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# Re-imagining the Wheel: Seeking a Feasible International Regime to Protect Indigenous Cultural Expressions Through Trademark Law

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# Re-imagining the Wheel: Seeking a Feasible International Regime to Protect Indigenous Cultural Expressions Through Trademark Law

Jimmy Pak\*

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## I. INTRODUCTION

Toucan Sam, once a beloved children's cereal icon, is now entangled in controversy.<sup>1</sup> The Kellogg Company filed legal action against a Mayan non-profit organization for use of a toucan as part of their logo, resembling Kellogg's famous Toucan Sam.<sup>2</sup> In defense of their mark, the Mayan non-profit organization launched their own investigation of Kellogg's claims, revealing usage of derogatory Mayan stereotypes in other Kellogg products.<sup>3</sup> Kellogg immediately removed the product from their website and is currently in talks with the non-profit to allow the usage of the toucan trademark for fundraising purposes.<sup>4</sup> This is just one recent example of how large corporations abuse their ownership and legal sophistication to trump the rights of indigenous peoples within the strict confines of sovereign countries' intellectual property laws.<sup>5</sup> In the rush of globalization and the technological advancement of the twenty-first century, international institutions struggle to maintain the cultural property rights of indigenous cultures.<sup>6</sup> Protecting indigenous cultures has developed into a condescending exercise of balancing the preservation of traditional cultural expressions with the ethical treatment of indigenous peoples.<sup>7</sup> As corporations continue to pirate traditional cultural expressions, the international community attempts to balance the altruistic goal of protecting indigenous cultures while simultaneously maintaining global economic policies.<sup>8</sup>

Although indigenous cultures have freely shared their knowledge in the past,<sup>9</sup> the continuing abuses and profiteering have made some indigenous cultures wary of outside influence.<sup>10</sup> Western ideals of private intellectual property ("IP") ownership also conflict with indigenous views of community ownership,<sup>11</sup> which corporations can easily manipulate using Western-centric ownership doctrines.<sup>12</sup>

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1. Adrian Carrasquillo, *Toucan Smackdown: Kellogg vs. Maya Archaeology Initiative in Logo Controversy*, FOX NEWS LATINO (Sept. 2, 2011), <http://latino.foxnews.com/latino/lifestyle/2011/09/02/toucan-smackdown-kelloggs-vs-maya-archaeology-initiative-in-logo-controversy/?test=faces>.

2. *Id.*

3. *Id.* These derogatory images of Mayans included a board game where the only person of color was the "witch-doctor," or main villain, of the game.

4. *Id.*

5. Dep't of Econ. & Soc. Affairs, Div. for Soc. Policy & Dev., Secretariat of the Permanent Forum on Indigenous Issues, *State of the World's Indigenous Peoples*, 69-70, ST/ESA/328 (2009) [hereinafter *Indigenous Status*].

6. *Id.*

7. Paul Kuruk, *The Role of Customary Law Under Sui Generis Frameworks of Intellectual Property Rights in Traditional and Indigenous Knowledge*, 17 IND. INT'L & COMP. L. REV. 67, 83 n.103 (2007) (citing specific examples of "traditional knowledge" as defined under the WIPO, including "expression of folklore").

8. *Indigenous Status*, *supra* note 5, at 76.

9. *Id.* at 69-70.

10. *Id.*

11. *Id.* at 74.

12. *See id.*

Recognizing this growing problem, the international community is currently seeking reconciliation between Western IP regimes and indigenous cultures' sense of communal ownership.<sup>13</sup> However, no current international trademark IP law adequately responds to these issues.<sup>14</sup> While international IP regimes have sought legal respite for indigenous cultures for over a decade, reform is being stifled by bureaucracy and debate.<sup>15</sup>

A number of individual countries have carefully considered the problem of exploiting indigenous cultures, each country taking varied steps to combat the abuse.<sup>16</sup> New Zealand recently took steps to protect the culturally significant trademarks of the native Maori Peoples.<sup>17</sup> Canada has a number of restrictions to prevent the application of trademarks that have significance to an indigenous community.<sup>18</sup> The United States provides some measure of protection by disallowing the registration of any trademark that "disparages" a certain group or culture.<sup>19</sup> However, the practicality problem arises when these individual state protections clash with any international indigenous protection regime. This Comment analyzes global trademark regimes along with international treaties, and compares them with individual countries' efforts to protect traditional cultural expressions.<sup>20</sup> This Comment emphasizes the potential role that traditional trademark law can play in the protection of indigenous cultures. Existing theoretical efforts and dispute resolution approaches for the misappropriation of indigenous culture will also be examined. While individual states attempt to grant some legal procedures to protect indigenous cultures,<sup>21</sup> these efforts fail to address the problem of global exploitation of indigenous cultures.<sup>22</sup> Moreover, current international efforts to protect cultural expressions abandon existing global IP infrastructure and create a wholly unique protection

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13. *Id.* at 76.

14. *Id.*

15. Intergovernmental Comm. on Intellectual Prop. & Genetic Res., *Traditional Knowledge & Folklore, Revised Draft Provisions for the Protection of Traditional Cultural Expressions/Expressions of Folklore: Policy Objectives and Core Principles*, WIPO/GRTKF/IC/17/4 (Sept. 21, 2010) [hereinafter WIPO Draft].

16. *See infra* Part III.A-C.

17. Peter J. Chalk & Alexander Dunlop, *Indigenous Trade Marks and Human Rights: An Australian and New Zealand Perspective*, 99 TRADEMARK REP. 956, 971 (2009).

18. *Id.* at 957.

19. Lanham Act of 1946 § 2(a), 15 U.S.C. § 1052(a) (2006).

20. Traditional Cultural Expressions ("TCEs") "include music, art, designs, names, signs and symbols, performances, architectural forms, handicrafts and narratives." Other forms of indigenous intellectual properties include "Traditional Knowledge" ("TK") and genetic resources. *Traditional Cultural Expressions (Folklore)*, WIPO, <http://www.wipo.int/tk/en/folklore/> (last visited July 18, 2011); *see also* WORLD INTELLECTUAL PROP. ORG., INTELLECTUAL PROPERTY AND TRADITIONAL CULTURAL EXPRESSIONS/FOLKLORE 1-2 (2005), available at [http://www.wipo.int/freepublications/en/tk/913/wipo\\_pub\\_913.pdf](http://www.wipo.int/freepublications/en/tk/913/wipo_pub_913.pdf).

21. *See generally* Chalk & Dunlop, *supra* note 17 (discussing legislative efforts in New Zealand and Australia to craft legislation that protects indigenous peoples' rights in their cultural heritage, traditional knowledge, and traditional cultural expressions).

22. Indigenous Status, *supra* note 5, at 70-71.

scheme.<sup>23</sup> According to the United Nations, Western IP rights need to be reconciled with indigenous cultures' notion of ownership as a community.<sup>24</sup> If the creation of an international IP regime adjusted current trademark law procedures, traditional cultural expressions could be protected.<sup>25</sup>

Part II of this Comment discusses the general background of trademark law and the issues surrounding indigenous cultures. Parts III and IV discuss current efforts by individual states and the international community to protect indigenous populations for exploitation through various IP regimes. Part V examines the various theoretical approaches to protecting indigenous cultures. Part VI then argues that while the existing trademark regime requires change, this regime can address both theoretical and practical concerns with indigenous cultural expressions.

## II. BACKGROUND

Understanding the history behind the Western idea of private ownership is essential in comprehending the conflicting viewpoints of intellectual property ownership.<sup>26</sup> Across various nations,<sup>27</sup> trademark law affords the registrant or user the ownership rights of "any word, phrase, name, symbol, logo, or design used to identify and distinguish one's goods" or service.<sup>28</sup> The historical nature of trademark law is rooted in the commercial nature of distinguishing one's goods while protecting the interests of the mark-holder against misappropriation by a third party.<sup>29</sup>

In the United States, the Lanham Act provides the legal basis for trademark protection.<sup>30</sup> U.S. trademark law requires actual use of the proposed trademark in commerce in order for the mark to receive protection and enforcement against others.<sup>31</sup> Registration is not necessary in order to maintain legal rights in a trademark.<sup>32</sup> Common law protections also apply to certain trademarks used in-commerce without the formalities of registration.<sup>33</sup>

The United States also provides cancellation proceedings for third parties who wish to oppose a trademark application or cancel a registered trademark.<sup>34</sup> A

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23. WORLD INTELLECTUAL PROP. ORG., *supra* note 20, at 1-2.

24. Indigenous Status, *supra* note 5, at 74.

25. See WORLD INTELLECTUAL PROP. ORG., *supra* note 20.

26. See Indigenous Status, *supra* note 5, at 74.

27. See Jon O. Webster, *Creating a Trademark Protection Program in the United States and Abroad*, in UNDERSTANDING TRADEMARK LAW 2008 169, 186 (2008).

28. *Id.* at 177.

29. See S. REP. NO. 1333, at 3 (1946).

30. Lanham Act of 1946 § 1, 15 U.S.C. § 1051 (2006).

31. 15 U.S.C. § 1051(a)(1)(C).

32. Webster, *supra* note 27, at 184.

33. *Id.*

34. Lynda J. Oswald, *Challenging the Registration of Scandalous and Disparaging Marks Under the*

number of potential grounds exist for the cancellation of a trademark, including non-commercial use and inactivity.<sup>35</sup> Recent litigation involving indigenous groups has also expanded the scope of cancellation to include “disparaging” trademarks.<sup>36</sup>

Outside the United States, trademark protection is based on a registration-first system.<sup>37</sup> International intellectual property regimes offer some streamlined procedures for registering a trademark.<sup>38</sup> For example, the U.S. Federal Trademark Register offers the option of automatically applying to various international trademark regimes, which pools a number of different countries under one application.<sup>39</sup> One example of an international trademark protection regime is the Community Trade Mark (“CTM”), a system that allows simultaneous registration with twenty-seven European Union countries.<sup>40</sup>

The Madrid Protocol is similar to CTM and is the primary source of international trademark registration.<sup>41</sup> The Protocol allows simultaneous registration of a mark in seventy-two contracting member countries.<sup>42</sup> Other registration outlets include regional agreements, such as the Andean Pact, African Regional Intellectual Property Organization, North American Free Trade Agreement, and the Pan-American Convention for Trademark and Commercial Protection.<sup>43</sup> The key issue for indigenous groups is how well these local, national, and international IP regimes will protect culturally significant trademarks.<sup>44</sup>

#### *A. Indigenous Culture Conflicts*

Indigenous groups have sharply contrasting viewpoints from Western notions of property ownership.<sup>45</sup> Because indigenous cultures do not view their cultural expressions as privately owned, but rather as communal, most indigenous groups

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*Lanham Act: Who Has Standing to Sue?*, 41 AM. BUS. L.J. 251, 252 (2004).

35. 15 U.S.C. § 1064 (detailing various grounds for the cancellation of a trademark registration, including the mark: becoming the generic name for the type of goods or services represented; tarnishing existing marks; or blurring the distinction of another existing mark).

36. Oswald, *supra* note 34, at 252-53 (discussing a trademark case involving the Washington Redskins football team, which held that the term ‘redskin’ was a potentially disparaging term for Native Americans).

37. Webster, *supra* note 27, at 184.

38. *Id.*

39. *Madrid FAQs*, U.S. PAT. & TRADEMARK OFF., <http://www.uspto.gov/trademarks/law/madrid/madridfaqs.jsp> (last visited Sept. 14, 2011).

40. Webster, *supra* note 27, at 184, 187.

41. *Id.* at 189.

42. *Id.*

43. *Id.* at 196-98.

44. See WORLD INTELLECTUAL PROP. ORG., *supra* note 20, at 22.

45. Indigenous Status, *supra* note 5, at 74.

shun legal remedies.<sup>46</sup> This sense of communal ownership stands in sharp contrast to the fundamentals of trademark law, which are based on private, commercial ownership rights.<sup>47</sup> This difference in viewpoints raises the issue of whether IP law, specifically trademark law, is a viable mechanism for protecting indigenous cultures from exploitation.<sup>48</sup>

Beyond the underlying policy differences between indigenous and Western notions of IP ownership, as a general practice, indigenous cultures tend to avoid litigation as a means of enforcing their cultural property rights.<sup>49</sup> Citing litigation costs, impropriety of lawyers, and inherent cultural opposition to Western courts, most indigenous groups rarely use litigation to protect traditional cultural expressions.<sup>50</sup> Numerous proposals have addressed the issue of misappropriating traditional cultural expressions at the national level,<sup>51</sup> but nothing concrete has coalesced in the international community that addresses this issue.<sup>52</sup> Debate has ensued over an appropriate international forum to protect indigenous cultures from misappropriation.<sup>53</sup> Moreover, while several countries lead the way in offering trademark protections,<sup>54</sup> no international body has developed any substantial protections.<sup>55</sup>

### III. CURRENT EFFORTS TO PROTECT INDIGENOUS TRADEMARKS

#### A. Maori Peoples of New Zealand

The Maori, the largest indigenous population of New Zealand, first arrived over 1,000 years ago by sea-voyaging canoes, described as part of the people's

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46. *See id.*

47. *See* Chalk & Dunlop, *supra* note 17, at 957; *see also* Indigenous Status, *supra* note 5, at 74.

48. *See generally* Sabine Sand, *Sui Generis Laws for the Protection of Indigenous Expressions of Culture and Traditional Knowledge*, 22 U. QUEENSLAND L.J. 188 (2003).

49. Carlo Osi, *Understanding Indigenous Dispute Resolution Processes and Western Alternative Dispute Resolution Cultivating Culturally Appropriate Methods in Lieu of Litigation*, 10 CARDOZO ONLINE J. CONFLICT RESOL. 163, 220-21 (2008).

50. *Id.*

51. Weerawit Weeraworawit, *Formulating an International Legal Protection for Genetic Resources, Traditional Knowledge and Folklore: Challenges for the Intellectual Property System*, 11 CARDOZO J. INT'L & COMP. L. 769, 770 (2003).

52. *Id.* at 771. Some attempts have been made to protect cultural expressions. *See generally* *Convention on the Protection and Promotion of the Diversity of Cultural Expressions*, UNESCO <http://unesdoc.unesco.org/images/0014/001495/149502e.pdf> (last visited Sept. 13, 2011) (recognizing "that cultural goods and services convey identity, values and meaning and consequently cannot be considered as mere commodities or consumer goods . . . and . . . the need for States to take all appropriate measures to protect and promote diversity of cultural expressions while ensuring the free flow of ideas and works . . . and . . . the need to redefine international cooperation, the keystone of the Convention").

53. *See generally* WIPO Draft, *supra* note 15.

54. *See* Chalk & Dunlop, *supra* note 17, at 957 (discussing indigenous trademark protections for Australia and New Zealand).

55. *See* Indigenous Status, *supra* note 5, at 75-76.

mythical origins.<sup>56</sup> In addition to sharing a deep history and culture with New Zealand, the Maori peoples also make up nearly fourteen percent of the country's population.<sup>57</sup> Because they constitute a large portion of the population, the Maori greatly benefit from indigenous trademark protections enacted in New Zealand.

The most compelling form of trademark protections offered by an individual government for indigenous populations comes from the New Zealand Trade Marks Act ("Act"), enacted due to concerns over Maori rights.<sup>58</sup> This Act provides special protection in the form of the Maori Trade Marks Advisory Committee, which makes recommendations to the Commissioner about whether a proposed application appears to be "derivative of a Maori sign, including text and imagery" that "is, or is likely to be, offensive to Maori."<sup>59</sup> These are not, however, the only form of trademark protections offered by the Act.<sup>60</sup>

Another form of protecting indigenous trademarks granted by the Act is to simply deny offending trademarks at the outset of the trademark application where they offend indigenous peoples' cultural sensibilities.<sup>61</sup> For example, different languages that resemble offensive marks may become the basis of denying registration in New Zealand<sup>62</sup> because the Maori consider the usage of any of its signs or languages by outsiders as offensive.<sup>63</sup> One example, given by the Intellectual Property Office of New Zealand, states that the Japanese word "amaru," meaning "to remain, to be left over, to be in excess," also has meaning in the Maori language as "dignified."<sup>64</sup> This example hopes to inform potential trademark applicants, and to instill some cultural sensitivity in the broader community.<sup>65</sup>

An attractive method of providing protection for indigenous cultures is the power to refuse registration to such "offensive" marks.<sup>66</sup> For example, the Advisory Committee has used its influence to reject over 5,000 trademark applications as of 2008.<sup>67</sup> The Advisory Committee has several examples of

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56. *New Zealand Culture—Maori*, NEWZEALAND.COM, <http://www.newzealand.com/int/article/new-zealand-culture-maori/> (last visited Oct. 20, 2011).

57. *Id.*

58. Chalk & Dunlop, *supra* note 17, at 971.

59. *Id.*

60. *Id.*

61. *Id.* at 972.

62. *Identification of Maori Signs*, IPONZ, <http://www.iponz.govt.nz/cms/trade-marks/practice-guidelines-index/practice-guidelines/16-maori-advisory-committee-maori-trade-marks/3-identification-of-maori-signs> (last updated Nov. 16, 2009); *see also* Chalk & Dunlop, *supra* note 17, at 972.

63. *Introduction*, IPONZ, <http://www.iponz.govt.nz/cms/trade-marks/practice-guidelines-index/practice-guidelines/16-maori-advisory-committee-maori-trade-marks/introduction> (last updated June 23, 2008); *see also* Chalk & Dunlop, *supra* note 17, at 972.

64. *Identification of Maori Signs*, *supra* note 62.

65. *See id.*

66. *Id.*

67. *See* Chalk & Dunlop, *supra* note 17, at 971-72.



offending Maori marks on their website, including the following example of cigarette packaging that contains a mask figure.<sup>68</sup> These examples are meant to give some reference and guidance to the public at large.<sup>69</sup>



The Advisory Committee consists of diverse members from the Maori community.<sup>70</sup> Exact standards and practices in determining the offensiveness of a mark remain elusive, since Committee discussions are confidential and closed to the public.<sup>71</sup> Moreover, the Act specifically grants the Committee power to “regulate its own procedure” in screening and advising of potentially offensive trademark applications.<sup>72</sup>

Nevertheless, several issues hinder the effectiveness of the Advisory Committee’s ability to offer legal remedies for the Maori. First, the Advisory Committee confers no enforceable legal right.<sup>73</sup> Second, the Advisory Committee

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68. *Identification of Maori Imagery*, IPONZ, <http://www.iponz.govt.nz/cms/trade-marks/practice-guidelines-index/practice-guidelines/16-maori-advisory-committee-maori-trade-marks/3-identification-of-maori-signs/3-2-identification-of-maori-imagery> (last updated Nov. 16, 2009) (showing one example of a trademark utilizing Maori imagery that would not be registered by current New Zealand standards).

69. *Id.*

70. *See* Chalk & Dunlop, *supra* note 17, at 973.

71. *Id.*

72. *Id.* at 972.

73. *See id.* at 973.

remains silent on potential private trademark cancellation actions that individual Maori communities may wish to bring on their own behalf.<sup>74</sup> Third, procedural difficulties arise in regards to an “international committee” capable of determining the varying degrees of cultural sensitivity of all known indigenous groups.<sup>75</sup> For example, cross-cultural interpretations of several Japanese language marks can be interpreted as offensive to the Maori people,<sup>76</sup> but the ability to consider these concerns in any international forum is infeasible.<sup>77</sup> Despite these substantive and procedural issues, the Maori Advisory Committee remains the most progressive body in protecting indigenous cultures against offensive trademark practice.<sup>78</sup>

### B. The Panama Approach

In contrast to the generous IP rights granted in New Zealand, Panama was one of the first to pass a comprehensive, but restrictive *sui generis* Indigenous Intellectual Property system.<sup>79</sup> In 2000, Panama passed Law No. 20, a protective *sui generis* intellectual property protection scheme.<sup>80</sup> The law passed partly in response to concerns stemming from the misappropriation of a type of indigenous cloth, called the “mola,” and its cultural significance to the Kuna peoples.<sup>81</sup> Law No. 20 offers indigenous cultures protections and property rights in their “cultural” IP.<sup>82</sup>

The Kuna People are one of seven distinct indigenous cultures living in Panama.<sup>83</sup> Known as ferocious fighters, the Kuna played a large role in shaping Panama’s government through revolution and eventually established a large

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74. See *id.* (discussing the issues that arise from inconsistent definitions of the standards for “offensive” among varying Maori communities in New Zealand).

75. See *id.*

76. *Id.* at 971-72.

77. See *id.* at 973. Currently, there are over 300 million indigenous peoples. The sheer amount of diversity amongst cultures, languages, and peoples would be problematic in providing any group that was an expert on each group in terms of their culture intellectual property protection needs. *Indigenous Peoples*, WORLD BANK, <http://web.worldbank.org/WBSITE/EXTERNAL/TOPICS/EXTSOCIALDEVELOPMENT/EXTINDPEOPLE/0,,menuPK:407808~pagePK:149018~piPK:149093~theSitePK:407802,00.html> (last updated Oct. 4, 2011).

78. See generally Chalk & Dunlop, *supra* note 17, at 971-74.

79. Irma De Obaldia, *Western Intellectual Property and Indigenous Cultures: The Case of the Panamanian Indigenous Intellectual Property Law*, 23 B.U. INT’L L.J. 337, 338 (2005). *Sui generis* is defined as a wholly novel and independent legal doctrine that is outside of traditionally conceived legal doctrines.

80. *Id.*; see also Law No. 20 of 26 June 2000 on the Special Intellectual Property Regime with Respect to the Collective Rights of Indigenous Peoples to the Protection and Defense of their Cultural Identity and Traditional Knowledge, WORLD INTELL. PROP. ORG. (June 26, 2000), <http://www.wipo.int/wipolex/en/details.jsp?id=3400> [hereinafter *Law No. 20*].

81. Obaldia, *supra* note 79, at 338-39.

82. *Id.* at 365; Law No. 20, *supra* note 80.

83. Obaldia, *supra* note 79, at 351.

presence in its government.<sup>84</sup> They account for the numerous laws passed in favor of all indigenous cultures within the country.<sup>85</sup> Today, the Kuna are known for making authentic molas, colorful woven tapestries.<sup>86</sup> Each mola takes time and effort, with higher quality molas incorporating a “dizzying array of layers, stitching, cutouts, and color combinations.”<sup>87</sup> As the popularity of these indigenous forms of art has grown, the Panamanian government became concerned about the importation of foreign molas, and thus took steps to protect the Kuna by passing Law No. 20.<sup>88</sup>

The scope of Law No. 20 exhibits the difficulties in merging Western ideals of private ownership with the altruistic goals of protecting indigenous cultures against exploitation.<sup>89</sup> The Panamanian Law was criticized as “motivated as much by protection of indigenous tradition as by the importance of the commercial and economic success of the crafts.”<sup>90</sup> In order to qualify for protection under Law No. 20, an indigenous group must first register the intellectual property.<sup>91</sup> This registered mark must comply with requirements, which include originality, authenticity to the indigenous group, and “commercial viability of the subject matter.”<sup>92</sup> Law No. 20 blends “commercialization and cultural protection,” which conflicts with indigenous people’s notions of property ownership.<sup>93</sup>

The conflicting policies of providing IP protection for indigenous peoples and the economic incentives underlying Law No. 20 are allegedly reconcilable by the Panamanian government; “Panama and its tribes [are] rooted in common interests, such as increasing tourism and consequently the quality of life across the board.”<sup>94</sup> While it is possible that the protection of indigenous cultures and commercialization rights can be reconciled, the key criticism arises in the “commercial” nature of the law.<sup>95</sup> Unlike the IP protections found in New Zealand, where the purpose of the protection is to avoid culturally offensive marks,<sup>96</sup> Panama focuses specifically on protecting the commercial rights of its indigenous cultures.<sup>97</sup> The Panama Law loses its focus—protecting the communal property rights of indigenous peoples—by favoring commercial rights, which causes the widespread abuse of indigenous cultures outside the context of

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84. *Id.* at 353, 356.

85. *Id.* at 356.

86. *Id.* at 356-59.

87. *Id.* at 357.

88. *Id.* at 359.

89. *Id.* at 376.

90. *Id.*

91. *Id.* at 366; Law No. 20, *supra* note 80, at arts. 7-9.

92. Obaldia, *supra* note 79, at 367; Law No. 20, *supra* note 80, at arts. 1, 6.

93. Obaldia, *supra* note 79, at 376.

94. *Id.* at 377.

95. *Id.* at 378-79.

96. See Chalk & Dunlop, *supra* note 17, at 971.

97. Obaldia, *supra* note 79, at 378-79.

commercial gain.<sup>98</sup> Thus, the approaches in Panama and New Zealand exhibit two underlying policies of IP: (1) commercial protectionism and (2) sensitivity to indigenous cultures.<sup>99</sup>

### C. The Western Approach

IP law in the United States and Canada illustrate the issues involved in reconciling protections against indigenous exploitation with Western notions of commercialization. In traditional Western trademark law, a mark is granted registration as long as the owner shows that the mark is distinctive, source identifying, used in commerce, and not confusingly similar to other trademarks.<sup>100</sup> Accordingly, indigenous groups can apply for a trademark of their traditional cultural expressions, as long as they meet each of these factors.<sup>101</sup> However, indigenous cultures tend to fail to meet some of these basic requirements, such as the requirement to use their mark commercially.<sup>102</sup>

Canada offers limited protection at the registration level for indigenous groups.<sup>103</sup> According to Section 9 of the Trade-marks Act of Canada, registration of marks is refused if based on “any badge, crest, emblem or mark,” including marks “adopted and used by any *public authority*, in Canada as an official mark for wares or services.”<sup>104</sup> Since Canada grants indigenous groups specific “public authority” status, indigenous groups have some baseline protections from non-indigenous registrations under Section 9.<sup>105</sup> Therefore, any mark used to represent an indigenous community, which also satisfies the ‘public authority’ requirement, is protected by the Canadian trademark offices.<sup>106</sup> Like the U.S. Trademark and Patent Office (“PTO”), Canada’s trademark examiners have the authority to refuse trademark applications that are similar to marks used by indigenous groups.<sup>107</sup>

One aspect of U.S. trademark law utilized by indigenous cultures is the cancellation of marks deemed “disparaging” as defined by Section 2(a) of the Lanham Act.<sup>108</sup> In the seminal case of *Harjo v. Pro-Football*, members of the

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98. See *id.*

99. See *supra* Part III.A-B.

100. Webster, *supra* note 27, at 177.

101. *Id.*

102. *Id.*

103. Chalk & Dunlop, *supra* note 17, at 961.

104. *Id.* (emphasis added).

105. *Id.* “Public Authority” status is granted to any group under the Canadian government control, and contributes to the public good. *Practice Notice: Public Authority Status Under Sub-paragraph 9(1)(n)(iii)*, CAN. INTEL. PROP. OFFICE, <http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00150.html> (last modified June 7, 2011).

106. Chalk & Dunlop, *supra* note 17, at 961.

107. *Id.* at 961-62.

108. See *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215 (T.T.A.B. 2010); see generally Oswald, *supra*

Native American community brought a cancellation proceeding for the allegedly disparaging mark of a football team, the Washington Redskins.<sup>109</sup> The plaintiffs brought an action to the Trademark Trial and Appeals Board (“TTAB”) claiming that the word “redskins” was disparaging as used as part of the trademark brand of the team.<sup>110</sup> The TTAB established the legal standard for determining disparaging marks: (1) the mark is “reasonably understood” to be referring to the plaintiffs, and (2) the mark “may be disparaging to a substantial composite of the persons or institutions at issue.”<sup>111</sup> The TTAB held that testimony proving the first prong of the test should come from “linguistics experts or other disinterested witnesses.”<sup>112</sup> Evidence proving the second prong of the test can be shown by surveys, personal testimony, and other such evidence from the target group.<sup>113</sup> On appeal, the Federal District Court for the District of Columbia rejected the cancellation of the mark based on an unrelated matter.<sup>114</sup> However, the court held that the TTAB test for disparaging marks was the correct legal test, and PTO trademark examiners have since adopted the test.<sup>115</sup>

The Lanham Act provides other grounds for which a trademark registration application can be denied in the United States.<sup>116</sup> For example, Section 2(b) of the Lanham Act stipulates trademarks that consist of a “flag or coat of arms or other insignia . . . of any State or municipality, or of any foreign nation . . .” may be denied registration, which can include official insignia of indigenous nations.<sup>117</sup> Section 2(a) also provides a prohibition against registration of marks that resemble particular living persons, deceased U.S. Presidents, and deceptive descriptions of trademarks in relation to its goods or geographic location.<sup>118</sup> Moreover, causes of action exist for marks that dilute another mark by either tarnishing or blurring the mark’s distinctive value.<sup>119</sup>

However, because these latter provisions require indigenous groups to have sufficient legal standing to bring a trademark cause of action, requiring a perceivable harm, indigenous groups need significant legal reform to maintain a successful action under the current Lanham Act.<sup>120</sup> Standing remains a significant

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note 34.

109. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999), *rev’d*, 284 F.Supp.2d 96 (D.D.C. 2003) (reversing on grounds unrelated to the PTO’s examination for disparaging marks).

110. *Id.* at 99.

111. Oswald, *supra* note 34, at 278.

112. *Id.* at 279.

113. *Id.* at 280.

114. Upon appeal, the court sided with the Washington Redskins in holding that the doctrine of laches applied to the Native American’s claims. *Pro-Football, Inc. v. Harjo*, 284 F.Supp.2d 96 (D.D.C. 2003).

115. *Id.* at 133-36; Oswald, *supra* note 34, at 277, 280.

116. Lanham Act of 1946 § 2(b), 15 U.S.C.A. § 1052(b) (West 2011).

117. *Id.*

118. *Id.*

119. *Id.*

120. See Oswald, *supra* note 34, at 288-89; Abraham’s Seed v. John One Ten, 1 U.S.P.Q.2d 1230

roadblock for indigenous groups because the requirement of proof of ownership of cultural expressions creates a substantial burden in tracing true ownership.<sup>121</sup> Such evidence is unlikely to be conclusive without involving historians, anthropologists, or a national registry that identifies every indigenous culture and their cultural properties.<sup>122</sup>

Opponents against maintaining current trademark jurisdiction to regulate indigenous cultural marks state that traditional Western trademark approaches fail to bridge the gap between the commercialized ideologies of IP law and the indigenous sense of ownership.<sup>123</sup> Essentially, the core principle of Western IP law is granting a limited monopoly in the rights of a mark, whereas indigenous cultures do not share the belief in specific, individual ownership of any cultural expressions.<sup>124</sup> It would be abhorrent in Native American society for an individual to claim private, commercial ownership over any religious symbol as a trademark right.<sup>125</sup>

Enforcing IP rights in Western nations also relies on litigation, which indigenous cultures inherently oppose.<sup>126</sup> Even where litigation is preferable due to gross misappropriation of indigenous marks, most indigenous groups cannot afford to initiate any legal action.<sup>127</sup> Other complaints include incompetent attorneys in terms of indigenous cultural expression.<sup>128</sup> Yet, while these complaints frighten indigenous cultures from seeking relief under Western IP laws,<sup>129</sup> indigenous cultures are still limited to the geographic locality of their tribe,<sup>130</sup> protected only to the sovereign borders of the country of which the tribe is located.

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(T.T.A.B. 1986) (noting that a party petitioning to cancel registration of a mark based on disparagement must have sufficient standing).

121. See Oswald, *supra* note 34, at 289.

122. See *id.*

123. Suzanne Milchan, *Whose Rights Are These Anyway?—A Rethinking of Our Society's Intellectual Property Laws in Order to Better Protect Native American Religious Property*, 28 AM. INDIAN L. REV. 157, 163 (2004).

124. *Id.*

125. *Id.*

126. See Osi, *supra* note 49, at 220.

127. *Id.*

128. *Id.* at 223. Some international pro bono legal communities do provide competent IP advice to indigenous cultures. See *Promoting the Public Interest in Innovation and Creativity in Developing Countries by Providing Access to Intellectual Property Expertise*, PIIPA, <http://www.piipa.org/> (last visited Oct. 14, 2011).

129. See *id.*

130. See Osi, *supra* note 49, at 223.

#### IV. INTERNATIONAL INTELLECTUAL PROPERTY APPROACHES

##### A. Paris, Madrid, and the Trademark Law Treaty

International agreements for trademark protection grant little substance for indigenous groups and other non-mark holders.<sup>131</sup> For example, the first major international intellectual property treaty, the Paris Convention, holds that all member states must offer similar protections as those offered by every other member state.<sup>132</sup> This protection is limited to requiring similar registration processes as those guaranteed by other member nations.<sup>133</sup> Essentially, the Paris Convention only gives foreigners the right to register their trademarks in the member state.<sup>134</sup> The Paris Convention includes one cancellation proceeding, but only for non-use of the mark, which ranges from three to five years in most countries.<sup>135</sup>

The Paris Convention led to the creation of the World Intellectual Property Organization (“WIPO”).<sup>136</sup> WIPO handles the administrative regulation of IP treaties.<sup>137</sup> Today, WIPO acts in conjunction with the World Trade Organization and nearly 184 member states.<sup>138</sup> With twenty-four major international IP treaties under WIPO’s administration,<sup>139</sup> WIPO attempts to harmonize varying national IP procedures by providing an international application process for IP rights, international exchange of IP data, and legal services for developing countries.<sup>140</sup> These treaties institute the bureaucratic foundation for all international IP administration.<sup>141</sup>

The Madrid System for the International Registration of Marks (“Madrid System”) also offers little substantive protections for indigenous groups.<sup>142</sup> The Madrid Agreement Concerning the International Registration of Marks (“Madrid Agreement”), created in 1891, merely simplified the process for the international registration of a trademark.<sup>143</sup> By filing an application in a member state that is

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131. AARON SCHWABACH, *INTELLECTUAL PROPERTY: A REFERENCE HANDBOOK* 114 (2007).

132. *WIPO Treaties—General Information*, WIPO, <http://www.wipo.int/treaties/en/general/> (last visited Oct. 14, 2011) [hereinafter *WIPO Treaties*].

133. SCHWABACH, *supra* note 131, at 114.

134. *Id.*

135. MARY M. SQUYRES, *TRADEMARK PRACTICE THROUGHOUT THE WORLD* § 6:7 (2011).

136. *WIPO Treaties*, *supra* note 132.

137. *Id.*

138. *Id.* It should be noted that the WTO and WIPO are completely distinct international organizations.

139. *Id.*

140. *Id.*

141. *Id.*

142. *See* SCHWABACH, *supra* note 131, at 115.

143. *Id.* at 114-15; *Summary of the Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989)*, WIPO, [http://www.wipo.int/treaties/en/registration/madrid/summary\\_madrid.html](http://www.wipo.int/treaties/en/registration/madrid/summary_madrid.html) (last visited Oct. 21, 2011) [hereinafter *WIPO Madrid*].

subject to the Madrid Agreement or Protocol, one can submit an application to all members of the Madrid Agreement with a single filing, rather than taking tedious steps in filing applications in each country.<sup>144</sup> One application can grant trademark protection in over seventy-eight member countries.<sup>145</sup>

The Trademark Law Treaty (“TLT”), which is not as expansive as the Madrid Agreement, includes thirty-three members, and constitutes an additional international trademark treaty.<sup>146</sup> The TLT essentially requires each member nation to provide uniform registration and renewal processes, but fails to provide any substantive rights to indigenous peoples and other non-mark holders.<sup>147</sup> The trend for many of the international trademark regimes is to streamline commerce by protecting mark holders’ rights, but these fail to recognize any rights based on non-mark holding indigenous peoples.<sup>148</sup> Overall, these treaties and agreements provide only procedural tools for international trademark law, without offering any avenue for remedies for indigenous groups.

### *B. Other Multinational Trademark Agreements*

Comprised of Bolivia, Colombia, Ecuador, Peru and Venezuela, the Commission of the Cartagena Accord of the Andean Pact of Common Systems of Access (“Andean Pact”) formed in July 1996.<sup>149</sup> The member countries of this pact require all applicants seeking the use of “genetic resources” of an indigenous group to first obtain prior informed consent and also to grant financial incentives to the local indigenous community.<sup>150</sup> Any violation of the provisions provided in the Andean Pact may result in the cancellation of any IP right registered for the specific resource.<sup>151</sup>

The African Regional Intellectual Property Organization (“ARIPO”) is another regional trademark treaty that includes fifteen African countries.<sup>152</sup> The treaty creates a centralized registration system for trademark.<sup>153</sup> ARIPO is unique

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Agreement].

144. See SCHWABACH, *supra* note 131, at 115.

145. *Id.*

146. *Id.*

147. *Id.*

148. See *id.*; WIPO Madrid Agreement, *supra* note 143.

149. Weeraworawit, *supra* note 51, at 775; *Common Regime on Access to Genetic Resources*, COMUNIDAD ANDINA, <http://www.comunidadandina.org/ingles/normativa/d391e.htm> (last visited Oct. 21, 2011).

150. Weeraworawit, *supra* note 51, at 775.

151. *Id.*

152. Webster, *supra* note 27, at 196-97 (Member states include Botswana, Gambia, Ghana, Kenya, Lesotho, Malawi, Mozambique, Sierra Leone, Somalia, Sudan, Swaziland, Tanzania, Uganda, Zambia, and Zimbabwe.); *What is a Trademark?*, ARIPO (Oct. 6, 2006, 4:47 PM), [http://www.aripo.org/index.php?option=com\\_content&view=article&id=13&Itemid=60](http://www.aripo.org/index.php?option=com_content&view=article&id=13&Itemid=60) [hereinafter ARIPO].

153. Webster, *supra* note 27, at 196-97; ARIPO, *supra* note 152.



in that each trademark application is sent to every member nation for a substantive review.<sup>154</sup> Each member country can then contest the mark within one year.<sup>155</sup> This additional check on trademark applications provides another safeguard against the misappropriation of indigenous marks.<sup>156</sup>

All multinational trademark agreements share the same underlying purpose of streamlining the trademark registration process.<sup>157</sup> But these multinational IP agreements provide some unique methods that can be applied to protect indigenous cultures, while working within the traditional trademark legal structure.

## V. RECOMMENDED THEORETICAL APPROACHES

### A. WIPO's Approach

Recently, WIPO finally began developing a new, substantive theoretical approach to protect indigenous culture's traditional knowledge, cultural expressions, and other indigenous IP.<sup>158</sup> Borrowing heavily from recommendations of other member states, advocate groups, and existing IP law, WIPO hopes to create an international *sui generis* approach for the protection of indigenous cultural expressions.<sup>159</sup> In 1998, WIPO began initial fact-finding research into what would eventually become the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore ("WIPO Committee").<sup>160</sup> The WIPO Committee is tasked with discovering potential avenues to protect indigenous cultures under current and innovative IP techniques.<sup>161</sup> The WIPO Committee's mandate is to reconcile the existing legal IP framework of member states, and attempt to formulate a compromise to ensure indigenous protections.<sup>162</sup> The WIPO Committee's most recent activities resulted in two draft provisions for the protection of "Traditional Knowledge" and "Traditional Cultural Expressions" ("TCEs").<sup>163</sup> TCEs are any forms, whether tangible or intangible, "in which traditional culture and

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154. Webster, *supra* note 27, at 196-97.

155. *Id.*; ARIPO, *supra* note 152.

156. See generally Webster, *supra* note 27, at 196-97.

157. See *id.* at 186-98.

158. Kaitlin Mara, *WIPO Members Move to Detailed Talks Toward Folklore Treaty*, INTELL. PROP. WATCH (Dec. 11, 2010, 2:21 AM), <http://www.ip-watch.org/weblog/2010/12/11/wipo-members-move-into-detailed-talks-toward-folklore-treaty/>.

159. See WIPO Draft, *supra* note 15.

160. WIPO Draft, *supra* note 15, at 1.

161. Lena Sinn, *The WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC—GRTKF)*, CULTURAL PROP., [http://www.cultural-property.org/wp-content/uploads/2009/03/lena\\_sinn-wipo\\_igc.pdf](http://www.cultural-property.org/wp-content/uploads/2009/03/lena_sinn-wipo_igc.pdf) (last visited Dec. 9, 2010).

162. *Id.* § II(1).

163. *Id.* §§ I, III.

knowledge are expressed,” and may include any combination of verbal or musical acts or art.<sup>164</sup> While these draft provisions hold no legal force and are not endorsed by the WIPO’s Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (“IGC”), they are meant to provide a starting point for debate based on surveys of current laws of individual member states and their struggle in providing indigenous protection.<sup>165</sup> Case studies include the practical legal experiences of Australia, India, Indonesia, and the Philippines, with detailed briefings provided by New Zealand, Nigeria, Panama, Russia, Tunisia, and the United States.<sup>166</sup> These draft provisions were simply meant to provide a point of reference in the debate currently taking place, but in actuality provide the first step in substantive reform.<sup>167</sup>

WIPO’s most recent proposed draft provisions for protecting traditional cultural expressions move beyond traditional IP and attempt to create a *sui generis* system.<sup>168</sup> The draft provisions begin by laying the foundational objectives, recognizing the value of indigenous work, promoting respect for their culture, preventing misappropriation of IP rights, and empowering indigenous communities by giving them tangible, legal rights.<sup>169</sup> These draft provisions are a major step towards substantive reform.<sup>170</sup>

The substantive portions begin by identifying specific instances of traditional cultural expressions, including “verbal expressions, such as: stories, epics, legends, poetry, riddles and other narratives; words, signs, names, and symbols.”<sup>171</sup> Indigenous cultural subject matter also includes both tangible and intangible forms of expression.<sup>172</sup> Furthermore, to qualify under protectable subject matter, the expressions must have some linkage with the “community’s cultural and social identity.”<sup>173</sup> These expressions must be used in the community in question.<sup>174</sup>

More significantly, the draft provisions state that misappropriation of IP rights can take place by the usage of any “words, signs, names, and symbols” that qualify as traditional expressions but “disparage, offend or falsely suggest a connection with the community.”<sup>175</sup> Article 4 of the draft provisions suggests that

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164. *Id.* § I. See generally WIPO Draft, *supra* note 15, at 1.

165. Sinn, *supra* note 161, §§ I, III.

166. *Id.*

167. *Id.*

168. See generally WIPO Draft, *supra* note 15.

169. WIPO Draft, *supra* note 15, at 3, 4.

170. Mara, *supra* note 158.

171. WIPO Draft, *supra* note 15, at 11.

172. *Id.* at 12. Tangible forms include those artistic expressional works such as mola from Panama. Intangible forms would include spoken word, sounds, tastes and other non-tangible forms of indigenous properties.

173. *Id.* at 12-13.

174. *Id.* at 13.

175. *Id.* at 19.

private individuals and corporations can seek approved uses of traditional expressions, pursuant to authorization by direct appeal to the relevant community in question.<sup>176</sup> WIPO would mandate the IGC to educate indigenous cultures of their rights under Article 4.<sup>177</sup> Under Article 6, which addresses concerns about an unlimited protection period for indigenous cultural expressions, the Term of Protection allows the mark's duration to continue as long as the expression can be classified under Article 1.<sup>178</sup> Article 7 reconciles automatic registration and protection to all qualified indigenous marks with seeking a more formalistic review process.<sup>179</sup> Acting as a compromise during the drafting, Article 7 has a general policy presumption that automatically protects cultural expressions, but allows indigenous groups to formally register and gain stricter protections for commonly known TCE's.<sup>180</sup> This presumption would be similar to the immediate protection given to a creator of a copyrightable work of original authorship at the time of creation.<sup>181</sup>

Article 8 contains suggested provisions for sanctions, remedies, and exercise of rights by indigenous groups.<sup>182</sup> Current language appears to suggest that criminal and civil sanctions should be available in cases of misappropriation, but the draft provisions provide little detail.<sup>183</sup> This is perhaps due to the amount of international debate regarding acceptable norms in drafting restrictive sanctions.<sup>184</sup> Article 8 also suggests that the committee, already tasked with "advising and assisting" indigenous communities of their legal rights, also be assigned administrative and enforcement powers.<sup>185</sup> The commentary of WIPO's draft provisions provides several examples of what marks indigenous cultures can acquire through traditional IP rights.<sup>186</sup> They include the trademark of "traditional signs, symbols, and other marks."<sup>187</sup> Examples also include the usage of traditional songs, stories, emblems, masks, ceremonial garbs, and any other culturally significant item that could be generally classified under traditional trademark law.<sup>188</sup>

Article 11 of the draft provisions includes language that grants foreign nationals comparable rights at the national level.<sup>189</sup> Article 11 is another example

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176. *Id.* at 24.

177. *Id.*

178. *Id.* at 30.

179. *Id.* at 33.

180. *Id.* at 34.

181. *Id.*

182. *Id.* at 38.

183. *Id.*

184. *See id.* at 39.

185. *Id.* at 38.

186. *Id.* at 44.

187. *Id.*

188. *See id.*; WORLD INTELLECTUAL PROP. ORG., *supra* note 20, at 6.

189. WIPO Draft, *supra* note 15, at 48.

of the infancy of the draft language, as the “national treatment” standard, commonly found in most international treaties, merely acts as a starting point to begin discussion of more exact substantive language.<sup>190</sup> The commentary to the draft provisions for Article 11 concedes that the national treatment standard merely acts as a stopgap until further international discussion take place.<sup>191</sup> While WIPO’s draft provisions prove to be a substantial step in reforming the international IP regime, the draft provisions remain years away from being a realistic alternative for indigenous groups.<sup>192</sup>

### *B. Alternative Dispute Resolution (ADR)*

In addition to WIPO’s current effort to garner international support for its *sui generis* system of protection for indigenous groups, legal scholars offer other dispute resolution recommendations. One approach attempts to resolve the issues of expensive litigation and indigenous distrust of Western legal systems by resorting to Alternative Dispute Resolution (“ADR”).<sup>193</sup> ADR procedures typically include mediation, negotiation, or arbitration.<sup>194</sup> Mediation relies on the appointment of a mediator as a neutral third party who is appointed voluntarily by opposing parties.<sup>195</sup> Negotiation relies on the mutual exchange of needs based on a common conflict of interests.<sup>196</sup> Finally, arbitration relies on a “pre-determined jurisdiction and arbitration tribunal to handle disputes between parties.”<sup>197</sup>

Although arbitration clauses are typical in private party contracts, major international organizations handle specific IP claims between parties.<sup>198</sup> One such arbitration forum is WIPO’s Center for Arbitration and Mediation, created in October 1994.<sup>199</sup> While arbitration can be an effective form of dispute resolution, ADR practices would not benefit unwilling parties.<sup>200</sup> Where third parties misappropriate an indigenous culture’s IP and no ADR agreement exists, ADR would provide no relief.<sup>201</sup>

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190. *Id.*

191. *Id.*

192. *See id.*

193. *See* Osi, *supra* note 49, at 224.

194. *See id.* at 199-200.

195. *Id.*

196. *Id.* at 200.

197. *Id.* at 201.

198. *Id.* at 208-09.

199. *Id.* at 209. *See generally* WIPO Arbitration and Mediation Center, WIPO, <http://www.wipo.int/amc/en/index.html> (last visited Oct. 15, 2011).

200. *See* Osi, *supra* note 49, at 202.

201. *See id.*

Even though legal systems offer the benefit of creating judicial precedence, ADR addresses other shortcomings of pursuing litigation.<sup>202</sup> One contentious issue of litigation is the shortage of potential funds of indigenous groups in their legal war chest.<sup>203</sup> Yet, the most compelling argument asserted by indigenous group supporters is that current Western attorneys lack the cultural experience to handle indigenous group claims.<sup>204</sup> While ADR does not alleviate all the potential issues that arise from misappropriated indigenous marks, ADR practices attempt to provide a more cost-effective solution by cutting costs typically associated with litigation, such as production of documents, evidentiary procedures for witnesses, and lengthy courtroom battles.<sup>205</sup>

### C. Benefit-sharing Models

Another model used to protect indigenous TCEs is the benefit-sharing model.<sup>206</sup> Benefit-sharing relies on mutual assent, which is typical of a common contract.<sup>207</sup> This model focuses on making profit on knowledge gained from an indigenous group and giving back a share of those profits.<sup>208</sup> Typically, a multinational corporation stands in a better position to gain intellectual property rights of indigenous properties than indigenous cultures themselves.<sup>209</sup> The basic model requires consent from the indigenous body and some profit-sharing in the resulting goods or service.<sup>210</sup>

The main advantage of this model is providing some insurance that the indigenous group will receive a fair share of profits.<sup>211</sup> However, one issue is whether indigenous groups are able to give informed consent to these partnerships, due to undue influence by the more legally and commercially sophisticated corporations or the perception of less sophisticated indigenous groups.<sup>212</sup> Additionally, a benefit-sharing model does not prevent a third party from completely abridging an indigenous culture's TCEs without some

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202. *Id.* at 223; see *Why Arbitration in Intellectual Property?*, WIPO, <http://www.wipo.int/amc/en/arbitration/why-is-arb.html> (last visited Nov. 1, 2011).

203. Osi, *supra* note 49, at 224.

204. *See id.* at 223.

205. *Id.* at 213.

206. Chih-Chieh Yang, *A Comparative Study of the Models Employed to Protect Indigenous Traditional Cultural Expressions*, 11 *ASIAN-PAC. L. & POL'Y J.* 49, 59 (2010). Benefit-sharing has been essential in the realm of bio-diversity. See generally *Access to Genetic Resources and the Fair and Equitable Sharing of Benefits Arising Out of Their Utilization (ABS)*, UNEP, <http://www.cbd.int/iyb/doc/prints/factsheets/iyb-cbd-factsheet-abs-en.pdf> (last visited Sept. 15, 2011).

207. Yang, *supra* note 206, at 59-60.

208. *Id.*

209. *Id.*

210. *Id.*

211. *See id.*

212. *See id.*

extraneous regulatory scheme in place.<sup>213</sup> Altogether, the intent to profit from an indigenous culture's TCEs through a benefit-sharing system fails to provide adequate measures to protect those cultures from abuse.

## VI. TRADEMARK AS A VIABLE PROTECTION TOOL

As seen by the number of approaches that attempt to protect indigenous cultures and their cultural property, specific countries and the international community struggle with granting cultural autonomy.<sup>214</sup> Nevertheless, utilizing time-tested IP laws would not require the extensive imagination that creating a brand new international protection scheme does.<sup>215</sup> Adopting an international model based on Western trademark law can offer adequate protection against the exploitation of indigenous groups without sacrificing centuries of the practical legal infrastructure.<sup>216</sup>

To assess the viability of trademark law jurisprudence in today's international protection scheme, the various criticisms of trademark law must be addressed.<sup>217</sup> By examining the reoccurring trends that plague every mechanism designed to protect indigenous cultures, trademark law can be adapted to fulfill a much broader role in protecting TCEs.

### A. *Overcoming Criticisms of Trademark Law*

Current criticisms of trademark law in protecting TCEs stem from the foundations of trademark jurisprudence itself.<sup>218</sup> First, trademark laws cannot prevent the use of TCEs when a third party does not seek to register that trademark.<sup>219</sup> Second, current TCE trademark holders prevent legitimate indigenous groups from acquiring trademark rights.<sup>220</sup> Third, the commercial use requirement of trademark law prevents indigenous groups who simply wish to prevent misappropriation of their TCE from utilizing the law.<sup>221</sup> Finally, it would be prohibitively expensive for indigenous peoples to register all prospective TCEs as trademarks.<sup>222</sup> These points summarize the main difficulty that

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213. *See id.*

214. *See infra* Parts II-III.

215. *See id.*

216. DAPHNE ZOGRAFOS, INTELLECTUAL PROPERTY AND TRADITIONAL CULTURAL EXPRESSION 100 (2010).

217. *Id.* at 101.

218. *See id.*

219. *Id.*

220. *Id.*

221. *Id.*

222. *Id.*

indigenous cultures face when attempting to enact their property rights in an international forum.<sup>223</sup>

1. *Misappropriation Without Registering a Trademark.*

The first criticism dismisses the central purpose of trademark registration.<sup>224</sup> In the United States, for example, laws protect registered trademarks against illegal misrepresentation of the source or origin of a good.<sup>225</sup> Section 43(a) of the Lanham Act can protect TCEs by treating third party uses as false advertising and misleading the public as to the “nature, characteristics, qualities, or geographic origin.”<sup>226</sup> *Federal-Mogul-Bower Bearings, Inc. v. Azoff*<sup>227</sup> expanded this definition to include “origin of source or manufacture,” which theoretically can include indigenous peoples as the manufacturer.<sup>228</sup> Therefore, even when a third party misappropriates an indigenous group’s TCEs without applying for a trademark, indigenous groups can take active steps to prevent these non-trademark uses.<sup>229</sup>

The first criticism arises when there is mere superfluous use of an indigenous TCE by a third party, which threatens to bypass any trademark protection scheme.<sup>230</sup> One example of superfluous use is Lego’s use of various Maori names in the game “Bionicle,” in which the company claimed no intent to assert trademark rights over the texts or imagery used.<sup>231</sup> Other provisions of U.S. trademark law can be adapted to suit an international protection scheme.<sup>232</sup> For example, the United States allows mark holders to bring causes of action for dilution, even in cases of non-competing usages of a registered trademark.<sup>233</sup> Because U.S. dilution laws provide a cause of action against blurring or tarnishing trademarks,<sup>234</sup> indigenous groups can deter others against the misappropriation of TCEs.<sup>235</sup>

For third party users who do not trademark their use of indigenous TCEs, international protection can still be based on traditional trademark law if

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223. *See id.*

224. *See id.*

225. *Id.* at 197.

226. Lanham Act of 1946 § 43(a), 15 U.S.C. § 1125(a) (2006).

227. 313 F.2d 405, 408 (6th Cir. 1963).

228. *See id.*

229. *See id.*

230. *See ZOGRAFOS, supra* note 216, at 101.

231. *Id.*

232. Lanham Act of 1946 § 43(c), 15 U.S.C. § 1125(c) (2006).

233. *Id.* Dilution refers to the blurring or tarnishing of a trademark’s source-identifying function and image.

234. *Id.*

235. *See id.*

procedures are reformed.<sup>236</sup> In cases where no trademark registration is filed and a third party uses a TCE, indigenous groups must assert trademark ownership rights.<sup>237</sup> Indigenous groups have not applied for trademarks in the past, which stems from their general distaste of the legal system.<sup>238</sup> WIPO's suggestion to create an international body that informs indigenous groups of their legal rights resolves this situation.<sup>239</sup> Such committees are highly effective in protecting specific indigenous groups, like the Maori in New Zealand.<sup>240</sup> With these committees acting as watchdogs for indigenous groups on the international level, local indigenous groups would be protected vicariously through these committees and would even prevent non-trademark uses of their cultural properties.<sup>241</sup>

The commercial nature and extent of trademark law shows how protecting one's mark is a valuable venture.<sup>242</sup> Brand names, for example, offer profits estimated in the billions.<sup>243</sup> Because of the high value placed on trademarks, the smart business choice is to register trademarks in order to protect the brand.<sup>244</sup> Thus, an effective check against TCE misappropriation is relying on business sense and judgment.<sup>245</sup>

## *2. Current Mark Holders Prevent Indigenous Groups from Trademarking Their Own Property*

The second criticism, which cites third parties that have previously registered indigenous groups' TCEs, is addressed by synthesizing American cancellation procedures.<sup>246</sup> Once the PTO grants a trademark application, the mark is subject to cancellation by third parties with proper justification.<sup>247</sup> Typical grounds for cancellation arise under non-use of the mark, or when the mark becomes generic and loses its source-identifying function.<sup>248</sup> Other cancellation grounds exist which may allow indigenous groups relief from the misappropriation of their TCEs.<sup>249</sup> One example results from the cancellation action in *Harjo v. Pro-*

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236. See Webster, *supra* note 27, at 196-97.

237. See *id.*

238. Osi, *supra* note 49, at 220-22.

239. WIPO Draft, *supra* note 15, at 25, 38.

240. See Chalk & Dunlop, *supra* note 17, at 971-74.

241. See *id.*

242. See *Best Global Brands 2010*, INTERBRAND, <http://www.interbrand.com/en/knowledge/best-global-brands/best-global-brands-2008/best-global-brands-2010.aspx> (last visited Oct. 21, 2011).

243. See *id.*

244. ZOGRAFOS, *supra* note 216, at 100-01.

245. See *id.*

246. See Webster, *supra* note 27, at 177-81.

247. *Id.* at 180.

248. *Id.* at 177-80.

249. See *Harjo v. Pro-Football*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999).



*Football, Inc.*<sup>250</sup> As discussed earlier, *Harjo* provided the basis for indigenous cultures to seek cancellation of a registered mark based on its “disparaging or scandalous” nature.<sup>251</sup> While the term “Redskins” was not considered disparaging to Native Americans, the cancellation test in *Harjo* survives the holding of the case.<sup>252</sup> This disparaging nature test could be reformed to include indigenous TCEs used by third parties.<sup>253</sup>

While cancellation procedures allow indigenous groups in the United States to prevent disparaging or scandalous use of their TCEs, a problem arises where a third party does not use indigenous TCEs in a disparaging manner.<sup>254</sup> Here is where the PTO examiner and advisory groups, like the advisory committee created to benefit the Maori people, would provide a gateway function in preventing the misappropriation of TCEs.<sup>255</sup> The PTO examiner has authority to reject the registration of a trademark if it is based on “institution, beliefs or national symbols.”<sup>256</sup> Therefore, the PTO examiner in U.S. trademark cases has sufficient authority to reject indigenous TCEs, which often represent the institutional knowledge, belief systems, or national symbol of an indigenous group.<sup>257</sup>

There remains a serious question as to the practicality of a PTO examiner identifying indigenous marks. However, an advisory committee would allow the proper identification of TCEs before improperly granting trademark registration.<sup>258</sup> A full-blown advisory committee is not required; the PTO examiner can allow objections by indigenous groups and other non-profit organizations to trademarks that violate the Lanham Act.<sup>259</sup>

This method of gate-keeping TCEs is not a new concept.<sup>260</sup> Article 4 of the WIPO draft papers allows third parties to seek direct permission for the usage of a TCE.<sup>261</sup> While the draft provisions seek to shift the gate-keeping function to specific indigenous cultures themselves and rely on the education of indigenous groups,<sup>262</sup> the simpler solution is to rework traditional IP regimes already in place. Moreover, allowing third parties to object to TCEs, rather than placing the burden on indigenous peoples, permits educated, non-profit groups to protect

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250. *Id.*

251. *Id.* at 1707.

252. *Id.*

253. See ZOGRAFOS, *supra* note 216, at 101.

254. *Id.*

255. See Chalk & Dunlop, *supra* note 17, at 971.

256. Lanham Act of 1946 § 2(a), 15 U.S.C. § 1052(a) (2006).

257. *Id.*

258. See Chalk & Dunlop, *supra* note 17, at 971.

259. 15 U.S.C. § 1052(a).

260. WIPO Draft, *supra* note 15, at 24.

261. *Id.*

262. *Id.*

indigenous TCEs.<sup>263</sup> Making suggestions to the trademark office, like the Maori's Advisory Committee,<sup>264</sup> could prevent future registration of TCEs.<sup>265</sup> Overall, an international system based on the New Zealand model and within WIPO's current administrative framework could prevent the misappropriation of trademarks of indigenous cultures.

### *3. Commercial Use Requirement of Trademark Law Prevents Indigenous Groups from Asserting Trademark Rights*

Another criticism of utilizing traditional trademark law as a basis for TCE protection is the requirement of commercial use.<sup>266</sup> One of the requirements for the creation of a trademark right is that the mark be used in commerce.<sup>267</sup> This 'use in commerce' requirement is one of the foundations of trademark law.<sup>268</sup> Indigenous groups simply wish to protect their TCE against any commercial use, especially of their sacred items.<sup>269</sup>

Rather than requiring indigenous groups to trademark their TCEs to prevent third party use, cancellation procedures could prevent misappropriation based on a mark's affiliation with an indigenous group.<sup>270</sup> Cancellation could therefore reconcile indigenous concerns over cultural ownership.<sup>271</sup>

Typically, a trademark user can only prevent others from using the mark once the trademark is properly registered.<sup>272</sup> However, other provisions of trademark jurisprudence exhibit the relatively insignificant nature of proper ownership.<sup>273</sup> If the indigenous property in question consists of disparaging or false connections to their "institutions, beliefs, or national symbols," then such items would never be granted registration by a trademark examiner.<sup>274</sup> One solution for increasing indigenous protections is to instruct trademark examiners to competently screen indigenous marks that qualify under this provision, which is comparable to WIPO's suggestion to educate indigenous groups on their legal

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263. *See id.*

264. *See Chalk & Dunlop, supra* note 17, at 971.

265. *See ZOGRAFOS, supra* note 216, at 101.

266. *Id.*

267. Lanham Act of 1946 § 1, 15 U.S.C. § 1051 (2006).

268. *See generally id.*

269. ZOGRAFOS, *supra* note 216, at 101.

270. *See* 15 U.S.C. § 1052(a).

271. JANE E. ANDERSON, LAW, KNOWLEDGE, CULTURE: THE PRODUCTION OF INDIGENOUS KNOWLEDGE IN INTELLECTUAL PROPERTY 188 (2009) (discussing the issue of cultural ownership, which is contrary to the ideals of indigenous cultures' sense of ownership).

272. GRAEME B. DINWOODIE & MARK D. JANIS, TRADEMARKS AND UNFAIR COMPETITION: LAW AND POLICY 228 (3d ed. 2010).

273. *See generally* 15 U.S.C. § 1052(a).

274. *Id.*

rights.<sup>275</sup> By educating trademark examiners to recognize sacred indigenous properties, misappropriation could be prevented early in the process of trademark approval.<sup>276</sup>

4. *No Current International Trademark Regime Adequately Protects Indigenous Cultures*

The final criticism is the lack of a comprehensive protection system.<sup>277</sup> This is one area where the WIPO draft provisions can have a significant role.<sup>278</sup> In Article 4 of the draft provisions, WIPO provides that TCEs' rights can be granted when consent is received from the governing body for the indigenous group in question.<sup>279</sup> Applied in a trademark context, this would allow the trademark office a streamlined process to grant TCE rights to third parties while also protecting indigenous groups.<sup>280</sup> While the lack of an international protection scheme remains a problem, the issue of high costs is unavoidable without some third party intervention or benefit-sharing system.<sup>281</sup> Under WIPO's draft provisions, these costs would be subsumed by the newly created agency under WIPO's purview, which would be used to educate indigenous cultures on their legal rights.<sup>282</sup> However, when combined with a Maori-like advisory committee, the WIPO draft provisions could provide substantial relief from cost burdens to indigenous cultures.<sup>283</sup> Instead of requiring indigenous cultures to constantly object to every TCE ownership application by a third party, a procedure requiring the indigenous culture's consent merely requires a simple yes or no.<sup>284</sup> Incorporated on the international level, this system would acknowledge that indigenous cultures retain ownership rights, and it would also provide a mechanism to reject unwanted exploitation of TCEs.<sup>285</sup> Moreover, a Maori-like advisory committee would shift costs away from indigenous groups and allow international organizations like WIPO to bear most of the costs.<sup>286</sup>

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275. See WIPO Draft, *supra* note 15, at 38.

276. See *id.*

277. ZOGRAFOS, *supra* note 216, at 101.

278. See WIPO Draft, *supra* note 15, at 24.

279. *Id.* A problem still arises as to whether the indigenous group in question truly represents the will of the entire culture. This problem will hopefully be alleviated when WIPO's services are offered to indigenous groups, who will fully counsel the indigenous groups in question. However, if group consent cannot be achieved, WIPO's provisions would simply deny registration of the recommended mark. See *id.*

280. See *id.*

281. *Id.*

282. *Id.*

283. See *id.*

284. See *id.*

285. See *id.*

286. See *id.*

*B. Advantages of a Trademark Model*

The key benefit in relying on a traditional IP model is the centuries of fine-tuning, culminating in the current trademark system.<sup>287</sup> Evolving case law and social norms have created a trademark system in the United States that is concerned with the protection of commercial interests,<sup>288</sup> and that is influenced by the public policy concern of protecting minority interests.<sup>289</sup> While many countries and international bodies attempt to create their own new and unique protection systems,<sup>290</sup> many of those attempts pose a serious administrative nightmare on the global scale.<sup>291</sup>

The first advantage of relying on U.S. trademark jurisprudence to structure the administrative aspects of a global protection regime is that various international trademark regimes are already in place.<sup>292</sup> These systems currently enjoy compliance by a majority of countries.<sup>293</sup>

Regardless of the substantive disconnects within indigenous protection schemes, recent reforms attempt to disregard these procedural foundations and advance a new international system.<sup>294</sup> WIPO's draft provisions are the only current international effort to protect indigenous TCEs.<sup>295</sup> According to the WIPO draft provisions, WIPO would provide most of the administrative duties in establishing a protection system for indigenous peoples,<sup>296</sup> in addition to its current responsibilities of handling other IP treaties and arbitrations.<sup>297</sup> While WIPO's ambition may be lauded, the draft provisions speak nothing as to the costs, manpower, and practicality in forming this new system of trademark protection.<sup>298</sup> By structuring reform based on existing administrative procedures

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287. DINWOODIE & JANIS, *supra* note 272, at 4.

288. *Id.* at 5.

289. See Lanham Act of 1946 § 2(a), 15 U.S.C. § 1052(a) (2006) (noting various bars for approving a trademark in the United States).

290. Compare Chalk & Dunlop, *supra* note 17 (discussing the Maori advisory committee's role in New Zealand's trademark practice), and Obaldia, *supra* note 79, at 338 (discussing Panama's law protecting indigenous IP creations), with WIPO Draft, *supra* note 15 (discussing the creation of a new international IP protection regime for indigenous groups).

291. See Chalk & Dunlop, *supra* note 17, at 971-74; Obaldia, *supra* note 79, at 338-41.

292. While both international and multinational treaties exist regarding trademark registration, most all of these regimes rely solely on providing procedural guidelines in the registration of a trademark. These treaties neglect to provide substantive rights to those indigenous groups affected by misappropriating trademarks. See *supra* Part IV.

293. WIPO Treaties, *supra* note 132.

294. See WIPO Draft, *supra* note 15.

295. *Id.*

296. See *id.* at 19.

297. WIPO Treaties, *supra* note 132.

298. See generally WIPO Draft, *supra* note 15. While WIPO's draft provisions are still in the substantive review stage, none of the commentaries or debated articles inquired about the potential practicality of costs in enacting the proposed treaty.

and international treaties already in place,<sup>299</sup> and limiting reform to the fundamental policies embodied by traditional trademark law,<sup>300</sup> administrative strain could be distributed.

The international community's willingness to abandon traditional IP regimes in favor of a *sui generis* protection system is premature.<sup>301</sup> The dangers of creating *sui generis* systems were shown by Panama's Law No. 20, where the focus in the law was shifted to only commercial interests.<sup>302</sup> The greatest flaw in WIPO's recommended *sui generis* system is the delay of actual reform.<sup>303</sup> From its initial procedural gesture, to the current substantive draft provisions, nearly a decade passed with no real enforceable agreement.<sup>304</sup> While any international agreement would suffer the same fate, adding reform amendments to existing international treaties would be more efficient than creating a brand new protection scheme from scratch.<sup>305</sup>

Trademark law itself is the product of substantial reform, which has endured the test of time<sup>306</sup> and could withstand substantial reform without abandoning its core structure.<sup>307</sup> The Lanham Act is an example of how U.S. trademark law advocates emerging public policy issues.<sup>308</sup> *Harjo* exhibits the possibility of bringing suit against a disparaging trademark.<sup>309</sup> New Zealand laws demonstrate how reform can be accomplished by the creation of an advisory committee, which can be successfully integrated into the country's trademark system.<sup>310</sup>

## VII. CONCLUSION

Currently, no international IP regime protects the indigenous rights to TCEs, and exploitation of these groups and their TCEs continues.<sup>311</sup> Individual countries have, however, attempted to combat the exploitation of their native groups.<sup>312</sup> For example, New Zealand boasts the most protective scheme for protecting indigenous IP in the case of misappropriated trademarks.<sup>313</sup> Panama, however,

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299. See generally *id.*

300. Sinn, *supra* note 161, § II.

301. WORLD INTELLECTUAL PROP. ORG., *supra* note 20, at 3.

302. See Obaldia, *supra* note 79, at 365.

303. See Mara, *supra* note 158.

304. *Id.*

305. CHRISTIANE GERSTETTER ET AL., THE WORLD INTELLECTUAL PROPERTY ORGANIZATION—AN INSTITUTIONAL MODEL FOR U.N. ENVIRONMENTAL REFORM? 22 (2009).

306. DINWOODIE & JANIS, *supra* note 272, at 4.

307. *Harjo v. Pro-Football*, 50 U.S.P.Q. 2d 1705 (T.T.A.B. 1999).

308. Lanham Act of 1946 § 2(a), 15 U.S.C. § 1052(a) (2006).

309. *Harjo*, 50 U.S.P.Q. 2d at 1705.

310. See Chalk & Dunlop, *supra* note 17, at 972.

311. Indigenous Status, *supra* note 5, at 69-70.

312. See *supra* Parts II-III.

313. See Chalk & Dunlop, *supra* note 17, at 972.

limits its protection for indigenous groups to commercially viable IP that would benefit Panama's local economy.<sup>314</sup>

WIPO attempts to create a new system of protecting indigenous groups,<sup>315</sup> but is mired in procedural thicket and debate.<sup>316</sup> A viable international protection model for indigenous groups must be shaped around existing international property legal structures. By using the backdrop of U.S. trademark law and incorporating novel reforms from across the globe, indigenous peoples, properties, and culture can be protected.

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314. See Obaldia, *supra* note 79, at 365-68.

315. See Mara, *supra* note 158.

316. See Sinn, *supra* note 161.

