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Fourth Session

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PRESENTATIONS ON NATIONAL AND REGIONAL EXPERIENCES WITH SPECIFIC
LEGISLATION FOR THE LEGAL PROTECTION OF TRADITIONAL CULTURAL
EXPRESSIONS (EXPRESSIONS OF FOLKLORE)

Document prepared by the Secretariat

INTRODUCTION

1. As requested at the third session of the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (the “Committee”), the WIPO Secretariat has prepared a working document for the fourth session on the use of existing intellectual property rights (IPRs) in protecting traditional cultural expressions (WIPO/GRTKF/IC/4/3). This document identifies circumstances in which traditional cultural expressions appear adequately protected by current rights, as well as cases in which current rights may be inadequate. The document also describes in general terms the ways in which *sui generis* legislation, mechanisms or systems have sought to complement existing IPRs.

2. In addition, at the third session of the Committee participants showed great interest in the national and regional experiences of those countries or organizations that have enacted or put in place *sui generis* approaches, or are considering such approaches, and requested presentations on them.

3. Accordingly, a portion of the fourth session will be devoted to presentations on national and regional experiences with specific legislative systems for the legal protection of traditional cultural expressions. The presentations offer an opportunity for the invited presenters to describe, in-depth and from a practical viewpoint, their laws, systems or mechanisms (actual or proposed), including their actual experiences with developing, enacting and implementing them, if any to date. Presentations will be made by the delegations of New Zealand, Nigeria, Panama, Tunisia and the Representative of the Secretariat of the Pacific Community. The oral presentations therefore complement the Secretariat's document WIPO/GRTKF/IC/4/3.

4. This document (WIPO/GRTKF/IC/4/INF/2) contains the written presentations of New Zealand, Nigeria and the Secretariat of the Pacific Community, as Annexes II, III and IV respectively. The presentation of Tunisia is contained in WIPO/GRTKF/IC/4/INF/3 and that of Panama in WIPO/GRTKF/IC/4/INF/4. Annex I contains suggested guidelines that were prepared to help provide a common focus for the presentations.

[Annex I follows]

ANNEX I

Presentations on National and Regional Experiences
with
Specific Legislative systems for the Legal Protection of Traditional Cultural Expressions
(Expressions of Folklore)

INFORMATION NOTE AND GUIDELINES

Suggested elements and structure of presentations

The following suggested key elements and structure for the presentations indicate the issues of direct relevance to the discussions as they have advanced in the Intergovernmental Committee to date and may assist in ensuring that each presentation has a shared focus. In addition, if the presentations follow more or less a common structure, they could provide the participants in the fourth Intergovernmental Committee session with the possibility to consider the various experiences from within a common framework of information.

As some Members of the Intergovernmental Committee have pointed out, there is a close link between traditional cultural expressions and “technical” traditional knowledge (such as medicinal knowledge). For the time being, however, these two related areas are being discussed by the Intergovernmental Committee separately although in parallel. It is recognized that some *sui generis* systems may address both traditional cultural expressions and “technical” traditional knowledge. Presenters are, however, invited as far as possible to focus on their respective systems in relation to cultural expressions.

A. Which of the following elements or standards of currently existing intellectual property law did you perceive as limiting the application of intellectual property law to the protection of traditional cultural expressions (therefore leading to the development of *sui generis* legislation, systems or mechanisms)?:

- (i) originality;
- (ii) fixation;
- (iii) broader divergences in policy objectives and conceptions of “ownership” between intellectual property law and customary laws and systems;
- (iv) protection of “expressions”, not “ideas” (or styles and methods of manufacture);
- (v) identifiable author versus collective creation and ownership;
- (vi) the limited term of protection;
- (vii) other.

B. Please describe, as far as possible and to the extent applicable in each case, how your *sui generis* law, system or mechanism (actual or proposed):

- (i) identifies its policy objectives;
- (ii) defines and/or identifies its subject matter (scope of protection);
- (iii) identifies the criteria the subject matter must meet as a condition for its protection;
- (iv) identifies the owner of the rights;
- (v) defines the rights conferred (economic and moral), including exceptions and limitations;
- (vi) establishes the procedures and formalities, if any, for the acquisition and maintenance of the rights conferred (for example, is there a registration requirement? Is fixation required? Does the law establish an inventory or other recordal system relevant to the acquisition and maintenance of the rights?);
- (vii) vests responsibility in new or existing authorities, associations and other institutions to exercise and/or manage the rights. Do collective management societies have a role to play?
- (viii) addresses enforcement procedures so as to permit effective action against infringement of the rights in traditional cultural expressions;
- (ix) defines how the rights are lost and how they expire (including invalidation or revocation of any registration). For example, are the rights limited in time?;
- (x) addresses the interaction between the *sui generis* system and the existing standards of intellectual property, especially the extent to which they overlap or complement each other;
- (xi) refers to, incorporates and/or recognizes any relevant customary laws and protocols;
- (xii) refers to and/or integrates within its scheme the activities of archives, museums, libraries and other such cultural heritage institutions. For example, how are existing collections and databases of cultural expressions protected?
- (xiii) addresses the protection of foreign traditional cultural expressions, including the question of the protection of the same or similar cultural expressions from neighboring countries (so-called "regional folklore").

C. Please provide any useful information on your experiences in conceptualizing, drafting and enacting the legislation. For example, which governmental ministries and departments were involved? Were public consultations held? Which stakeholder groups were involved?

D. Where applicable and possible, please describe experiences with the implementation, enforcement and use of the *sui generis* system to date. For example:

- (i) are your country's Indigenous and/or traditional communities aware of the law?
- (ii) are there any instances yet in which the law has been used?
- (iii) which lessons, if any, have been drawn so far regarding the necessity for and usefulness of such a law?
- (iv) are there aspects of the law and its related procedures that are or will undergo amendment?

[Annex II follows]

ANNEX II

NEW ZEALAND

SPECIFIC LEGISLATION FOR THE LEGAL PROTECTION OF TRADITIONAL CULTURAL EXPRESSIONS - EXPERIENCES AND PERSPECTIVES OF NEW ZEALAND*

Introduction

1. At the third session of the Intergovernmental Committee, Members showed significant interest in national experiences of those countries or organisations that have enacted or put in place *sui generis* approaches, or are considering such approaches, to the legal protection of traditional cultural expressions, and requested presentations on them.

2. New Zealand has been invited by WIPO to make a presentation at the fourth session of the Intergovernmental Committee on its experiences and perspectives on the issue of *sui generis* protection for traditional cultural expressions. This paper provides background information to that presentation.

3. In approaching the issue of *sui generis* protection for traditional cultural expressions, we make a number of preliminary points.

– At previous sessions of the Intergovernmental Committee (and other international fora, including UNESCO) New Zealand has commented on the inappropriate use of the term “folklore” to describe the subject matter under consideration. We, therefore, commend the Secretariat for its use of the term “traditional cultural expressions,” and suggest that other delegations do likewise from now on.

– For the purpose of this paper the term *sui generis* protection is used to refer to a range of mechanisms to complement existing intellectual property rights. Such mechanisms may or may not be intellectual property-related in the strict sense (for example, the granting of access permits for bioprospecting, or educational programmes on the culturally appropriate use of traditional imagery). They may constitute stand-alone legislation, or may comprise amendments to existing legislation to deal specifically with the use of traditional cultural expressions where the legislation was previously silent on the issue.

– New Zealand has also stated previously that there may be some difficulty in considering traditional cultural expressions in isolation from traditional knowledge as a whole. We made this point bearing in mind the holistic nature of many indigenous cultures. For the purpose of this paper, however, we limit our comments to traditional cultural expressions, as far as possible.

* Document submitted by the delegation of New Zealand

Background and outline

4. This paper outlines New Zealand's experiences and perspective as a country currently *considering putting in place a sui generis approach* (no *sui generis* measures are yet in place). We start from the perspective that the current range of intellectual property rights statutes may not be sufficient to adequately protect the traditional knowledge of Maori, the indigenous people of New Zealand, and that *sui generis* approaches should, therefore, be considered.

5. A two-tier approach has, in effect, been adopted. The first step has been to consider what changes might appropriately be made to existing intellectual property rights statutes. This process was recently carried out with respect to the review of the Trade Marks Act 1953, and is currently being undertaken as part of the review of the Patents Act 1953. We consider that amendments to existing intellectual property laws can, however, only go so far before the integrity and purpose of the legislation is affected.¹ It has been acknowledged that changes to the Trade Marks Act, for example, will only address some of the concerns of Maori about the inappropriate use of Maori text and imagery.

6. Our second step is to consider a range of *sui generis* approaches (in addition to changes to existing intellectual property laws). This work is at an early stage, and consultations have yet to be undertaken. We anticipate, however, seeking the views of Maori (and other stakeholders) on a broad range of mechanisms for protecting traditional knowledge.

7. This paper follows, as far as possible, the suggested elements and structure for written papers, provided by the WIPO Secretariat:

- Limiting aspects of current IP laws that lead to the consideration of new measures.
- A description of the *sui generis* system (including policy objectives).
- Additional information on the development of the mechanism (including consultation processes).
- Implementation and enforcement.

8. The paper uses specific provisions of the New Zealand Trade Marks Bill, as a case study and practical example of our experiences developing a proposed mechanism for the protection of traditional cultural expressions. In using this example, we stress from the outset that the relevant provisions of the Trade Marks Bill will, if enacted, only address some of the concerns held by Maori concerning the inappropriate use of Maori text and imagery. It is not, therefore, a comprehensive model for the protection of traditional cultural expressions.

9. In addition to the Trade Marks Bill example, the paper also discusses an approach to *sui generis* mechanisms more generally.

¹ See for example, *Review of the Patents Act 1953: Boundaries to Patentability - A Discussion Paper*, March 2002. Chapter 4 considers Maori and the Patenting of Biotechnological Inventions. The paper is available on the Ministry of Economic Development website: www.med.govt.nz.

TRADE MARKS BILL - PROVISIONS CONCERNING THE REGISTRATION OF TRADE MARKS BASED ON MAORI TEXT AND IMAGERY

Introduction

10. At the time of writing this paper, the Trade Marks Bill (“the Bill”) was awaiting its second reading by the New Zealand Parliament. The Bill is a substantial rewrite of the Trade Marks Act 1953. The amendments are generally designed to define more clearly the scope of rights protected by trade marks, to simplify procedures, reduce compliance costs, deter piracy of copyright works and counterfeit activity in relation to registered trade marks, and ensure that New Zealand’s trade mark regime takes account of international developments.

11. The Bill also contains a number of clauses (outlined in Appendix A) designed to address concerns of Maori regarding the inappropriate registration of Maori text and imagery² as trade marks, including:

– A new absolute ground for refusal to register a trade mark where the Commissioner of Trade Marks considers on reasonable grounds that its use or registration would be likely to “offend a significant section of the community”, including Maori.³ This updates the test in the 1953 Act, which prohibits registration of a mark that is “scandalous and contrary to morality.” The clause applies generally to significant sections of the community, not just to Maori.

– A provision requiring the Commissioner of Trade Marks to appoint an advisory committee to advise the Commissioner whether the proposed registration or use of a trade mark that is, or appears to be, derivative of Maori text and imagery is likely to be offensive to Maori.⁴

– Providing standing for persons who are “culturally aggrieved” to seek a declaration that a registered trade mark is invalid because it is likely to offend a significant section of the community, including Maori.⁵

12. These proposals were developed from the recommendations of a Maori Trade Marks Focus Group established by the then Ministry of Commerce (now Economic Development), and have been the subject of extensive consultation with Maori. While the provision in the Bill relating to offensiveness applies generally to all significant sections of the community, it is considered in this paper from the particular perspective of offensiveness to Maori.

² The terms “text and imagery” are used in this paper to refer generally to the full range of subject matter that may be registered as a trade mark. A trade mark is defined in clause 5 of the Bill as any sign, or combination of signs, capable of being represented graphically, and distinguishing the goods and services of one person from those of another person. A sign is defined as including the following: brand, color, device, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket or word, and any combination of signs.

³ Clause 17.

⁴ Clauses 177-180.

⁵ Clause 174.

Limiting aspects of existing intellectual property laws

13. There are a number of factors, commonly cited, as limiting the application of intellectual property laws to the protection of traditional cultural expressions. These include originality, fixation, the protection of expressions (not ideas), identifiable author versus collective creation and ownership, limited term of protection, and broader divergences in policy objectives and conceptions of ownership between intellectual property laws and customary laws and systems.⁶

14. In commenting on this issue generally, New Zealand has referred to a number of these elements - including novel contribution, duration, identification of an owner and the lack of a protective imperative - as reasons that existing intellectual property laws do not provide the level of protection for traditional knowledge that Maori, and other indigenous peoples, seek.⁷

15. We note, however, that some of these elements (such as duration and identification of owner) are not necessarily impediments to the protection of traditional knowledge and could be overcome by adjustments to existing intellectual property laws. Others, including divergent policy objectives, such as protection versus the promotion of the use of knowledge, are more difficult to address because of the underlying objectives and values on which intellectual property laws are based. The objective of traditional knowledge protection might be more effectively addressed by new *sui generis* mechanisms distinct from existing intellectual property laws.

16. Considering the issue more specifically, in relation to the Bill, we note that the provisions of the Bill are essentially defensive measures designed to prevent the inappropriate registration of Maori text and imagery as trade marks. In this context, many of the elements commonly cited as limiting the application of intellectual property laws are not applicable as we are not approaching the issue from the point of view of Maori wanting to protect their traditional cultural expressions through the registration of trade marks (although they may well do so).

17. As a defensive measure there are, however, still limits to the proposed *sui generis* measure, as a result of it being part of a broader intellectual property based system. The proposed measures will not prevent the offensive use of Maori text and imagery where the user does not seek to register a trade mark. Similarly, the proposed measures will not assist Maori to obtain the exclusive rights to trade marks based on Maori text and imagery where third parties have already registered such trade marks and the registration or use is not considered to be offensive. The issue of what constitutes "offence" is considered further below.

18. Submissions by Maori groups on the Bill generally agreed that these limitations exist. The submission on behalf the tribes of Ngati Kuri, Te Rarawa and Ngati Wai referred to two practical examples of inappropriate use of Maori traditional knowledge that the provisions in

⁶ Information Note and Guidelines - Presentations on National Experiences with Specific Legislative Systems for the Legal Protection of Traditional Cultural Expressions, p4.

⁷ Survey on Existing Forms of Intellectual Property Protection for Traditional Knowledge (WIPO/GRTKF/IC/2/5), Response of New Zealand, p28.

the Bill would not be able to address: Lego Bionicles and Canterbury rugby football boots. These examples, and a number of others, are discussed in the next section of this paper.

Examples of use of Maori traditional cultural expressions

19. The first example raised by counsel for Ngati Kuri, Te Rarawa and Ngati Wai related to the use of Maori names such as “Rangatira”, “Moko” and “Tane-Toa” by a major New Zealand apparel company, on rugby football boots. The manufacturer, Canterbury New Zealand, had not sought trade mark protection for these names. The submitter argued that the use of such sacred names was very offensive, and noted, for example that Tane was one of the creator gods in Maori belief. The submitter suggested that Christian people might be “similarly outraged” if rugby football boots bearing the name “Jesus Christ” were produced.⁸

20. The second example given in the submission related to the use by the Danish owned Lego company of a number of Maori names or words for their range of Bionicle toys and a game based on the toys. The game involves a group of imaginary inhabitants of the Island of Mata Nui called the Tohunga, who are in the power of an evil character named Makuta. Six heroes called Toa are sworn to liberate the Tohunga.

21. While Lego sought to trade mark the term “Bionicle”, it did not seek to register trade marks based on the Maori words, and for this reason the trade marks legislation could be of no assistance. The Maori words used included “Tohunga” which is the term for a Maori spiritual healer. Also *Pohatu* (stone), *Whenua* (land), *toa* (warrior) and *kanohi* (face).

22. A number of Maori found the way Lego used these Maori words and concepts to be culturally offensive. Generally speaking, the concern was not so much about the use of Maori language for toys, but the fact that it should be done in a way that’s culturally appropriate and ensures, for example, that words and names are used in the correct context with the necessary background. The mixing of aspects of number of different cultures was also considered offensive.

23. Following approaches on behalf of the three tribes referred to above (and Ngati Koata) Lego, while claiming that it hadn’t acted illegally, later acknowledged that it had acted inappropriately. The submitter noted that Lego has agreed to develop a self-regulating code of conduct in relation to all future dealings concerning proposed use of traditional knowledge of indigenous peoples.⁹ The government has not been a party to these discussions.

24. More recently, an unofficial Lego Bionicle website (www.bzpower.com) was targeted by a computer hacker identified as “Kotiate”. The hacker is reported to have demanded that the website administrator remove the site’s email forum and “discontinue the abusive use of the Maori culture, customs and history”. When the administrator failed to comply, the site was inundated with automated emails until its Internet service provider closed it down. The website administrators have indicated that they will continue to use the Maori words in

⁸ *Submission to Commerce Select Committee on Behalf of Wai 262 Claimants Ngati Kuri, Te Rarawa and Ngati Wai on the Trade Marks Bill (TM/30)*, Maui Solomon (Senior Counsel), 21 September 2001, p2-3.

⁹ *Ibid*, p3.

question.¹⁰ A Maori issues website, www.aotearoalive.com, believes that attacks on its site by hackers are a reaction to the hacking of the BZPower site by allegedly Maori hackers.

25. Other relatively recent examples of the use of Maori traditional cultural expressions involve haka and ta moko. Ta Moko, the art of Maori tattoo, is a process of carving deep grooves and colouring into the skin for family and personal identification. Certain people were entitled to wear moko for particular reasons such as rank, status, achievements, membership and also life history. As tattooing involved marking the face and the shedding of blood, it was highly tapu or sacred and the process was associated with extensive ritual and regulations. While in contemporary society, the practice of ta moko is not as prevalent as in traditional times, the norms governing this art form still exist. Given these restrictions, it causes offence when it takes place outside of these parameters, particularly when sacred images are using in an inappropriate context.

26. Haka can be described as a form of Maori ceremonial dance. It is commonly associated with warfare and challenge, but may also convey a range of emotions including prayer. There are particular customs that govern how a haka is performed and who may perform it (for example, women may only perform certain haka). One of the most well known haka is *Ka Mate*. This haka, composed by the Ngati Toa chief Te Rauparaha in 1821, has become one of the most performed, and misused and exploited, of all haka. It is also the haka performed by the New Zealand national rugby football team, the *All Blacks*. *Ka Mate* is traditionally performed by men, and not by women.

27. The following examples of the use of ta moko and haka have attracted attention internationally and in New Zealand. An advertisement by British Bass Breweries, which featured women wearing bikinis on a beach performing a haka to advertise an alcoholic fruit drink, caused some controversy. The advertisement lead the New Zealand High Commission in London to write to the manufacturer of the drink to ask that the advertisement be withdrawn immediately on the basis that the use of the haka in that situation (by woman and associated with alcohol) was offensive to Maori culture. The advertisement was reportedly withdrawn following a large number of complaints received by Britain's Independent Television Commission.¹¹

28. Similarly, an attempt by pop group, the Spice Girls, to do a haka was considered to be extremely culturally offensive according to a number of Maori commentators. The haka has also been used by British TV channel BBC One to launch its new look. One of the promotional indents features Welsh rugby football players performing a haka, lead by a Maori player.¹²

29. Moko have also been used in circumstances that many Maori consider culturally inappropriate. For example, a restaurant in the Netherlands has branded itself using the name *Moko*. Its website clearly associates the restaurant with Maori moko, and contains a number of images of simulated tattoos on what appear to be European faces. The website attracted a significant amount of attention in the New Zealand media, and the images were described as offensive by a number of commentators.

¹⁰ The Dominion, Tuesday 12 November 2002 [www.stuff.co.nz/in].

¹¹ www.nzedge.com/hot/ar-moko; www.gaurdian.co.uk

¹² [www.tvhome.co.uk/bbc one](http://www.tvhome.co.uk/bbc_one); www.nzedge.com/hot/ar-moko.

30. Moko have also appeared on the international fashion scene. For example, designer Thierry Mugler used masks inspired by moko to launch a collection. Paco Rabanne's Spring 1998 Collection featured two models wearing metal attire reported to be based on the stylised moko of the New Zealand film *Once Were Warriors*.¹³

31. Celebrities have also used moko. British pop singer Robbie Williams recently had his arm tattooed by a Maori moko artist. The design is reported to represent the story of Mr Williams' life, spiritual beliefs and aspirations. Some Maori, however, have objected to this use of moko. Soccer star Eric Cantona has appeared on the cover of English GQ Magazine with a face-painted moko.

32. The above examples have been highlighted to indicate the sorts of uses of Maori traditional cultural expressions that a number of Maori consider offensive or inappropriate, and that in many cases cannot be addressed by existing intellectual property laws (or the proposed changes to the Trade Marks Act). They also suggest that Maori designs are gaining increasing attention at an international level.

33. It is difficult, however, to determine with any certainty what constitutes permissible use and what is offensive. A number of Maori consider the exposure of Maori culture, when appropriately done, to be a positive step, which promotes the culture and provides Maori with opportunities for economic development. Others are very concerned about the expropriation of culture. Some cases are more-clear cut than others.

34. In some of the examples referred to above there were differences of opinion among Maori commentators and experts about the appropriateness of the actions taken. This illustrates one of the difficulties the Committee may face in considering the development of *sui generis* measures. The matter is further complicated when we consider the unique nature of the many cultures of indigenous peoples and local communities. This may make a search for a "one size fits all" approach counter productive. Any measures adopted must be appropriate to the cultures concerned. For this reason New Zealand supports an approach by the Intergovernmental Committee to the protection of traditional cultural expressions based on a multi-faceted menu of options, using both existing intellectual property rights and a range of *sui generis* measures.¹⁴

Description of *sui generis* measure

Policy objectives (Treaty of Waitangi)

35. The provisions of the Bill relating to Maori text and imagery are a response to Maori concerns in the area of trade mark registration. These concerns also reflect broader concerns regarding the protection of Maori cultural heritage and government activity in granting trade mark and other intellectual property rights involving words, images and indigenous material that Maori consider to be their "cultural and intellectual property".

¹³ www.nzedge.com/hot/ar-moko.

¹⁴ WIPO/GRTKF/IC/4/3, para 10.

36. These issues are a significant feature of a claim by a number of iwi (Maori tribes) to the Waitangi Tribunal (“the Wai 262 claim”).¹⁵ The Waitangi Tribunal was established in 1975. Its role is to determine claims put to it by Maori that allege breaches of the principles of the Treaty of Waitangi (“the Treaty”) based on Crown policy, legislation, actions or omissions. The Treaty of Waitangi is considered to be New Zealand’s founding document. It establishes a relationship between the tribes and the government, and outlines a number of rights and obligations.

37. The Wai 262 claim is an extremely broad Treaty claim. Matters raised in the most recent statements of claim include cultural property (tangible), traditional knowledge, Maori “cultural and intellectual property” rights, rights to specified flora and fauna, environmental management, and protection and promotion of Maori language.

38. The intellectual property issues raised by the Wai 262 claim are twofold. First, the perceived adverse effects intellectual property rights can have on traditional knowledge and associated cultural property and biological resources. The key concern here is the granting of intellectual property rights to third parties for creations or inventions based on traditional knowledge or practices (where there is no originality or novelty) and the resulting commercialisation that occurs in some cases. The inappropriate use and registration of trade marks containing Maori text and imagery is an example of this. The claimants are also concerned about the patenting of life-form inventions.

39. Secondly, the claimants are concerned about the inability of Maori to obtain or use intellectual property rights to enable them to protect or commercially exploit (where appropriate) their traditional knowledge, cultural property and biological resources.

40. While much of the claim is about intellectual property rights, and the inability of existing intellectual property laws to protect traditional knowledge effectively, the claim also has what might be described as a constitutional or governance dimension. The statements of claim assert a right to participate in the general exercise of government, including in the development of all legislation, policy and international agreements affecting the ability of the claimant iwi to exercise authority over their taonga (things highly prized, treasures). This claim is based on Article II of the Treaty of Waitangi, which guaranteed to Maori the full, exclusive and undisturbed possession of all their treasures, and is said to impose on the Crown an obligation of active protection. We note that the governance issue raised here seems to have attracted little consideration in the Intergovernmental Committee’s discussions to date.

41. This Treaty of Waitangi dimension suggests, to a degree, a point of departure for New Zealand on the issues being considered by the Committee. The Treaty must be foremost in our minds when considering the protection of traditional cultural expressions. In considering solutions we must maintain our ability to meet our Treaty obligations.

42. The Wai 262 claim is still some way from completion. Meanwhile the government is proceeding with legislative reform (in the trade marks and patents areas) that may go some way towards addressing the issues raised by the claim. We note, however, that reforms such

¹⁵ For introductory information on the role of the Waitangi Tribunal, and the Treaty of Waitangi, refer to the Tribunal’s website: <http://www.waitangi-tribunal.govt.nz>.

as those in the Bill will not address all concerns. It is for this reason that New Zealand intends to consider a range of *sui generis* measures (discussed later in this paper).

Subject matter/scope of protection (registerable trade marks)

43. As noted previously, the provisions in the Bill designed to prevent the inappropriate registration of trade marks based on Maori text and imagery provide a *defensive* means of protection for traditional cultural expressions by preventing registration in certain circumstances.

44. The subject matter or scope of protection will be directly linked to the criteria for the registrability of trade marks.¹⁶ Defensive protection will only exist where an application is made to register a trade mark. Broadly speaking, therefore, the subject matter of protection will be registerable trade marks based on Maori text and imagery.

Criteria for protection (offensiveness)

45. The Bill provides an absolute ground for refusing to register a trade mark where the Commissioner of Trade Marks considers that the use or registration of the trade mark would be likely to offend a significant section of the community, including Maori.

46. In order for the defensive protection to operate, therefore, there are two criteria to be met: offensiveness and “significant section of the community” (neither of these terms are defined in the Bill). Applied to trade marks based on Maori text and imagery, Maori are specifically referred to as a significant section of the community.

47. The criteria for offensiveness is slightly more problematic. Offence may be caused to a particular group of Maori, or to Maori more generally. While offence is not defined in the Bill, it is not envisaged that the mere registration or use of a trade mark based on Maori text and imagery will be considered to be offensive only by virtue of the fact that the applicant or owner is not Maori. There must be something particularly offensive, or culturally inappropriate, about the trade mark or its use.

48. The Maori Trade Marks Focus Group noted that Maori text and imagery are part of Maori cultural heritage, and as such they should be respected and used in appropriate ways. The use of Maori text and imagery as trade marks should, therefore, be consistent with their use in Maori culture. The Focus Group used the following example. The word “mana” can mean a person’s honour, their sense of prestige and the essence of their being. If there were a beer marketed under the trade mark “mana” (if “mana” was able to be registered) Maori would be likely to find this offensive as the qualities of “mana” would not appropriately apply

¹⁶ A trade mark is defined in clause 5 of the Bill as any sign, or combination of signs capable of being represented graphically, and distinguishing the goods and services of one person from those of another person. A sign is defined as including the following: brand, color, device, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket or word, and any combination of signs.

to a beverage.¹⁷ An application to trade mark a wine named “Mana” lapsed for this reason. Other examples of offensiveness might include the use of the names of sacred places or ancestors in relation to foodstuffs or cleaning products.

Identification of owner of rights

49. Under the proposed mechanism, identification of the owner of rights will not be directly required. As a defensive mechanism, what is required is a finding that a significant section of the community is likely to consider the registration or use of the mark to be offensive. A decision by the Commissioner of Trade Marks not to register a trade mark on this basis will not constitute a finding that any particular section of the community is the owner of that text or imagery.

50. In coming to the conclusion that the use or registration of a particular trade mark is offensive, there is however likely to be some inquiry as to the relationship of particular text or imagery to particular Maori groups in order to make a finding as to offensiveness. It is envisaged that the Maori Advisory Committee, to be established to assist the Commissioner, will provide advice in this regard. The processes to be employed by the Advisory Committee are considered below.

Definition of rights

51. As a defensive measure, the provisions in the Bill do not give positive rights to Maori. Rather it provides a process to ensure that culturally offensive marks are not registered.

Role of new/existing authorities (Maori Advisory Committee)

52. The Bill contains a number of provisions that relate to the establishment of an advisory committee (“the Advisory Committee”).

53. The establishment of an advisory committee was thought necessary to ensure that the Commissioner of Trade Marks has access to expert advice, and thereby provide some assurance that the decisions the Commissioner is required to make in respect of the registration of Maori text and imagery are made appropriately. The underlying objective is to minimise the risk that the government may inadvertently register as trade marks Maori text and imagery where registration would cause offence to Maori.

54. The Bill provides the following guidance as to the function, membership and operation of the Advisory Committee:

- The function of the Advisory Committee will be to advise the Commissioner of Trade Marks whether the proposed use or registration of a trade mark that is, or

¹⁷ Maori and Trade Marks, A Discussion Paper, Maori Trade Marks Focus Group, 1997, p20.

appears to be, derivative of Maori text or imagery is, or is likely to be, offensive to Maori.¹⁸

- The Commissioner must appoint an advisory committee but may discharge or replace members at anytime. The appointment process is left to the discretion of the Commissioner.¹⁹
- In making appointments to the Advisory Committee the Commissioner shall have regard to a person’s knowledge of *te ao Maori* (Maori worldview) and *tikanga Maori* (Maori protocol and culture).²⁰
- The Advisory Committee may regulate its own procedure subject to any direction given by the Commissioner.²¹

Procedures/formalities

55. The Bill does not address process issues, except to say that the Advisory Committee may regulate its own procedure, subject to any direction given by the Commissioner. While the Bill has yet to be passed into law, some preliminary thought has been given to a process for consideration, by the Advisory Committee, of trade marks based on Maori text and imagery. This process would also be subject to discussion with the members of the Advisory Committee, once appointed.

56. It is envisaged that, at least initially, all applications containing Maori text and imagery will be forwarded to the Advisory Committee for consideration. After a suitable period of time guidelines would be developed, by the Advisory Committee, as to what sorts of applications do and do not need to be referred to it. It is also envisaged that the Advisory Committee would provide advice to the Commissioner on key parties that applicants should consult regarding particular applications and in order to obtain further information or verify information already provided by the applicant. It is not envisaged that the Advisory Committee would communicate with applicants directly.

57. A three-step process for consideration of applications by the Advisory Committee is being considered:

- All applications received by the Intellectual Property Office of New Zealand (“IPONZ”) would be assessed to determine whether they are based on, or have been sourced from, Maori text or imagery. Trade marks that are, or appear to be, derivative of Maori text or imagery will be forwarded to the Advisory Committee. Currently, around 12 applications containing Maori text and imagery are received by IPONZ per month (less than one per cent of all applications).

¹⁸ Clause 178.

¹⁹ Clause 179(1).

²⁰ Clause 179(2).

²¹ Clause 180.

- The Advisory Committee would examine applications against the offensiveness criteria taking into account the proposed use of the trade mark and the goods or services to which it is affixed. Individual committee members would be required to advise the Commissioner within a set number of working days of the outcome of their “preliminary consideration”. If individual members were confident that registration is unlikely to cause offence, IPONZ would advise the applicant accordingly, and the application would proceed through the usual process of trade mark examination.
- If individual members have initial concerns, the Advisory Committee as a whole would be asked to consider the application (and the applicant would be advised of this). The Committee would be asked to advise the Commissioner in respect of each application whether:
 - (a) Registration of the proposed trade mark is unlikely to cause offence to Maori (the application would then proceed through the usual trade mark registration process).
 - (b) Registration of the proposed trade mark may cause offence to Maori and the applicant is advised to discuss the application further with identified key parties. The application would be re-assessed by the Advisory Committee, once any additional information is provided. This process might repeat itself several times until the Committee makes a final determination on whether the proposed mark is “likely” or “unlikely” to cause offence.
- (a) Registration of the proposed trade mark is likely to cause offence to Maori.

58. The Commissioner of Trade Marks would then make a decision based on the advice of the Advisory Committee.

Enforcement procedures

59. Not applicable.

Expiry/loss of rights

60. Not applicable.

Interaction with existing intellectual property standards.

61. The proposed mechanism regarding Maori text and imagery will form part of the future Trade Marks Act. No issues arise, therefore, in respect of interaction with existing intellectual property standards.

Customary laws and protocols

62. While there is no specific reference to customary laws, the test of offensiveness to Maori is in a sense a recognition that Maori text and imagery should be used in a manner

deemed appropriate by the protocols of Maori culture. It is hoped that the Advisory Committee will be able to provide advice on applicable customary law.

Protection of foreign traditional cultural expressions

63. The provision of the Bill that will require the Commissioner of Trade Marks to refuse to register a trade mark on the basis of offence will apply to all significant sections of the community. It will apply, therefore, to cultures other than Maori, and may prevent the registration of trade marks based on, for example, Samoan or Chinese text and imagery.

Additional information

Consultation processes

64. The provisions in the Bill relating to the registration or use of trade marks based on Maori text and imagery are the result of a comprehensive consultation process. The process began in 1990 with a review of industrial property rights legislation generally. A proposed Intellectual Property Law Reform Bill was put on hold following consultation with Maori, which revealed that Maori had significant concerns about intellectual property law reform. It was subsequently decided that the industrial property review should be progressed in three stages encompassing trade marks, patents, designs and other issues.

65. In 1991 the Ministry of Commerce produced a public discussion paper, which proposed a number of changes to the Trade Marks Act 1953. In view of concerns expressed by Maori that the 1953 Act did not adequately protect Maori “cultural and intellectual property”, work on the legislation was suspended in order to undertake consultations with Maori.

66. Four national hui (meetings) were held in 1994. One of the outcomes of these meetings was the establishment of the Maori Trade Marks Focus Group (“the Focus Group”). The members of the Focus Group came from a range of backgrounds including Maori language, cultural property, tourism and Maori business.

67. The Focus Group met during 1995 and 1996 and produced a discussion paper, which was released in 1997. The paper reported on the outcome of the Focus Group’s deliberations relating to the registration, as trade marks, of Maori words, symbols, sounds or smells. It was used as the basis of discussion for a series on eight further meetings held throughout New Zealand in 1997.

68. Officials from the Ministry of Commerce and the Ministry of Maori Development attended these meetings and made presentations, along with members of the Focus Group. The response to the Focus Group’s recommendations was generally supportive. The work of the Focus Group and the subsequent consultations formed the basis of recommendations to the government in April 1999 concerning the registration of Maori text and imagery as trade marks.

69. The Focus Group’s recommendation that a consultative group be established to advise the Commissioner of Trade Marks led to a direction that officials from the Ministry of Commerce and the Ministry of Maori Development convene an Establishment Team to

provide further recommendations on this issue. The Establishment Team was selected on the basis of business, legal and other expertise, particularly in the area of Maori arts and culture.

70. The work of the Establishment Team led to a further report to the government in 1999 concerning what has now become the Advisory Committee in the Bill. The provisions in the Bill are a direct result of the recommendations arising through the process outlined above.

Use of trade marks by Maori

71. As stated previously, the provisions in the Bill relating to Maori text and imagery provide a degree of defensive protection. They are not concerned, therefore, with Maori using trade mark law to protect, in a positive way, traditional cultural expressions.

72. Maori do, of course, register Maori text and imagery as trade marks.²² Of particular note is an application to register, as a trade mark, the words of the Ka Mate haka. The application was made on behalf of the Ngati Toa tribe, who had concerns about the guardianship of the haka and the inappropriate use of it. The Intellectual Property Office of New Zealand initially raised some reservations about the distinctiveness of the claimed mark as the Ka Mate Haka is very well known, and many people are not aware that it is a haka of a particular tribe.²³ The application is still pending.

Other *Sui Generis* Approaches

General approach to sui generis protection

73. As noted previously, New Zealand considers *sui generis* measures such as the proposed changes to the Trade Marks Act 1953, while developed in response to Maori concerns about the inappropriate use of Maori text and imagery as trade marks, do not address wider concerns. We have signalled, therefore, that additional *sui generis* measures may be required.

74. New Zealand has begun a process of considering a range of legal and non-legal mechanisms (some, not all, are intellectual property-based). While a number of solutions are likely to be found in testing and adapting existing intellectual property laws, it seems that new mechanisms will eventually be required.

75. The issue of *sui generis* mechanisms was first considered in 1994 in response to a number of domestic and international developments, including the Draft Declaration on the Rights of Indigenous Peoples, the Convention on Biological Diversity and the Mataatua Declaration on the Cultural and Intellectual Property Rights of Indigenous Peoples.²⁴ In 1994

²² At the time of writing there were approximately 650 registered trade marks that contain Maori text and imagery. It is not possible to say with any certainty how many of those marks belong to Maori as ethnicity is not recorded on application forms.

²³ In order to be eligible for registration a trade mark must be distinctive, that is, it must be “capable of distinguishing the goods or services of one person from those of another person” (section 2, Trade Marks Act 1953).

²⁴ In 1993, the Nine Tribes of Mataatua in the Bay of Plenty region of Aotearoa (New Zealand) convened the First International Conference on the Cultural and Intellectual Property Rights of

Maori expressed significant concerns about New Zealand becoming a signatory to the TRIPs agreement and its potential impact on Maori cultural and intellectual property rights. As noted above in relation to the Wai 262 claim, Maori were also concerned about the resulting reform of New Zealand's intellectual property statutes, which were seen by claimant groups as inadequate or inappropriate to protect Maori cultural and intellectual property rights.

76. In response to these developments the Ministry of Maori Development, along with the Ministry of Commerce and Ministry of Foreign Affairs and Trade were instructed to explore the possibility of using *sui generis* mechanisms to protect Maori traditional knowledge. To date, scoping work has been undertaken in the context of not just intellectual property, but also the other needs of Maori, such as self-determination, health, justice, cultural heritage and economic development.

77. The next logical step in the process is to seek the views of Maori (and other stakeholders) on the range of mechanisms that have been identified. These include:

- new intellectual property laws;
- further adjustments to existing intellectual property laws;
- stand alone legal frameworks and model laws (including the Model Law for the Protection of Traditional Knowledge and Expressions of Culture, developed by the Secretariat of the Pacific Community);
- contractual agreements;
- common law;
- documentation initiatives (inventories, registries and databases);
- voluntary codes of ethics;
- education programmes;
- customary law; and Treaty of Waitangi settlements.

78. The practical examples of *sui generis* mechanisms collated by WIPO will also provide a useful resource. It is envisaged that discussion of these mechanisms and the needs and objectives of Maori in relation to traditional knowledge will be undertaken in the coming year.

The Maori Made Mark

79. The Maori Made Mark (Toi Iho) is another mechanism developed in response to concerns raised by Maori about the protection of traditional cultural expressions, including the mis-use of Maori concepts, styles and imagery and the lack of commercial returns accruing to

[Footnote continued from previous page]

Indigenous Peoples. Over 150 delegates from 14 countries attended, including indigenous representatives from Ainu (Japan), Australia, Cook Islands, Fiji, India, Panama, Peru, Philippines, Surinam, USA and New Zealand. The Conference met over six days to consider a range of significant issues, including: the value of indigenous knowledge, biodiversity and biotechnology, customary environmental management, arts, music, language and other physical and spiritual cultural forms.

Maori. The mark is considered by many as an interim means of providing limited protection to Maori traditional cultural expressions, by decreasing the market for copy-cat works produced by non-Maori.

80. The Maori Made Mark, developed by the Maori Arts Board (Te Waka Toi) of the Arts Council of New Zealand (Creative New Zealand), is a registered trade mark and a mark of authenticity used to promote and sell authentic, quality Maori arts and crafts. The mark indicates to consumers that the creator of works is of Maori descent and produces work of a particular quality. Creative New Zealand is currently the owner of the trade mark. It is envisaged, however, that once the mark is established, ownership of it will be transferred to an autonomous Maori entity.

81. In addition, the *Mainly* Maori Mark is available for groups of artists, most of whom are of Maori descent, who work together to produce, present or perform works across platforms. The Maori *Co-production* Mark is a companion mark available to Maori artists who create works with persons of non-Maori descent. The Co-production Mark acknowledges the growth of innovative, collaborative ventures between Maori and non-Maori.

82. Since the Maori Made Mark was launched earlier this year, 84 applications have been received. Fifty-seven artists have been licensed to use the Maori Made Mark, and one to use the Maori Co-production Mark. Ten retailers have been granted licensed stockist status.

83. The New Zealand delegation to the Fourth Session of the Intergovernmental Committee will make a short presentation highlighting the main aspects of this paper. The delegation would also be pleased to discuss any issues of interest with other delegations.

[Appendix follows]

APPENDIX

RELEVANT CLAUSES OF TRADE MARKS BILL

This appendix contains the text of the relevant clauses of the Trade Marks Bill. At the time of writing this paper the Bill was about to have its second reading before the New Zealand Parliament. Should any changes be made to the Bill, New Zealand will advise the Committee in due course.

Refusal to register on the basis of offence

17 *Absolute grounds for not registering trade mark: general*

(1) *The Commissioner must not do any of the following things:*

(a) *Register as a trade mark or part of a trade mark any matter the use of which would be likely to deceive or cause confusion;*

(b) *Register as a trade mark or part of a trade mark if –*

(c) *its use is contrary to New Zealand law or would otherwise be disentitled to protection in any court:*

(i) *the Commissioner considers that its use or registration would be likely to offend a significant section of the community, including Maori:*
[emphasis added]

(ii) *the application for the registration of the trade mark is made in bad faith.*

(2) *Despite subsection (1)(b)(i), the Commissioner may register a trade mark even if use of the trade mark is restricted or prohibited under the Smoke-free Environments Act 1990.*

Invalidity - persons culturally aggrieved

74 *Invalidity of registration of trade mark*

(1) *The Commissioner or the Court may, on the application of any aggrieved person (which includes a person who is culturally aggrieved), declare that the registration of a trade mark is invalid to the extent that the trade mark was not registrable under Part 2 at the deemed date of registration.* [emphasis added]

(2) *Despite subsection (1), the registration of a trade mark that has acquired a distinctive character after its registration must not be declared invalid even though the trade mark was not registrable under Part 2 at the deemed date of registration.*

Advisory Committee

177 *Advisory committee*

- (1) *The Commissioner must appoint an advisory committee.*
- (2) *The Commissioner may alter the advisory committee.*

178 *Function of advisory committee*

The function of the advisory committee is to advise the Commissioner whether the proposed use or registration of a trade mark that is, or appears to be, derivative of a Maori sign, including Maori text and imagery is, or is likely to be, offensive to Maori.

179 *Membership of advisory committee*

- (1) *The Commissioner may, at any time, appoint or discharge a member of the advisory committee and, if the Commissioner thinks fit, appoint another member in a discharged member's place.*
- (1) *A person must not be appointed as a member of the advisory committee unless, in the opinion of the Commissioner, the person is qualified for appointment, having regard to that person's knowledge of te ao Maori (Maori world view) and tikanga Maori (Maori protocol and culture).*
- (3) *A member of the advisory committee may resign office by notice in writing to the Commissioner.*

180 *Advisory committee to regulate own procedure*

Subject to any direction given by the Commissioner, an advisory committee may regulate its own procedure.

[Annex III follows]

ANNEX III

NIGERIA*

NIGERIA - A BRIEF PROFILE

1. Nigeria is a country in the west-African sub region made up of over 120 million people. There are over 250 ethnic groups in Nigeria. Two million Nigerians live in the United Kingdom and about 6 million Nigerians reside in the United States. Nigeria became independent in 1960. It is presently a democracy.
2. There is a significant exploitation of intangible cultural heritage such as folklore and other indigenous knowledge. This is particularly evident in the leisure industries of tourism and entertainment. In the video film market in Nigeria for example, the usage of cultural themes and symbols are currently witnessing a phenomenal expansion. As at July 2002, the Nigerian Film and Video Censors Board had assessed over 554 video films. The Nigerian Copyright Commission is the Federal Government agency statutorily responsible for all matters pertaining to Copyright in Nigeria as contained in the Nigerian Copyright Act, including expressions of folklore. The Copyright Act was promulgated in 1988 and has been subject to amendments in 1992 and 1999.

The Nigerian Experience

A. The following elements or standards of currently existing intellectual property law limit the application of intellectual property law to the protection of traditional cultural expressions and therefore require *sui generis* legislation:

- (i) Originality
- (ii) Fixation
- (iii) Differences in policy objectives and conceptions of “ownership” between intellectual property law and customary systems.
- (iv) Protection of “expressions”, not “ideas”
- (v) Identifiable author versus collective creation and ownership;
- (vi) The limited term of protection; and
- (vii) Wider permissible exceptions in intellectual property law.

B. Description of how the *sui generis* provision in the nigerian copyright act apply with regard to expressions of folklore.

- (i) The Policy Objectives of Protection: The policy objectives in the Act in respect of expressions of folklore is to prevent unauthorized use of folklore resources; ensure the honour dignity or the cultural interests of the source community; acknowledge the source of the folklore while not unnecessarily inhibiting the public access to the resources.

* Document prepared by Associate Professor E.S Nwauche, Director-General, Nigerian Copyright Commission, nwauche@hotmail.com

(ii) The Subject Matter of Protection: The subject matter of protection is found in section 28 (5) of the Copyright Act. The said section provides that folklore is a “ *group-oriented and tradition based creation of group or individuals reflecting the expectation of the community as an adequate expression of its cultural and social identity, its standards and values as transmitted orally, by imitation or by other means including:*

- (a) *folktales, folk poetry and folk riddles;*
- (b) *folk songs and instrumental folk music;*
- (c) *folk dances and folk plays;*
- (d) *productions of folk arts in particular, drawings, painting, carvings, sculptures, pottery, terracotta, mosaic, woodwork, metal ware, jewelry, handicrafts, costumes and indigenous textiles)*

These expressions of folklore are protected against:

- *reproduction;*
- *communication to the public by performance, broadcasting distribution by cable or other means;*
- *adaptations, translations and other transformations, when such expressions are made either for commercial purposes or outside their traditional or customary context.:* (section 28 (1) of the Copyright Act)

(iii) Criteria for Identification of Subject Matter: There is no explicit identifiable criteria expressions of folklore must meet as a condition for its protection but such criteria may be implied from the definition cited in section 28 (5). Folklore is a “ *group-oriented and tradition based creation of group or individuals reflecting the expectation of the community as an adequate expression of its cultural and social identity, its standards and values as transmitted orally, by imitation or any other means*”

One of the problems with this criterion is the definition of the word “community.”

(iv) The Owner of the Rights: The owner of the right is the (source community) and this is implicit from the aforesaid definition of folklore in section 28(5). However, the law vests in the Nigerian Copyright Commission the right to authorize the exploitation of the expression of folklore resources. The Nigerian Copyright Commission is more of a custodian. However the Commission is not answerable to the source communities or is it bound to obey their directives.

(v) The Nature of Rights Conferred: There are moral and economic rights granted in respect of expressions of folklore.

3. The moral rights are as follows: (i) S. 28(2) of the Copyright Act allows expressions of folklore by way of fair dealing for private and domestic use subject to the condition that if the use is public it shall be accompanied by the title of the work and its source. Secondly section. 28(3) requires all printed publications and communications to the public of any identifiable expressions of folklore to bear an indication in the appropriate manner of its source and to mention the community or place where the expression utilized has been derived. Thirdly section 29A(1)c & d criminalizes a willful misrepresentation of the source of an

expression of folklore or willful distortion of folklore in a manner prejudicial to the honour dignity or cultural interests of the community in which it originates. There are no economic rights granted to the Commission or to the source communities.

4. The following exceptions and limitations are found in S.28(2) of the Act:

(a) *the doing of any of the acts by way of fair dealing for private or domestic use, subject to the condition that, if the use is public, it shall be accompanied by an acknowledgement of the title of the work and its source;*

(b) *the utilization for purpose of education;*

(c) *utilization by way of illustration in an original work of an author, provided that the extent of such utilization is compatible with fair practice;*

(d) *the borrowing of expressions of folklore for creating an original work of an author, provided that the extent of such utilization is compatible with fair practice;*

(e) *the incidental utilization of expressions of folklore.*

(vi) Registration or Fixation Requirements: There are neither any registration requirement nor fixation requirement for the acquisition and maintenance of the rights subsisting in expressions of folklore.

(vii) Management of the Rights: The responsibility to manage the rights subsisting in expressions of folklore is legally vested on the Nigerian Copyright Commission (NCC) on behalf of the originating indigenous communities. There are consultations with approved collecting societies with a view to their involvement in the management of folklore rights that can be said to form part of their mandate. There are two approved collecting societies. The first is the Performing and Mechanical Rights Society (PMRS) for the music industry. The second is the Reproduction Rights Organisation of Nigeria (REPRONIG).

(viii) Enforcement Procedures: There are no separate enforcement procedures in this respect but the Commission's general enforcement procedures. Copyright Inspectors will investigate any alleged infringement and take appropriate legal action. The action can be civil or criminal.

A civil action is enabled by S. 29 of the Act which provides that "*any person who without the consent of the Nigerian Copyright Commission, uses an expression of folklore in a manner not permitted by Section 28 of this Act shall be in breach of statutory duty and be liable to the Commission in damages, injunctions and any other remedies as the court may deem fit to award in the circumstances.*"

Section 29A provides for criminal liability. The said section provides that, "*Any person who – (a) does any of the acts set out in section 28 of this Act without the consent or authorization of the Commission; or (b) does not comply with the requirement in subsection (4) of section 28 of this Act; or (c) willfully misrepresents the source of an expression of folklore; or (d) Wilfully distorts an expressions of folklore in a manner prejudicial to the honour, dignity or cultural interests of the community in which it originates, commits an offence under this Act*".

Section 29A(2) of the Act provides that “*a person convicted of an offence under subsection (1) of this section is liable on conviction to – (a) in the case of an individual, to a fine not exceeding N100,000 or to imprisonment for a term of 12 months or to both such fine and imprisonment; and (b) in the case of a body corporate, to a fine of N500,000.*”

Furthermore, S. 29A(3) provides that “*a court before which an offence under this section is tried may order that the infringing or offending article be delivered to the Commission.*”

The Commission has embarked on the documentation of Nigeria indigenous folklore resources as a first step towards the effective administration and enforcement of the rights subsisting in the expressions of folklore.

(ix) Expiration and Loss of Expressions of Folklore: Expressions of folklore exist in perpetuity. The Act does not address how the rights are lost or expire.

(x) Interaction Between Sui Generis System and Existing Standards of Intellectual Property: With respect to fixation, certain aspect of folklore (productions of folklore arts in particular, drawings, paintings, carvings, sculptures, pottery, terra cotta, mosaic, woodwork, metal ware, jewelry, handicrafts, costumes and indigenous textiles), possess the fixation qualities applicable in copyright. In addition the concept of joint authorship should make it easy to acknowledge the possibility of community ownership inherent in expressions of folklore.

(xi) Relevant Customary Law: While there is no express reference or incorporation of relevant customary law, there is an indirect recognition of the role of customary law. This is evident in the definition of expressions of folklore. Indeed, it will be customary law that defines the group orientation and tradition of a community to be able to identify an authentic expression. In addition, customary law will be of assistance in determining the meaning of traditional or customary context used in section 28(1) of the Act

(xii) The Activities of Cultural Heritage Institutions: There is no referral or integration of the activities of cultural heritage institutions.

(xiii) The Protection of regional folklore: This is not addressed.

C. CONSULTATIONS TOWARDS THE LEGISLATION

The Federal Ministries of Justice, Information, and Culture were involved in the process of promulgating the Copyright Act. Other government agencies involved are Nigerian Institute for Advanced Legal Studies and Nigerian Law Reform Commission.

The stakeholder groups involved in the consultations include cultural administrators; legal practitioners; ethno-musicologists; university lecturers especially in the fields of Arts and law; librarians; local artist and representatives of indigenous people.

D. Experiences with the implementation, enforcement and use of the provisions on the expressions of folklore in Nigeria.

(i) Some indigenous and/or traditional communities are aware of the law on the expressions of folklore. Granted that the level of such awareness is still very low, the Nigerian Copyright Commission is striving to improve of this awareness.

As a prelude to effective administration and enforcement of the provision on the expressions of folklore, the Commission sees the need to document the diverse repertoire of Nigerian indigenous folklore resources. It is for this reason that it set up a “Multi-Disciplinary Committee on Folklore” to determine the most efficacious strategy for identification, documentation and effective implementation of the legal provisions of the law in this regard.

Clearly, the Commission cannot document the folklore resources of the numerous ethnic cultures of Nigeria without the closest collaboration with the people themselves. Accordingly, the Commission is systematically eliciting such support. A committee comprising representatives of the indigenous people and other stakeholders to document the folklore resources of *Igala* ethnic nationality has been inaugurated as a pilot project. This committee is part of the outcome of a national workshop on folklore resources recently organized in Lafia, Nassarawa State in collaboration with the State Government.

(ii) There are no instances in which the law has been used.

(iii) The usefulness of the law can be summarized as follows:

- (a) Identification of the folklore resources of respective indigenous people;
- (b) Preservation of vital artistic cultural heritage;
- (c) Provision of and access to raw materials for more creative production;
- (d) Incentive to spur creativity;
- (e) Protection of the rights of the source communities;
- (f) Alternative source of revenue to both the local communities and Government;
- (g) Promotion and revitalization of crucial aspects of Nigerian cultural heritage.

(iv) The following are areas for consideration with a view to amendment. They are:

- (a) The question of economic rights for the source communities and the Commission.
- (b) The management of the right and the role of collective management organizations in this regard.
- (c) The time limit for the grant of the procedure and the duration of such consent.
- (d) The meaning of “traditional or customary context” as provided for in section 28(1)c of the Act.
- (e) The mode of appropriate indication of the source of an identifiable expression of folklore
- (f) The manner in which expressions of folklore are extinguished or enter into the public domain of Nigeria.

[Appendix follows]

APPENDIX

Excerpt from the Nigerian Copyright Act
(as last amended by the Copyright (Amendment) Decree No. 96 of 1992)

28. PROTECTION OF EXPRESSIONS OF FOLKLORE

- (1) Expressions of folklore are protected against –
 - (a) reproduction
 - (b) communication to the public by performance, broadcasting, distribution by cable or other means;
 - (c) adaptations, translations and other transformations, when such expressions are made either for commercial purposes or outside their traditional or customary context.
- (2) The right conferred in sub section (1) of this section shall not include the right to control –
 - (a) the doing of any of the acts by way of fair dealing for private and domestic use, subject to the condition that, if the use is public, it shall be accompanied by an acknowledgement of the title of the work and its source;
 - (b) the utilization for purposes of education;
 - (c) utilization by way of illustration in an original work of an author: provided that the extent of such utilization is compactible with fair practice;
 - (d) the borrowing of expressions of folklore for creating an original work of an author:
provided that the extent of such utilization is compactible with fair practice;
 - (e) the incidental utilization of expressions of folklore.
- (3) In all printed publications, and in connection with any communications to the public, of any identifiable expression of folklore, its source shall be indicated in an appropriate manner, and in conformity with fair practice, by mentioning the community or place from where the expression utilized has been derived.
- (4) The right to authorize acts referred to in sub section (1) of this section shall vest in the Nigerian Copyright Commission.
- (5) For the purpose of this section, “folklore” means a group – oriented and tradition - based creation of groups or individuals reflecti ng the expectation of the community as an adequate expression of his cultural and social identity, its standards and values as transmitted orally, by imitation or by other means including –
 - (a) folklore, folk poetry, and folk riddles;
 - (b) folk songs and instrumental folk music;
 - (c) folk dances and folk plays;

- (d) productions of folk arts in particular, drawings, paintings, carvings, sculptures, pottery, terracotta, mosaic, woodwork, metalware, jewelry, handicrafts, costumes, and indigenous textiles.

29. INFRINGEMENT OF FOLKLORE

Any person who, without the consent of the Nigerian Copyright Commission, uses an expression of folklore in a manner not permitted by section 28 of this Act shall be in breach of statutory duty and be liable to the Commission in damages, injunctions and any other remedies as the court may deemed fit to award in the circumstances.

29A CRIMINAL LIABILITY IN RESPECT OF INFRINGEMENT OF FOLKLORE

- (1). Any person who –
 - (a) does any of the acts set out in section 28 of this Act without the consent or authorization of the Commission; or
 - (b) does not comply with the requirements in sub section (4) of section 28 of this Act; or
 - (c) willfully misrepresents the source of an expression of folklore;
or
 - (d) willfully distorts an expression of folklore in a manner prejudicial to the honour, dignity or cultural interest of the community in which it originates, commits an offence under this Act.
- (2) A person convicted of an offence under sub section (1) of this section is liable on conviction –
 - (a) in the case of an individual, to a fine not exceeding ^100,000.00 or to imprisonment for a term of 12 months or to both such fine and imprisonment; and
 - (b) in the case of a body corporate, to a fine of ^500,000.00.
- (3) A court before which an offence under this section is tried may order that the infringing or offending article be delivered to the Commission.

[Annex IV follows]

ANNEX IV

SECRETARIAT OF THE PACIFIC COMMUNITY

BACKGROUND

1. The Secretariat of the Pacific Community is an intergovernmental regional, technical development organization that works in partnership with its members, other organizations and donors to deliver work priority programmes to its member countries and territories. SPC work programmes aim to develop the technical, professional, scientific, research, planning and management capability of Pacific Island people and directly provide information and advice, to enable them to make informed decisions about future development and well-being.
2. The Pacific Community currently has twenty-seven members; 22 Pacific Island countries and territories: American Samoa, Cook Islands, Federated States of Micronesia (FSM), Fiji Islands, French Polynesia, Guam, Kiribati, Marshall Islands, Nauru, New Caledonia, Niue, Commonwealth of the Northern Marianas (CNMI), Palau, Papua New Guinea (PNG), Pitcairn Islands, Samoa, Solomon Islands, Tokelau, Tonga, Tuvalu, Vanuatu, and Wallis and Futuna; plus the five remaining founding countries: Australia, France, New Zealand, United Kingdom and United States of America.
3. The Legal Protection Project initiated by the Cultural Affairs Programme at the request of the Council of Pacific Arts, is aimed at promoting legislation in the Pacific Islands for the protection of Traditional Knowledge and Expressions of Culture.

PHASE 1: REGIONAL SYMPOSIUM

4. The first stage of this project consisted of the organization of a symposium entitled: *Symposium on the Protection of Traditional Knowledge and Expressions of Indigenous Cultures in the Pacific Islands*. For the first time in the region, the Symposium, jointly organized by SPC and UNESCO from the February 15 to 19, 1999, provided an opportunity to assess the level of awareness within the Pacific Island countries and territories with regards to the importance of intellectual property issues and mechanisms put in place in Pacific Island countries and territories to ensure, through legal and other means, the intangible heritage is safeguarded for future generations.
5. Although vast differences were revealed in existing levels of protection, the symposium successfully found a common definition of heritage to be protected. Existing legal systems in the region were found not to address the crucial issue of protection against improper use of Pacific Island peoples' traditional living heritage. Appeals for specific legislation were strongly voiced among common requests.

PHASE 2: DEVELOPMENT OF REGIONAL FRAMEWORK

6. In 1999, the Pacific Islands Forum Secretariat, another regional intergovernmental organisation responsible for the political, trade and economic development of Pacific Island members, was mandated by its last Trade Ministers meeting to work towards the development of national, regional, multilateral and international rules and legislation to protect the intellectual property rights of indigenous peoples for presentation to the Forum Trade Ministers.

7. This made a collaborative approach an obvious course by these three organizations, for the benefit of Pacific Island countries. Therefore SPC, UNESCO, and the Forum Secretariat jointly engaged two legal consultants, Professor Kamal Puri from the University of Queensland, Australia, and Mr. Clark Peteru from Samoa to draft a suitable regional framework for the protection of traditional knowledge and expressions of culture.

8. The consultants presented their report and the draft regional framework, comprising regional guidelines, model legislation and explanatory notes for the model legislation, at the regional SPC, ForSec, UNESCO *Workshop for Legal and Cultural Experts on the Legal Protection of Traditional Knowledge and Expressions of Culture* held at SPC Headquarters in Noumea, New Caledonia from February 26 to 28, 2001.

9. The objective of the workshop was to discuss the proposed regional framework of regional policy guidelines and model legislation to enable the consultants to further the framework at the end of the workshop.

10. The Workshop, after considering the Framework agreed: that the draft regional guidelines and draft Model Law provided a good basis for the protection of traditional knowledge and cultural expressions; that further work incorporating suggested amendments agreed to during the workshop be incorporated into the draft guidelines and Model Law; that the Framework be circulated to all members for comments and submitted to the 2001 Forum Trade Ministers and Economic Ministers Meetings'; with a recommendation that they be adopted and enacted as soon as possible. It was also agreed that: that there was a role for an existing regional body to promote the Model Law, provide assistance to countries in the region to adapt the Model Law, assist the countries in the region to further their intellectual property laws consistent with the Model Law and other international norms, and provide assistance with training, education, and awareness raising on the protection of Traditional Knowledge and Expressions of Culture. It was recommended that SPC take on this role with the assistance of the Forum Secretariat and UNESCO as appropriate.

11. The 2001 Forum Trade Ministers Meeting received the framework and requested the Forum Secretariat in cooperation with the SPC, UNESCO and the World Intellectual Property Organisation (WIPO) to continue work on the further development and application as appropriate of the regional framework at both the national and regional levels, taking into account the wider international context. The Trade Ministers also encouraged the Forum Secretariat in cooperation with the SPC, UNESCO and WIPO to assist Forum Island Countries wishing to proceed with the drafting and adoption of national legislation for the protection of traditional knowledge and cultural expressions, taking into account the work on the further development and application of the draft regional framework.

PHASE 3: FINALISATION OF MODEL LAW

12. In accordance with the wishes of member countries and territories and following the invitation by WIPO, the framework was then sent to WIPO for comment in relation to the obligations of members under existing intellectual property treaties, including the TRIPS Agreement. Following the receipt of these comments, SPC and Forum Secretariat then engaged the lead consultant to review and revise the framework taking into consideration, the work being done in WIPO.

13. In 2002, SPC and the Forum Secretariat jointly organised the *Working Group for Legal Experts on the Protection of Traditional Knowledge and Expressions of Culture*. This Working Group comprised legal experts from eight members, as well as WIPO. The June 2002 Working Group reviewed the Model Law, re-evaluated the general features of an adequate *sui generis* system for the protection of Traditional Knowledge and Expressions of Culture, and identified the elements that the system must contain in order to be effective.
14. The development of the model law has been guided by responding to a range of questions posed in the document *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. These questions include: 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?; how are the rights lost or how do they expire etc. These questions are relevant to the development of any effective legal system for the protection of property rights, and not just to the particular approach taken in this model law.
15. The policy objective of the 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. The model law also reflects the policy that it should complement and not undermine intellectual property rights.
16. The approach taken in the model law is to create new rights in traditional knowledge and expressions of culture which previously might have been regarded, for the purposes of intellectual property law, as part of the public domain. The rights created by the model law essentially fall into two categories: traditional cultural rights and moral rights. The existence of these rights do not depend upon registration or other formalities.
17. Traditional cultural rights grant traditional owners exclusive rights in respect of a range of uses of traditional knowledge and expressions of culture that are of a non-customary 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').
18. The moral rights created for traditional owners are the right of attribution, the right against false attribution and the right against derogatory treatment in respect of traditional knowledge and expressions of culture.
19. 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. If a derivative work is created, the intellectual property rights in the work vest in the creator, or as otherwise provided for by intellectual property rights. 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 the traditional owners, provide acknowledgement of the source of the traditional knowledge or expressions of culture and respect the traditional owners' moral rights.

20. The model law 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:

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

dealing directly with the traditional owners.

21. In both cases, the prior and informed consent of the traditional owners is to be evidenced by an 'authorised user agreement.' And in both cases, the Cultural Authority has a role in providing advice to traditional owners about the terms and conditions of authorised user agreements and maintaining a record of finalised authorised user agreements.

22. The model law also creates offences and civil actions for contraventions of traditional cultural rights and moral rights.

PHASE 4: ENACTMENT AND IMPLEMENTATION OF THE MODEL LAW

23. In accordance with the 2001 decision by Forum Trade Ministers, SPC and the Forum Secretariat will assist members, on request, wishing to proceed with the adaptation and enactment of national legislation for the protection of Traditional Knowledge and Expressions of Culture. The SPC and the Forum Secretariat will seek legal-technical assistance from WIPO and UNESCO as appropriate on the effective implementation of the Model Law in accordance with the SPC and Forum Secretariat, Regional Implementation Action Plan.

24. The Regional Implementation Action Plan is aimed at assisting members in the:

- enactment of legislation that will protect the rights of traditional owners and facilitate the use of traditional knowledge and expressions of culture for the benefit of traditional owners;
- development of human resources in government offices for the protection of traditional knowledge and expressions of culture;
- development of human resources in traditional owners to protect their traditional knowledge and expressions of culture; and
- enhanced public awareness in the region of the role and importance of traditional knowledge and expressions of culture.

25. At the *First Regional Meeting of Pacific Island Ministers of Culture* held at SPC headquarters (September 16 to 18, 2002) Ministers received and endorsed the model law as a basis for Pacific Island countries wishing to enact legislation for the protection of traditional knowledge and expressions of culture.

26. Recognising that the Model Law is appropriate for national protection only and given that WIPO Members at the third meeting of the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, held in Geneva on June 13 to 21, 2002, did not support the examination of possible measures for the regional and international protection of expression of folklore, SPC and the Forum Secretariat will also undertake to examine existing and future possibilities on the extra-territorial application of the Model Law.

[End of Annex IV and of document]