

The Trademark Reporter®

The Law Journal of the International Trademark Association



Trademarks and Human Rights: Oil and Water?
Or Chocolate and Peanut Butter?

Megan M. Carpenter

Trademarks as Fundamental Rights—Europe

Burkhart Goebel

Indigenous Trade Marks and Human Rights:
An Australian and New Zealand Perspective

Peter J. Chalk and Alexander Dunlop

Famous Marks Under the TDRA

David S. Welkowitz

Trademark Protection for Restaurant Owners:
Having Your Cake and Trademarking It, Too

Lisa K. Krizman

Amicus Brief of

The International Trademark Association in
Grupo Anderson's, S.A. de C.V.

v. Mexican Institute of Industrial Property, IMPI

The Trademark Reporter®

EDITOR'S NOTE

The Trademark Reporter is pleased to publish in this issue the articles of three panelists at the INTA Leadership Meeting in Boca Raton last November who addressed the issue of trademarks as human rights. The panelists and authors are Associate Professor Megan Carpenter of Texas Wesleyan University School of Law; Burkhardt Goebel of Lovells, LLP (Spain); and Peter J. Chalk and Alexander Dunlop, both of Blake Dawson (Australia). Their articles address their perspectives on trademarks as human rights within the United States, the European Union, and Australia/New Zealand. We believe that you will find these articles to be very thought provoking.

On January 9, 2009, INTA hosted the Academic Forum (formerly known as the Learned Professors Symposium) at the Omni San Diego Hotel in San Diego, California. *The Trademark Reporter* is pleased to publish in this issue the article of presenter Professor David S. Welkowitz of the Whittier Law School.

Cliff Browning, *Editor-in-Chief*

INDIGENOUS TRADE MARKS AND HUMAN RIGHTS: AN AUSTRALIAN AND NEW ZEALAND PERSPECTIVE

By Peter J. Chalk and Alexander Dunlop***

I. INTRODUCTION

Article 17 of the Universal Declaration of Human Rights (UDHR) provides that (1) “everyone has the right to own property alone as well as in association with others” and that (2) “no one shall be arbitrarily deprived of his property.”¹

In considering Article 17 of the UDHR, it is instructive to refer to interpretations of Article 1 of Protocol No. 1 to the European Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR),² which similarly provides for the right to possess property. It provides that “every natural or legal person is entitled to the peaceful enjoyment of his possessions.” The Grand Chamber of the European Court of Human Rights in *Anheuser-Busch v. Portugal*³ agreed with the conclusion of the Grand Chamber at first instance that Article 1 of Protocol No. 1 applies to intellectual property, such as trade marks,⁴ and went further to declare that Article 1 of Protocol No. 1 also applies to trade mark registration applications.⁵

In addition, Article 31 of the United Nations’ Declaration on the Rights of Indigenous Peoples provides that indigenous peoples “. . . have the right to maintain, control, protect and develop their

* Partner, Blake Dawson, Melbourne, Australia; member, Intellectual Property Society of Australia and New Zealand; Associate Member, International Trademark Association.

** Lawyer, Blake Dawson, Melbourne, Australia; member, Intellectual Property Society of Australia.

1. Article 17, Universal Declaration of Human Rights, G.A. Res. 217A(III), U.S. GAOR, 3d Sess., 1st plen. mtg., U.N. Doc. A/810 (Dec. 10, 1948).

2. Article 1, Protocol No. 1, European Convention for the Protection of Human Rights and Fundamental Freedoms (Nov. 4, 1950, Rome).

3. *Anheuser-Busch, Inc. v. Portugal*, Case No. 73049/01, 45 Eur. Ct. H.R. 830 (ECHR, Grand Chamber, Jan. 11, 2007).

4. *Id.* at [71].

5. *Id.* at [78].

intellectual property over such cultural heritage, traditional knowledge and traditional cultural expressions.”⁶

Some jurisdictions, such as New Zealand and Canada, restrict the public’s ability to register as trade marks any indicia (whether words or symbols) that are significant to indigenous peoples in those jurisdictions. (These restrictions are discussed in more detail below.) Indigenous rights reflect that indigenous peoples may regard the use of particular indicia (especially use for commercial purposes) as culturally inappropriate or as a misappropriation of their culture. However, where the ability to register a particular indicium is restricted for any reason, this appears to conflict with the general right to own (and apply for) intellectual property in the form of a trade mark.

It is against this background that this article considers the role of trade mark legislation in restricting the registration of indicia that are significant to indigenous peoples in the jurisdiction where that legislation operates. In making this analysis, this article highlights the perspectives in Australia and New Zealand in relation to indigenous trade marks, and will comment on some of the challenges that are met where such arrangements are put in place within the context of the fundamental human right to own property.

II. INDIGENOUS BELIEFS IN CONFLICT WITH THE TRADE MARK SYSTEM

The fundamental basis of a trade mark system—ownership—can conflict with the commonly held views of indigenous groups, whose views of ownership may differ from those most commonly held by Western cultures. Consequently, the use of indigenous indicia in commerce may be seen by indigenous communities as being a misappropriation of their culture.

As one commentator states:

The commercialisation of Indigenous culture and intellectual property has often been without respect for Indigenous cultures, without legal Indigenous control and without sharing the benefits with Indigenous communities. Indigenous cultural heritage has often been distorted and mutilated in

6. U.N. General Assembly, Declarations and Conventions Contained in General Assembly Resolutions (1946 onwards), *available at* http://www.un.org/documents/instruments/docs_en.asp#top (last visited July 28, 2009).

order to maximise commercial returns. This in turn is eroding our cultural heritage.⁷

Indigenous cultural heritage can be understood as “the intangible and tangible aspects of the whole body of cultural practices, resources and knowledge systems developed, nurtured and refined by indigenous people.”⁸ Indigenous intellectual property rights can be understood to be a right to protect that cultural heritage. Misappropriation of indigenous cultural heritage can occur in relation to musical, artistic and performing works that feature indigenous words, designs, motifs, symbols, artworks, song, stories and dances.⁹

One Australian commentator has reported “an increasing market for indigenous language words for brand names and company names and trade marks,” referring to examples of a heater manufacturer who wanted to use an Aboriginal word for “fire” as a brand name for a range of heaters, and of a computer manufacturer who wanted to use an Aboriginal clan name as its brand name.¹⁰

The conflict between indigenous intellectual property rights and the providing of a free and open trade mark regime in accordance with the UDHR raises a number of issues for consideration by trade mark lawyers.

As discussed below, two practices—restricting access to certain indicia and using labels of authenticity—have been adopted to varying extents in Australia and New Zealand, as well as in other countries. At the time of this writing, there are no legislative provisions restricting the registration of indicia of indigenous significance in Australia, and although labels of authenticity have been (and are being) used, use of labels of authenticity has been of little effect to date. This can be contrasted against the position in New Zealand, where both practices have been adopted far more extensively.

7. M. Solomon, *Indigenous People's Rights Versus Intellectual Property Rights*, in *Collective Human Rights of Pacific Peoples*, New Zealand Human Rights Commission 46, 51 (Tomas ed., 2000).

8. T. Janke, *Our Culture: Our Future*. Report on Australian Indigenous Cultural and Intellectual Property Rights xvii (1998).

9. Solomon, *supra* note 7, at 49.

10. *Id.* at 51.

III. DEPARTING FROM THE PRESUMPTION OF REGISTRABILITY

Section 33 of the *Trade Marks Act 1995* (Cth) (Australian Trade Marks Act) creates a “presumption of registrability” of a trade mark. Unless an application must be rejected because of non-compliance with the Act, an application for registration of a mark must be accepted. So in the case of indigenous cultural heritage indicia, the Australian Registrar of Trade Marks is bound to accept marks containing such indicia for registration unless there is a reason for denying registration that arises under the Act.

The starting point for determining the potential restrictions to the registration of a trade mark is to ask under what circumstances should the presumption of registrability under section 33 of the Australian Trade Marks Act be departed from, if at all?

One long-standing example involves section 42 of the Australian Trade Marks Act, which provides that registration will be refused for a word or device that is “scandalous or otherwise contrary to law.” Section 42 can be seen as an example of where the right to own property may be made subservient to a conformance with societal norms, allowing for a departure from the presumption of registrability.

Seeking more examples, one may consider the two fundamental objectives of any trade-related legislation¹¹—the protection of rights of owners and the protection of the public at large—which allows for a departure from the presumption of registrability in circumstances where protection of either type is required. The second consideration, the protection of the public at large—or “consumer protection”—appears to underlie an increasingly common departure from the presumption of registrability, and is evidenced by the refusal to register marks that are “geographic indications”—such as “champagne” for sparkling wines.

Considering the issue at hand, the question thus arises as to what justification can be given for denying registration of any particular indicia on the basis of the sensitivities of a particular cultural group.

In the context of this discussion, the goal of “protecting the public at large” extends to protecting consumers from being misled into believing that particular goods, such as popular Australian aboriginal artworks, have been produced by an indigenous person or persons, when in fact that is not the case. Creative New

11. O. Morgan, *The New Zealand Trade Marks Act—No Place for Offence* (Occasional Paper No. 2/03, Intellectual Property Research Institute of Australia, 2003).

Zealand's¹² approach is its set of TOI IHO labels of authenticity, which have been registered as trade marks in New Zealand, and which go some way to resolving passing-off type difficulties. (These labels are discussed in further detail in Part VI.B. below.)

If a label of authenticity is adopted by a particular indigenous group, it may be argued that the "consumer protection" justification for creating special provisions of trade marks legislation has been met, in which case, any additional provisions of the same legislation that restrict the ability of the public at large to register indicia of indigenous significance would appear to be justified only by a desire to protect indigenous cultural rights. If this is the case, then a number of significant questions are raised, including the extent to which such protection should be extended. For example, if trade mark protection is granted for indicia that are significant to indigenous groups, might the same protection one day be granted to large migrant populations within the same country? As will be discussed in more detail below, the Trade Marks Act 2002 (NZ) (New Zealand Trade Marks Act) provides this type of protection for any "significant" section of the community.

IV. METHODOLOGY FOR PROTECTING INDIGENOUS TRADE MARK RIGHTS

If indicia of indigenous significance are to be protected, the methodology for doing so will be of critical importance. Significantly, it is impractical for indigenous groups to seek registration of specific indicia so as to prevent others from doing so, first, because it would not be possible for all potential marks to be covered, and second, because it is generally the case (as provided in the Australian Trade Marks Act)¹³ that a trade mark can be subject to removal from the trade marks register if it is not used "in the course of trade." The defensive trade mark provisions of the Act would likely be of no avail as the basis for such indigenous applications, either, as there must be a famous mark on which the defensive applications can be based. And as is apparent, the intention behind registering indicia of indigenous significance for this purpose would be to "block" those indicia from

12. Creative New Zealand is the operating name of the New Zealand national agency for the development of the arts, the Arts Council of New Zealand Toi Aotearoa.

13. Section 17 of the *Trade Marks Act 1995* (Cth) defines *trade mark* as "a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person." Section 92 of the Act provides that a trade mark may be removed from the Register for non-use.

being used in the course of trade. It may also be that for cultural reasons, indigenous groups may not wish to use the mark “in the course of trade” themselves.

Internationally, two different methods of safeguarding indigenous culture using trade mark legislation have emerged. The first, being the restriction or prohibition of the registration of indicia of indigenous significance, helps to ensure that those indicia are not used inappropriately or offensively. The second, being the registration as trade marks of “labels of authenticity” (or alternatively, “labels of origin”), helps indigenous people to legitimately market and sell their products as being of indigenous origin.

A. Preventing Registrations of Marks of Indigenous Significance

If a trade mark system is to include an exception to registration of marks of indigenous significance, the methodology for determining what is, and what is not, significant to a particular indigenous group is crucial. (See, for example, the establishment of the Maori Trade Marks Advisory Committee in New Zealand, which is discussed in more detail in Part VI.A. below.) Relevant considerations include whether indigenous indicia can be registered at all, or whether they may be registrable in relation to certain products, but not in relation to others.

As an example of preventing registration of marks of indigenous significance, section 9 of the *Trade-marks Act 1995* (Canada) (Canadian Trade-marks Act), for example, prohibits the adoption “in connection with a business, as a trade-mark or otherwise” of any “mark consisting of, or so nearly resembling as to be likely to be mistaken for:

...

(n) any badge, crest, emblem or mark

...

(iii) adopted and used by any public authority, in Canada as an official mark for wares or services.

Indigenous groups have been granted “public authority” status for the purposes of the Canadian Trade-Marks Act, and as such can protect their use of any “badge, crest, emblem or mark” from being registered by third parties.¹⁴

14. R. Stein, *Trade Mark Protection and ICIP: How Does Australia Fare?*, Arts Law Centre of Australia (2006), available at <http://www.artslaw.com.au/artlaw/archive/2006/06/TradeMarkProtectionAndICIP.asp> (last visited July 28, 2009).

In the United States, the Lanham Act¹⁵ relevantly prohibits registration of marks that consist of or comprise “matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”

Preventing trade mark registration of indicia of indigenous significance gives rise to the question: Can registrable words be restricted to registration by the indigenous peoples for whom they have meaning, or can they be registered by non-indigenous peoples as well? This will be considered in more detail with respect to trade marks featuring the Maori *Pitau* or *Koru*, below.

The implementation of such a system requires careful consideration of the extent to which protection is desirable as well as to whom the protection should apply: How will the system treat a trade mark application where one of the words featured in the application is of indigenous significance, but where other indicia featured in the application are not?

B. Problems Associated with Existing “Inappropriate” Marks

The implementation of a system to deny registration of indicia that are found to be offensive to local indigenous peoples (as is the case in New Zealand) raises a question about the validity of marks that may already be registered, and how the system deals with those marks.

One high profile example of a controversial existing trade mark is the National Football League’s use of the mark REDSKINS for its Washington team, which has been the subject of ongoing litigation since 1992. A number of Native Americans challenged the trade mark as racially offensive. The most recent decision,¹⁶ which found in favour of Pro Football, Inc., the owner of the Washington Redskins, on a procedural point and did not address the trade marks issues on their merits, was affirmed by a United States Court of Appeals.¹⁷

Additionally, “controversial” registered trade marks that are owned by a non-indigenous person or organisation could be used to prevent an application by an indigenous group to register a particular indicium of indigenous significance. Two popular examples of such usage are the names of the Washington

15. U.S. Trademark (Lanham) Act § 2(a), 15 U.S.C. § 1052(a).

16. Pro-Football, Inc. v Suzan Shown Harjo, *et al.*, Civ. A. No. 99-1385 (CKK), Memorandum Opinion (D.D.C. June 25, 2008), *aff’d*, 565 F.3d 880 (D.C. Cir. 2009)).

17. Lawdit Solicitors, *US Football Team Wins Latest Trade Mark Battle* (July 17, 2008), http://www.lawdit.co.uk/reading_room/room/view_article.asp?name=../articles/8087-US-football-team-win-latest-in-trademark-court-battle.htm (last visited Sept. 2, 2008).

Redskins, discussed above, and of Vancouver's National Hockey League team, the Vancouver Canucks. These examples of word marks (REDSKINS and CANUCKS) and device marks (REDSKIN Logo) have the potential to raise issues where an indigenous person or group applies to register a similar mark or device. If this occurs, it is possible that an indigenous person or group would be prevented from registering its own mark because the mark is too similar to an existing mark, despite the fact that the existing mark is owned and used by a non-indigenous group, such as the Vancouver Canucks. In fact, Pro-Football Inc. is reported to have opposed an application by a Canadian company to register an "Indian head" device similar to the Redskin's Indian Head device mark.¹⁸

The issues that arise where an indigenous person or group applies to register a trade mark were recently exemplified in *In re Heeb Media LLC*,¹⁹ where the United States Patent and Trademark Office denied an application by a Jewish publisher to register the word mark HEEB on the basis that it was derogatory of the Jewish people. Unlike the Washington Redskins litigation, where indigenous peoples used the U.S. Trademark (Lanham) Act to try to remove a mark from the trade mark register (and initially succeeded in doing so before the U.S. Trademark Trial and Appeal Board (TTAB)), this case required the TTAB to apply the Lanham Act to an application filed by a member of a minority group to register a mark that the TTAB considered offensive to that group.

C. Labels of Authenticity

A measure that has been adopted to protect indigenous cultural indicia in both Australia and New Zealand is for a centralised body to register a "label of authenticity" as a trade mark, and then license the use of that mark to the producers of true indigenous works. This system then provides a method of ensuring that use of the label of authenticity can be monitored and exercised appropriately. The collective protection that is provided by using a label of authenticity is particularly apt for protecting works and products of indigenous origin, due to the collective, communal view of "ownership" that may be a tenet of particular indigenous groups.

18. Indian and Northern Affairs Canada, *Trade Marks*, http://www.ainc-inac.gc.ca/pr/ra/intpro/tms_e.html (last visited Sept. 2, 2008).

19. 89 U.S.P.Q.2d 1071, 1072 (T.T.A.B. 2008), cited in Proskauer Rose LLP's Trademark & False Advertising Practice Group, United States: Harjo's Legacy: *In re Heeb Media*, <http://www.mondaq.com/article.asp?articleid=75398> (last visited Mar. 22, 2009).

Labels of authenticity have been recognised since as early as 1958, when an igloo trade mark was registered to protect works created by the Dene, Métis and Inuvialuit peoples of Northern Canada.²⁰ The Igloo Label was the first of its type, and was closely followed by the “Silver Hand Program” in Alaska, which is administered by the Department of Indian Affairs and Northern Development and which licenses the use of the mark.

There are trade marks listed on the Canadian Trade-marks Register, such as Canadian Trade-mark No. 465836 for COWICHAN in the name of the Cowichan Band Council of British Columbia, which are registered as certification marks. The COWICHAN mark is used on Cowichan sweaters—which are hand knitted by the Cowichan people and are products for which the Cowichan people are famous—together with other clothing products. The Cowichan Band Council has also registered a certification mark for GENUINE COWICHAN APPROVED.²¹

Labels of authenticity are also of significant practical benefit when used in relation to indigenous products, such as art works. As one report states:

Consumers can approach a non-Indigenous artist (or their heirs) directly if they have any concerns about provenance and their conversation or correspondence will (almost invariably) be in English. Indigenous artists from “the bush” rarely have access to mainstream media such as newspapers and magazines that may draw their attention to provenance issues, many are illiterate and would have difficulty understanding comments made in English about their art practice and subject matter.²²

Of course, as with any trade mark, a mark used as a label of authenticity can be misappropriated and used without licence. Although this means that the use of labels of authenticity can never be guaranteed to be completely effective, the registration of the label as a trade mark can provide the registered owner (usually the body charged with administering its use) with legal redress if individuals or organisations using the mark without being licensed are discovered doing so. Furthermore, misappropriation of the label of authenticity can be made more difficult if traders or manufacturers are required to display a copy of their licence at shops where the goods bearing the label of authenticity are sold or produced.

20. Stein, *supra* note 13.

21. Indian and Northern Affairs Canada, *supra* note 17.

22. Centre for Aboriginal Economic Policy Research, Australian National University, Competition and Consumer Issues for Indigenous Australians 78 (2002).

It may also be argued that, despite the risk of the label of authenticity being misappropriated, the implementation of a licensing and registration system will encourage the use of the label of authenticity by indigenous peoples, and that such a system is an important step in providing recognition of and protection for indigenous cultures.

However, poor levels of adoption of labels of authenticity can lead to problems itself. One Australian report²³ cites anecdotal evidence that commercial art gallery operators may remove labels of authenticity from art works before exhibiting them due to a desire to avoid having an item on display that carries a number of pieces of documentation, and additionally because the presentation of art works carrying the label of authenticity alongside those that do not “might imply that unlabelled products were not authentic.”²⁴ In turn, artists who do not seek a licence for the use of labels of authenticity on their products may be regarded by consumers as lacking legitimacy. Around the time of the Sydney Olympic Games, the Australian Customs Department issued brochures to people visiting Australia that stated that indigenous style art work that did not feature the National Indigenous Arts Advocacy Association’s (NIAAA) label of authenticity was not genuine. Not only was this entirely incorrect on its face, but at the time the NIAAA labels had not yet even been printed and so could not have been placed on *any* works.²⁵ (The NIAAA label of authenticity is discussed in more detail in Part V.B. below.)

In the context of the present discussion, it is important to recognise that labels of authenticity do not themselves detract from the fundamental right to register, or to apply to register, a trade mark. In fact, registering a label of authenticity as a trade mark only has the effect of protecting the owner’s rights in relation to that particular mark, and so has no more of a restrictive effect than any other registered trade mark. Furthermore, as for any registered mark, the licensing of use of a label of authenticity is a matter solely for the owner of that mark, and not something that a trade mark system would (ordinarily) regulate.

23. *Id.* at 80.

24. *Id.*

25. *Id.*

V. AUSTRALIA—AN OUTDATED APPROACH?

A. Indigenous Trade Marks and the Australian Trade Marks Act

The Australian Trade Marks Act does not include any provisions dealing specifically with marks of indigenous significance. An application to register an indigenous indicium is currently more likely to have commercial consequences (such as consumer backlash) than any legal consequences.

To challenge the application to register an indicium of indigenous significance as a trade mark, the opposer (who need not necessarily be an indigenous person or group) would need to do so on the basis that the mark was scandalous or contrary to law, in that it was racially offensive or was being registered in bad faith. The argument that use of the mark is contrary to *indigenous* law is not enshrined in legislation in Australia, and indigenous law is not generally regarded as part of the “laws of the land” in Australia. This would make it unlikely that a mark that is in fact contrary to indigenous law would be found to be “contrary to law” for the purposes of the Australian Trade Marks Act.

To be considered “scandalous,” the mark would need to be regarded as shameful, offensive or shocking to an ordinary person. Due to the objective element of this test, it is difficult to imagine circumstances in which a mark of indigenous significance would be considered “shameful, offensive or shocking” to an ordinary person, rather than to a limited number of indigenous people or to any identifiable subsection of the community. This test should be contrasted with amendments to the New Zealand Trade Marks Act that specifically require a consideration of whether an application that features, or appears to feature, a derivative of a Maori word or image, is or is likely to be offensive to Maori. (The amendments to the New Zealand Trade Marks Act are discussed in more detail, below.)

To be contrary to law, use of the mark must contravene Australian statutory law. An opponent to registration of a mark may argue, for example, that use of an indicium of indigenous significance is contrary to the *Trade Practices Act 1974* (Cth) (and the equivalent provisions of the State and Territory *Fair Trading Acts*) on the basis that its use is misleading or deceptive.

To succeed on a ground of misleading and deceptive use, an opponent would need to establish that use of the mark by a non-indigenous person or entity was misleading in that it suggests that the person or group:

- (a) has an endorsement from, or an affiliation with, the indigenous peoples for whom the word or image had significance, where that was not the case; or
- (b) is of indigenous origin itself.

The prospects of such an opposition succeeding would depend on whether consumers would be likely to be aware that the mark in question had an indigenous derivation and therefore likely make a connection between the person or company and the indigenous group from which the mark was derived. It seems unlikely that an opponent would succeed on this ground.

As a consequence, the Australian Trade Marks Act cannot be seen to pose any real restriction upon the registration of particular indigenous indicia by non-indigenous people (or even indigenous people themselves), save for the requirement that a trade mark registration must not be “scandalous or otherwise contrary to law.” In this sense, it is difficult to argue that an applicant’s right to apply for registration of and own a trade mark is restricted by virtue of deference to the beliefs or feelings of Australian Aboriginal people, aside from the general provisions of section 42 of the Australian Trade Marks Act that provides for a departure from the rights of an applicant for the purpose of conformance with societal norms.

The lack of specific legislation dealing with the use and registration of indicia of indigenous significance in Australia can be contrasted with a number of other countries, including New Zealand, the United States, and Canada. When comparing the treatment of “indigenous trade marks” by the United States and Canada, one commentator has stated that “although these legal regimes faced similar requirements relative to indigenous populations, they have responded quite differently.”²⁶

Whether the Australian Trade Marks Act will be amended to better protect indicia of indigenous significance remains to be seen. Australia, and, most interestingly, Canada, New Zealand and the United States, were the only four countries to vote against the United Nations’ adoption of the Declaration on the Rights of Indigenous Peoples. In voting against the proposal to adopt the Declaration, Australia’s Ambassador and Permanent Representative to the United Nations, the Hon. Robert Hill, was reported to have said that Australia “did not support the inclusion of intellectual property rights for indigenous peoples.”²⁷

However, Australia has since had a change of federal government that may result in a change in government policy towards indigenous Australians, and most notably through the government issuing an apology to the Australian Aborigines who

26. R. Grad, *Indigenous Rights and Intellectual Property Law: A Comparison of the United States and Australia*, 13 *Duke J. Comp. & Int’l L.* 203, 205 (2003).

27. Declaration on the Rights of Indigenous Peoples, United Nations General Assembly, Sept. 13, 2007. Explanation of the vote by the Hon. Robert Hill, Ambassador and Permanent Representative of Australia to the United Nations.

were forcibly removed from their parents as children. Whether the government's change in policy will effect change in policy in relation to indigenous intellectual property rights remains to be seen.

B. Labels of Authenticity in Australia

Part 16 of the Australian Trade Marks Act provides for the registration of "certification trade marks," which are used (or intended to be used) to distinguish goods or services in relation to "quality, accuracy or some other characteristic, including (in the case of goods) origin, material or mode of manufacture."²⁸ The certification trade mark provisions of the Australian Trade Marks Act can thus be used by indigenous groups to register "labels of authenticity," although labels of authenticity have not been as popular in Australia as they have been in New Zealand.

The NIAAA established a label of authenticity in 1999 that it administered, and that included registering an authenticity mark and a collaboration mark. In doing so, the NIAAA put into practice a process that became moot in 1982, almost 20 years beforehand.²⁹

However, the NIAAA is no longer in operation, and its label of authenticity was criticised for being poorly promoted and administered. The series registrations for the NIAAA label of authenticity were due for renewal on September 8, 2008. However, with the NIAAA no longer operational, the marks were not renewed before the expiration of the renewal "grace period" on March 28, 2009. Consequently, they were removed from the Register of Trade Marks on April 9, 2009.³⁰

Poor levels of adoption of the NIAAA's labels of authenticity were also attributed to the cost and administrative complexity of receiving accreditation to use these marks,³¹ and to "a degree of antipathy on the part of many artists, especially those from remote regions, to the requirement to provide proof of Aboriginality."³² Poor management was also a complaint—the initial release of the labels of authenticity was at least six months behind schedule.³³

28. *Trade Marks Act 1995* (Cth) sec. 169.

29. K. Wells, *The Development of an Authenticity Trade Mark for Indigenous Artists*, 21/1 *Alternative L.J.* 38.

30. Australian Registration Nos. 772563, 772564 and 772565.

31. Centre for Aboriginal Economic Policy Research, Australian National University, *supra* note 21, at 79.

32. *Id.*

33. J. Sexton, *Signs Say Label Has Late Message*, *The Australian* (Sydney), June 5, 2000, at 14.

When criticising the “administrative complexity” involved in receiving accreditation to use the NIAAA’s mark, it is important to observe that registration of certification marks in Australia requires that the certification mark be used only in accordance with the rules governing its use.³⁴ Section 173 of the Australian Trade Marks Act requires that rules governing the use of the certification mark must be filed by the applicant for registration of the mark, and it sets out the type of certification requirements those rules must specify. The rules are then considered by the Australian Competition and Consumer Commission (ACCC), which must approve the rules before the certification mark can be granted.³⁵ Although the authors accept that rules for the use of certification marks are important and necessary, they submit that those rules have the potential to hinder the registration and use of labels of authenticity by indigenous Australians.

Despite the initial fanfare surrounding the implementation of the labels of authenticity scheme, by mid-2000, the NIAAA’s Executive Director admitted that more than 75 percent of the applications that had been received were rejected for insufficient documentation of the applicants’ Aboriginality.³⁶

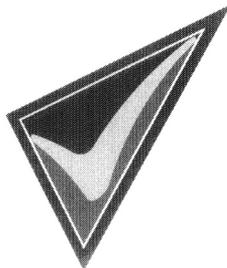


Figure 1: NIAAA Label of Authenticity

It has been suggested that a “regional” approach to labels of authenticity may be more appropriate in Australia.³⁷ This method may be preferable to a centralised label of authenticity, as was administered by the NIAAA, because in the Australian Aboriginal community, responsibility for items of cultural heritage is often handled locally. A regional approach to authenticity labelling

34. *Trade Marks Act 1995* (Cth) sec. 171.

35. *Id.* sec. 175.

36. *Id.*

37. M. Rimmer, *Australian Icons: Authenticity Marks and Identity Politics*, 3 *Indigenous L.J.* 140, 178 (2004).

would also overcome another criticism, that it did not take into account region-specific artistic styles. In doing so, it overlooked the fact that a more “popular” regional style could potentially be misappropriated by artists from another region of Australia, but nonetheless be considered authentic if works produced by those artists were adorned by the NIAAA label. For example, popular “dot work” paintings by New South Wales artists were deemed to be authentic, despite the fact that the “dot work” style was traditionally produced by Aboriginals in Central Australia.³⁸ In fact, “it is quite possible for an indigenous artist to produce an item that is not authentic.”³⁹

One example of a more regional approach to labels of authenticity that has been more successful than the NIAAA mark is the DESART Device,⁴⁰ which is used on original indigenous artistic works as well as licensed works. The DESART Device is available for use by artists from community art centres that are members of Desart, and who co-ordinate the use of the mark.

Community art centres are commonly located in remote parts of Australia, and their membership is made up of artists within the local community. As such, the art centres have “no analogue in the mainstream arts industry; they have been structured in such a way as to meet the particular needs of Indigenous artists.”⁴¹

The approach taken by Desart is different from the one taken by NIAAA. While the NIAAA had focussed on the identity of the producer of the goods in question, Desart “aims to ensure that ‘the provenance of a work, the materials used and the returns to artists are correctly documented, and that the use of standard and equitable contracts between artists and retailers is encouraged.’”⁴²



Figure 2: DESART Device

38. D. Jopson, *Aboriginal Seal of Approval Loses Its Seal of Approval*, Sydney Morning Herald (Sydney), Dec. 14, 2002, at 78.

39. J. Altman *et al.*, *Some Competition and Consumer Issues in the Indigenous Visual Arts Industry* 17 (Technical Report Discussion Paper No. 235, Centre for Aboriginal Economic Policy Research, Australian National University, 2002), *cited in* Rimmer, *supra* note 36, and Sexton, *supra* note 32.

40. Australian Registration No. 783368.

41. Centre for Aboriginal Economic Policy Research, Australian National University, *supra* note 21, at 70.

42. *Id.* at 79.

VI. NEW ZEALAND

A. Indigenous Trade Marks and the New Zealand Trade Marks Act

One of the stated purposes of the New Zealand Trade Marks Act is to “address Maori concerns relating to the registration of trade marks that contain a Maori sign, including imagery and text.”⁴³ Maori are the main indigenous group in New Zealand.

The New Zealand Trade Marks Act provides for the establishment of an advisory committee, known as the Maori Trade Marks Advisory Committee (Advisory Committee), 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 text and imagery, is, or is likely to be, offensive to Maori.”⁴⁴ Importantly, the Intellectual Property Office of New Zealand’s (IPONZ) Practice Guidelines state that “the fact that a word, of any other language, is recognised as a Maori word in New Zealand, will mean that it will be treated as such.”⁴⁵ As an example, the Practice Guidelines include the Japanese word *amaru*, which in Japanese means “to remain, to be left over, to be in excess.” In Maori, however, *amaru* means “dignified,” and it is treated as such for the purposes of the New Zealand Trade Marks Act. The Practice Guidelines also state that the same applies to imagery.

The Act also grants the Advisory Committee broad powers of self determination: section 180 of the Act provides that, subject to any direction from the Commissioner, the Committee may regulate its own procedure. This part of the Act was added after Maori had expressed concerns that the precursor to the Act (the Trade Marks Act 1953 (NZ)) “did not adequately protect Maori cultural and intellectual property.”⁴⁶

Trade mark registration applications that are identified as including Maori indicia, or are derived from Maori indicia, will have the trade mark “type descriptor” “Maori” added to the application. A recent search of the IPONZ trade marks database revealed almost 5,000 marks designated by the type descriptor “Maori.”⁴⁷

43. Trade Marks Act 2002 (NZ), sec. 3(c).

44. *Id.* sec. 178.

45. Intellectual Property Office of New Zealand, “Practice Guidelines: Sections 177-180 of the Trade Marks Act 2002” (2003), sec. 3.

46. *Id.*

47. Search conducted on Aug. 10, 2008.

The advisory committee is given its powers by section 17(1)(c) of the Act, which provides for a prohibition of the registration of marks “the use or registration of which would, in the opinion of the Commissioner, be likely to offend a significant section of the community, including Maori.” Importantly, although section 17(1)(c) specifically references Maori and section 178 establishes a Committee specifically for the purpose of considering marks that may be offensive to Maori, the wording of section 17(1)(c) allows the Commissioner to refuse to register a trade mark that would (in the Commissioner’s opinion) offend “a significant section of the community.” This gives the operation of section 17 a broader scope than just the indigenous population. As the New Zealand Parliament’s Commerce Committee noted, the wording of section 17(1)(c) “allows for changes in New Zealand’s social and demographic patterns, and shifts in the mix and ‘significance’ of identifiable groups, values and beliefs to be recognised over time.”⁴⁸

As stated in the IPONZ Practice Guidelines, “Maori attribute spiritual and cultural significance to certain words, images and locations.”⁴⁹ Use of those indicia may be regarded as offensive. So too can the association of Maori words or imagery with “common” products, such as food or cigarettes.⁵⁰ Consequently, the Advisory Committee will consider not only the word or image in question, but also the goods or services to which it is to be applied.

This test replaced the “scandalous matter” and “contrary to law or morality” tests that had previously existed in the New Zealand Trade Marks Act, and which, as is the case in Australia, were subject to criticism on the grounds that there was no legislative guidance as to their meaning. That said, the New Zealand Trade Marks Act, as amended, does not define “offend”—indeed, in many respects the concept of “offensive” is equally as subjective as the concept of “scandalous.”

This gives rise to the question of how the decision is made by the Advisory Committee as to whether a mark “is, or is likely to be, offensive to Maori.” Aside from any direction the Commissioner may give, the Advisory Committee is able to regulate its own procedure, how the Advisory Committee comes to conclude whether or not an application featuring a word or symbol that “is, or appears to be a derivative of a Maori sign,” “is, or is likely to be,

48. Commerce Committee, “Trade Marks Bill: New Zealand Parliament Comment on Trade Marks Bill” (Mar. 1, 2002), *cited in* Rimmer, *supra* note 36, at 168.

49. Intellectual Property Office of New Zealand, “Practice Guidelines: Section 17 of the Trade Marks Act 2002” (2003), sec. 4.2.

50. *Id.*

offensive to Maori” may well determine whether the application is successful or not.

Section 45 of the New Zealand Trade Marks Act provides an applicant with the power to request that the Commissioner state in writing the grounds upon which its application has been rejected. This gives rise to the question, if the Commissioner has made a decision based on the recommendation of the Advisory Committee, is the Commissioner required to state the grounds upon which *the Advisory Committee* came to its decision? An important point to note when considering this question, and the function and utility of the Advisory Committee, generally, is that:

The advice of the Committee is not binding on the Commissioner. The Commissioner will consider the advice taking into account all relevant factors affecting registrability and may come to a determination on the eligibility of an application that is different to the advice received from the Committee.⁵¹

Additionally, by framing the test by reference to what is, or is likely to be, offensive to Maori, one is entitled to ask the questions: “Which Maori?” Is it possible that a particular work or symbol may offend some Maori sub-groups, but not others? Or should section 178 be read by reference to “any Maori”?

Framing the test in this way underscores the importance of ensuring that the make-up of the Advisory Committee reflects a broad representation of the Maori community. Although acting on the advice of a committee constituted by people from an indigenous group may be preferable to not having a specific group to refer to at all (as is the case in Australia), it is submitted that unless an Advisory Committee is drawn from a broad cross-section of an indigenous community (and therefore is regarded as appropriately representative of an indigenous community), the purpose of establishing such a committee could be undermined.

However, the New Zealand Trade Marks Act only provides that in appointing a member of the Advisory Committee, the Commissioner must have formed the opinion that “the person is qualified for appointment, having regard to that person’s knowledge of *te o Maori* (Maori worldview) and *tikanga Maori* (Maori protocol and culture).” The Act is silent, however, as to how the Commissioner is supposed to come to this conclusion. Additionally, section 179(1) of the Act provides the Commissioner with absolute discretion to appoint or discharge a member of the Advisory Committee. This, of course, leaves open the possibility that instead of the Commissioner acting on the advice of the

51. Intellectual Property Office of New Zealand, *supra* note 44, sec. 2.

Advisory Committee (something which, in any event, the Commissioner has the *discretion* to do), it may be the Advisory Committee that acts at the behest of the Commissioner.

Although little information regarding the Advisory Committee's operation is publicly available, the Committee's Annual Report for the year ending June 2004 states that between August 20, 2003, and May 11, 2004, the Committee assessed 333 trade marks identified by the Commissioner that contained Maori text and/or imagery, and it considered that eight of those "needed more information or were likely to be offensive."⁵² The Act also provides that an applicant for registration of a mark that a Commissioner objects to on the advice of the Advisory Committee will be sent a "compliance report" detailing the reasons for the objection and inviting the applicant to respond. However, it is unclear how an objection of this nature can be overcome in practice.

Another issue, which involves the registration of indicia of indigenous significance, may arise when different indigenous groups in the same country disagree about the registration of a particular word. This has occurred on at least one occasion in Canada, where an application by the Toonoonik Sahooinik Co-operative to register NUNAVUT OUR LAND was opposed by the Baffin Regional Inuit Association. The Government of Nunavut (a territory in Canada to the north and west of Hudson Bay) had applied to protect the words "Nunavut, Our Land" as a prohibited mark in 2001.⁵³

1. Is Use by Non-Maori Likely to Be Offensive?

The IPONZ Practice Guidelines were amended in December 2006 after the Advisory Committee had reported that it had reviewed a large number of trade mark registration applications incorporating a *koru* or *pitau* device.⁵⁴ The *pitau* is often featured in Maori carvings, scroll painting and tattooing—although rarely in a "singular" form, as it is often depicted "in more complex patterns made from reflections, repetitions and rotations" of its single form.⁵⁵ The *koru* has been used increasingly by non-Maori

52. Maori Trade Marks Advisory Committee, "Annual Report for the year ending June 2004" (2004), available at: <http://www.iponz.govt.nz> (last visited Aug. 24, 2008).

53. Canadian Trade-mark Application No. 0913040.

54. Maori Trade Marks Advisory Committee, "Practice Guidelines Amendment 2006/11" (2006), Intellectual Property Office of New Zealand Newsletter, available at <http://www.iponz.govt.nz/cms/trade-marks/practice-guidelines-index/practice-guidelines/16-maori-advisory-committee-maori-trade-marks/6-annexure/6-3-pitau-koru>.

55. *Id.*

designers and artists “since the late 1920s”⁵⁶ and, it has been suggested, “increasingly over the past two decades by tourist operators, by corporations, and by government, in an attempt to portray the divergent ethnic make-up” of New Zealand.⁵⁷ A well-known example of a *pitau* device is that used by Air New Zealand, pictured below.



Figure 3: New Zealand Registered
Trade Mark No. 105486

The proposal to amend the Practice Guideline is instructive in that it discusses when use of the pitau might be offensive for the purposes of section 17(1) (c) of the New Zealand Trade Marks Act. The proposal recognises that the use of the *pitau* device by non-Maori may not necessarily be appropriate, but states that this is no matter for the Advisory Committee, because

the threshold of “offensiveness” under the Trade Marks Act 2002 is much higher than that of ‘appropriateness’, and the cultural origins of designers and applicants are not part of the assessment process.⁵⁸

This demonstrates that the Advisory Committee will not consider an application featuring Maori words or symbols to be offensive solely because the application has been made by non-Maori. However, because the *koru* is interpreted as a Maori symbol of “natural generation, growth and nurturing, product or design associations that are at odds with this interpretation may be deemed to be offensive or likely to offend.”⁵⁹

2. Geographical Locations

The Advisory Committee has also informed the Commissioner that it will not *prima facie* consider an application featuring a word that is a geographical location in New Zealand to be offensive. Consequently, the Practice Guidelines stated that marks

56. P. Shand, *Scenes from the Colonial Catwalk: Cultural Appropriation, Intellectual Property Rights, and Fashion*, 3 *Cultural Analysis* 47, 50 (2002).

57. *Id.*

58. *Id.*

59. *Id.*

featuring a geographical location will not be forwarded to the Advisory Committee unless the mark contains:

- (a) an Atua (god/god-like) or Tupuna (ancestral) name/image;
- (b) an association with wahi tapu—a place sacred to Maori in the traditional, spiritual, religious, ritual or mythological sense;
- (c) a word that may be regarded by whanau (extended family) / hapu (a section of a tribe) / iwi (tribe) as having mana (prestige or power); or
- (d) other Maori text and/or imagery.⁶⁰

3. The New Zealand Trade Marks Act and the UDHR

Consequently, it appears that in the context of the fundamental right to own a trade mark pursuant to the Universal Declaration of Human Rights (UDHR), section 17(1)(c) of the New Zealand Trade Marks Act does not, in practice, limit the ability to register particular indicia to a particular section of the population (i.e., Maori, or more broadly, a “significant section of the community”). Instead, the section ensures that “inappropriate” registration of words or symbols (and in particular, but not only, Maori words or symbols) will not be allowed, regardless of the heritage of the applicant. In this sense, the practical effect of section 17(1)(c) only differs from section 42 of the Australian Trade Marks Act, and the similarly worded section of the Trade Marks Act 1953 (NZ), which it replaced, in that it ensures that Maori views are taken into account when considering what is appropriate and inappropriate for registration as a trade mark. It is submitted that the Australian Trade Marks Act would be well served by a similar amendment.

B. Labels of Authenticity in New Zealand

Like the Australian Trade Marks Act, the New Zealand Trade Marks Act provides for the use of certification marks, which distinguish goods “in respect of original, material, mode of manufacture, quality, accuracy or other characteristics.”⁶¹ The provisions of the New Zealand Trade Marks Act governing certification marks are similar to those in the Australian Trade Marks Act, although importantly, it is the Commissioner of Trade

60. Intellectual Property Office of New Zealand, *supra* note 44, sec. 6.2.

61. Trade Marks Act 2002 (NZ) sec. 5.

Marks (rather than a regulatory body such as Australia's ACCC) that must approve the regulations governing use of the mark.⁶²

A system for utilising a label of authenticity, known as the TOI IHO label, has been more successful and widespread in New Zealand than in Australia. The words "Toi" and "Iho" each have a number of meanings in the Maori language, but when used together they refer to the "essence of the Maori art culture."⁶³

The Arts Council of New Zealand Toi Aotearoa (also known as Creative New Zealand), the overseer of intellectual property rights in New Zealand, has created a detailed structure for usage of the TOI IHO marks in New Zealand. The "Maori Made" TOI IHO mark is accompanied by two "companion marks"—the "mainly Maori" mark and the "The Maori Co-production" mark. Artists, or groups of artists, are able to apply for a licence to use the mark for a period of one year.



Figure 4: TOI IHO Trade Mark



Figure 5: "Mainly Maori" TOI IHO Companion Mark

62. Trade Marks Act 2002 (NZ) sec. 55.

63. *Arts News: Toi Iho Maori Made Mark and Its Companion Marks Launched in Auckland Tonight*, Creative New Zealand, Feb. 8, 2002, <http://www.creativenz.govt.nz/node/2414> (last visited Sept. 2, 2008).



Figure 6: “Maori Co-production” TOI IHO
Companion Mark

The TOI IHO “Maori Made” mark is available for licensed use by individuals or groups of Maori descent. Similarly, the “Mainly Maori” mark is, as the name suggests, for use by groups consisting of people “mostly” of Maori descent. As a guideline, the Toi Iho website suggests that “groups should comprise at least 80% Maori membership.”⁶⁴ Additionally, the “Maori Co-production” mark can be used by Maori artists who create works in collaboration with non-Maori artists or entities. A fourth mark, indicating that the user of the mark is a licensed stockist of Maori material, can be used by retailers or gallery owners who stock the works of at least six Maori artists. Those individuals or organisations must also apply to use the TOI IHO Licensed Stockist mark.

Creative New Zealand publishes detailed rules that govern usage of each of the TOI IHO marks. The rules are largely similar for each mark, and so for the purposes of this article, reference will be made to the Rules Governing the Use by Artists of the TOI IHO Maori Made Mark (the Rules). The Rules provide for the establishment of a Panel that “shall have the principal function of advising Creative New Zealand on all artistic matters relating to the grant, supervision, suspension, amendment and revocation of Licences.”⁶⁵ The Rules also provide that the Panel shall consist of more than five people who Creative New Zealand “considers have specialist knowledge of Maori artforms [sic],”⁶⁶ but which shall have no upper limit.⁶⁷ Creative New Zealand can provide the Panel with written directions as to its procedures, but in the absence of any such direction, the Panel may regulate its own procedures.⁶⁸

64. Arts Council of New Zealand, <http://www.toiio.com/Apply/Guidelines/tabid/272/Default.aspx> (last visited Aug. 24, 2008).

65. *Rules Governing the Use by the Artists of the TOI IHO Maori Made Mark*, Rule 2.1, Arts Council of New Zealand.

66. *Id.* Rule 2.2(b).

67. *Id.* Rule 2.3.

68. *Id.* Rule 2.4.

Vesting control over the TOI IHO mark to Creative New Zealand may be one reason why, compared to the NIAAA's mark in Australia, the TOI IHO mark "has been a successful venture in both material and symbolic forms."⁶⁹ The Australia Council's review of the NIAAA was critical of the instability of the NIAAA's governance:

A common issue that was raised by NIAAA's governance was the frequent occurrence of what a number of people described as "palace coups." It was reported that there had been several instances where there had been acrimonious and major changes of Board members.⁷⁰

In contrast, "the New Zealand government allocated funds to a government agency with a clear mandate to develop a comprehensive and workable scheme."⁷¹ Furthermore, the TOI IHO mark has been complimented by legislative reforms to the New Zealand Trade Marks Act, which have no equivalent in Australia. (These reforms are considered in more detail, below.)

1. TOI IHO—Requirement for "Quality"

In addition to the TOI IHO mark being used on works to authenticate them as having been made by a person (or people) of Maori descent, the Rules include a second "purpose" behind the creation of the mark that is worthy of note: to "provide a mark of quality."⁷² In fact, Rule 3.1(b) provides that not only must the work of an applicant for a licence to use the TOI IHO mark be "distinguishable as a work of Maori art or craft,"⁷³ it must also be a "work of quality."⁷⁴ The surrounding wording of Rule 3.1(b) makes it clear that this determination will be made by the Panel. Furthermore, Rule 5 provides the circumstances in which the mark may be used, which includes a requirement that the mark is only used "in connection with . . . a Work of quality."⁷⁵ Creative New Zealand may revoke a licence for a breach of the Rules,⁷⁶ including presumably, a breach of Rule 5.3(c).

69. Rimmer, *supra* note 36, at 167.

70. Australia Council, Final Report of the Review of the National Indigenous Arts Advocacy Association (Sydney: The Australia Council, December 2002), *cited in* Rimmer, *supra* note 36, at 161.

71. Rimmer, *supra* note 36, at 167.

72. Arts Council of New Zealand, *supra* note 63, at 2.

73. *Id.* Rule 3.1(b)(i).

74. *Id.* Rule 3.1(b)(ii).

75. *Id.* Rule 5.3(c).

76. *Id.* Rule 7.1.

Although an attempt to ensure that the mark is used only on works “of quality” is understandable from a quality control perspective, particularly where the works in question may be distributed to a global audience and act as a symbol of Maori cultural heritage, it is submitted that this requirement moves the mark away from its purpose of serving as a label of authenticity, and towards a “label of quality artistic works produced by Maori artists.” Indeed, “this qualitative assessment factor [was] one of the most controversial aspects of the consultative meetings that Te Waka Toi [the Maori Arts Board of Creative New Zealand] engaged in to promote the idea of the Maori Made Mark.”⁷⁷

What will constitute a work of “quality”—or perhaps more importantly, what will *not* be considered to be a work of “quality”—is undefined, and will presumably be decided by the Panel based on the views of the Panel members. Although it may be assumed that the Panel members will be the persons best placed to make such a determination, one may ask whether the determination is necessary in the first place. Furthermore, the inherently subjective nature of determining what constitutes a work of “quality” means that use of the TOI IHO mark is inconsistent with the use of other “quality” type marks. The International Woolmark, for example, is used to indicate that a product bearing that mark is made of 100% wool, and so is a “mark descriptive of material characteristics,”⁷⁸ rather than being indicative of a subjectively determined feature of the product bearing the mark, such as “quality.”

By including this requirement in the Rules, the Maori artist whose work is not deemed to be a work of “quality” will be unable to affix the mark to the artist’s work, which may, if the mark is being used prominently by other Maori artists, cause the public to question the authenticity of the particular work. It is suggested that the TOI IHO mark operate strictly as a label of authenticity, rather than as a mark of quality, and that determinations of quality should be left to the market. This view is not necessarily shared by those who have previously considered this topic,⁷⁹ and in fact it has been suggested that a “quality” requirement is what was missing from the NIAAA’s label of authenticity in Australia, which, it has been argued

was flawed in its initial conception because it was too narrowly focused on regulating art and craft products for the

77. Shand, *supra* note 55, at 78.

78. *Id.* at 79.

79. D. Zografos, *Legal Protection of Traditional Cultural Expressions in East and Southeast Asia: Unexplored Territory?*, 18 Australian Intell. Prop. J. 167, 177 (2007).

tourist market. There was no oversight of the quality of the products that were seeking accreditation.⁸⁰

VII. CONCLUSION

The differing positions in Australia and New Zealand in relation to protection of indigenous words and images from inappropriate trade mark registration, and the use of labels of authenticity in those countries, is quite apparent. However, despite the differences in approach, in the context of the fundamental right to own, or apply for registration of, trade marks, it is submitted that the position in the two countries are in many respects the same.

In Australia, it appears that the use of indicia that would be offensive to Aboriginal Australians is no more restricted than the use of words or symbols that would be offensive to any group in Australia, owing to the broad-brush approach of section 42 of the Australian Trade Marks Act. If anything, the protection offered to Aboriginal Australians by the Australian Trade Marks Act is less than that offered to the rest of the Australian community, owing to the requirement that to be considered “scandalous” for the purposes of section 42, the mark would need to be considered shameful, offensive or shocking to an “ordinary person”—meaning a reference to a person in the general community, not a specific indigenous community.

In contrast, the New Zealand Trade Marks Act includes a prohibition against the use or registration of indicia that would “be likely to offend a significant section of the community, including Maori.” However, the Advisory Committee has indicated that it will not consider an application featuring Maori words or symbols to be offensive solely because the application has been made by a non-Maori. This approach, it is submitted, means that in practice, an individual’s ability to register a trade mark featuring Maori indicia is no more restricted than their ability to register an indicium that has a meaning in English. In effect, the New Zealand Trade Marks Act simply ensures that the view of indigenous groups (particularly New Zealand Maori) is taken into account, compared to the Australian Trade Marks Act, which has been interpreted by reference merely to “the ordinary person.”

As for labels of authenticity, restriction on who can use those marks (for example the TOI IHO mark in New Zealand) is not to be mistaken for a departure or detraction from the fundamental human right to register a trade mark. In the case of a registered

80. Rimmer, *supra* note 36, at 178.

trade mark that is used as a label of authenticity, as for any trade mark, only the owner, or permitted licensees of the owner, can use that mark. However, it is not for the trade mark system to regulate the extent to which an owner of a trade mark makes use of that mark, rather that is something for the registered owner to determine.

Consequently, it is submitted that indigenous trade mark rights can be protected through incorporation into trade mark legislation without restricting the fundamental human right to own property. In situations where trade mark legislation includes provisions on indigenous trade mark rights, how those provisions are applied within the jurisdiction in question will be of critical importance.

In light of the questions raised above in relation to the New Zealand Trade Marks Act, it will be interesting to observe any future amendments to the Australian Trade Marks Act, should such amendments occur, and to review how any such amendments compare to the New Zealand legislation. Meanwhile, the provisions of the New Zealand Trade Marks Act, and the New Zealand Trade Marks Advisory Committee, are still relatively new, and so the evolution of both in the future will be interesting to observe.
