<sup>166</sup>

The New Hawaiian model borrows from both the Alaska model and the New Zealand model regarding the requirements for certification to use the cultural

160. See ALASKA STAT. § 45.65.010(a) (2010) (protecting certain articles created or crafted in the state by Alaska Native persons, but does not preempt federal trademark law).

161. See *STUDY*, *supra* note 18, at 11 (arguing that the difficulty with getting support for the Akaka bill demonstrates that national support would be tough to get).

162. See *id.* at 11, 15 (citing that a majority of artists surveyed supported the idea of state funding of the cultural trademark program).

163. See *id.* at 5 (demonstrating state legislature support for the program supports through formal adoption of Paoakalani Declaration and funding of OHA study).

164. See *id.* at 40 (supporting transfer of administration of the cultural trademark program to an organization to be entitled the "Native Hawaiian Cultural Arts Board").

165. See *id.* at 11; see also *Panel Discussions*, *supra* note 152, at 11 (speaking about money, panelist Meleanna Meyer stated "it's a necessary tool to allow us to do what we want to do").

166. See *STUDY*, *supra* note 18, at 40 (arguing that a Native Hawaiian cultural arts council will be able to have powers far beyond implementation of the trademark program to include protecting heritage treasures, developing and recognizing emerging artists, promoting native arts education, and developing new markets).

# THE NEW HAWAIIAN MODEL

trademark.<sup>167</sup> It would require artists to be residents of Hawaii to receive permission to use the trademark, similar to the residency requirements under the Alaska model.<sup>168</sup> Imitation products sold in the Hawaiian tourism industry have a profoundly detrimental effect on the authentic Native Hawaiian arts market, and requiring that those who use the cultural trademark be residents of Hawaii provides an extra layer of protection against imported fakes in the tourism market.<sup>169</sup> The Study stated that a cultural trademark program should identify native artworks that reflect a "cultural truth," demonstrating that, for Native Hawaiians, it is more important for an artist to understand the Native Hawaiian cultural experience and traditional arts than prove pure blood quantum.<sup>170</sup> This emphasis on an artist's understanding of cultural truth combined with the proven success of the New Zealand model demonstrates that certification should be based on works of quality, rather than ethnicity.<sup>171</sup> Borrowing from the New Zealand model, the standards of quality should be determined by a set of well-known and well-respected master artists.<sup>172</sup> Distinguishing works of art based on quality rather than the ethnicity of the artist is particularly important for any program implemented under United States law, where a program that discriminated based on ethnicity would likely be deemed unconstitutional.<sup>173</sup>

The New Hawaiian model would borrow the flexibility of ownership of the New Zealand model and the periodic renewal requirements from the Alaska

model. It would employ several trademarks to allow artists to collaborate with non-Native artists.<sup>174</sup> The success of the New Zealand program has largely been because the program gives native artists the choice to collaborate with non-native artists and still create works of traditional cultural expression.<sup>175</sup> The New Hawaiian model borrows the two-year renewal requirement from the Alaska program, and would require artists to provide examples of quality works they have recently produced in order to qualify for re-certification.<sup>176</sup> Periodic renewal of the trademarks would ensure that artists are preserving the high-quality standards of the trademark and still producing works of authentic cultural expression to represent Native Hawaiian cultural arts.

## IV. CONCLUSION

The New Hawaiian model is an important step in the preservation and protection of Native Hawaiian culture, and would give Native Hawaiian artists a way to distinguish their authentic works of art from cheaper imitations in marketplace while simultaneously elevating the status of Native Hawaiian cultural arts.<sup>177</sup> However, the New Hawaiian solution does not provide answers to every example of cultural misappropriation; it would not stop Disney from copyrighting mele inoa, and it would not prevent Dodge from misusing Hawaiian words in car names. However, given the conclusion in the Study, the New Hawaiian model presents a uniquely tailored solution that would align with the Native Hawaiian artists' desire to implement a cultural trademark.<sup>178</sup> Although a cultural trademark program is only an incremental step toward protecting native culture, it is an important step nonetheless.<sup>179</sup> Furthermore, placing administration of the program in the hands of Native Hawaiians will give them the power and resources to expand into other areas

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167. See generally STUDY, *supra* note 18, at 41 (stating that the trademark should be a newly created and visually distinctive design that embodies the cultural essence of Native Hawaiians).

168. See *Alaska State Council on the Arts Silver Hand Program & Permit Application*, *supra* note 148 (requiring proof of residency through current photo I.D.).

169. See STUDY, *supra* note 18, at 38-39 (suggesting the cultural trademark's use in tourism industry will help weed out fakes and imitations while simultaneously emphasizing authentic expressions of native culture with tourists).

170. See *id.* at 8 (commenting on the perspective of Native Hawaiians that "they do not think of the race or racial content of a person as defining the person's standing in Native Hawaiian culture. It is a matrix of genealogy, kinship to indigenous families, cultural lineage, and the source(s) of a person's cultural knowledge rather than race that Native Hawaiian artists believe is important").

171. See *id.* at 29 (arguing that focusing on quality rather than ethnicity is more consistent and effective for achieving the goal of distinguishing imitation artwork from authentic artwork).

172. See MÄORI MADE RULES, *supra* note 129, at 4 (establishing that the panel in charge of artistic standards will be made up of "persons who Creative New Zealand considers have specialist knowledge of Mäori artforms").

173. See STUDY, *supra* note 18, at 34-35 (pointing out that it is not illegal for a trademark to be associated with a particular ethnic or racial group but that in order to receive any government funding, there can be no racial discrimination).

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174. See *toi iho > About us*, *supra* note 77 (listing the variety of marks available and the purpose behind each mark).

175. See *id.* (allowing retailers and gallery owners to use a mark to show that they are an official vendor of authentic art).

176. See MÄORI MADE RULES, *supra* note 129, at 4 (requiring artist to demonstrate continual artistry upon submitting renewal application).

177. See STUDY, *supra* note 18, at 29 (noting that The *toi iho* program has not only been able to distinguish authenticity in the marketplace but also establish a reputation for excellence in the arts).

178. See *id.* at 3 (concluding that a cultural trademark program would greatly benefit Native Hawaiian cultural arts).

179. See *id.* at 17 (referring to the statement of Maui Solomon, a Mäori lawyer invited to the cultural trademark conference because of his involvement with The *toi iho* program, that a cultural trademark program is an important step in building the "cultural capacity" of indigenous peoples to demand and shape their intellectual property rights).

in need of solutions, such as native arts education and protection of traditional knowledge from bioprospecting.<sup>180</sup> The New Hawaiian solution is an incremental step in what should be a larger dialogue in Hawaii of creating customized solutions to protect indigenous intellectual property rights and preserve Native Hawaiian culture.

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180. *See id.* at 17, 18 (describing a cultural trademark program as producing a “ripple effect” that would empower Native Hawaiians “to develop the capability to exercise sovereignty over culture”).

# **New Zealand: Māori Culture and Intellectual Property Law**

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## NEW ZEALAND

### MĀORI CULTURE AND INTELLECTUAL PROPERTY LAW

#### *Executive Summary*

*The protection of the traditional cultural expressions of indigenous people from inappropriate use raises issues relating to the differences between standard intellectual property concepts and the “worldview” of such groups. In New Zealand, Māori claims regarding rights to “guardianship” of their cultural knowledge have been expressed in the context of the guarantees in the Treaty of Waitangi. Some recognition of these interests can be seen in amendments to intellectual property laws. However, there remain questions regarding the protection of expressions of culture that are considered in the public domain, and that are used commercially and non-commercially in both the domestic and international settings.*

#### **I. Introduction**

Any discussion of Māori rights in the context of New Zealand law should begin with the Treaty of Waitangi. Signed in 1840 between representatives of the British Crown and 540 Māori chiefs, the Treaty is “the founding document of government in New Zealand.”<sup>1</sup> The Treaty’s preamble and three articles set out the principles upon which the British Crown was given the right to govern and develop British settlement in New Zealand, with Māori guaranteed full protection of their property rights as well as the rights and privileges of citizenship.<sup>2</sup>

Article 2 of the Treaty is of particular relevance in the context of intellectual property rights. There are some important differences in the wording of the English and Māori versions of this Article, both of which are considered to be official. The English version guaranteed Māori “full exclusive and undisturbed possession of their lands and estates, forests, fisheries and other properties which they may collectively or individually possess so long as it is their wish and desire to retain the same in their possession ....”<sup>3</sup> In comparison, the Māori version

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<sup>1</sup> Rt. Hon. Kenneth Keith, *On The Constitution of New Zealand: An Introduction to the Foundations of the Current Form of Government*, in CABINET MANUAL 2008, available at <http://cabinetmanual.cabinetoffice.govt.nz/node/68>.

<sup>2</sup> The Treaty of Waitangi 1840, arts. 2 & 4 (English), available at <http://www.nzhistory.net.nz/politics/treaty/read-the-treaty/english-text> and <http://www.waitangi-tribunal.govt.nz/treaty/english.asp>.

<sup>3</sup> *Id.* art. 2.

guarantees “tino rangatiratanga” (full authority or chieftainship) over all “taonga”<sup>4</sup> (treasures, which to Māori includes both the tangible and intangible, material and non-material<sup>5</sup>).

These and other differences in the two texts have been the source of much debate.<sup>6</sup> As a consequence, it is now common to refer to the intention, spirit, or “principles” of the Treaty. The principles of the Treaty can be seen as having emerged from the reports of the Waitangi Tribunal<sup>7</sup> and other sources and include “the principle of active protection, the tribal right to self-regulation, the right of redress for past breaches, and the duty to consult.”<sup>8</sup> Such “principles of the Treaty of Waitangi,” and the need to take these into account in government decision-making processes and other activities, are referred to in several Acts of Parliament.<sup>9</sup> Apart from these references, the Treaty itself has not been incorporated into New Zealand’s domestic law.

Given this context, this report discusses some of the issues and challenges in protecting cultural expressions and traditional knowledge in the law, and examines two examples of this in the context of the use of Māori cultural expressions. It also sets out the changes (or proposed changes) to New Zealand’s intellectual property legislation that seeks to enable Māori concerns and concepts to be taken into account through a consultative process. Further changes to the law

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<sup>4</sup> The Treaty of Waitangi 1840, art. 2 (Māori), available at <http://www.nzhistory.net.nz/politics/read-the-treaty/maori-text> and <http://www.waitangi-tribunal.govt.nz/treaty/maori.asp>.

<sup>5</sup> See Waitangi Tribunal, WAI 262 Statement of Issues 6 (July 2006), available at <http://www.waitangitribunal.govt.nz/doclibrary/public/wai262/SOI/Wai262SOI%28doc2.314%29small.pdf> In some reports, the Tribunal has noted that taonga means “all things highly prized by Māori,” which includes tangibles such as fishing grounds, and intangibles such as the Māori language and life force of a river. See, e.g., REPORT OF THE WAITANGI TRIBUNAL ON THE MOTONUI–WAITARA CLAIM 50 (Waitangi Tribunal, 2nd ed. 1989), available at <http://www.waitangi-tribunal.govt.nz/scripts/reports/reports/6/2BC95342-6426-48EF-A9CE-38F3C9027330.pdf>.

<sup>6</sup> See Differences Between the Texts, New Zealand History Online, <http://www.nzhistory.net.nz/politics/treaty/read-the-Treaty/differences-between-the-texts> (last visited Nov. 29, 2010).

<sup>7</sup> The Waitangi Tribunal was established in 1975 to investigate alleged breaches of the Treaty by the Crown. See Treaty of Waitangi Act 1975, s 5 (setting out the functions of the Waitangi Tribunal), available at <http://www.legislation.govt.nz/act/public/1975/0114/latest/DLM435368.html>.

<sup>8</sup> See Principles of the Treaty, The Waitangi Tribunal, <http://www.waitangi-tribunal.govt.nz/treaty/principles.asp> (last visited Nov. 29, 2010). Particular “principles” of the Treaty were set out in the judgment of Lord Cooke of Thorndon (then President of the New Zealand Court of Appeal) in *New Zealand Māori Council v Attorney-General* [1987] 1 NZLR 641. The judgment listed the principles as being: the acquisition of sovereignty in exchange for the protection of rangatiratanga, the establishment of a partnership, which imposes on the partners the duty to act reasonable and in good faith, the freedom of the Crown to govern, the Crown’s duty of active protection, the duty of the Crown to remedy past breaches, the maintenance of rangatiratanga by Maori over their resources and taonga, Maori to have the privileges of citizenship, and the duty to consult. Following this decision, in 1989, the Labour Government released a document entitled “Principles for Crown Action on the Treaty of Waitangi,” which listed and explained the principles of government, self-management, equality, reasonable cooperation, and redress. These principles, and those contained in Waitangi Tribunal reports and court decisions, are set out in Dr. Janine Hayward, *Appendix – The Principles of the Treaty of Waitangi*, in 2 ALAN WARD, NATIONAL OVERVIEW 493-94 (Waitangi Tribunal Rangahaua Whanui Series, 1997) available at <http://www.waitangi-tribunal.govt.nz/doclibrary/public/Appendix%2899%29.pdf>.

<sup>9</sup> See, e.g., Resource Management Act 1991, s 8; Climate Change Response Act 2002, s 3A; New Zealand Geographic Board (Ngā Pou Taunaha o Aotearoa) Act 2008, s 6; Education Act 1989, s 181; State-Owned Enterprises Act 1986, s 9; Local Government Act 2002, s 4.

are also likely to be considered in New Zealand following the release of the Tribunal's report on WAI 262, a major inquiry into claims regarding Māori rights relating to indigenous flora and fauna and cultural intellectual property, and the obligations of the Crown with respect to those rights.<sup>10</sup>

## II. Protecting Indigenous Cultural Expressions and Traditional Knowledge

Traditional cultural expressions, which include artwork, symbols, song, and dance, that “reflect and identify a community’s history, cultural and social identity, and values,”<sup>11</sup> can result in economic benefits to indigenous peoples. However, “they are also and perhaps more importantly, instrumental to the preservation and continuation of indigenous cultures.”<sup>12</sup>

The challenges of protecting the cultural and intellectual property rights of indigenous peoples, including their ability to benefit commercially from cultural expressions and traditional knowledge and prevent exploitation or inappropriate use, have generated considerable discussion over the years. The issues relate to the appropriateness and usefulness of various Anglo-American legal concepts, including those found in copyright, trademark, and patent laws in a number of countries, to protect knowledge, designs, or other expressions that have been passed down over the generations and which are considered to be owned collectively by a group.<sup>13</sup> Indigenous communities often have a holistic view of their traditional knowledge in terms of its connections with their history, environment, and artistic expressions.<sup>14</sup> For instance, it is noted that:

It is the holistic nature of TK [traditional knowledge] which makes it singularly difficult to analyse coherently and accommodate within traditional Anglo-American intellectual property systems. Imprecision, a quality in statute law generally abhorred by lawyers, tends to characterize TK. Furthermore, from the intellectual property law (particularly the patent law) perspective, there are handicaps, such as the tendency toward communal

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<sup>10</sup> See generally, *Flora and Fauna (Wai 262 Inquiry)*, WAITANGI TRIBUNAL, <http://www.waitangi-tribunal.govt.nz/inquiries/genericinquiries2/florafaua/> (last visited Nov. 29, 2010).

<sup>11</sup> WORLD INTELLECTUAL PROPERTY ORGANISATION, INTELLECTUAL PROPERTY AND TRADITIONAL CULTURAL EXPRESSIONS/FOLKLORE 5, available at [http://www.wipo.int/export/sites/www/freepublications/en/tk/913/wipo\\_pub\\_913.pdf](http://www.wipo.int/export/sites/www/freepublications/en/tk/913/wipo_pub_913.pdf).

<sup>12</sup> Mariaan deBeer, *Protecting Echoes of the Past: Intellectual Property and Expressions of Culture*, 12 CANTERLAWRW 94, 102 (2006), available at <http://www.nzlii.org/nz/journals/CanterLawRw/2006/4.html>.

<sup>13</sup> See PAUL SUMPTER, INTELLECTUAL PROPERTY LAW: PRINCIPLES AND PRACTICE 254-255 (2006).

<sup>14</sup> In New Zealand, reference to “mātauranga Māori” is used to describe the Maori body of knowledge in a broader, more holistic sense than perhaps the separate terms of “traditional knowledge” and “traditional cultural expressions.” See DR. CHARLES ROYAL, MĀTAURANGA MAORI AND MUSEUM PRACTICE (Ministry of Economic Development, 2004), available at [http://www.med.govt.nz/templates/MultipageDocumentTOC\\_688.aspx](http://www.med.govt.nz/templates/MultipageDocumentTOC_688.aspx); DAVID WILLIAMS, MĀTAURANGA MĀORI AND TAONGA. THE NATURE AND EXTENT OF TREATY RIGHTS HELD BY IWI AND HAPŪ IN INDIGENOUS FLORA AND FAUNA CULTURAL HERITAGE OBJECTS AND VALUED TRADITIONAL KNOWLEDGE (Waitangi Tribunal, 1997), available at <http://www.waitangi-tribunal.govt.nz/inquiries/genericinquiries2/florafaua/mtaurangamoriandtaonga.asp>; TE MANA TAUMARU MĀTAURANGA: INTELLECTUAL PROPERTY GUIDE FOR MĀORI ORGANISATIONS AND COMMUNITIES (Ministry of Economic Development, 2007), available at [http://www.med.govt.nz/templates/MultipageDocumentTOC\\_28180.aspx](http://www.med.govt.nz/templates/MultipageDocumentTOC_28180.aspx).

ownership and the fact that TK is often already in the public domain, suggesting that it is available for use by one and all.<sup>15</sup>

In essence, “fundamentally contrasting worldviews form the basis of European and indigenous expectations of the international intellectual property system.”<sup>16</sup> There are key differences in perspectives relating to the ownership of property, including intellectual property, and in defining the “value” of that property and the rewards that are or should be gained from its creation.<sup>17</sup> As a result, the requirements for conventional intellectual property protection, such as individual or identifiable authorship, originality, and time limits for protection, often cannot be met by indigenous peoples.<sup>18</sup>

The Māori people have been “vocal and active within the international indigenous struggle for intellectual property rights and protections.”<sup>19</sup> In fact, in the early 1990s, the First International Conference on the Cultural and Intellectual Property Rights of Indigenous Peoples was held in New Zealand and resulted in the Mataatua Declaration.<sup>20</sup> This declared that “Indigenous Peoples of the world have the right to self determination and in exercising that right must be recognised as the exclusive owners of their cultural and intellectual property.”<sup>21</sup> It went on to make recommendations to indigenous peoples regarding the development of policies and practices relating to protecting their intellectual and cultural property, as well as recommendations to governments and agencies, including the statement that “existing protection mechanisms are insufficient for the protection of Indigenous Peoples Cultural and Intellectual Property Rights.”<sup>22</sup> It recommended that intellectual property rights regimes incorporate collective ownership and origin, coverage of historical as well as contemporary works, protection against debasement of culturally significant items, and “multi-generational coverage span.”<sup>23</sup>

### III. Use of Māori Cultural Expressions

The use of Māori cultural expressions has become increasingly popular in recent years, including on the part of overseas companies and people,<sup>24</sup> and in New Zealand aspects of Māori

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<sup>15</sup> SUMPTER, *supra* note 13, at 259.

<sup>16</sup> deBeer, *supra* note 12, at 95.

<sup>17</sup> *Id.* at 96.

<sup>18</sup> *Id.* at 97.

<sup>19</sup> *Id.* at 111. See also SUMPTER, *supra* note 13, at 257.

<sup>20</sup> The Mataatua Declaration on Cultural and Intellectual Property Rights of Indigenous Peoples, First International Conference on the Cultural & Intellectual Property Rights of Indigenous Peoples (1993), available at [http://www.wipo.int/export/sites/www/tk/en/folklore/creative\\_heritage/docs/mataatua.pdf](http://www.wipo.int/export/sites/www/tk/en/folklore/creative_heritage/docs/mataatua.pdf).

<sup>21</sup> *Id.* at 2.

<sup>22</sup> *Id.* at 3.

<sup>23</sup> *Id.* at 4.

<sup>24</sup> Jessica Lai, *Maori Culture in the Modern World: Its Creation, Appropriation and Trade* 10 (University of Luzern, Switzerland, i-call Working Paper No. 02, 2010), available at [http://www.unilu.ch/files/i-Call\\_Working\\_Paper02\\_Lai.pdf](http://www.unilu.ch/files/i-Call_Working_Paper02_Lai.pdf). Lai states that “[o]utside of New Zealand, there is currently something “cool” and “hot” about Māori designs and culture that have made them increasingly popular on the global market and in the

cultural heritage can be seen as becoming part of the broader New Zealand identity and culture.<sup>25</sup> In both the international and domestic context, issues include the use of Māori symbols or language in trademarks and inappropriate use of customary knowledge and expressions in products, advertising, and for other commercial purposes.<sup>26</sup> In general, Māori consider that they are unable to exercise control of the trade of their culture in any real or comprehensive sense under the traditional intellectual property framework, and that they are also not reaping the benefits of this trade, whether nationally or internationally.<sup>27</sup>

The fact that certain knowledge or cultural expressions may be seen from a non-Māori or “Western” perspective as having entered the “public domain” is important in considering the type and level of protection that can be achieved. This concept is not necessarily recognized by Māori and other indigenous peoples for whom the cultural knowledge forms an integral part of their history and identity as both individuals and as a group.<sup>28</sup> The inappropriate use of Māori culture that does not recognize the meaning and protocols (*tikanga*) relevant to those expressions can therefore cause offense and anger.

Even if “ownership” of cultural knowledge or different cultural expressions may not be able to be (or wished to be) asserted in a legal sense according to the concepts of intellectual property law, Māori argue that their “guardianship” (*kaitiakitanga*) of such knowledge should be acknowledged, and there are frequently calls for prior consultation in order for the deeper meaning and significance of a cultural expression to be explained, understood, and respected.

Two of the most identifiable Māori cultural expressions that have been used by non-Māori in different contexts, both in New Zealand and overseas, are the Ka Mate haka (the war-dance used by the New Zealand national rugby team, the All Blacks, since 1905) and the koru pattern (unfolding fern frond).

### A. The Ka Mate Haka

The Ka Mate haka “has become a symbol, not only of the All Blacks, but of New Zealand and all its people.”<sup>29</sup> It is performed formally and informally at sporting events and by New Zealanders overseas wishing to express their New Zealand identity, but it has also been used, satirically or otherwise, in foreign advertisements for Italian cars,<sup>30</sup> Scottish whisky, and

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tourism industry in New Zealand.” See also *Maori Culture Taking Off Overseas*, THE DOMINION POST (Feb. 4, 2008), <http://www.stuff.co.nz/dominion-post/archive/national-news/252323>.

<sup>25</sup> Lai, *supra* note 24, at 30-31.

<sup>26</sup> deBeer, *supra* note 12, at 102-103.

<sup>27</sup> Lai, *supra* note 24, at 11.

<sup>28</sup> *Id.* at 25-26.

<sup>29</sup> *Id.* at 32.

<sup>30</sup> See *Italians Drive Ahead with Car Mate Haka*, NEW ZEALAND HERALD (July 4, 2006), [http://www.nzherald.co.nz/nz/news/article.cfm?c\\_id=1&objectid=10389619](http://www.nzherald.co.nz/nz/news/article.cfm?c_id=1&objectid=10389619). See generally Susy Frankel & Megan Richardson, *Cultural Property and ‘the Public Domain’: Case Studies from New Zealand and Australia*, in TRADITIONAL KNOWLEDGE, TRADITIONAL CULTURAL EXPRESSIONS AND INTELLECTUAL PROPERTY LAW IN THE ASIA-PACIFIC REGION 280-83 (Christoph Antons ed., 2009).

for a British employment website.<sup>31</sup> Māori people, and particularly the Ngāti Toa tribe of the warrior chief Te Rauparaha, who authored the haka in 1821, have taken offense and expressed their anger at the inappropriate use of the words and actions, which have been performed outside of and against *tikanga* and without consultation, particularly in instances of overseas commercial use.<sup>32</sup> This has been communicated to the companies involved directly and there have been discussions in the media, but the outcomes have been mainly some bad publicity and possibly a raising of the awareness of Māori culture and concerns among a broader audience.<sup>33</sup>

An attempt was made to trademark the lyrics of the Ka Mate haka, but this was rejected for various reasons.<sup>34</sup> More recently, in February 2009 the Government, as part of negotiations for financial, property, and cultural redress for breaches of the Treaty of Waitangi, stated in a formal offer letter to Ngāti Toa that the legislation implementing the final settlement will recognize the significance of the haka to the tribe.<sup>35</sup> In particular, the offer expresses the expectation of the tribe that “the primary objective of this redress is to prevent the misappropriation and culturally inappropriate use or performance of the haka ‘Ka Mate’.”<sup>36</sup>

The exact approach to the issue is still being negotiated, and the wording of any legislative provisions that give affect to it are sure to be the subject of widespread public interest. However, it has become clear over the years that Ngāti Toa’s aim is not to prevent use of the haka by the public or the All Blacks (who have the tribe’s permission to use it) from using it, but to prevent inappropriate use, particularly in a commercial setting. A spokesman has previously stated: “For all New Zealanders who wish to participate and use the haka – not a problem. But

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<sup>31</sup> Mark Sweeney, ‘Haka’ War Dance Ad for Jobs Site Cleared of Being Offensive to Maoris, THE GUARDIAN (July 29, 2009), <http://www.guardian.co.uk/media/2009/jul/29/haka-ad-cleared-asa-stv>; Watch an STV Jobs Ad Attacked for Spoofing the Haka, THE GUARDIAN (July 29, 2009), <http://www.guardian.co.uk/media/video/2009/jul/28/stv-jobs-ad-haka>.

<sup>32</sup> See, e.g. *Hollywood Hijacks Haka*, STUFF.CO.NZ (Nov. 3, 2008), <http://www.stuff.co.nz/entertainment/701595>. See also Lai, *supra* note 24, at 38, stating that “[w]hen Māori culture is appropriated outside of New Zealand, there are different implications. It is not potentially a sign of Māori culture forming part of the general New Zealand identity or done out of pride or affiliation for the country’s history and Indigenous people. In almost all cases, such appropriation is done for commercial reasons, outside of Tikanga Māori and is offensive to the Māori.”

<sup>33</sup> Lai, *supra* note 24, at 38.

<sup>34</sup> *Id.* at 32; Frankel & Richardsor, *supra* note 30, at 283. See also Jonathan Milne, *Iwi Threatens to Place Trademark on All Black Haka*, HERALD ON SUNDAY (May 22, 2005), [http://www.nzherald.co.nz/nz/news/article.cfm?c\\_id=1&objectid=10126807](http://www.nzherald.co.nz/nz/news/article.cfm?c_id=1&objectid=10126807); Patrick Crewdson, *Iwi Claim to All Black Haka Turned Down*, HERALD ON SUNDAY (July 2, 2006), [http://www.nzherald.co.nz/nz/news/article.cfm?c\\_id=1&objectid=10389347](http://www.nzherald.co.nz/nz/news/article.cfm?c_id=1&objectid=10389347).

<sup>35</sup> Ngāti Toa Rangatira Letter of Agreement, Attachment 2: Cultural Redress 18 (New Zealand Government, Feb. 11, 2009), available at <http://www.nz01.2day.terabyte.co.nz/ots/DocumentLibrary%5CNgatiToaofferletter.pdf>. See also Martin Kay & Katherine Newton, *Haka Seals Ka Mate Deal*, THE DOMINION POST (Feb. 11, 2009), <http://www.stuff.co.nz/national/1397833>; Ellen Connolly, *Maori Win Battle to Control All Blacks’ Haka Ritual*, THE GUARDIAN (Feb. 12, 2009), <http://www.guardian.co.uk/world/2009/feb/12/new-zealand-haka-maoris>.

<sup>36</sup> Letter of Agreement, *supra* note 35, at 19.

when it comes to commercial activity we feel strongly that we need to be sitting down at the table.”<sup>37</sup>

The final settlement will not confer full ownership rights and will not result in the tribe being able to claim royalties or the right to an outright veto of the use of the haka.<sup>38</sup> The Government is concerned that a balance is struck between the “rights and interests of Ngāti Toa, users, and the broader public” and considers that the special protection for the haka “should be complementary to, and not replace or prejudice the acquisition of, any applicable conventional intellectual property protection and derivatives thereof.”<sup>39</sup> The outcome is therefore likely to involve consultation requirements in some form, although it is unclear to what extent this might have an impact on overseas companies wishing to use depictions of the haka.

The Letter of Agreement between the government and Ngati Toa also refers to the WAI 262 inquiry, stating that “[t]he Crown will work with Ngāti Toa in designing an approach to address the issues and concerns relating to the use of the Ka Mate haka that is consistent with the Crown’s response to WAI 262 and the policy objectives and future outcomes of the Government’s Traditional Knowledge Work Programme.”<sup>40</sup>

## B. Koru

The koru pattern is another example of a Māori cultural expression becoming “infused” into everyday New Zealand, with the association with Māori deliberately maintained by those that use it.<sup>41</sup> Traditionally used in carvings, jewelry, tattoos, and other artwork, the pattern is now widely used in souvenir products and the artwork of both Māori and non-Māori New Zealanders, in product labels, and in major corporate brands (including the national airline). The limits of the intellectual property regime are also evident in this example: koru designs feature greatly in expressions of a New Zealand identity and the fact that the patterns are based on natural forms and ideas adds further weight to the argument that they are in the public domain.<sup>42</sup> Furthermore, a particular koru pattern that is of significance to a tribe would not be protected by copyright and could not be registered as a trademark if it is not used in trade.<sup>43</sup>

While many businesses do seek to explain the meaning of the design, there are concerns about the level of understanding being superficial and some of the products being “kitschy,” rather than the design being used with a true appreciation and observance of *tikanga*.<sup>44</sup> As with the haka and other cultural expressions, the concept of guardianship has been raised by some

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<sup>37</sup> Patrick Crewdson, *supra* note 34.

<sup>38</sup> Letter of Agreement, *supra* note 35, at 19.

<sup>39</sup> *Id.*

<sup>40</sup> *Id.* at 19.

<sup>41</sup> Frankel & Richardson, *supra* note 30, at 285-86.

<sup>42</sup> *Id.* at 286.

<sup>43</sup> *Id.*

<sup>44</sup> See Lai, *supra* note 24, at 30.

Māori, who argue that Māori have the role of protecting flora and fauna, and the cultural knowledge associated with it, from misuse, on behalf of past and future generations.<sup>45</sup>

### C. Non-Legislative Initiatives

One initiative that has sought to ensure that Māori benefit from their own use of koru and other traditional designs in jewelry and other artwork is the Toi Iho Māori Made Mark, a registered trademark for use by Māori artists.<sup>46</sup> The authentication mark was launched by the Government in 2002 and was originally funded through Creative New Zealand (Arts Council of New Zealand).<sup>47</sup> On launching the mark, the Minister for Arts, Culture and Heritage stated:

Māori art is unique to Aotearoa [New Zealand]. As a nation, we need to preserve and promote our unique Māori artistic expression, not only because it is precious to us, but also because it gives us a point of difference on the global market. There is a burgeoning interest in Māori art both in New Zealand and internationally. Assurances of authenticity and quality have been lacking in the tourism industry for many years. The mark provides this to New Zealanders and visitors from overseas.<sup>48</sup>

Following various reviews of the initiative, however, it was announced in 2009 that Creative New Zealand would no longer invest in managing and promoting the Toi Iho mark.<sup>49</sup> In announcing the decision, Creative New Zealand said that:

For many Māori artists, the quality of their work speaks for itself and this is reflected in a growth of opportunities for consumers to buy Māori art from specialist Māori art and general galleries, the Internet and Māori arts markets. Creative New Zealand has conducted several reviews of toi iho™ since its inception and a consistent theme was that while the ideas underpinning the brand have considerable merit, it has failed to deliver on its promise in terms of increasing sales of Māori art by licensed artists and stockists (retailers).<sup>50</sup>

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<sup>45</sup> Frankel & Richardson, *supra* note 30, at 286.

<sup>46</sup> See *About Us*, TOI IHO MAORI MADE, <http://www.toiiho.com/Aboutus/tabid/249/Default.aspx> (last visited Nov. 30, 2010).

<sup>47</sup> See Speech, Hon. Judith Tizard, Launch of the toi iho Maori Made Mark (Feb. 8, 2002), available at <http://www.beehive.govt.nz/node/13013>.

<sup>48</sup> Press Release, Hon. Judith Tizard, Toi Iho Maori Made Mark Will Bring Cultural and Economic Benefits to New Zealand (Feb. 8, 2002), <http://www.beehive.govt.nz/node/12988>.

<sup>49</sup> Press Release, Creative New Zealand, Creative New Zealand Statement on Toi Iho (Oct. 21, 2009), [http://www.creativenz.govt.nz/who\\_we\\_are/news/articletype/articleview/articleid/334/categoryid/4/creative-new-zealand-statement-on-toi-iho](http://www.creativenz.govt.nz/who_we_are/news/articletype/articleview/articleid/334/categoryid/4/creative-new-zealand-statement-on-toi-iho) and [http://www.creativenz.govt.nz/funding/toi\\_iho%E2%84%A2\\_M%C4%81ori\\_made\\_mark](http://www.creativenz.govt.nz/funding/toi_iho%E2%84%A2_M%C4%81ori_made_mark) (including frequently asked questions). See also Toi Iho website, <http://www.toiiho.com/>.

<sup>50</sup> *Id.*

In February 2010, Creative New Zealand sought expressions of interest from entities who might wish to take ownership of the Toi Iho mark.<sup>51</sup> It has been reported that a foundation made up of Māori artists has been established to ensure that the trademarks continue.<sup>52</sup>

Separate from the Toi Iho initiative, as part of the broader work program on intellectual property law and the protection of indigenous rights relating to cultural and traditional knowledge,<sup>53</sup> in 2007 the Ministry of Economic Development published detailed guidance on protecting Māori cultural or artistic expressions through the use of intellectual property laws.<sup>54</sup> This document states that:

While there are limits to the protection IP rights can provide for mātauranga Māori,<sup>55</sup> a number of existing forms of IP rights can give some protection. Some IP rights, such as copyright, are available to protect contemporary expressions or adaptations of mātauranga Māori (not the underlying mātauranga Māori or traditional knowledge). Other IP rights, such as trade marks, can be used to certify the authenticity of Māori products, and the action of “passing off” can be used to fight false claims of indigenous authenticity.<sup>56</sup>

#### IV. Amendments to New Zealand’s Intellectual Property Legislation

While New Zealand’s intellectual property laws were originally based on the laws of the United Kingdom, more recent amendments reflect an increased recognition of Māori concerns.<sup>57</sup> Reform processes commenced in the 1990s, including a 1994 Māori consultation paper and meetings on an Intellectual Property Law Reform Bill that referred to possible recommendations to the government for changes to the trademark and patent legislation.<sup>58</sup> These reforms progressed as separate bills, and further changes may arise as a result of the findings of the Waitangi Tribunal in the WAI 262 claim, which are expected to be released soon.

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<sup>51</sup> Press Release, Creative New Zealand, Expressions of Interest in Toi Ihu Sought (Feb. 25, 2010), [http://www.creativenz.govt.nz/who\\_we\\_are/news/articletype/articleview/articleid/453/categoryid/18/expressions-of-interest-in-toi-iho-sought](http://www.creativenz.govt.nz/who_we_are/news/articletype/articleview/articleid/453/categoryid/18/expressions-of-interest-in-toi-iho-sought).

<sup>52</sup> *Toi Iho in Maori Control (finally!)*, TANGATAWHENUA.COM (May 22, 2010), <http://news.tangatawhenua.com/archives/5166>. See also Lai, *supra* note 24, at 25.

<sup>53</sup> See *The Intellectual Property and Traditional Knowledge Work Programme*, MINISTRY OF ECONOMIC DEVELOPMENT, [http://www.med.govt.nz/templates/ContentTopicSummary\\_1938.aspx](http://www.med.govt.nz/templates/ContentTopicSummary_1938.aspx) (last visited Nov. 30, 2010).

<sup>54</sup> TE MANA TAUMARU MĀTAURANGA: INTELLECTUAL PROPERTY GUIDE FOR MĀORI ORGANISATIONS AND COMMUNITIES (Ministry of Economic Development, 2007), available at <http://www.med.govt.nz/upload/48608/ip-guide-maori.pdf>.

<sup>55</sup> “Mātauranga Māori” refers to “knowledge specific to Māori communities and is the most significant body of traditional knowledge in Aotearoa-New Zealand.” *Id.* at 3. See also note 14, *supra*.

<sup>56</sup> TE MANA TAUMARU MĀTAURANGA, *supra* note 54, at 6.

<sup>57</sup> See SUMPTER, *supra* note 13, at 254-59. See also *Copyright Laws to Protect Māori Heritage*, BBC NEWS (Aug. 10, 2001), <http://news.bbc.co.uk/2/hi/business/1482203.stm>.

<sup>58</sup> INTELLECTUAL PROPERTY LAW REFORM BILL: MAORI CONSULTATION PAPER (Ministry of Commerce, Nov. 1994).

## A. Trade Marks Act 2002

Following on from the 1994 consultation paper, the Ministry of Commerce established a Māori Trade Marks Focus Group which released a discussion paper in 1997 on proposals relating to Māori that would be contained within a new trademarks bill.<sup>59</sup> A bill was eventually introduced in 2001 and was enacted in 2002. One of the stated purposes of the Trade Marks Act 2002 is to “address Māori concerns relating to the registration of trade marks that contain a Māori sign, including imagery and text.”<sup>60</sup>

The Act contains provisions that resulted from the recommendations of the Māori Trade Marks Focus Group. Section 17 of the Act sets out absolute grounds for the Commissioner of Trade Marks to refuse to register a trademark or part of a trademark, including where its use or registration would “in the opinion of the Commissioner, be likely to offend a significant section of the community, including Māori.”<sup>61</sup> The Act also requires the appointment of an advisory committee<sup>62</sup> “to advise the Commissioner whether the proposed use or registration of a trade mark that is, or appears to be, derivative of a Māori sign, including text and imagery, is, or is likely to be, offensive to Māori.”<sup>63</sup>

The previous trademark legislation prohibited the registration of trademarks containing “scandalous matter,”<sup>64</sup> and cultural issues may have been taken into account under that provision despite not being spelled out in the legislation. The establishment of an advisory committee also means that such issues can be considered in a proactive manner as there is no requirement for a complaint to be received regarding a particular trademark.<sup>65</sup> There is also nothing in the legislation that requires a particular level of offensiveness, or proof of that offensiveness, or that requires the Commissioner to follow the recommendations of the Committee. At least one commentator has raised concerns with these aspects of the law, stating that “offence is a value laden concept open to a variety of interpretations and a determination of whether a mark is likely to offend is more open to subjective judgment than the provisions which were replaced.”<sup>66</sup>

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<sup>59</sup> See Maori Trade Marks Advisory Committee, Background Information, Ministry of Economic Development, [http://www.med.govt.nz/templates/Page\\_1291.aspx](http://www.med.govt.nz/templates/Page_1291.aspx) (last visited Nov. 30, 2010).

<sup>60</sup> Trade Marks Act 2002, s 3(a), available at <http://www.legislation.govt.nz/act/public/2002/0049/latest/DLM164240.html>.

<sup>61</sup> Trade Marks Act 2002, s 17(1)(c).

<sup>62</sup> Trade Marks Act 2002, s 177 (stating that “the Commissioner must appoint an advisory committee”).

<sup>63</sup> Trade Marks Act 2002, s 178 (Functions of Advisory Committee).

<sup>64</sup> Trade Marks Act 1953, s 16.

<sup>65</sup> Provision is also made for complaints to be made, including by a “culturally aggrieved” person, which can result in the Commissioner or a court declaring the registration of a trademark to be invalid. Trade Marks Act 2002, s 73.

<sup>66</sup> Owen J. Morgan, *The New Zealand Trade Marks Act – No Place for Offence 2* (Intellectual Property Research Institute of Australia, Occasional Paper No. 2/03, 2003), available at <http://www.ipria.org/publications/occasional%20papers/Occasional%20Paper%202.03.pdf>.

The Māori Trade Marks Advisory Committee meets quarterly and reviews applications referred to it by the Commissioner of Trade Marks. In 2003, 333 trademark applications were referred to the Committee, and of these they considered that eight were likely to be offensive or required more information.<sup>67</sup> This did not mean that they were necessarily declined; instead the applicants appear to have been asked to rework and resubmit their applications.<sup>68</sup> There has not been any litigation regarding the application of the provisions, and it is noted that:

It will be difficult to measure the success of the provisions until a particularly controversial mark comes before the Commissioner of Trade Marks. The willingness of the Commissioner to ignore the recommendations of the Committee will then be tested. It is unlikely that this will occur often given the option for an applicant to amend their application in order to meet the requirements of the Act.<sup>69</sup>

The Committee has also issued guidance on the use of Māori symbols in trademarks, including particular reference to the use of the koru pattern. A general guideline states that the use of a koru in a trademark application is not offensive for a wide range of goods and services.<sup>70</sup> In this context, it has been stated that the threshold of “offensiveness” under the Trade Marks Act 2002 is much higher than that of “appropriateness,” and that the “cultural origins of designs and designers are not part of the assessment process.”<sup>71</sup> Therefore, one view is that, even under the amendments, the range of Māori concerns about the use of particular cultural expressions may not be fully accommodated by the ability to object on offensiveness alone.<sup>72</sup>

## B. Patents Bill

Following a review, consultation, and decision-making process that commenced in the 1990s, including a 1999 discussion document entitled Māori and the Patenting of Life Form Inventions,<sup>73</sup> a Patents Bill was introduced in 2008 and is currently before the New Zealand Parliament awaiting the final stages of debate.<sup>74</sup> If passed, this bill will repeal and replace the

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<sup>67</sup> deBeer, *supra* note 12, at 110.

<sup>68</sup> *Id.*

<sup>69</sup> *Id.*

<sup>70</sup> Trade Marks Practice Guidelines: Pitau (Koru), Intellectual Property Office of New Zealand (IPONZ), <http://www.iponz.govt.nz/cms/trade-marks/practice-guidelines-index/practice-guidelines/16-maori-advisory-committee-maori-trade-marks/6-annexure/6-3-pitau-koru>.

<sup>71</sup> Frankel & Richardson, *supra* note 30, at 287 (quoting Practice Guideline Amendment 2006/11, IPONZ Newsletter, Dec. 2006).

<sup>72</sup> *Id.*

<sup>73</sup> MĀORI AND THE PATENTING OF LIFE FORM INVENTIONS (Ministry of Commerce, 1999), available at [http://www.med.govt.nz/templates/MultipageDocumentTOC\\_1237.aspx](http://www.med.govt.nz/templates/MultipageDocumentTOC_1237.aspx)  
<http://www.med.govt.nz/upload/3649/patentsreview.pdf>.

<sup>74</sup> The Patents Bill was reported on by the Commerce Committee on March 30, 2010. See Patents Bill, New Zealand Parliament, [http://www.parliament.nz/en-NZ/PB/Legislation/Bills/a/f/2/00DBHOH\\_BILL8651\\_1-Patents-Bill.htm](http://www.parliament.nz/en-NZ/PB/Legislation/Bills/a/f/2/00DBHOH_BILL8651_1-Patents-Bill.htm).

existing 1953 legislation.<sup>75</sup> Clause 14 of the bill provides for a morality exclusion and allows the Commissioner to seek advice from a Māori advisory committee.<sup>76</sup> Therefore, similar to the trademark legislation, the bill provides for the establishment of a Māori Advisory Committee to advise the Commissioner of Patents on whether an invention is “derived from Māori traditional knowledge or from indigenous plants or animals” and, if so, “whether the commercial exploitation of the invention is likely to be contrary to Māori values.”<sup>77</sup>

The parliamentary committee that considered the bill received submissions and advice regarding Māori interests, including a number of references to the WAI 262 inquiry. It noted that further amendments may be made to the legislation as part of the government response to the Tribunal’s report on this inquiry.<sup>78</sup>

### C. WAI 262 Inquiry

The WAI 262 claim was lodged in 1991 by a number of different Māori groups. It combines a wide range of elements, “including traditional practices of Māori, spiritual values, and other aspects which are perhaps more recognizable as cultural features rather than intellectual property.”<sup>79</sup> The claimants essentially argue that their rights to control, manage, and utilize indigenous flora and fauna, and the genetic resources they contain, arise from Article 2 of the Treaty of Waitangi. They assert that the Crown had an active duty to protect these interests and that the Crown has breached the Treaty by denying Māori proprietary interests in indigenous flora and fauna, including through some intellectual property laws and agreements.<sup>80</sup> The intellectual property aspects of the claim have never been addressed by the Tribunal before.

The claims and inquiry include issues relating to the protection of cultural expressions. For example, the Statement of Issues refers to “taonga works,” which include a long list of examples of “artistic and literary works,” including the “mauri” (spirit) of those works, “where the work reflects in some way the culture and/or identity of the kaitiaki [guardian] of the work and includes the knowledge, skills, cultural or spiritual values upon which the work is based.”<sup>81</sup>

The claimants contend that their cultural knowledge and expressions are taonga, and that the guarantees in the Treaty included the rights of guardianship, custody, collection,

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<sup>75</sup> Patents Act 1953, available at <http://www.legislation.govt.nz/act/public/1953/0064/latest/DLM280031.html>.

<sup>76</sup> Patents Bill, As Reported From the Commerce Committee, cl 14, available at [http://www.parliament.nz/NR/rdonlyres/B6E4F834-C47A-426A-86B8-F573ED4F5E04/133805/DBSCH\\_SCR\\_4679\\_PatentsBill\\_2352\\_7434\\_3.pdf](http://www.parliament.nz/NR/rdonlyres/B6E4F834-C47A-426A-86B8-F573ED4F5E04/133805/DBSCH_SCR_4679_PatentsBill_2352_7434_3.pdf).

<sup>77</sup> *Id.* cl 14(3).

<sup>78</sup> *Id.*, Commentary, at 3.

<sup>79</sup> SUMPTER, *supra* note 13, at 257.

<sup>80</sup> See Statement of Issues, *supra* note 5, at 4 and 6-12.

<sup>81</sup> *Id.* at 6.

revitalization, and transmission of such knowledge and expressions.<sup>82</sup> The issues being considered by the Tribunal therefore include:

- Must the Crown protect taonga works from use by persons other than the kaitiaki or in a manner inconsistent with the customs and values of those kaitiaki?
  - If so, in what circumstances does New Zealand law and policy provide such protection?
- Must the Crown provide for the regulation, control, use and development by kaitiaki of their taonga works?
  - If so, in what circumstances does New Zealand law and policy ensure this activity?
- Must the Crown ensure the preservation of intellectual property aspects of taonga works in the hands of kaitiaki and the transmission of those works from generation to generation among kaitiaki?
  - If so, in what circumstances, does New Zealand law and policy provide for such preservation and transmission?<sup>83</sup>

The Statement of Issues goes on to list a number of questions relating to specific intellectual property laws and concepts, including whether they are inconsistent with the Treaty and, if so, whether they can be made consistent through particular amendments.<sup>84</sup>

The Tribunal has recently released a chapter relating to the Māori language aspects of the claim<sup>85</sup> and the remaining recommendations are also expected to be released in 2010. The Tribunal's recommendations are not binding on the government, but are likely to have a considerable impact on discussions regarding the need for any further amendments to the intellectual property regime, the development of other legislative changes, or non-legislative initiatives relating to the protection of Māori cultural knowledge and expressions.

## V. Concluding Remarks

The amendments to New Zealand's intellectual property laws, in terms of requirements for considering Māori concerns about the use of their cultural knowledge in trademarks and patents, are unique. Furthermore, traditional intellectual property concepts, including copyright and trademarks, can be beneficial to Māori in protecting and benefiting from their own contemporary cultural expressions. However, concerns remain about the level of control that Māori have over the use of their traditional cultural expressions by others, particularly in a commercial setting. The concept of "guardianship" and requirements for prior consultation and

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<sup>82</sup> *Id.* at 6-12.

<sup>83</sup> *Id.* at 14.

<sup>84</sup> *Id.* at 14-21.

<sup>85</sup> TE REO MĀORI (Waitangi Tribunal Report No. 262, pre-publication version, Oct. 2010), available at <http://www.waitangitribunal.govt.nz/scripts/reports/reports/262/056831F7-3388-45B5-B553-A37B8084D018.pdf>. This chapter was released early so that it would be available to the current Ministerial review panel considering the Māori language sector and strategy. *Indigenous Flora and Fauna and Cultural Intellectual Property: Report Summary*, WAITANGI TRIBUNAL, <http://www.waitangitribunal.govt.nz/reports/summary.asp?reportid={BF981901-5B55-441C-A93E-8E84B67B76E9}> (last visited Nov. 30, 2010).

for use that conforms with Māori protocols are difficult to include in an intellectual property legal regime. This is particularly the case with expressions that are seen by non-Māori as being in the public domain or that have become infused within the broader culture and identity of the country.

The detailed examination of these issues by the Waitangi Tribunal offers the opportunity for increased clarity and understanding regarding Māori rights and interests in protecting their culture from inappropriate use. In responding to the Tribunal's final recommendations, it appears that the New Zealand government will seek to achieve a balance between these and the interests of the public, meeting any obligations arising from international instruments, as well as the need to maintain the coherency and benefits of the existing intellectual property regime. Any changes to the framework in New Zealand with respect to traditional cultural expressions could have an impact on how overseas companies approach the use of Māori culture, although the lack of agreed international rules or standards at this stage<sup>86</sup> may mean that Maori will need to continue to use other mechanisms to enhance the understanding and protection of their culture.

Kelly Buchanan  
Foreign Law Specialist

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<sup>86</sup> The World Intellectual Property Organisation's Intergovernmental Committee on Traditional Knowledge, Genetic Resources and Traditional Cultural Expressions/Folklore is continuing to work towards an agreement on an international legal instrument on traditional cultural expressions. Press Release, World Intellectual Property Office, Experts Break New Ground in Traditional Cultural Expression Talks (July 23, 2010), [http://www.wipo.int/pressroom/en/articles/2010/article\\_0026.html](http://www.wipo.int/pressroom/en/articles/2010/article_0026.html).

**SAMOA**  
**LAW REFORM COMMISSION**

THE PROTECTION OF SAMOA'S  
TRADITIONAL KNOWLEDGE AND  
EXPRESSIONS OF CULTURE  
**Issues Paper IP 08/10**

**June 2010**

## **Preface**

The Attorney General referred the reference “Project” on the protection of Samoa’s traditional knowledge and expressions of culture to the Law Reform Commission “Commission” in November 2008.

The project aims to examine existing intellectual property laws (*Copyright Act 1998, Patents Act 1972, Trademarks Act 1972 and Industrial Designs Act 1972*) “conventional legal frameworks” and their appropriateness for protecting Samoa’s traditional knowledge and expressions of culture.

The project will also look at approaches adopted by other jurisdictions to cater for the protection of their traditional knowledge and expressions of culture to help Samoa in determining a suitable approach to take.

The Commission will endeavor to formulate an articulated and reasoned legal policy for the protection of Samoa’s traditional knowledge and expressions of culture at the completion of this project.

The Commission has employed for this Issues Paper, the form of questions and a closing date for responses 31 March 2011. This paper therefore discusses the issues and poses questions for consideration. The intention is to enable detailed and practical consideration of the issues.

We emphasize that we are not committed to the views indicated and any provisional conclusions should not be taken as precluding further consideration of the issues.

Given that many questions have been posed, the Commission will make its recommendations once it has received all submissions from stakeholders. The recommendations of the Commission will form the basis of its final report to Cabinet. The recommendations of the Commission will be independent of all stakeholders.

We emphasize however that the views expressed in this paper are those of the Commission and not necessarily those of the people who have helped us

Submissions or comments on this paper should be sent by 31 March 2011 to the Executive Director, Samoa Law Reform Commission, Private Bag 974 or by email to [lawreform@ag.gov.ws](mailto:lawreform@ag.gov.ws).

We are grateful for the assistance of the following people who provided comments on earlier drafts of this paper: List

*The content of the issues paper will be as follows:*

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## 1) IS THERE A NEED FOR CHANGE?

Intellectual property refers to a creation of the mind. It includes inventions, literary and artistic works, symbols, names, images, designs and inventive processes used in commerce. Intellectual property right laws operate to protect the right of creators to their creations.

The *Copyright Act 1998*, *Patents Act 1972*, *Trademarks Act 1972* and *Industrial Designs Act 1972* operate to protect the intellectual property rights of creators in Samoa. The enactment dates of these legislation “conventional legal frameworks” fall within the third quarter of the twentieth century, with the exception of the *Copyright Act*. This is approximately two decades before traditional knowledge and expressions of culture were considered to be valuable commodities and given formal international recognition. Therefore, it is without a doubt that these legislation were formulated and enacted without any policy consideration for the regulation and protection of traditional knowledge and expressions of culture.

The lack of relevant law reform in the past years is evident in the failure of conventional legal frameworks to provide adequate protection for Samoa’s traditional knowledge and expressions of culture.

The complex nature of traditional knowledge and expressions of culture also render them incompatible with requirements under most of these conventional legal frameworks. This affects the extent to which they can be protected under these intellectual property legislation.

This project will discuss the reasons for this incompatibility and identify possible remedies to ensure that Samoa’s traditional knowledge and expressions of culture are given adequate protection.

The paper will consider approaches adopted by other comparable jurisdictions such as the Pacific Islands Forum Secretariat Model (PIFS Model), African Union Model and China, for the protection of traditional knowledge and expressions of culture.

## 2) DEFINING TRADITIONAL KNOWLEDGE AND EXPRESSIONS OF CULTURE

The recognition of traditional knowledge stemmed from studies into the origins, behaviour and the development of humans in both primitive and modern societies<sup>1</sup>. This coincided with heightened environmental awareness, which resolved that traditional knowledge contributes to broader environmental assessment than conventional scientific knowledge<sup>2</sup>. It sparked an interest in the relationship between indigenous ways and the preservation of the environment.

The adoptions by international development organizations lead to worldwide appreciation and recognition of traditional knowledge. The United Nations was one of the first international development organizations that produced a report advocating the importance of traditional knowledge. These sentiments were prominently reflected in documents such as the 1992 *Convention on Biological Diversity*, *Agenda 21* and the *Rio Declaration*<sup>3</sup>.

However, opponents argue that the integration of traditional knowledge into public policy is dangerous. The basis for this position is the fact that traditional knowledge has a

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<sup>1</sup><http://network.nationalpost.com/np/blogs/fullcomment/archive/2009/02/06/book-excerpt-the-problem-with-traditional-knowledge.aspx> (Accessed 2 Feb 2010)

<sup>2</sup> Peter J.Usher, "Traditional ecological knowledge in environmental assessment and management", *Arctic*, 53(2) June, 2000 pp. 183-193.

<sup>3</sup> Frances Widdowson, Sir Wilfred Grenfell College, Memorial University & Albert Howard, Independent Researcher: Aboriginal "Traditional Knowledge" and Canadian Public Policy: Ten Years of Listening to the Silence" @ <http://www.cpsa-acsp.ca/papers-2006/Widdowson-Howard.pdf> (Accessed 2 Feb 2010).

spiritual component which would be difficult to prove through scientific reasoning. Thus, there is a risk that traditional knowledge can be used to justify any activity<sup>4</sup>.

Traditional owners on the other hand are also reluctant to disclose their indigenous wisdom for fear of access and abuse by others who are not entitled to such knowledge. Owners may only divulge such valuable knowledge if there is an assurance that their rights and interests are protected.

The latter concern gave birth to the existing dilemma of what appropriate measures should be adopted to offer such protection. Certain matters need to be considered when determining suitable legal mechanisms to protect traditional knowledge. These include the need to seek prior informed consent of traditional owners; the fair and equal sharing of benefits derived from any transactions involving traditional knowledge and expressions of culture; protection of traditional knowledge and expressions of culture from abuse particularly in commercial transactions; and continual respect for customary law and practices<sup>5</sup>.

### 2.1) *What is traditional knowledge?*

Attempts to define traditional knowledge have been numerous. One definition refers to it as the large body of knowledge and skills embedded in culture and unique to a given location or society<sup>6</sup>. Another definition states it as knowledge and values acquired through experience and observation from the land or from spiritual teachings, and handed down from one generation to another<sup>7</sup>.

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<sup>4</sup> Above n. 3.

<sup>5</sup> *Intellectual Property and Traditional Knowledge: Booklet No. 2*, World Intellectual Property Organization Publication No. 920(E). p. 24.

<sup>6</sup> <http://www.unesco.org/most/bpindi.htm> (Accessed 12 March 2010).

<sup>7</sup> Above n.3.

The Pacific Islands Forum Secretariat Model Law (PIFS Model Law) defines traditional knowledge as knowledge generally created, acquired or inspired for traditional economic, spiritual, ritual, narrative, decorative or recreational purposes. It is capable of being transmitted from generation to generation and is regarded as pertaining to a particular traditional group, clan or community and is collectively originated and held<sup>8</sup>.

However, a better description of traditional knowledge is given by Stephen Hansen and Justin Van Fleet in *Traditional Knowledge and Intellectual Property: A Handbook on Issues and Options for Traditional Knowledge Holders in Protecting their Intellectual Property, and Maintaining Biological Diversity*<sup>9</sup>. They describe traditional knowledge as the information that people in a given community, based on experience and adaptation to a local culture and environment, have developed over time, and continue to develop. This knowledge is used to sustain the community and its culture and to maintain the genetic resources necessary for its continual survival<sup>10</sup>.

Traditional knowledge includes mental inventories of local biological resources, animal breeds, and local plant, crop and tree species. It may include such information as trees and plants that grow well together, and indicator plants, such as plants that show the soil salinity or that are known to flower at the beginning of the rains. It includes practices and technologies, such as seed treatment and storage methods and tools used for planting and harvesting<sup>11</sup>.

Traditional knowledge also encompasses belief systems that play a fundamental role in a people's livelihood, maintaining their health, and protecting and replenishing the environment. Traditional knowledge is dynamic in nature and may include

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<sup>8</sup> Model Law 2002 (PIFS) cl. 4.

<sup>9</sup> Hansen, Stephen et al, *Traditional Knowledge and Intellectual Property: A Handbook on Issues and Options for Traditional Knowledge Holders in Protecting their Intellectual Property, and Maintaining Biological Diversity*: (2003) p.3.

<sup>10</sup> Above n. 9.

<sup>11</sup> Above n. 9.

experimentation in the integration of new plant or tree species into existing farming systems or a traditional healer's tests of new plant medicines.

In Stephen Hansen and Justin Van Fleets' view, the term "traditional" used in describing this knowledge does not imply that this knowledge is old or untechnical in nature, but "tradition-based." It is "traditional" because it is created in a manner that reflects the traditions of the communities, therefore not relating to the nature of the knowledge itself, but to the way in which that knowledge is created, preserved and disseminated<sup>12</sup>.

Furthermore, traditional knowledge is collective in nature hence it is often considered the property of the entire community and not belonging to any single individual within the community<sup>13</sup>. It is transmitted through specific cultural and traditional information exchange mechanisms, for example, maintained and transmitted orally through elders or specialists, such as *tufuga* (traditional tattooist) or *taulasea* (fofo).

Traditional knowledge also has been referred to as indigenous traditional knowledge,<sup>14</sup> cultural knowledge<sup>15</sup> or indigenous knowledge,<sup>16</sup> by a number of other authors. Therefore, traditional knowledge can take to mean cultural knowledge or indigenous knowledge.

<b>Questions:</b>	<ol style="list-style-type: none"><li>1. <i>What is your definition of traditional knowledge?</i></li><li>2. <i>What are examples of traditional knowledge found in your village?</i></li></ol>
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<sup>12</sup> *Elements Of A Sui Generis System For The Protection Of Traditional Knowledge*, World Intellectual Property Organization, Intergovernmental Committee On Intellectual Property And Genetic Resources, Traditional Knowledge And Folklore, 3rd Sess., 2002, WIPO/GRTKF/IC/3/8.

<sup>13</sup> Above n. 12.

<sup>14</sup> Erin MacKay the Director of the Indigenous Art and the Law project at the Indigenous Law Centre, University of New South Wales and Legal Officer at the Australian Law Reform Commission in, *Indigenous Traditional Knowledge, Copyright and Art – Shortcomings in protection and alternative approach* (2009) *UNSW Law Journal* Volume 32(1).

<sup>15</sup> Above n. 14.

<sup>16</sup> Jane Anderson, 'The Politics of Indigenous Knowledge: Australia's Proposed Communal Moral Rights Bill' (2004) 27(3) *University of New South Wales Law Journal* 585.

	<p>3. <i>Do you think all sorts of traditional knowledge should be protected?</i></p> <p>4. <i>Who should traditional knowledge be protected from?</i></p> <p>5. <i>Who does traditional knowledge belong to?</i></p> <p>6. <i>Are all traditional knowledge linked to customary land?</i></p>
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2.2) *What are expressions of culture?*

The PIFS Model Law gives a clear meaning of expressions of culture. Expressions of culture is defined as any way in which traditional knowledge appears or is manifested, irrespective of content, quality or purpose and whether tangible or intangible.

The PIFS Model Law also gives an inclusive list of examples of expressions of culture. The list includes names, stories, chants, riddles, histories and songs in oral narratives, woodwork, metalware, painting, jewellery, weaving, needlework, shell work, rugs, costumes and textiles, music, dances, theatre, literature, ceremonies, ritual performances and cultural practices, the delineated forms, parts and details of designs and visual compositions and architectural forms<sup>17</sup>.

The *Copyright Act 1998* also gives expressions of folklore a similar definition. A comparable list identical to the list above is also provided under the Act as examples of expressions of folklore. A detailed discussion of the definition of expressions of folklore will be done in the relevant section which discusses the *Copyright Act*.

A number of authors have referred to expressions of culture as either cultural property<sup>18</sup>, traditional cultural expressions or indigenous property<sup>19</sup>. Therefore, expressions of

<sup>17</sup> *Model Law 2002* (PIFS) cl.4.

<sup>18</sup> Susy Frankel a Professor of Law, Victoria University of New Zealand in *Trademarks and Traditional Knowledge and Cultural Intellectual Property*.

<sup>19</sup> Above n. 14.

culture can take to mean cultural property, expressions of folklore, traditional cultural expressions or indigenous property.

<b>Questions:</b>	<ol style="list-style-type: none"><li>7. <i>What is your definition of expressions of culture?</i></li><li>8. <i>What are examples of expressions of culture found in your village?</i></li><li>9. <i>Do you think all sorts of expressions of culture should be protected?</i></li><li>10. <i>Who should expressions of culture be protected from?</i></li><li>11. <i>Who do expressions of culture belong to?</i></li><li>12. <i>Are all expressions of culture linked to land?</i></li></ol>
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### 3) CONVENTIONAL LEGAL FRAMEWORKS

The *Copyright Act 1998*, *Patents Act 1972*, *Trademarks Act 1972* and *Industrial Designs Act 1972* protect the rights of intellectual property owners in Samoa. These conventional frameworks fulfill the public policy objective of consumer protection by preventing the public from being misled as to the origin or quality of a product or service. For example, trademark law operates to prevent customers from buying products of inferior quality.

These conventional frameworks also offer periodic protections over new creations and inventions. The given protection aims to give creators monopoly over their creations and encourage them to make new creations and inventions. It also gives them confidence to publicise and commercialise their works without fear that potential competitors or imitators would benefit from their labour.

But, no country favours giving the creator of an idea, an eternal property in his or her creation against imitators<sup>20</sup>. The implications of such a privilege on economies would be great. Instead, they would rather set limited forms of protection fashioned to safeguard against unauthorized exploitation by others<sup>21</sup>. Once this period of protection lapses, the

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<sup>20</sup> Professor Cornish (1981) *Intellectual Property: Patents, Copyright, trade Marks and allied Rights*: London.

<sup>21</sup> Above n. 20.

public can freely access and use the ideas, concepts and designs that formed the basis for these formerly protected creations and inventions. The rationale for this is to promote innovation and creativity in society and facilitate the productions of newly improved creations and inventions.

The protections that are offered under conventional frameworks all focus on private individuals rather than communities or groups, except in the case of the *Copyright Act*. Hence, these conventional frameworks are inappropriate for safeguarding local traditional knowledge and expressions of culture that are usually held by communities.

In addition, the strict conditions for protection specified under these conventional frameworks are also incompatible with the unique nature of traditional knowledge and expressions of culture.

### 3.1) Copyright protection

The *Copyright Act 1998* protects original intellectual creations in the literary and artistic domain. A work is protected under copyright law by the sole fact of its creation, irrespective of its form of expression, content, quality and purpose<sup>22</sup>. Therefore, a creation or original work does not need to be registered in order for it to be protected.

In defining works that can be protected the Act gives an inclusive definition. The definition includes writings, oral works, works created for stage productions, expressions of folklore, audiovisual works, architectural work, works of fine art, photographic works, works of applied art, illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography architecture or science<sup>23</sup>.

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<sup>22</sup> *Copyright Act* s. 3(2).

<sup>23</sup> *Copyright Act* s. 3(1).

The Act also offers protection over derivative works from earlier protected works. These include translations, adaptations, arrangements and other transformations or modifications of an earlier work or collections of works<sup>24</sup>.

In establishing such protection, the Act recognises economic and moral rights of creators in their creations. Economic rights are exclusive rights which operate to exclude the whole world and give holders the right to authorise the usage of their creations by others<sup>25</sup>. Economic rights are alienable. They can be alienated either temporarily (licence) or permanently<sup>26</sup>. Moral rights on the other hand are based on a European-imported idea of inalienable artistic merit that exists within a creation, apart from its economic value<sup>27</sup>. The Act recognises three moral rights: the right of acknowledgement, the right against false acknowledgement and the author's right to have his or her work treated with integrity and not in any kind of offensive manner<sup>28</sup>.

Any person found to have infringed the economic or moral rights of an owner may be liable for damages or a fine not exceeding WST25,000.00 or in the case of re-offenders a maximum penalty of WST50,000.00; under civil law and criminal sanctions provided under the Act.

A number of exceptions are available under the Act where protected works may be used without the authority of the owner such as, in the cases of private reproduction for personal purposes,<sup>29</sup> quotation,<sup>30</sup> educational purposes,<sup>31</sup> for storing and preservation in libraries and archives,<sup>32</sup> public information<sup>33</sup> and display<sup>34</sup>.

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<sup>24</sup> *Copyright Act* s. 4(1).

<sup>25</sup> *Copyright Act* s. 6.

<sup>26</sup> *Copyright Act* s. 19.

<sup>27</sup> See, generally, Maree Sainsbury, *Moral Rights and their Application in Australia* (2003) cited in Erin MacKay, Above n. 14.

<sup>28</sup> *Copyright Act* s. 7.

<sup>29</sup> *Copyright Act* s. 8.

<sup>30</sup> *Copyright Act* s. 9.

<sup>31</sup> *Copyright Act* s. 10.

<sup>32</sup> *Copyright Act* s. 11.

<sup>33</sup> *Copyright Act* s. 12.

<sup>34</sup> *Copyright Act* s. 15.

The Act also contains an incorporation provision<sup>35</sup> which operates to give legislative force to international treaties in respect of copyright and related rights that Samoa is a party. However, the provision is specific that in the case of a conflict between the provisions of the Act and that of a treaty, the provisions of the Act prevails. Samoa has only ratified the *Berne Convention*<sup>36</sup>. The *Berne Convention* provides an international framework for protection of author's rights. (*A discussion of this convention is outside the scope of this paper.*)

Lastly, the Act specifies the duration of protection periods which are given to various categories of authors. A single author's economic and moral rights are protected during the life of the author and for seventy five (75) years after his or her death<sup>37</sup>. In a joint authorship, their economic and moral rights are protected during the life of the last surviving author and for seventy five (75) years after his or her death<sup>38</sup>. In the case of a collective work (other than applied art or audio visual work) economic and moral rights are protected for seventy five (75) years starting from the date when it was made<sup>39</sup>. In relation to a work published anonymously, the economic and moral rights are protected for seventy five (75) years beginning from the date which the work was first published<sup>40</sup>. The economic and moral rights in an applied art (e.g. a cup decorated with designs) are protected for twenty five (25) years commencing from the date when the work was made<sup>41</sup>.

### 3.1.1) Protection of expressions of folklore:

The protection of expressions of folklore is also specifically addressed under the Act. The definition given to expressions of folklore is, a group and tradition-based creation of groups or individuals reflecting the expectations of the community as an adequate

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<sup>35</sup> *Copyright Act* s. 33.

<sup>36</sup> *Berne Convention for the Protection of Literary and Artistic Works*, opened for signature 9 July 1886, 943 UNTS 178, art 6bis (entered into force in Samoa in July 21, 2006).

<sup>37</sup> *Copyright Act* s. 16(1).

<sup>38</sup> *Copyright Act* s. 16(2).

<sup>39</sup> *Copyright Act* s. 16(3).

<sup>40</sup> *Copyright Act* s. 16(4).

<sup>41</sup> *Copyright Act* s. 16(5).

expressions of its cultural and social identity, standards and values as transmitted orally by imitation or by other means<sup>42</sup>. This provision has not been tested in the local courts. However, it seems to mean that for a creation to be accepted as an expression of folklore, it initially must be a creation based on traditions of an identified group of people or community. Secondly, the relevant community must accept such creation as an adequate expression of its values, standards, social identity and culture.

A broad list of examples of how folklore can be expressed is also incorporated in the definition given. It includes tales, poetry, riddles, songs and instrumental music, dances, plays, art, drawings, paintings, carvings, sculptures, pottery, terra-cotta, mosaic, woodwork, metal wares, jewellery, handicrafts, costumes and indigenous textiles.

The protection offered safeguards against reproduction, communication to the public by performance, broadcasting, distribution by cable or other means and adaptation, translation and other transformations made either for commercial purposes or outside their traditional or customary context<sup>43</sup>.

In addition to customary exception and general exceptions in Part I, the Act also allows the use of expressions of folklore by a person exclusively for his/her personal purposes; short excerpts for reporting current events; and solely for face to face teaching or scientific research<sup>44</sup>.

Anyone who wishes to use an expression of folklore for commercial purposes or in a manner outside its traditional or cultural context has to seek permission from the competent authority determined by the Minister of Justice. It is a requirement that the community or place from where the expression of folklore was derived from be specifically indicated every time it is published or communicated to the public.

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<sup>42</sup> *Copyright Act* s. 2.

<sup>43</sup> *Copyright Act* s. 29(1).

<sup>44</sup> *Copyright Act* s. 29(2).

Any person who uses an expression of folklore for commercial purposes or in a way that does not fall under any of the exceptions is liable to the competent authority for damages, injunctions or any other remedies that the court would deem fit in each claim<sup>45</sup>.

All monies collected from expressions of folklore for fees, damages and compensation are to be used for the development of culture<sup>46</sup>. The Act does not give any guidance on how such monies are to be used for the development of culture.

### 3.1.2) Limitations

Copyright law only protects tangible manifestations of the mind. When an idea is captured or fixed in a physical form that an owner can exert possession over, it will be protected. For example, a song can be given protection if the notes or words are reduced to writing or recorded. Therefore, copyright protection would only be applicable to expressions of culture. Traditional knowledge can only be protected when they become embodied as an expression of culture.

Furthermore, not all expressions of culture can be protected under copyright law. It is, only those that can fit under the definition of literary or artistic domain or expressions of folklore. The definition of expression of folklore is wide enough to cover most expressions of culture except few that can be addressed under patent law.

In addition, an expression of culture will have to be an original work before it can be protected. In the judgment of the Honourable Chief Justice Sapolu in *Fauolo v Gray*,<sup>47</sup> a case that was decided just before the enactment of the current Act, he takes the view that an original work can be a first creation or a derivative of that first creation. Therefore, in claiming copyright protection over an expression of culture, the alleged creator will have

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<sup>45</sup> *Copyright Act* s. 30.

<sup>46</sup> *Copyright Act* s. 29(5).

<sup>47</sup> [1997] WSSC 1; CP 364 1995 (5 August 1997).

to provide sufficient evidence that he or she was either the first creator or the creator of a derivative work.

It is important to note that the protection of a derivative creation may be dependent on the consent of the first creator, whether it was granted or not. Furthermore, it may be difficult to prove originality for some expressions of Samoan culture in cases where they would seem identical to existing ones. For example, the designs on many of *upeti* (printing boards) sold by hawkers around town all seem identical. However, in the case that such works cannot be protected as first creations they might qualify as derivative creations.

In relation to the extent of application of the Act, the Court of Appeal in *Galumalemana v. Timani Samau & Sons Truck Services Ltd*,<sup>48</sup> provided a good discussion on the subject. The Court in its findings found that the Act operates to protect original creations from 19 December 1972. The *Copyright Act 1913* (New Zealand) was the relevant law in Samoa prior to that. (*A discussion of the NZ Act is outside the scope of this paper.*) Therefore, protection under the Act is only limited to eligible expressions of culture created after 19 December 1972.

Problems would also arise when determining who has original ownership of economic rights in an expression of culture. In *Fauolo v. Gray*,<sup>49</sup> Chief Justice Sapolu when commenting on *Ladbroke (Football) Ltd v. William Hill (Football) Ltd*,<sup>50</sup> asserted that leadership and the act of making a request are not susceptible to copyright law because there is no copyright in a suggestion. He takes the view that a person must make material contributions to a creation before his or her rights to such a creation are recognised under copyright law. In light of such a discussion, an elder in a village who advises a group of women on *siapo* making would not have a right in the *siapo*. The elder must provide material contributions such as the pounding of the mulberry bark or drawing designs on the mulberry paper before it can be said that he or she has a moral or economic right in the *siapo*.

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<sup>48</sup> [2006] WSCA 6 (26 April 2006).

<sup>49</sup> [1997] WSSC 1; CP 364 1995 (5 August 1997).

<sup>50</sup> [1964] All ER 465.

Even if expressions of culture are given copyright protection, such protection is only for a limited time before it can be freely accessed by the public. It is highly likely that traditional owners of eligible works want the protection of their rights to continue endlessly. After all, it is an embodiment of their cultural and social identity, standards and values.

As mentioned earlier, the provisions regarding the protection of expressions of folklore are applicable to expressions of culture. These provisions have not been tested in the local courts to date hence their scope is unclear. However, it appears that the Act vests original economic rights in expressions of folklore in the competent authority referred to and not the relevant creators of expressions of folklore. This competent authority is yet to be determined. Moreover, it is unclear who has control over monies collected from transactions involving expressions of folklore. There is also no mention of the original creators getting a fair share from the use of their creations. In the absence of an express provision, there is no guarantee that traditional owners will get a fair share from any financial benefit obtained from their creations.

Furthermore, the Act does not require the seeking of prior and informed consent of the original creators and the members of a community or group whose cultural and social identity, standards and values are fixed in the expression of folklore in question, before authority is given to a commercial or non-customary user. The consent of the competent authority is the only requirement. It is possible that the competent authority would seek the prior and informed consent of the original creators before authorisation is given to potential users but in the absence of express provisions in the Act there is a great possibility that such prior and informed consent would not be sought particularly in cases where disputes would arise.

Lastly, an aggrieved copyright owner will have to bring a claim before a court against an infringer of his or her copyright before he or she can be compensated. The process is lengthy and costly hence it is unlikely that traditional owners will take out civil claims

unless it is worthwhile and they are confident of success. Trivial infringements however, can be addressed under the criminal sanctions.

It is also important to note the concerns of the International Bureau of WIPO regarding the inappropriateness of copyright law for protecting expressions of folklore.<sup>51</sup> In their view, even though relevant amendments have been made to the *Berne Convention* in 1967 to introduce copyright protection for folklore at the international level, it seemed that copyright law was not the right and certainly not the only means for protecting expressions of folklore. This is because copyright was author centric but in the case of folklore, an author - at least in the way in which the notion of "author" is conceived in the field of copyright - is absent. Because the existing system of copyright protection was not adequate for the protection of folklore, the Bureau recommended a new legal framework as a solution.

<b>Questions:</b>	<p><i>13. How can the Copyright Act be improved to make it more suitable for the regulation and protection of traditional knowledge and expressions of culture?</i></p> <p><i>14. Should exclusive rights in an expression of folklore/expression of culture be vested in a competent authority determined by the Minister of Justice or the creator?</i></p> <p><i>15. Who should benefit from monies earned from transactions in relation to trade in expressions of folklore?</i></p>
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### 3.2) Patents Protection

The *Patents Act 1972* confers an inventor with exclusive rights in his or her invention. An invention is defined in the Act as any manner of new manufacture; any new method of

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<sup>51</sup> *The Protection of Expressions of Folklore: The Attempt at International Level* at <http://itt.nissat.tripod.com/itt9903/folklore.htm> (Accessed 10 June 2010)

application of known processes or the improvement or control of known processes<sup>52</sup>. The exclusive right in an invention is conferred by a letters patent<sup>53</sup>. A letters patent provides an inventor with a temporary legal monopoly over the using, selling, or making his or her said invention in Samoa, and of authorising others to do so, for a term of sixteen (16) years from the date of issue of the letters patent<sup>54</sup>. The rights and privileges created by a letters patent are alienable<sup>55</sup>.

When the period of protection lapses the protected invention goes into the public domain and is freely accessible by the public.

An invention is patentable under the Act if it satisfies certain requirements. Firstly, the invention must be new. That is, it was never known to the public domain before the invention was discovered or before the invention was disclosed during the patent application process. Secondly, the invention must have a specific utility. That is, it must be useful.

### *3.2.1) Limitations*

Patent protection can be given only to traditional knowledge that satisfy the requirements of the Act. This means that a traditional knowledge must first qualify to be an invention. Secondly, such traditional knowledge must be new. Thirdly, the traditional knowledge concerned must be useful. The stringent requirements, limit the types and number of traditional knowledge that can be protected under patent law. However, keen traditional owners can still hope to take advantage of the costly and lengthy patent registration process. That is, they can still apply for registration and may be successful if a member of the public does not object and the Attorney General approves their applications.

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<sup>52</sup> *Patent Act 1972 s. 2.*

<sup>53</sup> *Patent Act 1972 s. 4.*

<sup>54</sup> *Patent Act 1972 s. 4(2).*

<sup>55</sup> *Patent Act 1972 s. 12.*

The inclusive definition given to 'inventor' under the Act is wide enough to embrace traditional owners. However, the Act is silent on whether an inventor can be a group of people. In the absence of any clear guidance in case law, it is unclear whether the provisions of the Act are wide enough to cover collectively owned traditional knowledge based inventions. An express recognition of collective ownership would be suitable for traditional societies, given that most traditional knowledge are owned collectively. For example, the traditional knowledge related to the production of the *mamala* concoction that is used by Epenesa Mauigoa of Falealupo to treat hepatitis, is likely to belong to her family rather than her alone.

However, nothing would stop a group of traditional owners from appointing a single representative to obtain a patent on their behalf. The group can also incorporate themselves into a company and take out a patent on a particular traditional knowledge.

The requirement for full disclosure of an invention when applying for patent registration is another limiting factor. If an application fails, any traditional knowledge related to an invention in a failed application is now in the public domain and cannot be retracted. In the absence of clear statutory guidelines, traditional owners would hesitate to seek protection under the patent law.

There is also the issue regarding the finite period of patent protection which would be given to a patented invention. Any traditional knowledge linked to a patented invention would be in the public domain after sixteen (16) years. It is highly likely that traditional owners would approve of their traditional knowledge being freely accessible by others who are not members of their group. The whole process maybe counter productive given the short period of protection after which time the traditional knowledge is available to the public.

The Act also does not provide any guidance as to legal recourses that would be available to a disgruntled traditional owner whose patent has been infringed. However, as evident in *China Construction Realty Ltd v. China International Club Ltd.*,<sup>56</sup> the owner of a patent can rely on civil remedies to protect any infringement of their patent. But, given the cost involved in bringing such a claim before a court, a traditional owner would only do so if it is worthwhile. Therefore, it would have been helpful if criminal sanctions were available under the Act. That would mean any patent owner who cannot afford to bring a civil claim against a rich company that has infringed his or her patent can rely on the police or prosecutors protecting his or her interests.

<b>Question:</b>	<i>16. How can the Patents Act be improved to make it more suitable for the regulation and protection of traditional knowledge and expressions of culture?</i>
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### 3.3) Trademarks protection

A trade mark is a mark used in the course of trade to indicate a connection between a natural or legal person and certain goods<sup>57</sup>. A mark can be words, phrases, symbols, designs or a combination of these. The *Trademarks Act 1972* confers the owner of a trade mark with exclusive rights to the use of such trade mark in connection with the goods in respect of which it was registered<sup>58</sup>. This means they can assign or transmit their marks for a consideration<sup>59</sup>.

The prime purpose of trade marks was concisely expressed by the Supreme Court of the United States in *Hanover Star Milling Co. v Metcalf*.<sup>60</sup> It is to identify the origin or ownership of the goods to which it is affixed. It is a marketing short-cut which persuades

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<sup>56</sup> [2007] WSSC 52 (3 July 2007).

<sup>57</sup> *Trademarks Act 1972* s. 2.

<sup>58</sup> *Trademarks Act 1972* ss. 2 and 15.

<sup>59</sup> *Trademarks Act 1972* s. 15.

<sup>60</sup> (1916) 240 US 403, 412.

customers to select what they want or what they had been led to believe they want<sup>61</sup>. It protects customers from buying inferior products. On the other hand, it also works to protect a proprietor from others who may wish to benefit from the success of his or her products.

A mark is registrable as a trade mark if it satisfies certain requirements<sup>62</sup>. It must be registered in respect of particular goods or classes of goods as classified in the First Schedule to the Act. The mark to be registered must also be distinctive. Being distinct means the mark does not resemble any other existing word, phrase, symbol or design associated with a similar product.

An interested person must apply in writing to the Registrar of Trademarks (Registrar of the Supreme Court) to register a trade mark<sup>63</sup>. If the application is successful, he or she will be issued with a certificate of registration as proof of registration<sup>64</sup>. The successful applicant can enforce his or her exclusive rights against infringers of such a trade mark. This protection upon registration is for a period of fourteen (14) years and it may be extended through re-registration<sup>65</sup>.

### 3.3.1) Limitations

When registering a traditional knowledge as a trade mark, it must satisfy the statutory requirements before it can be registered. Firstly, it must qualify as a registrable mark. That means a traditional knowledge needs to be transformed into a word, phrase, symbol, design or a combination of these before they can become a registrable mark. Hence, a traditional knowledge has to be transformed into an expression of culture that satisfies requirements of the Act before it can become registrable. This would operate to exclude a traditional knowledge that is incapable of being transformed into an expression of culture, as well as an expression of culture that cannot be fashioned into one of the prescribed forms.

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<sup>61</sup> *Mishawaka Rubber and Woollen Mfg Co v SS Kresge Co* (1942) 316 US 203, 205.

<sup>62</sup> *Trademarks Act 1972* s. 5.

<sup>63</sup> *Trademarks Act 1972* s. 6.

<sup>64</sup> *Trademarks Act 1972* s. 9.

<sup>65</sup> *Trademarks Act 1972* s. 13.

Secondly, the expression of culture must be distinctive. That is, such expression of culture must not resemble any existing trade mark. The prohibition of the use of geographical names, matai titles and surnames by the Act also means that the names of villages or family names cannot be registered.

The last condition requires the expression of culture to be registered in respect of goods or classes of goods classified in the First Schedule to the Act. The list includes chemical products, building materials, machinery and electrical appliances, foodstuff, scientific apparatus, metal products, tools, utensils, vehicles and spare parts, textiles, leather products, wooden products, agricultural products, groceries, alcohol and tobacco.

Once registered, the expression of culture is protected as a trade mark and must be used in connection with the goods in which it was registered. If it is used outside the prescriptions of the Act without legitimate justifications, it will be removed from the trade mark register. This goes to prove that monopoly guaranteed under a trade mark is in a proprietor's trade and not in the trade mark.

However, Justice Laddie in *Wagamama Ltd v City Centre Restaurants Plc and Another*,<sup>66</sup> commented that the scope of such a monopoly can be broadened to include the trademark itself. He claimed that such a monopoly could be likened to a quasi-copyright in the mark, but unlike copyright, there would be no fixed duration for the right and it would be a true monopoly effective<sup>67</sup> against copyist and non-copyist alike. If such an extension would mean that proprietors would have the sole right to deal with their trade marks even to the extent of restraining conduct that is injurious to them, then it is highly likely that such a modification would suit traditional owners. On the other hand,

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<sup>66</sup> [1995] FSR 713.

<sup>67</sup> [1995] FSR 713.

such a reform would inflate the trade mark register to the extent that it will be difficult to maintain.

Traditional owners who are interested in selling their expressions of culture can also register a trade mark in respect of their products. This was a strategy used by the *Seri* people of Mexico when facing competition from mass production. They registered a trade mark to protect authentic ironwood products that are produced through their traditional methods<sup>68</sup>.

The list of goods under the First Schedule to the Act may need to be extended to capture a wider range of expressions of culture if found to be restrictive. This latter approach will create a competitive advantage over similar products that are alike but are not traditional knowledge-based. It also helps to certify the authenticity of their products. But, this would only suit traditional owners who are keen to market their expressions of culture. It also does not protect against imitators and pirates reproducing such expressions of culture for commercial purposes.

Therefore, given the function of a trade mark and the limited forms of expressions of culture that can be protected under it, it is doubtful whether trade mark law can single-handedly provide the much needed regulation and protection of traditional knowledge and expressions of culture.

<b>Question:</b>	<i>17. How can the Trademarks Act be improved to make it more suitable for the regulation and protection of traditional knowledge and expressions of culture?</i>
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<sup>68</sup> *Intellectual Property and Traditional Knowledge: Booklet No. 2*, World Intellectual Property Organization Publication No. 920(E), p. 19.

### 3.4) Industrial Designs Protection

Industrial design is the skill of creating and developing concepts and specifications that optimize the function, value and appearance of products and systems for the common benefit of both user and manufacturer. It is a combination of applied art and applied science, whereby the aesthetics and usability of mass-produced products may be improved for marketability and production<sup>69</sup>.

The definition given in the *Industrial Designs Act 1972* is:

*“ ... any assemblage of lines or colours designed to give a special appearance to an industrial or artisanal product, and any plastic form, whether or not associated with colours, provided such assemblage or form can serve as a pattern for the manufacture of an industrial or artisanal product but does not include anything in the industrial design which serves solely for the obtaining of a technical result;”*<sup>70</sup>

A person who wishes to register an industrial design in Samoa has to apply to the Registrar of Designs. Any application should satisfy all the listed statutory requirements before being accepted for registration<sup>71</sup>. These requirements include: a written request for registration; name and address of applicant or an address for service in the case of a foreign applicants; a sample of the product which the design is incorporated or a graphic representation in colour; and indication of products for which the industrial design will be used<sup>72</sup>. Successful applicants will be registered and issued certificates of registration<sup>73</sup>.

The effect of registration is such that it gives the registered owner exclusive right to the industrial design. That is, the right to restrain others from reproduction of the industrial design protected; offering any product incorporating the industrial design for sale or utilisation and holding such products for offering it for sale or utilisation<sup>74</sup>.

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<sup>69</sup> [http://www.absoluteastronomy.com/topics/Applied\\_art](http://www.absoluteastronomy.com/topics/Applied_art) (Accessed 10 March 2010)

<sup>70</sup> *Industrial Designs Act 1972* s. 2.

<sup>71</sup> Refer to relevant sections of the *Industrial Designs Act 1972*.

<sup>72</sup> *Industrial Designs Act 1972* s. 7.

<sup>73</sup> *Industrial Designs Act 1972* s. 11.

<sup>74</sup> *Industrial Designs Act 1972* ss. 16(1) (a) to 16(1) (c).

The rights conferred by the registration of an industrial design can be alienated temporarily through the granting of licences,<sup>75</sup> or permanently either through assignment or transmission through succession<sup>76</sup>.

The protection offered through registration is only against acts done for industrial and commercial purposes<sup>77</sup>. The rights conferred do not extend to acts done to the product incorporating the protected industrial design after it has been sold only in the case of duplication or substantial copying of the protected design<sup>78</sup>. The duration of such protection under Industrial Designs Act is for a period of 5 years determined from the date of application and is renewable<sup>79</sup>.

#### 3.4.1) Limitations

Industrial design law can be used to protect expressions of culture that can be applied to products to increase their function, value and appearance. For example, traditional artworks, models, designs and fashions.

The scope of such protection is limited to designs that are new and have not been available to the public. This means that only new expressions of culture can be registered and protected under the Industrial Designs Act. The Act does not provide a clear definition of what it means by “new” and whether a special exception can be made in relation to expressions of culture.

The *Industrial Designs Act* establishes rights akin to economic and exclusive rights. This would seem adequate for owners of expressions of culture to engage in simple transactions. But economic rights would not be sufficient to protect their interests in the

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<sup>75</sup> *Industrial Designs Act 1972* ss. 19 to 22.

<sup>76</sup> *Industrial Designs Act 1972* s. 17.

<sup>77</sup> *Industrial Designs Act 1972* s. 16(3).

<sup>78</sup> *Industrial Designs Act 1972* s. 16(4).

<sup>79</sup> *Industrial Designs Act 1972* ss. 14 and 15.

case of abuse and offensive use of such cultural expressions and/or related traditional knowledge by a third party.

The Act does not provide a mechanism by which an interested third party can obtain the consent of traditional owners for the use of an expression of culture and related traditional knowledge. Distribution of benefits acquired from any resulting transactions should also be regulated to ensure that they are distributed fairly amongst the right traditional owners.

<b>Question:</b>	<i>18. How can the Industrial Designs Act be improved to make it more suitable for the regulation and protection of traditional knowledge and expressions of culture?</i>
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### 3.5) Other applicable laws

In addition to conventional legal frameworks, the protection of certain expressions of culture can be obtained from the *Samoan Antiquities Ordinance 1954*.

The *Ordinance* provides for the protection and preservation of Samoan antiquities. Antiquities are defined under the Ordinance as Samoan relics and articles manufactured with ancient Samoan tools and according to Samoa customs and methods<sup>80</sup>. It also includes all other articles or things of historic, anthropological, or scientific value or interest and relating to Samoa including Samoan fine mats, orators staffs, orators fly whisks, ceremonial headdress and other artefacts but does not include any botanical or mineral collections or specimens<sup>81</sup>. In the case of a dispute as to the scope of the

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<sup>80</sup> *Samoa Antiquities Ordinance 1954*, s 2.

<sup>81</sup> *Samoa Antiquities Ordinance 1954*, s 2.

Ordinance, the Head of State has the final say as to what articles or things are within its scope<sup>82</sup>.

The Ordinance operates to prevent unauthorised exportation of Samoan antiquities. It empowers officers of Customs to seize and detain any Samoan antiquities about to be removed illegally from Samoa<sup>83</sup>. The Head of State may authorise the export of any antiquities<sup>84</sup>. A Customs officer may authorise the export of fine mats<sup>85</sup>.

The Head of State may make the granting of his/her authorisation conditional upon the making of copies of antiquities to be exported either through photography, cast or in any such manner as the Head of State directs<sup>86</sup>. These copies are the property of the Government of Samoa for the use of the people of Samoa<sup>87</sup>.

### 3.5.1) *Limitations*

The Samoan Antiquities Ordinance is a potential measure that can be used to protect local expressions of culture. It can operate as a border protection measure, regulating the taking of expressions of culture out of Samoa.

However, the effectiveness of any protection provided under the Ordinance is hindered by the fact that it is only limited to expressions of culture that can fit under the definition of antiquities. That is, protection would only be given to expressions of culture manufactured with ancient Samoan tools and according to Samoan customs and methods. This would exclude expressions of culture created with new technology or a new method, which may be a more economical and faster way to reproduce such expressions of culture for the tourism market.

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<sup>82</sup> *Samoa Antiquities Ordinance 1954*, s 9.

<sup>83</sup> *Samoa Antiquities Ordinance 1954*, s 5.

<sup>84</sup> *Samoa Antiquities Ordinance 1954*, ss. 6 and 7.

<sup>85</sup> *Samoa Antiquities Ordinance 1954*, s. 4.

<sup>86</sup> *Samoa Antiquities Ordinance 1954*, s. 8.

<sup>87</sup> *Samoa Antiquities Ordinance 1954*, s. 9.

Furthermore, protection can only be warranted to expressions of culture that are articles or things of historic, anthropological or scientific value and relating to Samoa. This can limit such protection to old and ancient articles leaving recently manufactured expressions of culture vulnerable to exploitation and abuse.

The Ordinance is also explicit that it does not protect botanical, mineral collections or specimens. This potentially means that the Ordinance cannot protect expressions of culture that deal with the use of herbs as in the case of traditional medicine or any other products made from local minerals.

In addition, the absence of proper guidelines to how the Head of State may exercise his or her discretion under the Ordinance particularly in relation to articles and things that can be covered under the Antiquities Ordinance during disputes allows for uncertainty as to its real scope.

<b>Question:</b>	<i>19. How should the Samoa Antiquities Ordinance be improved to make it more suitable for the regulation and protection of traditional knowledge and expressions of culture?</i>
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### 3.6) *A Case for Law Reform?*

A brief analysis of the conventional legal frameworks reveals that they are not totally incompatible. These conventional frameworks can still be used to regulate and protect traditional knowledge and expressions of culture despite limitations. Identical frameworks have also been reformed and are successfully being utilised in other jurisdictions to regulate and protect traditional knowledge and expressions of culture. Therefore, the important concerns are, how efficient are these conventional legal frameworks in other jurisdictions and whether law reform would be the answer.

In the next part, this paper will look at reforms in China to improve the relevance of conventional legal frameworks to traditional knowledge and expressions of culture.

### 3.6.1) *China*

China has modified its Patent laws and relevant regulations to provide for the protection of its traditional medicine<sup>88</sup>.

#### ➤ *Patent Law of 2000*

The purpose of *Patent Law 2000* is to accelerate inventors' enthusiasm and stimulate innovation<sup>89</sup>. It is also aimed at providing an important and effective means of traditional medicine intellectual property protection. The scope of this protection covers product,<sup>90</sup> method<sup>91</sup> and the use<sup>92</sup> of medicine<sup>93</sup>.

The conditions of protection of traditional knowledge under *Patent Law 2000* are novelty,<sup>94</sup> inventiveness,<sup>95</sup> and practical applicability<sup>96</sup>. A successful applicant is given a certificate of patent<sup>97</sup> upon registration<sup>98</sup>. This gives the holder exclusive rights to prevent third parties not having the right holders' consent from making, using, offering for sale, selling or importing the patented invention and to bringing litigation when infringement occurs.

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<sup>88</sup> *Patent Law 2000* (of the People's Republic of China); *Regulations on the Protection of Varieties of Chinese Traditional Medicine* cited in WIPO/GRTKF/IC/5/INF/4.

<sup>89</sup> Above n. 88.

<sup>90</sup> Product is defined in the context of the *Patent Law 2000* (China) as a new pharmaceutical composition and preparation thereof, effective ingredient extracted/separated from traditional medicine, effective parts and preparation thereof, new preparation of changing the administration route, etc.

<sup>91</sup> Method is defined in the context of the *Patent Law 2000* (China) as a preparation method of the products mentioned above, new or improved technology of production, etc.

<sup>92</sup> Use is defined in the context of the *Patent Law 2000* (China) as the new indication of medicine, first medical use, the second use of the known medicine, etc.

<sup>93</sup> *Patent Law of 2000* (China)

<sup>94</sup> That is, determined in accordance to the principle of complete identity of technical solution.

<sup>95</sup> That is, determined by comparing the prominent substantive features and notable progress of new product/process with the existing technology.

<sup>96</sup> That is, the product having medical effect; methods can be carried out or exploited industrially; use can be realized industrially;

<sup>97</sup> *Patent Law 2000* (China) Art. 39.

<sup>98</sup> *Patent Law 2000* (China) Chapt. III.

The *Patent Law 2000* establishes a patent administration department under the State Council, which is responsible for patent work throughout the country. It receives and examines patent applications and grants patent rights for inventions-creations in accordance with law<sup>99</sup>. The patent administration departments hold administrative authority for patent affairs under governments of provinces, autonomous regions and municipalities directly under the Central Government and are responsible for the administrative work concerning patents in their respective administrative areas.

It is also the responsibility of these patent administration departments to maintain a Traditional Chinese Medicine (TCM) Patent Database required for the defensive protection of patents<sup>100</sup>.

Protection under *Patent Law 2000* is limited to only 20 years counted from the date of filing the patent application.

➤ *Regulations on the Protection of Varieties of Chinese Traditional Medicine*

The purpose of *Regulations on the Protection of Varieties of Chinese Traditional Medicine* is to improve product quality, normalize the market, and wash out low quality medicine<sup>101</sup>.

The protection provided under the relevant regulations is limited to Chinese traditional medicine that fulfils official criteria. They are, medicines produced only in China that do not qualify for patent protection and categorised within the officially recognised classes. It is important to note that these regulations do not provide for conventional requirements such as novelty but it is necessary for all traditional medicine to pass a quality inspection in order for any relevant protection to be granted.

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<sup>99</sup> *Patent Law 2000* (China) Art. 3.

<sup>100</sup> That is *Patent Law 2000* provides for the establishment and use of advanced search tools for patent and non-patent literature during substantive examination of Traditional Knowledge related patent applications.

<sup>101</sup> Above n. 88.

Therefore, protection given under such regulations only gives holders the right to manufacture or produce traditional medicines on the basis that their methods are safe. Any manufacture by unauthorised producers will be dealt with by the Health Department of local governments. The period of protection under these regulations, vary from seven (7) to thirty (30) years.

<b>Question:</b>	<i>20. What is full protection of traditional knowledge and expressions of culture?</i>
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#### **4) A NEW LEGAL FRAMEWORK**

New legal frameworks have been adopted by some jurisdictions. These new legal frameworks provide specifically for the protection of traditional knowledge and expressions of culture. They guarantee proper regulation and full protection to traditional knowledge and expressions of culture. They also embrace local customary laws and are fashioned to complement conventional frameworks. This move fits in well with the international call for the recognition of rights of indigenous peoples<sup>102</sup>.

In the next part, this paper will look at legislative developments undertaken by the Pacific Islands Forum Secretariat and the African Union, which are aimed at providing appropriate legal frameworks to effectively regulate and protect the traditional knowledge and expressions of culture of their member countries.

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<sup>102</sup> See United Nations Draft Declaration on the Right of Indigenous Peoples, Art. 29., available at <http://www.ohchr.org/english/issues/indigenous/docs/declaration.doc>.

#### 4.1) Pacific Islands Forum Secretariat's Model Law

The mandate of the Pacific Island Forum Secretariat to develop frameworks for traditional knowledge protection arose at the Forum Trade Ministers Meeting in 1999<sup>103</sup>. A Model Law for the protection of traditional knowledge was produced as a result.

The PIFS Model Law establishes a new range of statutory rights for traditional owners of traditional knowledge and expressions of culture. It provides a basis for Pacific Island countries wishing to enact legislation for the protection of traditional knowledge and expressions of culture. Cook Islands, Fiji, Kiribati, Palau, Papua New Guinea and Vanuatu have adopted the PIFS Model Law.

The policy objective of the PIFS Model Law is to protect the rights of traditional owners in their traditional knowledge and expressions of culture and permit tradition-based creativity and innovation, including commercialisation thereof, subject to prior and informed consent and benefit sharing. It reflects the policy that it should complement and not undermine intellectual property rights.

The development of the model law was guided by responses to a range of questions posed by Pacific Islands Forum Secretariat adopted from reports by the World Intellectual Property Organisation (WIPO)<sup>104</sup>. These questions are listed below.

- *What is the policy objective of the protection?*
- *What is the subject matter?*
- *Who owns the rights?*
- *What are the rights?*
- *How are the rights administered and enforced?*

<sup>103</sup> Traditional Knowledge Implementation Action Plan at: <http://www.forumsec.org.fj/resources/uploads/attachments/documents/Traditional%20Knowledge%20Action%20Plan%202009.pdf> (Accessed 13 January 2010).

<sup>104</sup> *Elements of a sui generis system for the protection of traditional knowledge created by the World Intellectual Property Organisation for consideration by the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore* at [www.wipo.int/export/sites/www/tk/en/igc/ngo/scbd\\_igc6.pdf](http://www.wipo.int/export/sites/www/tk/en/igc/ngo/scbd_igc6.pdf) (Accessed 9 Feb 2010)

- *How are the rights lost or how do they expire?*

The model law create new rights in traditional knowledge and expressions of culture. The rights created fall into two categories: traditional cultural rights and moral rights. Traditional cultural rights grant traditional owners exclusive rights in respect of a range of uses of traditional knowledge and expressions of culture that are non-customary in nature, irrespective of whether they are for commercial or non-commercial purposes. This includes the use of traditional knowledge and cultural expressions for the making of new creations and innovations based thereon ('derivative works').

The moral rights created for traditional owners are the right of acknowledgment, the right against false acknowledgment and the right against derogatory treatment of traditional knowledge and expressions of culture. The existences of these rights do not depend upon registration or other formalities.

The model law establishes procedures whereby consent can be obtained for the non-customary use of traditional knowledge and cultural expressions, including the making of derivative works. The intellectual property rights in derivative works created, is vested in the creator. In other words, intellectual property rights are fully respected, and the model makes it clear that the rights it creates are in addition to and do not affect intellectual property rights. However, should a derivative work or traditional knowledge and cultural expressions be used for commercial purposes, the user must share benefits with traditional owners, provide acknowledgement of the source of the traditional knowledge or expressions of culture and respect the traditional owners' moral rights.

The model law also provides two avenues by which a prospective user of traditional knowledge or expressions of culture for non-customary purposes can seek the prior and informed consent of the traditional owners for the use of the traditional knowledge or expressions of culture. These avenues are through applying to a 'Cultural Authority', which has functions in relation to identifying traditional owners and acting as a liaison between prospective users and traditional owners or directly approaching traditional owners.

In both cases, the prior and informed consent of the traditional owners is to be evidenced through an ‘authorised user agreement’. The Cultural Authority has an obligation to advise traditional owners about the terms and conditions of such user agreements and maintain a record of finalised authorised user agreements.

In terms of enforcement the model law proposes offences for contraventions of traditional cultural rights and moral rights. The first of the proposed offences is against the infringement of traditional rights of traditional owners<sup>105</sup>. Any person who makes a non-customary use of traditional knowledge or an expression of culture without the prior and informed consent of traditional owners would be liable upon conviction for a fine or imprisonment term or both fine and imprisonment term.

The second offence is against the infringement of traditional owners’ moral rights<sup>106</sup>. Any person who does an act or omits to do an act that would lead to the infringement of the moral rights of traditional owners without their prior and informed consent to such act or omission would be liable upon conviction for a fine or imprisonment term or both fine and imprisonment term.

The third offence is against the non-customary use of sacred–secret traditional knowledge or any expression of culture<sup>107</sup>. Any person who uses sacred-secret traditional knowledge or any expression of culture other than in accordance with a customary use would be liable upon conviction for a fine or imprisonment term or both fine and imprisonment term.

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<sup>105</sup> See *Model Law (PIFS)* cl. 26. If a person makes non-customary use of a Traditional Knowledge and Expressions of Culture (whether or not such use is of a commercial nature) and the traditional owners have not given their prior and informed consent to that use, the person is guilty of an offence.

<sup>106</sup> See *Model Law (PIFS)* cl. 27. If a person does an act or omission in relation to a Traditional Knowledge and Expressions of Culture that is inconsistent with the moral rights of the traditional owners and the traditional owners have not given their prior informed consent to the act or omission, the person is guilty of an offence.

<sup>107</sup> *Model Law (PIFS)* cl. 28.

The fourth offence deals with the importation<sup>108</sup> of articles that would infringe the traditional and moral rights of traditional owners and the exportation<sup>109</sup> of traditional knowledge and expressions of culture. The first arm of the offence captures people who import articles that relates to local traditional knowledge and expressions of culture knowing those imported articles would infringe the traditional and moral rights of traditional owners. Any person that would be convicted under this provision would be liable for a fine or imprisonment term or both fine and imprisonment term.

The second arm of the offence captures people who export traditional knowledge and expressions of culture for non-customary use without the prior and informed consent of traditional owners. Any person that would be convicted under this provision would be liable for a fine or imprisonment term or both fine and imprisonment term.

The model law also proposes an inclusive range of civil remedies available to traditional owners for the non-customary usage of their traditional knowledge and expressions of culture without their prior informed consent<sup>110</sup>. The remedies range from claims for damages for loss resulting from the unauthorized use of traditional knowledge or expression of culture, equitable orders such as injunction, order to account for profits and orders for the seizure of illegal objects to any order that the court considers appropriate in the circumstances<sup>111</sup>.

The possible limitations of the PIFS Model are its failure to address the issue concerning the indivisibility of traditional knowledge and any of its various forms of manifestation from customary land. That is, when a dispute arises concerning the ownership of a traditional knowledge questions as to its origin will be asked and most certainly, it will have some linkage to *matai* titles and customary land. Any dispute pertaining to customary land and *matai* titles are to be determined by the Land and Titles Court.

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<sup>108</sup> *Model Law (PIFS)* cl. 29(1).

<sup>109</sup> *Model Law (PIFS)* cl.29 (2).

<sup>110</sup> *Model Law (PIFS)* cl. 30.

<sup>111</sup> *Model Law (PIFS)* cl. 31.

The PIFS Model seems to encourage a hands-off approach when a dispute pertaining to traditional knowledge arises. It advises the relevant Cultural Authority to refer the matter to the persons concerned to be resolved<sup>112</sup>. It does offer some assistance by pointing at various mechanisms that can assist in resolving related disputes, such as mediation, alternative dispute resolution procedure and customary law and practice but it does not offer advice as to the customary land issue given that customary land tenure exists in most if not all of the members of the PIFS. On the other hand, perhaps this was left to be addressed by each respective member country.

Secondly, the scope of what is protected is problematic. The nature of the properties proposed to be protected under the PIFS Model Law is both tangible and intangible. There is the danger that when the focus is too wide then the strength and effectiveness of any protection to be offered can be limited. It might be better to address property rights in the intangible and tangible parts (expressions of culture) of traditional in separate pieces of legislation. This will make such legislation simple and easy to administer.

However, this is just a model and it can be tailored to suit the Samoan context.

<b>Questions:</b>	21. <i>What are some of advantages of the PIFS Model?</i> 22. <i>What are some of disadvantages of the PIFS Model?</i>
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#### 4.2) African Union Model

The African Union<sup>113</sup> Model Legislation for the Protection of Rights of Local Communities, Farmers and Breeders and Regulation of Access to Biological Resources (2000) provides for the conservation, evaluation and sustainable use of biological resources,<sup>114</sup> knowledge,<sup>115</sup> and technologies in order to maintain and improve their

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<sup>112</sup> *Model Law (PIFS)* cl. 18.

<sup>113</sup> Botswana, Gambia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Namibia, Sierra Leone, Somalia, Sudan, Swaziland, Tanzania, Uganda, Zambia, and Zimbabwe.

<sup>114</sup> “Biological resources” are defined to include “genetic resources, organisms or parts thereof, populations, or any other component of ecosystems, including ecosystems themselves, with actual or potential use or value for humanity.”

diversity<sup>116</sup>. It specifically aims to provide recognition, protection and support for the inalienable rights of local communities over their knowledge and technologies. It establishes an appropriate system for access to community knowledge and technologies.

The model promotes mechanisms for fair and equitable sharing of benefits arising from the use of community knowledge and technologies. It ensures effective participation of concerned communities in deciding the distribution of benefits deriving from knowledge and technologies. It also provides mechanisms for implementation and enforcement of rights of local communities and conditions of access to biological resources, community knowledge and technologies<sup>117</sup>.

The model law also regulates access,<sup>118</sup> use and exchange of traditional knowledge by those who are not members of any local community<sup>119</sup>. It provides for the establishment of National Competent Authorities, which receive applications from third parties and grant access to traditional knowledge. It also requires all applications to provide detailed descriptions of innovations, practices, knowledge or technologies associated with the biological resources and propose mechanisms for benefit sharing<sup>120</sup>.

The law also recognizes the right of local communities to refuse access to their traditional knowledge where such access will be detrimental to the integrity of their natural or cultural heritage<sup>121</sup>.

The model law is not specific about conditions of protection of traditional knowledge. It is left to National Competent Authorities to determine and set their own conditions<sup>122</sup>. National Competent Authorities are also expected to develop National Information

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<sup>115</sup> “Community knowledge” is defined as “the accumulated knowledge that is vital for conservation and sustainable use of biological resources and/or which is of socio-economic value, and which has been developed over the years in indigenous/local communities.”

<sup>116</sup> *Model Law 2000 (African Union)*, Art.2 (1) (i-iii).

<sup>117</sup> *Model Law 2000 (African Union)*, Part I.

<sup>118</sup> *Model Law 2000 (African Union)*, Art. 2(2) (ii).

<sup>119</sup> *Model Law 2000 (African Union)*, Art. 21(2).

<sup>120</sup> *Model Law 2000 (African Union)*, Art.4. (1)(xi) and 4(1) (x).

<sup>121</sup> *Model Law 2000 (African Union)*, Art.19.

<sup>122</sup> *Model Law 2000 (African Union)*, Article 58 (iv).

Systems to document community innovations, practices, knowledge and technologies<sup>123</sup>. Local communities are also expected to establish their own databases on local knowledge and technologies<sup>124</sup>.

Access to information deposited in National Information Systems and local databases are regulated by charters which set out the rights of the owners of the data.<sup>125</sup> It specifies that any access to such traditional knowledge is subject to the necessary prior informed consent of National Competent Authorities as well as concerned local communities<sup>126</sup>. Any access granted without consultation with the local communities is invalid and in violation of the prior informed consent requirement<sup>127</sup>.

National Competent Authorities grant access to traditional knowledge through written agreements between local communities on the one hand and applicants on the other<sup>128</sup>. The guidelines for these agreements specify that they must contain statements by applicants/collectors that they agree not to apply any intellectual property rights over biological resources and over traditional knowledge without the prior informed consent of the providers<sup>129</sup>. They also require commitments by applicants/collectors to provide for the sharing of benefits<sup>130</sup>.

The rights established under the model law are Community (Intellectual) Rights and Farmers' Rights. Community (Intellectual) Rights are the rights of communities over their innovations, practices, knowledge and technologies acquired through generations. It gives local communities the authority to use their innovations, practices, knowledge and technologies in the conservation and sustainable use of biological diversity and to benefit collectively from any such utilization<sup>131</sup>. This type of right is inalienable<sup>132</sup>. Farmers'

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<sup>123</sup> *Model Law 2000 (African Union)*, Arts. 58 (vi), 64 (1) and 65(1).

<sup>124</sup> *Model Law 2000 (African Union)*, Art. 64 (2).

<sup>125</sup> *Model Law 2000 (African Union)*, Art. 64 (3).

<sup>126</sup> *Model Law 2000 (African Union)*, Arts. 3(1), 5(1) and 18)

<sup>127</sup> *Model Law 2000 (African Union)*, Art. 5 (3).

<sup>128</sup> *Model Law 2000 (African Union)*, Art. 7.

<sup>129</sup> *Model Law 2000 (African Union)*, Art. 8 (1) (v).

<sup>130</sup> *Model Law 2000 (African Union)*, Art. 8(1) (vi).

<sup>131</sup> *Model Law 2000 (African Union)*, Art. 16(iii)-(v).

<sup>132</sup> *Model Law 2000 (African Union)*, Art. 23(1).

Rights are the rights of farmers' over their traditional knowledge of plant and animal genetic resources<sup>133</sup>.

The Model Law also recognises customary law and protocols<sup>134</sup>. It provides that customary laws and practices of local communities can assist in identifying, interpreting and ascertaining their local traditional knowledge<sup>135</sup>. Customary law also guides how local communities exercise their inalienable rights to access, use, exchange or share their biological resources<sup>136</sup>. The determination of rights available under customary law is done through consultations between National Competent Authorities and local communities<sup>137</sup>.

Sanctions are expressly provided under the model law as well. It stipulates that each state must establish appropriate agencies with the power to ensure compliance with the provisions of the model law<sup>138</sup>. Sanctions and penalties include; written warnings, fines, automatic cancellation/revocation of the permission for access, confiscation of collected specimens and permanent bars from access to community knowledge and biological resources.

Violations are publicised and reported by the relevant National Competent Authority to the secretariats of international agreements. Intergovernmental co-operation is also necessary to ensure that any violations outside of national jurisdiction are prosecuted accordingly. The model also embraces recourse to courts after exhaustion of all administrative remedies<sup>139</sup>.

<b>Questions:</b>	<i>23. What are some advantages of the African Union Model?</i> <i>24. What are some disadvantages of the African Union Model?</i>
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<sup>133</sup> *Model Law 2000 (African Union)*, Art. 26(1) (a).

<sup>134</sup> *Model Law 2000 (African Union)*, Art. 17.

<sup>135</sup> *Model Law 2000 (African Union)*, Art. 23(2).

<sup>136</sup> *Model Law 2000 (African Union)*, Art. 21(1).

<sup>137</sup> *Model Law 2000 (African Union)*, Art. 58(ii).

<sup>138</sup> *Model Law 2000 (African Union)*, Art. 67.2.

<sup>139</sup> *Model Law 2000 (African Union)*, Art. 68.

#### 4.3) PIFS Model vs. African Union Model

A brief comparison of the two models reveal the PIFS Model to be more comprehensive than the African Union Model. That is, the scope of the former encompasses all traditional knowledge and expressions of culture created, acquired or inspired for traditional, economic, spiritual, narrative, decorative or recreational purposes. The scope of the latter is limited to traditional biological and agricultural knowledge and resources.

The two models both encourage the creation of new legal frameworks, but the rights proposed to be established are distinct. That is, the African Union Model establishes only exclusive rights which are alienable. The PIFS Model on the other hand creates traditional cultural rights and moral rights, which are inalienable.

Both models aim to conserve and ensure the sustainable development of traditional knowledge. They promise to protect the rights of the owners and guarantee fair and equitable benefit sharing amongst them. However, only the PIFS Model allows and promotes creativity and innovation. That is, it recognises rights in derivative works, which are intellectual creation or innovation that are based upon or derived from traditional knowledge.

Finally, both the models promise all forms of protection. That is, positive and defensive protection and encourage the regulation of access. Positive protection is the recognition of rights in traditional knowledge and expressions of culture and the recognition of the need to acquire prior informed consent of owners before the appropriation of their traditional knowledge and expressions of culture.

Defensive protection involves the publishing of a traditional knowledge as a defensive measure to block third parties from patenting it. However, the problem with this is that it makes it easier for third parties to use the knowledge against the wishes of traditional knowledge holders.

Access control is merely regulating access by third parties by providing conditions to the use of traditional knowledge upon acquiring prior informed consent of traditional knowledge owners.

Both models allow for customary exceptions. That is, the customary use of traditional knowledge and expressions of culture do not give rise to any criminal or civil liability<sup>140</sup>.

<b>Questions:</b>	<p>25. <i>Should Samoa adopt a new legal framework for the regulation and protection of traditional knowledge and expressions of culture?</i></p> <p>26. <i>What are the advantages of adopting a new legal framework?</i></p> <p>27. <i>What are the disadvantages of adopting a new legal framework?</i></p> <p>28. <i>If you believe that a new legal framework is the best solution then what should be covered under the new legal framework?</i></p>
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## 5) SUMMARY

In their current forms, conventional legal frameworks can only protect certain aspects of traditional knowledge and expressions of culture. Legislative change can improve their efficiency. However, it is evident in the case of China that even if these conventional frameworks undergo modifications, there is no guarantee that all aspects of traditional knowledge and expressions of culture will be sufficiently regulated and protected.

The requirements under the *Patent Law of 2000* still follow those of conventional frameworks. The regulation and protection of traditional medicine are specifically provided under regulations. This means that the regulation and protection given under such subsidiary legislation can easily be overruled by any legislation. It also places interests in traditional knowledge and expressions of culture in a special class that is inferior to patented property interests directly protected under *Patent Law of 2000*.

Even if these conventional legal frameworks operate simultaneously, parts of traditional knowledge and expressions of culture would still be left unprotected. The features of

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<sup>140</sup> *Model Law (PIFS)*, cl. 8.

these conventional legal frameworks may not be suitable for the desires of traditional owners.

It is conceivable that any legislative change to conventional legal frameworks would not be extensive unless the related international intellectual property conventions undergo modifications first, as seen in the case of the amendments to the *Berne Convention* when incorporating the international protection of expressions of folklore.

Therefore, reviewing these conventional legal frameworks would only be for the purposes of enhancing their application to the appropriate aspects of traditional knowledge and expressions of culture only.

On the other hand, there has been high recommendation for the development of a new legal framework specifically aimed at regulating and protecting traditional knowledge and expressions of culture, in all the academic papers and special reports discussed in this paper. For example, the International Bureau of WIPO expressly stated that the protection of expressions of folklore does not sit well in copyright law and they recommended that such protection be provided under a new legal framework.

The feasibility of such a new framework is due mainly to the fact that it focuses on regulating and protecting traditional knowledge and expressions of culture. It proposes the recognition of inalienable rights in traditional knowledge and expressions of culture. This however has to be considered carefully as such a desire can hinder innovation and creativity in a society.

The consideration of the interests and welfare of traditional owners is also promoted in such a new framework. Traditional owners must have a say in the process of granting authority for the use of their traditional knowledge or expressions of culture for commercial purposes and any benefits obtained from related transactions must be distributed fairly. This must be given careful consideration as it can create onerous responsibilities on the Government and can hamper viable trade opportunities.

The new legal framework also encourages the use of customary laws and protocols. Given the perceivable relationship between traditional knowledge and customary land, customary law would best be used to determine disputes as to ownership of traditional knowledge and expressions of culture. Samoa already has a framework in place which is used to determine ownership of land and titles in the Samoan Land and Titles Court. This may mean that the jurisdiction of the Land and Titles Court would need to be extended to address such matters pertaining to traditional knowledge and expressions of culture.

Furthermore, there is the danger that such a comprehensive protection for traditional knowledge and expressions of culture under a new legal framework would place traditional knowledge and expressions of culture out of reach. This could limit innovation and creativity in a society and hinder any efforts to commercialise them. Hence, in such a situation, the selective protection of traditional knowledge and expressions of culture under the conventional legal frameworks would be preferable, to allow for the protection of specific areas of traditional knowledge and expressions of culture that require protection from abuse and exploitation by outsiders.

Irrespective of which path Samoa opts to take, the protection of the rights of Samoans in their traditional knowledge and expressions of culture is long overdue. This protection should be developed at both national and international levels. Proper regulation and protection would ensure that Samoan culture is preserved and valued. The right people would benefit from the commercial use of their traditional knowledge and expressions of culture. The Samoan economy would finally receive revenues it has been denied for many years due to the lack of proper regulation.

Any legislative change whether it be amending the conventional legal frameworks or the development of a new legal framework or both, should be carried out with reverence to Samoan customs and customary laws and if possible, complement existing frameworks.

## **6) SUMMARY OF QUESTIONS**

1. *What is your definition of traditional knowledge?*
2. *What are examples of traditional knowledge found in your village?*
3. *Do you think all sorts of traditional knowledge should be protected?*
4. *Who should traditional knowledge be protected from?*
5. *Who does traditional knowledge belong to?*
6. *Are all traditional knowledge linked to customary land?*
7. *What is your definition of expressions of culture?*
8. *What are examples of expressions of culture found in your village?*
9. *Do you think all sorts of expressions of culture should be protected?*
10. *Who should expressions of culture be protected from?*
11. *Who do expressions of culture belong to?*
12. *Are all expressions of culture linked to land?*
13. *How should the Copyright Act be improved to make it more suitable for the regulation and protection of traditional knowledge and expressions of culture?*
14. *Should exclusive rights in an expression of folklore/expression of culture be vested in a competent authority determined by the Minister of Justice or the creator?*
15. *Who should benefit from monies earned from transactions relation to trade in expressions of folklore?*
16. *How should the Patents Act be improved to make it more suitable for the regulation and protection of traditional knowledge and expressions of culture?*
17. *How should the Trademarks Act be improved to make it more suitable for the regulation and protection of traditional knowledge and expressions of culture?*
18. *How should the Industrial Designs Act be improved to make it more suitable for the regulation and protection of traditional knowledge and expressions of culture?*
19. *How should the Samoa Antiquities Ordinance be improved to make it more suitable for the regulation and protection of traditional knowledge and expressions of culture?*
20. *What is full protection of traditional knowledge and expressions of culture?*
21. *What are some of advantages of the PIFS Model?*
22. *What are some of disadvantages of the PIFS Model?*

23. *What are some advantages of the African Union Model?*
24. *What are some disadvantages of the African Union Model?*
25. *Should Samoa adopt a new legal framework for the regulation and protection of traditional knowledge and expressions of culture?*
26. *What are the advantages of adopting a new legal framework?*
27. *What are the disadvantages of adopting a new legal framework?*
28. *If you believe that a new legal framework is the best solution then what should be covered under the new legal framework?*

## **7) CALL FOR RESPONSES**

It is not necessary to respond to all questions. It is preferred that responses be in writing. Responses on this paper should be sent by<sup>^</sup> to the Executive Director, Samoa Law Reform Commission, Private Bag 974 or by email to [lawreform@ag.gov.ws](mailto:lawreform@ag.gov.ws).

Public Law 101-644  
101st Congress

An Act

Nov. 29, 1990  
[H.R. 2006]

To expand the powers of the Indian Arts and Crafts Board, and for other purposes.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,*

Indian Arts and  
Crafts Act of  
1990.

**TITLE I—INDIAN ARTS AND CRAFTS**

**SEC. 101. SHORT TITLE.**

25 USC 305 note.

This title may be cited as the "Indian Arts and Crafts Act of 1990".

**SEC. 102. POWERS OF INDIAN ARTS AND CRAFTS BOARD.**

Section 2 of the Act entitled "An Act to promote the development of Indian arts and crafts and to create a board to assist therein, and for other purposes" (25 U.S.C. 305a) is amended—

(1) in the first sentence—

(A) by striking "the Board" and inserting "the Secretary of the Interior through the Board"; and

(B) by striking "the Indian wards of the Government" and inserting "Indian individuals";

(2) by amending clause (g) to read as follows: "(g)(1) to create for the Board, or for an individual Indian or Indian tribe or Indian arts and crafts organization, trademarks of genuineness and quality for Indian products and the products of an individual Indian or particular Indian tribe or Indian arts and crafts organization; (2) to establish standards and regulations for the use of Government-owned trademarks by corporations, associations, or individuals, and to charge for such use under such licenses; (3) to register any such trademark owned by the Government in the United States Patent and Trademark Office without charge and assign it and the goodwill associated with it to an individual Indian or Indian tribe without charge; and (4) to pursue or defend in the courts any appeal or proceeding with respect to any final determination of that office;"; and

(3) by adding at the end the following new sentence: "For the purposes of this section, the term 'Indian arts and crafts organization' means any legally established arts and crafts marketing organization composed of members of Indian tribes."

**SEC. 103. REFERRAL FOR CRIMINAL AND CIVIL VIOLATIONS.**

The Act entitled "An Act to promote the development of Indian arts and crafts and to create a board to assist therein, and for other purposes" (25 U.S.C. 305 et seq.) is amended by adding at the end of the following:

25 USC 305d.

"SEC. 5. (a) The Board may receive complaints of violations of section 1159 of title 18, United States Code, and refer complaints of such violations to the Federal Bureau of Investigation for appropriate investigation. After reviewing the investigation report, the

Board may recommend to the Attorney General of the United States that criminal proceedings be instituted under that section.

“(b) The Board may recommend that the Secretary of the Interior refer the matter to the Attorney General for civil action under section 6.”

**SEC. 104. CRIMINAL PENALTY FOR MISREPRESENTATION OF INDIAN PRODUCED GOODS AND PRODUCTS.**

(a) **IN GENERAL.**—Section 1159 of title 18, United States Code, is amended to read as follows:

**“§ 1159. Misrepresentation of Indian produced goods and products**

“(a) It is unlawful to offer or display for sale or sell any good, with or without a Government trademark, in a manner that falsely suggests it is Indian produced, an Indian product, or the product of a particular Indian or Indian tribe or Indian arts and crafts organization, resident within the United States.

“(b) Whoever knowingly violates subsection (a) shall—

“(1) in the case of a first violation, if an individual, be fined not more than \$250,000 or imprisoned not more than five years, or both, and, if a person other than an individual, be fined not more than \$1,000,000; and

“(2) in the case of subsequent violations, if an individual, be fined not more than \$1,000,000 or imprisoned not more than fifteen years, or both, and, if a person other than an individual, be fined not more than \$5,000,000.

“(c) As used in this section—

“(1) the term ‘Indian’ means any individual who is a member of an Indian tribe, or for the purposes of this section is certified as an Indian artisan by an Indian tribe;

“(2) the terms ‘Indian product’ and ‘product of a particular Indian tribe or Indian arts and crafts organization’ has the meaning given such term in regulations which may be promulgated by the Secretary of the Interior;

“(3) the term ‘Indian tribe’ means—

“(A) any Indian tribe, band, nation, Alaska Native village, or other organized group or community which is recognized as eligible for the special programs and services provided by the United States to Indians because of their status as Indians; or

“(B) any Indian group that has been formally recognized as an Indian tribe by a State legislature or by a State commission or similar organization legislatively vested with State tribal recognition authority; and

“(4) the term ‘Indian arts and crafts organization’ means any legally established arts and crafts marketing organization composed of members of Indian tribes.

“(d) In the event that any provision of this section is held invalid, it is the intent of Congress that the remaining provisions of this section shall continue in full force and effect.”

(b) **CONFORMING AMENDMENT.**—The item relating to section 1159 in the table of sections for chapter 53 of title 18, United States Code, is amended to read as follows:

“1159. Misrepresentation of Indian produced goods and products.”

SEC. 105. CAUSE OF ACTION FOR MISREPRESENTATION OF INDIAN PRODUCED GOODS AND PRODUCTS.

The Act entitled "An Act to promote the development of Indian arts and crafts and to create a board to assist therein, and for other purposes" (25 U.S.C. 305 et seq.) (as amended by section 3) is further amended by adding at the end of the following:

25 USC 305e.

"SEC. 6. (a) A person specified in subsection (c) may, in a civil action in a court of competent jurisdiction, bring an action against a person who offers or displays for sale or sells a good, with or without a Government trademark, in a manner that falsely suggests it is Indian produced, an Indian product, or the product of a particular Indian or Indian tribe or Indian arts and crafts organization, resident within the United States, to—

"(1) obtain injunctive or other equitable relief; and

"(2) recover the greater of—

"(A) treble damages; or

"(B) in the case of each aggrieved individual Indian, Indian tribe, or Indian arts and crafts organization, not less than \$1,000 for each day on which the offer or display for sale or sale continues.

"(b) In addition to the relief specified in subsection (a), the court may award punitive damages and the costs of suit and a reasonable attorney's fee.

"(c)(1) A civil action under subsection (a) may be commenced—

"(A) by the Attorney General of the United States upon request of the Secretary of the Interior on behalf of an Indian who is a member of an Indian tribe or on behalf of an Indian tribe or Indian arts and crafts organization; or

"(B) by an Indian tribe on behalf of itself, an Indian who is a member of the tribe, or on behalf of an Indian arts and crafts organization.

"(2) Any amount recovered pursuant to this section shall be paid to the individual Indian, Indian tribe, or Indian arts and crafts organization, except that—

"(A) in the case of paragraph (1)(A), the Attorney General may deduct from the amount recovered the amount for the costs of suit and reasonable attorney's fees awarded pursuant to subsection (b) and deposit the amount of such costs and fees as a reimbursement credited to appropriations currently available to the Attorney General at the time of receipt of the amount recovered; and

"(B) in the case of paragraph (1)(B), the amount recovered for the costs of suit and reasonable attorney's fees pursuant to subsection (b) may be deducted from the total amount awarded under subsection (a)(2).

"(d) As used in this section—

"(1) the term 'Indian' means any individual who is a member of an Indian tribe; or for the purposes of this section is certified as an Indian artisan by an Indian tribe;

"(2) the terms 'Indian product' and 'product of a particular Indian tribe or Indian arts and crafts organization' has the meaning given such term in regulations which may be promulgated by the Secretary of the Interior;

"(3) the term 'Indian tribe' means—

"(A) any Indian tribe, band, nation, Alaska Native village, or other organized group or community which is

recognized as eligible for the special programs and services provided by the United States to Indians because of their status as Indians; or

“(B) any Indian group that has been formally recognized as an Indian tribe by a State legislature or by a State commission or similar organization legislatively vested with State tribal recognition authority; and

“(4) the term ‘Indian arts and crafts organization’ means any legally established arts and crafts marketing organization composed of members of Indian tribes.

“(e) In the event that any provision of this section is held invalid, it is the intent of Congress that the remaining provisions of this section shall continue in full force and effect.”.

**SEC. 106. PENALTY FOR COUNTERFEITING INDIAN ARTS AND CRAFTS BOARD TRADEMARK.**

Section 1158 of title 18, United States Code, is amended by striking “be fined not more than \$500 or imprisoned not more than six months, or both; and” and inserting “(1) in the case of a first violation, if an individual, be fined not more than \$250,000 or imprisoned not more than five years, or both, and, if a person other than an individual, be fined not more than \$1,000,000; and (2) in the case of subsequent violations, if an individual, be fined not more than \$1,000,000 or imprisoned not more than fifteen years, or both, and, if a person other than an individual, be fined not more than \$5,000,000; and (3)”.

**SEC. 107. CERTIFICATION OF INDIAN ARTISANS.**

25 USC 305e  
note.

For the purposes of section 1159 of title 18, United States Code, and section 6 of the Act entitled “An Act to promote the development of Indian arts and crafts and to create a board to assist therein, and for other purposes” (25 U.S.C. 305 et seq.) an Indian tribe may not impose a fee in certifying an individual as an Indian artisan. For the purposes of this section, the term “Indian tribe” has the same meaning given such term in section 1159(c)(3) of title 18, United States Code.

**TITLE II—TECHNICAL AND CLARIFYING AMENDMENTS**

**SEC. 201. SHORT TITLE.**

This title may be cited as the “Indian Self-Determination and Education Assistance Act Amendments of 1990”.

Indian Self-  
Determination  
and Education  
Assistance Act  
Amendments of  
1990.  
25 USC 450 note.

**SEC. 202. AMENDMENTS TO INDIAN SELF-DETERMINATION AND EDUCATION ASSISTANCE ACT.**

The Indian Self-Determination and Education Assistance Act is amended as follows:

(1) In section 4(h) of such Act (25 U.S.C. 450b(h)), delete “in existence on the date of enactment of the Indian Self-Determination and Education Assistance Act Amendments of 1988”.

(2) In section 4(j) of such Act (25 U.S.C. 450b(j)), delete “contract entered” each place it appears and insert in lieu thereof “contract (or grant or cooperative agreement utilized under section 9 of this Act) entered”.

(3) In section 5(d) of such Act (25 U.S.C. 450c(d)), delete the word “Any” and insert in lieu thereof “Except as provided in

section 8 or 106(a)(3) of this Act," and before the period insert the words "through the respective Secretary".

**SEC. 203. AMENDMENTS TO THE INDIAN SELF-DETERMINATION ACT.**

(a) Section 106 of the Indian Self-Determination Act (25 U.S.C. 450j-1(e)) is amended by deleting "1988" and inserting in lieu thereof "1992".

(b) In section 102(d) of such Act (25 U.S.C. 450f(d)), immediately after "investigations," insert "or for purposes of section 2679, title 28, United States Code, with respect to claims by any such person, on or after the date of the enactment of the Indian Self-Determination and Education Assistance Act Amendments of 1990, for personal injury, including death, resulting from the operation of an emergency motor vehicle,".

(c) Section 105(c)(1)(B) of such Act (25 U.S.C. 450j(c)(1)(B)) is amended to read as follows:

"(B) for a definite or an indefinite term, as requested by the tribe (or, to the extent not limited by tribal resolution, by the tribal organization), in the case of a mature contract."

(d) Section 105(d) of such Act (25 U.S.C. 450j(d)) is amended to read as follows:

"(d)(1) Beginning in fiscal year 1990, upon the election of a tribal organization, the Secretary shall use the calendar year as the basis for any contracts or agreements under this Act, unless the Secretary and the Indian tribe or tribal organization agree on a different period.

Reports.

"(2) The Secretary shall, on or before April 1 of each year beginning in 1992, submit a report to the Congress on the amounts of any additional obligation authority needed to implement this subsection in the next following fiscal year."

(e) In paragraphs (2) and (3) of section 105(f) of such Act (25 U.S.C. 450j(f) (2) and (3)), insert "or real" immediately after "personal" each place it appears in such paragraphs.

(f) In section 107(c) of such Act (25 U.S.C. 450k(c)), immediately after "authorized", insert the following: ", with the participation of Indian tribes and tribal organizations,".

(g)(1) In section 301(a)(3) of the Indian Self-Determination Act (25 U.S.C. 450h(a)(3)), delete "reservation boundaries" and insert in lieu thereof "Indian country (as defined in chapter 53 of title 18, United States Code)".

25 USC 450h  
note.

(2) The amendment made by paragraph (1) shall not alter or otherwise modify or affect existing prohibitions or limitations on the Secretary's authority to acquire lands in trust.

**TITLE III—AMENDMENTS TO OTHER ACTS**

**SEC. 301. AMENDMENTS TO OTHER ACTS.**

(a) **AMENDMENT TO INDIAN LAND CONSOLIDATION ACT.**—Section 207(a) of the Indian Land Consolidation Act (25 U.S.C. 2206) is amended by deleting "No undivided interest in any tract of trust or restricted land within a tribe's reservation or otherwise subject to a tribe's jurisdiction shall descend by intestacy or devise but shall escheat to that tribe" and inserting in lieu thereof the following: "No undivided interest held by a member or nonmember Indian in any tract of trust land or restricted land within a tribe's reservation or outside of a reservation and subject to such tribe's jurisdiction

shall descend by intestacy or devise but shall escheat to the reservation's recognized tribal government, or if outside of a reservation, to the recognized tribal government possessing jurisdiction over the land".

(b) AMENDMENT TO ACT OF NOVEMBER 8, 1988.—In section 1 of the Act entitled "An Act to declare that certain lands be held in trust for the Quinault Indian Nation, and for other purposes", approved November 8, 1988 (102 Stat. 3327), insert "and attached narrative metes and bounds description" immediately after "map" each time it appears.

(c) AMENDMENT TO THE ACT OF MARCH 29, 1956.—The second sentence of subsection (a) of the Act entitled "An Act to authorize the execution of mortgages and deeds of trust on individual Indian trust or restricted land", approved March 29, 1956 (25 U.S.C. 483a), is amended by inserting immediately before "State" the following: "tribe which has jurisdiction over such land or, in the case where no tribal foreclosure law exists, in accordance with the laws of the".

**SEC. 302. AMENDMENT TO THE ACT OF JUNE 24, 1938.**

Section 1 of the Act of June 24, 1938 (25 U.S.C. 162a) is amended by designating the existing text thereof as subsection (a), and by adding at the end thereof the following new subsection:

"(b)(1) Notwithstanding subsection (a), the Secretary of the Interior, at the request of any Indian tribe, in the case of trust funds of such tribe, or any individual Indian, in the case of trust funds of such individual, is authorized to invest such funds, or any part thereof, in guaranteed or public debt obligations of the United States or in a mutual fund, otherwise known as an open-ended diversified investment management company if—

"(A) the portfolio of such mutual fund consists entirely of public-debt obligations of the United States, or bonds, notes, or other obligations which are unconditionally guaranteed as to both interest and principal by the United States, or a combination thereof;

"(B) the trust funds to be invested exceed \$50,000;

"(C) the mutual fund is registered by the Securities and Exchange Commission; and

"(D) the Secretary is satisfied with respect to the security and protection provided by the mutual fund against loss of the principal of such trust funds.

"(2) The Secretary, as a condition to complying with a request pursuant to paragraph (1) of this subsection, is authorized to require such tribe or individual Indian, as the case may be, to enter into an agreement with the Secretary for the purpose of relieving the United States of any liability in connection with the interest, or amount thereof, payable in connection with such trust funds so invested during the period of that investment.

Government  
contracts.

"(3) Investments pursuant to paragraph (1) of this subsection shall be deemed to be the same as cash or a bank deposit for purposes of section 5 of the Act of September 21, 1959 (25 U.S.C. 955)."

**SEC. 303. AMENDMENT TO INDIAN FINANCING ACT OF 1974.**

(a) Section 101 of the Indian Financing Act of 1974 (25 U.S.C. 1461) is amended—

(1) by deleting "money markets," and inserting in lieu thereof the following: "money markets, or to supplement funds from

private lenders, including loans guaranteed by the Secretary pursuant to section 201 of this Act,"; and

(2) by inserting immediately before the period at the end of the third sentence a comma and the following: "or, in the discretion of the Secretary of the Interior, as a contribution to the Indian Loan Guaranty and Insurance Fund authorized by section 217 of this Act, or for the payment of interest subsidies authorized by section 301 of this Act".

(b) Section 204 of the Indian Financing Act of 1974 (25 U.S.C. 1484) is amended—

(1) by deleting in the first sentence the word "prior"; and

(2) by deleting in the second sentence "shall review" and inserting in lieu thereof "may review".

Hawaiian  
natives.

#### TITLE IV—PUBLIC HEALTH SERVICE ACT

##### SEC. 401. AMENDMENT TO PUBLIC HEALTH SERVICE ACT.

Section 338J(a) of subpart III of part D of title III of the Public Health Service Act (42 U.S.C. 254s) is amended to read as follows:

"(a) Subject to the availability of funds appropriated under the authority of subsection (d), the Secretary shall provide funds to Kamehameha Schools/Bishop Estate for the purpose of providing scholarship assistance to students who—

"(1) meet the requirements of section 338A(b), and

"(2) are Native Hawaiians."

Hawaiian  
natives.

#### TITLE V—BOARD OF INSTITUTE OF AMERICAN INDIAN AND ALASKA NATIVE CULTURE AND ARTS DEVELOPMENT

##### SEC. 501. GENERAL POWERS OF BOARD OF INSTITUTE OF AMERICAN INDIAN AND ALASKA NATIVE CULTURE AND ARTS DEVELOPMENT.

(a) INTEREST AND INVESTMENT INCOME.—Section 1507 of the American Indian, Alaska Native, and Native Hawaiian Culture and Art Development Act (20 U.S.C. 4414) is amended by adding at the end the following new subsection:

"(c) INTEREST AND INVESTMENTS.—Interest and earnings on amounts received by the Institute pursuant to section 1531 invested under subsection (a)(12) shall be the property of the Institute and may be expended to carry out this title. The Board shall be held to a reasonable and prudent standard of care, given such information and circumstances as existed when the decision is made, in decisions involving investment of funds under subsection (a)(12)."

(b) INSURANCE.—Section 1507(a)(11) of such Act (20 U.S.C. 4414(a)(11)) is amended to read as follows:

"(11) to the extent not already provided by law, to obtain insurance to cover all activities of the Institute, including coverage relating to property and liability, or make other provisions against losses."

##### SEC. 502. ESTABLISHMENTS WITHIN THE INSTITUTE.

Section 1510(b) of the American Indian, Alaska Native, and Native Hawaiian Culture and Art Development Act (20 U.S.C. 4417(b)) is amended—

- (1) in paragraph (2), by striking subparagraph (A) and redesignating subparagraphs (B) through (I) as subparagraphs (A) through (H), respectively;
- (2) by striking "and" at the end of paragraph (1);
- (3) by striking the period at the end of paragraph (2) and inserting "; and"; and
- (4) by inserting after paragraph (2) the following:  
 "(3) a Museum of American Indian and Alaska Native Arts, which shall be under the direction of the President of the Institute."

**SEC. 503. TRANSFER OF FUNCTIONS.**

Section 1514 of the American Indian, Alaska Native, and Native Hawaiian Culture and Art Development Act (20 U.S.C. 4421) is amended—

- (1) by striking subsections (d), (e), and (f); and
- (2) by adding at the end the following new subsection (d):  
 "(d) **FORGIVENESS OF AMOUNTS OWED; HOLD HARMLESS.**—(1) Subject to paragraph (2)—

"(A) the Institute shall be responsible for all obligations of the Institute incurred after June 2, 1988, and

"(B) the Secretary shall be responsible for all obligations of the Institute incurred on or before June 2, 1988, including those which accrued by reason of any statutory, contractual, or other reason prior to June 2, 1988, which became payable within two years of June 2, 1988.

"(2) With respect to all programs of the Federal Government, in whatever form or from whatever source derived, the Institute shall only be held responsible for actions and requirements, either administrative, regulatory, or statutory in nature, for events which occurred after July 1, 1988, including the submission of reports, audits, and other required information. The United States may not seek any monetary damage or repayment for the commission of events, or omission to comply with either administrative or regulatory requirements, for any action which occurred prior to June 2, 1988."

Reports.

**SEC. 504. COMPLIANCE WITH OTHER ACTS.**

Section 1517 of the American Indian, Alaska Native, and Native Hawaiian Culture and Art Development Act (20 U.S.C. 4424) is amended by adding at the end the following:

"(c) **OTHER FEDERAL ASSISTANCE.**—Funds received by the institute pursuant to this Act shall not be regarded as Federal money for purposes of meeting any matching requirements for any Federal grant, contract or cooperative agreement."

**SEC. 505. ENDOWMENT PROGRAMS.**

Section 1518 of the American Indian, Alaska Native, and Native Hawaiian Culture and Art Development Act (20 U.S.C. 4425) is amended to read as follows:

**"SEC. 1518. ENDOWMENT PROGRAMS.**

"(a) **PROGRAM ENHANCEMENT ENDOWMENT.**—

"(1)(A) From the total amount appropriated for this subsection pursuant to section 1531(a), funds may be deposited into a trust fund maintained by the Institute at a federally insured banking or savings institution.

“(B) The President of the Institute shall provide—

“(i) for the deposit into the trust fund referred to in subparagraph (A)—

“(I) of a capital contribution by the Institute in an amount equal to the amount of each Federal contribution; and

“(II) any earnings on the funds deposited under this paragraph; or

“(ii) for the reservation for the sole use of the Institute of any noncash, in-kind contributions of real or personal property, which property may at any time be converted to cash, which shall be deposited as a capital contribution into the trust fund referred to in subparagraph (A).

“(C) If at any time the Institute withdraws any capital contribution (as described in subparagraph (B)(i)) made by the Institute to the trust fund referred to in subparagraph (A) or puts any property (as described in subparagraph (B)(ii)) to a use which is not for the sole benefit of the Institute, an amount equal to the value of the Federal contribution shall be withdrawn from such trust fund and returned to the Treasury as miscellaneous receipts.

“(2) Interest deposited into the trust fund pursuant to paragraph (1)(B)(ii) may be periodically withdrawn and used, at the direction of the Board or its designee, to defray any expense associated with the operation of the Institute, including the expense of operations and maintenance, administration, academic and support personnel, community and student services programs, and technical assistance.

“(3) For the purpose of complying with the contribution requirement of paragraph (1)(B), the Institute may use funds or in-kind contributions of real or personal property fairly valued which are made available from any private or tribal source, including interest earned by the funds invested under this subsection. In-kind contributions shall be other than fully depreciable property or property which is designated for addition to the permanent collection of the Museum and shall be valued according to the procedures established for such purpose by the Secretary of the Treasury. For purposes of this paragraph, all contributions, including in-kind and real estate, which are on-hand as of the date of enactment of this Act and which have been received after June 2, 1988, but which have not been included in computations under this provision shall be eligible for matching with Federal funds appropriated in any fiscal year.

“(4) Amounts appropriated under section 1531(a) for use under this subsection shall be paid by the Secretary of the Treasury to the Institute as a Federal capital contribution equal to the amount of funds or the value of the in-kind contributions which the Institute demonstrates have been placed within the control of, or irrevocably committed to the use of, the Institute as a capital contribution of the Institute in accordance with this subsection.

“(b) CAPITAL IMPROVEMENT ENDOWMENT.—

“(1) In addition to the trust fund established under subsection (a), funds may be deposited into a trust fund maintained by the Institute at a federally insured banking or savings institution from the amount reserved for this subsection pursuant to sec-

tion 1531(a) for the purpose of establishing a separate special endowment for capital improvement (hereafter in this subsection referred to as the 'capital endowment fund') to pay expenses associated with site selection and preparation, site planning and architectural design and planning, new construction, materials and equipment procurement, renovation, alteration, repair, and other building and expansion costs of the Institute.

"(2) The President of the Institute shall provide for the deposit into the capital endowment fund of a capital contribution by the Institute in an amount equal to the amount of each Federal contribution and any earnings on amounts in the capital endowment fund.

"(3) Funds deposited by the Institute as a match for Federal contributions under paragraph (5) shall remain in the capital endowment fund for a period of not less than two years. If at any time the Institute withdraws any capital contribution to the capital endowment fund before the funds have been deposited for this two-year period, an equal amount of the Federal contribution shall be withdrawn from the capital endowment fund and returned to the Treasury as miscellaneous receipts. At the end of the two-year period, the entire principal and interest of the funds deposited for this period, including the Federal matching portion, shall accrue, without reservation, to the Institute and may be withdrawn, in whole or in part, to defray expenses associated with capital acquisition and improvement of the Institute referred to in paragraph (1).

"(4) For the purpose of complying with the contribution requirement of paragraph (2), the Institute may use funds which are available from any private or tribal source.

"(5) Subject to paragraph (3), amounts appropriated under section 1531(a) for use under this subsection shall be paid by the Secretary of the Treasury to the Institute as a Federal capital contribution equal to the amount which the Institute demonstrates has been placed within the control of, or irrevocably committed to the use of, the Institute and is available for deposit as a capital contribution of the Institute in accordance with this subsection.

"(c) **GENERAL ADMINISTRATIVE PROVISIONS.**—(1) Funds in the trust funds described in subsections (a) and (b) shall be invested at a rate not less than that generally available for similar funds deposited at the same banking institution for the same period or periods of time.

Investments.

"(2) No part of the net earnings of the trust funds established under this section shall inure to the benefit of any private person.

"(3) The President of the Institute shall provide for such other provisions governing the trust funds established under this section as may be necessary to protect the financial interest of the United States and to promote the purpose of this title as agreed to by the Secretary of the Treasury and the Board or its designee, including recordkeeping procedures for the investment of funds received under the trust fund established under subsection (b) and such other recordkeeping procedures for the expenditure of accumulated interest for the trust fund under subsection (a) as will allow the Secretary of the Treasury to audit and monitor activities under this section."

Records.

**SEC. 506. AUTHORIZATION OF APPROPRIATIONS.**

Section 1531(a) of the American Indian, Alaska Native, and Native Hawaiian Culture and Art Development Act (20 U.S.C. 4451(a)) is amended by adding at the end the following new paragraphs:

“(4) Funds appropriated under this subsection for the fiscal year 1992 and for each succeeding fiscal year shall be transferred by the Secretary of the Treasury through the most expeditious method available with the Institute being designated as its own certifying agency.

“(5) Funds are authorized to be appropriated for programs for more than one fiscal year. For the purpose of affording adequate notice of funding available under this Act, amounts appropriated in an appropriations Act for any fiscal year to carry out this Act may, subject to the appropriation, become available for obligations on July 1 of that fiscal year.”.

**TITLE VI—MISCELLANEOUS PROVISIONS**

Mexico.

**SEC. 601. COCHITI DAM LICENSE.**

Notwithstanding the provisions of any other Federal law, no license shall be issued by the Federal Energy Regulatory Commission for the development of hydroelectric power at the Army Corps of Engineers' Cochiti Dam located on the Pueblo de Cochiti Indian Reservation in the State of New Mexico.

South Dakota.

**SEC. 602. DAKOTA WESLEYAN UNIVERSITY.**

Notwithstanding the provisions of section 487(c)(2)(B) of the Higher Education Act of 1965, the Secretary of Education shall reassess the amount owed by the Dakota Wesleyan University, located in Mitchell, South Dakota, in the amount of \$159,260, plus any accrued interest thereon to \$16,113.

Approved November 29, 1990.

**LEGISLATIVE HISTORY—H.R. 2006:**

HOUSE REPORTS: No. 101-400, Pt. 1 (Comm. on Interior and Insular Affairs) and Pt. 2 (Comm. on the Judiciary).

CONGRESSIONAL RECORD, Vol. 136 (1990):

Sept. 27, considered and passed House.

Oct. 25, considered and passed Senate, amended.

Oct. 27, House concurred in Senate amendment with amendments. Senate concurred in House amendments.



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## Overview of Intellectual Property Laws

A wide body of federal and state laws protects creative property such as writing, music, drawings, paintings, photography, and films. Collectively, this body of law is called “intellectual property” law, which includes copyright, trademark, and patent laws, each applicable in various situations and each with its own set of technical rules. When obtaining permission to use creative works, you’re concerned primarily with copyright law. However, trademarks, trade secrets, and publicity and privacy rights sometimes come into play when permission to use certain types of works is sought. Below is a summary of the various types of intellectual property laws that are relevant to the permissions process.

- **Copyright.** Federal copyright law protects original creative works such as paintings, writing, architecture, movies, software, photos, dance, and music. A work must meet certain minimum requirements to qualify for copyright protection. The length of protection also varies depending on when the work was created or first published.
- **Trademark.** Brand names such as Nike and Apple, as well as logos, slogans, and other devices that identify and distinguish products and services, are protected under federal and state trademark laws. Unlike copyrighted works, trademarks receive different degrees of protection depending on numerous variables, including the consumer awareness of the trademark, the type of service and product it identifies, and the geographic area in which the trademark is used.
- **Right of Publicity.** A patchwork of state laws known as the right of publicity protects the image and name of a person. These laws protect against the unauthorized use of a person’s name or image for commercial purposes—for example, the use of your picture on a box of cereal. The extent of this protection varies from state to state.
- **Trade Secrets.** State and federal trade secret laws protect sensitive business information. An example of a trade secret would be a confidential marketing plan for the introduction of a new software product or the secret recipe for a brand of salsa. The extent of trade secret protection depends on whether the information gives the business an advantage over competitors, is kept a secret, and is not known by competitors.
- **Right of Privacy.** Although not part of intellectual property laws, state privacy laws preserve the right of all people to be left alone. Invasion of privacy occurs when someone publishes or publicly exploits information about another person’s private affairs. Invasion of privacy laws prevent you from intruding on, exposing private facts about, or falsely portraying someone. The extent of this protection may vary if the subject is a public figure—for example, a celebrity or politician.

### in this Section:

- **[Copyright Overview \(NOLO\)](#)**
  - **[Introduction to the Permissions Process](#)**
    - **[Overview of Intellectual Property Laws](#)**

The content for the Copyright and Fair Use Overview section is from **[NOLO](#)**, with much of it taken from the book **[Getting Permission](#)** (October 2016) by **[Richard Stim](#)**. Thanks!



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**Guidelines for developing national legislation for the protection  
of traditional knowledge and expressions of culture based on the  
Pacific Model Law 2002**

**SECRETARIAT OF THE PACIFIC COMMUNITY  
NOUMEA, NEW CALEDONIA**

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# FOREWORD

In September 2002, I was fortunate to attend the first Pacific Island Regional Meeting of Ministers of Culture, held in Noumea, New Caledonia. A key item on the agenda was the presentation and subsequent endorsement of a Regional Framework for the Protection of Traditional Knowledge and Expressions of Culture (also known as the Pacific Model Law), which had been developed under the leadership of the Secretariat of the Pacific Community (SPC). As the New Zealand Government gives further consideration to traditional knowledge issues, I continue to be inspired by the enthusiasm of our discussions and the progress that is being made in terms of cultural heritage preservation and promotion in the Pacific Islands.

I am delighted that New Zealand has been given this opportunity to work with SPC on developing a set of guidelines designed to assist policy-makers in Pacific communities in the development of national legislation for the protection of traditional knowledge and expressions of culture. Based on the Pacific Model Law, the guidelines move Pacific communities one step closer towards the implementation of a regional framework for protecting traditional knowledge and expressions of culture. It is a resource that will help traditional knowledge holders identify potentially applicable protection mechanisms in the current intellectual property rights regime.

Internationally, issues relating to traditional knowledge have received increasing attention due to concerns such as the rapid loss of traditional knowledge and cultural diversity, illicit uses and misappropriation of traditional knowledge with little or no sharing of benefits with traditional communities, and interest in harnessing the potential of traditional knowledge for sustainable development.

Many countries and communities are considering how to best address these issues and concerns. The Pacific Model Law recognises that a 'one-size-fits-all' or 'universal' template to protect expressions of culture is not likely to be workable in terms of accommodating national priorities, the legal and cultural environment and the needs of traditional communities. Instead, a broad and holistic approach to issues relating to traditional knowledge is taken in order to find the best way to enable policy solutions to fit seamlessly together and work in a complementary manner.

The preservation, protection and promotion of traditional knowledge are of crucial importance for Pacific communities. Traditional knowledge forms an integral part of the lives of Pacific peoples and plays a critical role in their health, culture, identity, education, food security and natural resources management. It is therefore vital to the future well-being and sustainable development of Pacific communities.

**Hon. Judith Tizard**  
Associate Minister for Arts, Culture and Heritage  
Associate Minister of Commerce  
Government of New Zealand

# ACKNOWLEDGEMENTS

SPC would like to gratefully acknowledge the New Zealand Government for its ongoing support of the SPC Cultural Affairs Programme. We are particularly appreciative of the generous package of support from NZAID to assist the implementation of the Pacific Model Law in the Pacific region, including the development of the Guidelines.

We acknowledge the author of the Guidelines, Anne Haira, for her commitment to this project and traditional knowledge issues generally, particularly within the Pacific region.

Lastly, SPC would like to acknowledge the work of the World Intellectual Property Organization (WIPO), and in particular Wend Wendland for his continual support of this project. The Guidelines draw from documents, publications and other materials prepared for the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC), particularly WIPO documents WIPO/GRTKF/IC/7/3, WIPO/GRTKF/IC/7/4, WIPO/GRTKF/IC/8/4 and WIPO/GRTKF/IC/9/4. These documents, which summarise the key legal and policy issues and suggest draft objectives, guiding principles and substantive provisions for the protection of traditional cultural expressions and traditional knowledge, draw from national and regional experiences and are based directly on extensive deliberations within the WIPO Committee among the diverse range of stakeholders who participate in sessions of the Committee, as well as on comments submitted by them through open commenting processes. At the same time, these materials are informing national and regional developments in many parts of the world and are a useful resource for policy-makers, legislators, communities and others. For further information, see <http://www.wipo.int/tk/en/index.html>.

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## **ACRONYMS AND ABBREVIATIONS**

ADR	alternative/appropriate dispute resolution
IP	intellectual property
IPRs	intellectual property rights
NZAID	New Zealand International Aid & Development Agency
PIC	prior and informed consent
PICTs	Pacific Island countries and territories
SPC	Secretariat of the Pacific Community
SPREP	Pacific Regional Environment Programme
TKECs	traditional knowledge and expressions of culture
TRIPS	Trade-Related Aspects of Intellectual Property Rights
UNCTAD	United Nations Conference on Trade and Development
UNESCO	United Nations Educational, Cultural and Scientific Organization
WIPO	World Intellectual Property Organization
WIPO IGC	WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore
WPPT	WIPO Performances and Phonograms Treaty
WTO	World Trade Organization

# PREFACE

Traditional knowledge and expressions of culture are the foundation of Pacific Island societies. Values and practices strengthen identities and build cohesion among communities, as well as being a rich, diverse source of creativity and innovation. Strong identities, social cohesion and the opportunity to be innovative and creative are essential in the face of rapid changes taking place in the Pacific Community, including increasing migration and urbanisation, commercial and media exploitation, and growing material aspirations. Culture is the key to a successful future for Pacific Islanders.

The heightened global competition for new products, processes and services brought about by the globalisation of trade and advances in information technology has unfortunately triggered widespread appropriation of the cultural and social identity of Pacific Island peoples. In many Pacific Island countries and territories, handicrafts and souvenirs have been replicated and imported for sale to an unknowing tourism industry. Music and images are recorded for publication without the permission of traditional owners. Medicines and plants have been patented with few benefits being returned to communities.

As manifestations of intellectual creativity, traditional knowledge and expressions of culture deserve to be accorded the same legal protection that is provided to other forms of intellectual property. Robust measures need to be taken to guarantee the status of and economic support for the clans, groups or communities that are the creators, repository, custodians and trustees of traditional knowledge and expressions of culture, which have collective ownership, are held in perpetuity from generation to generation, are incremental and informal, and change over time.

The Secretariat of the Pacific Community, in partnership with the Pacific Islands Forum Secretariat and UNESCO and through extensive consultations with stakeholders, has been working to establish the legal protection of traditional knowledge and expressions of culture through the Regional Framework for the Protection of Traditional Knowledge and Expressions of Culture (the Pacific Model Law). Designed to ensure that legitimate forms of commercialisation take place, where Pacific Island peoples consent to and profit from any commercialisation of their traditional knowledge and expressions of culture, the Model Law was endorsed at the first Pacific Island Regional Meeting of Ministers of Culture.

SPC is the lead regional agency in efforts to develop a legal protection regime for Pacific Island traditional knowledge and expressions of culture. It works with and values the contributions of its stakeholders and partners in achieving its goal. Working together is essential to success of our vision for the region: a secure and prosperous Pacific Community, whose people are healthy and manage their resources in an economically, environmentally and socially sustainable way.

**Dr Jimmie Rodgers**  
Director-General  
Secretariat of the Pacific Community

# ABOUT THE GUIDELINES

## Objective

The Guidelines are intended to provide technical assistance to policy-makers in Pacific Island countries and territories (PICTs) in the development of national legislation for the protection of traditional knowledge and expressions of culture (TKECs) based on the Model Law for the Protection of Traditional Knowledge and Expressions of Culture (the 'Pacific Model Law').

The Guidelines have been designed to align with the areas in which PICTs have indicated they require assistance:

- guidance on an effective policy process that could be followed when using the Pacific Model Law as the basis for developing national legislation;
- guidance on the policy questions that need to be considered when developing the legal elements of protection in the legislation; and
- guidance on implementation options when using the Pacific Model Law as the basis for developing national legislation.

## Scope

The Guidelines cover only the policy development portion of developing legislation for the protection of TKECs. The Guidelines do not extend to the parliamentary process, as this will differ between countries and has not been a matter on which PICTs have indicated that they require technical assistance.

Additionally, as is the case with the Pacific Model Law, the Guidelines cover only the legal protection of TKECs. 'Protection' in these Guidelines refers to protection of the creativity, innovation and distinctiveness embodied in TKECs against their unauthorised, unfair and derogatory use – in short, their misappropriation and misuse. This is distinct from, but complementary to, 'preservation', 'conservation' and 'safeguarding' of TKECs (see next paragraph). Comprehensive protection is likely to require going beyond legislation to a range of proprietary and non-proprietary tools such as customary and Indigenous laws and protocols, trade practices and marketing laws, contracts and licences, and cultural heritage registers and databases. These measures are not mutually exclusive options, and each may have a role to play in a comprehensive approach to protection. A *sui generis* system should not replace the need for such measures and programmes.

The Guidelines also do not cover the important and closely related themes of safeguarding and preservation of cultural heritage and expressions. These would need to be addressed through complementary policy measures, such as cultural heritage preservation laws and programmes and handicrafts promotion and development programmes.

## Structure

The Guidelines are structured according to the broad stages of policy development when developing legislation of this nature. In respect of the legal elements of protection, the Guidelines group this process into thematic areas rather than follow the structure of the Pacific Model Law itself.

## Approach

The Guidelines:

- are voluntary and should not be interpreted as affecting the sovereign rights of countries;
- do not seek to promote any particular outcome nor to express any preference, but simply aim to catalogue and describe the available options to address issues;
- acknowledge that the forms of traditional expression and customary means of regulating their use, transmission, protection and preservation are diverse;
- reflect the understanding that different countries have varied interests and concerns in respect of TKECs and also that countries' positions may be based on different assumptions and ideological standpoints;
- recognise that a 'one size fits all' or universal template to protect TKECs is not likely to be workable in terms of accommodating national priorities, the legal and cultural environment and the needs of traditional communities;
- acknowledge that complementary measures, such as intellectual property (IP) laws, contracts and customary laws, will also be needed to provide comprehensive legal protection; and
- are intended to be reviewed and accordingly revised and improved as experience is gained in the legal protection of TKECs.

## Use of terms

For the purposes of the Guidelines, the use of the following terms should be interpreted as follows:

- the legislation: refers to legislation that is being developed by policy-makers in PICTs for the protection of TKECs based on the Pacific Model Law with reference to the Guidelines;
- protection: means that protection typically provided by IP laws to provide legal means to restrain third parties from undertaking certain unauthorised acts that involve the use of protected material. Protection refers to all matters affecting the availability, acquisition, scope, management and enforcement of rights and interests relating to TKECs, and is distinguished from the concepts of 'conservation' and 'preservation' but should not be construed as suggesting these are less important;
- traditional communities: encompasses both Indigenous and local communities and cultural communities;
- traditional knowledge holders: encompasses those who hold traditional knowledge from traditional communities in accordance with traditional or customary law and practices. The term 'holders' is intended to convey the relationship between a community and its traditional knowledge, often seen as custodianship or responsibility, and is considered more appropriate than the term 'owners';
- traditional knowledge and expressions of culture: means expressions of culture of traditional communities and the traditional knowledge underpinning those expressions.

## Presumptions

The focus of the Guidelines on the development of national legislation based on the Pacific Model Law presupposes the following:

- i. PICTs have reached a stage in the policy development process where the lack of legal protection for TKECs has been identified as a problem;
- ii. *sui generis* approaches have been identified as necessary, as existing mechanisms (legal and non-legal) are not sufficient to meet the objectives of protection; and
- iii. of the possible *sui generis* approaches, new *sui generis* legislation has been identified as necessary (most likely as one of many tools needed) to achieve some or all of the identified objectives of protection for TKECs.

It is beyond the scope of the Guidelines to provide a comprehensive discussion of the work that would precede this point. However, the Traditional Knowledge Toolkit being compiled by SPC includes a 'Policy Map' that has been prepared as a complementary measure to the Guidelines. It is designed to assist policy-makers in PICTs to progress through the process of developing a broad legal and policy framework for the preservation, protection and promotion of traditional knowledge, of which legislation would form part.

# THE POLICY DEVELOPMENT PROCESS

Some PICTs have expressed process-related difficulties with using the Pacific Model Law as the basis for developing national legislation. For the most part, this can be attributed to the Pacific Model Law being a type of 'end product'. As it is a high-level framework to guide the development of national legislation, countries will need to progress through the standard policy development process to 'flesh out' matters of detail and determine which aspects of the Pacific Model Law are appropriate to their circumstances. This can be challenging, however, as it involves policy-makers proceeding backwards through the policy development cycle.

With this in mind, this section outlines a possible process for developing the policy component of legislation for the protection of TKECs. It is recognised that countries may redefine these steps in order to meet their own needs and requirements. In addition, process principles to guide the policy development process are discussed.

## Organisation of work

The following suggested policy process would ideally form part of a broader process of developing a legal and policy framework for traditional knowledge generally. This could include workstreams such as preservation initiatives and the development of core IP legislation, as appropriate.

### A possible policy development process

- Part I: Review the approach of the Pacific Model Law and determine whether or not it is an appropriate means to address some or all of the problems identified and/or the objectives of protection. Seek appropriate ministerial approval for this approach to form the basis of the new legislation.
- Part II: Develop the overarching policy framework of the legislation, that is, the policy objectives and guiding principles. Determining objectives is a key early step. Seek appropriate ministerial approval.
- Part III: Determine the content or scope of the legal elements of protection and seek appropriate ministerial approval.
- What is the subject matter of protection?
  - What are the criteria for protection?
  - Who are the beneficiaries of protection?
  - What is the scope of protection?
  - What are the exceptions and limitations regarding rights?
  - How will rights be managed?
  - What is the term of protection?
  - What are the formalities for protection?
  - What are the legal proceedings for taking action (including remedies and penalties)?
  - How will rights be enforced?
  - What processes can be used for dispute resolution?
  - What is the relationship with IP protection?
  - How will international and regional protection be addressed?
- Part IV: Translate the legal elements of protection into legislative language.
- Part V: Develop additional legislative features such as transitional measures and regulatory making powers.
- Part VI: Develop secondary legislation (regulations).

## **Process principles**

Prior to commencing policy development, policy-makers may wish to consider whether it would be useful to develop process principles to guide the process. These are sometimes referred to as 'behavioural principles' and can be a useful means of ensuring that policy-makers exhibit a specified level of behaviour. They can also serve as a benchmark for all decisions taken by policy-makers, where appropriate, during the policy development process.

It is important to note that in the context of developing legislation for the protection of TKECs, the relationship between policy-makers and traditional communities is critical. It is, therefore, essential that policy-makers operate to a high standard in their engagement with traditional communities.

If countries wish to establish behavioural principles, policy-makers may wish to draw on the following points that are commonly emphasised.

- Recognise that the broad and active participation of traditional communities throughout the process is critical in order to ensure that their rights as traditional knowledge holders are fully and effectively protected.
- Acknowledge that policy development should be guided by aspirations and expectations expressed directly by traditional communities as well as by the nature, specific characteristics and forms of traditional cultures, expression and creativity.
- Respect the rights of traditional communities, including Indigenous peoples, under national and international law.

# PART 1. ASSESSING THE PACIFIC MODEL LAW APPROACH

The Pacific Model Law is a tool for PICTs that have determined that new, *sui generis* legislation is necessary and that require assistance with developing such legislation. From the outset, it should be noted that the Pacific Model Law is only one approach that can be used. There are, of course, others.

It is not the intention of the Guidelines to advocate that the Pacific Model Law will meet some or all of a country's objectives of protection. Countries will need to individually assess the approach of the Pacific Model Law as to whether it is a suitable means for doing so. To assist countries in this regard, this section explains the various dimensions of the Pacific Model Law approach. These dimensions can be broadly characterised by nature, subject matter, and legal form of protection. An additional dimension is the application of the *sui generis* system: countries can elect to develop a national system shaped according to their particular circumstances or opt to implement a regional approach (such as the Pacific Model Law) or an international approach.

If a country is to use the Pacific Model Law as the basis for national legislation, it will need to firstly adopt the approach of the Pacific Model Law as this sets the framework for the legal elements of protection (discussed in Part 3). It is fully recognised that a country may elect to take a different approach from that of the Pacific Model Law. If so, the Guidelines may be of limited assistance, although policy-makers may obtain useful guidance on generic matters.

## 1.1 Nature of the *sui generis* system

Existing *sui generis* systems for the protection of TKECs against misappropriation and misuse can be loosely grouped by nature into two areas. They both provide protection of an IP nature (the focus of these Guidelines).

- i. *Sui generis* systems with an explicit IP focus that contain new IP, or IP-like, rights – often referred to as *sui generis* IP protection. The WIPO–UNESCO Model Provisions for National Laws on the Protection of Expressions of Folklore Against Illicit Exploitation and Other Prejudicial Actions 1982 (the 'Model Provisions 1982') provide *sui generis* IP protection for expressions of folklore/traditional cultural expressions. Other examples are the Tunis Model Law on Copyright for Developing Countries 1976 (the 'Tunis Model Law 1976') and the Special Intellectual Property Regime Governing the Collective Rights of Indigenous Peoples for the Protection and Defence of Their Cultural Identity and Their Traditional Knowledge of Panama 2000 and the related Executive Decree of 2001 (the 'Panama Law 2000'). Further examples are found in several national copyright laws that contain *sui generis* provisions for the protection of traditional cultural expressions (sometimes referred to in such laws as 'expressions of folklore'). These laws very often follow the Model Provisions 1982 and/or the Tunis Model Law 1976 referred to above.
- ii. *Sui generis* systems that have been developed within a different policy area or context but nonetheless provide IP-like protection. This can often refer to systems of protection based on the customary laws/traditional protocols of traditional knowledge holders and bearers of cultural traditions. Examples also include cultural heritage preservation and marketing and consumer protection laws that sometimes have provisions aimed at the protection of TKECs against misappropriation and misuse.

The Pacific Model Law is an IP-based *sui generis* system (so it falls into the first category described above). It creates new IP, or IP-like, rights. Wide experience has shown that the IP protection of traditional cultural expressions involves legal doctrines closest to those underpinning the copyright and related rights systems. Accordingly, the Pacific Model Law addresses the protection of TKECs against the illicit uses and misappropriations that IP protection (primarily copyright) usually addresses, while taking into account the particular nature and characteristics of traditional creativity and cultural

expressions, including their communal nature. Customary laws and traditional protocols have also been incorporated into the Pacific Model Law, but within an IP framework.

As noted previously, the Pacific Model Law addresses only the protection of TKECs at the IP interface; other aspects of protection would need to be addressed with other policy measures.

## 1.2 Subject matter of the *sui generis* system

Existing national *sui generis* systems of protection have taken different approaches to what subject matter will be covered. While traditional knowledge holders have frequently stressed that they view traditional knowledge holistically, many countries have opted not to incorporate all traditional knowledge into a single system. Possible reasons for this include the subject matter being too diverse, which raises practicality questions. In addition, the design of regimes with a broad scope or that are applicable to a wide range of beneficiary communities requires the drafting of rules that, due to their generality, may not be adequate when applied to specific types of subject matter or particular types of communities (Correa 2003: 34–36). Cultural expressions, medicinal methods, etc. may require different legal treatments in view of their different nature, as is the case under IP law (Correa 2003: 34–36).

The subject matter of *sui generis* systems can be grouped into three areas:

- i. traditional cultural expressions or expressions of culture – examples include the Tunis Model Law 1976 and Panama Law 2000;
- ii. biodiversity-related traditional knowledge – examples include the Peru Law of 2002 Introducing a Protection Regime for the Collective Knowledge of Indigenous Peoples Derived from Biological Resources (the 'Peru Law 2002') and Brazil's Provisional Measure No. 2186-16 of 2001 Regulating Access to the Genetic Heritage, Protection of and Access to Associated Traditional Knowledge; and
- iii. all traditional knowledge – an example is the Philippines' Indigenous Peoples Rights Act 1997 (the 'Philippines Law 1997').

The Pacific Model Law covers TKECs. This is because Indigenous and traditional communities generally regard expressions of their traditional cultures as inseparable from the systems of traditional knowledge underpinning those expressions. The Pacific Model Law does not, however, extend to other dimensions of traditional knowledge, such as knowledge related to biological resources. The nature and scope of protection it offers, including the exceptions, build most directly upon copyright principles and are therefore most directly applicable to literary, musical and artistic expressions of cultural heritage. It is worthwhile noting that a model law is also being developed under the auspices of the Pacific Regional Environment Programme (SPREP) for the protection of traditional ecological knowledge.

## 1.3 Legal form of protection

Existing laws for the protection of traditional cultural expressions utilise a wide range of legal doctrines and mechanisms. Some extend a true exclusive right while others do not, focusing rather on regulating use of the protected traditional cultural expressions.

The range of existing approaches to the legal form of protection includes:

- i. exclusive property rights: giving the right to authorise or prevent others from undertaking certain acts in relation to TKECs. An exclusive rights approach would be one way of giving effect to the principle of prior and informed consent (PIC). Exclusive rights are provided for in the Tunis Model Law 1976, Model Provisions 1982, Panama Law 2000, Pacific Model Law 2002 and Philippines Law 1997;

- ii. entitlements under a scheme for equitable remuneration: providing for some form of equitable return to rights holders for use of their TKECs, without creating an exclusive right in the TKECs. This approach has been used in some systems for protection of TKECs, often through a *domaine public payant* system;
- iii. a moral rights approach: normally providing the rights of attribution of ownership; not to have ownership falsely attributed; not to have the protected materials subjected to derogatory treatment; and, at least in some jurisdictions, the right to publish or disclose (the right to decide if, when and how the protected materials ought to be made accessible to the public) (Lucas-Schloetter 2004: 298). The integrity right that protects the reputation of creators may address anxiety over inappropriate use of expressions of culture by preventing distortion, alteration or misrepresentation of creators' works. This may provide redress against culturally inappropriate treatment of expressions of culture. The publication right is the creator's right to decide when, where and in what form a work will be published. It may be effective in providing communities with a degree of control over the publication or disclosure of sacred works and thus reduce the possibility of inappropriate use. Furthermore, it could potentially be coupled with a breach-of-confidence action if the sacred information was communicated in confidence (Palethorpe & Verhulst 2000: 31). A number of *sui generis* systems for the protection of expressions of culture provide for moral rights, including the Model Provisions 1982, Pacific Model Law 2002 and Copyright Act of Nigeria 1992;
- iv. an unfair competition approach: providing a right to prevent various acts that constitute 'unfair competition' broadly speaking, such as misleading and deceptive trade practices, unjust enrichment, passing off and taking of undue commercial advantage. This approach underlies the US Indian Arts and Crafts Act 1990, which prevents the marketing of products as 'Indian made' when the products are not made by Indians as they are defined by that legislation; and
- v. a penal sanctions approach: where certain acts and omissions are treated as criminal offences. The Model Provisions 1982 and Pacific Model Law 2002 provide for criminal offences.

These options are not necessarily mutually exclusive, and can be combined. One option may, for example, be more relevant or suited to a particular form of cultural expression than another. Most *sui generis* systems include at least one of these options.

Exclusive property rights in TKECs and IP-type mechanisms in general should complement and be carefully balanced and coordinated with other non-IP measures, to reflect the characteristics of traditional forms and processes of creativity, the stakeholder interests involved, customary uses and practices associated with such forms and processes, and community social structures and practices. It should also be noted that exclusive private property rights in TKECs, even if they are held by communities, may run counter to the characteristics of traditional forms and processes of creativity and may induce unforeseen side-effects, such as competition within and between communities. Among the many countries that have already enacted specific protection for TKECs, few provide for genuine exclusive property rights in TKECs; most aim rather at the regulation of their exploitation.

The Pacific Model Law combines some of the approaches above and provides:

- i. for exclusive property rights by providing that particular uses of TKECs require the PIC of the traditional owners;
- ii. that the traditional owners of TKECs are the holders of moral rights in the TKECs, which comprise the right of attribution of ownership in relation to their TKECs, the right not to have ownership of TKECs falsely attributed to them, and the right not to have their TKECs subject to derogatory treatment; and
- iii. for certain criminal offences in relation to traditional cultural rights, moral rights, sacred–secret material and importation and exportation.

The Pacific Model Law requires equitable benefit-sharing arrangements (monetary or non-monetary compensation) with the traditional owners where a derivative work, traditional knowledge or an expression of culture is used for a commercial purpose. However, this differs from the 'entitlements under a scheme for equitable remuneration/compensatory liability' approach, where the entitlement is not based on the creation of an exclusive property right.

In addition, while there are no specific provisions in the Pacific Model Law regarding unfair competition, it is still possible to utilise common law remedies for passing off, unjust enrichment and the like, as well as trade practices.

## 1.4 Application of the *sui generis* system

Countries can elect to develop their own national system or opt to implement a regional approach (such as the Pacific Model Law) or an international approach. Each has its own advantages and disadvantages.

- i. **National approach:** The benefit of developing a national system 'from scratch' is that it enables a country to develop measures that reflect and respond to its particular circumstances. However, the disadvantage is that in the absence of bilateral or multilateral agreements providing protection in foreign jurisdictions, protection is limited to within the particular country. This may, for example, lead to situations where a protection system in a country is circumvented by the use of the same or similar traditional knowledge in another country that does not have the necessary system of protection in place.
- ii. **Regional approach:** A regional framework can provide more effective protection than a national system. A framework approach, such as the Pacific Regional Framework for the Protection of Traditional Knowledge and Expressions of Culture (of which the Pacific Model Law forms part), can achieve harmonisation across national systems through the use of minimum substantive standards while providing flexibility for countries to modify and adapt matters of detail to suit their particular circumstances. In this sense, a 'regional approach' means a regional framework that guides national laws and ensures a certain level of similarity between them. The national laws remain, however, national, and their application is limited to their respective territories. A 'regional system' can also refer to a more integrated approach that could enable, for example, mutual recognition of rights between joining territories, reciprocal enforcement of rights in territories of the region, and a regional mechanism for the resolution of disputes. This is especially useful where particular TKECs are not confined to one country, as is the case in the Pacific and other regions.
- iii. **International approach:** It is often suggested that comprehensive protection can only be achieved by way of an international system. Such a system is likely to consist of norms and principles, such as those developed in WIPO IGC, with matters of detail left to national and regional levels. This is important given the world's cultural diversity as well as jurisprudential diversity. It is also realistic, given the varied interests and concerns of countries with positions based on quite different assumptions and ideological standpoints concerning traditional knowledge and traditional knowledge-holding groups. Nonetheless, any international regime that provides effective international legal protection will require a degree of harmonisation, and this can be achieved via norms and principles adopted at international level. An international system has as its main and most attractive feature the facility to enforce rights regarding TKECs of one ratifying country in another ratifying country (such as the international protection for copyright provided by the Berne Convention 1971). Discussions are continuing at WIPO IGC on the development and adoption of such a system. As noted, at the international level there are diverse interests at stake and a wide range of perspectives on the issues. The development of the Pacific Model Law has contributed valuably to the international discussions at WIPO, and the discussions serve to inform further consideration of the Model Law 2002 and, above all, its implementation in PICTs.

The Pacific Model Law is a hybrid of the national and regional approaches. It sets out a high-level framework for national legislation and leaves matters of detail or implementation to be determined by policy-makers in accordance with their national laws and systems. It has also been designed with the circumstances of PICTs in mind, with the expectation that it will form the basis of a harmonised legal framework for the regional protection of TKECs.

## PART 2. DEVELOPING THE POLICY FRAMEWORK

If a country has elected to develop legislation based on the Pacific Model Law, including acceptance of the general approach of the Pacific Model Law, the next step is to develop the policy framework that will guide the development of the legislation, that is, the policy objective and the guiding principles. In a similar way to Part 1, countries will need to agree, at a general level, to the policy objective and guiding principles of the Pacific Model Law. There is, nonetheless, flexibility to articulate matters differently and to elaborate the objective and principles in more detail as appropriate. This section explains the policy objective and guiding policy principles of the Pacific Model Law and provides guidance on possible implementation options.

Depending on countries' policy processes, it may be beneficial to obtain the appropriate ministerial approvals regarding the policy framework before proceeding to the development of the legal elements of protection in Part 3. This will ensure that policy-makers have clear guidance on ministers' preferences and expectations as they progress through this stage of the process. The approvals could be obtained at the same time as seeking approval for the approach of the legislation in Part 1.

### 2.1 Policy objective

The way in which a protection system is shaped and defined will depend to a large extent on the objectives it is intended to serve. In developing the legislation, it is paramount that it has clear objectives and that careful consideration is given to the objectives sought.

An important initial step, therefore, is to determine the policy objective or objectives. This is not necessarily akin to the overarching objectives of protection of a legal and policy framework for traditional knowledge. These overarching objectives are likely to extend beyond the protection that can be achieved via this legislation to include matters such as the prevention of the granting of erroneous IP rights over TKECs. The policy objective, in this case, concerns the aim of the legislation and what it is seeking to achieve. It would form part of, and contribute to, the overarching objectives of protection of a broad legal and policy framework for traditional knowledge.

The policy objective of the Pacific Model Law is to 'protect the rights of traditional owners in their TKECs and permit tradition-based creativity and innovation, including commercialisation thereof, subject to prior informed consent and benefit sharing'.<sup>1</sup> It has four components:

- i. to protect the rights of traditional owners in their TKECs;
- ii. to permit tradition-based creativity and innovation, including commercialisation;
- iii. to ensure that the use of TKECs (in terms of tradition-based creativity and innovation) takes place with the PIC of the traditional owners; and
- iv. to ensure the sharing of benefits derived from the use of TKECs (in terms of tradition-based creativity and innovation) with the traditional owners.

Regarding drafting, the policy objective is purposely high level, in keeping with the approach of the Pacific Model Law that matters of detail are left to be determined at the national level. Countries can transfer the policy objective of the Pacific Model Law in its existing form or develop more specific policy objectives as they see fit, recalling that the core substance of the policy objective would need to be retained. Within that constraint, there is flexibility to articulate the policy objective as desired and to develop more detailed objectives and sub-objectives specific to a country's needs.

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<sup>1</sup> The Pacific Model Law does not contain matters of legislative detail such as a preamble, of which a policy objective would typically form part. The policy objective is found in its Explanatory Memorandum.

## 2.2 Guiding policy principles

Generally, the guiding policy principles of a law are designed both to promote the policy objective of the law and, at a practical level, to provide guidance for policy-makers as they develop its substance (in this case, the legal elements of protection). Where there is uncertainty as to the intent of a particular provision, the courts, government agencies, traditional knowledge holders and others can refer to the guiding policy principles for assistance. Whether a country includes provisions articulating the principles that have guided a law's development often depends on national legislative practices. The Pacific Model Law does not contain a provision stating the guiding policy principles of the legislation, but to assist policy-makers, the guiding policy principles have been extracted as follows.

- i. Recognise that traditional cultures comprise frameworks of creativity and innovation that benefit traditional communities as well as all humanity.
- ii. Recognise that traditional communities are the owners, rights holders and custodians of TKECs and the primary decision-makers regarding their use.
- iii. Respect and give effect to the right of traditional communities to control access to their TKECs, especially those of particular cultural or spiritual significance, such as sacred–secret TKECs.
- iv. Ensure measures and procedures for the protection of TKECs are fair and equitable, accessible, transparent and not burdensome for holders of traditional knowledge, while safeguarding legitimate third-party interests and the interests of the general public.
- v. Recognise that the benefits of protection should accrue to traditional communities rather than individuals, while individual rights (including conventional IP rights) for innovators or creators of original works will be able to be recognised in other systems.
- vi. Encourage the use of customary laws and systems and traditional governance and decision-making systems as far as possible, and recognise that communities will always be entitled to rely exclusively or in addition upon their own customary and traditional forms of protection against unwanted access, which might be the most effective in practice.
- vii. Recognise that the continued uses, exchange, transmission and development of TKECs within the customary context by the relevant traditional community, as determined by customary laws and practices, should not be restricted or interfered with.
- viii. Recognise that the state has a role in the protection of TKECs, including providing assistance to traditional communities in the management and enforcement of their rights in TKECs.
- ix. Strike an appropriate balance between the rights and interests of traditional communities, users and the broader public, including taking international human-rights standards into account and striking balances between, for example, the protection of TKECs on the one hand, and artistic and intellectual freedom, the preservation of cultural heritage, the customary use and transmission of TKECs, the promotion of cultural diversity, the stimulation of individual creativity, access to and use of TKECs and freedom of expression, on the other.
- x. Recognise that special protection for TKECs should be complementary to, and not replace or prejudice the acquisition of, any applicable conventional IP protection and derivatives thereof.
- xi. Ensure enforcement and dispute-resolution mechanisms are accessible, appropriate and adequate in cases of breach of the protection for TKECs.

There is flexibility to adapt the articulation of the guiding principles and to add additional principles if desired. However, as with the policy objective, as countries have elected to develop legislation based on the Pacific Model Law, the thrust of the guiding principles needs to be retained.

# **PART 3. DEVELOPING THE LEGAL ELEMENTS OF PROTECTION**

In developing IP-based legislation for the protection of TKECs, a number of legal elements of protection need to be addressed:

- i) What is the subject matter of protection?
- ii) What are the criteria for protection?
- iii) Who are the beneficiaries?
- iv) What is the scope of protection?
- v) What are the exceptions and limitations?
- vi) How will rights be managed?
- vii) What is the term of protection?
- viii) What are the formalities for protection?
- ix) What are the legal proceedings for taking action (including remedies and penalties)?
- x) How will rights be enforced?
- xi) What processes can be used for dispute resolution?
- xii) What is the relationship with IP protection?
- xiii) How will international and regional protection be addressed?

This section of the Guidelines provides technical information on each of these elements. The nature of each element is detailed along with why the element needs to be addressed. Guidance is provided on the policy questions that need to be considered for each element and implementation options in this regard. Where relevant, the Guidelines identify important policy considerations for policy-makers.

## 3.1 Subject matter of protection

The subject matter of protection is simply that which will be protected under the legislation. As the Guidelines are concerned with the development of legislation for the protection of TKECs, the general subject matter is obvious.

However, there is an important distinction between the subject matter in general and the protectable subject matter. It is only the latter that will receive protection under the legislation.

In order to demarcate the protected subject matter, policy-makers can progress through a two-step process. This first step is to develop a description of the subject matter that should be protectable. Policy-makers may find it useful to consider this exercise as that of defining the scope of the protectable subject matter. It is commonplace for the scope of the protectable subject matter to be determined at national level rather than at regional or international level. Therefore, the Pacific Model Law should be viewed as indicative only. The second step is to develop a more precise delimitation of those TKECs that are eligible for protection under the legislation. This is addressed under the element 'The criteria for protection'.

### 3.1.1 Policy questions

The following questions are intended to assist policy-makers to identify the protectable subject matter of the legislation that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### a) Which expressions of culture should receive protection?

The legislation should identify as clearly as possible which TKECs will be protectable, or the scope of the subject matter may appear too wide and imprecise.

In developing a description of the expressions of culture for which protection is sought, policy-makers may find it useful to work through the following list:

- verbal expressions, such as names, stories, chants, epics, legends, poetry, riddles and other narratives, histories, words, signs, indications and symbols;
- musical expressions, such as songs and instrumental music;
- expressions by actions, such as dances, plays, ceremonies, rituals and other performances, whether or not reduced to a material form; and
- tangible expressions, such as drawings, designs, paintings (including body-painting), carvings, sculptures, pottery, terracotta, mosaic, woodwork, metalware, jewellery, baskets, needlework, textiles, glassware, carpets, costumes, handicrafts, musical instruments and architectural forms.

Policy-makers may also wish to refer to clause 4 of the Pacific Model Law and the definition of 'expressions of culture'. This definition is a non-exhaustive list intended to provide a basis for discussion. Countries can adapt it as desired. As well, these expressions of culture are only

#### **Expressions of culture include:**

- a. names, stories, chants, riddles, histories and songs in oral narratives; and
- b. art and craft, musical instruments, sculpture, painting, carving, pottery, terracotta mosaic, woodwork, metalware, painting, jewellery, weaving, needlework, shell work, rugs, costumes and textiles; and
- c. music, dances, theatre, literature, ceremonies, ritual performances and cultural practices; and
- d. the delineated forms, parts and details of designs and visual compositions; and
- e. architectural forms.

#### **Pacific Model Law, Clause 4**

examples of this particular subject matter, bearing in mind the diversity of culture within the Pacific region. It is not expected that all of these examples will be applicable to all PICTs.

In countries with a number of distinct traditional communities, policy-makers should consider whether the description adequately accommodates that diversity. It is not necessary to have separate definitions for each traditional community. It will be sufficient if the collective scope of the subject matter captures the various expressions.

## **b) What terminology should be used to describe the subject matter?**

Flexibility regarding terminology is important, and many international IP standards defer to the national level for determining such matters. Accordingly, the Pacific Model Law has left detailed decisions on terminology to be determined at national level. For example, there is an option to use the term 'traditional cultural expressions' or another term that may be appropriate rather than 'expressions of culture'. Existing laws show diversity in the terms used to refer to this subject matter. For example, the Tunis Model Law 1976 refers to 'folklore' and the Panama Law 2000 refers to 'traditional expressions of Indigenous communities'.

In addition, a country may wish to use vernacular terms to describe the expressions themselves, such as waiata, the Maori word for 'song' in New Zealand, or tivaevae, meaning 'quilts' in the Cook Islands.

## **c) Should the legislation cover both tangible and intangible expressions?**

**Expressions of culture** mean any way in which traditional knowledge appears or is manifested, irrespective of content, quality or purpose, whether tangible or intangible ...

**Pacific Model Law, Clause 4**

Many expressions of culture are preserved and passed between generations by oral means and are traditionally never written down. Under the Pacific Model Law (clause 8), TKECs are protected regardless of the form or mode of their expression. Fixation would therefore not be a requirement for protection. Of note is that fixation is not a mandatory element of international copyright law and many countries,

especially those following the civil law tradition, extend protection to works that are not fixed in material form.

In terms of drafting, if a country considers it appropriate to cover both tangible and intangible expressions, policy-makers may wish to also include the words 'or combinations thereof' to demonstrate that TKECs can be both tangible and intangible and have both tangible and intangible components.

## **d) How should the relationship with traditional knowledge be treated?**

Protectable subject matter under the Pacific Model Law includes both expressions of culture and the traditional knowledge underpinning those expressions. The rationale for this is that many traditional communities regard their expressions of culture and traditional knowledge systems as parts of an inseparable whole: the expression of culture is the manifestation of the traditional knowledge. Traditional knowledge holders have stressed that the two should not be treated separately.

Therefore, the traditional knowledge that will form part of the protectable subject matter of the legislation will be determined by which expressions of culture a country elects to protect. It will be the traditional knowledge underpinning those expressions of culture that will be protected.

Policy-makers may wish to note that since the Pacific Model Law was developed in 2002, WIPO IGC has explored further the relationship between expressions of culture and the underlying traditional knowledge in terms of legal protection. WIPO notes that while expressions of culture and traditional knowledge are inextricably linked and part of a holistic cultural heritage and identity of traditional communities in daily life, from a legal protection point of view each raises some distinct policy issues and is relevant to different aspects of the IP system and other policy areas. This is not to suggest that they should be artificially distinguished in the daily community context. WIPO suggests that distinct

legal tools and a different set of policy questions typically arise when IP is applied to protect expressions of culture on the one hand, and technical knowledge on the other. For example, the IP-like protection of expressions of culture involves legal doctrines and policy questions closest to those underpinning the copyright and related rights systems, and the relevant broader policy context includes laws and programmes related to the safeguarding and preservation of cultural heritage, respect for freedom of expression and the promotion of cultural diversity. Certain forms of cultural expression are already protected by international copyright and related rights law, such as performances of 'expressions of folklore', which are protected internationally by the WIPO Performances and Phonograms Treaty (WPPT) 1996. It is these legal and policy aspects that come into play when considering the enhanced protection of traditional cultural expressions. When it comes to knowledge and know-how as such, however, it is the principles of patent law and the considerations relating to conservation of the environment and biodiversity, as well as health and agricultural policies, that make up the relevant legal and policy context. The specific solutions for the *legal protection* of expressions of culture and traditional knowledge may, therefore, differ. WIPO suggests that it is important that the forms of protection provided for expressions of culture be inspired and shaped by appropriate legal and cultural policies. A good solution might be to protect both expressions of knowledge and culture and the knowledge itself in one law, but have distinct chapters for each area that deal with the detailed substance of protection (like a country can have an intellectual property law with different chapters for copyright, patents, trademarks, etc.).

As the Pacific Model Law is an IP-based law, PICTs are encouraged to give WIPO's observations due consideration. It is, of course, a matter for individual countries to determine whether the traditional knowledge underlying the expressions of culture will also form part of the protected subject matter. In developing legislation based on the Pacific Model Law, there is flexibility to make this determination. The above discussion is intended to assist countries to make an informed decision in this regard. Countries may wish to consider this matter in the context of their respective objectives of protection.

### **e) Should the protectable subject matter be treated equally under the legislation?**

In many traditional communities, some TKECs are considered to hold greater cultural or spiritual significance than others. There are also expressions that are sacred–secret where access and use are highly restricted. Therefore, in developing a description, countries may wish to make reference to different layers or levels of TKECs.

Recognising these distinctions can be critically important from a protection perspective, particularly in respect of the term of protection, the scope of protection and formalities. Varying and multiple levels and forms of treatment may be appropriate for different kinds of expressions. For example, expressions of particular cultural or spiritual significance may be the subject of strong forms of protection, while for other expressions, especially those that are already publicly available or accessible, the focus could be on regulation of their use.

Under the Pacific Model Law, TKECs are treated in two 'layers'. There is a stronger degree of protection for sacred–secret material.<sup>2</sup> All other TKECs are treated equally. WIPO IGC has identified three layers or groupings of expressions: secret, confidential or undisclosed expressions; expressions of particular cultural or spiritual value to a community; and other expressions. This approach takes an additional step to the Pacific Model Law and identifies two layers within non-sacred–secret expressions: those of particular cultural or spiritual value, and others.

It is important for policy-makers to consider whether all expressions should be treated uniformly or whether their treatment should reflect differences, where they exist. If a country determines that there should be different treatment, consideration will need to be given to which TKECs would fall into the

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<sup>2</sup> 'Sacred–secret' means any TKEC that has a secret or sacred significance according to the customary law and practices of the traditional owners concerned (clause 4). Clause 28 establishes a criminal offence for non-customary use of sacred–secret material.

various layers. Implementation options regarding varying layers of treatment are considered under the elements 'Scope of protection', 'Term of protection' and 'Formalities'.

### **3.1.2 Further information**

Another source of information regarding the subject matter of protection is:

- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 6 provides information on the subject matter of protection in copyright.

## 3.2 Criteria for protection

Having developed a description of the subject matter generally, the next step is to formulate a more precise delimitation of those TKECs that are eligible for protection under the legislation. This is because within an IP-based *sui generis* system such as the Pacific Model Law, it is conceivable that not all TKECs are the subject of protection.

In order to distinguish between expressions that form part of the subject matter in general and those that are eligible for protection under a specific legal measure, laws typically stipulate the substantive criteria that subject matter should display in order to be protectable.

The Pacific Model Law does not include explicit criteria for protection. In developing national legislation, countries could benefit from developing explicit criteria for protection and linking them with the description of protectable subject matter.

### 3.2.1 Policy considerations

In identifying the characteristics that TKECs should possess in order to be protectable, an important policy consideration is the balance between protection imperatives and the promotion of creativity. If a criterion is too rigorous, the level of protection will be reduced. However, if a criterion is relatively loose, it could have a negative impact on the public domain, which is likely to impact on innovation and creativity.

Another consideration is that of extra-territorial protection. While generous and flexible criteria may provide protection for more expressions nationally, lesser protection may be available in other jurisdictions that do not take such a broad approach. A difficulty for countries is that there is currently no international standard regarding criteria for protection of expressions of culture. That being the case, countries could take guidance from provisions developed within WIPO IGC that have the potential, in their existing or modified form, to evolve into a form of international norm or standard.

### 3.2.2 Policy questions

The following questions are intended to assist policy-makers to develop criteria for protection that are appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### **a) To be protected, should expressions be required to be the result of creative human intellectual activity?**

To be protectable as IP, subject matter should be the result of creative human intellectual activity, including collective creativity.<sup>3</sup> Examples of this principle include the 'originality' requirement of copyright works and the 'novel' requirement in patent laws. However, existing *sui generis* systems for the protection of TKECs do not generally require the protected TKECs to be 'original' or 'new' because such a requirement would protect only contemporary TKECs.<sup>4</sup> WIPO has also suggested that an 'originality' requirement would be out of step with evolving practice and would exclude significant amounts of TKEC subject matter (WIPO 2005 Annex: 11–15).

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<sup>3</sup> The Convention Establishing the World Intellectual Property Organization 1967 defines IP by reference to rights relating to: literary, artistic and scientific works; performances of performing artists, sound recordings and broadcasts; inventions in all fields of human endeavour; scientific discoveries; industrial designs; trademarks, service marks and commercial names and designations; protection against unfair competition; and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic field.

<sup>4</sup> This includes contemporary interpretations, arrangements, adaptations or collections of pre-existing cultural materials made by an identifiable individual or individuals, and not those materials themselves and mere recreations and imitations of them.

This raises the question of what an appropriate principle might be for the protection of TKECs that is in a manner inspired by IP. WIPO has suggested that a focus on 'intellectual creativity' may be appropriate as a substantive criterion for protectable expressions of culture (WIPO 2005 Annex: 11–15). TKECs are the products of creative and intellectual processes and this criterion would acknowledge the creative and intellectual value of the material.

Similarly to 'originality' in copyright, 'creativity' is not susceptible to precise and detailed definition at the international level. If a country considers it appropriate to include a 'creative' criterion, it should be noted that conformity would need to be determined by relevant judicial authorities on a case-by-case basis with due regard to the nature of TKECs and guided as appropriate by customary practices and the cultural context of the relevant community that identifies with the TKEC.

A subject of discussion at WIPO and elsewhere is whether or not individual creativity taking place within a traditional context (such as the contemporary but tradition-based art of a traditional community member) can qualify as a 'traditional' cultural expression and therefore benefit from *sui generis* protection. On the one hand, some argue that because such contemporary creativity is protectable under copyright, it should not also be able to get additional *sui generis* protection, and that allowing this causes an uneasy overlap between conventional copyright and *sui generis* systems. On the other hand, it is argued that even individual creativity can be 'traditional' when it is recognised as such by the artist's community and is undertaken within a customary and traditional context.

## **b) To be protected, should expressions be required to have an association with a traditional community?**

Most, if not all, existing systems for the protection of TKECs establish a criterion requiring some form of linkage between the TKEC and the community, often to distinguish between 'authentic' and 'non-authentic' TKECs to prevent the misleading marketing and sale of imitations. This linkage can be embodied by a possible criterion that TKECs should be 'characteristic' of a distinct cultural identity and heritage of a particular community.

There is some overlap between the criteria of 'authenticity' and 'characteristic'. Both seem aimed at establishing that only TKECs that have some true linkage with a community should be protectable. However, a number of issues have been identified with the use of the term 'authentic', particularly in folkloristics. The term 'characteristic' may therefore be a less problematic option, particularly as 'authenticity' is implicit in the requirement that the expressions, or elements of them, must be 'characteristic': expressions that become generally recognised as characteristic are, as a rule, authentic expressions, recognised as such by the tacit consensus of the community concerned.

Some *sui generis* systems and measures circumscribe the qualities that the makers of TKECs should display. For example, the US Indian Arts and Crafts Act 1990 provides protection only to arts and crafts that are 'Indian products' and the Indian Arts and Crafts Board registers trademarks of genuineness and quality; Australia's Label of Authenticity may be used only by 'Certified Indigenous Creators', as defined (Janke 2003: 134–158); and the *toi iho*<sup>TM</sup> 'maori made' mark of New Zealand, a registered trademark 'of authenticity and quality for Maori arts and crafts', is licensed to artists of 'Maori descent to be used on works produced by them which comprise an explicit or implicit Maori referent' (Arts Council of New Zealand n.d.).

Existing approaches are neutral regarding the physical residence of an individual TKEC holder or performer or community. In other words, a TKEC held or performed by an individual or a community living outside of his, her or its traditional geographical place of origin may still qualify as a protectable TKEC provided it remains 'characteristic' of the community's identity and heritage.

Policy-makers also need to consider whether expressions that characterise more recently established communities or identities will be covered.

### **c) To be protected, should there be a requirement that expressions be maintained or used by a community?**

An unfortunate reality is that some TKECs are no longer maintained or used by traditional communities. This raises a policy question of whether protection should be extended to TKECs that, although once characteristic of a traditional community, are no longer maintained or used by the community or by individuals having the responsibility to do so. Recalling the policy consideration of balancing protection with the promotion of creativity, countries may wish to consider whether there would be benefits in including a criterion that a TKEC be maintained, used or developed by a community, or by individuals having the right or responsibility to do so in accordance with the customary law and practices of that community. If this criterion is not met, then the TKEC would not be protectable even if it is the result of 'creativity' and 'characteristic' of a traditional community.

While this may appear to promote fairness, it is important to bear in mind that many PICTs are in the process of developing cultural preservation and revitalisation programmes to address the loss of cultural practices. If a 'maintenance or use' criterion were instituted, it might effectively exclude many expressions that have not been utilised in recent times.

### **3.2.3 Further information**

Another source of information regarding the development of criteria for protection is:

- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 7 provides information on the criteria of protection in copyright.

## 3.3 Beneficiaries

Traditional knowledge is generally understood to be a collective product of a traditional knowledge-holding community (even though individual innovators or traditional knowledge holders may have distinct personal rights or entitlements within the community structure). Any rights and interests in this material are commonly considered to be those of communities rather than individuals.

This is reflected in a guiding principle of the Pacific Model Law, which states that the benefits of protection should accrue to traditional communities rather than individuals while recalling that individual rights (including conventional IP rights) for innovators or creators of original works will be able to be recognised in other systems. The development of this element involves elaborating this principle in more detail.

### 3.3.1 Policy questions

The following questions are intended to assist policy-makers to develop a substantive policy regarding beneficiaries of protection that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### a) What groups or communities should benefit from the protection of TKECs?

TKECs are held by a range of communities, including Indigenous peoples, tribal peoples, local communities and other cultural communities. In the Pacific region, there is likely to be a range of traditional knowledge-holding communities within one particular country. An initial question for countries is which groups or communities should benefit from protection and whether this should extend to all traditional knowledge-holding communities or only specific groups.

Existing laws for the protection of TKECs utilise a range of approaches. In some cases protection is limited to knowledge held by Indigenous communities,<sup>5</sup> while in others the concept of beneficiaries is much broader and involves knowledge held by Indigenous as well as local communities or populations.<sup>6</sup> WIPO IGC has developed a draft provision that establishes that protection of TKECs should be for the benefit of Indigenous peoples and traditional and other cultural communities (WIPO 2005 Annex: 16). It also contemplates that more than one type of community may qualify for protection of their TKECs. Under the Pacific Model Law, the beneficiaries of protection are the 'traditional owners' of TKECs, which is sufficiently broad to encompass the range of traditional knowledge-holding communities.

In regard to identifying which groups or communities should benefit from conferred communal rights and interests in their TKECs, including considering whether or not to delimit the possible beneficiary groups, a country's objectives of protection should be instructive. There may also be moral or historical reasons that justify particular groups benefiting from protection ahead of other groups.

If a country considers it appropriate to delimit the possible beneficiary groups, it could include specific criteria in the legislation that beneficiary groups have to meet, such as being an Indigenous or local community of the country in question.

#### b) How should beneficiary groups be described?

The Pacific Model Law describes the beneficiaries of protection as 'traditional owners' – a broad term intended to cover the variety of traditional knowledge-holding communities. There is flexibility for countries to use an alternative term to describe the beneficiary group(s) in the legislation. Dependent

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<sup>5</sup> For example, the Panama Law 2000.

<sup>6</sup> Examples include laws in Bangladesh, Brazil and Portugal.

on the decision taken in section 3.3.1(a) above, it may be considered appropriate to refer to, for example, 'Indigenous people' or 'local communities'.

As well, some countries may prefer an alternative term to 'owners'. The term 'holders' is often considered to be more appropriate than 'owners'. It is used to convey the relationship between a community and its traditional knowledge, which is often seen as being more akin to custodianship.

In addition, existing laws for the protection of traditional knowledge do not necessarily identify beneficiaries as holders of distinct intangible property rights as such, although some have elected to establish distinct rights. Some laws identify the rights holders through the term 'local communities' or 'Indigenous peoples', or a combination thereof. Others do not identify rights holders, but define that 'benefit claimers' shall include 'creators and holders of knowledge and information relating to biological resources'. Other laws contain open definitions such as 'those who have registered their IPRs on traditional medical intelligence'. The Costa Rican law provides that the title holder of *sui generis* community intellectual rights shall be determined by a participatory process.

### **c) Should particular linkages be required between the beneficiaries of protection and the protected TKECs?**

The establishment of required linkages between the beneficiaries of protection and the protectable subject matter can be used for several purposes. If a form of 'relationship linkage' is required between the beneficiary group and the TKEC, this can be useful in ensuring that the appropriate groups benefit from protection. It can also promote greater certainty and transparency within the regime. The linkage could be demonstrated by reference to customary law or community practices. In the absence of such a linkage, a traditional community could potentially claim rights and interests in an expression of culture that is, in actual fact, held by another traditional community.

Relationship linkages can also be useful in scenarios where a small group within a broader community holds a TKEC that other parts of the particular community do not. In this situation, it may be considered appropriate for the group to benefit from protection rather than the community as a whole. The group could use the relationship linkage to demonstrate that it has the relationship required in order to benefit from the protection of the expression(s) in question.

In terms of linkages that could be used, two possibilities are:

- those to whom the custody, care and safeguarding of the TKEC are entrusted in accordance with customary law and practices; and
- those who maintain, use or develop the TKEC as characteristic of their cultural and social identity and cultural heritage (or simply 'as being characteristic of their traditional cultural heritage').

Traditional owners of TKECs are defined as:

- a) the group, clan or community of people, or
- b) the individual who is recognised by a group, clan or community of people as the individual

in whom the custody or protection of the TKECs are entrusted in accordance with the customary law and practices of that group, clan or community.

**Pacific Model Law, Clause 4**

### **d) How should the beneficiary group be represented?**

Having clarified the beneficiary group or groups in name or description, the next step is to consider whether or not the legislation will prescribe how these groups may or should be represented to receive benefits under the legislation (and to assert their rights). Existing laws for the protection of traditional cultural expressions use a range of approaches to address this issue, including the following.

- Requiring the beneficiary group to have a legal personality: For the purpose of legal procedures such as enforcing rights, a country may require the beneficiary group to have some form of legal

personality. The legislation could prescribe a particular form or provide that the beneficiary group must designate a distinct legal person (such as an association, a legal representative or a trustee) as rights holder in trust. Countries may wish to draw on existing legal models in their domestic law and experience with any community-held IP, such as collective marks, and on applicable customary law. For example, in the Panama Law 2000, existing models are utilised so that the relevant Indigenous communities may be represented by their general congresses or traditional authorities.

- **Determining representation through a process such as registration or certification:** A registration or certification process could be used to ensure there is a distinct entity to represent the beneficiary group. While it would require state involvement, it would be without the formalities of obtaining and maintaining a legal personality. This approach could also be used to support communities' own rules and customary practices by providing that beneficiary groups determine their representative(s) according to customary practices and notify the appropriate state body for registration or certification purposes. Alternatively, the legislation could specify the criteria to be met in order for a community to register as a beneficiary group. Such criteria could reflect any required linkages between a community and a TKEC. In Thailand, the PVP Law 1999 stipulates that 'a sui juris person, residing and commonly inheriting and passing over culture continually, who takes part in the conservation or development of the plant variety ... may register as a community under this Act'. In Portugal, the representation claimed by any private or public entity for registration of a local plant variety must be certified by a competent municipal chamber.
- **Not prescribing a representation requirement:** It is not imperative that the beneficiary group be identified as distinct 'owners'. The legislation could be silent in respect of representation requirements, thereby leaving the matter open to all forms of representation. IP need not be separately owned by distinct rights holders. Some forms of IP protection, such as geographical indications, do not need to have distinct 'owners' and may be administered by the state on behalf of groups of eligible producers. Collective marks and certification marks may be protected on behalf of a group of beneficiaries. Where the 'right' is essentially an entitlement to seek certain legal remedies and injunctions, there may not be a need to identify a specific right holder, and it may be possible to define aggrieved or interested parties who have standing to take action. There would be implications for international protection if the beneficiary group were to be granted rights in foreign jurisdictions and there were no distinct rights holders.<sup>7</sup> The Pacific Model Law does not prescribe how 'traditional owners' may or should be represented for the purposes of legislation. This is not a policy of the Pacific Model Law but, rather, reflects its approach that it is a high-level framework and a matter such as representation should be determined at national level. There is flexibility to institute a representation requirement if desired or to leave the matter open. If the latter approach is taken, a prospective user wishing to use TKECs would apply to the Cultural Authority established under the legislation, which would then follow a prescribed process to identify the relevant traditional owners.

## **e) Should the state have a beneficiary role?**

While it is well established that the beneficiaries of protection should be the communities that hold the TKECs, in some cases it may be considered appropriate for the state to have a beneficiary role as well. For example, where there are difficulties in identifying which groups have rights over specific expressions, particularly expressions that are shared across communities, the state could receive the benefits of protection on behalf of these communities and then apply the proceeds towards initiatives that are for the betterment of all the communities concerned. In existing laws that take this approach, proceeds from the granting of such rights are applied towards national heritage, social welfare and culture-related programmes for the general benefit of traditional communities but without transferring the proceeds directly to the communities. In addition, if there are issues with transferring the benefits

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<sup>7</sup> Although, in respect of collective marks, the Paris Convention provides for the protection of collective marks belonging to associations 'the existence of which is not contrary to the law of the country of origin, even if such associations do not possess an industrial or commercial establishment' (Article 7bis).

of protection to the beneficiary group, the state could act as a conduit and receive the benefits on their behalf, then transfer the benefits to the beneficiary group.

If the state assumes a beneficiary role, policy-makers may wish to consider whether the state should also have a role in the management and enforcement of rights, which are often a heavy burden for traditional communities to bear (see the elements 'Management of rights' and 'Enforcement').

#### **f) How can the relationship between a beneficiary group and an individual creator be addressed?**

Where an individual has developed a tradition-based creation within his or her customary context, it is regarded from a community perspective as the product of communal creative processes. This aligns with the essential characteristics of 'traditional' creations: they contain motifs, a style or other items that are characteristic of and identify a tradition and a community that still bears and practises them. The creation is not 'owned' by the individual but 'controlled' by the community according to customary legal systems and practices. This is what marks such a creation as 'traditional' and provides a policy rationale for providing benefits under the legislation at collective rather than individual level.

In terms of how the interests of individual creators should be addressed within their communities, the Pacific Model Law takes the approach that this is a matter for customary law and practices to address. Customary law often establishes the attribution of rights and benefits within a community, including individual interests in traditional knowledge. This will also be relevant for individual rights that may accrue under existing IP laws. There is, of course, flexibility for countries to incorporate measures that regulate the relationship between individual creators and their community. However, the use of such measures is not commonly recognised as being desirable.

#### **g) Can there be two or more beneficiary groups in particular TKECs?**

In some cases, two or more traditional communities in a country may share the same or similar TKECs. As well, communities in different countries and even regions may lay claim to the same or similar TKECs. This can result in potentially overlapping rights in the same or similar expressions, and therefore it will be necessary to clarify the allocation of rights or distribution of benefits among those communities. As this is not a question of whether the groups should benefit, but rather how the benefits should be distributed, the issue is addressed under the element 'Management of rights'. For the purposes of the present element, it is useful to note that there may be two or more beneficiary groups in some TKECs and that policy measures will be needed to address these multiple interests.

### **3.3.2 Further information**

Another source of information regarding beneficiaries of protection is:

- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 5 provides information on the beneficiaries of protection in copyright.

## 3.4 Scope of protection

The protection of TKECs is a central component of the legislation. As the Guidelines focus on the development of an IP-based *sui generis* system (based on the Pacific Model Law), the protection afforded by the legislation is that which IP usually addresses – that is, illicit uses and misappropriations.<sup>8</sup> It is important to recall that this conception of protection reflects a strong IP focus. It is acknowledged that expectations regarding protection are likely to extend beyond illicit uses and misappropriations. Therefore, general background information is provided in this section to illustrate where the legislation may sit in a broader framework of protection.

The form of protection in the Pacific Model Law draws on legal doctrines similar to copyright and related rights. It consists of:

- i. exclusive property rights<sup>9</sup> where particular uses of TKECs require the PIC of the traditional owners. Failure to obtain the PIC of traditional owners where required will constitute an illicit use and/or misappropriation; and
- ii. the moral rights of traditional owners in their TKECs.

The development of this element entails clarifying the scope of these rights – that is, the uses, appropriations and omissions that should be prohibited, should require authorisation or should be regulated in other ways. It also involves consideration of whether different types of protection should be applied to different layers, where appropriate, of TKECs.

### 3.4.1 Background

#### **a) What uses, appropriations and omissions regarding TKECs are frequently identified as being of concern to traditional communities?**

From the outset, it is acknowledged that traditional communities are diverse and are likely to have a range of views in this area. It would be useful for policy-makers to progress through a problem-definition process to develop a localised understanding of the uses, appropriations and omissions that are of concern to traditional communities in their particular country.

The uses, appropriations and omissions regarding TKECs that are frequently identified as being of concern to traditional communities include, but are not limited to:

- a) unauthorised reproduction, adaptation and subsequent commercialisation of TKECs, with no sharing of economic benefits. This could include the recording of traditional music, the reproduction of paintings, and the taking of photographs of traditional beadwork and attire worn by Indigenous and traditional persons;
- b) appropriation of traditional languages, such as Indigenous and traditional words, symbols and other distinctive signs being used by non-community members outside the traditional context;
- c) use of TKECs that is insulting, degrading and/or culturally and spiritually offensive. This could include, for example, the modification of an expression to suit foreign markets or the performance of a ritual in an inappropriate context or setting;

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<sup>8</sup> As noted previously, the legislation only covers protection at the IP interface, not protection generally, and is distinguishable from the related concepts of 'safeguarding' and 'preservation' of cultural heritage.

<sup>9</sup> The legal form of protection will have been agreed upon when assessing the approach of the Pacific Model Law in Part 1 of the Guidelines.

- d) failure to acknowledge the traditional source of a tradition-based creation or innovation. Examples could include the use of traditional music as part of a 'world music' album without acknowledging the source of the music;
- e) appropriation of the reputation or distinctive character of TKECs in ways that evoke an authentic traditional product by use of misleading or false indications as to authenticity or origin, or adoption of their methods of manufacture and 'style'. This could include the marketing of fake traditional souvenir items as 'Indigenous', 'Indian-made' or 'authentic';
- f) unauthorised access to and disclosure and use of sacred–secret materials. This could refer to, for example, disclosure to the public at large of secret and/or culturally sensitive materials such as tribal sites and objects of deep religious and cultural significance;
- g) unauthorised fixation of live performances of TKECs, and subsequent acts in relation to those fixations. For example, the photographing of live performances of songs and dances by Indigenous persons, and the subsequent reproduction and publication of the photographs on DVDs, tape cassettes, postcards or the Internet;
- h) granting of erroneous IP rights over TKECs and derivatives thereof. For example, a patent has been granted over a process for the formation of the Caribbean steel pan musical instrument; and
- i) the exploitation of derivative works created by individuals (particularly those not connected with the traditions and cultural materials they adapted or were inspired by) and the acquisition of IP rights over derivations and adaptations of TKECs and representations.

## **b) What policy measures can be used to address these concerns?**

It is apparent that the majority of concerns related to uses, appropriations and omissions are the type that are typically addressed through IP rights measures. It is acknowledged that there are likely to be additional concerns other than uses, appropriations and omissions regarding TKECs, such as the loss of knowledge. These would need to be addressed through additional policy measures.

Given the breadth of the abovementioned concerns, it is also apparent that a range of policy responses will be needed. It is also evident that protection would need to include not only the protection of the expressions themselves but also of the reputation or distinctive character associated with them and/or the method of production (in the case of handicrafts and textiles, for example). Some of these concerns can be addressed via existing IP rights such as copyright, trademarks, designs, patents and unfair competition, while others will require the use of new IP-type rights by way of a *sui generis* law such as the Pacific Model Law.

Table 1 illustrates policy options that could be used to address the concerns of traditional communities regarding uses, appropriations and omissions relating to TKECs. These options are not mutually exclusive.

**Table 1: Policy measures for addressing the concerns of traditional communities regarding uses, appropriations and omissions relating to TKECs**

Traditional communities' concerns	Policy measures	Examples
<p>a. Unauthorised reproduction, adaptation and subsequent commercialisation of TKECs, with no sharing of economic benefits</p>	<p>TKECs that meet the criteria for copyright protection can be protected under existing copyright laws.</p>	<p>Examples of copyright laws in the Pacific region include New Zealand's Copyright Act 1994, Australia's Copyright Act 1968, Fiji's Copyright Act 1999 and Samoa's Copyright Act 1998.</p>
	<p>For TKECs that do not meet the criteria for copyright protection, <i>sui generis</i> laws can be used that establish typical copyright-type exclusive rights over TKECs. These rights can extend to acts such as reproduction, adaptation, public performance, distribution, public recitation, communication to the public, the making of derivative works, and importation of unauthorised copies and adaptations under the law of the importing country.</p>	<p>Examples of <i>sui generis</i> laws that establish copyright-type exclusive rights over expressions of culture include the Pacific Model Law 2002, Tunis Model Law 1976 and Panama Law 2000.</p>
	<p>Regarding handicrafts in particular, explicit protection can be provided for designs as tangible expressions of culture.</p>	<p>Examples include New Zealand's Designs Act 1953 and Australia's Designs Act 2003.</p>
<p>b. Appropriation of traditional languages, such as Indigenous and traditional words, symbols and other distinctive signs being used by non-community members outside the traditional context</p>	<p>Defensive protection measures can prevent third parties obtaining IP rights over traditional words, symbols, etc. They will not prevent the use itself, but can act as a deterrent.</p>	<p>The Trade Marks Act 2002 in New Zealand includes a provision to prevent the registration of trademarks that would be likely to offend a significant section of the community, including Maori (section 17).</p>
<p>c. Uses of TKECs that are insulting, derogatory and/or culturally and spiritually offensive</p>	<p>Moral rights principles in copyright law can be used to prevent insulting, derogatory and culturally and spiritually offensive uses of TKECs.</p>	<p>New Zealand's Copyright Act 1994 contains provisions relating to moral rights, as does the Pacific Model Law 2002.</p>
<p>d. Failure to acknowledge the traditional source of a tradition-based creation or innovation</p>	<p>Moral rights principles in copyright law can be used to protect against failure to acknowledge source or misleading indications as to source.</p>	<p>The Model Provisions 1982, the Pacific Model Law 2002 and many copyright-based systems for the protection of expressions of culture provide rights and remedies in respect of failure to acknowledge source.</p>

Traditional communities' concerns	Policy measures	Examples
<p>e. Appropriation of the reputation or distinctive character of TKECs in ways that evoke an authentic traditional product, by use of misleading or false indications as to authenticity or origin, or adoption of their methods of manufacture and 'style'. This could include the marketing of fake traditional souvenir items as 'Indigenous', 'Indian-made' or 'authentic'.</p>	<p>The protection of reputation (the distinctiveness, 'style' and 'authenticity') of TKECs and prevention of false and misleading claims to 'authenticity', origin or link or endorsement by a community can be achieved through options such as:</p> <ul style="list-style-type: none"> <li>- certification trademarks;</li> <li>- geographical indications; and</li> <li>- unfair competition or trade practices.</li> </ul>	<p>Examples of certification trademarks include 'Toi Iho', the Maori Made Mark in New Zealand, and the Label of Authenticity in Australia.</p> <p>There are examples of geographical indications regarding TKECs in Portugal, Mexico and the Russian Federation.</p> <p>Regarding unfair competition or trade practices law, in an Australian case a company was prevented from continuing to describe or refer to its range of hand-painted or hand-carved Indigenous-oriented souvenirs as 'Aboriginal art' or 'authentic' unless it reasonably believed that the artwork or souvenir was painted or carved by a person of Aboriginal descent.</p>
<p>f. Unauthorised access to and disclosure and use of sacred-secret materials</p>	<p>The prevention of exploitation of sacred-secret materials can be achieved through the use of principles dealing with unfair competition, undisclosed and confidential information, breach of trust and confidence, and related areas.</p>	<p>In the Australian case of <i>Foster v Mountford</i>,<sup>10</sup> the common law doctrine of confidential information was used to prevent the publication of a book containing culturally sensitive information. The court held that the publication of the book could disclose information of deep religious and cultural significance to Aborigines that had been supplied to the defendant (an anthropologist) in confidence and that the revelation of such information amounted to a breach of confidence.</p>
<p>g. Unauthorised fixation of live performances of TKECs, and subsequent acts in relation to those fixations</p>	<p>The WIPO Performances and Phonograms Treaty 1996 provides for the protection of the moral and economic rights of performers of expressions of culture.</p>	<p>New Zealand is not a party to the WPPT. New Zealand does, however, have performers' rights provisions in its Copyright Act 1994 (Part 9) and provides performers with certain limited rights to control the exploitation of their performances where they have not given consent to that exploitation. However, there is no concept of group ownership, and members of a group do not have collective rights in a group's performance.</p>

<sup>10</sup> 1976. 29 FLR 233.

Traditional communities' concerns	Policy measures	Examples
h. The acquisition by third parties of erroneous IP rights over TKECs	Defensive protection measures can be used to prevent the granting of erroneous IP rights over TKECs, such as prevention of the unauthorised registration of Indigenous signs, symbols and other marks as trademarks.	The Trade Marks Act 2002 in New Zealand includes a provision to prevent the registration of trademarks that would be likely to offend a significant section of the community, including Maori (section 17).
i. Exploitation of derivative works created by individuals (particularly those not connected with the traditions and cultural materials they adapted or were inspired by) and the acquisition of IP rights over derivations and adaptations of TKECs and representations	<p>The right of adaptation refers to the right of an author or authors to control transformation of their work into another type of presentation, for instance, by translation or by changing a novel into a film script. Arguably, all adaptations involve reproduction where the essential features of the adapted work are used. However, in many national laws, the right of adaptation is viewed separately from that of reproduction.</p> <p>Within WIPO IGC, it has been noted that some key policy and legal questions pivot on the adaptation right, the right to make derivative works and the setting of appropriate exceptions and limitations in this regard. It is often the adaptation and commercialisation of traditional materials by 'outsiders' that cause the most cultural offence and economic harm. Suggestions have been made for communal regulation of the exploitation of derivative works created by individuals, particularly those individuals not connected with the traditions and cultural materials they adapted or were inspired by. The suggestion has also been noted that copyright and other IP rights should not be recognised in such tradition-based creations made by outsiders. Yet it has also been proposed that rights in derivative works should be fully recognised and respected and remain unencumbered by such obligations, since recognising such rights encourages and promotes tradition-based creativity. This is precisely how, some argue, the IP system is intended to work – not to reward the preservation of the past, but rather to revitalise it and incentivise tradition-based creativity for economic growth. Any copyright in the derivative work attaches only to new materials and leaves the underlying materials unaffected.</p>	<p>The Model Provisions 1982, the Tunis Model Law 1976, the Bangui Agreement, and other <i>sui generis</i> systems and national laws do not generally regulate the exploitation of derivative works. The Model Provisions 1982 contain no right of adaptation and have a wide 'borrowing exception'.</p> <p>The Pacific Model Law regulates how derivative works may be exploited and places certain obligations upon the creators of derivative works towards the relevant community. It requires benefit-sharing arrangements providing for equitable monetary or non-monetary compensation to the traditional owners where a derivative work or TKEC is used for a commercial purpose. It also requires the creator to respect the moral rights of the relevant community in the underlying traditions and heritage used, including acknowledging the community.</p> <p>Within WIPO IGC, the suggestion has been made for an adaptation right in respect of TKECs of particular cultural or spiritual value subject to prior registration or notification. In respect of other TKECs, there would be no adaptation right as such; nor would there be prevention of the obtaining of IP rights in the derivative work by its creator. Nor would, in either case, mere 'inspiration' be prevented, as is also the case in copyright law, in line with the idea/expression dichotomy. However, there would be regulation of how derivative works may be exploited.</p>

### **c) What protection measures can be provided under the legislation?**

It is useful to consider where the protection that can be achieved from a *sui generis* law such as the Pacific Model Law sits within a broader framework of protection. Based on Table 1, a country can utilise a combination of existing IP laws, adapted existing IP laws (through the addition of *sui generis* measures) and IP-based *sui generis* systems (such as legislation based on the Pacific Model Law) as well as common law principles (such as breach of confidence) to achieve a broad framework of protection.

The scope of protection that can be provided by legislation based on the Pacific Model Law includes:

- rights to authorise or prevent the unauthorised reproduction, adaptation and subsequent commercialisation of TKECs;
- appropriation of traditional languages, such as Indigenous and traditional words, symbols and other distinctive signs being used by non-community members outside the traditional context;
- uses of TKECs that are insulting, derogatory and/or culturally and spiritually offensive;
- failure to acknowledge the traditional source of a tradition-based creation or innovation; and
- exploitation of derivative works created by individuals outside of the traditional context.

These measures are similar to the protection usually provided by copyright and related rights, that is, protection against illicit uses, misappropriations and omissions.

### **3.4.2 Policy questions**

The following questions are intended to guide policy-makers through the issues relevant to developing a substantive policy on the scope of protection that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### **a) What acts regarding TKECs should be regulated?**

A central element of protection is the scope of acts that will be regulated. Typical copyright-type exclusive rights extend to acts such as reproduction, adaptation, the making of derivative works and importation. Many existing national laws for the protection of TKECs provide these copyright-style economic rights because the protection for TKECs has been conceived within copyright. In determining which uses should require the PIC of traditional communities, policy-makers may wish to refer to the following list of uses that are regulated in existing laws for the protection of TKECs:

- reproduction;
- adaptation;
- public performance;
- distribution;
- public recitation;
- communication to the public;
- the making of derivative works; and
- importation (of unauthorised copies and adaptations under the law of the importing country).

Policy-makers may also wish to refer to clause 7(2) of the Pacific Model Law:

The following uses of TKECs require the prior and informed consent of the traditional owners:

- a. to reproduce the traditional knowledge or expressions of culture;
- b. to publish the traditional knowledge or expressions of culture;
- c. to perform or display the traditional knowledge or expressions of culture in public;
- d. to broadcast the traditional knowledge or expressions of culture to the public by radio, television, satellite, cable or any other means of communication;
- e. to translate, adapt, arrange, transform or modify the traditional knowledge or expressions of culture;
- f. to fixate the traditional knowledge or expressions of culture through any process such as making a photograph, film or sound recording;
- g. to make available online or electronically transmit to the public (whether over a path or a combination of paths or both) traditional knowledge or expressions of culture;
- h. to create derivative works;
- i. to make, use, offer for sale, sell, import or export traditional knowledge or expressions of culture or products derived therefrom;
- j. to use the traditional knowledge or expressions of culture in any other material form;

if such use is a non-customary use (whether or not of a commercial nature).

**Pacific Model Law, Clause 7(2)**

It is useful to briefly mention at this point that the legislation should specify the context within which acts will be regulated. For example, in the Pacific Model Law the regulated acts only apply to non-customary use. Therefore, protection is extended only to uses of TKECs outside the traditional or customary context whether or not for commercial gain. This aligns with a guiding principle of the Pacific Model Law that provides that traditional and customary uses, exchanges and transmissions of TKECs, as determined by customary laws and practices and whether or not of a commercial nature, should not be restricted or interfered with by the legislation. This is discussed further under the element 'Exceptions and limitations'.

**b) What acts should be excepted from regulation?**

It is commonplace for some acts to be exempted from regulation, referred to as 'exceptions' or 'limitations'. This is addressed under the next element, 'Exceptions and limitations'.

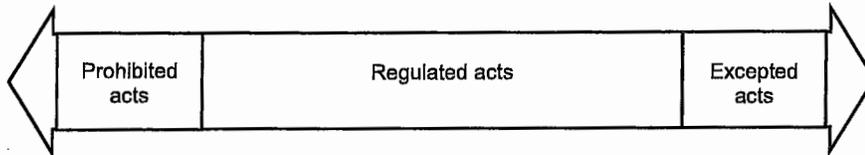
**c) Should any acts in relation to TKECs be prohibited?**

It is likely that traditional communities may consider that some acts should not be undertaken in any circumstances. Policy-makers should refer to customary laws and practices for guidance in this regard. Prohibiting particular acts not only provides a stronger degree of protection where desirable, it also provides some clarity for prospective users on the boundaries of possible uses.

The Pacific Model Law prohibits any non-customary use of sacred–secret TKECs (clause 28).

#### d) What is the relationship between prohibited, regulated and excepted acts?

While this is not strictly a policy question, it may assist policy-makers to clarify the matter.



Both prohibited and exempted acts are excluded from the requirement to obtain the PIC of traditional communities, but at opposite ends of the spectrum and in differing ways. Prohibition bars a particular use altogether and therefore the PIC requirement does not apply. Excepted acts, on the other hand, provide that particular uses do not have a PIC requirement and can occur, usually on the proviso that particular conditions are met.

#### e) What moral rights regarding TKECs should be established?

Moral rights relate to the protection of the personality of the creator or author, the integrity of the work, and similar matters (Sterling 1998: 279). While the scope of moral rights differs in different jurisdictions, certain features are fairly common: moral rights are almost invariably treated in national legislation separately from those sections dealing with economic rights; moral rights are not assignable although they may descend to heirs or successors; and moral rights have the same term of protection as economic rights or a longer term. Also, in civil law jurisdictions, where moral rights and economic rights clash, the moral right is likely to prevail (Sterling 1998: 279).

In determining what moral rights should be established, policy-makers may wish to note that the following types of moral rights frequently appear in both national laws for the protection of TKECs and copyright law:

- the right not to have TKECs subject to insulting, derogatory, cultural and spiritually offensive uses;
- the right of attribution of source in relation to TKECs; and
- the right not to have ownership of TKECs falsely attributed.

There are other types of moral rights, such as the divulgence right (the right to decide when, where and in what form the work will be divulged to any other person or persons) and the retraction right (the right of an author to withdraw a work from publication because of changed opinion), but these do not commonly appear in national laws for the protection of traditional cultural expressions.

#### f) How should acts regarding TKECs be regulated?

Having determined what should be regulated, the next step is to consider how these acts should be regulated. This has largely been predetermined by:

- the legal form of protection in the Pacific Model Law of exclusive property rights, which enable rights holders to authorise or prevent others from undertaking certain acts; and
- the guiding principle of the Pacific Model Law that traditional communities are the owners, holders and custodians of TKECs and the primary decision-makers regarding their use.

Based on these factors, the Pacific Model Law regulates acts regarding TKECs by establishing that particular uses require the **prior and informed consent** of the traditional owners. This is referred to as a '**traditional cultural right**'. Failure to obtain the PIC of traditional owners to use expressions of culture where required will constitute an illicit use and/or misappropriation (or, for the purposes of

legal proceedings, an 'infringement'). Therefore, in order to undertake a regulated act, a prospective user would need to obtain the PIC of the traditional community concerned.

At an operational level, the Pacific Model Law establishes an elaborate process regarding how the PIC of the relevant traditional community should be obtained. In terms of the requirement to obtain the PIC of the traditional communities (recalling that sacred–secret TKECs are excluded from the operation of the regime as they cannot be used outside their customary context), the Pacific Model Law treats all TKECs in the same manner. However, there is flexibility for countries to take a different approach if desired. For example, a country may not wish to impose a PIC requirement for all TKECs and may instead prefer that some expressions be more 'lightly' regulated. This is usefully illustrated by the 'three layers of protection' approach developed in WIPO IGC.

The **three 'layers' of protection** are (in descending order of strength):

- i. sacred–secret, confidential or undisclosed TKECs: legal and practical measures could ensure that communities have the means to prevent the unauthorised disclosure, subsequent use of and acquisition and exercise of intellectual property rights over sacred–secret TKECs;
- ii. TKECs of particular cultural or spiritual value to a community: legal and practical measures could ensure that the relevant traditional community can prevent specified acts taking place without its free, prior and informed consent; and
- iii. other TKECs: legal and practical measures could take a softer approach to ensure that:
  - i. the relevant traditional community is identified as the source of any work or other production adapted from TKECs;
  - ii. any distortion, mutilation or other modification of, or other derogatory action in relation to, a TKEC can be prevented and/or is subject to civil or criminal sanctions;
  - iii. any false, confusing or misleading indications or allegations that, in relation to goods or services that refer to, draw upon or evoke the TKECs of a community, suggest any endorsement by or linkage with that community can be prevented and/or are subject to civil or criminal sanctions; and
  - iv. where the use or exploitation is for gainful intent, there should be equitable remuneration or benefit-sharing on terms determined by a competent authority (where appropriate) in consultation with the relevant community.

**Based on WIPO IGC document WIPO/GRTKF/IC/9/4, Article 3: 'Acts of Misappropriation (Scope of Protection)'**

The 'three layers' approach is intended to provide supple protection that is tailored to different forms of cultural expression and the various objectives associated with their protection. It reflects a combination of exclusive and equitable remuneration rights and a mix of legal and practical measures.

Policy-makers may wish to note the following regarding this approach.

- Sacred–secret, confidential or undisclosed TKECs would receive the strongest form of protection drawing on existing protection for confidential or undisclosed information, building also upon case law to this effect.<sup>11</sup>

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<sup>11</sup> *Foster v. Mountford*. 1976. 29 FLR 233.

- TKECs of particular cultural or spiritual value to a community would receive strong protection in the form of the right of 'free, prior and informed consent', but not as strong as that for sacred–secret TKECs. The right of 'free, prior and informed consent':
  - is akin to an exclusive property right in IP terms and could apply to the kinds of acts usually covered by IP laws;
  - would grant a community the right to either prevent or authorise, on agreed terms including regarding benefit-sharing, the use of a TKEC; and
  - could be subject to prior notification or registration in a public register, depending on decisions taken under the element 'Formalities' (recalling that the use of registration or notification is only an option and for decision by relevant communities).
- Other TKECs (which could be those not registered or notified, depending on the decision taken under 'Formalities') would receive the softest protection and would not be subject to prior authorisation. Instead, protection would concern *how* the TKECs were used. The TKECs could be used – as a source of creative inspiration, for example – without the need for prior consent or authorisation, in furtherance of creativity and artistic freedom. However, *how* they are so used would be regulated, drawing mainly upon moral rights and unfair competition principles as well as the payment of equitable remuneration or equitable benefit-sharing, to be determined by a competent authority. This approach is akin perhaps to a compulsory licence or equitable remuneration approach, found in national *sui generis* laws concerning TKECs as well as in conventional copyright law concerning musical works already fixed in sound recordings.<sup>12</sup>

### 3.4.3 Further information

Other sources of information regarding the scope of protection include:

- WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Geneva: WIPO. Pages 19–23 of the Annex discuss the 'three layers of protection' approach.
- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapters 8 and 9 provide information on the types of moral rights and economic rights respectively used in copyright law.

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<sup>12</sup> Article 13, Berne Convention, 1971.

## 3.5 Exceptions and limitations

It is generally recognised that in certain cases, restrictions should be placed on the exercise or scope of established rights, referred to as 'exceptions' or 'limitations'. Exceptions and limitations provisions can stipulate that a right is not infringed by the doing of certain acts, the right does not subsist in relation to a particular class of subject matter, the right does not apply to things done by the right holder, and/or the right does not apply to certain categories of work.

Restrictions on the exercise or scope of established rights may also occur through the application of legal or other principles that are separate from the law of intellectual property, such as freedom of speech or international human rights standards. The rationale for such restrictions can include consideration of the public interest and prevention of monopoly control.

In the context of protecting TKECs, many traditional knowledge holders have stressed that any IP-type protection should be subject to certain limitations so as not to interfere with the use of TKECs by traditional communities. This is reflected in a guiding principle of the Pacific Model Law that recognises that the continued use, exchange, transmission and development of TKECs within the customary context by the relevant traditional community, as determined by customary laws and practices, should not be restricted or interfered with.

The development of this element involves identifying the exceptions that will be provided for in the legislation regarding uses of TKECs (i.e. uses that are exempt) as well as defining the limitations on the scope of protection.

For simplicity, the Guidelines use 'exceptions' to describe those uses that are excepted from the need to seek authorisation, and 'limitations' to describe limits on the scope of protection. There is, however, no definition in international instruments of the difference between an exception and a limitation. Sometimes what is called a limitation in one law is referred to as an exception in another. 'Exceptions and limitations' is often used to cover all types of restrictions on the exercise or scope of established rights.

### 3.5.1 Policy considerations

At the national level, a number of factors may influence the determination of the exceptions and limitations to be introduced. Of particular significance will be the basic philosophy of a country regarding the rationale of copyright. This will be relevant in setting the parameters of restrictions at both the legislative stage and in litigation before the courts (Sterling 1998: 376). It is apparent from existing national laws that different countries have different concepts as to what restrictions should be admitted and the extent of such restrictions. For example, in the United States, while copyright law is considered to secure a fair return for an author's creative labour, its ultimate aim is to provide an incentive to stimulate the creation of useful works for the general public good.<sup>13</sup> In contrast, the French system is based on the concept of the pre-eminent position of the individual author and the recognition of the principle that the author's right is a right of personality that must be accorded the highest respect.

At the international level, Article 9(2) of the Stockholm Act of the Berne Convention introduced what is commonly known as the 'three-step test', which, in general, governs the way in which exceptions and limitations are to be applied. Countries are able to make their own decisions, within certain parameters, regarding the restrictions to be imposed.

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<sup>13</sup> See *Twentieth Century Music Corp. v. Aiken* 422 US at 156, 186 USPQ at 67, quoted in *Harper and Row*, supra, 471, US at 558.

The three conditions that must be observed in the introduction of any limitation on or exception to the reproduction right are:<sup>14</sup>

- i. the limitation or exception can only apply in certain special cases (indicating that general limitations and exceptions to the reproduction right would not be permissible);
- ii. the limitation or exception must not conflict with normal exploitation of the work (covering the unauthorised making of reproductions in areas that are usually within the control of the right holder); and
- iii. the limitation or exception must not unreasonably prejudice the legitimate interests of the author (covering restrictions that would prevent the author from participating in the economic benefits flowing from the use of the work).

Of course, these conditions apply to the development of copyright law, and even then only if a country is party to the Berne Convention (also referred to as a Union country). However, policy-makers may find this test to be useful. Policy-makers may also wish to note that Article 13 of the TRIPS Agreement (the Agreement on Trade-Related Aspects of Intellectual Property Rights – Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, 1994) extended the application of the ‘three-step test’ from the reproduction right to any of the exclusive rights guaranteed under the TRIPS Agreement (Sterling 1998: 356).

In the context of protecting TKECs, a core policy consideration is striking an appropriate balance between protection against misappropriation and misuse of TKECs, and the freedom and encouragement of further development and dissemination of expressions of culture. As well, expressions of culture form a living body of human culture, and therefore a key policy consideration is ensuring that they are not protected too rigidly.

### 3.5.2 Policy questions

#### a) What uses of TKECs should be excepted from the PIC requirement under the legislation?

In copyright law, exceptions and limitations introduced by national laws and international and regional instruments cover a range of activities and vary considerably from country to country. Some general categories frequently appear: private use; criticism or review; education (e.g. libraries and research); and use of computer programs and databases. National laws may, of course, contain other or additional restrictions on the exercise of rights. Examples include reporting of current events, photography of artistic works on public display, and administrative and judicial procedures.

The Pacific Model Law contains typical copyright exceptions that restrict the exercise or scope of ‘traditional cultural rights’. These are not obligatory exceptions and are intended only to provide guidance for policy-makers.

The Pacific Model Law provides that PIC is not required for any of the following uses:

- a. face-to-face teaching;
- b. criticism or review;
- c. reporting news or current events;
- d. judicial proceedings; and
- e. incidental use.

**Pacific Model Law 2002, Clause 7(4)**

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<sup>14</sup> Article 9(2) reads ‘It shall be a matter for legislation in the countries of the Union to permit the reproduction of such works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author.’

Within WIPO IGC, the following have been identified as possible excepted uses:

- illustration for teaching and learning;<sup>15</sup>
- non-commercial research or private study;
- criticism or review;
- reporting news or current events;
- use in the course of legal proceedings;
- the making of recordings and other reproductions of TKECs for inclusion in an archive or inventory for non-commercial cultural heritage safeguarding purposes,<sup>16</sup> and
- incidental uses.

Further exceptions could be drawn from existing IP principles, in particular, copyright exceptions. However, not all typical copyright exceptions may be appropriate as they may undermine customary rights under customary laws and protocols. An example could be an exception that allows a sculpture or work of artistic craftsmanship permanently displayed in a public place to be reproduced in photographs or drawings and in other ways without permission (McDonald 1997: 44). Similarly, national copyright laws often allow public archives, libraries and the like to make reproductions of works and keep them available for the public. However, doing so in respect of copyrighted cultural expressions may raise cultural and spiritual issues.

## **b) Should conditions be established for the application of the exception?**

In some cases, national laws provide that an exception is only applicable when certain conditions or procedures are observed. Other national laws do not: the defendant in an action for infringement must show that the conduct in question falls within the scope of a statutory exception.

In the context of protection of TKECs, countries can include conditions that must be met in order for the exception to be applicable. For example, there could be a condition that in each case a use must be compatible with fair practice, the relevant community is acknowledged as the source where practicable and possible, and such uses would not be offensive to the relevant community. The Pacific Model Law provides that the user must make sufficient acknowledgement of the traditional owners by mentioning them and/or the geographical place from which the TKECs originated.

A user of traditional knowledge or expressions of culture mentioned in clause 7(4)(a)–(d) must make sufficient acknowledgement of the traditional owners by mentioning them and/or the geographical place from which the traditional knowledge or expressions of culture originated.

**Pacific Model Law, Clause 7(5)**

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<sup>15</sup> While exceptions for teaching purposes are sometimes limited to 'face-to-face' teaching such as in the Pacific Model Law, special exceptions for distance learning may also be appropriate. The term 'teaching and learning' could be used to encompass both scenarios.

<sup>16</sup> National copyright laws in some cases allow public archives, libraries and the like to make, for non-commercial safeguarding purposes only, reproductions of works and expressions of folklore and keep them available for the public (an example is the UK's Copyright, Designs and Patents Act 1988). In this respect, appropriate contracts, IP checklists and other guidelines and codes of conduct for museums, archives and inventories of cultural heritage are under development by WIPO.

### **c) What limitations should be applied on the scope of protection of the legislation?**

As noted previously, many traditional knowledge holders have stressed that any intellectual property-type protection of TKECs should be subject to certain limitations so as not to protect them too rigidly. Overly strict protection may stifle creativity and cultural exchanges, as well as be impracticable in its implementation, monitoring and enforcement.

In terms of defining the limitations of the scope of protection, it is widely acknowledged that protection should not prevent communities themselves from using, exchanging and transmitting amongst themselves expressions of their cultural heritage in customary ways and in developing them by continuous re-creation and imitation. This is reflected in a guiding principle of the Pacific Model Law that states that the continued use, exchange, transmission and development of TKECs within the traditional and customary context by members of the relevant traditional community, as determined by customary laws and practices, should not be interfered with or restricted by the legislation.

Stated differently, this means that protection will extend only to utilisations of TKECs taking place outside the traditional or customary context (*ex situ* uses), whether or not for commercial purposes. As it is utilisations outside the traditional or customary context that have caused most concern to traditional communities, this type of limitation is a useful way of achieving a balance between protection and ongoing use and development of TKECs by traditional communities.

The legislation could provide that all members of a community, or even all nationals of a country, would be allowed, in accordance with traditional or customary practice, unrestricted use of TKECs, or certain of them so specified.

### **3.5.3 Further information**

Other sources of information regarding exceptions and limitations include:

- WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Geneva: WIPO. Pages 26–28 of the Annex discuss exceptions and limitations.
- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 10 provides information on exceptions and limitations in copyright law.

## **3.6 Management of rights**

Having progressed through the development of rights regarding TKECs, the next step is to consider how those rights will be managed. Under copyright law, this would involve consideration of whether the rights holder will exercise the rights, or assign or license their use, or confide their administration to another (Sterling 1998). In the context of the protection of TKECs, it is generally considered that the scope needs to be much broader.

There is, of course, the standard exercising of rights and consideration of how and to whom prospective users apply to use TKECs. However, there are also a number of additional measures that can be used to support the management process, such as the provision of technical assistance and training to traditional communities as well as awareness-raising and cultural sensitisation programmes with industry and the general public. Consequently, the phrase 'management of rights' is purposely used to convey that this element requires broader consideration than the typical 'exercise of rights' under copyright law.

This broad approach is particularly critical from a prevention perspective. Prevention is an important component of protection. Traditional communities frequently emphasise that when their TKECs are misappropriated, the damage is often of a spiritual nature that cannot be remedied through monetary compensation or, in some cases, at all. It is therefore important that a proactive approach is taken to try to minimise the incidence of infringement as much as possible.

Given this broad conception of the management of rights, it becomes apparent that the state will have to play a role in the process. This is reflected in a guiding principle of the Pacific Model Law that recognises the role of the state in providing assistance to traditional communities in the management and enforcement of their rights in TKECs. The use of a state body also provides an identifiable point for prospective users of TKECs to engage with that can promote certainty. Under the Pacific Model Law, a state body – referred to as the Cultural Authority – is established to fill this role. The nature of assistance and guidance will be for individual countries to determine.

The development of this element involves clarifying what the management of rights will consist of and who will carry out the various aspects, including consideration of the respective roles of the state and traditional communities. It is also useful to note at this point that matters of policy relating to the management of rights should be included in the legislation, while matters of detail should be included in delegated or secondary legislation.

### **3.6.1 Policy considerations**

Key policy considerations in this area include striking a balance between acknowledging the rights of traditional communities to control access to and use of their TKECs on the one hand, and on the other hand recognising the capacity and resourcing constraints that many communities face and the need to provide assistance in this regard.

### **3.6.2 Policy questions**

The following questions are intended to assist policy-makers to develop a framework for the management of rights under the legislation. It should be noted that there may be additional questions for policy-makers to consider.

#### **a) What should the 'management of rights' consist of?**

Given that the management of rights has a broader scope than the typical 'exercise of rights' under copyright law, policy-makers will need to consider what should be encompassed within that scope, based on their national circumstances and other relevant factors.

At a minimum, the management of rights involves the administration of rights, including consideration of how and to whom prospective users apply to use TKECs. Additional measures and initiatives that can form part of the management of rights include:

- the provision of technical assistance to traditional communities (such as capacity building, training and education programmes);
- maintaining relationships with regional or government bodies in other countries within the region with responsibilities for the protection of TKECs; and
- undertaking prevention work with industry and the general public (such as developing a code of ethics for industry groups, and conducting public awareness campaigns and cultural sensitisation activities).

In determining the scope of the management of rights, policy-makers may find it useful to consider the aforementioned measures and initiatives as well as clause 37 of the Pacific Model Law. It is important to bear in mind that the functions listed in clause 37 are intended to be indicative only. Policy-makers may also find it useful to proceed on the basis of identifying what needs to be done and then identifying who will carry out those tasks as appropriate.

#### **Functions of the Cultural Authority**

The functions of the Cultural Authority may include the following:

- (a) to receive and process applications under Part 4;
- (b) to monitor compliance with authorised user agreements and to advise traditional owners of any breaches of such agreements;
- (c) to develop standard terms and conditions for authorised user agreements;
- (d) to provide training and education programmes for traditional owners and users of TKECs;
- (e) to develop a Code of Ethics in relation to use of TKECs;
- (f) to issue advisory guidelines for the purposes of this Act;
- (g) to liaise with regional bodies in relation to matters under this Act;
- (h) to maintain a record of traditional owners and/or knowledge and expressions of culture;
- (i) if requested to do so, to provide guidance on the meaning of customary use in specific cases;
- (j) such other functions as are conferred on it by this Act.

#### **Pacific Model Law, Clause 37**

## **b) Who will carry out the management of rights?**

Once a country has determined what measures will be encompassed within the scope of the management of rights, the next step is to consider who will carry out the various measures. Given the guiding principle of the Pacific Model Law, which recognises the role of the state in providing assistance to traditional communities in the management of their rights, there is an expectation that the state will have a role. Countries will therefore need to establish a body, or assign an existing body. While there is this requirement, countries have considerable flexibility to determine what roles and

functions the state body will have and what roles traditional communities will have. In some countries, there may be additional bodies, such as pan-tribal organisations, that should have a role as well.

Some management measures, such as technical assistance and capacity-building work with traditional communities, would most likely be carried out or supported by the state, as would bilateral and regional relationship management. Prevention work through awareness campaigns and the development of codes of ethics may be more suitably progressed as joint initiatives between traditional communities and the state, depending on resourcing constraints.

However, the administrative aspect of the management of rights is not so straightforward. A complex policy question needs to be addressed: *To whom should prospective users have to apply to use TKECs?*

Two guiding principles of the Pacific Model Law are instructive in this regard:

- recognise that traditional communities are the owners, rights holders and custodians of TKECs and the primary decision-makers regarding their use; and
- respect and give effect to the right of traditional communities to control access to their TKECs, especially those of particular cultural or spiritual value or significance, such as sacred–secret TKECs.

Under the Pacific Model Law, authorisation can be obtained only from the relevant traditional community or communities.<sup>17</sup> Prospective users have the option of applying to a state body (the Cultural Authority) that then performs an intermediary function between the prospective user and the community, or applying directly to the traditional community. However, in some circumstances traditional communities may not wish to or cannot exercise rights directly. In this case, a state body, such as an agency, authority or statutory body, may be designated to act at all times at the request of and on behalf of relevant communities.

In identifying to whom prospective users would have to apply to use TKECs, countries may find the following approaches, which are used in existing laws for the protection of traditional cultural expressions, to be instructive:

- i. the relevant traditional community; or
- ii. a state body (whether existing or specially created); or
- iii. both a state body and the relevant traditional community; or
- iv. a collective management organisation.

An explanation of each approach follows.

#### *Option i: The relevant traditional community*

Under this option, a prospective user would apply directly to the relevant traditional community for authorisation to use the expression and the underlying traditional knowledge concerned. This approach could be considered to be the ideal arrangement as traditional communities themselves will decide whether or not to grant authorisation. It therefore gives recognition to the principle that traditional communities are the primary decision-makers regarding their TKECs.

However, at a practical level a number of limitations have been identified with this approach. For example, there are often capacity issues within communities that can negatively impact on the

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<sup>17</sup> There is an exception where no traditional owners can be identified or no agreement has been reached about ownership (clause 19, Pacific Model Law).

negotiation of a fair and equitable agreement. Moreover, communities may face resourcing constraints that hamper their ability to obtain external advice on the proposed use and the terms and conditions of the agreement.

#### *Option ii: A state body*

Where the relevant communities are not able or do not wish to exercise rights directly, a state body may be designated to act at all times at the request of and on behalf of the communities. In this case, the rights holder would confide the administration of their rights to the state body so that the body could grant authorisation, where appropriate, on behalf of the traditional community concerned.

Many Indigenous peoples, however, have expressed serious reservations about any state body acting on their behalf. This underscores the need for any state body to derive its entitlement to act from the explicit wishes and authority of the community concerned.

An existing office, authority or society could be used and it could be governmental, quasi-governmental or non-governmental. Many national laws providing *sui generis* protection for traditional cultural expressions utilise this approach. For example, the Tunisian Copyright Act 1994 provides that ‘... any transcription of folklore with a view to exploitation for profit shall require authorisation from the Ministry responsible for culture against payment of a fee for the benefit of the welfare fund of the Copyright Protection Agency established pursuant to this Law’.<sup>18</sup> The Nigerian Copyright Act 1997 vests the right to authorise acts in relation to folklore in the Nigerian Copyright Commission.<sup>19</sup> The Indigenous Peoples Rights Act of 1997 of the Philippines also uses this approach.

This approach may also be useful where there are shared expressions across a number of traditional communities in the same country and it is difficult to agree upon an equitable way to distribute benefits received across the communities involved. The agency could collect the benefits and transfer them to an initiative that benefits all the communities.

If this approach is taken, policy-makers will need to address a number of questions, including the following.

- What consultation, if any, should the state body have with the relevant traditional community? While this approach is based on the rights holder confiding the administration of their rights to a state body, it may not be preferable to grant the body an absolute power in this regard. For example, a country may wish to include a provision establishing that where authorisations are granted by an agency, such authorisations should be granted only in appropriate consultation with the relevant community, in accordance with their traditional decision-making and governance processes.
- What authorisations can be granted by the state body? It may not be desirable for the body to have an absolute power to grant authorisations, and some parameters may be necessary. At a minimum, it could be expected that authorisations should comply with the scope of protection provided for the TKECs concerned. A provision could also be included specifying that in order to act on behalf of a community, a state body would need to negotiate the scope of its authority with the community. This may, for example, include specified restricted uses that require consultation with the community concerned.
- What should the authority do with the benefits received? The state body may receive benefits for the use of particular TKECs. A country may wish to include a provision specifying that monetary or non-monetary benefits collected by the authority for the use of expressions of culture should be provided directly by the authority to the community concerned.

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<sup>18</sup> Section 7, Tunisian Copyright Act 1994.

<sup>19</sup> Section 28, Nigerian Copyright Act 1997.

This body could also carry out various tasks associated with the management of rights. These other functions are discussed further in this section of the Guidelines.

*Option iii: Both a state body and the relevant traditional community*

Under this option, the state body plays a primarily administrative role in the authorisation process, although in some instances it can grant authorisation. Both the state body and the relevant traditional community have specified roles in the authorisation process. The state body, whether existing or specially created, acts as a contact point for prospective users and receives applications for authorisation to use TKECs if communities are not able to, and then forwards the applications to the relevant communities. The state body acts in the interests of the relevant communities and mediates between the communities and users. This is the approach taken in the Peru Law 2002, which provides for a 'Competent National Authority' and an 'Indigenous Knowledge Protection Board', each having various specific duties. Prospective users are also able to apply directly to the relevant traditional community if desired, although the state body will carry out a 'watchdog' role to ensure that the interests of the community are appropriately promoted.

The Pacific Model Law takes a similar approach and provides for the establishment of a 'Cultural Authority' to which application can be made by prospective users of particular TKECs to obtain the PIC of the 'traditional owners'. The prospective user can also apply directly to the community concerned. Where an application is made to the Cultural Authority, the Cultural Authority has to identify the traditional owners and act as a liaison between the prospective user and traditional owners, including resolving uncertainties or disputes as to ownership. If no 'traditional owners' can be found or there is no agreement as to ownership, the Cultural Authority can be determined to be the traditional owner. In cases where the prospective user deals directly with the traditional owners, the Cultural Authority still has a role in providing advice on the terms and conditions of the agreement.

If this approach is taken, policy-makers will need to address a number of questions, including the following.

- What authorisations can be granted by the state body? The Pacific Model Law provides that where no 'traditional owners' can be found or there is no agreement as to ownership, the Cultural Authority can be determined to be the traditional owner. It can then grant authorisations, if appropriate. For countries using this approach, it is important that any authority of a state body to act is obtained from the traditional communities. In some countries, it may not be appropriate that a state body grant authorisations in any situation. A provision could be included in the legislation specifying that in order to act on behalf of a community, a state body needs to negotiate the scope of its authority with the community concerned.
- Should the state body have a role in determining whether PIC has been obtained? Under the Pacific Model Law clause 7(2), uses of TKECs are regulated through a requirement to obtain the PIC of the traditional owners. Countries may wish to consider whether indicators of what constitutes PIC are needed. Clause 23(1) of the Pacific Model Law provides that if an authorised user agreement is entered into, traditional owners are deemed to have given their PIC. Some of the characteristics of PIC that are often identified are: all members of the communities affected consent to the decision; consent is determined in accordance with customary processes; there is full disclosure of the intent and scope of the proposed activity; and decisions are made in a language and process understandable to the communities.
- Should the state body have a role in determining equitable compensation and, as appropriate, facilitating and administering the payment and use of equitable compensation?
- How should prospective users make application to use TKECs? Having determined who prospective users make application to, the secondary question is how this is done. Matters of operational detail in this regard would typically form part of secondary legislation rather than primary legislation. However, as this issue forms part of the broader framework of the management of rights, it is useful to make brief reference to the types of issues that would need to

be addressed. They include guidance on procedures for applications for authorisations; the information any application for authorisation has to contain; allowing for the collecting of fees, if any, for authorisations and the purpose for which the collected fees must be used; public notification procedures; and the terms and conditions upon which authorisations may be granted by the authority.

#### *Option iv: A collective management organisation*

Another option is the use of a collective management organisation, which is potentially the most practical means of administering rights in TKECs. Systems of collective administration and management of IP rights are well developed for copyright and certain related rights. Increasingly, the exercise of rights is being confided to collecting societies that have the resources and expertise to act effectively for the rights holder (Sterling 1998: 393). Typically, the organisation is registered as a legal entity (company, etc.) under the relevant law. There is often a board, consisting of, for example in the case of authors, representatives of authors and publishers.

In the case of TKECs, rights holders are compensated for use of their material through licence schemes. For example, through these schemes approved collecting organisations would be paid for the reproduction of expressions. The collecting society would then be responsible for distribution of the money to their members. Alternatively, a national trust fund could be established, into which part of any funds obtained from licences granted in relation to TKECs are paid. The fund could be used to, for example, assist the preservation of cultural practices within traditional communities.

### **3.6.3 Further information**

Another source of information regarding the management of rights is:

- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 12 provides information on the exercise of rights in copyright law.

## 3.7 Term of protection

It is commonplace for IP laws, such as copyright and patent law, to establish a term of protection following which the protected subject matter enters the public domain for the common good, thereby facilitating and encouraging disclosure of innovation. Copyright generally provides for a term of protection based on the life of the author plus a fixed term of years. For the related rights of performers, producers, broadcasters, etc., protection is usually determined on the basis of a fixed term of years beginning at a certain point in time.<sup>20</sup>

However, many traditional communities desire indefinite protection for at least some aspects of expressions of their traditional cultures, and in this instance, most branches of the IP system do not meet their needs.<sup>21</sup> On the other hand, it is generally seen as integral to the balance within the IP system that the term of protection not be indefinite so that works ultimately enter the 'public domain'.

The development of this element involves determining the term of protection in relation to the nature of TKECs, particularly where different layers of TKECs have been identified. It also involves consideration of whether particular conditions should be invoked in order to maintain the term of protection.

### 3.7.1 Policy considerations

A fundamental policy consideration is striking an appropriate balance between traditional knowledge holders' desire for indefinite protection and that of the promotion of the public domain for the general public good.

### 3.7.2 Policy questions

The following questions are intended to assist countries to develop a policy regarding the term of protection that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### a) Should all TKECs receive the same term of protection?

Depending on decisions taken under the element 'Subject matter of protection', a country may have determined that there are different layers of TKECs and that for the purposes of protection, the layers should be treated differently. Under the element 'Scope of protection', different strengths of protection were discussed for different layers (referred to as the 'three layers of protection' approach).

It may be considered inappropriate that a single term of protection be used to cover all TKECs. Therefore, in determining the term of protection, countries may need to consider whether different terms of protection are necessary to accommodate different layers of TKECs. For example, indefinite protection could be used only for sacred–secret expressions, while those expressions of significance to a traditional community could also qualify for indefinite protection but only if particular conditions are met and maintained.

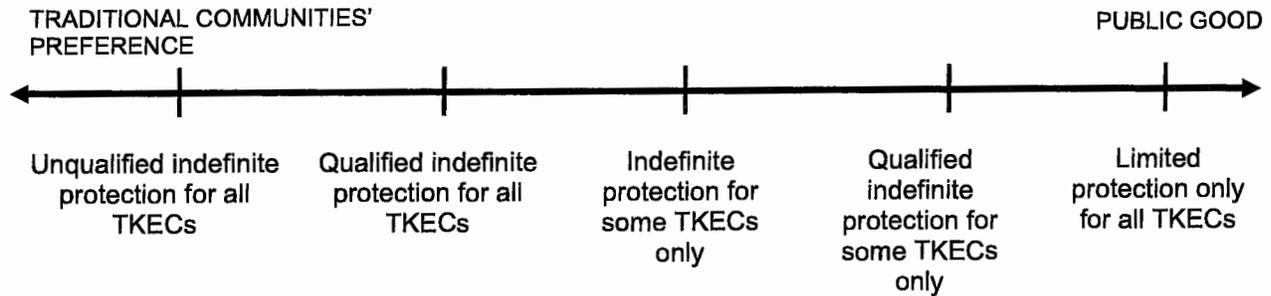
The Pacific Model Law does not establish a time limit. Clause 9 provides that traditional cultural rights continue in perpetuity. This is a matter that countries have the flexibility to change if desired. The

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<sup>20</sup> The general international term of protection for authors' rights is the life of the author plus 50 years (by virtue of the Berne Convention and the TRIPS Agreement) and the fixed term of protection is 50 years for the related rights. See Sterling 1999: 380.

<sup>21</sup> Trademarks are renewable, and unfair competition protection is indefinite. Extended protection in the copyright domain is also not entirely without precedent. While the Berne Convention and the TRIPS Agreement stipulate 50 years as a minimum period, countries are free to protect copyright for longer periods.

range of options regarding the possible terms of protection for TKECs can be loosely illustrated using a spectrum, as follows.



Each of these options caters for the interests of traditional communities and the public good in a different way.

- i. Unqualified indefinite protection for all TKECs: All TKECs would receive indefinite protection and protection would not be linked to any conditions. This is the approach taken in the Pacific Model Law as well as the Model Provisions 1982.
- ii. Qualified indefinite protection for all TKECs: This option provides the same coverage of protection for TKECs but qualifies the protection with conditions that must be met in order for protection to be maintained.
- iii. Indefinite protection for some TKECs only: The policy rationale here is that it may be inappropriate that a single term of protection be used to cover all TKECs.
  - i. Qualified indefinite protection for some TKECs only: Indefinite protection would be available for some TKECs provided particular conditions were met. Such conditions could be the criteria for protection established under the legislation.
  - ii. Limited protection only for all TKECs: No distinction would be drawn between different layers of TKECs.

## **b) Should the term of protection be linked to particular conditions?**

If an expression of culture and its underlying traditional knowledge receive indefinite protection, one means for ensuring that the protection remains valid is to impose conditions that must be met for protection to continue. For example, such conditions could be that the expression continues to be maintained and used by, and is characteristic of, the relevant community. This would entail a trademark-like emphasis on current use, so that once the community that the TKEC is characteristic of no longer uses the TKEC or no longer exists as a distinct entity, protection for the TKEC would lapse (Scafidi 2001: 793).

Such an approach has the merit of giving effect to customary laws and practices and drawing upon the very essence of the subject matter of protection. When a TKEC ceases to be characteristic of and ceases to identify a community, it ceases by definition to be a TKEC for the purposes of protection under the legislation, and it follows that protection should lapse. This general line of thinking is reflected in the US Indian Arts and Crafts Act 1990, which excludes from protection products that are no longer 'Indian' because, for example, they have become 'industrial products'. This act sets out in some detail what constitutes an 'Indian product'. The Panama Law 2000 seems to link the term of protection to the protected subject matter continuing to display the characteristics that qualified it for protection in the first place (as protection is indefinite rather than unlimited).

If any notification or registration requirements (discussed in 'Formalities' below) are considered useful, and depending also on their legal effects, the period of protection may also be linked to the maintenance of registration.

### **3.7.3 Further information**

Another source of information regarding the term of protection is:

- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 11 provides information on the term of protection in copyright.

## 3.8 Formalities

This element concerns how protection will be acquired and maintained under the legislation, referred to as 'formalities'. This should not be confused with how authorisation to use TKECs will be obtained.

The Pacific Model Law does not contain a formalities provision. Automatic protection is granted without formalities. The policy rationale for this is that the imposition of formalities has been identified by traditional knowledge holders as having a significant bearing on the accessibility of protection. There is flexibility to modify this policy if countries wish to incorporate greater certainty and precision.

The development of this element involves identifying how protection will be acquired under the legislation.

### 3.8.1 Policy considerations

Important considerations for policy-makers include the need for practically feasible formalities and avoiding excessive administrative burdens for rights holders and administrators alike. At the same time, it is important to be cognisant of the need for transparency and certainty, particularly for external researchers and other users of TKECs in their relations with traditional communities.

### 3.8.2 Policy questions

The following questions are intended to assist countries to develop a policy regarding formalities that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### a) How should protection be acquired?

There are three broad approaches that are used across existing laws for the protection of traditional cultural expressions regarding how protection is acquired:

- i. automatic protection without formalities: Protection is provided automatically without formalities so that it is available as of the moment an expression is created, similar to copyright. As noted above, examples of this approach include the Pacific Model Law 2002 and the Model Provisions 1982;
- ii. a registration or notification system: An alternative to automatic protection is to provide for some kind of registration, possibly subject to formal or substantive examination. A registration or notification system is often used to provide greater transparency and certainty, which can be important for users of TKECs and researchers. Existing laws that utilise this approach include the Panama Law 2000 and the Peru Law 2002. A registration system may merely have declaratory effect, in which case proof of registration would be used to substantiate a claim of ownership, or it may constitute rights; and
- iii. a hybrid of automatic protection and registration: This approach reflects the general principle that TKECs should be protected without formality following copyright principles and in an endeavour to make protection as easily available as possible, but requiring some form of registration or notification for those expressions that would receive strong protection, that is, sacred–secret expressions (ensuring, though, that registration should not entail the inappropriate disclosure of such material) and expressions of particular cultural or spiritual significance for which strong PIC-based protection would be applicable. This approach also provides different treatment for different layers of TKECs.

If automatic protection is considered appropriate, policy-makers may wish to consider whether or not it would be beneficial to add a specific provision to the legislation clarifying this.

If registration or notification is considered appropriate, policy-makers would need to consider further questions of implementation. Secondary legislation or administrative measures could provide guidance on issues such as:

- the manner in which applications for notification or registration should be made;
- to what extent and for what purposes applications are examined by the registration office;
- measures to ensure that the registration or notification of TKECs is accessible and affordable;
- public access to information concerning which TKECs have been registered or notified;
- appeals against the registration or notification of TKECs;
- the resolution by the registration office of disputes relating to which community or communities should be entitled to benefit from the protection of a TKEC, including competing claims from communities from more than one country; and
- the legal effect of notification or registration.

While a notification or registration system may have initial application at the national level, thus implying national registers or other notification systems, eventually some form of regional and international register could form part of regional and international systems of protection. Such an international system of notification/registration could perhaps draw from existing systems such as Article 6*ter* of the Paris Convention or the registration system provided for in Article 5 of the Lisbon Agreement for the International Registration of Appellations of Origin 1958.

If a country prefers the hybrid approach, the implementation questions outlined regarding notification and registration would also be applicable. There would be no need to register or notify sacred–secret expressions as these would be separately protected. The registration option would be applicable only in cases where communities wished to obtain strict, PIC protection for TKECs that were already known and publicly available and of particular cultural or spiritual value or significance. Policy-makers may wish to note the following regarding how this approach could be implemented.

- Only a community that claims protection of a particular expression and the underlying traditional knowledge may register or notify, or, in cases where the community is not able to do so, a competent authority with rights management responsibilities can do so, acting at the request of and in the interests of the community.
- Registration or notification need not be an obligation: protection could remain available for unregistered expressions. The registration option is applicable only in cases where communities wish to obtain strict, PIC protection for expressions that are already known and publicly available.
- Registration or notification can be declaratory only and not constitute rights. This is for individual countries to determine. Without prejudice thereto, entry in the register could presume that the facts recorded therein are true unless proven otherwise, and also not affect the rights of third parties.
- To the extent that such registration or notification may involve the recording or other fixation of the TKECs concerned, any IP rights in such recordings or fixations could vest in or be assigned to the relevant community.
- Information on and representations of the TKECs that have been so registered or notified could be made publicly accessible at least to the extent necessary to provide transparency and certainty to third parties as to which TKECs are so protected and for whose benefit.

- The competent authority receiving such registrations or notifications could resolve any uncertainties or disputes as to which communities – including those in more than one country – should be entitled to registration or notification or should be the beneficiaries of protection, using customary laws and processes, alternative dispute resolution and existing cultural resources, such as cultural heritage inventories, as far as possible. In so far as taking existing cultural resources into account, the authority could refer also to cultural heritage inventories, lists and collections such as those established under the UNESCO Convention for the Safeguarding of the Intangible Cultural Heritage 2003. There may, more broadly, be some opportunities for developing synergies between inventories established or being established for cultural heritage preservation purposes (such as States Parties are obliged to do under the UNESCO Convention referred to) and the kind of registers or notification systems suggested here. Indeed, measures could be developed to ensure that cultural heritage inventories, lists and collections reinforce, support and facilitate the implementation of *sui generis* provisions for the protection of TKECs (UNESCO 2005). To this end, WIPO is developing IP protocols and best practices for the recording and digitising of intangible cultural heritage.<sup>22</sup> These protocols and best practices will be of assistance to communities, museums, archives, cultural agencies and others who collect, record, make inventories of, digitise and make available elements of intangible cultural heritage. They will help such parties to identify IP issues, clarify IP options and develop IP strategies that further their overall safeguarding objectives.

### 3.8.3 Further information

Other sources of information regarding formalities include:

- WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Geneva: WIPO. Pages 32–36 of the Annex provide information on formalities.
- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell.

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<sup>22</sup> See <http://www.wipo.int/tk/en/folklore/culturalheritage/index.html>.

## 3.9 Legal proceedings (sanctions and remedies)

It is common for countries to have civil remedies as well as criminal sanctions for copyright infringement. Similarly, in the context of the protection of traditional cultural expressions, it has been broadly acknowledged that both civil and criminal actions should be available where the rights of traditional communities have been breached. The development of this element involves prescribing the civil and criminal legal proceedings in this regard.

### 3.9.1 Policy questions: civil proceedings

Civil law is not primarily concerned with punishment; this is the domain of criminal law. The remedies provided by civil law have other purposes, such as compensation, the remedying of wrongs and stopping unlawful conduct. There are exceptions to this general principle, in particular the civil remedy of exemplary damages (designed to inflict punishment rather than compensate) and the sentence of reparation (designed to compensate the victim rather than punish the offender).

The following questions are intended to assist countries to clarify the civil proceedings for infringement.

#### a) What constitutes an infringement?

During the development of the element 'Scope of protection', countries will have determined the types of acts relating to TKECs that will be regulated under the legislation. Countries may wish to consider including a specific provision linking these regulated acts to what constitutes an infringement under the legislation. For example, there could be a provision that states that 'traditional cultural rights in TKECs are infringed by a person who does any restricted act'. The provision could also clarify whether the doing of the restricted act had to be to the work as a whole to constitute infringement or whether the doing of the restricted act to any substantial part of the work is sufficient. It could also clarify whether the doing of a restricted act includes both direct and indirect acts.

The Pacific Model Law does not include a provision specifying what amounts to infringement under the legislation on the basis that this will be determined at national level.

#### b) When may infringement proceedings be brought?

The legislation will need to clarify when proceedings can be brought. Typically, it will state that an infringement under the legislation is actionable.

Under the Pacific Model Law, infringement proceedings may be instituted in two situations:

- i. where traditional cultural rights are infringed – that is, if a person makes a non-customary use of a TKEC (whether or not such use is of a commercial nature), and the traditional owners have not given their PIC to that use (clause 30(1)); and
- ii. where moral rights are infringed – that is, if a person does an act or makes an omission in relation to a TKEC that is inconsistent with the moral rights of the traditional owners of that TKEC, and the traditional owners have not given their PIC to the act or omission (clause 30(2)).

Countries may wish to also clarify when infringement proceedings may not be brought. For example, the legislation may include a provision stating that no person may bring proceedings for the infringement of unregistered rights (if a registration or notification system is adopted), where relevant.

In addition, policy-makers may wish to consider whether an action may be brought when there is a strong likelihood that rights may be infringed. For example, under the Peru Law 2002 an action may be brought if imminent danger exists that rights may be violated. Also, under the Panama Law 2000 Indigenous communities or the country or regional governor may take preventative action (Article 22).

This 'precautionary'-type approach is important given the spiritual and cultural damage that frequently occurs when expressions of culture are misappropriated. In some cases, the damage to particular individuals and/or traditional communities is irreversible. It is therefore preferable to prevent infringements before they occur rather than wait until after the fact to take an action.

### **c) Who may institute infringement proceedings?**

It is important to specify who may institute infringement proceedings. This will be determined largely by the decisions taken under the element 'Enforcement', regarding the role of the state in enforcement.

A guiding principle of the Pacific Model Law is that 'traditional communities are the owners, holders and custodians of TKECs and the primary decision-makers regarding their use'. It follows, therefore, that the legislation would make provision for traditional communities to be able to take an action to enforce their rights. This is reflected in clause 30 of the Pacific Model Law, which provides that traditional owners may institute civil proceedings. It is also the case in many *sui generis* laws for the protection of traditional cultural expressions.

However, policy-makers may wish to consider whether it is necessary for the legislation to make provision for other individuals or bodies to be able to take an action. For example, under the Panama Law 2000, apart from the affected Indigenous communities, the regional or country governor may take preventative action (Article 22). In the Peru Law 2002, infringement actions may also be brought *ex officio* by decision of INDECOPI (the competent national authority).

There is also a possibility that some traditional communities may wish a state body to enforce their rights on their behalf while other communities in the same country may not wish to do so. The legislation would need to be able to accommodate the relevant scenarios while ensuring consistency with the guiding principle that traditional communities are the owners, holders and custodians of TKECs and the primary decision-makers regarding their use.

Policy-makers may also wish to address whether the legislation should include limitations on who can take an action, to prevent erroneous or non-mandated actions. For example, the legislation may provide that only a mandated representative of a traditional community can bring an action rather than individual members of a community.

### **d) Where may infringement proceedings be brought?**

The legislation should specify which court infringement proceedings would need to be brought to. The Pacific Model Law purposely leaves the court blank as this should be determined at national level.

However, a secondary question arises: Are the ordinary courts an appropriate body for legal proceedings relating to TKECs? Given that the majority of PICTs are small countries with limited resources, the Pacific Model Law does not establish new institutions for the purposes of legal proceedings. It uses ordinary courts but does not prescribe what type of court, leaving this to be determined at national level.

When the Pacific Model Law was being developed, it was recognised that the procedural character of the ordinary courts process may not be appropriate. New or existing institutions other than the ordinary courts may be better able to manage matters requiring resolution under the legislation because of the need for specialist knowledge, the desirability of less formality in proceedings than is the practice of the ordinary courts and the desirability of different fact-finding procedures or other procedures such as mediation that may not be available through the ordinary courts. Indeed, traditional communities have widely criticised the use of the Western judicial system and called for more appropriate processes, including greater recognition of customary law processes.

There are numerous examples that countries can draw on for guidance if they wish to establish a dedicated body under the legislation for civil proceedings rather than use the formal and adversarial

processes of the ordinary courts. In terms of specialised bodies on Indigenous issues, there are the Maori Land Court and the Waitangi Tribunal in New Zealand. In respect of less formality and different fact-finding procedures, many countries have family courts. Regarding IP models, some countries provide that proceedings can be taken to commissioners (such as the Commissioner of Trade Marks) in addition to the ordinary courts. Copyright tribunals are also used in Australia and New Zealand.

### **e) Should there be a penalty for bringing unjustified proceedings?**

In order to provide a deterrent for vexatious claims, policy-makers may wish to consider whether it is appropriate to incorporate a penalty in the legislation for bringing unjustified proceedings. While not a typical feature of copyright law or laws for the protection of traditional cultural expressions, it does appear in New Zealand's copyright and trademark legislation as well as Fiji's copyright law.

An example of an unjustified proceedings provision from New Zealand's copyright legislation is provided below.

- 1) Where a person brings proceedings alleging an infringement of copyright, a court may, on the application of any person against whom the proceedings are brought:
  - a. make a declaration that the bringing of proceedings was unjustified;
  - b. make an order for the payment of damages for any loss suffered by the person against whom the proceedings are brought.
- 2) A court shall not grant relief under this section if the person who brought the proceedings proves that the acts in respect of which proceedings were brought constituted, or would have constituted if they had been done, an infringement of the copyright concerned.
- 3) Nothing in this section makes a barrister or solicitor of the High Court of New Zealand liable to any proceedings under this section in respect of any act done in his or her professional capacity on behalf of a client.

#### **Section 130, Copyright Act 1994 (New Zealand)**

### **f) What types of remedies should be available for infringement?**

Common remedies that are available under copyright laws and legislation for the protection of traditional cultural expressions are injunctions, damages and account of profits. Often, a general provision is also included that enables the court to grant additional relief as it considers appropriate. Of particular importance in the prevention of infringement is the availability of judicial procedures that enable speedy recourse to the courts for relief pending trial of the action (such as the issuing of injunctions to prevent the further distribution of the defendant's product).

In the context of infringements regarding TKECs, traditional communities often argue that the remedies available under current law may not provide for damages equivalent to the degree of cultural and non-economic damage caused by the infringing use. While in some cases damages awarded by courts have taken cultural issues into account,<sup>23</sup> when TKECs are misappropriated and/or used offensively the primary damage is often not monetary in nature, but cultural. Consequently, monetary remedies will have very limited effect in addressing the cultural harm caused to traditional communities. Forms of cultural redress are therefore critical. Existing customary law practices will be instructive in this regard.

Policy-makers can refer to clause 31 of the Pacific Model Law to assist them in identifying what remedies may be appropriate. It may also be useful to note the following regarding clause 31.

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<sup>23</sup> See the Australian case of *George M\*, Payunka, Marika and Others v. Indofurn Pty Ltd* 30 IPR 209.

- It includes civil remedies that are commonly available, such as injunctions, damages and account of profits.
- It includes additional remedies, such as a public apology and a declaration that the traditional cultural rights of the traditional owners have been contravened (clauses 31(1)(c) and (d)).
- It provides that the court can make an order that infringements of moral rights cease or be reversed (clause 31(1)(e)).
- It provides that the court may grant an order for the seizure of any object made, imported or exported contrary to the Act. Policy-makers should consider whether to provide greater clarification for the courts in the legislation on this matter. Such provisions could clarify matters such as the ability of the court to be able to order erasure, removal, obliteration, delivery up and to whom (owner or other person the court thinks fit), and also disposal. It could also clarify whether those with an interest in the infringing objects will be served with notice, and whether those with an interest in the infringing objects have any rights and what those rights are. Policy-makers may wish to refer to existing copyright legislation for further guidance on this matter (clause 31(1)(g)).

The Court may grant all or any of the following remedies in relation to civil claim proceedings:

- an injunction;
- damages for loss resulting from the unauthorised use;
- a declaration that the traditional cultural rights of the traditional owners have been contravened;
- an order that the defendant make a public apology for the contravention;
- an order that any false attribution of ownership, or derogatory treatment, of the traditional knowledge or expression of culture cease or be reversed;
- an order for an account for profits;
- an order for the seizure of any object made, imported or exported contrary to the legislation;
- such other orders as the Court considers appropriate in the circumstances.

**Pacific Model Law, Clause 31**

- It provides that the court may grant any such orders as it considers appropriate in the circumstances. This could be used to provide cultural redress in respect of cultural and non-economic damage caused by the infringing use. However, countries may wish to provide greater clarity in this regard through the inclusion of a specific remedy. If there is some uncertainty as to application of a remedy, specific legislative provision is desirable (clause 31(1)(h)).

Once it has been determined which remedies should be available, policy-makers will need to consider these against the various civil remedies of general application that are available under the common law and the general statute law in their country, and assess their adequacy. The outcomes of this assessment may result in one or more of the following.

- Existing civil remedies are considered to be sufficient.
- It is considered that some remedies require modification for the purposes of the legislation: it may be necessary to vary some aspect of a remedy to make it effective in the particular context of protecting TKECs. An example of a modification to an existing civil remedy is contained in section 81 of the Commerce Act 1986 in New Zealand, which specifies a range of circumstances in which the High Court may grant an injunction to restrain certain behaviour. The section enlarges the range of circumstances in which the existing remedy would be available under the common law, and clarifies the application of the remedy.
- It is considered necessary to create new remedies: this may arise in circumstances such as if there is a demonstrated inadequacy of existing civil remedies in achieving the desired policy objective or there are difficulties in modifying existing remedies to improve their utility. If policy-makers are considering a new remedy, it is wise to undertake prior consultation with persons knowledgeable in the operation of the remedy to ascertain the likely pitfalls, and consider whether

the proposed remedy will create anomalies or inconsistencies in the operation of the law generally (i.e. whether the innovation is desirable in principle as well as effective in practice).

### **g) What matters should be considered by the court?**

It is common for legislation to specify criteria for the court to consider when making a decision regarding relief. This can vary from precise rules of law to very broad standards (such as the public interest or the welfare of a child).

In developing criteria, policy-makers may wish to refer to clause 31(2) of the Pacific Model Law, which specifies what the court must take into account when considering the relief to be granted. This criterion is indicative only and countries can adapt as desired.

The [ ] court in deciding what relief is to be granted may take into account all or any of the following:

- a) whether the defendant was aware or ought reasonably to have been aware of the traditional cultural rights and moral rights of the traditional owners;
- b) the effect on the honour or reputation of the traditional owners resulting from the unauthorised use;
- c) anything done by the defendant to mitigate the effects of the unauthorised use;
- d) any cost or difficulty that may have been associated with identifying the traditional owners;
- e) any cost or difficulty in ceasing or reversing any false attribution of ownership, or derogatory treatment, of the traditional knowledge or expression of culture;
- f) whether the parties have undertaken any other action to resolve the dispute.

**Clause 31(2), Pacific Model Law**

## **3.9.2 Policy questions: criminal proceedings**

### **a) Is it necessary to create a criminal offence?**

Most legal systems draw a distinction between conduct that is treated as a criminal offence and conduct that, while regarded as wrongful, is regulated only by the civil law. A primary question, therefore, for policy-makers to address is whether or not particular conduct requires the intervention of the criminal law or whether civil remedies are adequate and appropriate for the purposes of enforcement. Understandably, rights holders are in a stronger position where both civil and criminal penalties are available. In some countries, the same act of infringement can bring about liabilities for damages, etc. under a civil action, and for fines and/or imprisonment under criminal provisions.

In determining whether there should be criminal offences under the legislation, it is important to note that the criminal law is concerned with the punishment of offenders and the deterrence of others from wrongdoing. Generally, it is not concerned with compensation, which is the province of the civil law. The criminal law is intended to punish only conduct that is in some way blameworthy. The notion of blameworthiness is an integral feature of the criminal process (Legislation Advisory Committee 2001: 141).

Policy-makers may wish to consider the following questions when determining whether to create a criminal offence (Legislation Advisory Committee 2001: 143).

- Will the conduct in question, if permitted or allowed to continue unchecked, cause substantial harm to individual or public interests?

- Would public opinion support the use of the criminal law, or is the conduct in question likely to be regarded as trivial by the general public?
- Is the conduct in question best regulated by the civil law because the appropriate remedies are those characteristic of the civil law (e.g. compensation, restitution)?
- Is the use of the criminal law being considered solely or primarily for reasons of convenience rather than as a consequence of a decision that the conduct itself warrants criminal sanctions?
- If the conduct in question is made a criminal offence, how will enforcement be undertaken, who will be responsible for the investigation and prosecution of the offence, and what powers will be required for enforcement to be undertaken?
- If the new offences in question are unlikely to be enforced, or likely to be enforced only rarely, the question of whether a criminal sanction is warranted should be examined carefully, because creating offences that are not going to be enforced will bring the law into disrepute. If enforcement of the new law is going to be left to the police as part of their general duty to enforce the law, it may be useful to make prior enquiries of the police as to the likely priority to be given to the new offence or offences being created.
- Would it be more economic or practicable to regulate the conduct in question through the use of existing or new civil law remedies?
- Is the conduct that is to be categorised as a criminal offence able to be defined with precision?

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***The following policy questions are relevant only if a country decides that the intervention of the criminal law is required.***

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## **b) What should constitute an offence?**

Where a country has determined that the intervention of the criminal law is required, it will need to identify what constitutes an offence.

Some existing laws for the protection of TKECs provide that particular acts in relation to TKECs are offences. For instance, under the United States Code, Title 18, Part I, Chapter 53, it is unlawful, and subject to fines or imprisonment, to imitate any government trademark used or devised by the Indian Arts and Crafts Board (Section 1158: Counterfeiting Indian Arts and Crafts Board trademark), and to offer or display for sale or sell any good in a manner that falsely suggests it is Indian produced, an Indian product, or the product of a particular Indian or Indian tribe or Indian arts and crafts organisation resident within the United States (Section 1159: Misrepresentation of Indian-produced goods and products).

Policy-makers may wish to refer to the Pacific Model Law for guidance in identifying what constitutes an offence.

The Pacific Model Law establishes offences in relation to:

- traditional cultural rights: if a person makes non-customary use of a TKEC (whether or not such use is of a commercial nature) and the traditional owners have not given their PIC to that use, the person is guilty of an offence (clause 26);
- moral rights: if a person does an act or makes an omission in relation to a TKEC that is inconsistent with the moral rights of the traditional owners of that TKEC, and the traditional owners have not given their PIC to the act or omission, the person is guilty of an offence (clause 27);
- sacred–secret material: if a person uses sacred–secret TKECs other than in accordance with a customary use, the person is guilty of an offence (clause 28);
- importation: if a person imports an article or other thing into [ ] that relates to TKECs of that country, and the person knew, or ought reasonably to have known, that the article or thing would have contravened the traditional cultural rights or the moral rights of the traditional owners had it been created in [ ], the person is guilty of an offence (clause 29(1)); and
- exportation: if a person exports TKECs and the export is a non-customary use (whether or not such use is of a commercial nature) and the traditional owners have not given their PIC to the export of the TKECs, the person is guilty of an offence (clause 29(2)).

Under the Pacific Model Law, the same act in relation to traditional cultural rights (i.e. non-customary use without the PIC of traditional owners) constitutes a criminal offence and an infringement under civil law. As well, the same act or omission in relation to moral rights constitutes a criminal offence and an infringement under civil law. Therefore, a traditional community could potentially take a civil action for damages, etc. and also for fines and/or imprisonment under criminal provisions. As noted previously, some countries' copyright laws provide that the same act of infringement can bring about liabilities for damages under a civil action, and for fines and/or imprisonment under criminal provisions.

The Pacific Model Law establishes three additional acts as offences: the use of sacred–secret material, importation of TKECs and exportation of TKECs. Policy-makers may find it useful to consider these acts against the list of questions in section 3.9.2(a) above to determine whether the acts are sufficiently blameworthy in their national context to constitute a criminal offence.

If a country has determined that some types of TKECs will be treated differently (such as TKECs of high spiritual value), policy-makers may wish to consider whether it is appropriate for infringing uses in relation to those TKECs to carry more severe consequences. For example, the use of sacred–secret material under the Pacific Model Law is a criminal offence.

### **c) When may criminal proceedings be commenced?**

It is commonplace for legislation to establish when criminal proceedings may be commenced, and countries may wish to include a provision clarifying this matter. There is no provision in the Pacific Model Law in this regard.

In the case of IP laws, criminal proceedings can generally only be commenced after the matter arises. For example, trademark legislation may provide that no proceeding may be commenced for any offence that was committed before the actual date of registration of the trademark concerned.

Similarly to civil proceedings, policy-makers may also wish to consider whether an action may be brought when there is a strong likelihood that rights may be infringed. As previously discussed,

'precautionary'-type approaches are used in Peru and Panama that allow rights holders to bring a preventative action, as sometimes the damage to particular individuals and/or traditional communities from infringing acts is irreversible.

#### **d) Who should be responsible for bringing criminal proceedings?**

As it can take considerable resources to bring criminal proceedings, policy-makers may wish to consider this in light of the traditional communities in their country and whether assistance is needed in this regard. This is considered in further detail under the element 'Enforcement'. It may be necessary to explicitly provide for a particular agency to be responsible for bringing criminal proceedings (such as the police or a state body). If it is not the police, and instead a state body is to be used, policy-makers will need to give consideration to including provisions in the legislation that grant the agency appropriate powers to gather information (such as search warrants) as well as establishing offences for not cooperating with such investigation.

#### **e) What should be the penalties for offences?**

When considering penalties, it is important to recall that the criminal law is concerned with the punishment of offenders and the deterrence of others from wrongdoing, rather than compensation.

There are no rules in international or regional instruments on copyright and related rights specifying the penalties that are to be applied, nor are there rules at these levels in respect of traditional knowledge. Criminal penalties vary widely from country to country, both in respect of the amount of fines that may be imposed and possible terms of imprisonment (Sterling 1999: 432).

The Pacific Model Law provides that those persons found guilty of an offence are punishable on conviction by a fine or a term of imprisonment. Neither the amount of the fine nor the term of imprisonment is specified, as this is left to the enacting country to determine. As individual countries are likely to have conventions relating to appropriate penalties, further discussion on this matter is not included here.

If a country considers that the use of fines is appropriate, a secondary question that policy-makers may wish to consider is how the proceeds of fines should be used. The proceeds could be treated in the same way as other funds received by the government and form part of the consolidated fund for general purposes. An important policy consideration is that penalties are imposed for the purposes of punishment, not compensation – although there are some exceptions to this principle. If it is considered appropriate, the proceeds could be channelled into a fund for promoting and safeguarding national culture, for example.

#### **f) Should the court be able to grant orders for delivery up?**

Similarly to civil proceedings, policy-makers may wish to consider whether the legislation should include provisions regarding orders for delivery up in relation to criminal offences. The Pacific Model Law does not contain a provision in this regard. If it is considered desirable, policy-makers will need to consider:

- when the orders may be made;
- matters to be considered by the court;
- the rights of persons with interest in the goods or other object; and
- whether goods will be returned where no order is made.

### **g) What types of defences should be provided for?**

The Pacific Model Law provides that it is a defence to a criminal offence if a determination has been published and the traditional owners specified in that determination have given their PIC to the use in question. This is the only defence established under the Pacific Model Law. Policy-makers may wish to consider whether this is sufficient or whether additional defences are appropriate.

### **3.9.3 Further information**

Other sources of information regarding civil and criminal proceedings include:

- Legislation Advisory Committee. 2001. *Guidelines on Process and Content of Legislation*. Wellington: Ministry of Justice. Chapters 11 and 12 provide information on remedies and criminal offences respectively.
- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 13 provides information on infringement in copyright law.

## 3.10 Enforcement

Enforcement is an important and often overlooked aspect of the protection of traditional knowledge. As with other IP laws, while rights can be established via legislation, whether effective protection is achieved will depend to a significant extent on enforcement. However, while comprehensive rights may be recognised in TKECs in the legislation, the intended beneficiaries may be unable to enforce them – due to cultural or economic reasons, for example (Correa 2003: 38).

Many laws for the protection of traditional cultural expressions provide for the state to have a role in the enforcement of the rights of traditional communities. This approach is reflected in a guiding principle of the Pacific Model Law that ‘recognises that the state should have a role in the protection of TKECs, including providing assistance to traditional communities in the management and enforcement of their rights in TKECs’.

The development of this element involves consideration of what role the state should have in enforcing the rights of traditional communities.

### 3.10.1 Policy considerations

In terms of supporting the enforcement process, there may be national policies or laws that provide a context for the state to have a role in this regard, particularly in the context of Indigenous communities.

From a practical perspective, it is important to be cognisant of the costs and resources associated with enforcement. These can be significant depending on factors such as the size of a country and the extent of use of TKECs. Policy-makers should consider whether there are adequate resources available for the state to play a particular role in the enforcement of rights.

### 3.10.2 Policy questions

The following questions are intended to assist countries to develop a policy regarding enforcement that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### **a) What role should the state have in enforcing the rights of traditional communities?**

The role of the state pivots primarily on the traditional communities concerned. It would be useful for policy-makers to examine the capacity of traditional communities to enforce their rights under the legislation. If it is considered that enforcement by traditional communities may be hampered by particular factors such as capacity and resources, it may be appropriate and/or necessary for the state to have a role in the enforcement of rights under the legislation.

In existing national laws, the role of the state takes a range of forms regarding enforcing IP rights as well as rights in TKECs, including the following.

- i. **Monitoring:** In the context of enforcing IP rights, some countries have established specialised IP enforcement units, such as an interagency anti-piracy taskforce.<sup>24</sup> They work closely with industry groups as well as crime and investigation authorities to monitor and enforce against illegal activities. Some countries have established channels or official routes to assist rights owners in informing them when suspected infringements or evidence of suspected infringing

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<sup>24</sup> Examples include the Intellectual Property Rights Branch of the Criminal Investigation Bureau in Singapore, and the Intellectual Property Strategy Headquarters in Japan.

activity takes place. The US Indian Arts and Crafts Act 1990 vests various rights and responsibilities in an 'Indian Arts and Crafts Board', which has a specific role in monitoring violations of the Indian Arts and Crafts Act in the US. The Pacific Model Law includes a monitoring function for the Cultural Authority.

- ii. Legal proceedings: The state can have a role in both civil and criminal matters, if desired. This role can vary from assisting traditional communities, where appropriate, in enforcing their rights regarding their TKECs through the provision of technical advice or providing financial assistance through dedicated legal funds, to having full responsibility for enforcement. The precise role is likely to be influenced by traditional communities' needs and aspirations.

Policy-makers may wish to consider whether a specialist institution or agency needs to be created to oversee or assist in enforcement of the legislation, such as investigating and prosecuting infringements. Some existing laws use national authorities to ensure effective protection. A specific role may be envisaged for a state body in enforcing protection for traditional knowledge. In respect of criminal proceedings, a country may consider it appropriate for a state body to have a role in enforcement in addition, or as an alternative, to the police. This may be necessary if the police in a country do not see themselves as taking a lead role in investigating and prosecuting what they view as 'regulatory offences'. Within WIPO IGC, it has been acknowledged that a state body could be tasked with, among other things, advising and assisting communities with regard to the enforcement of rights and with instituting civil, criminal and administrative proceedings on their behalf when appropriate and requested by them (WIPO 2005).

The US Indian Arts and Crafts Act 1990 contains extensive enforcement provisions. While Indian tribes, Indian arts and crafts organisations and individual Indians have the right to bring civil suits under the act, the Indian Arts and Crafts Board can also receive complaints and act upon them, including by way of referring criminal matters to the Federal Bureau of Investigation and the US Attorney General. For example, a person who sells a product falsely suggesting it is Indian produced can be subject to very heavy fines and imprisonment, with penalties escalating for repeat infringement.

- iii. Enforcement training: Effective enforcement may require enhanced awareness of infringement by police and customs officials, which can be improved through training and cooperative relationships between the officials and traditional communities. Ongoing training is important for enforcement officials.
- iv. Border control: Enforcement issues in relation to TKECs often concern the importation of infringing product. The strengthening of border measures in a region can assist with this problem. The above-mentioned training for customs officials can be useful. Also, in some countries, customs and enforcement authorities have procedures to notify rights holders in order to carry out verification procedures for IP rights-infringing products.
- v. Public education and outreach: Many countries recognise the contribution of IP rights to their economy and have enacted national policies and public education measures, and in some cases established agencies, to promote respect for these rights. This is closely related to but distinct from the education programmes and awareness campaigns discussed under the element 'Management of rights'. These measures are more prevention focused, to try to minimise the incidence of infringements. Enforcement-related campaigns are often directed towards promoting awareness of respect for the rights of others and encouraging consumers to refuse to buy pirated or counterfeit goods. There are also reward schemes for the provision of information by the public about illegal activity or border infringements.

It may not be necessary or appropriate for the state to carry out all of these roles. Policy-makers should draw guidance from their domestic circumstances and the needs of traditional communities. Moreover, some of these enforcement measures would not necessarily require legislative backing

and could therefore operate alongside the legislation (such as the public education and training measures and the enforcement training).

In addition, copyright experience has shown that even with extensive enforcement campaigns, infringements may still continue. Consequently, effective enforcement involves constant review of current procedures and adaptation to deal with the methods devised by infringers to circumvent the law.

### **3.10.3 Further information**

Other sources of information regarding enforcement include:

- Legislation Advisory Committee. 2001. *Guidelines on Process and Content of Legislation*. Wellington: Ministry of Justice. Chapters 11 and 12 provide information on remedies and criminal offences respectively.
- J.A.L. Sterling. 1998. *World Copyright Law*. London: Sweet & Maxwell. Chapter 13 provides information on infringement in copyright law.

## 3.11 Dispute resolution

The desirability of alternative dispute resolution mechanisms in cases relating to traditional knowledge is frequently emphasised. Alternative dispute resolution or ADR<sup>25</sup> is a 'catch-all' term that describes a number of methods used to resolve disputes out of court, such as negotiation, conciliation, mediation and the many types of arbitration. In matters involving Indigenous and traditional communities, ADR can be considered to encompass the use of customary laws, or customary laws can be considered to be an additional approach to ADR.

Common characteristics of ADR methods are that they are faster, less formal, cheaper and often less adversarial than a court trial. The general principle is that if disputes and conflicts can be resolved without recourse to the courts, this should be encouraged as a preferable alternative to reliance on the general legal system.

In the context of the protection of TKECs, customary laws and decision-making processes will generally be the means by which traditional communities are regulated and controlled. It follows, therefore, that these are likely to be the preferred means of dispute resolution as traditional communities will be accustomed to these practices. Many existing national laws for the protection of traditional knowledge make explicit reference to the use of customary laws and/or ADR. For example, in the Philippines, the Indigenous Peoples Rights Act 1997 provides that 'when disputes involve Indigenous cultural communities/Indigenous peoples, customary laws and practices shall be used to resolve the dispute'.<sup>26</sup> Clause 33 of the Pacific Model Law specifies that disputes may be resolved using mediation, ADR procedures and customary law and practices.

For the purposes of the legislation, where ADR methods (including customary law and practices) are utilised, they would generally occur as alternatives to civil and criminal proceedings under the legislation. In such cases, detailed provisions relating to ADR may not be necessary and countries may take the approach of the Pacific Model Law and simply confirm that ADR is an available option.

Alternatively, countries may consider it necessary to establish a specific process in the legislation for resolving disputes. An important policy consideration in this context is that customary laws used for social control within traditional communities vary greatly. For example, policy-makers should not assume that the role of elders is the same or that similar procedures for resolving disputes are in use across different communities. Close consultation with traditional communities will be critical to ensure that any ADR process established under the legislation is an appropriate means to achieve reconciliation (Wichard & Wendland 2006).

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<sup>25</sup> In recent years, the term ADR has come to mean 'appropriate dispute resolution' to emphasise that ADR methods stand on their own as effective ways to resolve disputes and should not be seen simply as alternatives to a court action.

<sup>26</sup> Section 65, Primacy of Customary Laws and Practices.

## 3.12 Relationship with intellectual property protection

There is a generally accepted principle that new forms of protection for TKECs should be complementary to any applicable conventional IP protection. This is often referred to as 'filling the gap' and is reflected in a guiding principle of the Pacific Model Law that states that 'special protection for TKECs should be complementary to, and not replace or prejudice the acquisition of, any applicable conventional IP protection and derivatives thereof'.

In both developing and implementing the legislation, there are at least two important relationships that policy-makers should be familiar with: firstly, the relationship between the protection available for TKECs under conventional IP laws and the protection that will be provided by the legislation; and secondly, the relationship between the legislation and conventional IP laws in terms of the protection available for works derived from TKECs (derivative works). Having a clear understanding of these relationships is critical, particularly when the legislation is promulgated to stakeholders: policy-makers should expect interested parties to enquire about the interface between the legislation and conventional IP laws. Information regarding the relationship with IP laws is provided in the 'Background' section below, as it does not strictly relate to policy questions.

There is, however, an important policy question for policy-makers to address. The abovementioned guiding principle of the Pacific Model Law specifies that special protection should be complementary to, and not replace or prejudice the acquisition of, any applicable IP protection. In other words, the policy question of whether IP rights in works derived from TKECs (derivative works) should be recognised has already been determined. However, this recognition can be qualified by the imposition of terms and conditions on the creator of a derivative work. This is the approach taken in the Pacific Model Law (see clause 12). In developing this element, policy-makers will need to consider whether terms and conditions should be imposed, in what circumstances, and what the nature of those terms and conditions might be.

### 3.12.1 Background

#### a) What is the relationship between the legislation and existing IP laws in terms of the protection provided to TKECs?

Some of the needs of traditional communities regarding the protection of TKECs may be met by solutions existing already within current IP laws, including through appropriate extensions or adaptations of those laws. For example:

- copyright and industrial design laws can protect contemporary adaptations and interpretations of pre-existing TKECs, even if made within a traditional context;
- copyright law may protect unpublished works of which the author is unknown;
- the *droit de suite* (resale right) in copyright allows authors of works of art to benefit economically from successive sales of their works;
- performances of expressions of culture may be protected under WPPT 1996;
- traditional signs, symbols and other marks can be registered as trademarks;
- traditional geographical names can be registered as geographical indications; and
- the distinctiveness and reputation associated with traditional goods and services can be protected against 'passing off' under unfair competition laws and/or the use of certification trademarks.

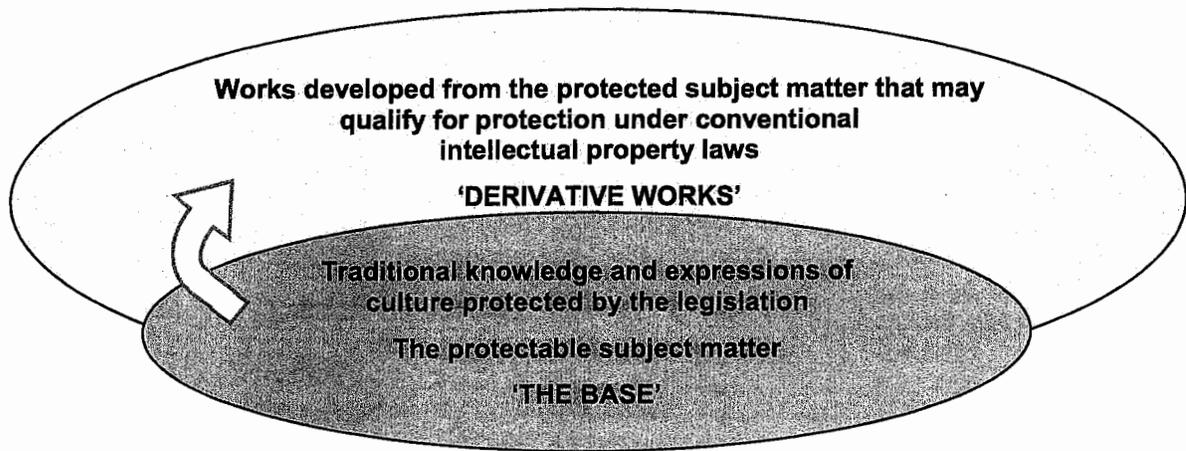
The Pacific Model Law was developed to provide forms of protection for TKECs not currently available under conventional IP laws. Policy-makers may wish to refer to the background section of

the element 'Scope of protection' for further information on the relationship between the protection provided under the legislation and protection available under existing IP laws.

**b) What is the relationship between the legislation and existing IP laws in terms of the protection provided to derivative works?**

Many national laws distinguish between TKECs (referred to as 'pre-existing' or 'the base') and contemporary expressions, adaptations and interpretations derived therefrom. The former generally require *sui generis* protection, while the latter may qualify for conventional copyright or other IP protection. For example, the Tunis Model Law 1976 protects 'works derived from national folklore' as original copyright works, whereas folklore itself – described as 'works of national folklore' – is accorded a *sui generis* type of copyright protection because it is unprotected by copyright. The Model Provisions 1982 make a similar distinction, as do national laws in Hungary, Indonesia and many others.

Figure 1 illustrates the relationship between the protectable subject matter (the 'base'; Wendland 2002), which is protected under the legislation, and derivative works, which could be protected under conventional IP laws.



**Figure 1: Relationship between the 'base' and derivative works**

The relationship is usefully explained through the following fictitious example.

Tom is an Australian living in Noumea. He would like to create a sculpture work that draws substantially on particular carvings of the local Kanak community. He intends to sell the work upon completion. As the proposed use is non-customary in nature, under the Pacific Model Law the PIC of the community is required in order to use the cultural expression to create a derivative work. Tom obtains authorisation from the community to create a work that draws on the TKECs of the Kanak community.

This authorisation is set out in an agreement between Tom and the community. The agreement does not contain any terms or conditions regarding the future use of the work in terms of the community's interests. The agreement provides that as the creator of the work, any copyright, trademark, design or other IP right that exists in the work vests in Tom.

After the work is completed, Tom sells the work for a considerable sum of money. Several years later, he is approached by a major publishing company that wants to use an image of the sculpture for the cover of a book. As Tom is the copyright holder, he negotiates an agreement with the publishing company that provides for Tom to receive an initial payment of \$10,000 along with a percentage of sales.

Tom has received a fair return for his creative labour and, arguably, the availability of IP rights has provided an incentive for innovation and creativity. However, this example also raises a

number of issues regarding the relationship between the rights of the community concerned and Tom's IP rights. While Tom has made his own creative contribution, he drew primarily on, and benefited from, the TKECs of the local Kanak community, who did not benefit commercially. This highlights a key issue regarding the protection of a traditional community's rights and interests in derivative works and is discussed in further detail under the 'Policy questions' section below.

### **3.12.2 Policy questions**

The following questions are intended to assist policy-makers to develop a policy on the regulation of derivative works that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### **a) Should terms and conditions be imposed regarding derivative works?**

The imposition of terms and conditions regarding derivative works can be a means of appropriately recognising the prior relationship, rights and interests of traditional communities with the TKECs that underpin those works. In the absence of terms and conditions within an agreement to ensure the community concerned has ongoing rights and interests in derivative works, a user can enjoy the benefits of IP rights without a requirement for benefits to be shared with the community concerned.

Such an approach is not uncommon, particularly in the context of traditional knowledge associated with genetic resources. Under Article 8(j) of the Convention on Biological Diversity, parties are required to encourage the equitable sharing of the benefits arising from the utilisation of traditional knowledge, innovations and practices. At a practical level, there have been a number of examples where users (e.g. companies, collectors, researchers) have entered into agreements with Indigenous and traditional communities in this regard. Agreements have included provisions that in exchange for using and applying the traditional knowledge of traditional communities and being able to obtain IP rights over research outcomes, the user will fairly and equitably share the benefits that accrue from that utilisation with the communities concerned.

It is a policy decision for individual countries as to whether it is appropriate to impose terms and conditions in this regard. The Pacific Model Law establishes terms and conditions that an authorised user agreement must contain (see clause 12).

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***The following policy questions are relevant only if a country decides that it will impose terms and conditions regarding derivative works.***

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#### **b) In what circumstances should terms and conditions be imposed?**

The imposition of terms and conditions on the creator of a derivative work may be necessary only in particular circumstances. For example, if an individual wanted to develop a derivative work for their own personal use with no commercial intentions, it may not be appropriate to require this individual to meet conditions such as benefit-sharing.

Under the Pacific Model Law, terms and conditions are only imposed where a derivative work is to be used for a commercial purpose. Policy-makers may wish to consider whether this is an appropriate circumstance in which to impose terms and conditions or whether alternative or additional scenarios are appropriate, such as a non-customary use.

Secondary questions to consider include whether the terms and conditions should be imposed in all cases, and whether all terms and conditions must be satisfied or whether it is sufficient to meet one or more of the conditions.

### c) What types of terms and conditions should be imposed?

The types of terms and conditions to be imposed should be developed in close consultation with traditional communities. In terms of the available options, as mentioned previously, it is not uncommon to impose a condition for benefit-sharing; there are international standards in this regard. Other options include acknowledging the community from which the work is derived and moral rights-type provisions specifying that the work will not be subject to derogatory treatment.

Policy-makers may wish to refer to clause 12(2) of the Pacific Model Law for guidance:

If a derivative work ... is to be used for a commercial purpose, the authorised user agreement must:

- (a) contain a benefit-sharing arrangement providing for equitable monetary or non-monetary compensation to the traditional owners; and
- (b) provide for identification of the TKECs on which the derivative work is based in an appropriate manner in connection with the exploitation of the derivative work by mentioning the traditional owners and/or the geographical place from which it originated; and
- (c) provide that the TKECs in the derived work will not be subject to derogatory treatment.

#### **Clause 12, Pacific Model Law**

Continuing on with the fictitious example of 'Tom', the following scenario is intended to illustrate how terms and conditions can operate in practice.

After the work is completed, Tom is approached by a major publishing company, which wants to use an image of the sculpture on the cover of a book. As Tom is the copyright holder, he negotiates an agreement with the publishing company that provides for him to receive an initial payment of \$10,000 along with a percentage of sales.

The agreement between Tom and the community includes several terms and conditions regarding the use of the sculpture for a commercial purpose, as follows.

- In recognition of the fact that Tom's work was derived from the TKECs of the community, the agreement contains a benefit-sharing arrangement whereby the community will receive 20% of any monetary compensation that Tom accrues.
- Any reproduction of the derivative work will make explicit reference to the fact that the work is based on the TKECs of the particular Kanak community of New Caledonia.
- The TKEC will not be subject to derogatory treatment in the derivative work.

Based on these terms and conditions, Tom transfers 20% of the initial payment he receives from the publishing company to the community and advises them that he will transfer 20% of the percentage sales he receives. The description of the work on the inside cover of the book makes explicit reference to the Kanak community of New Caledonia and acknowledges that the work is derived from their cultural expression.

This example shows how a balance can be struck between appropriately addressing the rights and interests of a traditional community and allowing the creator of a derivative work to enjoy the benefits of his or her IP rights. Where this balance sits within countries will of course be influenced by the local context and circumstances.

### 3.12.3 Further information

Other sources of information regarding the relationship with IP protection include:

- the website of the Convention on Biological Diversity, Article 8(j): Traditional Knowledge, Innovations and Practices Portal, contains a considerable amount of information on benefit-sharing and traditional knowledge; and
- WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Geneva: WIPO. Pages 42–44 of the Annex provide information on the relationship with IP laws.

## 3.13 International and regional protection

Intellectual property has long had an international dimension, reflecting agreement in the mid-nineteenth century that effective and appropriate protection was dependent on a degree of international coordination and cooperation (WIPO 2004c: 2). This is equally the case for the protection of TKECs.

The first major question that was dealt with at the international IP level was the recognition of foreign rights holders as having access to national IP systems on a par with domestic nationals. Generally, but not exclusively, this was resolved by the national treatment principle (or the 'right of assimilation'). Practical mechanisms were also created to facilitate the obtaining and administration of IP rights, particularly when foreign rights holders faced difficulties (leading to recognition of rights of priority, and the elaboration of international application and registration systems). Another aspect of the international dimension has seen the progressive development of substantive standards, setting international standards for how IP should be protected at national level (such as minimum standards for protection) and how other interests, such as third parties and the general public, should be safeguarded (such as through exceptions to IP rights and remedies for the abuse of IP rights).

Regarding the development of substantive standards within international forums regarding TKECs, such as WIPO IGC, and the potential impact on national laws for the protection of TKECs, it is likely that such international standards will continue to respect national discretion as has been the case with existing international IP laws. Countries are likely to have wide discretion in giving effect to any international standards that emerge.

In developing this element, policy-makers will need to consider the recognition of the rights of foreign rights holders regarding TKECs in national systems of protection, including in what circumstances foreign rights holders would have access to national protection systems and the nature and extent of rights granted to foreign nationals. Practical mechanisms to facilitate the obtaining and administration of rights regarding TKECs may need to be addressed if foreign rights holders experience difficulties. This may be difficult to anticipate prior to the legislation coming into force.

### 3.13.1 Background

IP is essentially protected through rights recognised and exercised under national laws (regional laws may also apply, and for the sake of simplicity in this document any reference to national laws also refers to applicable regional laws). As a rule, it is at the national level that rights holders are recognised as having legal identity (or legal personality), that they are given standing to take legal action, and that they are considered entitled to be granted or to hold an IP right. It is ultimately under national law that IP rights are legally recognised (though international arrangements can facilitate applying for rights, can facilitate their registration and recording and, in some jurisdictions, can form the basis for rights directly exercised by individual rights holders), and national legal mechanisms allow IP rights holders to take action to restrain infringement of their rights and to secure other remedies such as damages. Contracts and agreements that affect the ownership of, licensing of and other dealing in IP rights are also concluded and enforced under national laws (WIPO 2004c: 4).

Similarly, the protection of TKECs – whether through conventional IP rights, *sui generis* adaptations or extensions of IP rights, or distinct *sui generis* systems such as the Pacific Model Law – ultimately takes place at national level. Any general approach to the IP protection of this subject matter, including its international dimension, involves consideration of what legal tools and mechanisms are required at national level, how they should operate, and what legal and operational contributions the international dimension can make to protection at national level. It also requires a shared understanding of the role, and the limits on the role, of international mechanisms, whether they are legal, policy, administrative or capacity-building mechanisms. This is not to diminish the international dimension of IP protection, but to set it in a practical and operational context (WIPO 2004c: 5).

Nonetheless, even if its protection ultimately hinges on the operation of national laws, the nature of IP has long demanded international cooperation, including through international legal instruments, but

also through a wide range of other international systems and processes. In fact, it has been considered necessary to craft an international dimension to IP protection since the mid-nineteenth century, first through a series of bilateral trade and IP agreements, and then through the first multilateral treaties on IP (the Paris Convention on the Protection of Industrial Property concluded in 1883, and the Berne Convention for the Protection of Literary and Artistic Works in 1886<sup>27</sup>) (WIPO 2004c: 5).

The initial driver towards these landmark multilateral treaties on IP came in part from recognition of the need for consistent recognition of foreign rights holders in national jurisdictions, and the consequent desire for a multilateral framework to allow reasonable non-discriminatory access to the IP system for foreign rights holders. Accordingly, a major effect of the creation of the Paris and Berne unions was to ensure that countries in each union provided non-discriminatory access to their industrial property or copyright systems for nationals of all other countries (WIPO 2004c: 5).

### **3.13.2 Policy considerations**

Coordination and clarification of linkages with related elements of international law is important. With respect to TKECs, these areas would include cultural heritage, education, creative industries, tourism promotion, human rights, labour standards, Indigenous peoples' issues, and trade and industry (small business development, arts and crafts promotion). International legal instruments of particular relevance to TKECs include those administered or under development by UNESCO (such as the Convention for the Safeguarding of the Intangible Cultural Heritage, and the Convention on the Protection of the Diversity of Cultural Contents and Artistic Expressions).

### **3.13.3 Policy questions**

#### **a) How can the rights and interests of foreign holders of rights be recognised?**

One of the cornerstone elements of the international dimension of the conventional IP system is the mechanism for establishing the entitlement of foreign nationals to receive protection (enabling nationals of one country to enjoy IP rights in a foreign jurisdiction). As a rule, the international standard is for relatively open access to IP systems for foreign nationals (provided that they are nationals of a country with relevant treaty commitments) – a rule that dates back to the first international conventions in the 1800s. By virtue of the obligations under the Paris Convention, the Berne Convention, TRIPS and other IP treaties, the principle of national treatment applies to most categories of IP protection (subject to certain exceptions). In addition, World Trade Organization (WTO) members are required (also subject to certain exceptions) to apply the most-favoured-nation principle at least in relation to the IP protection required under the WTO TRIPS Agreement. Some specific aspects of IP protection (such as the duration of term of copyright protection) may also be determined in certain circumstances by the principle of reciprocity.

The protection of foreign holders of rights in TKECs is, however, a complex question, particularly where different customary laws are at play and also where TKECs are part of the shared cultural heritage of countries. Moreover, while international mechanisms for enabling nationals of one country to enjoy IP rights in a foreign jurisdiction are one of the foundational elements of the general international dimension of IP law, there is currently no international instrument establishing obligations and undertakings regarding the recognition of the rights and interests of foreign holders of rights

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<sup>27</sup> Article 5 of the Berne Convention provides that 'Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention', and that 'protection in the country of origin is governed by domestic law. However, when the author is not a national of the country of origin of the work for which he is protected under this Convention, he shall enjoy in that country the same rights as national authors'.

regarding TKECs. Existing TKEC *sui generis* national laws either do not protect foreign rights holders at all or show a mix of approaches. Some systems of registration and recognition of *sui generis* rights in TKECs appear to be focused on rights holders who are nationals of the country of protection, or that are communities recognised in that country. One model that has been applied has been for reciprocal protection to apply. For example, the Panama Law 2000 and the Pacific Model Law provide for protection of foreign materials. The Model Provisions 1982 provide protection for TKECs of foreign origin either according to a reciprocity principle or on the basis of international treaties (Section 14).

On the presumption that countries will determine that foreign rights holders should be entitled to protection (on the basis that the Pacific Model Law forms part of a regional framework agreed to at the Regional Ministers of Culture meeting in 2002), and recognising that there are also likely to be important exceptions and limitations present, policy-makers may find it useful to refer to the following approaches for guidance on how this could be implemented.

- i. National treatment: The question of how rights and interests of foreign holders of rights in TKECs could be recognised in national laws has been resolved, broadly speaking, in existing IP laws by reference to the principle of 'national treatment', although this principle can be subject to some important exceptions and limitations. National treatment can be defined as granting the same protection to foreign rights holders that are granted to domestic nationals, or *at least* the same form of protection. Examples include the Berne Convention, the Rome Convention 1961<sup>28</sup> and WPPT 1996.<sup>29</sup>
- ii. Reciprocity: Instead of national treatment, or supplementing national treatment, other international legal mechanisms have been used to recognise the IP rights of foreign nationals. Under 'reciprocity' (or reciprocal recognition), whether a country grants protection to nationals of a foreign country depends on whether that country in turn extends protection to nationals of the first country; the duration or nature of protection may be determined by the same principle. Under a 'mutual recognition' approach, a right recognised in one country would be recognised in a foreign country by virtue of an agreement between the two countries. Another, related mechanism for affording access to a national system is 'assimilation' to an eligible nationality by virtue of residence. For example, the Berne Convention provides that authors who are not nationals of one of the countries of the [Berne] Union but who have their habitual residence in one of them shall, for the purposes of the Convention, be assimilated to nationals of that country.<sup>30</sup>
- iii. Most-favoured-nation: Also of potential application to the recognition of rights of foreign rights holders is the 'most-favoured-nation' principle. The TRIPS Agreement provides (subject to exceptions) that with regard to the protection of IP, any advantage, favour, privilege or immunity granted by a [WTO] member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other members.

While a national treatment approach would, in light of precedent and past experience in the IP field, appear to be an appropriate starting point, the very nature of TKECs suggests that national treatment should be supplemented by certain exceptions and limitations or other principles, such as mutual recognition, reciprocity and assimilation, especially when this concerns the legal status and customary laws of beneficiaries of protection.

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<sup>28</sup> Article 2 of the Rome Convention 1961, in so far as performers are concerned, provides that: 'For the purposes of this Convention, national treatment shall mean the treatment accorded by the domestic law of the Contracting State in which protection is claimed: (a) to performers who are its nationals, as regards performances taking place, broadcast, or first fixed, on its territory; National treatment shall be subject to the protection specifically guaranteed, and the limitations specifically provided for, in this Convention.'

<sup>29</sup> WPPT 1996 states that: 'Each Contracting Party shall accord to nationals of other Contracting Parties, as defined in Article 3(2), the treatment it accords to its own nationals with regard to the exclusive rights specifically granted in this Treaty, and to the right to equitable remuneration provided for in Article 15 of this Treaty.'

<sup>30</sup> Article 3(2), Berne Convention.

For example, it is broadly accepted that the beneficiaries of protection should be the traditional communities in whom the custody, care and safeguarding of TKECs are entrusted in accordance with the customary laws and practices of the communities. Under one strict conception of national treatment, a foreign court in the country of protection would have recourse to its own laws, including its own customary laws, to determine whether a foreign community qualifies as a beneficiary. This may not satisfactorily address the situation from the community's viewpoint; the community would, reasonably, wish for its own customary laws to be referred to. Under mutual recognition and assimilation principles, a foreign court in the country of protection could accept that a community from the country of origin of the TKECs has legal standing to take action in country A as the beneficiary of protection because it has such legal standing in the country of origin. Thus, while national treatment might be appropriate as a general rule, it may be that mutual recognition, for example, would be the appropriate principle for addressing certain issues, such as legal standing.

In considering which approach to use, policy-makers may wish to refer to the Pacific Model Law, which uses the reciprocal approach. By way of example only, if Fiji and the Cook Islands have a reciprocal arrangement, the beneficiaries of protection in Fiji will enjoy the same rights and interests regarding their TKECs in the Cook Islands as they do under Fiji's law, and vice versa. The legislation could specify that the rights and benefits arising from the protection of TKECs under the legislation should be available to all eligible beneficiaries who are nationals or habitual residents of a prescribed country, depending on whether a national treatment or reciprocity approach is taken.

#### **Recognition of other laws**

In accordance with reciprocal arrangements, this Act may provide the same protection to TKECs originating in other countries or territories as is provided to TKECs originating in the [enacting country].

#### **Pacific Model Law, Clause 39**

## **b) What should recognition of the rights of foreign nationals consist of?**

Access by foreign rights holders regarding TKECs to national *sui generis* protection systems may entail various forms of recognition. For instance, it may concern:

- recognition as eligible Indigenous or local communities, or recognition of the legal identity of a collective or community as rights holder;
- entitlement to be granted a right relating to TKECs, including entitlement for TKECs or related subject matter to be entered on a register, where applicable;
- participation in any official mechanisms for the collective administration of rights;
- participation in benefit-sharing arrangements or other funds concerning the exploitation of TKECs; and
- entitlements concerning enforcement of rights, including *ex officio* enforcement action taken by national authorities or public prosecutors.

Under some national laws, rights in TKECs may be specifically reserved for certain classes of individuals or communities identified and recognised under domestic law – for example, 'Indians' in the US Indian Arts and Crafts Act 1990, or certain local or Indigenous communities. Hence, the availability of such rights to foreign individual or collective claimants may also be dependent on their compliance with similar or adapted criteria to be eligible rights holders. This may entail clarifying whether eligibility of foreign rights holders for rights or benefits reserved for particular categories of TKECs holders would be assessed according to the laws of the country of origin, or the laws of the country in which protection is claimed.

### **c) How should practical impediments, if any, to foreign rights holders be addressed?**

The practical exercise and enforcement of IP rights can pose major difficulties for rights holders, especially when multiple jurisdictions are involved and when rights holders have limited resources. This has given the administration of IP rights an international dimension. If the validity of a patent, trademark or industrial design right depended on the timely filing of applications, then applicants would face considerable hurdles in securing the early filing date necessary to safeguard their rights in countries other than their own. Hence the notion of a right of priority was introduced into the Paris Convention for such industrial property rights, so that a filing date in one country would have effect in another Paris Union country provided an application was filed within a certain period of time. International systems such as the Madrid and Hague international registration systems and the Patent Cooperation Treaty are, in essence, developments of this important mechanism, motivated by the recognition that seeking IP rights in multiple jurisdictions creates practical burdens both for applicants and for national authorities, and entails considerable duplication of administrative activities by various authorities. Such developments provide public benefits by reducing the investment of public resources in duplicative administration and the checking of formalities, and creating more effective and useful public information resources. There is, similarly, an international dimension to the question of making more practicable the exercise of IP rights covering TKECs for the benefit of traditional communities.

The difficulty of enforcement of IP rights in multiple jurisdictions has also led to the development of quasi-international mechanisms for alternative dispute resolution. ADR procedures respond in part to practical difficulties with conventional litigation for parties in more than one jurisdiction, and the international aspect of disputes over such IP-related subject matter as Internet domain names.

As the Pacific Model Law and the regional framework have introduced a comparatively new approach to the protection of TKECs, and in the absence of practical experience regarding its implementation, it is difficult to gauge at this point whether administrative measures are needed to address practical impediments. Even so, the development of cooperative mechanisms would most likely occur at regional level for subsequent implementation at national level. If and when it occurs, countries wishing to implement measures to address practical impediments may need to make amendments to their legislation for the protection of TKECs.

#### **3.13.4 Further information**

Another source of information regarding the relationship with international and regional protection is:

- WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Pages 45–48 of the Annex provide information on the relationship with international and regional protection.

# **PART 4. DEVELOPING ADDITIONAL LEGISLATIVE FEATURES**

Following the development of the legal elements of protection of the legislation, there are a number of additional legislative features that policy-makers will need to address. The majority of these features will be shaped by national legislative practices. The Guidelines focus only on complex matters in which policy-makers are likely to require assistance: the development of transitional measures and the development of regulatory making powers.

## **4.1 Transitional measures**

### **4.1.1 Policy questions**

The following questions are intended to assist policy-makers to develop a policy on transitional measures that is appropriate to their national circumstances. It should be noted that there may be additional questions for policy-makers to consider.

#### **a) Should protection operate retroactively or prospectively?**

Most countries have general transitional provisions, but these provisions may not provide the result intended in the context of TKECs. A key issue for policy-makers is whether protection should operate retroactively or prospectively, and in particular how to deal with utilisations of TKECs that are continuing when the legislation enters into force and that had lawfully commenced before then.

In terms of policy considerations, it is an accepted principle that laws should respect, as far as possible, rights previously lawfully acquired. That said, it has also been noted that prior and ongoing uses of TKECs should be regulated as far as possible within a certain period of protection measures coming into force (WIPO 2005: 40).

Existing laws utilise a range of approaches, as follows (WIPO 2005: 40).

- i. Retroactivity of the law, which means that all previous, ongoing and new utilisations would become subject to authorisation under the new law or regulation.
- ii. Non-retroactivity, which means that the only new utilisations that would come under the law or regulation would be those that had not been commenced before the law or regulation's entry into force. For example, the Panama Law 2000 provides that rights previously obtained shall be respected and not affected by the legislation. The US Indian Arts and Crafts Act 1990 only operates prospectively (as from 1935, when the predecessor Act came into force).
- iii. An intermediate solution, in terms of which utilisations that become subject to authorisation under the law or regulation, but were commenced without authorisation before the entry into force, should be brought to an end before the expiry of a certain period (if no relevant authorisation is obtained by the user in the meantime, as required).

### **Application**

- (1) This Act applies to TKECs that:
  - (a) were in existence before the commencement of this Act; and
  - (b) are created on or after that commencement.
- (2) This Act does not affect or apply to rights that exist immediately before the commencement of this Act, including intellectual property rights.
- (3) This Act does not affect or apply to contracts, licences or other agreements entered into by traditional owners before the commencement of this Act in relation to the use of TKECs.

### **Clause 3, Pacific Model Law**

The Pacific Model Law follows in general the intermediate solution. Clause 3 sets out the general application of the Act and specifies that the Act does not affect or apply to rights that exist immediately before the commencement of the Act.

As well, clause 35 establishes a period of 60 days (referred to as the 'application period') within which a person making a non-customary use of protectable TKECs before the commencement of the Act must obtain the PIC of the traditional owners to continue to use the particular TKEC.

### **Procedure for transitional arrangements**

- (1) ... this section applies to a person if, immediately before the commencement of this Act, the person was making a non-customary use of a TKEC.
- (2) The provisions of this Act do not apply to the person during the period of 60 days (the 'application period') starting on the commencement of this Act.
- (3) During the application period, the person must apply ... to the Cultural Authority to obtain prior and informed consent from the traditional owners to continue to use the TKEC.
- (4) If the person does not apply to the Cultural Authority ... the Act applies to the person on and after the end of the application period.
- (5) If a person has applied to the Cultural Authority ... the Act continues not to apply to the person until the traditional owners reject the application or enter into an authorised user agreement with the person, whichever first occurs.

### **Clause 35, Pacific Model Law**

Countries are able to modify these provisions as desired. Policy-makers may also wish to consider whether it would be beneficial for the purpose of clarity to include a linkage to the criteria for protection, such as 'the Act applies to all TKECs that ... after that commencement that fulfil the criteria for protection'.

## **4.1.2 Further information**

Another source of information regarding transitional measures is:

- WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Pages 39–41 of the Annex provide information on transitional measures.

## 4.2 Regulatory making power

There is a general principle that matters of policy should be included in the empowering statute (primary legislation) while matters of detail should be left to delegated legislation (secondary legislation). This interface has been characterised as that between the principle and the detail, between policy and its implementation (Legislation Advisory Committee 2001: 125).

As there is a considerable operational dimension to the protection approach taken in the Pacific Model Law, secondary legislation will be needed to provide guidance on these matters. In order to make secondary legislation, a regulatory making power will need to be developed for inclusion in the primary legislation (referred to as an 'empowering clause'). This segment of the Guidelines provides guidance in this regard.

### 4.2.1 Policy questions

#### a) Who is the appropriate person to make the delegation to?

The empowering clause will need to delegate power to an appropriate person to make regulations. The person to whom the power is given should have an appropriate degree of responsibility. Within central government, law-making powers are often delegated to the governor-general, ministers or officials. Law-making powers can also be given to professional bodies to regulate particular industries.

If the law-making power will potentially impact on individual rights and liberties, careful consideration must be given to the person that will exercise the power. It may be appropriate for the governor-general or an equivalent to exercise the power (Legislation Advisory Committee 2001: 126). If the law-making power involves prescribing technical matters that will not impact upon individual rights, an official may be the appropriate person to exercise the power.

For the purposes of the legislation, the matters prescribed will relate mostly to procedural matters rather than matters that could impact on individual rights and freedoms. Therefore, it may be appropriate for a minister rather than a governor-general to exercise the law-making power, recognising that this is a matter for individual countries to determine based on their national circumstances and practices.

The empowering clause in the Pacific Model Law is contained in clause 38. It delegates the law-making power to the minister responsible for the Act. The responsible minister is a matter for countries to determine.

#### **Regulations**

The Minister may make regulations prescribing all matters:

- (a) required or permitted by this Act to be prescribed; or
- (b) necessary or convenient to be prescribed for carrying out or giving effect to this Act.

#### **Clause 38, Pacific Model Law**

## b) What should be the scope of the delegation?

Within the empowering clause, the limits of the law-making power should be specified as clearly as possible. It is common for countries to have standard wording providing for the making of regulations and the specific purposes for the regulations are simply inserted. In terms of the legislation, the scope of the delegation will be influenced by the policy decisions taken in Part 3. It is, therefore, difficult to define the necessary scope in the Guidelines. The following non-exhaustive list is intended to provide guidance to policy-makers on the types of matters that could be covered in regulations.

- Management of rights
  - Procedures for applications for authorisation
  - Information any application for authorisation has to contain
  - Fees, if any, that the state body may charge for its services
  - Purpose for which the collected fees must be used
  - Public notification procedures
  - Terms and conditions upon which authorisations may be granted by the state body
  - Resolution of disputes
- Formalities<sup>31</sup>
  - The manner in which applications for notification or registration should be made
  - To what extent and for what purposes applications are examined by the registration office
  - Measures to ensure that registration or notification is accessible and affordable
  - Public access to information concerning which TKECs have been registered or notified
  - Appeals against the registration or notification of particular TKECs
  - Resolution by the registration office of disputes relating to which community or communities should be entitled to benefit from the protection of an expression of culture and its underlying traditional knowledge, including competing claims from communities from more than one country
  - The legal effect of notification or registration

### 4.2.2 Further information

In developing the actual regulations, policy-makers can obtain detailed guidance from Part 4 of the Pacific Model Law. It contains provisions that would typically form part of regulations. Other sources of information regarding regulatory making powers include:

- Legislation Advisory Committee. 2001. *Guidelines on Process and Content of Legislation*. Wellington: Ministry of Justice. See Chapter 10, 'Delegation of Lawmaking Power', which provides information on empowering clauses.
- WIPO. 2005. *The Protection of Traditional Cultural Expressions/Expressions of Folklore: Revised Objectives and Principles*. WIPO/GRTKF/IC/8/4. Pages 39–41 of the Annex provide information on transitional measures.

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<sup>31</sup> These matters would be relevant if a decision were made to use a registration or notification approach.

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# **COMMITTEE REPORT DIGEST**

## ***Guam Trademark Commission***

### **Monthly Regular Meeting**

**Monday, December 16, 2019**

## **I. OVERVIEW**

The Committee on Heritage, and the Arts, Parks, Guam Products, *Hagåtña* Revitalization, Self Determination, and Regional Affairs, convened the Guam Trademark Commission, monthly meeting on Monday, December 16, 2019, 8:30 am, *I Liheslaturan Guåhan's*, Public Hearing Room.

### **a. Public Notice Requirements**

Notices were disseminated via electronic mail to all senators, stakeholders, and primary broadcasting instrumentalities in accordance with the Open Government Law and the 35<sup>th</sup> Guam Legislature Standing Rules. The first notice was issued on December 10, 2019, and a second notice was subsequently disseminated on December 13, 2019.

### **b. Guam Trademark Commissioners Present**

- Senator Kelly Marsh (Taitano), Ph.D.      Chair
- Anna Marie Arceo      Commissioner, Department of CHamoru Affairs
- Rita P Nauta      Commissioner, Guampedia
- Albert Perez      Commissioner Alternate, Department of Revenue & Taxation
- Dr. Laura Souder      Commissioner, *Kumisiòn I Fino' CHamoru*
- Dee Hernandez      Commissioner Alternate, Guam Visitors Bureau

## **II. SUMMARY OF TESTIMONY & DISCUSSION**

Senator Kelly Marsh (Taitano), Ph.D., Chairperson of the Committee on Heritage, and the Arts, Parks, Guam Products, *Hagåtña* Revitalization, Self Determination, and Regional Affairs;, and Chair of the Guam Trademark Commission, presided over the monthly meeting. The meeting was called to order at 8:45 am and adjourning at 9:32 am. Items for discussion on the agenda were:

I. CALL TO ORDER

II. NEW BUSINESS

- a. Informational Resources in creating the framework and scope necessary in drafting the “Guam Cultural Trademark Act”, and the “Guam Trademark, and Intellectual Property Rights Act.”

III. OLD BUSINESS

- a. Continuing Discussions on the Formation of the Guam Trademark Commission Committees:
- i. Delineation of Committees
  - ii. Committee Duties and Responsibilities
    1. Responsibilities and Duties
    2. Reporting to the Commission on Activities, and Actions
    3. Creation of Subcommittees

IV. OPEN DISCUSSION

V. ADJOURNMENT

**The Guam Trademark Commission monthly meeting was called to order on December 16, 2019, at 8:45 am.**

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** *Håfa Adai yan Mana'na Si Yu'os.* Good morning, and thank you all for being here today. The Guam trademark commission

will now be called to order. For the record, in accordance with the open government law meeting notices were given to all commission, and senatorial members, stakeholders, and all main media broadcasting outlets. The first notice went out on Friday, December 6th, 2019, and the second notice went out on Friday December 13<sup>th</sup>, 2019. Today is Monday, December 16, 2019, and the time is 8:45. We have six including myself seven members present which represents a quorum. *Si Yu'os Ma'åse* for attending this morning's meeting.

So let's move on to item 2a of the agenda, new business. This is an overview of the resources that were sent via email that were meant to assist in creating the framework and scope necessary in drafting the Guam Cultural Trademark Act, and the Guam Trademark, and Intellectual Property Rights Act.

So for the information that was sent out, and it's one that perhaps others have additional material to add but that can be done in our subcommittee work and then shared with all of us. Some of these are ones that Dr. Laura Souder discussed in our last presentation. The Alaska Silver Hand Program. The indigenous IP Rights Overview by Taiwan regarding their Intellectual Property Copyright Law. The Enforcement Overview of Taiwan because as we've been discussing enforcement seems to be a sticking point that we can develop very good guidelines, and programs, but we need to also make sure that we develop an enforcement program that balances between the ideals needed for enforcement, and then the realities of what we can enforce. A Trademark Law Overview by Taiwan, so several things from Taiwan.

The guidelines for the Pacific Model Law that was developed in 2002. The Native Hawaiian Cultural Trademark and Intellectual Property Study again that was found and shared with us a bit from Dr. Laura Souder. The New Zealand Maori Culture and Intellectual Property Law. The Republic of Palau Copyright Law. The protection of Samoa's traditional knowledge and expressions of culture and issues paper. There's also one that I haven't sent out yet, but it's about Intellectual Property and the Festival of Pacific Arts. That one might be helpful. It might be very Solomon Islands specific. I'll need to look at that. Some of the US Public Laws got really lengthy. I think that was just sent as a link. A whole lot of laws can come into play. The World Intellectual Property Organization, some of the overview that they shared on intellectual property laws.

We have had a lot to look at, and actually, these will come into play some more than others as we move forward, but hopefully people got a chance to at least look at the beginnings of them, and get a sense of what might be in the material that was shared.

As we've mentioned before the Maori Toi Iho Program of New Zealand is referenced as a guidance in the Guam Trademark Commission Enabling Law. This reference guides the commission to craft the Guam Cultural Trademark Act that promotes, and licenses *CHamoru* Cultural Arts manufactured or produced on Guam.

I believe we're also making hard copies. You'll have both digital and hard copies for those who have requested them, and let's go ahead and move on to item number 3, old business. We were at a couple of places. One was considering continuing discussions on the presentation by the Guam Department of Revenue and Taxation, but I believe we're going to do that in January is that in January? Yes, and then we'll also for January have the Guam Brand presentation by the Guam Visitors Bureau. We're going to have the Director Miss Pilar Lujan. She's going to be able to share that with us.

**MS. DEE HERNANDEZ, COMMISSIONER ALTERNATE, GUAM VISITORS BUREAU:**

Laguana....

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** Laguana, sorry. Some of my family trees jumped out instead. Thank you for the correction. Ms. Pilar Laguana is going to be sharing that with us. We are very much looking forward to those two continuing presentations.

For today, we'll go ahead and jump right into some of what we've been talking about here and there, and that's the continuing discussions on the formation of the Guam Trademark Commission Committees. We had decided that we would go ahead and tackle the most complicated one because if we can sort things out there than we've created a pretty smooth path for both of the acts that were developing policy guidelines for. With that, do people have some suggestions that they'd like to profer as to committees? I think what I've looked at in our enabling legislation on page 3, I'm not sure if you have that with you, but I keep referring back to that one as a possible guideline for developing subcommittees, but if others have some beginning points that they'd like to discuss?

**DR. LAURA SOUDER, COMMISSIONER, KUMISION I FINO CHAMORU:** We've talked about Indigenous tangible, and intangible properties and I've asked the *Kumisiòn I Fino'* *CHamoru* if the *Kumisiòn* itself could act as a subcommittee on that theme, and the *Kumisiòn* has agreed to do that, to start things off. Of course, we welcome other folks and contributions, but we could take a crack on how we define indigenous tangible and intangible properties.

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** I think that's an excellent start. We've talked before, and CAHA has provided us a list of Masters. But this is a growing field in a

sense where people are taking the customary aspects of their culture, and perhaps not having had to think of it very formally in certain ways because it was a way of life. We've now been trying to think of it more fully so that it can fit as best possible into modern government laws and that kind of thought I think will be really good work that they'll be able to provide that will go hand-in-hand, and help guide CAHA in their development of the list of types of arts, and you two could figure out if you work together or if the work that you do informs them, and they continue building, and you build some as well. *Si Yu'os Ma'åse* for reminding us of that, and then helping us understand the role that *Kumisiòn I Fino' CHamoru* can play.

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** In the enabling law, it has 10 items for us to work on, and we can certainly always be adding more to this as we've been learning about these issues and as I said, the awareness about them has been growing throughout the world. The first one continues to be the identification of initial types of cultural arts for the use of the trademark. I think that it makes sense to stay perhaps still a subcommittee could be developed with CAHA, and perhaps DCA could work with them, and it could be maybe the first three or four. You know sometimes it's hard to differentiate these because they're all so linked. I've even thought about just having that two or three like major subcommittees because elements are so late. CAHA makes a lot of sense for identifying the types of cultural arts. Criteria for the lineage of cultural knowledge qualifying for the use of a trademark. Criteria for the authenticity, Criteria for the quality of works, and criteria for the cultural content.

What do we think? Do we want to have a larger subcommittee group, and then different members of it could tackle each of those parts, and when you come together, you could discuss them based on your own individual discussions, and research? If we had one large CAHA and DCA a maybe even Guampedia being there where it could be 1 through 5. What do you guys think of that? Do you want to start off with a large subcommittee or do you see that you could break those up into some smaller ones that each come together here.

**DR. LAURA SOUDER, COMMISSIONER, KUMISION I FINO CHAMORU:**

Senator could I ask for a clarification? The law currently establishes four areas of interest. The visual, literary, performing, and demonstrations and exhibitions categories. Are these the subcommittees that were thinking of? Initially we had talked about those four subcommittees, and then we realized that overlapping that would be a clarity of definition about intangible and tangible indigenous arts at least for the cultural trademark component, but I know so much of what we do overlaps. I'm trying to think of what the most expeditious way we could organize subcommittees to provide the information into the *Kumisiòn* so that we could make some clear recommendations, but not sure do you have any thoughts on that?

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** That's a very good point, and I'm glad you brought it up because I had sort of jumped forward without tackling that issue. It's true in the legislation, it mentions subcommittee's visual, literary, performing, and traditional arts, and in one sense, they do have some distinction, but in another sense, as you mentioned, have a whole lot of overlap. It seemed to me anyway, that if visual is looking at these different elements: types of cultural arts, how they qualify, how they authenticate the quality, the cultural content, and then literary does it, then performing does it, and then traditional arts does it they might be replicating a lot of the same work over, and over again. To work collaboratively perhaps, what we could do is have that larger group between CAHA, DCA, and represent a cultural organization. Each of you could do some Outreach with those individuals. I know you've each been part of the FestPacs, and you've each had a lot of Outreach, and connection over the years with members so that you could hear from them as to what they feel some other distinctions are but that could be subcommittee work within the larger committee. What do you guys think?

**MS. RITA NAUTA, COMMISSIONER, GUAMPEDIA:** I was thinking in terms of the purpose of our commission, and trying to provide best practices process I was thinking more so from the perspective of the users, the cultural producers, and from that vantage point as well as from the processing, and identification of who these special designation those different program components that we need to address from different perspectives. Enforcement is one of the key issues. I see GEDA, Rev, and Tax, and maybe even SPDC, and UOG. Then from the cultural producer perspective, as you mentioned, Guampedia, *Kumisiòn*, CAHA, especially to take the lead in that aspect of doing outreach, and education, then feedback of what needs to be done, and what are the challenges. Like you said, all of these different forms of art, but we are trying to get at is the program. Does that make sense?

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** I think we're along the same lines. I wasn't sure how you all felt. But this is the perfect time to hear from you of course is if we formed two larger subcommittees or three, because we have *Kumisiòn I Fino' CHamoru* that's doing its work. Then we had basically a cultural committee, and then one that deals with the enforcement, and the actual certifying processes the nuts, and bolts if you will, and then I think there are enough people within them that they can divvy up work amongst themselves, and they report to each other, and then we can report all together. Does that make sense or do we want to have smaller subcommittees?

**DR. LAURA SOUDER, COMMISSIONER, KUMISION I FINO CHAMORU:** I don't think it makes sense to have to break up into Visual, and those kinds of designations because as

Rita pointed out the Mandate of the law of creating the commission is to attend to the different stakeholder groups that will be impacted by the Trademarks Act, so...I think thinking along the lines that you've just articulated, would probably be less cumbersome, and I think for example that the AG made a presentation to us several times, The Department of Revenue and Taxation, GEDA. Those are all part of the enforcement element, right which is critical. Then there's the indigenous element, which is critical, and the Cultural Arts the whole panoply of different users of producers as I like Rita's word of cultural producers, and their interests, and how to protect their interests as well. I think that aligns well in terms of committee formation.

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** *Maolek.* It seems like we're on the same track, and then in looking at number 10, perhaps this is where the Guam Visitors Bureau could be. Is the proposed terms of use for the trademark in advertising marketing and sales? I think with the development of the Guam brand from what we've heard from Guam Visitors Bureau that you've had many years of experience in these areas. It's something that you guys specialize in, and certainly, the work that we do we want it to work for the community amongst ourselves. I've seen some increase in the Buy Local Support Local sort of movements but also for our visitors that we want to make sure that we're reaching out, and in really important ways for visitors, and even visiting artists like we do get visiting artists here at various times certainly during Fest pack we did and we do I mean this is going beyond our scope, but just keeping it in the back of our mind. I have heard stories as maybe you have as well about things that go on in Germany, and things that go on in the US Mainland, and things that go on elsewhere, and perhaps I don't know again if this is going too far, but perhaps the Guam visitors bureau could also reach out with the Marianas Visitors Authority, and just see those issues of certain things being *CHamoru*, and certain things in us working together as an archipelago. It may not make sense, but it might be something to keep in mind that we want to do. We might want to reach out to the Department of Cultural and Community Affairs, DCCA, in the Northern Mariana Islands. They also have an Indigenous Affairs. The cultural group there may be some of that reaching out so that there isn't that feeling I know *Kumisiòn I Fino CHamoru* has gone through this. There isn't that feeling of a divide or not understanding how we're going to work on this here, and they're working on something very similar there. I think if we do it in some communication that will be very good.

Are we good with perhaps 1 thru 5? We know the *Kumisiòn I Fino CHamoru* they're going to work on the very important aspect of what is tangible, and intangible, and how to define those, and those are really important. When I was working as an anthropologist in Palau that was one of the most common questions we would get during our different presentations and helping people understand because when we're talking about the intangible, oftentimes there is a tangible element to it and so it can become confusing. Weaving is the intangible the skill, and the knowledge of how to do that

but the basket is tangible, and so people would get a bit confused, and it's true. It can be very confusing. I think that's going to be a great role that they serve, and then for the subcommittees, we will have to figure out how to refer to each other. If you want to come up with some names, maybe they can be very functional. Maybe they can be otherwise descriptive, and then we'll have our cultural group for lack of a better term at this time that could cover the 1 through 5 and perhaps for GVB, what do you think D. Does it make sense to connect 6, and 10 together? Oh, let me show it to you. Sorry about that. I'm talking away, and you haven't even gotten to see it.

**MS. DEE HERNANDEZ, COMMISSIONER ALTERNATE, GUAM VISITORS BUREAU:**

I think that's a good idea. What we can do is just look into what they are, and then we'll do the subcommittee on these.

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** *Si Yu'os Ma'ãse* for taking those on. I think those fit in really well with GVB. Now we have here, the process for certifying artists. I think with some of what GEDA has talked about, and the role that the Department of Revenue and Taxation is already doing. They definitely have a lot of value to put into those sorts of ideas. Does that make sense to you that your group? Sorry for not coming up with a better name right now. Mr. Perez if 7, 8, and 9 make sense for you?

**MR. ALBERT PEREZ, COMMISSIONER ALTERNATE, DEPARTMENT OF REVENUE AND TAXATION:** Yes, Senator. Rev and Tax will up to the challenge to fulfill the scope of activities for 7, 8, and 9.

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** Rev, and Tax, AG, and GEDA. I know the Attorney General's office, they've just had something like four or five people that have retired or otherwise moved on, and I know that they're short-handed but the good news is we do have somebody that's assigned to us, and so we should be able to connect with her very soon. Cultural we have Guampedia if it's okay to refer to your participation that way, and then DCA, and then CAHA

**DR. LAURA SOUDER, COMMISSIONER, KUMISION I FINO CHAMORU:** Are those the only criteria?

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** I think these would be the criteria of what we start looking at 1 through 3. DCA, CAHA, and GuamPedia looking at the cultural aspects from 1 through 5, and then eventually, when people think it's the right time for

perhaps the cultural entities to also have in mind the possible development of a logo that goes with this trademark.

I think it can work either way. What *Kumisiòn* is doing right now is as you mentioned tackling the tangible and intangible. It could either be folded in or I know that they're doing many things, so perhaps guiding some of the different processes as they come up. We can always see how these committees are going, and we can always refine and tailor as it goes on.

I did want us to talk about the timeline at least a little bit but I'll save that towards the end. Did we have any other thoughts or discussion points for the subcommittees right now? Perhaps what we can do is I will email it to everybody, and then people will have this next month to look it over to see if it makes sense, to see if there are other elements that they think that their subcommittee should be looking at and putting together just making sure that you're starting to connect with each other. I know the holidays is a hard time to do this, but perhaps to get together at least once with each other or to have some email communications about feeling comfortable with the focus, feeling comfortable with the committee composition, and then perhaps starting some initial work that could be reported on in January. Are there any other thoughts and discussions before we talk about the timeline?

So regarding the timeline, let's go ahead and get into that for open discussion. The timeline, and thinking realistically for next year, we have two policies to put together, and also looking at the work of the body the legislative body throughout the year. We have Fest pack in June. It might be a little premature to come up with anything too hard right now as far as the timeline, but I think that could be one of the things that's looked at in January, and February as you're really looking around at your scope of work, and having some subcommittee meetings, and thinking whether you can get things done per your subcommittee in the next month or two enough that we're coming back, and we're starting to have some real discussion. January is kind of the first of the formation. We still have a couple presentations in February. People should have really rolled up their sleeves by then. Then maybe in March, and April could be months where we're finishing putting that together our different points, and then by April or May, we have some real discussion amongst ourselves. I mean, we'll be discussing all along. But April and May maybe even June having some real discussion, and then July getting those down for an actual policy recommendation. Continue to think about these as to how you think these make sense or don't.

**MR. ALBERT PEREZ, COMMISSIONER ALTERNATE, DEPARTMENT OF REVENUE AND TAXATION:** Just your thoughts...Are we anticipating funding for any activities that we will be administering, and enforcing these programs for the next fiscal year?

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** That's a very good point. We do have a budget coming up very soon, and I think if we start having some solid Thoughts by February, we may be able to think about things that we might need that could be proposed into the budget. Where this office is, where these policies are going to sit, who's going to enforce them the budget that might be associated with it, to at least have those thoughts in mind. I think that's really important consideration. I'm glad you brought that up, and we've even talked amongst ourselves in my office that we might see if we can find some funding so that we get some real dedicated legal advice because we want to make sure that this is well thought out, and it's going to stand the test of time, and a lot of these I think, for a lot of people, they feel like murky waters , and to provide some real clarity for us, and for our community, our artists, and others who are going to benefit from these.

**DR. LAURA SOUDER, COMMISSIONER, KUMISION I FINO CHAMORU:** Can I also seek clarification relative to process? If we're going to be working our subcommittees, and sort of giving an initial report in February or March, what is the structure for getting that process going? I mean who takes charge of the different units? The different subcommittees? Can we talk a little bit about that guidance so that everybody is clear? Otherwise, we're going to be meeting in February, and looking at each other, and wondering who is supposed to have just picked up the ball on each of these. I know for example that I will work with the *Kumisiòn* on our work sessions that we've already said we're going to commit to brainstorming on the definitions or guidelines for understanding what tangible and intangible indigenous properties are. We'll work on that. But in terms of the other subcommittees, because it involves multiple agencies. Could we discuss process?

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** Yes. That's a very good point, and I can absolutely see us getting together in January, and maybe not having tackled that. I think that's very good. It makes a lot of sense for the *Kumisiòn I Fino CHamoru* that you are their point person, and you will head up that part of connecting us with them. For the cultural aspect, which I was going to throw myself into a bit because that's some of my background but for that we have a representative from Guampedia, DCA, CAHA, it could go either way. It could be you're not here, then you get volunteered. Or it could be based on what makes the most sense. Are there any thoughts on heading up the cultural aspect?

I guess to me the department of CHamoru Affairs, it makes a lot of sense that culture is what they do. Culture, language, and those sorts of things. CAHA has art, and sometimes it's cultural, and

sometimes it's other elements as well. Guampedia does all sorts of wonderful things, much of which is cultural. I think it's an excellent group. Does that make sense to people? That the Department of CHamoru Affairs would head up that subcommittee?

For process, you are most familiar Mr. Perez. What do you think between the Department of Revenue and Taxation, the AG's office, and GEDA, what do you think makes the most sense for heading up that subcommittee of process?

**MR. ALBERT PEREZ, COMMISSIONER ALTERNATE, DEPARTMENT OF REVENUE AND TAXATION:** Well, either way I will let you decided.

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** You are here, and your attendance is very consistent, and I know you're extremely experienced, and you're a consummate professional. Would you mind heading up that committee, and then your committee can always have discussion amongst itself, but if you wouldn't mind, I think you'd be an excellent head.

**MR. ALBERT PEREZ, COMMISSIONER ALTERNATE, DEPARTMENT OF REVENUE AND TAXATION:** That will be fine. Thank you.

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** *Si Yu'os Ma'åse*, and then I think it's pretty clear for GVB. Excellent. I think as Mr. Perez mentioned last time, us interacting with each other, that if there's something that comes up for GVB, they could certainly be reaching out in the interim to GEDA or to the Department of Revenue and Taxation for some queries, and that we're all here to support each other in our different subcommittees as well.

**MR. ALBERT PEREZ, COMMISSIONER ALTERNATE, DEPARTMENT OF REVENUE AND TAXATION:** If I can just comment. The statute does reference the Department of Commerce as part of the enforcement mechanism with the current Trademark Commission Law. So the hope is that the other agencies represented here can be listed, and delineated among the participants to the enforcement process and so the statue would have to be amended to reflect that, and so it's just a guide everyone that at some point, they'll be a sign-off process to who will actually be will be spearheading those queries or complaints or any of the producers of these particular products tangible or otherwise. There will be a point agency to go to. Aside from just registering your item with Department of Revenue and Taxation, perhaps the other agencies can assist in entertaining some of the concerns that the producers have.

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** That's very good point. That's what I enjoy very much about this group. Is that the commission take their roles very seriously. They have so much experience per their field and bring forth really good points for us to take into consideration that move us all forward. Our subcommittee membership, there might be a way where we can address some of that. We had mentioned at the Marianas history conference Doctora Souder had been able to get some people to sign up so we could be reaching out to them. But there if there are other members of the public who have expressed interest or you know that they'd be a really good fit, we have each other but as you're mentioning the relevant agencies who are going to come into play we can we can do that in our subcommittee work is to reach out to them, and make sure to hear from them or get input or guidance from them or make sure that they continue to be on board. I know sometimes, well all the time, when we're writing legislation, it's really important to reach out to the different agencies, and make sure that they're on board, and providing input and have the ability to do that. Those are really important points as well Thinking about our subcommittee, the structure of it, the members of it, and the goals of it, and then getting some of that initial work done before January that we could report on a bit as to structure if you need to comment on some of the goals or maybe approaches as to how they're going to be attained. Then we still we have our two presentation. So I think it'll be a very full January.

**MS. ANNAMARIE ARCEO, COMMISSION, DEPARTMENT OF CHAMORU AFFAIRS:**

So Senator you saying the process of how each committee or how each group is going to carry out we can report to you after we've met to see what our goals are, and how we're going to about it?

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** *Magâhet.* Yes. For culture, there's five elements there, and so some might make more sense for DCA itself. Some might be ones that Guampedia has a lot of experience at, and really knows how to get to, and some such as the identification of different types of cultural arts is something that CAHA has already started. I think that would be a good amount of reporting back for January and not impeding too much into all of your family time and the ability to spend that time with family.

**DR. LAURA SOUDER, COMMISSIONER, KUMISION I FINO CHAMORU:** Could I suggest to that as we proceed rather than waiting until we're done with the work that we've consolidated from different perspectives, that we have public meetings wrapped into our subcommittee efforts. What I mean to say is just make it available to the public so that if there's anyone who's really feels very passionately about something that they're able to express, and share their concerns or their ideas because there's many great ideas that can come so that we can fold those into recommendations rather than waiting until after everything is kind of been solidified. I

don't mean a formal public hearing, but we need to let folks know that we are welcoming perspectives, and ideas, and please if you feel strongly about something, join a subcommittee that kind of thing if there's a public announcement that we could make relative to that, I think that would be good. .

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** That's a very good point. So I think we could do a few different things. People here are pretty well-versed at that. We can do some press releases, and we can be on some radio shows, and talk about some of our work. Even this part, that we formed our subcommittee's if people are interested. We're going to be sharing it from month to month as we gather. I think in January the information that will be bringing will be just those initial parts of it. But then in February, we'll have an hour or two in February to just talk about our subcommittees, and those different steps so that people can be viewing, and then they can be having some discussion with us or amongst themselves, but then also all throughout we could maybe be continuing to have some appearances on radio shows, and some different press releases that inform everybody about the stages we are going through. I think that's very important. *Si Yu'os Ma'åse* for bringing that up, and what we can even work on a press release after this meeting just to announce this part of the formation of what we've done.

**MS. RITA NAUTA, COMMISSIONER, GUAMPEDIA:** If I can also add as each committee or subcommittee goes through identifying process is to especially because of the sense of urgency in terms of there really has been a lot of interest, and a lot of opportunity, and building up specially to FestPac 2020 that cultural producers now that want to roll out is that we look at existing framework, and instead of reinventing the wheel, we expand within this the existing framework. Let's take that approach as opposed to trying to create something new because then, within the interest of time, it's just broadening the horizons for example; the Guam product seal, and that maybe creating a different tier for cultural producers. Something like that. But I think it would be a great for all of us to walk into our committees with that mindset. Thank you.

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** Very important. I think that's a very important point. Sometimes perhaps when we have a task like this there might be the ideal of starting something brand new, and it's going to be all shiny, and it's going to resolve certain things but we have very successful programs, and I think that's been the benefit of us hearing from the different programs all along. We see that framework, and we see a lot of good working framework so very much, I think that's important for us to have in mind that we're expanding what exists, and making it work as possible and as you mentioned there might be ways that we can add tears to the Guam product seal rather than necessarily inventing something brand-new, and trying to find a brand new entity to take care of it. Extremely good point. *Si Yu'os Ma'åse*.

Is there any other new business or open discussion? Points that anybody would like to make before we adjourn for today.

**DR. LAURA SOUDER, COMMISSIONER, KUMISION I FINO CHAMORU:** I just want to thank your staff for producing the material to us. Electronic is good. It's great, especially because it's portable but I think when we're comparing notes, and looking at different things paper product is always handy, and we know that the trees may join us in this, and forgive us for needing their paper, but I want to say thank you for that.

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** It's always our pleasure to, and so anytime that you want something printed out, be it you a handout or something else that we've sent digitally we're always happy to do that.

I definitely am a person who highlights and scribbles notes everywhere. I also find paper can be very helpful sometimes, and like I said, we're always happy to do that.

So if there's no other open discussion, let's go ahead and have you introduce yourselves. There's nothing like wrapping up and introducing yourself before you wrap up, right? If you wouldn't mind just for formality sake going around introducing yourselves and the entity you are representing: Albert Perez, Department of Revenue and Taxation; Rita Pangelinan Nauta, Guampedia; Dee Hernandez, Guam Visitors Bureau; AnnaMarie Arceo, *Depårtmentan Man CHamoru*; Dr. Laura Souder, Representing the speaker also a member of *Kumisiòn I Fino CHamoru*, and of course there's myself Senator Kelly Marsh (Taitano) Chair of the Commission.

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** *Si Yu'os Ma'åse* for your presence at this morning's commission meeting, and I think we made some significant progress. Today's meeting is the commission seventh meeting. The commission last met on Thursday, November 21st, 2019.

Okay. So now that we have no further items for discussion and now that we've introduced ourselves, can I hear a motion to adjourn?

**MS. ANNAMARIE ARCEO, COMMISSION, DEPARTMENT OF CHAMORU AFFAIRS:**  
Motion to adjourn...

**DR. LAURA SOUDER, COMMISSIONER, KUMISION I FINO CHAMORU:** Second the motion...

**COMMITTEE REPORT DIGEST**

*Guam Trademark Commission*

Monthly Regular Meeting

Monday, December 16, 2019

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** All those in favor?

**ALL:** Aye....

**SENATOR KELLY MARSH (TAITANO), PHD., CHAIR:** Motion carries to adjourn this Guam Trademark Commission meeting the time is now 9:32. Have a wonderful morning, and a very Happy Holiday Season with your families and friends, and loved ones.

**The Guam Trademark Commission monthly meeting was adjourned at 9:32 am.**

**VI. FINDINGS & RECOMMENDATIONS**

The Committee on Heritage, and the Arts, Parks, Guam Products, *Hagåtña* Revitalization, Self Determination, and Regional Affairs, hereby report out for public record December 16, 2019, Committee Digest, and transcription of the Guam Trademark Commission monthly meeting.