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COMMENTS ON

**THE REVISED DRAFT PROVISIONS FOR THE PROTECTION OF
TRADITIONAL CULTURAL EXPRESSIONS/ EXPRESSIONS OF FOLKLORE:
POLICY OBJECTIVES AND CORE PRINCIPLES**

**Submitted by the
Emerging Issues Committee –
Indigenous Peoples' Rights Subcommittee**

July 31, 2006

GENERAL COMMENTS

The International Trademark Association (INTA) appreciates that its previous comments to the WIPO secretariat on the draft policy objectives and core principles for the protection of traditional cultural expressions (TCEs) /expressions of folklore (EoF) (document WIPO/GRTKF/IC/7/3) were considered in comparing the revised draft provisions for protection of TCEs/EoF (document WIPO/GRTKF/IC/9/4) (“revised draft”). As the WIPO secretariat is aware, INTA represents the interests of trademark owners, and we have reviewed the revised draft document in this context and by reference to our previous articulated concerns. Our comments are limited in this regard and our specific comments follow. However, as a preliminary matter we make the observation that the provisions adopt and merge language from various intellectual property regimes but mainly find their precursors in copyright. This heavy reliance on copyright language creates concerns for trademark owners. The definition of TCEs/EoF includes within its ambit "words, signs, names and symbols", which are the most common material for trademarks. Most countries' trademark systems include a mechanism for managing conflicts between trademarks with a level of international uniformity. In addition, a body of associated jurisprudence has developed to address many of the issues thought to be of concern. Much of the language and principles sought to be adopted within this document are foreign to the trademark owner and generally not appropriate to the intellectual property regime whose purpose is to encourage free and fair competition within a transparent operating system.

SPECIFIC COMMENTS

1. Objective (iv): Prevent the misappropriation of traditional cultural expressions/expressions of folklore

We note inclusion of this new objective. While INTA empathises with the challenges faced by the various indigenous communities and peoples for the recognition and protection of their TCEs/EoF, INTA strongly believes that in seeking to provide indigenous peoples and traditional and other cultural communities with the legal and practical means, including enforcement

measures, to prevent misappropriation, it would be inappropriate to create a separate system which would conflict with current intellectual property regimes, and in particular trademark law. Most countries' trademark laws, to the extent that they are TRIPS compliant, provide adequate remedies within the statutory framework to prevent the registration and/or use of symbols or other marks or badges of origin if their use by the proposed registrant/user would create a likelihood of deception or confusion. Mechanisms also exist to prevent bad faith trademark registrations. Furthermore, there exists in most trademark systems an opportunity for the collective community to own and register marks to obtain the benefit of statutory protection.

To the extent that existing and tested intellectual property systems have not been fully utilized by indigenous peoples for the protection of their TCEs/EoF, it appears counter-intuitive to create a new system over which there is no experience or knowledge of operation. It would seem more appropriate for, and INTA would encourage, indigenous communities being informed about and encouraged to use existing systems.

2. Objective (xii): Preclude unauthorised IP rights

We note that the term "curtail" used in the earlier draft of the stated objectives has been replaced by the term "preclude". The use of such mandatory language is of concern to INTA, particularly with the use of the word "derivatives" in this context. The term "derivatives" has no established meaning in trademark law and in this context is ambiguous in its scope for those who create trademarks and may draw their inspiration from various sources. The apparently infinite scope of the term "derivative" is problematic, particularly when the revised draft simultaneously seeks to provide specific groups certain absolute property rights in TCEs/EoF.

If that term were adopted, a trademark owner would be required to determine what constitutes a TCE/EoF and then face with the uncertainty of the extent of protection of the infinite variations that may be legitimately considered to be "derivates". For example, if the TCE comprises common geometric shapes or combinations of such shapes, to what extent would this inhibit the legitimate use of such shapes in other contexts, solely on the basis of a claim that the shapes are derivative? Only by including an assessment of such subsequent use on the basis of "likelihood

of confusion" can the legitimate interests of all parties be properly defined and balanced. Furthermore, the terminology in relation to assessing the likelihood of deception or confusion is familiar to the trademark community, has an accepted meaning, and has been used effectively for many years to protect consumers. Similarly, there is significant experience in handling trademark applications which may have been made in bad faith.

3. Article 1: Subject Matter of Protection

It is noted in the commentary that accompanies this section that further consideration may be given to deletion of the criterion to be applied to determining what comprises a TCE/EoF (paragraph bb) on the basis that it may impose too heavy a burden of proof on communities. INTA notes that the acquisition of rights as foreshadowed by this document - that is, to be used to "preclude" other parties' activities, surely must be based on the ability to establish some objective and clearly articulated criterion. Anything less creates confusion and uncertainty and does not have the requisite level of transparency of process.

4. Article 3: Acts of Misappropriation (Scope of Protection)

We note the reference first to TCEs/EoF "which have been registered or notified as referred to in Article 7". INTA's experience with alternate registers, such as registers of well-known trademarks, has highlighted concerns of trademark owners in establishing separate recordal systems. While transparency and certainty are important, practices in the establishment of such registries need to be considered. For this reason, it is INTA's preference that in relation to indicia that may form trademark material, the established trademark registers be used for protection purposes. However, if separate registers are pursued, we urge that guidance be sought from those WIPO members who have experience with both the establishment of registers of well-known marks and the registration systems adopted by many States in relation to the protection of geographical indications.

While INTA acknowledges that different standards have been sought to be established in relation to varying levels of disclosure by indigenous people of their TCEs/EoF, we note that the revised

draft continues to seek criminal and civil sanctions in relation to such symbols which have not been notified as of significance (Article 3(b)(ii)). It seems extraordinary that such sanctions could be envisaged without adequate disclosure and establishment of rights. There are already sufficient avenues for protection for false and misleading conduct in the legal system and no need to seek to introduce additional penalties without requiring full disclosure of the rights upon which there is reliance.

Furthermore, we note with concern the continued reference to "or derivatives thereof" particularly in the context of words, signs, names and symbols. Because these are the kinds of signs that trademark owners are most likely to seek to adopt, the use of the term "derivatives" in this context without further limitation again causes uncertainty.

Article 3(b)(ii) contains a caveat – "any distortion, mutilation or other modification of, or other derogatory action" – which implies again a subjective assessment. To provide for criminal sanctions against an action for which there is no notice and appears to be indeterminate creates unnecessary uncertainty and would seemingly contravene any notion of due process.

Concern continues in relation to that material which is to be kept secret (Article 3(c)). As a matter of natural justice, it seems that no rights should be enforced against a third party who has, without malicious intent, adopted a TCE/EoF with no knowledge that it existed, as protection for it has not been sought. Having made a decision to retain certain elements as secret, to then seek enforcement over third parties using such materials in good faith puts an unfair, unnecessary and unworkable burden on intellectual property rights holders and undermines the role that such systems have within the commercial context.

While it is noted that the mechanism for identification or registration is to be left for regional determination, INTA reiterates its concerns regarding the setting up of any kind of regional system which would be seen to grant rights without taking into consideration the established intellectual property principles of territoriality, exclusivity, priority and, where applicable, notice.

5. Article 6: Term of Protection

Regarding Article 6(ii), a term of protection in relation to secret rights as long as they remain secret has no scope for certainty, and thus is clearly prejudicial to the legitimately obtained protection and enforcement of other intellectual property rights such as trademarks.

6. Article 9: Transitional Measures

We note the reference to "continuing acts" in paragraph (b). This terminology is unclear as to the scope of acts it is meant to encompass. With no linkage to Article 1, the reference begs the question whether this expands the manner of use of the TCEs/EoF, for example, in relation to a cultural expression which has become commercial, or indeed to cover the situation where in fact there is no ongoing use notwithstanding the reference back to Article 1. In short, the term "acts" is ambiguous in this context.

While the phrase "subject to respect for rights previously acquired by third parties" has been included, it is by no means certain that this phrase is intended to support the general principle of "first in time, first in right" to which INTA strongly adheres.

7. Article 10: Relationship with Intellectual Property Protection and Other Forms of Protection, Preservation and Promotion

Notwithstanding amendment, Article 10 continues to provide for special protection of TCEs/EoF via use of complementary protection mechanisms. As previously stated, INTA opposes any proposal which would seek to grant special trademark status to TCEs/EoF for the reasons previously noted.

While it is recognised in the commentary that the mechanism for identification and "registration" of a TCE/EoF is to be left for regional determination, INTA is concerned that insufficient thought has been given to the implementation mechanisms or the general principles for the protection of TCEs/EoF within such systems. Quite clearly, it is the implementation of many of

these principles which will be of concern, and careful consideration as to their implementation may avoid subsequent issues arising from vague guidelines, particularly when these may conflict with existing intellectual property systems, the users of which require certainty and consistency. While it is important to recognise and protect the TCEs/EoF of indigenous communities and people, it is not necessary to provide such protection by creating vague or over-reaching rules, or by applying a different standard for what is protectable (and the level and sanctions applicable) under the intellectual property laws of the region in question. The failure to fully consider in the preparatory phases the full impact and ramifications of such a process could ultimately undermine the original desired intent of formulating a doctrine of general protection so as to foster wider community awareness of the inherent value of indigenous heritage and associated traditional cultural expressions.