

MINDING CULTURE

CASE STUDIES ON INTELLECTUAL PROPERTY AND TRADITIONAL CULTURAL EXPRESSIONS

*prepared by
Ms. Terri Janke
for the World Intellectual Property Organization*

Study n° 1

This is one of a series of Studies dealing with intellectual property and genetic resources, traditional knowledge and traditional cultural expressions/folklore

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WORLD
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FOREWORD

The relationship between intellectual property protection and the rights and interests of Indigenous and local communities in expressions of their traditional cultures (or 'folklore') has been the subject of international discussion for several decades.

Discussion of policy and legal options for the improved protection of expressions of traditional cultures should be guided as far as possible by the real needs articulated by Indigenous and local communities and, most importantly, their actual experiences with the intellectual property system. This was one of the key findings of extensive fact-finding and consultations conducted by the World Intellectual Property Organization (WIPO) since 1998.

More recently, the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore is making significant progress in identifying and clarifying the relevant issues and in developing policy and practical responses to them. The Committee, comprising States and non-governmental organizations and representatives of Indigenous and local communities, has also expressed the need for practical and empirical information on the usefulness of the intellectual property system in this area as a basis for its policy and practical work.

This publication, 'Minding Culture: Case Studies on Intellectual Property and Traditional Cultural Expressions', written for WIPO by Ms. Terri Janke of Australia, responds directly to this need. The Case Studies provide factual and practical information, based on specific cases, on actual and attempted use of the existing intellectual property system by Indigenous Australians and legal and practical lessons learned therefrom. They contain examples of how designs, copyright and trade marks have been used by Indigenous communities to protect and promote their arts, cultures and identities, as well as, where so desired, their economic interests. They also indicate, in a practical context, in which respects existing systems were not seen by communities as meeting their interests, and that non-intellectual property measures also have a role to play in securing comprehensive and effective protection. These Studies will be a useful resource for policy makers at the international, regional and national levels, private legal practitioners, Indigenous and local communities and other stakeholders.

I wish to thank Ms. Janke and all the communities, individuals and organizations whom she consulted, as well as the artists and communities who consented to the use of their artworks, designs and other creations in the publication, for this most valuable contribution to the development of practical and policy responses to the challenges posed by the protection of expressions of traditional cultures and folklore.

Kamil Idris,
Director General,
WIPO



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INTRODUCTION BY THE AUTHOR

This publication, *Minding Culture: Case Studies on Intellectual Property and Traditional Cultural Expressions*, presents specific and actual examples where Indigenous Australians have explored and used intellectual property laws to protect their arts and cultural expressions. The following case studies report on the use of copyright, trademarks and designs:

1. The Carpets Case: M*, Payunka, Marika & Others v Indofurn (copyright)
2. Use of Trade Marks to Protect Traditional Cultural Expressions (trade marks)
3. Bulun Bulun & Anor v R & T Textiles Pty Ltd (copyright)
4. Industrial Designs and their Application to Indigenous Cultural Material (industrial designs)
5. Protection of Indigenous Dance Performances (copyright)
6. Unauthorized Reproduction of Indigenous Rock Art (copyright)
7. Marketing and Merchandising of Art: Desert Trade Mark and Copyright Licensing (copyright, trade marks)
8. Indigenous Arts Certification Marks (trade marks)

In many instances, they show how Indigenous Australians have been able to do so through acquiring, exercising, enforcing and managing intellectual property rights.

However there are shortfalls in the intellectual property system, as the studies indicate. For example, stories that are orally transmitted are often not protected under copyright, at least not in common law systems. Works that are very old, where the original creator passed away more than fifty years ago, are not protected. Economic remedies are the focus of copyright and trademark actions, not cultural rights. The costs of and procedures for designs and trademarks registration often hinder Indigenous people's access to and use of the intellectual property system.

I also wish to emphasize that intellectual property law is just one avenue Indigenous Australians have explored for protecting traditional knowledge and cultural expressions. Other strategies are being employed as Indigenous people assert their rights to own and control their traditional knowledge and arts. These include:

- the use of contracts;
- the establishment of collective management systems;
- the drafting of cultural protocols;
- the use of knowledge management systems; and
- the strengthening of Indigenous customary laws.

Indigenous Australians continue to call for *sui generis* legislation to protect Aboriginal and Torres Strait Islander traditional knowledge and cultural expressions. They ask for recognition of their cultural rights within the Australian legal and policy framework.

" This means not only recognizing the uniqueness of Indigenous culture but also respecting it and understanding that Indigenous knowledge and Western knowledge are two parallel systems of innovation. Furthermore, it must be recognized that Indigenous customary laws and the existing Australian legal system are two parallel systems of law, both of which need to be given proper weight and recognition." (Terri Janke, *Our Culture: Our Future – Report on Australian Indigenous Cultural and Intellectual Property Rights*, Michael Frankel and Company, Sydney, 1999, p. 112)

These case studies were originally researched and written in 2000. Only case studies 7 and 8 were updated in 2003. The Terms of References for the studies can be found at the end of the publication.

Unless otherwise indicated, references to legislation are to the applicable legislation in Australia.

Thank You.

Terri Janke

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INTRODUCTION

In 1993, imported carpets reproducing copyright works of Indigenous artists were found to be infringements of each Indigenous artist's works. The artistic works embodied pre-existing cultural clan images that were, in some instances, altered by the carpet manufacturer, thereby distorting the cultural message of the works. The artists instituted a copyright action against the company which had imported the carpets, Indofurn Pty Ltd ("Indofurn"), successfully winning their case. This case resulted in the landmark Federal Court decision *M*(deceased) v Indofurn*,¹ representing an accommodation of copyright law to protect Indigenous art and cultural expression.

Banduk Marika is an Aboriginal artist from Yirrkala. Of the artists that initiated the case, she is the only artist who is still living. Her work *Djanda and the Sacred Waterhole* was copied directly from an educational portfolio produced by the National Australian Gallery. This study will examine the case with reference to Banduk Marika's work and the underlying traditional knowledge of her people, the Rirratingu clan.

SUMMARY OF THE FACTS

Carpets reproducing the works of several prominent Indigenous artists were discovered by the National Indigenous Arts Advocacy Association (NIAAA).

Three artists, George M* (now deceased), Kumantjayi Tjapangati (now deceased) and Banduk Marika, together with the Public Trustee of the Northern Territory on behalf of deceased artists (see textbox below for full list of artists and relevant artistic works) brought an action against Indofurn², a Perth-based import company. The company imported the carpets from Viet Nam, a country that is not a signatory to the Berne Convention for the Protection of Literary and Artistic Works, 1971 (the "Berne Convention"). Copyright was protected in Viet Nam first by way of an Ordinance on Copyright (1994). The Ordinance was subsequently replaced by the Civil Code, which came into effect from July 1, 1996.³

Banduk Marika
George M*
Gamarang

Djanda and the Sacred Water Hole
Goose Egg Hunt
Wititj

This bark painting depicts the story of the Wagilag Sisters. The artist knew both the "inside" and "outside" of the story and only the "outside" story could be disclosed to women and children.

Ngaritj⁴
Wamut

Freshwater Fish
Crow and Praying Mantis

Artists 2 - 5 come from Ramingining, Central Arnhem Land. Bark paintings.

Tim Payunka Tjapangati
Tjaltjarri
Jangala

Kangaroo and Shield People Dreaming
The Seven Sisters
Emu Dreaming

Artists 6 - 8 are from Central Australia and are desert dreamings.

NIAAA became aware of the carpets when they were contacted by a salesperson from a Sydney carpet store. The salesperson was interested in knowing whether the “Aboriginal carpets” for sale in the store were authentic. When staff at NIAAA saw the carpets they identified them as copying the original works of several well-known Aboriginal artists.

The artists were all very prominent. George M* had been the first Aboriginal artist to have a solo exhibition at the National Australian Gallery. His work *Goose Egg Hunt*, which was reproduced on the carpets, is owned and displayed by the National Gallery of Australia. It was reproduced on the 85-cent stamp issued in 1993 to celebrate the International Year of World's Indigenous Peoples.

Banduk Marika is herself an internationally acclaimed artist. She is the first Aboriginal to be appointed to the Board of the National Gallery of Australia. She is a board member of the Museum and Art Gallery of Northern Territory. She is also Chairperson of Yirrkala Landcare and takes an active role in cultural environment issues.

Banduk's work was reproduced from an education portfolio of Aboriginal artwork produced by the Gallery in 1988. One of the main purposes of the portfolio was to educate teachers and students about the importance of Indigenous cultures. According to evidence given to the Court, the portfolio was at the carpet factory in Viet Nam when a director of Indofurn first visited it.

In June 1992, after production and importation of the carpets had commenced, Indofurn sought advice on copyright permission from the Aboriginal Legal Service of Western Australia. A letter was written to the Aboriginal Arts Management Association (AAMA, later called NIAAA) informing them of the reproduction of their paintings and the importation of the carpets. The letter enclosed photographs of the carpets and details of the artists together with a cheque for A\$750.⁵ The cheque was claimed by the respondents to represent 8% of the landed costs of A\$180 per carpet. This letter was addressed incorrectly and was never received by NIAAA.⁶

In November, Indofurn sent a copy of the letter to NIAAA. Staff at NIAAA contacted the artists to let them know of the carpets. The artists expressed outrage at the use of their works in this way. They refused permission and sought assistance from NIAAA to take action against the illegal importations. NIAAA returned the cheque and commenced action.

In the course of proceedings it was discovered that Indofurn imported approximately 200 carpets totalling about 850 square metres of carpets. Some of the carpets were for sold for over A\$4,000 each.

THE TRADITIONAL KNOWLEDGE

Banduk's work is central to the cultural heritage of her people, the Rirratingu clan. The original work is a six colour linocut, ink on paper. She created the work in 1986. By drawing original art onto plates, she made a small number of prints. The work was made under commission for the Australian National University for the Bicentenary celebrated in Australia in 1988. One of the prints was purchased by the National Gallery of Australia and another one was purchased by Jennifer Isaacs who reproduced the print with the artist's permission in her book, *Aboriginality*.⁷ According to Banduk, she allowed Ms. Isaacs to reproduce “because I knew that she would do so in a respectful and appropriate way and not in a

commercial way. The technique which I adopted of making my artwork directly in a form for printing was, I believe, the first time this technique has been used by an Aboriginal artist.”⁸

In the Australian National Gallery portfolio, Banduk’s name and clan were printed alongside the work. Her consent to reproduce the work in the portfolio was obtained by the Gallery subject to formal approval and royalty agreements with the artist or her representatives.

Banduk explains the significance of the painting:

“The image in question relates to a site on Rirratjingu clan land where our creation ancestors, the Djangkawu, visited on their journey across Arnhem Land. The Djangkawu were the original ancestors of the people of the Dhuwa moiety.

The image is associated with a place on Rirratjingu land called Yalangbara (which is at Port Bradshaw south of Yirrkala) and represents the events associated with the Djangkawu that took place there. My rights to use this image arise by virtue of my membership of the land owning group. The right to use the image is one of the incidents arising out of land ownership.

When the Djangkawu handed over this land to the Rirratjingu they did so on the condition that we continued to perform the ceremonies, produce the paintings and the ceremonial objects that commemorate their acts and journeys. Yolngu guard their rights in paintings and the land equally. Aboriginal art allows our relationship with the land to be encoded, and whether the production of artworks is for sale or ceremony, it is an assertion of the rights that are held in the land.

The place, Yalangbara, and the particular story of the Djangkawu associated with it do not exist in isolation. They are part of a complex or “dreaming track” stretching from the sea off the east coast of Arnhem Land through Yalangbara, across the land to the west of Ramingining and Milingimbi.”⁹

Djanda is the sand goanna and the image relates to information about that country on a number of levels. Djanda is part of a bigger story, the nature of which cannot be disclosed generally.”¹⁰

Communal Ownership

The underlying knowledge of the artwork and the image itself belong to the Rirratjingu clan communally. Banduk notes:

“My artwork which has been reproduced on carpets by the respondents herein is known as the “Djanda Sacred Waterhole.” The image is an image which belongs to my clan, the Rirratjingu, and forms part of the mythology of the Djangkawu creation story. The image is of great importance to my clan and also has importance to clans in neighbouring areas, which have rights in this image.”¹¹

Banduk is the daughter of Mawalan (1), leader of the Rirratjingu clan of northeast Arnhem Land until his death in 1967. Mawalan (2) is now the senior representative of the clan. Mawalan had given permission to Banduk to depict the image. Mawalan is responsible for the land and associated clan designs. He has *manala*, meaning he has “deep knowledge” about the area Yalangbara - north of Port Bradshaw in Arnhemland. Mawalan was given the

responsibility over land and culture by his father Wandjuk Marika.¹² According to Mawalan, Banduk is also not allowed to know the deep knowledge of the area. There are some places women are not permitted to see or to visit.

Mawalan refers to the story, art, place and entirety of Yalangbara as “his backbone.”¹³ In 2001, Mawalan took action against another man who was digging in Yalangbara for well water. Mawalan says, “He was digging up my backbone.” The action was taken in respect of land and the sacredness of the land. Mawalan won the case and was able to stop the digging of the waterhole.

Yalangbara was registered as a sacred site-complex with the Aboriginal Areas Protection Authority in 1983. A detailed Heritage Assessment of the area, prepared recently by Geoffrey Bagshaw and Banduk Marika,¹⁴ outlined the cultural significance of the work, and included an inventory of artistic works depicting the site.

Most of the Yalangbara area is traditionally owned by the Rirratjingu *baparru*, a Yolngu estate-owning group recruited mainly through the father.¹⁵

Both the estate (*yiralka*) and the membership (*mala*) of the Rirratjingu are affiliated with the Dhuwa moiety, which is one of the two main categories in which the entirety of the Yolngu cosmos is divided - the Dhuwa and the Yirritja. Like the moieties, each *baparru* must marry outside the group. For Rirratjingu people, this is a fundamental rule of social organization. There is a connection with land as offspring of mothers from moieties. Djanda is a facet of that *baparru*.¹⁶

Timmy Burarrwanga, Gumatj clan, explained the significance of Yalangbara as the parliament of the Yolngu - it is where the Mawalan Mace originated.¹⁷ It is very important. Timmy's family has a responsibility to keep Banduk's knowledge strong.

Under customary laws of the Yolngu people, any decisions pertaining to their estate require the direct input of Rirratjingu traditional owners (*nayi watangu* - “country belonging to”) and/or persons designated as ritual and territorial guardians (*djungaya*).¹⁸

Commercialisation of Traditional Knowledge

The traditional custodians and the artists consent to reproduction of artistic works of significance where the reproduction is in a prestigious publication for the purposes of educating members of the non-Indigenous community about Aboriginal culture.¹⁹

Although Banduk has the right to depict the image, she must be cautious of its reproduction, and in particular, any commercial exploitation. She notes:

“I have always been concerned not to engage in the commercial exploitation of imagery which is of importance to my clan such as the waterhole image herein. The reproduction of the image on carpet has caused me great distress because I believe it desecrates the story which is partly told by the imagery in waterhole artwork.”²⁰

Banduk had created the work for culturally appropriate display in a reputable art gallery. The reproduction of the artwork on carpets, where it would be walked on, is totally opposed to the cultural use of the central imagery and underlying knowledge in her work.

Figure 1. Banduk Marika, *Djanda and the Sacred Waterhole*



Author: Ms. Banduk Marika
All rights reserved
This work is the copyright of the artist and may not be reproduced in any form without the permission of the artist and the clan concerned.

Figure 2. Carpet produced by Indofurn reproducing Banduk's work



All rights reserved

Impact of Infringement on Artist and Culture

The reproduction of the image on carpets caused Banduk great stress and anxiety. She was worried that other Yolngu may see or learn about the carpets and question her involvement in the manufacture. Further, she was concerned that continued right to use the image would be revoked.

She noted:

“Even though I know that I am not responsible for the reproduction I am still concerned about the ramifications for me and my work within Yolngu society, and I greatly fear a loss of reputation arising from Yolngu associating me with the reproduction. I fear that my family and others may accuse me of giving permission for the reproduction behind their backs without consulting and seeking permission in the manner required by our law and culture. I fear that this could result in my family and others deciding that I cannot be trusted to use important images such as this one any more.

This would not only threaten my artistic and economic livelihood but also my ability to participate fully in Yolngu society and cultural practice.”²¹

CUSTOMARY LAWS AND REGIMES

Under Aboriginal law, the right to create artworks depicting creation and dreaming stories, and to use pre-existing designs and totems of the clan, resides with the traditional owners as custodians of the images. The traditional owners have the collective authority to determine whether these images may be used in an artwork, by whom the artwork may be created, by whom it may be published, and the terms, if any, on which the artwork may be reproduced. The extent to which an artwork bearing a pre-existing design can be reproduced will depend upon the subject matter of the work. For instance, an artwork that is associated with a public story or ceremony might have fewer restrictions than an artwork that embodies a dreaming or creation story.

Aboriginal artwork will often depict secret parts of a dreaming that will only be recognised and understood by those who are initiated into the relevant ceremonies, or at least have a close knowledge of the cultural significance of the story. It is therefore important that any reproduction is accurate in every respect and done with full, proper permission of the artist and community so as not to offend the traditional owners.

DECISION-MAKING AND CONSENT

Banduk first heard about the carpets when she was contacted by the then Executive Officer of the Aboriginal Arts Management Association (now NIAAA).

Banduk says she was hurt when she found out about the carpets. “They didn’t understand the importance of the art - art is my culture - my identity.”²²

Banduk also put it like this:

“It’s like the Queen and the monarchy. They have their symbols and uniforms and it’s passed down through one line of the family. It doesn’t go anywhere else. That is what Aboriginal art is about.”²³

Banduk had to conceal the infringement from members of her clan whilst she began action against Indofurn. If it had become widely known in her community, Banduk believes that her family could have told her to stop producing artwork or restricted her participating in ceremonies. The clan might have also made her an outcast and sought recompense from her.²⁴

Knowledge of Copyright

Before taking the case, Banduk had little knowledge of copyright law. Six years since the case was brought, Banduk now has a very good knowledge of copyright law. She is a leading advocate for Indigenous artists asserting their rights under copyright and has presented at many conferences regarding copyright.

Unauthorised Reproduction under Customary Law

If a story or design is reproduced without the permission of the traditional custodians, it is the responsibility of the traditional custodians (or owners) to take steps to preserve the dreaming and to punish those responsible for the breach. The court noted:

“If permission has been given by the traditional owners to a particular artist to create a picture of the dreaming, and that artwork is inappropriately used or reproduced by a third party, the artist is held responsible for the breach which has occurred, even if the artist had no control over or no knowledge of what occurred.”²⁵

There are severe consequences for misuse of artwork without permission. According to Banduk Marika, in the past the offender could be put to death. However now there are other forms of punishment including taking away the rights to participate in ceremonies, the removal of the right to reproduce designs of that or any other story of the clan, being outcast from the community, or being required to pay money. Other evidence in the case noted being speared as another possible consequence.²⁶

INTELLECTUAL PROPERTY PROTECTION

Copyright in Artworks

Copyright protects artistic works that are original and in material form. Under Australian law, copyright continues to subsist until 50 years after the end of the calendar year in which the author dies.²⁷ After this period, works are considered to be in the public domain. Once in the public domain, works are free to be used by others without having to get the consent of the copyright owner.

Although four of the artists were deceased, they were not deceased for more than fifty years. Hence, copyright still subsisted in their works. The Public Trustee of Northern Territory brought the action on behalf of the deceased artists’ families and representatives.²⁸

The Artists' Rights

The copyright owner of an artistic work has the exclusive right to do all or any of the following acts:

- to reproduce the work in a material form;
- to publish the work;
- to communicate the work to the public.²⁹

Importation of Artworks

It is an infringement of copyright to import copies of artistic works without the license of the copyright owner for the purposes of sale, distribution or trade, if the importer knew, or ought reasonably to have known, that the making of the article would, if the article had been made in Australia by the importer, have constituted an infringement of the copyright.³⁰ The relevant section of the Copyright Act is set out below.

SECTION 37 OF COPYRIGHT ACT, 1968 (CTH)

The copyright in a literary, dramatic, musical or artistic work is infringed by a person who, without the licence of the owner of copyright, imports an article into Australia for the purpose of:

- selling, letting for hire, or by way of trade offering or exposing the sale or hire, the article;
- distributing the article:
 - for the purpose of trade; or
 - for any other purpose to an extent that will affect prejudicially the owner of the copyright;
- by way of trade exhibiting the article in public,

if the importer knew, or ought reasonably to have known, that the making of the article would, if the article had been made in Australia by the importer, have constituted an infringement of the copyright.

For a claim of infringement under the importation provisions to be made out, it must be established that the importer knew or ought reasonably to have known that the carpets would, if made in Australia by the importer, have constituted an infringement of copyright. For the purposes of section 37, the court noted that "(k)nowledge refers to notice of facts such as would suggest to a reasonable person having the ordinary understanding expected of persons in the particular line of business that a breach of copyright was being committed."³¹ The court considered that it was not necessary to establish actual knowledge and constructive knowledge was sufficient.³² "It is sufficient that there be actual or constructive knowledge that intellectual property rights would be infringed, without knowing the precise nature of those rights."³³

Justice Von Doussa was satisfied that the company, via its active director, had constructive knowledge of the infringement. That is, he had knowledge of facts that would suggest to a reasonable person, particularly one about to engage in the business of distributing carpets in Australia, that a breach of copyright law would be committed if the carpets were to be made in Australia.

Infringement

Did copyright subsist in the Indigenous artworks?

At the beginning of the trial, Indofurn disputed that copyright subsisted in the works. The issue before the court was whether a work incorporating pre-existing traditional designs and images was original and therefore subject to copyright protection. By the end of the trial the respondents admitted copyright ownership of the artists. The judge was of the opinion:

“Although the artworks follow traditional Aboriginal form and are based on dreaming themes, each artwork is one of intricate detail and complexity reflecting great skill and originality.”³⁴

Were the carpets infringing copies of the Indigenous artworks?

It is an infringement of copyright to authorise or to do any of the acts controlled by the copyright owner without permission of the copyright owner.³⁵ It is also an infringement of copyright to do any of those acts in relation to a substantial part of an artistic work. These acts are outlined above.³⁶ Indofurn’s carpet was a direct copy of the original work. Hence, the judge found that the carpets were a copyright infringement of ***Djanda and the Sacred Waterhole***. The other carpets which reproduced the works of George M*, Wamut and Ngaritj were direct copies and were found to be copyright infringements of the original works.

Under the Copyright Act, it is not necessary for an artwork to be an exact copy. It is also an infringement to copy a substantial part of an artistic work. A substantial part of an artistic work does not necessarily refer to a large part of the work, quantitatively measured. A range of issues are relevant including the quality of the part taken. Generally, to consider this issue, the Court will look at the striking similarities between the original artwork and the infringing copy. Quality is more important than quantity and depends largely on the nature of the parts taken from the original artwork.

Justice Von Doussa noted that the altered images on the carpets, although not identical to the artworks, reproduced parts of the original artworks that were centrally important to that particular artwork. For instance, in considering whether the Green Centre Carpet of Indofurn infringed Tim Payunka Tjapangati’s artwork “Kangaroo and Shield People Dreaming”, the judge noted that the part reproduced was an important part of the overall work which depicted a sacred men’s story.³⁷ This factor was significant in leading the Court to conclude that copyright had been infringed.³⁸

Further, the judge considered that “*animus furandi*” was amongst the most important considerations in establishing substantial reproduction. That is, it was the intention on the part of the designers to take from the artworks for the purpose of saving themselves labour.³⁹ This consideration was satisfied in the opinion of the judge given that the original works were at the factory and a director of Indofurn had given instructions to produce the carpets in designs that were less complicated.⁴⁰

According to Colin Golvan, the determination of substantial copying in the works that were altered is a significant aspect of the case.⁴¹

REMEDIES UNDER INTELLECTUAL PROPERTY LAW

A copyright owner of an artistic work has the following remedies available against infringers:

- **Injunction.** An injunction is a court order prohibiting the other party from continuing to infringe the other parties' rights.⁴²
- **Delivery Up.** Delivery up is the power of the court in equity to order the defendant to deliver up articles which have been made in contravention of the plaintiff's proprietary rights.⁴³ An infringing article is not regarded as the plaintiff's property.⁴⁴ On delivery up, the infringing articles are generally destroyed by the plaintiff or the court. If the infringer is unable to deliver up, conversion damages may be payable.⁴⁵
- **Account of Profits.** Payment of profits the infringer made in exploiting the infringing articles.⁴⁶
- **Damages.** Payment of compensation⁴⁷ for lost income from exploitation can be claimed as an alternative to account of profits. In some circumstances additional damages may be available if the infringement is flagrant.⁴⁸

In some circumstances, there may be criminal liability for copyright infringement, as in the case of large-scale piracy, and orders for seizure and delivery up can be made.⁴⁹

The court found copyright existed in the works and that the carpets had infringed the copyright in the works. The artists were able to establish that 246 carpets were made from their designs and imported between December 1991 and September 1994. The only offer ever made to the artists was around A\$14 per carpet. However, the carpets themselves sold for between A\$500 and A\$4,000 each.

The court ordered:

- Delivery up of the unsold carpets;
- Damages of approximately A\$188,640.

Delivery Up of Unsold Carpets

Indofurn was required to hand over the unsold carpets to the artists and their representatives. The total area of carpets returned was 366.59 square metre.⁵⁰ The artists dealt with the carpets in varying ways. Banduk Marika's first reaction was to burn the carpets in a private ceremony. However, one of the carpets has been put on display in the Buku-Larrnggay Mulka Museum to serve as a reminder of the case and the importance of maintaining the integrity of the artwork.

Damages

The court awarded conversion damages based on an agreed sum for landed cost on importation of A\$190 per square metre. The conversion damages amounted to approximately A\$90,000 of the total award. General damages by way of depreciation in the copyright were also awarded at A\$12,000.⁵¹

The Court made a collective award to the artists rather than individual awards so the artists could distribute it according to their cultural practices.⁵² At a meeting in 1997, the artists and their representatives agreed to share the damages equally regardless of the actual number of carpets per artist that was made.⁵³

Flagrancy Damages

The court awarded additional damages for flagrant conduct under section 115(4) of the Copyright Act (1968). Justice von Doussa considered the copyright infringements to be “plainly deliberate and calculated.” He noted that from the beginning the source of the imagery on the carpets was known to Indofurn and they had been put on notice of this by Mr Horrocks, a staff member of the Aboriginal Legal Services from whom Indofurn initially sought copyright advice, and later by AAMA.

Damages for Culturally-Based Harm

Part of the award was given in consideration of the personal hurt and cultural harm. The judge considered that the misuse of the artwork caused great upset and cultural harm to the artists. The court noted that the standing of the artist within his or her community could have been affected given the nature of the reproduction and the fact that the prior consent of the group was not sought or given. This was because, regardless of whether the artists authorised the reproduction of their artworks on carpets, they were responsible under Indigenous law for the transgression that had occurred. They were also liable to be punished for this transgression.

Non-Executive Directors

A percentage of the overall award was personally awarded against two other nominal directors of the Carpet Company. At trial, Justice von Doussa considered that they had allowed the importation of the carpets after the commencement of proceedings and therefore should personally pay A\$43,222 towards the full judgment award. The two directors were held liable only for importations which occurred after they were put on notice by the service of proceedings, and who had had time, had they chosen to do so, to react to that notice.⁵⁴

THE APPEAL CASE

The decision concerning the non-executive directors was appealed to the Full Federal Court in 1995.⁵⁵ On appeal of this issue only, the Full Court held that the inaction of the directors to act or stop the importation of the carpets did not amount to authorisation or permission by them for the continued importation of the carpets by the company.⁵⁶ On appeal, the directors argued that there was insufficient evidence against them to derive the finding of personal liability.

The Full Court found that they did not have the necessary mental element to authorise the company to continue importation, and therefore the judgment debt of A\$43,222 against them personally was overturned.

The artists sought to apply for special leave to appeal to the High Court but the appeal avenue was not pursued because a settlement was reached.

POST-CASE INFRINGEMENTS

After the case, NIAAA found another carpet produced by Indofurn which was very similar to Banduk Marika's work, *Djanda and the Sacred Waterhole*. The carpet was an "oriental" version of the first carpet. Instead of the goannas, the carpet depicted a dragon. The same colour and background remained. Ceramic umbrella stands were also discovered with reproductions of *Djanda and the Sacred Waterhole*.⁵⁷

TRADE PRACTICES

A further issue before the court was whether the carpets infringed the Trade Practices Act of 1974 (Cth). The Trade Practice Act makes it illegal for a Corporation, in trade or commerce, to engage in conduct that is misleading or deceptive or is likely to mislead or deceive.⁵⁸

Justice Von Doussa found that the labelling which stated that "Royalties are paid to Aboriginal Artists" was misleading. The labelling had also been attached to other carpets which had no Aboriginal association at all. By using such labelling, the court considered that Indofurn had misled the consumer to believe that the copyright in the artworks belonged to the company, or was licensed to it, or the carpets were approved or made under the licence and approval of the Aboriginal artists. In Justice Von Doussa's opinion, such conduct was false and misleading.⁵⁹

FINANCIAL QUESTIONS

The Aboriginal Arts Management Association (now the National Indigenous Arts Advocacy Association) coordinated the case. NIAAA receives funding for operating costs from the Aboriginal and Torres Strait Islander Arts Board of the Australia Council.

The action was jointly funded by the Aboriginal and Torres Strait Islander Commission (ATSIC) and the Aboriginal and Torres Strait Islander Arts Board of the Australia Council.⁶⁰

The Northern Aboriginal Legal Aid Services acted as solicitors for the case. Colin Golvan, a barrister specialising in intellectual property, acted as counsel for the case.

MORAL RIGHTS

Since the case, moral rights have been introduced into the Copyright Act by the Copyright Amendment (Moral Rights) Act 2000.⁶¹ The new moral rights laws give creators the right to protect the integrity of their works, the right to have their works attributed to them and the right not to have someone else's work falsely attributed to them. The new law aims to implement Australia's obligations under the Berne Convention. Moral rights are recognised in a number of jurisdictions including France, the United Kingdom, Switzerland, Canada and New Zealand.

If moral rights laws had been in existence at the time the Carpets Case was heard, the artists may have had additional claims for infringement of moral rights including:

- ***Infringement of the right of attribution of authorship.*** The author of a work has a right to be identified as the author of his or her work.⁶² The author is entitled to be attributed where his or her work has been used in a certain way. For example, the author of an artistic work is entitled to be attributed where his or her work is reproduced in material form, published, exhibited or transmitted.⁶³ The failure of Indofurn to place a reasonable prominent credit for the artist would most likely have been argued as an infringement of the right of attribution.
- ***Infringement of the right of integrity of authorship in respect of the work.***⁶⁴ This right provides that an artist may bring an action if the work is subjected to derogatory treatment. “Derogatory treatment” in respect of an artistic work includes “the doing, in relation to the work, of anything that results in a material distortion of, the destruction or mutilation of, or material alteration to, the work that is prejudicial to the author’s honour or reputation;” or “an exhibition in public of the work that is prejudicial to the author’s honour or reputation because of the manner or place in which the exhibition occurs.”⁶⁵

The right of integrity is important for Indigenous artists. Preserving the overall integrity of the work and the underlying story or ritual knowledge is extremely important to proper representation of Indigenous art and film. For instance, under the new laws, the artists could have argued an additional claim against the respondents for infringement of the right of integrity in that reproduction in such a manner was derogatory, and that the alteration of the works was derogatory treatment.

Whilst the introduction of moral rights addresses certain moral-based claims of Indigenous artists, moral rights only vest in individual copyright owners.⁶⁶ The collective ownership of rights to traditional ritual knowledge is not adequately recognised. This requirement excludes Indigenous persons from exercising moral rights over works embodying traditional ritual knowledge.⁶⁷

CONCLUSION

The decision in *M* v Indofurn* is a significant development towards greater protection under copyright laws for Indigenous art and cultural expression. The case has gone far in bringing the message of copyright and Indigenous art to the public. Shortly after the case, an exhibition toured nationally showcasing the original works with the infringements.⁶⁸

It should be noted, however, that the artists did not receive the total awarded damages. Firstly, the two non-executive directors appealed successfully against their part of the award, and Indofurn was wound up and the active director was declared bankrupt. The artists got some monies from a sum paid into Court and also from the sales of some of the carpets organised by NIAAA for their benefit.

The importance of the judgment remains despite this. There is greater assertion on the part of artists as to copyright and the community responsibilities. For instance, Buku Larrnggay Mulka now have a practice of including the community on copyright notices of artistic works:

“© Banduk Marika, 1998. This work and documentation is the copyright of the artist and may not be reproduced in any form without the permission of the artist and the clan concerned.”⁶⁹

Moreover, within the arts and the manufacturing industry, there is more awareness now that Indigenous artists are copyright owners of their works. This has resulted in licensing opportunities for artists, and some artists have even licensed works for production of carpets.

The arts practice continues in Yirrkala in accordance with artists' customary laws and obligations. As Dundiwuy Mununggur of Buku Larnnggay notes:

"In our art we tell the story, the background and knowledge of our clan, our thoughts and understanding, it goes deep, we get direction from the old people.

*The balanda copyright protection is not considered, but with the copyright case of Banduk's, it has helped to open the eyes of the Yolngu. We do the art, not expecting it to be copied, just to be kept in museums, galleries and homes for people to enjoy."*⁷⁰

The case has also served to raise awareness within the legal system including the judiciary. Justice Kirby of the High Court of Australia has noted:

*"Difficulties with extending Australia's intellectual property law to the styles and nuances of the artistic creations of Aboriginal and other indigenous people of Australia suggest that there may be a need to look specifically at the express adaptation of that law to the needs of indigenous peoples so that the law can respond to the problem and not simply impose its view of what the problem is upon all people uniformly."*⁷¹

Whilst the judgment is a precedent in the recognition of Indigenous rights within the copyright law framework, significant expressions of Indigenous cultures will not meet the requirements of copyright to benefit from these laws. For example, orally transmitted works will not meet the requirement of fixation and works of antiquity will not come within the period of protection.⁷² As Cathie Craigie, the Director of the Aboriginal and Torres Strait Islander Arts Board notes:

*"The judgment has served to discourage further infringements of Indigenous copyright though much more needs to be done to improve the protection of our culture by amendment of existing laws to recognise traditional, customary and collective ownership."*⁷³

Endnotes

- 1 ***M*, Payunka, Marika & Others v Indofurn Pty Ltd*** 30 *IPR* 209 at 210.
- 2 At the time the importations occurred the company was known as Beechrow.
- 3 Part IV, Chapter 1 of the ***Vietnamese Civil Code*** (Articles 745-779).
- 4 Skin names used for deceased artists.
- 5 References to monetary amounts are to Australian Dollars.
- 6 ***M*, Payunka, Marika & Others v Indofurn Pty Ltd*** 30 *IPR* 209 at 210.
- 7 Jennifer Isaacs, ***Aboriginality***, University of Queensland Press, St Lucia, Qld, Australia, 1989.
- 8 Banduk Marika, Affidavit, 1994.
- 9 Banduk Marika, Affidavit, 1994.
- 10 Not for women to know, according to Mawalan (2) and Marika Banduk, (Interview, Nhulunbuy, 31 July 2000).
- 11 Banduk Marika, Affidavit, 1994.
- 12 Wandjuk was one of the first advocates for copyright protection. Wandjuk is Banduk's eldest brother. He was a very important man within their clan but also in terms of Australian Indigenous arts - he was the Chairman of the Aboriginal Arts Board from 1971 - 78.
- 13 Interview with Mawalan (2) Marika, Nhulunbuy, 31 July 2000.
- 14 ***Yalangbara: A Heritage Assessment Report to the Australian Heritage Commission***, Geoffrey Bagshaw & Banduk Marika, Prepared for and on behalf of the Landcare Department, Yirrkala Dhanbul Community Association Inc, June 2000.
- 15 Bagshaw and Marika note that the Rirratjingu bapurru also includes a small number of individuals whose membership is based on paternal adoption. Bagshaw and Marika, ***ibid***, page 44.
- 16 This word is used similarly to "totem".
- 17 Meeting with Timmy Burrawarrnga, Yirrkala, 2 August 2000.
- 18 Djungaya explained in ***Bulun Bulun***, See Bagshaw & Marika, ***Op Cit***, at page 44.
- 19 ***Milpurruru and Others v Indofurn Pty Ltd and Others*** (1993) 130 ALR 659 at 662.
- 20 Banduk Marika, Affidavit, 1994.
- 21 Banduk Marika, Affidavit, 1994.
- 22 Interview with Banduk Marika, Yirrkala, 1 August 2000.
- 23 Banduk Marika quoted by Debra Jopson, "Poor Fellow, my Culture", ***Sydney Morning Herald***, 22 September 1999.
- 24 ***M* and Others v Indofurn Pty Ltd and Others*** (1993) 130 ALR 659 at 663-4.
- 25 ***M* and Others v Indofurn Pty Ltd and Others*** (1993) 130 ALR 659 at 663.
- 26 ***M* and Others v Indofurn Pty Ltd and Others*** (1993) 130 ALR 659 at 663.
- 27 Section 32(2) ***Copyright Act 1968***. See also Berne Convention.
- 28 The artists died without a will: intestacy estate management is conducted by the Public Trustee of the Northern Territory.
- 29 Section 31(1)(b), ***Copyright Act 1968 (Cth)***.
- 30 Section 37, ***Copyright Act 1968 (Cth)***.

- 31 ***Apple Computer Inc v Computer Edge Pty Ltd*** (1984) 53 ALR 225.
- 32 ***M* and Others v Indofurn Pty Ltd and Others*** (1994) 130 ALR 659 at 674.
- 33 Applied in ***Raben Footwear Pty Ltd v Polygram Records Inc & Anor*** [1997] 370 FCA (16 May 1997).
- 34 ***M* and Others v Indofurn Pty Ltd and Others*** (1994) 130 ALR 659 at 665.
- 35 Section 36, ***Copyright Act 1968***.
- 36 See above.
- 37 Evidence given by the artist. ***M* and Others v Indofurn Pty Ltd and Others*** (1994 130 ALR 659 at 678.
- 38 At 229 - 230.
- 39 ***M* and Others v Indofurn Pty Ltd and Others*** (1994)30 ALR 659 at 677.
- 40 ***M* and Others v Indofurn Pty Ltd and Others*** (1994)130 ALR 659 at 667.
- 41 See Colin Golvan, "Aboriginal Art and Copyright - An Overview and Commentary Concerning Recent Developments", Vol 1, ***Media and Arts Law Review***, page 153.
- 42 Section 115(2), ***Copyright Act 1968 (Cth)***.
- 43 ***Prince Albert v Strange*** (1849) 2 DeG & Sm 652.
- 44 Section 116, ***Copyright Act 1968 (Cth)***.
- 45 Section 116, ***Copyright Act 1968 (Cth)***.
- 46 Section 115(2), ***Copyright Act 1968 (Cth)***.
- 47 Section 115(2), ***Copyright Act 1968 (Cth)***.
- 48 Section 115(4), ***Copyright Act 1968 (Cth)***.
- 49 Sections 132, 133 ***Copyright Act 1968 (Cth)***.
- 50 ***M* and Others v Indofurn Pty Ltd and Others*** 30 IPR 209 at 241.
- 51 Colin Golvan, ***Op Cit***, page 153.
- 52 ***M* and Others v Indofurn Pty Ltd and Others*** 30 IPR 209 at 239.
- 53 It should be noted that no award of damages has been made to their artists or their representatives because Indofurn was wound up and the active director has been declared bankrupt. Further, the two non-executive directors appealed successfully against their part of the award.
- 54 ***M* and Others v Indofurn Pty Ltd and Others*** (1994) 130 ALR 659 at 687.
- 55 (1996)AIPC 91-219.
- 56 Jenkinson and Beazley JJ (with Lee J in minority).
- 57 See House of Aboriginality Website, <<http://www.mq.edu.au/hoa/stand.htm>>.
- 58 Section 52, ***Trade Practices Act 1974 (Cth)***.
- 59 Section 52 and 53, ***Trade Practices Act 1974 (Cth)***.
- 60 Communication with ATSIIC Chairman Geoff Clark, 26 March 2001..
- 61 These laws came into effect on 21 December 2000.
- 62 Section 193(1) ***Copyright Act 1968 (Cth)***.
- 63 Section 194(2) ***Copyright Act 1968 (Cth)***.

- 64 Section 195AI *Copyright Act 1968 (Cth)*.
- 65 Section 195AK *Copyright Act 1968 (Cth)*.
- 66 Section 90 *Copyright Act 1968 (Cth)*.
- 67 Terri Janke, "A Moral Issue: Moral Rights and Indigenous People's Cultural Rights", *NIAAA News*, Autumn 2001, pp 2 – 3, at 3.
- 68 Dr Vivien Johnson, *Copyrites: Aboriginal Art in the Age of Reproductive Technologies*, Touring Exhibition Catalogue, National Indigenous Arts Advocacy Association and Macquarie University, 1996.
- 69 Interview with Diane Blake, Buku-Larrnggay Mulka Arts Centre, Yirrkala, 31 July 2000.
- 70 Dundiwuy/Mundul Munungurr, Associate Printmaker, Buku-Larrnggay Arts, Yirrkala, Northern Territory, Correspondence, February 2001.
- 71 The Hon Justice Michael Kirby AC CMG, "Protecting Cultural Rights - Some Developments", United Nations Educational, Scientific and Cultural Organisation, The University of Waikato CNZJ, 12 - 13 October 1998, <<http://www.hcourt.gov.au/speeches/kirbyj/culture2.htm>>.
- 72 See Terri Janke, *Our Culture: Our Future – Report on Australian Indigenous Cultural and Intellectual Property Rights*, Michael Frankel and Company, under commission by Australian Institute of Aboriginal and Torres Strait Islander Studies and the Aboriginal and Torres Strait Islander Commission, Sydney, 1999, pp 52 – 60.
- 73 Cathy Craigie, Director, Aboriginal and Torres Strait Islander Arts Board, Correspondence to Terri Janke dated 12 April 2000.

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30 *Intellectual Property Reports* 209.

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INTRODUCTION

A trade mark is one or more words, designs or symbols that are used to distinguish goods and services of one person or firm from those of others in the marketplace. Trade marks identify a connection between producers and their products. For example, Coca-Cola®, Nike® and McDonalds® are all well-known registered trade marks. Trade marks allow firms to establish a reputation in the market place. A national system of trade marks protection is established in Australia. It is implemented under the Trade marks Act of 1995 (Cth) (the "Trade Marks Act").

The trade marks system has relevance to the protection of Indigenous traditional cultural expressions in the following ways:

- There is increasing use of Indigenous words, designs and symbols in the course of trade, by Indigenous people and by non-Indigenous entities.
- Indigenous people are concerned that many Indigenous words, designs and symbols are used as trade marks by non-Indigenous entities and individual Indigenous groups, without the proper consent being sought from traditional owners.¹
- Indigenous people want to protect their own trade interests, and in endeavouring to do so, may wish to use the trade marks system to enforce these rights.

This study will outline the trade marks system and discuss several issues concerning the ability of the existing system to protect aspects of Indigenous traditional knowledge and cultural expression. It will also report on use of the trade marks system by Indigenous Australians to consider the extent to which the system has been useful in protecting Indigenous interests.

WHAT IS A TRADE MARK?

A trade mark is "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."² A sign includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent.³ The most common form of trade mark is a word based trade mark, consisting of words, logo and devices.⁴

In Australia, the registration and administration of trade mark laws is the responsibility of IP Australia. IP Australia is a commonwealth agency responsible for granting rights in patents, trade marks and designs. Generally in Australia, there has been a significant increase in the number of trade mark applications being made. In the period from 1991 to 1998, there was almost a 100% increase in the number of trade mark applications lodged. In 1991/1992, 22 870 applications were lodged and in 1997/98, 43 127 applications were lodged with IP Australia.⁵

Unregistered Trade Marks

It is possible to use a trade mark without registering it under the trade marks system. Many Indigenous entities, particularly in the Indigenous arts industry, make use of trade marks as logos to promote and distinguish their wares.⁶ The majority of these are unregistered trade marks.

Unregistered Marks vs Registered Marks

With an unregistered trade mark, registration and payment of fees are not required. Ownership of a trade mark can be established through common law through use of the mark if it is not registered. If an unregistered mark is infringed, the owner can take action against the infringer for passing off, and would have to prove that the owner has developed a reputation in the trade mark and that the use of the infringing trade mark is likely to confuse or deceive the public.⁷

A registered trade mark, on the other hand, must be registered with IP Australia, a government authority, and fees are payable for registration. Registration provides a statutory proprietary right to the trade mark and direct evidence of ownership, which makes it easier to protect and enforce the rights of the trade mark owner.

The registration of a trade mark provides the following advantages to registered owners:

- The right to the exclusive use of the mark and to enforce that right through an action of infringement.⁸ To show infringement of an unregistered mark, the trade mark owner would need to prove reputation as is necessary in an action of passing off. A registered trade mark owner can rely on the registration of the mark to prove *prima facie* entitlement.
- Rights conferred by registration extend nationally.⁹ In actions of passing off, the owner of a common law trade mark would have to show their reputation is substantial in order to extend beyond the geographic boundaries of actual use.
- A registered trade mark is recognized as having commercial value as an asset.
- The registered owner can prevent importation of goods bearing the marks which are the same or substantially identical to the registered mark.¹⁰
- Improper use of a registered trade mark is a criminal offence.¹¹

RIGHTS OF TRADE MARK OWNERS

Once the trade mark is registered, the registered owner will be granted a type of property right to use that trade mark in association with his or her trade and in accordance with the class of goods and services approved by the Trade Marks Office. Trade marks are personal property¹² and therefore can be licensed, assigned and transmitted.

The rights exist as long as the registered owner continues to use the mark in the course of trade. Registration is for an initial 10 years¹³ and renewals of registration must be made in order for the rights to continue. This means effectively that trade mark rights can be held and maintained for as long as the registered owner continues to register the mark every 10 years and continues to use the mark in the course of trade. An unused trade mark is vulnerable to removal for non-use on the application of an aggrieved person.¹⁴

The continuous protection provided by the trade mark may allow greater scope for Indigenous peoples to protect the words, designs and symbols within their traditional knowledge. Copyright and patents, on the other hand, have limited terms of protection after which the material falls into the public domain.¹⁵

THE TRADE MARK APPLICATION PROCESS

An application to register a trade mark must be made on an approved form and accompanied by a specified fee. The mark must be represented graphically. Once lodged, the application is examined to see if the mark complies with the requirements for registration. This takes approximately 12 months. Like designs, there is a provision for applications to be expedited on the payment of an additional fee.

Fees

To register an application, the application must be accompanied with the following fees:

- Application to register (single class): A\$150
- Application for each additional class covered by the same application: A\$300

Once registered the costs for registration are as follows:

- Registration (single class): A\$150
- Registration for each additional class covered by the same application: A\$260.¹⁶

Classes of Goods and Services

When registering a trade mark, an applicant must indicate the class of goods and services for which registration is sought. Furthermore, the applicant must nominate the specific goods and services within that class, in connection with which the trade mark is to be used.¹⁷

Rights are granted in the specified class but protection may also extend to related classes of goods and services.

Who can Apply?

Generally, a person who claims to be “the owner of the mark” and is using or intends to use the trade mark may apply to register it with the Trade Marks Office at IP Australia, including if he/she intends to license use of the trade mark.¹⁸

The registration process does not require any special procedure when a trade mark application refers to or incorporates an Indigenous word, symbol or design. For example, it is not necessary for a person to provide evidence that they have the prior informed consent of the Indigenous traditional owners in order for them to register a trade mark related to an Indigenous word, symbol or design.

A common problem for Indigenous groups has been that non-Indigenous companies have trade marked Indigenous words without prior informed consent.¹⁹

Generally, Indigenous people and entities that make use of words and designs as unregistered trade marks are from the relevant cultural group, or they have sought the consent of the relevant traditional owners. In addition, some Indigenous traders have sought registration under the Trade Marks Act, whilst others appear reluctant to claim a registered trade mark monopoly in words and designs that are communally owned, or words and designs that have special cultural significance to Indigenous groups.

Can Indigenous people be registered owners of communally owned words and designs?

The registered owner of a regular trade mark can be an individual, a company, an unincorporated club or association, a partnership or any group of individuals in a business together and who jointly own a trade mark.²⁰ It is therefore possible for Indigenous peoples either individually or collectively to register trade marks rights accordingly. For instance, an Indigenous community organisation, an individual Indigenous person or an unincorporated Indigenous association can be a registered owner of a trade mark. The *Draft Manual of Practice and Procedure* notes that there is no prohibition in relation to the entry of notice of trusts in the Register.²¹ There may be scope for Indigenous entities to register a trade mark in the name of the trustee and/or on behalf of the beneficiaries. For example, perhaps a Prescribed Native Title Authority could register as a trustee on behalf of the Indigenous native title-holders as beneficiaries. An individual traditional custodian, such as Mr. M* in the *Bulun Bulun Case*²² may be able to register a design as a trade mark, and the beneficiaries could be the entire clan group.

Examination

After lodgement and before registration, each application is examined to consider whether there are any grounds for rejecting the application and whether it has been made according to the legislation. Division 2 of Part 4 of the Trade Marks Act lists grounds by which the Registrar can reject an application. Such grounds include:

- The trade mark does not distinguish the applicant's goods and services from the goods and services of other persons.²³
- The test for capacity to distinguish is the likelihood that other traders, in the ordinary course of their business and without improper motive, will wish to use the same mark.²⁴ Whether a mark, which is able to be adapted to distinguish, does in fact distinguish the applicant's goods and services from those of the other traders is a question of fact. Geographic marks and descriptive marks also fall into this category.
- The trade mark or part of the trade mark comprises of scandalous matter or would be contrary to law.²⁵ This provision is not often used but may provide scope for Indigenous people to challenge registration of culturally offensive marks.
- The trade mark is likely to deceive or cause confusion.²⁶ Most geographic name marks are unregistrable because they must be available for other traders from the same region to use.²⁷ If applied to goods having no connection with the geographic location such marks may be deceptive or confusing.
- The trade mark is substantially identical with, or deceptively similar to, the trade mark of another person who has an earlier priority date for registration.²⁸

If there are no such grounds the Registrar of Trade Marks accepts the application, notifies the applicant and advertises the decision in the *Official Journal of Trade Marks*.

There are no specific grounds which address the registration of Indigenous or traditional knowledge. However, there will be grounds for rejection if an Indigenous word appearing in the mark is descriptive of the goods and services for which registration is sought. This is because descriptive words should be available for other traders to use. Under the Trade Marks Regulations, if a trade mark includes a word or words in a language other than English, the applicant is required to provide a translation of the words in English.²⁹ If the applicant has not done this, the Examiner will generally ask for such a translation in order to assess whether the trade mark is capable of distinguishing. There is currently no basis in the

Act or Regulations which would require inquiries to be made as to whether a word or design is used with the consent of the relevant traditional owners.

Opposition

A person may oppose the registration of a trade mark by filing a notice of opposition at the Trade Marks Office within three months of the date acceptance of the trade mark was advertised in the *Official Journal*.³⁰ The grounds for opposition to registration are set out in Division 2 of Part 5 of the Trade Marks Act. These include most of the grounds under which the application would have been rejected during examination. The Registrar must either refuse to register the trade mark, or register the trade mark subject to conditions and/or limitation, having regard as to how far any ground on which the application was opposed has been established.³¹

There are also appeal avenues to the Federal Court concerning the Registrar's decisions and it is possible for Indigenous groups to oppose the application at this stage, however, few have used the opposition procedures.³² Many Indigenous people have limited access to legal advice and the *Official Journal of Trade Marks* to be aware of this process. The Trade Marks Office intends to put the Journal online which will in some way assist Indigenous people, who have online access, to learn about the trade mark registration system.

Limitation

The Registrar may accept an application subject to conditions and/or limitations.³³ A limitation means limitations on the exclusive right to use a trade mark given by the registration of the trade mark including limitations of that right as to:

- Mode of use; or
- Use within any territory area within Australia; or
- Use in relation to goods or services to be exported.³⁴

Endorsements

Prior to 1995, the Registrar required endorsements which restricted the use of a trade mark to goods and services which were in accord with the description contained within the mark.³⁵ This was done in order to avoid the mark from being wrongly descriptive. Under the new Act, this practice has been reviewed and will now only require an endorsement if the Registrar is satisfied that significant deception or confusion will result if the trade mark is applied to all the goods and services claimed.

Under the repealed Act there were also provisions for the Registrar to require an endorsement in the form of a disclaimer. A disclaimer was required to more clearly define the rights of the owner of a trade mark that was registrable when taken as a whole but which included features that would not be separately registrable.³⁶ The endorsement on the "Yolla" trade mark illustrates this. "Yolla" is the Aboriginal word from Tasmania for mutton-bird. This trade mark was lodged in 1993 and is therefore subject to the 1955 Act. The endorsement on the trade mark is as follows: -

"Registration gives no right to the exclusive use of the Aboriginal word Yolla which may be translated as Mutton bird and to the device of a Mutton bird and to the device of the Map of Tasmania except as represented in the mark."

The trade mark is registered for products made out of mutton bird – e.g. oil, and essential oil - hence, it is descriptive and arguably not distinctive. The endorsement allows other traders to use the Aboriginal word and image in this class by restricting the monopoly to the overall logo. Similar issues pertain to the map of Tasmania.

“Yolla” could be registered without endorsement for products not made from Mutton-birds such as Internet service providers or as a trade mark for a car. In comparison, “Dove” would not be registrable for live birds or products derived from doves but registrable for products not made from actual doves.

The NIAAA label of authenticity has an endorsement limiting itself to the colours black, red and yellow with a black border surrounding the triangular device. This was done, according to IP Australia, to reduce confusion between the NIAAA label and the NIKE® registered trade mark.

Adverse Reports

If there are any problems with the application when the trade marks examiners examine it, an adverse report is sent to the applicant detailing requirements and giving applicants an opportunity to rectify any issues.

It appears that Indigenous applicants in many cases provided no response to the adverse report and therefore the applications lapsed. From reviewing the applications, this could be largely due to the fact that many applications were made by the Indigenous applicants themselves without legal or technical advice.

What Happens when a Trade Mark Lapses or is Removed?

A trade mark application lapses if it does not proceed successfully through the examination process. This occurs often when no responses are received to adverse reports (15 months). A trade mark is removed from the Register if renewal of registration is not made within the 12 months extension period. When a trade mark lapses or is removed from the Register, similar trade marks are registrable under same or similar classes of goods and services.

RIGHTS

Once a trade mark is registered, the registered owner of the trade mark has the exclusive rights:

- to use the trade mark;
- to authorise other persons to use the trade mark in relation to the goods and/or services in respect of which the trade mark is registered;³⁷ and,
- the right to obtain relief if the trade marks rights are infringed.³⁸

This means that the owner of a trade mark can generally prevent other traders from using that mark, or a very similar mark, on or in relation to goods and services for which it has been registered.

How long does Registration last?

Registration will last for as long as the registration is kept current. This means that effectively rights could be held indefinitely as long as the trade mark is continuously used and renewals made every ten years. This feature of trade marks law makes it attractive for protecting Indigenous rights. Unlike patents, copyright or designs, the rights do not fall into the public domain after the patents, copyright and design protection terms have expired.

ENFORCEMENT

The trade mark owner is responsible for monitoring the marketplace for infringements and for taking legal action against similar and deceptive marks. An owner may also need to monitor the use of its own trade mark to ensure that it does not lose its distinctiveness by becoming a generic term and falling into the public domain.

REMEDIES

The registered owner of a trade mark who successfully establishes infringement can seek the following remedies:-

- an injunction, which if granted may be subject to conditions imposed by the courts;
- damages; or
- an account of profits.³⁹

There are no reported cases where Indigenous Australian trade mark owners have litigated for infringement of their trade marks.

COLLECTIVE MARKS

Collective marks are a recent addition to the Australian trade marks regime.⁴⁰ A collective trade mark is a sign used in relation to goods and services provided in the course of trade by members of an association, to distinguish their goods and services from those of non-members.⁴¹ Like ordinary trade marks, collective trade marks are used to indicate the trade origins of the goods and services rather than indicating that the goods and services meet a certain standard. However, the particular source indicated in the case of a collective trade mark is not a single trade source but one comprising the members of the association which has registered the collective mark. Registration is not available for trade marks which are used solely to indicate membership of an association or any other organisation. The trade marks must be applied to goods and/or services.

Since the new provisions commenced, there have been 53 applications for collective trade marks and 27 have been registered.⁴²

Unlike with the certification mark, there are no requirements for developing rules governing the use of a collective trade mark. Only members of the association in whose name a collective trade mark is registered may use the collective trade mark. A member of an association in whose name a collective trade mark is registered does not have the right to prevent another member of the association from using the same trade mark, unless the use

does not comply with any rules of the association governing that trade mark.⁴³ Collective trade marks registered since the establishment of this new category include “WA Citrus Improvement Group” and “Toyota Dealer Group.”⁴⁴

Indigenous associations, including groups of artists, could use the collective mark system to indicate their association within a group. The mark, of course, would need to be applied to goods and services but can be used by individual members of that association.⁴⁵ Unlike certification marks, there are no rules of requirement and use of the mark can be controlled by the rules of the constitution of the association.

CERTIFICATION MARKS

A certification mark is a sign used to distinguish goods and services which possess a certain quality, accuracy or characteristic. The distinguishing characteristics may include geographic origin, quality of material used, or the mode of manufacture.⁴⁶ Use of the mark is certified by the registered owner of the certification mark, or by representative organisations approved by the registered owner in accordance with the rules for use.

Certification marks are governed by Part 16 of the Trade Marks Act of 1995. Well-known certification trade marks in use in Australia include the “Woolmark” logo⁴⁷ and the “tick” logo indicating a product is National Heart Foundation Approved.⁴⁸

The National Indigenous Arts Advocacy Association (NIAAA) has registered two certification marks: the label of authenticity and the collaboration mark. The certification marks are used to certify that the work is authentic, that is it is produced by Indigenous people who, in compliance with the certification mark rules, have a claim to the type of style, knowledge, or information embodied in that product. The labelling system is administered under the control of NIAAA and in accordance with the rules for use.⁴⁹

GEOGRAPHICAL INDICATIONS

A trade mark containing or consisting of false geographical indications may be opposed.⁵⁰ Geographic indication in relation to goods originating in a particular country, region, or location of that country indicates that the sign is recognizable in that country as a sign which indicates that the goods:

- originated in that country, region or locality; and
- have a quality, reputation or other characteristic attributable to their geographic origin.⁵¹

Given that Indigenous peoples’ cultural expression reflects their belonging to land and territories, this may allow some scope for Indigenous people to use geographic indications for their clan names, and language words for regions.

BUSINESS AND COMPANY NAMES

Many Indigenous people register business names believing that this is the same as registering a trade mark in that it allows them to stop other rival traders from using the same or a similar name.⁵² This is not the case as a business name is not a proprietary right like a trade

mark. A business name is the name under which a business operates and registration thereof identifies the owner of that business. Registration is legally required before the business can start to trade. Laws against passing off can protect business names.

Company names like business names, do not provide proprietary rights for use of the trading name. Currently many Indigenous words are used for the names of companies.

INTERNET DOMAIN NAMES

The domain name system was designed to allow users to locate websites in an effective and quick manner. The simpler and more memorable the domain name, the greater the likelihood that a large number of users will access and use a particular website.

Domain names have acquired further significance as business identifiers. For this reason, the use of domain names has come into conflict with existing systems of trade marks and business name registration. Therefore, obtaining a particular domain name has become almost a commodity in the Internet world. In Australia, “.au Domain Administration Limited” (auDA) is the non-profit company formed as the industry’s self-regulatory body for the “.au” domain space.⁵³

The World Intellectual Property Organisation (WIPO) has established the Internet Domain Name Process, which sets out best practices for registration authorities. The list of standard practices relate to registration of the generic top-level domain names (GTLDs) including dispute resolution procedures and registration of domain names of famous and well-known marks.⁵⁴

The use of Indigenous names and words for domain names is an important issue for Indigenous people.⁵⁵ In New Zealand, the New Zealand Maori Internet Society (NZMIS) is a society which aims to promote a strong Maori presence on the Internet. NZMIS lobbies the Internet Society of New Zealand to allocate Maori second-level domain names that reflect Maori everyday usage and encourage more appropriate Maori domain names.⁵⁶

There are a number of domain names that have adopted Indigenous names and some of these are not owned or operated by the relevant Indigenous groups, leading to complaints about the registration of Indigenous words as domain names without the consent of the Indigenous Peoples.⁵⁷ The Report *Our Culture: Our Future* suggests that there should be some level of inquiry conducted on this issue when registration of a domain name is considered.⁵⁸

Ngarinyin elders Paddy Neowarra and Scotty Martin have set up a web site, <www.wandjina.com>, to spread the message of their culture worldwide. In the process, they have found three companies, named after the “wandjina” on the Internet and have politely requested the relevant owners to change the names appropriately. Two of the companies have handed over the names at the request of the owners.⁵⁹

PASSING OFF AND MISLEADING AND DECEPTIVE CONDUCT

The law of passing off is similar to the trade practices laws of misleading and deceptive conduct.⁶⁰ These laws are designed to protect the reputation of a business from misrepresentation. The classic passing off situation is where one trader represents to the

public that his/her goods and services are that of another. However, a range of representations are now actionable, including:

- misrepresentation as to the source of the goods and services;⁶¹
- misrepresentation that there is some sort of connection or association with another person's business, whether by way of partnership, sponsorship or licensing;⁶²
- misrepresentation that there is a connection or association with another person's images, characters, and personalities;⁶³
- deceptive or confusing use of names, descriptive terms and other indications to persuade purchasers to believe that goods and services have an association, quality or endorsement that belongs or is associated to the goods and services of another.⁶⁴

Passing off may be an avenue for Indigenous holders of unregistered trade marks if the following principles of passing off are met:

- the business or its goods have acquired a certain goodwill and reputation;
- the actions of the defendant have caused, or will cause, the consumers of the plaintiff's business to believe that the defendant's goods are those of the plaintiff;
- as a consequence of the misrepresentation, the plaintiff has suffered or is likely to suffer injury in his/her trade or business.⁶⁵

An owner of a common law trade mark can take actions of passing off, and misleading and deceptive conduct, against parties who adopt similar marks. Usually these actions are brought to court together. Indigenous traders, including arts organisations, are today gaining reputations as producers from specific regional areas and may therefore be able to show that they have established goodwill or reputation as Indigenous art and cultural material producers. Consumers are purchasing Indigenous arts and cultural products on the strength of this reputation.

Australian trade practices law protects consumers from any act of a corporation that is "misleading and deceptive." This includes false representation as to "sponsorship, approval or affiliation"⁶⁶ and false representation concerning the place of origin.⁶⁷

INDIGENOUS USE OF TRADE MARKS

Trade marks are used by Indigenous peoples to identify a wide range of goods and services. These include arts, cultural services, food preparation, medicines, tourism services, Indigenous-run business, and Indigenous government agencies. The following types of marks were found to be included on the Register of Trade Marks:

- Indigenous words and designs;
- English words that have a particular meaning or significance for Indigenous Australians. For example: the word "dreaming" is an English word used to describe Indigenous traditional concepts. This word has been incorporated into the mainstream of Australian culture. For instance, approximately 90 applications have been lodged for trade marks including the word "Dreamtime." 15 have been registered and nine are pending.

SOME EXAMPLES OF TRADE MARKS USING "INDIGENOUS" WORDS

Dreamtime

90 applications received including both word and combination image marks. 15 registered have been registered and 9 are pending. Goods and services include bedding, Aboriginal arts and craft products, milk products and jewellery.

Aboriginal

31 applications lodged – both word and combination image marks. 6 registered and 9 pending. Good and services include photo frames, cultural festivals, notepads, bookmarks and stationary.

Indigenous

9 applications lodged – 2 registered and 3 pending. Goods and services include sport programs; clothing, footwear, headgear; food prepared from native food and vegetables.

Piccaninny

7 applications lodged. Some very old – five removed and two never registered.

Boomerang

91 applications received. 24 registered and 9 pending. First trade mark was lodged in 1931 word and image for musical instruments. Also used for pillows, Manchester, tool boxes and sporting articles.

Coolamon

1 received and only one registered trade mark for luggage.

Aboriginal person images

65 trade marks applications which include images of Aboriginal people were listed on the register. Many old ones have been removed. 24 current trade marks incorporate images of Aboriginal people. 21 registered and 3 pending.

Baiime

2 trade marks lodged. One removed – not renewed and 1 currently registered for beauty products.

Billabong

90 trade marks applications listed as lodged on register. 35 registered and 9 pending.

Walkabout

69 noted as lodged. Currently, 16 registered and 5 pending.

Corroboree

21 applications lodged. 7 registered and one pending.

Coolabah

14 applications received. 13 registered and one pending.

Bullroarer

1 application lodged but never registered.

Churinga

Two applications lodged. One removed and 1 registered trade mark.

Woomera

7 lodged. 1 registered and 2 pending.

Monaro

7 lodged. 3 registered. 4 never registered.

Wandjina

1 lodged but never registered.

Aranda (Arrente)

2 lodged. One removed and one pending.

Uluru

10 lodged. 9 never registered and 1 pending.

Indigenous Words and Designs

Indigenous words and designs are a continuous expression of the cultures of the Indigenous peoples and represent a connection between the Indigenous people and their land. For example, language words and clan names such as Eora, Arrente (Aranda), Monaro, Uluru and Wik are important identifiers of Indigenous peoples.

Indigenous Cultural Festivals

Some Indigenous organisations have registered trade marks for Indigenous festivals and concerts. For example, the National Indigenous Arts Advocacy Association (NIAAA) hosts an annual concert on Australia Day which showcases Indigenous talent in music, dance and visual arts. NIAAA has registered "Survival Concert" as a trade mark in class 41 for "Entertainment services, being an annual national Indigenous concert and fair."⁶⁸

The logo for the Kyana Aboriginal Cultural Festival incorporates a snake coiled, patterned and broken diskette.⁶⁹ This mark was registered in 1991 by the Indigenous artist who designed the mark. It has an endorsement that registration gives no right to the exclusive use of the words "Aboriginal Cultural Festival."⁷⁰

PLANT, ANIMALS AND MEDICINAL KNOWLEDGE TRADE MARKS

There have been several attempts by Indigenous groups to trade mark Indigenous words related to plants or animals to protect them against the commercial exploitation by non-Indigenous businesses. The Bandjalang Aboriginal Corporation applied for registration of trade marks for the words "Gung-Guyar" and "Bulam" in the relevant class for soaps, perfumery, essential oils and body lotions.⁷¹ Both these words translate as "tea-tree" in the Bandjalang Aboriginal language. After lodgment, IP Australia sought clarification on the mark's ability to distinguish mainly because if the products were made from tea-tree, the use of the word would be descriptive. This issue of descriptiveness can be overcome by showing that the use of the mark is capable of being distinctive. In this application, there was no response to the report. The trade mark application has since lapsed.

Another example is an application by Coen Regional Aboriginal Corporation to register "Lemon Wardanee" for classes 29 (edible oil) and class 30 (spices). "Wardanee" is an Aboriginal word for Eucalypt.⁷² The trade mark did not proceed to registration.

The Tasmanian Aboriginal Corporation held several registered trade marks which it applied to mutton bird products. "Yolla" is the Indigenous word for mutton bird. The mutton bird is a species of bird, traditionally farmed by the Tasmanian Aboriginal people. Whilst descriptive, the mark incorporated other devices including an emblem. Hence, the mark met requirements of registration given that as a whole the combination of devices used in the overall mark was collectively capable of distinguishing. The "Yolla" trade mark was registered under the classes 3, 5, 29 and 19 to protect the commercial ventures of Tasmanian Aboriginals who had begun to make and sell products from mutton bird. The registration of the mark was to limit competitors from using the word in the production and manufacture of similar goods.⁷³

Arts Centre Trade Marks

The Indigenous arts network is facilitated by arts centres that promote the creation, distribution and sale of Indigenous visual arts and craft throughout Australia. These centres use trade marks in the course of their trade. Many arts centres use common law trade marks. For example, Munupi Arts has a logo that it puts on letterhead, invoice and promotional material. The mark is not registered but has been in use by the organisation for over ten years. Munupi incorporate the logo into the promotion and labelling of artistic works.⁷⁴ Some other examples include:

Papunya Tula
 Warlaryirti Artists
 Buku Larnngay Mulka

In recent years, some of the Centres have registered their marks with IP Australia. For instance, Desart is a regional arts organisation based in Alice Springs. Desart has a registered trade mark which is used by members of the organisation on promotional material for original artistic works and for licensed manufactured products. Desart has registered in several classes relating to the sale of Indigenous arts.

According to Desart, since its registration the mark has been effective in advancing the reputation and status of Desart as a collective organisation representing the rights of artists.⁷⁵ Member arts centre use the Desart mark with their unregistered marks thereby incorporating local and regional labelling systems. For some arts centre, this model was seen as being cost effective and adding to the solidarity of Indigenous organizations such as Desart⁷⁶ (see further Case Study 7 "Marketing and Merchandising of Art: Desart Trade Mark and Copyright Licensing").

Other Indigenous arts centre have registered their own trade marks. For instance, Keringke Arts Aboriginal Corporation has registered a mark since 1998 for "Keringke Arts" in class 24 (Textiles and textile goods, not included in other classes; bed and table covers) and Class 25 (Clothing - scarves, shirts, dresses, shorts, skirts, casual and fashion clothing for men, women and children, hats).⁷⁷ "Keringke" is an Arrente word meaning "Kangaroo Tracks."


 The logo for Keringke Arts is written in a stylized, hand-drawn font. The letters are thick and black, with a white outline. The word "Keringke" is written in a cursive-like style, and "Arts" is written in a more blocky, sans-serif style. A registered trademark symbol (®) is located to the right of the word "Arts".

A mark "Aboriginal" is registered by the Aboriginal Enterprises Company Ltd in the class 16 (Aboriginal art and artefacts). The mark incorporates a design of a thumb print. Registered in 1993, the mark has an endorsement that registration give no right to the exclusive use of the letters AB except as represented in the mark, and to the word "original." These endorsements were recorded before the commencement of the 1995 Trade Mark Act.

Foster Local Aboriginal Land Council has several registered marks for "Tobwabba Art." The trade mark incorporates an image of a lizard and is registered in a range of classes with bath linen; bed linen, clocks and bottle openers. The Register notes an endorsement to explain that "Tobwabba" translates to mean "place of clay" in the Worimi language.

Clothing

Indigenous people have registered trade marks for clothing. For instance, Broome Musicians Corporation has a registered trade mark logo of a snake (grot, wavy, scales and stripes). The trade mark is registered in class 25 for clothing, footwear and headgear.⁷⁸

Music, Film and Broadcasting

Central Australian Aboriginal Media Association Aboriginal Corporation (CAAMA) which provides broadcasting, film and music services to the Central Aboriginal Communities now uses a common law logo. In the past, CAAMA had made use of the registered trade marks system to protect the Imparja Record label. "Imparja" used to be registered in Class 41 - Recording and production of Aboriginal Music (contemporary and traditional).⁷⁹ According to the register, the word is an "Aranda"⁸⁰ word that may be translated into English as "Animal Tracks." This translation is listed as an endorsement on the trade mark. CAAMA now uses a black eagle device with the words "CAAMA Music" for CDs and cassettes it produces. This trade mark is not registered.



Publications and Internet

There have been attempts by Indigenous organisations to register trade marks in classes related to publications and internet. For instance, the Queensland Federation of Land Councils applied for the trade mark "Message Stick" in class 16 for printed matter in respect of a newsletter it published. This mark was lodged in 1996 but did not proceed to registration. The application has since lapsed.

Tandanya National Aboriginal Cultural Institute lodged an application for "Indigenous Arts Australia" in class 16 for a national Aboriginal and Torres Strait arts and cultural magazine. This also did not proceed to registration and the application has lapsed.

An example of a successfully registered trade mark is that for "Aboriginal Australia" which incorporates two open hands, thumbs and first finger touching with an Aboriginal pattern and which is registered in class 35 for retailing books, art and artefacts including retailing on the internet.⁸¹

Indigenous Government Programs

A registered mark for the joint initiative of the Aboriginal and Torres Strait Islander Commission (ATSIC) and the Australian Sports Commission's "Indigenous Sports Program" incorporates three dotted boomerangs and a spear. The registered classes are 16 (Printed matter, book binding material, photographics, stationery etc); Class 35 (advertising - business management, business administration); Class 41 - Education - providing of training, entertainment, sporting and cultural services) and Class 42 - providing food and drink, scientific and industrial research, sporting field advertising.⁸² The mark is affixed to events and functions as the ISP fund and is usually used alongside the ATSIC and AIS logos.⁸³

Aboriginal Hostels Limited (AHL) too has registered its logo which is a graphic of the letters A and H which are used to form an image of a house. AHL is a statutory authority which provides hostel and temporary accommodation for Indigenous people. Class of registration is 42 for temporary accommodation to Aboriginal and Torres Strait Islander people.⁸⁴

NON-INDIGENOUS USE OF INDIGENOUS STYLE TRADE MARKS

The search of the register also found Indigenous style or Indigenous sounding trade marks registered by manufacturing companies (see previous examples of trade marks using “Indigenous” words). Any confusion created by these non-Indigenous trade marks is likely to affect potential licensing opportunities for Indigenous people.

ENGLISH WORDS WITH INDIGENOUS SIGNIFICANCE

90 applications have been lodged for “Dreamtime” including both word and combination image marks. 15 have been registered and nine are pending. Goods and services include bedding, Aboriginal arts and craft products, milk products and jewellery.

Indigenous non-government organisations have also attempted to register English words that have Indigenous significance in Indigenous social policy. For instance, the word “Link-Up” used by Link-Up Aboriginal organizations in each state. Link-Up provides services of counselling and support for Indigenous persons who have been taken away from their families. It provides services of connecting people with their families hence the term “link-up.” The Queensland organisation has a registered trade mark for use in Queensland only. The New South Wales organisation had also applied but the application has since lapsed.

CONCLUDING COMMENTS

Trade marks may be useful for Indigenous people to protect their trade interests. For instance, if language groups and clans protected their names by trade marks, consumers might prefer to buy products and services bearing these names in the interests of buying authentic products.⁸⁵ There are several shortfalls in the law in protecting Indigenous designs and words generally. The requirement that trade marks be used in the course of trade may not be appropriate for general protection.

There has been an increase in the number of Indigenous businesses and organisations attempting to make use of trade mark laws in an effort to register their own trade marks for the protection of their artistic works and other Indigenous knowledge, particularly proposed Indigenous commercial use. In most cases, the trade marks have not proceeded to registration. It is hypothesised that this is because often the proposed trade mark consists entirely of words that are purely descriptive. For example, the Indigenous word for “tea-tree” for soap made of tea-tree. On receipt of an adverse report, the Indigenous application often does not reply to clarify the application. One exception, the Yolla trade mark incorporated a combination of devices – the word, symbol and a map of Tasmanian. The device as a whole was a registrable trade mark.

The number of unregistered trade marks used by Aboriginal businesses and organisations is considerably greater than those that are registered. However, there is strong evidence that Indigenous use of the trade marks system is increasing. Although there is use of the trade marks system, there is evidence to suggest that Indigenous people need to know much more about the system, namely:

- how to apply and overcome descriptiveness of marks and other issues raised in adverse reports; and
- how to oppose trade marks.

The trade marks system does not currently adequately take Indigenous cultural rights into account. For example, there is no requirement that prior informed consent be obtained before registration of an Indigenous word or symbol is proposed.

Protecting Culture by Registration

Can Indigenous peoples use trade marks to stop non-Indigenous business using cultural material as trade marks? If an Indigenous group wanted to protect a word, a symbol, a clan, or a language group name, for instance, from commercial exploitation, it would be possible to do so by registering the word in all 42 classes. However, this would be costly and would not achieve much unless there was use, or intended use, of the trade mark in relation to the goods and/or services in respect of which registration is sought.⁸⁶ Even after the trade mark is registered, it can be subsequently removed from the Register for non-use.⁸⁷

Canadian Indigenous groups have made use of official mark provisions of the Canadian Trade Marks Act to protect their cultural designs and words from unauthorised commercial use. In Canada, Indigenous groups have made use of the “official mark” trade mark provisions to protect their cultural expressions. Under the Canadian Trade Mark law, the official mark provisions prohibit registration of trade marks consisting of, or similar to,⁸⁸ “any badge, crest, emblem or mark, adopted and used by any public authority, in Canada as an official mark for wares and services.”⁸⁹ Whilst the prohibitions do not specifically include the symbols and designs of Indigenous Canadians, some groups have satisfied the “public authority” test and have registered their designs and words under these provisions.⁹⁰ For example, the Snuneymuxw First Nation has registered marks for petroglyph rock carvings created by the Snuneymuxw First Nation’s ancestors.⁹¹

The Australian law does not have prohibited mark provisions that Indigenous groups could use in a similar manner.

Prior Informed Consent

As noted, many businesses use Indigenous words and images as trade marks, however, these are unregistered. Consent is generally sought from the relevant traditional owner to use the name in the course of trade.

What happens when an individual applies to register a word or name as a trade mark without the consent of the traditional owners? The communal group can make use of the opposition procedures as outlined above.

In Canada, the Comox First Nation and a Canadian Aboriginal artist went to court over use of the trade mark “Queeneesh” to describe the artist’s art business. For the Comox First Nation, “Queeneesh” referred to a culturally significant legend and was also the name of its development corporation. The judge turned down the band’s effort to have its Aboriginal right to the term “Queeneesh” reviewed as part of a trade mark case as Aboriginal rights were considered to be outside the scope of trade mark law.⁹²

The Report, ***Our Culture: Our Future Report*** recommends that the registration of trade marks containing or incorporating Indigenous designs, sound words or symbols should only be allowed with the prior informed consent of the particular Indigenous community and if conditions regarding cultural appropriateness are met.⁹³ There is no authority under the Trade Marks Act to require prior consent unless the mark purports to be a representation of a person.⁹⁴

In 1997, a Maori Trade Marks Focus Group in New Zealand recommended similar prior informed consent provisions for the New Zealand Trade Marks Act.⁹⁵ Procedures for the protection of Maori signs and marks have since been adopted within the New Zealand Trade Marks systems.⁹⁶

Communal Rights

A lot of traditional knowledge is communally owned, although in many instances, an individual person may act as custodian for that aspect of cultural heritage. There may be scope for Indigenous clan owners to register trade mark rights and hold them in trust on behalf of the clan. Collective marks may also offer some scope for the rights of customary and traditional users of signs, symbols and words

Where a trader has been given permission to use an Indigenous word or symbol, what limitations are there on the trader's rights to deal and licence the trade mark to third parties? Under the Trade Marks Act, there are provisions that allows for claimed interests to be voluntarily recorded on the register.⁹⁷ At each assignment of rights the recorded claims would be noted.

Use of Sacred Words

Should people, non-Indigenous or Indigenous, be allowed to register sacred words as trade marks?

In Indigenous cultures, there are some designs and words that are "sacred" in that wider dissemination and use of them are restricted. Many Indigenous people find the idea of a registered sacred Indigenous words or design as a trade mark as offensive. It can similarly be compared to references to "Jesus" or "God" which have in the past been rejected as trade marks. Many Indigenous people consider that the registration of sacred words should be prohibited.

Indigenous Licensing of Words and Designs as Trade Marks

Can Indigenous peoples licence the rights to words and designs to traders for use as trade marks? Many language centres report enquiries from corporations wanting to use Indigenous names for brands and logos. Perhaps there is scope, where it is culturally appropriate, for Indigenous groups to licence rights to Indigenous words and symbols for licence fees and other sharing of benefits.

It is imperative that the system allows Indigenous groups to control use, negotiate terms and control the flow of benefits back to the originating groups. For instance, Navaho was recently licensed to a jean company with the consent of Indigenous Americans. In the past, Indigenous people in the United States have challenged the use of Indian images by football teams for logos and mascots on the grounds that they are demeaning. Actions have included holding public demonstrations against the "Atlanta Braves" and challenging the "Washington Redskins" trade mark in court.⁹⁸

There is a need for Indigenous owners to control commercial use of their words and symbols as trade marks. The Report *Our Culture: Our Future* recommended that an Indigenous unit be established within IP Australia to assess cultural issues relating to applications and to introduce checks and balances which require prior informed consent from traditional owners.⁹⁹ These issues should be addressed in order for the trade mark system to recognise the importance of Indigenous ownership and control of traditional words, designs and symbols.

Endnotes

- 1 See Terri Janke, *Our Culture: Our Future: Report on Australian Indigenous Cultural and Intellectual Property rights*, Michael Frankel & Company, written and published under commission by the Australian Institute of Aboriginal and Torres Strait Islander Studies and the Aboriginal and Torres Strait Islander Commission, Sydney 1999, page 19 – 21.
- 2 Section 17, Trade Marks Act 1995 (Cth).
- 3 Section 6, Trade Marks Act 1995 (Cth).
- 4 In Australia, the relevant legislation is the Trade Marks Act 1995 (Cth). The legislation was amended to take into account international trends towards greater uniformity in that field of law. In particular, this Act implements conformity with the minimum standards and principles of the Trade Related Aspects of Intellectual Property Agreement.
- 5 IPAustralia, 1999 Corporate Report, Canberra 1999.
- 6 See discussion below.
- 7 See below for discussion of passing off and common law trade marks.
- 8 Section 20(1), Trade Marks Act 1995 (Cth).
- 9 Except where geographical restraints have been imposed as a condition of registration.
- 10 Under Part 13 of the Trade Marks Act 1995 (Cth).
- 11 Part 14 of the Trade Marks Act 1995 (Cth). See James W Dwyer and Ann Dufty, *Lahore, Patents, Trade Marks & Related Rights*, Butterworths, Sydney, 1996, para 54,000.
- 12 Section 21(1), Trade Marks Act 1995 (Cth).
- 13 From the date of the application. Section 72(3) Trade Marks Act 1995 (Cth).
- 14 Part 9 of the Trade Marks Act 1995 (Cth): An application for removal can be made if the trade mark has not been used by, or on behalf of, the registered owner for a period of three years. Such applications are often made by applicants whose registration is held up by the registered mark.
- 15 Copyright protects works for fifty years after the death of the artist: section 32(2) **Copyright Act 1968 (Cth)**. Patent rights last for 20 years: section 67, Patents Act 1990 (Cth).
- 16 **The Trade Marks Application Kit**, IP Australia, Canberra, March 2000, p. 8.
- 17 See www.ipaustralia.gov.au for list of classification of goods and services in Australia.
- 18 Section 27(3), Trade Marks Act 1995 (Cth).
- 19 Terri Janke, *Our Culture: Our Future*, pp. 19 – 20.
- 20 Section 27(1), Trade Marks Act 1995 (Cth).
- 21 IPAustralia, *Draft Manual of Practice and Procedure*, Part 10 - Formalities, 1.1.8, (March 2001).
- 22 **Bulun Bulun v R & T Textiles Pty Ltd** (1998)157 ALR 193.
- 23 Section 41, Trade Marks Act 1995 (Cth).
- 24 **Registrar of Trade Marks v W & G DuCros Ltd** [1913]AC 624.
- 25 Section 42, Trade Marks Act 1995 (Cth).
- 26 Section 43, Trade Marks Act 1995 (Cth).
- 27 **Re registered Trade Mark "Yanx"**; *Ex parte Amalgamated Tobacco Corp Ltd* (1951) 82 CLR 199.
- 28 Section 44, Trade Marks Act 1995 (Cth).
- 29 Regulation 4.3(5), Trade Mark Regulations.

- 30 Section 52(1), Trade Marks Act 1995 (Cth).
- 31 Section 55, Trade Marks Act 1995 (Cth).
- 32 One regional Indigenous arts organisation has opposed a trade mark application for a local arts organisation arguing that the proposed word for trade mark should be available to all artists from the region.
- 33 Section 33(2), Trade Marks Act 1995 (Cth).
- 34 Section 6, Trade Marks Act 1995 (Cth).
- 35 Practice under the previous Act, Trade Marks Act 1955 (Cth).
- 36 Personal communication with Dr Noel Taylor, consultant, IP Australia, March 2001.
- 37 Section 20(1), Trade Marks Act 1995 (Cth).
- 38 Section 20(2), Trade Marks Act 1995(Cth).
- 39 Section 126, Trade Marks Act 1995 (Cth).
- 40 Part 15 of the Trade Marks Act 1995 (Cth) introduces collective trade marks as a new category of trade mark.
- 41 Section 162, Trade Marks Act 1995 (Cth).
- 42 Interview with Noel Taylor, Trade Marks Consultant, IPAustralia, 14 March 2001.
- 43 Section 165, Trade Marks Act 1995.
- 44 As noted in J. W. Dwyer et al (eds), Lahore, Patents, Trade Marks & Related Rights, Butterworths, Australia, 1996, pp 50, 138.
- 45 Compare registered trade mark owners who are unincorporated groups and associations. Use is made of the trade mark to, or in relation to, goods or services on behalf of all its members. See Draft Manual of Practice and Procedure, Part 10 – Formalities, 1 (March 2001).
- 46 Section 169(b), Trade Marks Act 1995 (Cth).
- 47 Trade Mark 185835 registered by the Australian Wool Research and Promotion Organisation.
- 48 Trade Mark 506334 registered by the Heart Foundation of Australia.
- 49 See Case Study 8 “Indigenous Arts Certification Mark”
- 50 Section 61, Trade Marks Act 1995 (Cth).
- 51 Section 6, Trade Marks Act 1995 (Cth).
- 52 Interview with Lewis Burns, Dubbo, September 2000.
- 53 <<http://www.auda.org.au>>.
- 54 WIPO, The Management of Internet Names and Addresses: Intellectual Property Issues, Final Report of the WIPO Internet Domain Name Process, April 30, 1999, Geneva, Switzerland <<http://www.wipo.org>>.
- 55 A North American Indigenous GTLD proposal for the Indigenous Nations and Peoples of North America can be found at <<http://www.world.std.com/~iipc/draft-icann-dnso-wgc-naa-01.txt>>.
- 56 <<http://www.nzmis.org.nz>>.
- 57 Terri Janke, Our Culture: Our Future Report, pp. 19 – 20.
- 58 Terri Janke, Our Culture: Our Future Report, p. 149.
- 59 Debra Jopson, “Misused spirits of creation returned to proper custodians”, Sydney Morning Herald, 07/03/2001.
- 60 Section 52 and 53 Trade Practices Act 1974 (Cth).

- 61 *Bollinger v Costa Brava Wines Co Ltd* (1960) RPC 16.
- 62 *Hogan v Koala Dundee Pty Ltd* (1988) 12 IPR 508.
- 63 *Ibid* per Pincus J.
- 64 *Moorgate Tobacco Co Ltd v Philip Morris Ltd* (1984) 156 CLR 414 at 445; at 214; at 516 as cited in Jill McKeough, *Intellectual Property: Commentary and Materials*, (2nd ed) Law Book Company, Sydney 1992, p 470.
- 65 Powell J, *Fletcher Challenge Ltd v Fletcher Challenge Pty Ltd* [1981] 1 NSWLR 196.
- 66 Section 53(d), Trade Practices Act 1974 (Cth).
- 67 Section 53(eb), Trade Practices Act 1974 (Cth).
- 68 Registered Trade Mark #656243.
- 69 Registered Trade Mark #561294.
- 70 The mark was registered before the commencement of the 1995 Act when endorsements were a Practice of the Trade Marks Office.
- 71 Telephone attendance with legal advisers to Bandjalang Aboriginal Corporation, March 2001.
- 72 Trade Mark #732493.
- 73 Telephone attendance with Michael Mansell, lawyer, Tasmanian Aboriginal Centre, 16 March 2001.
- 74 Correspondence with Munupi, February 2001.
- 75 Meeting with Ron Brien, Desart, Alice Springs, 1 September 2000.
- 76 See further Case Study 7 "Marketing and Marchandising of Art: Desart Trade Mark and Copyright Licensing". Interview with Rose Wallis, Walkatjara Arts, 2000.
- 77 Trade Mark #777943.
- 78 Registered Trade Mark 613320.
- 79 Registered Mark 405586 – registered in 1984. It lapsed in 24 November 1988 and has not been renewed.
- 80 Arennte language.
- 81 Registered Trade Mark 761991.
- 82 Registered Trade Mark 827192.
- 83 Telephone attendance Glenn Brennan, Australian Sports Commission, 20 March 2001.
- 84 600219.
- 85 Darrell A Posey & Graham Dutfield, *Beyond Intellectual Property: Towards Traditional Resource Rights for Indigenous Peoples and Local Communities*, International Development Research Centre, Canada, 1996, page 85.
- 86 Section 27, Trade Marks Act 1995 (Cth).
- 87 Section 92, Trade Marks Act 1995 (Cth).
- 88 The prohibited marks provisions restrict registration of marks that consist of or are "so nearly resembling as to be likely to be mistaken for symbols and crests used by government, royalty and public authorities: Section 9 of the Canadian Trade Marks Act.
- 89 Section 9(1)(n)(iii), Canadian Trade Marks Act.
- 90 Department of Indian Affairs and Northern Development, *Intellectual Property and Aboriginal People: Working Paper*, Fall 1999, p. 22.

- ⁹¹ Information provided by Murray W Browne, Barrister and Solicitor, Canada, Communication March 2001.
- ⁹² Department of Indian Affairs and Northern Development, Intellectual Property and Aboriginal People: Working Paper, Fall 1999, p. 19.
- ⁹³ Terri Janke, *Our Culture: Our Future*, p. 149.
- ⁹⁴ Compare Canadian legislation which prohibits the registration of any mark which falsely suggests a connection with a living individual or someone who has died within the last 30 years, unless they have given their consent.
- ⁹⁵ Maori Trade Mark Focus Group, NZ Ministry of Commerce, 1997.
- ⁹⁶ See WIPO documents WIPO/GRTKF/IC/5/3 and 6/3.
- ⁹⁷ Section 122(1), Trade Marks Act 1995 (Cth).
- ⁹⁸ Department of Indian Affairs and Northern Development, Intellectual Property and Aboriginal People: Working Paper, Fall 1999, p. 23.
- ⁹⁹ Terri Janke, *Op Cit*, p. 146.

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OVERVIEW

The work of Mr. John Bulun Bulun ("Mr. Bulun Bulun") incorporates imagery which is sacred and important to his clan group, the *Ganalbingu* people and their cultural heritage. His bark painting *Magpie Geese and Water Lilies at the Waterhole* was created in accordance with the traditional laws and customs of the *Ganalbingu* people. It was created with the necessary consent of the appropriate *Ganalbingu* elders. The art of painting and the act of creating artistic works is a continuing responsibility handed down through the generations.

Mr. Bulun Bulun's painting was altered and copied onto fabric, imported into Australia and sold nationally, by R & T Textiles (the "Company").

Mr. Bulun Bulun and Mr. George M*¹ ("Mr. M*"), a senior representative of the *Ganalbingu* people, commenced action against the Company, in the Federal Court of Australia. The Company admitted copyright infringement of Mr. Bulun Bulun's work and consent orders were entered into.

Mr. M* continued in his own right, claiming that the traditional owners of *Ganalbingu* country had certain rights in the copyright in the artistic work, separate from the individual rights of Mr. Bulun Bulun. The court dismissed Mr. M*'s claim. However, the judgment deals with some interesting issues regarding the application of copyright to Indigenous arts and cultural expressions.

The judgment in *Bulun Bulun v R & T Textiles*² was handed down in September 1998 and was given by Justice Von Doussa, the same judge who heard and gave judgment on the Carpets Case, *M* v Indofurn*.³ The judgment raises issues in relation to copyright and Indigenous art and it has sparked a lot of legal analysis on the protection of Indigenous art and whether the case creates a means for the protection of communal interests under intellectual property law. This study briefly looks at the case⁴ and provides a bibliography of the legal commentary since the case.

BACKGROUND

Mr. Bulun Bulun is a well known artist from Arnhemland and his work *Magpie Geese and Water Lilies at the Waterhole* was altered and copied by the Company. In 1996, Mr. Bulun Bulun commenced action against the Company for breach of copyright in the artistic works. Mr. M*, as representative of the Indigenous owners of *Ganalbingu* country, also brought proceedings in his own right, claiming that the Indigenous owners were the equitable owners of the copyright in the artistic works.

Magpie Geese and Water Lilies at the Waterhole is a bark painting that was created in 1978 by Mr. Bulun Bulun with the permission of senior members of the *Ganalbingu* people. Mr. Bulun Bulun sold the work to Maningrida Arts and Crafts Centre where it was resold to the Northern Territory Museum of Arts and Sciences. The work was also reproduced, with Mr. Bulun Bulun's consent, in a book by Jennifer Isaacs, "*Arts of the Dreaming - Australia's Living Heritage*". Additionally, the artwork was the subject of an earlier action, *Bulun Bulun v Nejlam* (1989) where it was copied without Mr. Bulun Bulun's consent onto t-shirts marketed under the name "The Aboriginals" by Flash Screenprinters. Mr. Bulun Bulun had commenced action under the Copyright Act of 1968 (the "Copyright Act") and the Trade Practices Act of 1974 (the "Trade Practices Act"), however, the matter was settled prior to hearing (see Text box).

BULUN BULUN V NEJLAM PTY LTD⁵

In 1989, Johnny Bulun Bulun commenced legal proceedings against a t-shirt manufacturer who had reproduced his work without his knowledge or permission. Mr. Bulun Bulun claimed infringement of his rights under the ***Copyright Act 1968 (Cth)*** and ***Trade Practices Act 1974 (Cth)***.

Flash Screenprinters had reproduced Mr. Bulun Bulun's 1980 painting ***Magpie Geese and Waterlilies at the Waterhole*** without consent or proper acknowledgement. Calling the t-shirt design "At the Waterhole", a swing ticket attached to the t-shirts referred to the design as "At the Waterhole - a design originated from Central Arnhemland". Later, the company produced another 'At the Waterhole' t-shirt, this time altering Mr. Bulun Bulun's painting, ***Sacred Waterholes Surrounded by Totemic Animals of the Artist's Clan***. The new t-shirt design also included elements believed to have been drawn from the works of other artists.

In his affidavit, Mr. Bulun Bulun explained the significance of the imagery in his paintings:

Many of my paintings feature waterhole settings, and these are an important part of my Dreaming, and all the animals in these paintings are part of that Dreaming ...

'The story is generally concerned with the travel of the long-necked turtle to Garmedi, and by tradition I am allowed to paint [that part of the story]. According to tradition, the long-necked turtle continued its journey, and other artists paint the onward journey.

The nature of this suffering was captured by Johnny Bulun Bulun in his affidavit:

This reproduction has caused me great embarrassment and shame, and I strongly feel that I have been the victim of the theft of an important birthright. I have not painted since I learned about the reproduction of my artworks, and attribute my inactivity as an artist directly to my annoyance and frustration with the actions of the respondents in this matter.

Prior to the Flash T-Shirts Case, it was generally assumed that many Indigenous artworks were not protected by copyright. This assumption considered that Indigenous artworks were not "original" because:

- they are based on traditional creation designs;
- they are passed on through the generations; and,
- are not the independent creative effort of the individual artist.

Evidence collected in the preparation of the case challenged this assumption. According to Arts Curator, Margie West, from the Northern Territory Museum of Arts and Sciences:

The works are clearly products of considerable skill, and reflect facets of the Applicant's [Bulun Bulun's] distinctive style. I note, for example, the fineness and detail of the cross-hatching, which is one of the most important features in any Aboriginal bark painting ... I am not aware of any other artist who depicts magpie geese, long-necked turtle and water snake at waterholes in the fashion of the Applicant ... I would rate the Applicant as amongst the best exponents in his art form, just as one might rate a particular Western artist as a leading exponent in his particular art form of, say, sculpture or watercolour painting.⁶

As it happened, investigations in support of Mr. Bulun Bulun's case revealed that 13 other Indigenous artists had grounds for legal action against Flash Screenprinters, and proceedings were also commenced on their behalf.

On the day before trial, the parties entered into a settlement arrangement which required Flash Screenprinters to withdraw all infringing t-shirts from sale, and pay damages to the amount of A\$150 000.

Although each Indigenous artist's works were infringed to varying degrees, the artists determined that they would share equally the sum, since each felt they had suffered equally.⁷

When proceedings were served, the Company admitted infringement of copyright in the artistic work pleading that they were unaware of copyright ownership by Mr. Bulun Bulun. Immediately afterwards the Company withdrew the infringing fabric from sale and consented to final declarations that they, the Company, had infringed Mr. Bulun Bulun's legal title to the copyright in the artistic work, and comprehensive permanent injunctions against future infringement. Approximately 7,600 metres of the fabric had been imported into Australia and approximately 4,231 metres had already been sold. The Company then went into administration and receivership. An amended statement continued to plead a claim by Mr. M* on his own behalf and as representative of the *Ganalbingu* people. His claim sought a declaration that:

- As a native title holder to a certain area of *Ganalbingu* country, he had rights of "traditional ownership" of that country. Such rights were inexorably linked with ownership of artistic works.
- Equitable ownership of copyright in the artistic works entitled him to bring action against the Company in his own right.

The Company was no longer part of the proceedings and the Minister of Aboriginal and Torres Strait Islander Affairs and the Attorney General of the Northern Territory intervened and made submissions on legal issues relating to the Native Title Act of 1993 (the "Native Title Act") and the Aboriginal Land Rights (NT) Act of 1978.

HOW WAS THE FABRIC DISCOVERED?

The fabric was brought to the attention of the artist by Mr. Martin Hardie, a solicitor,⁸ who had noticed the fabric in Darwin around 1996. The fabric was used by the Northern Territory's Chief Minister's Department as uniforms for the Department's protocol staff to wear on special occasions. Mr. Hardie bought some of the fabric and showed it to Mr. Bulun Bulun who had not consented to the use of his work in such a way and instructed Mr. Hardie to commence action.

According to Mr. Hardie, the Company had found the artwork in the Jennifer Isaacs book. The Company reproduced part of the artwork in a design for fabric which it had printed in Indonesia. The Company then imported the fabric into Australia through Brisbane where it was distributed nationally for sale.⁹ The fabric was then sold in fabric shops where it could be purchased and made into dresses, shirts and fabric items.

In 1996, an anonymous person brought the fabric to the attention of National Indigenous Arts Advocacy Association (NIAAA) requesting information about the artist. As there were no supply details of where the material was purchased, NIAAA was unable to follow up on the matter.¹⁰

THE TRADITIONAL CULTURAL EXPRESSION

The Ganalbingu People

The **Ganalbingu** people are the traditional Indigenous owners of **Ganalbingu** country. They have the right to permit and control the production and reproduction of the artistic work under the law and custom of the **Ganalbingu** people.

It was pleaded in the case that the traditional owners of **Ganalbingu** country comprise:

- the **Yolngu** people¹¹ who are the children of the women of the **Ganalbingu** people;
- the **Yolngu** people who stand in a relationship of mother's-mother to the members of the **Ganalbingu** people under **Ganalbingu** law and custom;
- such other **Yolngu** people who are recognised by the applicants according to **Ganalbingu** law and custom as being traditional Aboriginal owners of **Ganalbingu** country.¹²

The applicants pleaded that the **Ganalbingu** people "are the traditional owners of the body of ritual knowledge from which the artistic work is derived, including the subject matter of the artistic work and the artistic work itself."¹³

As evidenced in the court, the structure of **Ganalbingu** society has two levels. These levels are classified in the oral and anthropological evidence as "top" and "bottom" people. Mr. M* was the most senior person in the "top" people, and Mr. Bulun Bulun the most senior person of the "bottom" people.¹⁴

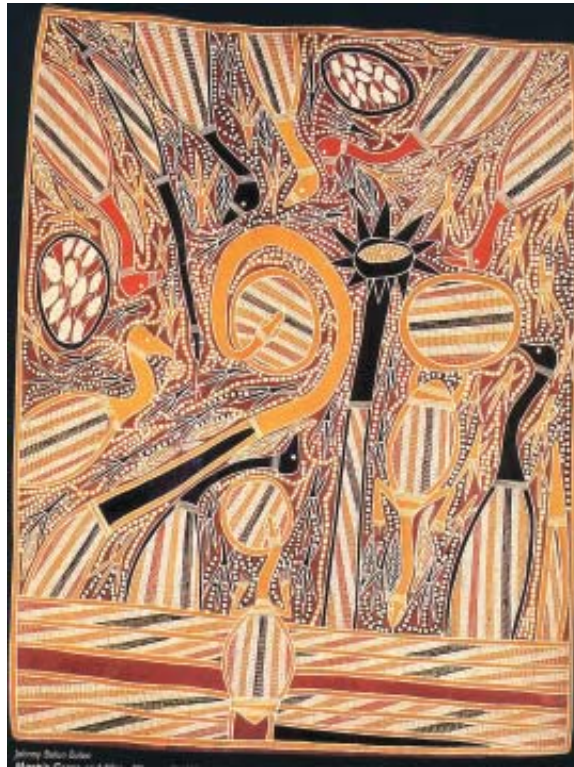
The Artistic Work

The artwork **Magpie Geese and Water Lilies at the Waterhole** depicts knowledge concerning **Djulibinyamurr**. **Djulibinyamurr** is the site of a waterhole complex situated in the Arafura Swamp. **Djulibinyamurr**, along with another waterhole site, **Ngalyindi**, are the two most important cultural sites in **Ganalbingu** country for the **Ganalbingu** people. Mr. Bulun Bulun describes **Djulibinyamurr** as the "**ral'kal**" for the lineage of the bottom **Ganalbingu** people. It is the place where **Barnda**, the turtle,¹⁵ the creator ancestor, emerged and began ancestral travels. Mr. Bulun Bulun explains:

"Barnda gave us our language and law. Barnda gave to my ancestors the country and the ceremony and paintings associated with the country. My ancestors had a responsibility given to them by Barnda to perform the ceremony and to do the paintings which were granted to them. This is a part of the continuing responsibility of the traditional Aboriginal owners handed down from generation to generation."¹⁶

Mr. Bulun Bulun noted that, under **Ganalbingu** law, ownership of land has a corresponding obligation to create artworks, designs, songs and other aspect of ritual and ceremony that go with the land. He stated:

Figure 1. Mr. Bulun Bulun, *Magpie Geese and Water Lilies at the Waterhole*



Author: Mr. Johnny Bulun Bulun,
Maningrida. Ganalbingu Clan.
All rights reserved

Figure 2. Fabric produced by R&T Textiles reproducing Bulun Bulun's work



All rights reserved

“If the rituals and ceremonies attached to land ownership are not fulfilled, that is if the responsibilities in respect of the Madayin are not maintained then traditional Aboriginal ownership rights lapse.”¹⁷

Furthermore, Mr. Bulun Bulun stated that the unauthorized reproduction of the artwork threatened the whole system in ways that underpin the stability and continuance of the *Yolngu* society. Unauthorized reproduction interferes with the relationship between the people, their creator ancestors and the land given to the people by *Barnda*.

Another witness, Mr. Djardie Ashley, gave evidence that according to Indigenous law, his role in the community was that of “*Djungayi*”¹⁸ (manager or policeman) to Mr. Bulun Bulun. It was Mr. Ashley’s obligation as *Djungayi* to ensure that the owners of certain land and *Madayin*¹⁹ associated with that land were dealt with in accordance with Indigenous customs and traditions. In this way, their role is important in maintaining the integrity of the land and the *Madayin*. At trial this evidence was supported by anthropologists’ affidavits. The importance of the artwork has been well documented by Howard Morphy in his book *Ancestral Connections: Art and an Aboriginal System of Knowledge*.²⁰

Rights to Apply Traditional Cultural Expressions Commercially

Evidence led in court stated that the right to paint was restricted to certain consent procedures which differed depending on the mode and purpose of reproduction. Djardie Ashley noted:

“If Bulun Bulun wanted to licence At the Waterhole so that somebody could mass produce it in the way that the Respondents have he would need to consult widely. If he wanted to licence At the Waterhole to a publisher to reproduce the painting in an art book he probably would not need to consult the other traditional Aboriginal owners at all.”²¹

COPYRIGHT

Copyright vests in an artistic work that is original²² and in material form. It is the expression that is protected and not the underlying idea. Copyright continues to subsist until 50 years after death of the author.²³ Copyright subsists in the painting *Magpie Geese and Water Lilies at the Waterhole*, notwithstanding its traditional character. By virtue of section 35(2) of the Copyright Act, the author of an artistic work is the owner of the copyright. Mr. Bulun Bulun as the creator of the artwork is recognized as the owner of the copyright in the painting under copyright law.

Rights of Copyright Owner

The copyright owner of an artistic work has the exclusive right to do all or any of the following acts:

- to reproduce the work in a material form;
- to publish the work;
- to include the work in a television broadcast;
- to cause a television programme that includes the work to be transmitted to subscribers to a diffusion service.²⁴

Infringement

It is an infringement of copyright to directly copy a substantial part of an artistic work. A substantial part of an artistic work does not necessarily refer to a large part of the work. A range of issues, which includes the quality of the part copied, are relevant.

The fabric was not an exact reproduction but parts of the original work were manipulated to form the pattern on the fabric. Had the Company not admitted infringement at the outset the court would have had to decide on the issue of whether the fabric design was a substantial reproduction of the original work. Justice Von Doussa commented that, in his opinion, the fabric was a substantial reproduction.²⁵

Was it a Work of "Joint Ownership"?

Another issue was whether the artistic work was a work of joint ownership. In other words, whether the work was owned jointly by Mr. Bulun Bulun and the Indigenous community. Justice Von Doussa held that the joint ownership provisions of the Copyright Act effectively precluded any notion of group ownership in an artistic work, unless the artistic work is a "work of joint ownership" within the meaning of section 10 (1) of Copyright Act. A "work of joint authorship" is a work that has been produced by the collaboration of two or more authors and in which the contribution of each author is not separate from the contribution of the other author or the contributions of the other authors.

In this case, Justice Von Doussa considered that there was no evidence to suggest that any person other than Mr. Bulun Bulun was the creative author of the artistic work. He noted:

"A person who supplies an artistic idea to an artist who then executes the work is not, on that ground alone, a joint author with the artist.²⁶ Joint authorship envisages the contribution of skill and labour to the production of the work itself."²⁷

NATIVE TITLE

Mr. M* claimed that the ***Ganalbingu*** people were the traditional Aboriginal owners of ***Djilbinyamurr*** for the purposes of the Aboriginal Land Rights (NT) Act of 1976. Furthermore, it was claimed that the ***Ganalbingu*** people were also "native title holders" of that land pursuant to section 224 of the Native Title Act. At the time of acquisition of sovereignty over the Northern Territory of Australia by the Crown, the applicant's ancestors were the traditional Aboriginal owners. The applicant claimed that the rights to paint and permit the reproduction of the artistic work are subject to the conditions and obligations and an incident of native title. This claim failed for two reasons.

Firstly, certain procedural requirements under the Native Title Act were not met. The Minister for Aboriginal and Torres Strait Islander Affairs intervened to the effect that the Native Title Act contained procedural provisions for applications for determination of native title and in the absence of such an application, the Federal Court had no jurisdiction to make a determination of native title in land.²⁸

Justice Von Doussa noted that neither the applicant nor the ***Ganalbingu*** people had made an application for determination of native title pursuant to section 74 of the Native Title Act. Hence, the Court was without jurisdiction to make a determination of native title in these

proceedings. There were similar procedural concerns regarding the Aboriginal Land Rights (NT) Act of 1976.

Secondly, the judge raised a further objection to the claim that the common law should recognise a connection between an interest in land and interest in a related artwork. Justice Von Doussa cited Justice Brennan in *Mabo v Queensland (No 2)*:²⁹

*“However, recognition by our common law of the rights and interests in land of indigenous inhabitants of a settled colony would be precluded if the recognition were to fracture a skeletal principle of our legal system.”*³⁰

According to Justice Von Doussa:

*“The principle that ownership of land and ownership of artistic works are separate statutory and common law institutions is a fundamental principle of the Australian legal system which may well be well characterized as “skeletal” and stands in the road of acceptance of the foreshadowed argument.”*³¹

COMMON LAW RIGHTS TO COMMUNAL TITLE

On the issue of whether common law can recognise communal title directly in an artistic work, Justice Von Doussa said,³²

*“Whilst it is superficially attractive to postulate that the common law should recognise communal title, it would be contrary to established legal principle for the common law to do so. There seems no reason to doubt that customary Aboriginal laws relating to the ownership of artistic works survived the introduction of the common law of England in 1788. The Aboriginal peoples did not cease to observe their sui generis system of rights and obligations upon the acquisition of sovereignty of Australia by the Crown. The question however is whether those Aboriginal laws can create binding obligations on persons outside the relevant Aboriginal community, either through recognition of those laws by the common law, or by their capacity to found equitable rights in rem.”*³³

Justice Von Doussa noted that in 1788, when Australia was colonized, the common law of England gave a property interest to the author of an artistic work in unpublished compositions. This right lasted in perpetuity. However, his Honour further note that the common law right of first publication was abolished by the United Kingdom’s Copyright Act of 1911. That Act was adopted with amendments in Australia in the form of the Copyright Act of 1912. Copyright in Australia does not subsist otherwise than by virtue of the subsequent Act - the Copyright Act of 1968.³⁴

Justice Von Doussa noted that to “conclude that the Ganabingu people were communal owners of the copyright in the existing work would ignore the provisions of section 8 of the Copyright Act, and involve the creation of rights in indigenous peoples which are not otherwise recognised by the legal system of Australia.”³⁵

EQUITABLE RIGHTS

Equitable rights are rights created and enforced by the court where it would be unconscionable to permit the legal owner of property to keep the benefit of property to herself. The Applicant argued that equitable rights were created in the artistic work given the nature of the artwork. Mr. M* represented those who have the power under customary law to regulate and control the production and reproduction of the corpus of ritual knowledge of the *Ganalbingu* people. It was argued that Mr. Bulun Bulun held the copyright subsisting in the artistic work on trust or alternatively as a fiduciary for Mr. M* and the *Ganalbingu* people.

Was there an Express Trust?

Justice Von Doussa considered that there was no express trust created in respect of the artistic work or the copyright subsisting in it. The existence of an express trust depended on the intention of the creator. To express an intention to create trust, it is not necessary that there be any formal or technical words. Any apt expression of intention will suffice.³⁶ The intention to create a trust must be manifested in some form or another.

Based on the evidence presented before him, Justice Von Doussa held that Mr. Bulun Bulun did not hold either the artwork or the copyright in it in trust for the *Ganalbingu* people. The fact that Mr. Bulun Bulun was entitled in customary law to sell his work and retain the profits himself was seen by the judge to be inconsistent with there being an intention to create an express trust. Also the fact that the artwork had been reproduced and sold commercially in a book *Art of Dreaming - Australian Living Heritage* was seen as being contrary to the argument that the sacred nature of the ritual knowledge embodied in the work was such as to infer an intention on the part of Mr. Bulun Bulun to hold the artwork in trust.³⁷

Further, there was no evidence as to any form of express agreement of a contractual nature which vested an equitable interest in the ownership of the copyright in Mr. M* or the *Ganalbingu* people.

Was there a Fiduciary Duty?

Fiduciary refers to a relationship of one person to another, where the former is bound to exercise rights and powers in good faith for the benefit of the other. Unless expressly entitled, a court of equity will not allow a person in a fiduciary position to make a personal profit or to put herself in a position where her duty and her interest conflict. Fiduciary relationships require a vital element, and that is "that the fiduciary undertakes or agrees to act for or on behalf of or in the interests of another person in the exercise of a power or discretion which will affect the interests of this other person in a legal or practical sense."³⁸ A question put before the Court was whether or not Mr. Bulun Bulun owed a fiduciary duty to the *Ganalbingu* people in respect of his role as author and copyright owner of the artistic work

Justice Von Doussa considered that a fiduciary relationship existed between the artist and the clan group and that the artist had a fiduciary duty towards his community. The artwork contained ritual knowledge that was of great importance to members of the *Ganalbingu* people. Justice Von Doussa noted that while the artist was entitled to pursue the exploitation of the artwork for his own benefit, he was still required under customary obligation to refrain from taking any steps which might harm the communal interests of the clan in the artwork. Having found that a fiduciary relationship existed, Justice Von Doussa considered that equity imposed on the artist, as fiduciary, obligations:

- not to exploit the artistic work in a way that is contrary to the laws and customs of the Ganalbingu people;
- in the event of infringement by a third party, to take reasonable and appropriate action to restrain and remedy the infringement of the copyright in the artistic work.³⁹

The equity recognized falls short of an equitable interest in copyright. The right of the *Ganalbingu* clan, in the event of a breach of obligation by the fiduciary, is a right *in personam*⁴⁰ to bring an action against the fiduciary to enforce the obligation. The court considered that Mr. Bulun Bulun had fulfilled this obligation by taking legal action against the infringers. Therefore there was no need for the intervention of equity to provide any additional remedy to the beneficiaries of the fiduciary relationship.

In addition, Justice Von Doussa said that “the occasion might exist for equity to impose a remedial constructive trust upon the copyright owner to strengthen the standing of the beneficiaries to bring proceedings to enforce the copyright. This may be necessary if the copyright owner cannot be identified or found and the beneficiaries are unable to join the legal owner of the copyright.”⁴¹

RELEVANCE OF CUSTOMARY LAW

The Court looked at the relevance of customary law and decided that evidence of customary law may be used as a basis for the foundation of rights recognized within the Australian legal system. After finding that Mr. Bulun Bulun’s customary law obligations gave rise to a fiduciary relationship between himself and the *Ganalbingu* people, Justice Von Doussa stated:

“The conclusion that in all the circumstances Mr. Bulun Bulun owes fiduciary obligations to the Ganalbingu people does not treat the law and custom of the Ganalbingu people as part of the Australian legal system. Rather, it treats the law and custom of the Ganalbingu people as part of the factual matrix which characterizes the relationship as one of mutual trust and confidence. It is that relationship which the Australian legal system recognizes as giving rise to the fiduciary relationship, and to the obligations that arise out of it.”⁴²

OUTCOME

Mr. M*’s claim was dismissed on the basis that Mr. Bulun Bulun had met his fiduciary obligations by commencing action against the Company and stopping the unauthorized production and sale of the artwork.

As mentioned above, the Company ceased production, import and sale as soon as they received the statement of claim from the Applicants. The action continued to the court to hear the novel arguments surrounding Mr. M*’s claim.

As part of the settlement, Mr. Bulun Bulun received over 2,000 metres of fabric on delivery-up. He and his community make use of the fabric to cordon off areas for ceremonies.⁴³

The judgment serves to raise an awareness of the collective interests of Indigenous artists in works that embody clan knowledge.

***YUMBULUL V RESERVE BANK OF AUSTRALIA (1991)*⁴⁴**

Many commentators have revisited the facts of the *Yumbulul Case* in order to analyze the nature of the “Bulun Bulun equity”. The *Yumbulul Case* involved the reproduction of artist Terry Yumbulul’s *Morning Star Pole* on the Bicentennial A\$10 note. Mr. Yumbulul created a Morning Star Pole under the authority given to him as a member of the Galpu clan group. The design of the pole is a clan design of the Galpu clan.⁴⁵ Mr. Yumbulul’s pole was sold to the Australian Museum for public display. As part of an agency agreement, Mr. Yumbulul licensed his reproduction rights to the Aboriginal Artists Agency. The right to reproduce the pole was subsequently licensed to the Reserve Bank of Australia to reproduce on the Bicentennial A\$10 note.

Mr. Yumbulul attracted considerable criticism from his community for allowing this to happen. According to the traditional custodians, such use exceeded the authority he had been given. Mr. Yumbulul had been trained by his community in the preparation of the pole and was permitted to sell the work where it would be permanently displayed to educate the wider community about Aboriginal culture. However, he had not been given authority to allow such a sacred item to be reproduced on money.

Mr. Yumbulul took action in the Federal Court against the Aboriginal Artists Agency and the Reserve Bank, alleging he would not have authorized the license to the Reserve Bank had he fully understood the nature of it. But he was unable to prove this in court.

The Court found that Mr. Yumbulul had mistakenly believed that the license to the Reserve Bank would impose limitations on the use of the pole similar to those in Aboriginal customary law and that this was his belief at the time of granting the license.

The traditional custodians were not part of the proceedings, so the Court did not have to decide on the issue of communal ownership. However, the Court noted that “Australia’s copyright law does not provide adequate recognition of Aboriginal community claims to regulate the reproduction and use of works which are essentially communal in origin.”⁴⁶

CONCLUDING COMMENTS

Copyright provides intellectual property protection for artistic works against unauthorized use or reproduction.⁴⁷ Intellectual property laws aim to provide creators with certain economic rights to exploit their efforts so as to provide an incentive for the creative process itself. There is evidence that economic factors are gaining importance for Indigenous creators. However, the creation of Indigenous art primarily concerns continuing obligations to express and maintain Indigenous cultural practices. Hence, artistic integrity and attribution are important rights and the recognition of these rights as communal is important for Indigenous peoples.

Before this judgment, remedies for Indigenous applicants under copyright law focused on individual notions of ownership. It was noted in the *Yumbulul v Reserve Bank of Australia Ltd.*,⁴⁸ that the law fails to acknowledge the claims of Indigenous communities “to regulate the reproduction and use of works which are essentially communal in origin.”⁴⁹ The Carpets Case, although also concerned with individual artists’ copyright, represented a step towards recognizing the communal aspect of Indigenous artistic works. This was evidenced by the global award of damages the court made to take into account the customary practice of Indigenous applicant’s communities in sharing the awarded amount. Further, part of the

damages were awarded for cultural harm the individual artists may have suffered, as being accountable to the rest of the clan for protecting the integrity of the work and the underlying ritual knowledge embodied therein.

The judgment in *Bulun Bulun v R & T Textiles* takes this premise further and shows a willingness of the courts to recognize an interest of the *Ganalbingu* people in protecting clan ritual knowledge as deserving of legal protection. Many commentators speculate that the judgment shows that Aboriginal customary law rights, interests and obligations are relevant in providing for rights which will be recognized and protected by the Australian legal system.

The court's recognition of the importance of protection of the interests that Indigenous communities have in artistic works embodying ritual knowledge is a significant development in law and equity and one that will no doubt be tested in future cases.

The "Bulun Bulun Equity" and third Party Rights

Already the judgment has been the subject of much speculation by legal commentators. Michael Hall, for instance, examines to what extent a third parties' dealing with an Indigenous artist for an assignment or license is at risk of acquiring an interest subject to the "Bulun Bulun equity."⁵⁰ Hall notes that "the commercial interests of Aboriginal artists may be adversely affected if this issue remains too much in doubt."⁵¹

Hall notes that an assignee for value of the legal title, who takes without notice of the existence of a "Bulun Bulun equity," will take title without encumbrance.⁵² However, if a purchaser of the legal title of an Aboriginal artwork is put on notice, then he or she may be bound by the equity.

The issue is what will satisfy the giving of this notice. Hall considers that one view might be that the purchaser is on notice by the very nature of the property.⁵³ However, he discounts this view, stating that it is not likely for courts to impute such notice by the mere fact that it is an Aboriginal artwork which has or may have religious or cultural significance.

Another significant aspect of the debate concerns the validity of copyright licenses granted in respect of Indigenous artworks. If a licensee is sued for infringement by a person in the position of Mr. M*, can the licensee argue in defense that it has a valid license from the legal copyright owner? These would have been the facts in the *Yumbulul Case* had the clan group taken action against the Reserve Bank. According to Hall, "(i)t seems reasonably clear that Justice Von Doussa only envisaged that Mr. M* could, in the proper circumstances, exercise the same rights as Mr. Bulun Bulun. The answer therefore seems to be that, while the third party remains licensed by the legal copyright owner, the license would be a good defense to an action brought by the holder of the equity."⁵⁴ However, a critical point is that, in appropriate circumstances, Mr. M* may be granted the ability to terminate any license granted by Mr. Bulun Bulun, if Mr. Bulun Bulun had the power to terminate. Hence, it is speculated that a custodian, on behalf of a group, could have a license set aside if it is shown to be in breach of customary laws.

Sally McCausland notes that to rely on the mere equity, Indigenous custodians must show that the infringing party was on notice of their rights to the copyright work. McCausland recommends that to be certain, Indigenous artists and custodians should give express and clear notice of their interest to third parties.⁵⁵ She provides a draft form of notice as follows:

“NOTICE OF CUSTODIAL INTEREST OF THE [NAME] COMMUNITY

The images in this artwork embody ritual knowledge of the [name] community. It was created with the consent of the custodians of the community. Dealing with any part of the images for any purpose that has not been authorized by the custodians is a serious breach of the customary laws of the [name] community, and may breach the Copyright Act 1968 (Cth). For enquiries regarding the permitted reproduction of these images, contact [community].¹⁵⁶

It is a practice of art centres to refer to the rights of the clan group, as well as the individual artists. For example, Buku Larnngay Mulka puts the following copyright notice on their individual artists' works:

“This work and documentation is the copyright of the artist and may not be reproduced in any form without the permission of the artists and clan concerned.”¹⁵⁷

As McCausland notes, this equity can arise not just in relation to artistic works but to other types of copyright material including dramatic, musical and literary works. A custodian's interest notice such as the one above could be adapted for these other types of materials.

The suggestions put forward by Hall and McCausland are yet to be tested in the courts. However, a positive outcome of the case is that it reinforced the importance of Indigenous people asserting rights to their cultural material and making these known to the world at large. In the same way that many copyright owners adopt a “©” symbol to provide notice of copyright, there is scope for such methods to provide notice of custodians' interests in copyright works.

Limitations of Copyright Protection

Although the case represents an extension of copyright law in protecting Indigenous arts, the limitation of copyright in generally protecting Indigenous arts and cultural expressions still remain:

Material form

There is still a necessity in Australian copyright law (and in the laws of many, but not all, countries) for the artistic knowledge of Indigenous people to be represented in some material form for it to be protected. Copyright protects the actual work of Mr. Bulun Bulun and not the underlying knowledge embodied therein.

Can a person hold traditional knowledge in an oral form on trust, or as a fiduciary, for others? V. J. Vann notes the problems associated with express trusts, beginning with the requirement that the subject matter of a trust must be property. Traditional knowledge does not meet this requirement unless it is a form that attracts copyright, patent or trademark protection.⁵⁸

Duration

Even if traditional knowledge could be constituted in material form as was done in the ***Bulun Bulun Case***, the problem of duration of protection remains. Copyright in the artistic work of Mr. Bulun Bulun will cease after fifty years from his death. For the ***Ganalbingu***, rights to protect the underlying knowledge, and to control its wider dissemination, last in perpetuity.

Moral rights

Moral rights laws address certain non-economic interests of creators. At the time of bringing action, Australia did not have moral rights laws. The new laws include the rights of attribution and integrity. The right of integrity is important for Indigenous artists. Preserving the overall integrity of the work and the underlying story or ritual knowledge is an extremely important for the proper representation of Indigenous art. However, the rights vest in individuals and not communities. The ***Bulun Bulun Case*** raised the issue of whether a clan representative could commence proceedings for moral rights infringement if the individual artist is unknown or unwilling to bring an action of moral rights infringement.

Effect on Customary Practices

A potential problem identified by commentators is the risk of this process of recognition hampering the dynamics at which traditional customary law is aimed.

V. J. Vann gives the following example: "In some art works there may be a fine line between what part of the work is referable to a tribe's dreaming and what is attributable to a separate expression or interpretation by an individual artist. Attempts might be made by a cultural group to restrain the use of knowledge absorbed during the artist's upbringing or experiences in that culture. Salman Rushdie and Mozart provide hypothetical examples."⁵⁹ In these instances, alternative forms of dispute resolution rather than litigation, could provide the balance between protection of traditional content and creative expression.

Native Title

The case does exclude the argument that native title rights include rights to protect Indigenous arts and cultural expression. However, Blackmore argues that such rights, if they existed, would have been extinguished by the Copyright Act. He states:

"The very last point at which one can say that the existence of copyright is not inconsistent with native title is at the point when the individual first exploits their copyright, by say, selling or licensing the work. Obviously, automatic extinguishment at such an early stage in a work's existence would render native title of little use to native title holders."⁶⁰

But Blackmore fails to observe the complexities of Indigenous knowledge systems. Art is a continuum of cultural expression, and a painting or recording embodying traditional knowledge is just a snapshot at any given time. Copyright vests in the expressed material form but continuing cultural rights remain as in the underlying traditional knowledge. The legal point not yet tested is whether a copyright interest in the western legal sense is a sufficient title to usurp the underlying rights to cultural traditional knowledge.

Endnotes

- ¹ The senior representative, Mr. M, is now deceased.
- ² ***Bulun Bulun v R & T Textiles Pty Ltd.*** (1998) 41 IPR 513.
- ³ George M*, Payunka, Marika & Others v Indofurn Pty Ltd, (1994) 54 FCR 240. A study on this case is available at <<http://www.wipo.int/globalissues/studies/cultural/minding-culture/carpetscase/index.html>>.
- ⁴ ***Bulun Bulun v R & T Textiles Pty Ltd.*** (1998) 41 IPR 513.
- ⁵ Additional information on *Bulun Bulun v Nejam*. Colin Golvan, "Aboriginal Art and Protection of Indigenous Cultural Rights", *Aboriginal Law Bulletin*, Vol 2, No 56, June 1992, pp. 5 – 8; Martin Hardie, "Copywrong", *All Asia Review of Books*, Vol 1, No 2 July 1989.
- ⁶ Reproduced in Colin Golvan, 'Aboriginal art and copyright: The case for Johnny Bulun Bulun', in *European Intellectual Property Review*, Vol 10, 1989, pp. 347–354.
- ⁷ ***Ibid.***
- ⁸ Martin Hardie, Interview with Susannah Lobez, *The Law Report*, Radio National, Tuesday, 15 September 1998.
- ⁹ Martin Hardie, Interview with Susannah Lobez, *The Law Report*, Radio National, Tuesday, 15 September 1998.
- ¹⁰ See National Indigenous Arts Advocacy Association, Submission to the Stopping the Ripoffs, May 1995.
- ¹¹ Aboriginal people of Arnhem Land.
- ¹² 41 IPR 513 at 517.
- ¹³ 41 IPR 513 at 517.
- ¹⁴ 41 IPR 513 at 517.
- ¹⁵ Long necked turtle.
- ¹⁶ Affidavit of Mr Bulun Bulun cited at 41 IPR 513 at 518.
- ¹⁷ Affidavit of Mr John Bulun Bulun cited at 41 IPR 513 at 518.
- ¹⁸ or "*Waku*" 41 IPR 513 at 519.
- ¹⁹ Corpus of ritual knowledge 4 IPR 513 at 518.
- ²⁰ Howard Morphy, *Ancestral Connections: Art and An Aboriginal System of Knowledge*, The University of Chicago Press, Chicago, 1991, 41 IPR 513 at 520.
- ²¹ 41 IPR 513 at 520.
- ²² Section 22, Copyright Act 1968 (Cth).
- ²³ Section 32(2) Copyright Act 1968 (Cth); copyright in a literary, dramatic, musical or artistic work continues to subsist until 50 years after the end of the calendar year in which the author dies.
- ²⁴ Section 31, Copyright Act 1968 (note 2000 changes to Act introduced the communication right to the public).
- ²⁵ 41 IPR 513 at 520.
- ²⁶ ***Kenrick & Co v Lawrence & Co*** (1890) 25 QBD 99 in 41 IPR 513 at 525.
- ²⁷ ***Fylde Microsystems Limited v Kay Radio Systems Limited*** (1998) IPR 481 at 486. in 41 IPR 513 at 525.
- ²⁸ Section 213(1), Native Title Act 1993 (Cth).
- ²⁹ (1992)175 CLR 1.
- ³⁰ (1992)175 CLR 1 at 43 in 41 IPR 513 at 524.

- 31 41 IPR 513 at 524.
- 32 41 IPR 513 at 525.
- 33 An act, proceeding or right available against the world at large as opposed to a right in personam which is a right against or with reference to a specific person.
- 34 Section 8, Copyright Act 1968 in 41 IPR 513 at 525.
- 35 41 IPR 513 at 525.
- 36 **Registrar, Accident Compensation Tribunal v Commissioner of Taxation** (1993) 178 CLR 145 at 166 in 41 IPR 513 at 526.
- 37 41 IPR 513 at 527.
- 38 **Hospital Products Ltd v United States Surgical Corp** (1984) 156 CLR 41 at 96 - 97 per Mason J. in 41 IPR 513 at 527.
- 39 41 IPR 513 at 531.
- 40 An act, proceeding or right available against the world at large as opposed to a right in personam which is a right against or with reference to a specific person.
- 41 41 IPR 513 at 531-32.
- 42 41 IPR 513 at 530.
- 43 Telephone interview with Ron Levy, Senior Legal Officer, Northern Land Council.
- 44 (1991) IPR 481.
- 45 Morning Star Poles are commonly used in funeral ceremonies of important people. They are made from feathers, wood and string and are painted with designs. The right to create the poles is governed by Indigenous customary law and the method of creating them must comply with religious rules.
- 46 *Ibid* at 490.
- 47 It also protects dramatic, musical and literary works.
- 48 **Yumbulul v Reserve Bank of Australia Ltd** (1991) 21 IPR 482, 490 French J.
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- 51 *Ibid*.
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- 53 Michael Hall, *Op cit*, at 131.
- 54 *Ibid*, at 132.
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INTRODUCTION

Industrial designs laws protect the aesthetic features of an article. The design of the article may consist of three-dimensional features such as the shape or configuration of an article (e.g. the shape of a chair), or of two-dimensional features such as patterns and ornamentation (e.g. painting on a t-shirt). Under design law, a proprietary right is given to registered owners of the visual form of an article which is to be commercially mass-produced. Industrial designs may be applied to a range of articles including handicrafts, textiles, household and industrial items. A registered design gives the registered owner exclusive rights over the design and can therefore prevent others from using his or her design without their permission.

In the area of traditional cultural expressions, designs, motifs, emblems, patterns and other cultural objects signify a belonging and connection to a particular group of peoples. For example: “*rarrk*”¹ painting styles come from Arnhem Land; “*wandjina*” figures from Kimberley; and, certain basket weaving techniques which derive from Maningrida. An issue for the international intellectual property regime is the extent to which design law can protect the designs, motifs and symbols of traditional knowledge holders. This case study examines the Australian experience and Indigenous Peoples use of design law to protect Indigenous arts and cultural expressions.

WHAT IS A DESIGN?

A design is the “features of shape, configuration, pattern or ornamentation applicable to an article, being features that, in the finished article, can be judged by the eye, but does not include a method or principle of construction.”² An “article” as defined under the Designs Act of 1906 (Cth) (the “Designs Act”) means “any article of manufacture.” Provisions in the Design Regulations allow the Registrar to exclude the registration of designs for articles that are primarily literary or artistic in character. This includes articles that carry printing, such as book-jackets, calendars, dressmaking patterns and greeting cards.³

Visual Appearance and not Function

A design does not necessarily need to have any artistic merit. Registration of a design gives the registered owner protection for the visual appearance of the product, and not its function.⁴ That is not to imply that the functional aspects of a product cannot be protected by the designs system. McKeough and Stewart note “the fact that a design includes features which serve a functional purpose has not operated as a bar to registrability.”⁵ The focus remains on the visual appearance of the article however, and this does not provide protection against copying of the functional aspects of a registered design if a different visual appearance is given to the competitor’s product.⁶

Designs are features of ornamentation or shape applied to an article that is purely aesthetic and adds to an article’s appeal to consumers. For example, the pattern on a t-shirt does not add to its function as a garment but serves to make the design appealing to consumers. If a manufacturer creates a new type of chair, the Designs Act will only protect the particular shape and design of the chair and not the chair itself. If there were a new or innovative element in the function of the chair, then the Patents Act would provide better protection for that element.

Not a Method or Principle of Construction

A design does not include a method or principle of construction.⁷

REGISTRATION

A design must be registered before protection will be granted, although in some countries unregistered designs may also receive protection. In Australia, the Designs Act sets up a system of registration for designs. The Designs Office of IP Australia administers the system of design registration as well as the registered designs.⁸ IP Australia receives approximately 4,500 applications each year to register designs.⁹

Application Process

For designs to be protected under design law in Australia, applications must be lodged with the Designs Office of IP Australia. Applications must be lodged in the prescribed form and accompanied by representations of the article to which the design is applied.¹⁰

A priority date is given when the application is first lodged. The priority date is important as any design rights that may be granted are deemed to commence from the priority date, and any infringements after this date can be pursued.¹¹ Additionally the priority date is relevant in determining whether the design is “new or original.” If the public is already aware of the design before the priority date, the design is not entitled to be registered as it is no longer considered “new or original” .

After lodgement, the Designs Office will examine the application to check that it meets the requirements of registration. Examination occurs approximately six months after it is lodged and it is possible to amend the application at any stage after filing.¹²

According to IP Australia, “(i)n determining if a design is new or original, an examiner in the Designs Office will conduct a search of applications and registered designs in the Office’s own records, and may search other materials available in IP Australia. This search cannot be exhaustive and the fact that a design is accepted for registration does not guarantee that someone will not challenge the validity of the registration.”¹³

If the application meets all the requirements, it will be accepted for registration. If not, the Designs Office will send out a report to the applicant notifying it of any objections that need to be resolved. The Act allows an initial twelve months from the Design Examiner’s first report for the applicant to meet any requirements that have been identified. A further three months is available.

Once accepted for registration, the details of the application are advertised in the ***Australian Official Journal of Designs***. During the 11 months after the registration date, any other person who believes that the design is not new or original may challenge the continuation of its registration by notifying the Designs Office.

Requirements of Registration

To be registrable, a design must be:

- “new” or “original” at the priority date;¹⁴ and,
- applied to an article.

A design must be “new” in that it is not known or has not been previously used. A design would be considered “original” if it has never been applied to a particular product, although it may have been applied to another type of product.¹⁵ A design is not registrable if, before the date of the application for registration, it was made known to the public, or articles bearing the design were being offered for sale in Australia. Additionally a design can only be registered in relation to an article, therefore it is not possible to register the design itself unless it is applied to an article.

HOW LONG DOES REGISTRATION LAST?

Design registration lasts for up to 16 years from the date of filing the application.¹⁶ Once design protection expires the registered designs fall into the public domain and can be used freely by the public for commercial or other purposes. Due to this limited period of protection, design law is not considered to be suitable for the protection of Indigenous cultural material, as rights to restrict use of this material subsist in perpetuity.¹⁷

The *Australian Law Reform Commission (ALRC) Discussion Paper on Designs* also considered this an issue stating:

“Such an outcome would be inappropriate when designs are sacred and reproducing them would cause offence to Aborigines. The Working Party found that in such circumstances reproduction outside the traditional or customary law context should be prohibited.”¹⁸

RIGHTS

A registered design gives the registered owner a legally enforceable exclusive right to use the design and to prevent others from using the design without the permission of the registered owner.¹⁹ The registered owner can take action in court for infringement by a third party if the latter uses his or her registered design without permission.

The rights to a design are a form of personal property that can be assigned and licensed to others.²⁰ There are two arguments advanced for the protection of designs. Firstly, creators of designs should have the right to benefit from their own work and it would be unfair for others to take advantage of that creativity without the creator’s permission, and secondly, the protection of designs is said to directly encourage creativity and innovation.²¹

WHO MAY REGISTER A DESIGN?

Only the owner or author of the design can apply for registration²², the author being the first owner of the design.²³ Persons other than the author may own the design rights only in the following circumstances:

- where there has been an assignment of the rights in writing, by the author to the other party;
- where the author created the design during the course of employment; and,
- where the author was specially commissioned to create the design under an agreement.²⁴

HOW MUCH DOES REGISTRATION COST?

The cost of an application to register a design is A\$90²⁵ and a request to expedite the examination is A\$90. The first period of extension fee is A\$55, the second A\$90, and the third period extension fee is A\$135. Therefore, the cost of one registered design for one particular article, for example an artistic work applied to a t-shirt, will cost approximately A\$370, if no application for expedition is made. This amount, however, excludes legal fees involving a lawyer or patent attorney in the lodging or prosecuting of the application.

While these rates may not appear costly to register one or two designs, the costs involved in protecting a whole body of designs belonging to an Indigenous community can be very high. These financial expenses act as a barrier for Indigenous communities to using this kind of protection.

INFRINGEMENT

A registered design is infringed:

- where an exact copy of the design is used on an article in respect of which the design is registered;
- where an obvious imitation of the design is used on an article in respect of which the design is registered; and,
- where a fraudulent imitation of the design is used on an article in respect of which the design is registered.²⁶

REMEDIES

The relief a court may grant in the case of an infringement of a registered design includes an injunction and, at the option of the plaintiff, damages or account of profits.²⁷

DESIGNS AND COPYRIGHT

There is, however, an overlap between copyright protection and designs law. Under copyright laws, it is not necessary for an “artistic work” to have artistic merit for it to gain protection. Therefore, production, engineering and design drawings, moulds and prototypes produced for the design and manufacturing process of an article, may fall within the definition of an “artistic work” in the Copyright Act of 1968 (Cth) (the “Copyright Act”).²⁸ Some artistic works that qualify for protection under the Designs Act would also be considered works of artistic craftsmanship under the Copyright Act. This latter category would include examples such as sculptures, jewellery and ceramics. Many artistic works such as paintings may also be directly applied as a design onto t-shirts or fabric.

The Copyright Act protects artistic works from unauthorized reproduction in material form.²⁹ This includes making a three-dimensional work from a two-dimensional work and vice versa.³⁰

Design registration provides an enforceable property right that can be used to prevent slavish copying of manufactured articles. Design protection is relatively inexpensive to obtain and gives the registered owner a property right as from the registered date. Copyright protection is not lost when a “flat design” (two-dimensional artistic work) is applied to the surface of an article for mass production. However, to protect the three-dimensional application of a design in mass production, it is necessary to obtain registered design protection. As McKeough and Stewart speculate, “if a design for burial poles or other three-dimensional works were to be mass-produced with the authority of the artist, copyright protection would be lost.”³¹

Three-dimensional designs that have been “applied industrially by, or with the licence of, the owner of the monopoly in the corresponding design” may lose copyright protection.³² A design is taken to be applied industrially if it is applied to more than 50 articles, or to one or more articles (other than handmade articles) manufactured in lengths or pieces.³³ It is not an infringement of the copyright in the artistic work to reproduce the work, on or after the day on which articles made to the corresponding design are first sold, let for hire, or offered or exposed for sale or hire, by applying that, or any other, corresponding design to an article.

RELEVANCE OF DESIGN LAW IN PROTECTING INDIGENOUS DESIGNS

There is a disparity between the legal use of the word “design” and the way in which the word is used in the Indigenous arts and cultural arena. Design protection is limited to protection of the appearance of manufactured articles, as discussed above. Indigenous designs are regarded as part of a continuing cultural expression. Indigenous designs have specific meanings in Indigenous cultures, being handed down through the generations, these designs relate people back to the Ancestral Beings, their journeys and events and places associated with them. As Dean Ellison notes:

“A pre-existing design may be made up of design elements - various specific images, motifs or stylistic depiction - each of which may itself be said to be a pre-existing design. According to traditional customary law, pre-existing designs cannot, and should not, be changed. Their efficacy, in the form of activating Ancestral power, would be impaired if they deviated too widely from socially accepted norms. The pre-existing designs do not just constitute depictions or representations of the Ancestral Past. They are manifestations of the Ancestral Beings and re-creations of events that they took part in. Such manifestations provide the people with the means of tapping the sources of Ancestral power.”³⁴

Wally Caruana further notes:

“Through the use of ancestrally inherited designs, artists assert their identity, and their rights and responsibilities. They also define the relationships between individuals and groups, and affirm their connections to the land and the Dreaming.”³⁵

Examples of ancestrally inherited designs include:

Wandjina	Northern Kimberley Area (Western Australia)
Rarrk (Cross Hatching)	Arnhem Land (Northern Territory)
Wagilag Sister Story (Dreaming)	
Yalangbara ³⁶	Arnhem Land (Northern Territory)

In many instances ancestral beings traveled across countries of various clans. Hence, more than one clan group might claim ownership over one design, or similar designs. Caruana notes:

“Many Dreaming Stories originate in one area and travel across the region, assuming a wider significance as they link clans who are associated with them. Especially prominent among these are the Dreamings concerning the ancestral beings Yingarna and Ngalyod the Rainbow Serpent, the Wagilag Sister, the Djang’kawu, Barama and Lany’tjung, all of whom figure in major ceremonial cycles.”³⁷

Parties other than the relevant group often copy Indigenous designs. These designs are commercially applied onto t-shirts and other products. For instance, the copying of pre-existing clan designs onto carpets was the subject of litigation in the Carpet’s Case.³⁸

The disparity between “ designs” protected under the Designs Act, and designs by Indigenous people, has been the source of some confusion. Complex Indigenous designs, such as the “ rarrk” style of cross-hatching, are not protected by the Designs Act unless they are applied to an article for manufacture.

Indigenous Designs and Designs Law

The Working Party on the Protection of Aboriginal Folklore, established in 1975, inquired into the adequacy of existing copyright and designs laws and “ the need and nature of legislation required for adequate protection of Aboriginal artists in regard to Australian and international copyright.”³⁹ The ***Report of the Working Party on the Protection of Aboriginal Folklore*** released in 1981 found that the Copyright Act did not satisfactorily protect Aboriginal cultural and artistic works. The Copyright Act protects an author’s work but this is an individual right which is likely to conflict with the traditional rights held by communities under Aboriginal customary law.⁴⁰

The ***Australian Law Reform Commission (ALRC) Report No 74 Designs*** (1995)⁴¹ noted the importance of traditional Indigenous designs to Australian design law. The Report considered that this area raised “ special issues that cannot be adequately addressed through general designs law and that should not be considered in isolation from other issues arising out of Aboriginal art, culture and heritage.”⁴²

AUSTRALIAN LAW REFORM COMMISSION REPORT ON DESIGNS

The Commission's Report contains 188 recommendations, the most significant of which are:

- A design should be defined as one or more visual features of a product, such as visual features including shape, configuration, pattern, ornamentation, colour and surface.
The Commission recommends that the new legislation continue to focus on the visual appearance of a product, but also recommends that a design continue to be protected regardless of whether its visual features serve or serve only a functional purpose. The Commission further recommends that the current review of the petty patent system address any gap in the protection of function.
- A new threshold test for protection be introduced - to be registrable a design must be new and distinctive. The novelty test will only exclude identical designs from registration. To be distinctive a design must differ substantially in overall impression from previous designs assessed by the standard of an informed user. In relation to the prior art base the Commission recommends:
A design should be taken to be new unless at any time before the priority date an identical design has been used in Australia or has been published anywhere in the world.
A design should be taken to be distinctive unless on the priority date a substantially similar design was being used in Australia or was currently registered anywhere in the world or had been published in Australia within the previous fifteen years under the proposed optional publication and registration system.
- Infringement should be assessed by a test of substantially similar in overall impression, also to be judged by the standard of an informed user. In determining whether a design is infringed the court should give more weight to the similarities between competing designs than to their differences.
- An optional publication or registration system should be introduced. At any time within six months from filing an application for registration a person can choose between publication and registration of the design. Publication will not give rise to any rights but will have the effect of preventing others from registering the design. If no election is made within the six months period the application will be regarded as lapsed. Lapsed applications should not form part of the research material for the prior art base.
- Before registration only a formalities examination will be undertaken and opposition proceedings will not be available. However, a registered design owner or any other person may request the Registrar to examine the validity of a registered design at any time. Where the design is found not to have been validly registered then, if there is no subsequent appeal to the courts, the register is to be amended.
- The maximum duration of protection for registered designs should be 15 years.





- Spare parts should continue to be protected subject to a special procedure for referring potentially anti-competitive spare parts designs to the Trade Practices Commission.
- The provisions in the Copyright Act dealing with the overlap between designs and copyright should be repealed and an adaptation right for artistic works should be introduced. The adaptation right would give the copyright owner the right to industrially apply a version of the copyright work that is itself an artistic work in three-dimensions. It should be expressly provided that it is not a reproduction of a work in a two-dimensional form to make a version of the work in a three-dimensional form.

A handful of submissions to the *ALRC Report* specifically addressed issues of Indigenous designs. A submission from the Aboriginal Legal Services (ALS) in Hobart to the Designs Review, for instance, submitted that any new design legislation should incorporate the recommendations, contained in the *Report of the Working Party on the Protection of Aboriginal Folklore*⁴³, for the prohibition of non-traditional uses of sacred-secret materials and to introduce a system of clearances for prospective users of items of Aboriginal folklore.⁴⁴ The submission further noted that there have been some suggestions that the Aboriginal communities have “native title” rights to Aboriginal designs based on dicta in *Mabo v Queensland*.⁴⁵ The submission questions the effect of registration of Aboriginal designs by non-Aboriginal persons, especially where such registration overrides possible common law rights of Aboriginal communities to those designs, which have yet to be determined by the courts. This, it is submitted by ALS, is a further reason why statutory protection and enforcement of Aboriginal designs is desirable.

PROPOSED CHANGES TO THE DESIGNS SYSTEM

Changes proposed for the designs system based upon the proposals of the Australian Law Reform Commission include:

- introducing a new two-step threshold test - namely that a design is not registrable unless it is both new and distinctive;
- expanding the prior art base so it will include use in Australia or publication anywhere in the world;
- adopting a formal examination system to replace the expensive and time consuming substantive examination system. Voluntary substantive examination will, however, be made available to applicants and be mandatory prior to initiating any challenge to the validity of a design; and,
- reducing the maximum term of design registration from 16 to 10 years.

WHAT TYPES OF INDIGENOUS DESIGNS ARE REGISTERED?

After conducting an examination of the Designs Register⁴⁶, the results were minimal firstly because of the difficulty in being able to use the search criteria to select whether or not an item/product or registered design was an “Indigenous” design. There were, however, some designs that had been “derived” or “inspired” by Indigenous themes. For example, types of registered designs relating to indigenous content:

- Aboriginal stylized art on T-shirts;
- use of boomerangs on T-shirts;
- use of *Uluru*⁴⁷ imagery;
- designs incorporating the Aboriginal flag; and,
- Didgeridoo.

There is still a wealth of decorative and hand crafted items from Indigenous cultures that can be registrable as designs. Examples of these include toas, coolamons, shields, basket weaving, spearheads, emu egg designs, carved boab nuts, and wooden animal and bird figures decorated with paints and feathers. Whether or not these items are registrable as an industrial design will depend on their ability to meet the requirements for registration.

Flag Designs

Aboriginal Flag

The Aboriginal Flag is designed with the colours red, black and yellow, the bottom half being red, the top half black, and a yellow circle in the middle. The flag symbolizes Indigenous pride, identity and struggle⁴⁸ and was created by Harold Thomas. The artistic work was proclaimed officially as the Aboriginal flag in 1995.⁴⁹ In 1997, a Federal Court Case discussed the copyright ownership and use of the flag. In *Thomas v Brown and Another*⁵⁰ the court confirmed Thomas as the copyright owner and discussed the design and copyright law provisions. The issue before the court was whether the production of over 50 flags constituted industrial application and therefore resulting in the loss of copyright.⁵¹ Justice Sheppard accepted that Mr. Thomas had never authorized any mass reproduction of the flag design for commercial purposes.⁵² The flag was reproduced on fabric and paper with his consent for Aboriginal communal purposes. Hence, sections 74 to 77 of the Copyright Act did not affect the ownership or subsistence of copyright.⁵³ These sections provide defences for infringement, by providing that some uses will not infringe copyright. Prior to the case, the flag was applied on commercial articles such as clocks, watches, t-shirts and desk calendar holders, all of which were produced without licence from Mr. Thomas. Therefore registered designs that incorporate elements of the Aboriginal flag may arguably be an infringement of Harold Thomas’ copyright.

Torres Strait Islander Flag

The design for the Torres Strait Islander flag was created by Bernard Namok of Thursday Island, now deceased. The flag with colours of green, black and blue incorporates a white *Dari* (headdress) with a white five-pointed star beneath it which symbolizes the five major island groups and the navigational importance of stars to Torres Strait Islanders. The green stripes represent the land, the black stripes represent the people, and the blue the sea.⁵⁴ The flag is also reproduced on a range of commercial articles such as those mentioned above, and the design of the flag is not registered under design law. However, the flag is proclaimed to be a flag of Australia⁵⁵ and copyright would still subsist in the flag. According to the Island Coordinating Council, the flag is a symbol of unity for all Torres Strait Islanders.⁵⁶

Didgeridoos

One item found on the design register, was a hand-painted didgeridoo. The statement of monopoly rights in the didgeridoo relates to the pattern and ornamentation applied to the surface of the didgeridoo. The act of registration does not preclude other people from designing or registering didgeridoos with different patterns or ornamentation applied to them.



Didgeridoo
design by
Lewis Burns.
All rights reserved

A design of a didgeridoo will not be registrable unless there is some novelty regarding its shape and configuration or if there is a distinct pattern or ornamentation applied to the didgeridoo. The shape and configuration of a didgeridoo is not new or original, as it has been in the public domain for quite some time, however, the appearance of a particular style could be considered new or original.

Lewis Burns is an Indigenous man from Dubbo, New South Wales, who shapes, designs and paints didgeridoos. According to Lewis, he was the first didgeridoo maker to design the footed didgeridoo some years ago.⁵⁷ Today many didgeridoo designers have used the footed design when designing their didgeridoos. The footed didgeridoo could have been registered as a design by Lewis prior to making the design public. This would have entitled Lewis to prevent others from copying the footed style. However, as Lewis was unaware of the protection provided by design laws and did not register his innovation, his design can no longer be protected under design laws as it has already been commercially applied.

Additionally, Lewis Burns applies a distinctive pattern to the didgeridoos he shapes and has used the design for over two years and applied it to over 800 didgeridoos. He has sought advice as to whether he can protect the design by registration under design laws. Once again the design would not be registrable as it is no longer novel. Similar to the example of the footed model, Lewis should have applied for protection prior to publication in order for the design to be protectable. Whilst the design would be registrable as a pattern or ornamentation applied to an article, namely a didgeridoo, the application for design protection could not suffice as it does not satisfy the requirements of "new" or "original."

As the footed didgeridoo is arguably a "work of artistic craftsmanship"⁵⁸ and each didgeridoo is a "durable, useful handmade object,"⁵⁹ the author must be consciously concerned to produce a work of art in order for a three dimensional object to qualify as a work of artistic craftsmanship.⁶⁰

Animal Sculptures

Papunya Tula artists produce carved coolamons with Indigenous designs burnt or painted on them. These coolamons are hand carved and sold both nationally and internationally. The question is whether the designs system offers some form of protection? The shape of the coolamon is neither "new or original", but the design burnt or painted onto the coolamon could be registered as a design of pattern and ornamentation, only if the particular design has not been used publicly in Australia. The artistic works applied to the surface of the painted coolamons may be protected by copyright law.

Basket-Weaving

The making of items from animal and plant fibres is an important cultural activity for many Indigenous communities. The overall process is the focus of the activity including collection of fibres from source, preparation, dying and weaving techniques.⁶¹ Basket-weaving is a tradition in some Indigenous communities such as the Torres Strait, Cape York and Maningrida. Particular weaving techniques and processes have developed within these distinct regions. Under design law, only the article would be registrable, not the actual art involved in the weaving as this would be considered to be a method of manufacture. The shape and configuration of the bags, if novel, may be registrable. Another issue is whether copyright protection would be available to the bags as works of artistic craftsmanship.

CONCLUSIONS

The Designs Act provides limited protection for Indigenous traditional designs. It offers protection of designs in so far as they refer to a pattern or ornamentation, shape and configuration of an article manufactured for commercial purposes. As discussed above, Indigenous design is about cultural process and belonging. The art of making carvings, sculptures, baskets, and didgeridoos is part of an overall process. These issues do not fit with the current intellectual property system and generally cannot be protected. It is not possible to register the rights to produce a particular design, for example, a coolamon, and have exclusive rights against third parties from making any other type of coolamon. Protection will only be limited to the features of that particular article and any person could develop another shape or style, apply it to the article and have a registrable design.

As noted in the Carpets Case⁶², Indigenous traditional custodians consent to the commercial use of their clan designs and motifs only in certain circumstances. For example, to be displayed in prestigious galleries or reproduced in a publication for the purposes of educating members of the Australian community about Aboriginal culture.⁶³ An issue for designs registration in relation to Indigenous designs is that protection is generally afforded to commercially manufactured products. This type of protection is not appropriate for many Indigenous designs.

Whilst there may be scope for Indigenous people to use design law for commercial items, there are general issues concerning the designs system that inhibit its wider use by Indigenous communities. The Report *Our Culture: Our Future* discusses whether the Designs Act should be amended to allow Indigenous cultural designs or styles to be registered in recognition of their communal ownership.⁶⁴ The Report did not consider amending the designs laws to provide adequate protection but preferred enactment of specific legislation to allow for registration and protection of Indigenous designs. A concept of registration in perpetuity would be more effectively achieved through a system which recognizes rights to authentic cultural designs. Additionally there must be scope for the traditional owners to manage and control uses of Indigenous design.

Endnotes

- 1 “Cross-hatching ” style of Aboriginal art.
- 2 Section 4(1) Designs Act 1906 (Cth).
- 3 Sections 4(1) and 17(2) of the Designs Act 1906 (Cth) and Regulation 11(1) of the *Design Regulations 1982*.
- 4 A major criticism of the Designs Act 1906 (Cth) has been its failure to protect functional innovation. See Australian Law Reform Commission, Report on Designs, AGPS, 1995.
- 5 Jill McKeough and Andrew Stewart, Intellectual Property in Australia, 2nd ed., Butterworths, Sydney 1997, p. 250.
- 6 Many designers and manufacturers argue that the system should protect beyond aesthetic aspects to the functioning of products. A review conducted by the Australian Law Reform Commission recommended that the designs system remain focused on the visual appearance and pointed to the benefits of the petty patent system in providing protection for functional aspects. See Text box on “ Australian Law Reform Commission Report on Designs” below.
- 7 See Section 4 Designs Act; *Malley Ltd v J W Tomlin Pty Ltd*(1961) 35 ALJR 352.
- 8 Section 9, Designs Act 1906 (Cth).
- 9 Interview with Hugh Ness, Deputy Registrar, Designs, IP Australia.
- 10 Section 20(3), Designs Act 1906 (Cth); See Attachment A for example.
- 11 McKeough and Stewart, op. cit., p. 252.
- 12 Applications can be expedited by paying an additional fee.
- 13 IP Australia Designs Information Booklet, Canberra, p. 6.
- 14 “ Priority Date” refers to the date of application.
- 15 Section 17(1) Designs Act 1906 (Cth).
- 16 Section 27A, Designs Act 1906 (Cth).
- 17 Terri Janke, Our Culture: Our Future: Report on Australian Indigenous Cultural and Intellectual Property rights, Michael Frankel & Company, written and published under commission by the Australian Institute of Aboriginal and Torres Strait Islander Studies and the Aboriginal and Torres Strait Islander Commission, Sydney 1999, p. 64.
- 18 Australian Law Reform Commission Discussion Paper 58, Designs, August 1994, p. 16.
- 19 Section 25, Designs Act 1906 (Cth).
- 20 Section 25C, Designs Act 1906 (Cth).
- 21 Dr. John Phillips, Protecting Designs: Law and Litigation, The Law Book Company Limited, 1994, pp. 6 – 7.
- 22 Section 20(1), Designs Act 1906 (Cth).
- 23 Section 19(1), Designs Act 1906 (Cth).
- 24 Section 19, Designs Act 1906 (Cth).
- 25 IP Australia, The Designs Information Pack: How to register and look after your design, July 1999, p 5. Costs are current as at 2001.
- 26 *Malleys Ltd v J W Tomlin Pty Ltd* (1961) 35 ALJR 352.
- 27 Section 32B(1), Designs Act 1906 (Cth).
- 28 Section 10(1), Copyright Act 1968 (Cth) defines ‘artistic works’. See *Warman International v Environtech Australia Ltd* (1986) 6 IPR 578.

- 29 Section 31(1)(b)(i), Copyright Act 1968 (Cth).
- 30 Section 21(3), Copyright Act 1968 (Cth).
- 31 Jill McKeough and Andrew Stewart, "Intellectual Property and the Dreaming" in Elliott Johnston et al, (eds), *Indigenous Australians and the Law*, Cavendish Publishing Australia Pty Ltd, Flinders University of South Australia, Adelaide, 1997, pp 53 – 79 at p. 73.
- 32 Section 77(1)(b), Copyright Act 1968 (Cth).
- 33 Regulation 17(1) of the Copyright Regulations.
- 34 Howard Morphy, "The Art of Northern Australia" at p. 59 in C Cooper et. al - Australian Gallery Director's Council (1981).
- 35 Wally Caruana, *Aboriginal Art*, Thames and Hudson, Singapore, 1993, p. 15.
- 36 Banduk Marika, *Rirratjingu Clan Design*.
- 37 Wally Caruana, op. cit., p. 22.
- 38 *M* and Others v Indofurn Pty Ltd and Others* 30 IPR 209. The study regarding this case can be viewed at <<http://www.wipo.int/globalissues/studies/cultural/minding-culture/carpetscase/index.html>>.
- 39 *Report of the Working Party on the Protection of Aboriginal Folklore*, Australian Government Printing Service, Canberra 1981, at p. 3.
- 40 *Ibid.*, p. 13.
- 41 Australian Law Reform Commission, *Designs*, Report No. 47, Australian Government Printing Service, 1995, Canberra.
- 42 *Ibid.*, p. 13.
- 43 *Report of the Working Party on the Protection of Aboriginal Folklore* Department of Home Affairs and Environment, Australian Government Printing Service, Canberra, 1981.
- 44 Submission of Aboriginal Legal Service, Hobart, 1 September 1994, written by John Wells, State Secretary, Tasmanian Aboriginal Centre.
- 45 107 ALR 1 at 51.
- 46 Meeting with Sharon Thomas, Designs Examiner, IPAustralia 16 July 2000.
- 47 Also known as "Ayers Rock."
- 48 See <www.ausflag.com.au/flags/ab.html>.
- 49 Section 5 Flags Act 1953.
- 50 37 IPR 207.
- 51 Pursuant to Section 77 of the Copyright Act 1968 (Cth). The rationale for loss of protection is discussed by Jill McKeough and Andrew Stewart, "Intellectual Property and the Dreaming" in Elliott Johnston et. al, *Indigenous Australians and the Law* (ed.), Cavendish Publishing Australia Pty Ltd, Flinders University of South Australia, Adelaide, pp 53 – 79 at p. 73.
- 52 Colin Golvan, "Copyright Ownership of the Aboriginal Flag", *Art + Law* 1997, Issue 2, p. 8.
- 53 *Ametex Fabrics Inc v C & F Fabrics Pty Ltd* (1992) 24 IPR 449 "In this case Wilcox J held that the immunity from suit for infringement conferred by s 77 deprived the copyright owner of a right of action but did not have the effect of divesting the copyright interest". *Thomas v Brown & Anor* 37 IPR 207 at 266.
- 54 See <www.flag.com.au/flags/torres.html>.
- 55 Under section 5 of the Flags Act 1953 (Cth). Proclaimed on 14 July 1995.
- 56 Meeting with Peter Anderson, Secretary, Island Coordinating Council.
- 57 Interview with Lewis Burns, Dubbo, August 2000.

- ⁵⁸ Section 10(1)(c), Copyright Act 1968 (Cth) provides that works of artistic craftsmanship are "artistic works".
- ⁵⁹ Must have the necessary display of skill for the requirement of 'craftsmanship': per Lord Reid in *George Hensher Ltd v Restawile Upholstery (Lanc) Ltd* [1976] AC 64.
- ⁶⁰ ***George Hensher Ltd v Restawile Upholstery (Lanc) Ltd* [1976] AC 64.**
- ⁶¹ See Fibrecrafts, Aboriginal Australia (Information Booklet) published by ATSIC, Canberra 1998.
- ⁶² ***M* and Others v Indofurn Pty Ltd and Others*** 30 IPR 209.
- ⁶³ ***ibid.*** at 215.
- ⁶⁴ Terri Janke, op. cit., p. 132.

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INTRODUCTION

The Laura Aboriginal Dance and Cultural Festival (the "Festival") is a bi-annual celebration of Indigenous Australian song, dance and music. The Indigenous dancers from the Cape York region perform their traditional cultural dances as their community has performed them for thousands of years. The performances of dance, music and cultural images exhibited represent the diversity of the Indigenous cultures of Cape York. Tourists, both national and international, attend the Festival with approximately 7,000 having attended the Festival in 1999. The protection of Indigenous performances and images are an important issue for Indigenous performers and the Festival organizers.¹

In 1998, the Cape York Land Council alerted the *Wik Apalech* dancers from *Aurukun*² to products that reproduced their images without their knowledge or consent. A photograph of the dancers, depicting the dance group dressed for ceremony with body painting and feathered headdresses, was taken by a commercial photographer who attended the Festival in 1995. The photograph was additionally reproduced onto CDs, postcards, and cassettes on a related website also without the consent of the performers. The *Wik Apalech* dancers found the unauthorized use of their images on the postcards and CDs offensive. The reproduction of their cultural material was suitable for dissemination only by those with the relevant status. As a result the dancers directed the Cape York Land Council to take action to end the manufacture of the products and to remove the photographs from the website.

THE TRADITIONAL CULTURAL EXPRESSION

Dance, song and ceremony are an integral part of *Wik* culture. The *Wik* people have a distinct cultural and social life which has an integral link to their rights and association with *Wik* land from the *Aurukun* in the Cape Keer Weer region of Cape York Peninsula in Queensland, Australia. This cultural association was the main focus of the case *Wik Peoples v Commonwealth* in 1996.³ The right to reproduce the dances, stories, songs, and the body paintings of the *Wik* people are an expression of this cultural association. In other words a complex system of ownership of songs, dances and body designs has developed in association with belonging to the country and the land from which they originate.⁴ There is ownership over each element of the ceremony namely, the song element, the dance element, the body-painting element and the feathered headdresses. A senior custodian with relevant authority must be present whenever the ceremony is performed.

The dance depicted in the photograph is performed by several male dancers and one central dancer, the elder and custodian of the dance.⁵ The dancers' bodies are painted in designs denoting their clan affiliation and seniority therein. There are five *Wik* clans - *Sara*, *Apalech*, *Wannum*, *Winchanem*, *Wik Waya*.⁶ The dance is performed with singing and clapsticks and the particular dance being performed contains underlying sacred knowledge which cannot be disclosed here.

The CD cover, where the photograph was reproduced, was called "*Corroboree* – Traditional Aboriginal Song and Dance". The word "*corroborree*" in the Cape York context refers to *malpa* or "play about dances"⁷ and to be used in this context, is offensive to the sacredness of the performance.

The *Wik Apalech* Dancers, from the *Aurukun* include:

Male Dancers:	Felix Yunkaporta Bruce Yunkaporta Marty Shortjoe Perry Yunkaporta Leon Yungaporta Patrick Koongotema
Female Dancer:	Gladys Tybingoompa - elder and spokesperson
Singer:	Joe Ngallametta, Minhbadha - elder spokesperson

Commercialization of Traditional Cultural Expression

The Group usually performs at Festivals in the Cape York region, including the Lockhardt Festival and the Laura Festival. They have also performed in the public for occasions such as the opening of the Australian National Museum in Canberra. However, except for the Laura Festival now attended mostly by non-Indigenous persons, these performances are limited. The dances at the Laura Festival are often now only performed for an Indigenous audience.

Indigenous communities, such as the *Wik* community, conduct open performances of ceremonies at respected events like the Laura Festival, for the purposes of sharing their culture and an understanding thereof.

Customary Law Rights to Perform and Disseminate Ceremony

Under *Wik* customary law, the right to control elements of ceremony or performances rests with certain individuals who are referred to as senior custodians. The authority vests in these senior custodians under a complex system of authority and relationships. Each element of the performance - the song, the dance, the body painting and the feathered head-dresses - can only be reproduced and disseminated with the consent of the senior custodians and in some instances, in the presence of custodians as only certain individuals can authorize reproduction of each element. When a senior custodian passes away, this authority is passed on to another person to continue the responsibility of guarding the elements of ceremony.

In performing the dance, the performers have a duty to the audience to prepare them for what they are about to see and hear. According to John Von Sturmer, an anthropologist, the dancers have a duty to the audience to protect those who have not previously seen the ceremony. They can do this by putting underarm smell on everybody. A photograph of the ceremony is seen as a reproduction and if the images are circulated prior to the performances, then the dancers cannot exercise this care for those people who have never seen the ceremony.⁸

Those who hold the responsibility for the use of the elements of the ceremony are not in control of the dissemination of these elements. Joe Ngallametta, *Wik* elder, notes that there are serious consequences for the unauthorized reproduction of the elements of ceremony.⁹ Such punishment might include spearing the transgressor in the leg or taking away his or her rights to participate in the ceremony.

Images of People

Under *Wik* custom, a person's image is regarded as an extension of his or her spirit and any reproduction of images should be done in consultation with them. Additionally it is offensive, within their custom, to display images of deceased persons. Therefore the depiction and reproduction in this case of the image of the main dancer, now deceased, is offensive and contrary to *Wik* custom.¹⁰

DECISION-MAKING AND CONSENT

The Cape York Land Council, an Aboriginal Corporation established in 1990¹¹ to assist Cape York Indigenous communities in land management issues, is also a native title representative body for the region. It has legal advisers working on native title claims for Indigenous clans in the Cape York region.

The postcards and CDs bearing the *Wik Apalech* Dance Group's images were discovered in 1998 by those who knew the dancers. The postcards and CDs were discovered being sold in a tourist retail outlet in Cairns and were brought to the attention of the Cape York Land Council. After further investigations, cassettes with the images were discovered to be reproduced on a related website on the internet. The Land Council sought specialist legal advice on the intellectual property issues of the reproduction of the images of the dancers.

RELATED RIGHTS AND COPYRIGHT

The *Wik* people wanted to take action against the photographer, the CD and cassette manufacturer alleging that the wide dissemination of the photograph was denying their cultural rights to guard the dissemination of the elements of the ceremony. In addition, the wide dissemination of a deceased respected elder was contrary to their custom.

The performers had little knowledge of copyright and intellectual property laws. However, they knew the consequences of unauthorized reproduction of the dance and related story under their own customary laws. At the time the photograph was taken, the performers did not understand that an ownership right such as copyright would vest in the person taking their photograph.¹² According to the dancers, if they had known this, they would not have allowed any photography at the performance or would have reconsidered performing such an important dance at the Festival. Since taking the action, the dancers are now more aware of copyright laws. Photography is restricted and careful choices of what dances are to be performed at the more public events are made.¹³

The elements of the performance raise the following issues in copyright:

- Is the dance a protected performance?
- Is the dance protected by copyright as a dramatic work?
- Are the body paintings protected by copyright as artistic works?
- Who has rights in the photograph?

Performers' Rights

There are performers' rights in the Copyright Act of 1968 (Cth) (the "Copyright Act") which allow a performer to bring an action for an injunction and damages in regard to the

unauthorized use of his or her performance. Criminal sanctions also apply. An unauthorized use includes:-

- making of an unauthorized sound recording or film of the live performance;¹⁴
- broadcasting or transmitting the live performance or unauthorized film or sound recording without permission;¹⁵
- making commercial use of the unauthorized films and sound recordings of the performance;¹⁶
- possession of an unauthorized film or sound recording for the purpose of a commercial dealing.¹⁷

“Recordings” means a “sound recording or cinematograph film” and it is questionable whether or not performer's rights would extend to still photography.

The current Copyright Act complies with the minimum obligations of the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (known as the “Rome Convention”).¹⁸ In most countries, performer's rights do not form part of copyright even if the rights may be contained within the Copyright Act. There have been some discussions in Australia regarding extending the scope of rights for performers under the Copyright Act.¹⁹

The Rome Convention, concluded in 1961, arose out of the joint efforts of the International Labour Organization, UNESCO and WIPO. The Convention leaves each contracting state to determine how it will accord performers protection, whether by copyright, administrative or penal measures or labour legislation.²⁰

The Trade Related Aspects of Intellectual Property Agreement (the “TRIPS Agreement”) provides for the enhanced protection of performers.²¹ Article 14.1 gives performers rights to prevent unauthorized fixation of an unfixed performance, unauthorized reproduction of such a fixation and unauthorized broadcast by wireless or communication to the public.

Some commentators note that if national laws provide protection for the performances of folklore performers and the phonograms (sound recordings) and broadcasts that embody them, then expressions of folklore can be indirectly protected in the form in which they are actually made available to the public. An indirect international system of protection might be set up in light of the principles of national treatment under the Rome Convention. However, under the Rome Convention, a “performance” can only be a performance of a “work” and in many cases, as a traditional dance is not considered to be “original” it does not constitute a “work.”²²

Whilst the definition of “performer” in the Rome Convention does not include a performer of folklore, there is now agreement at the international level that the protection of performers extends to the performers of expressions of folklore.²³ See the WIPO Performances and Phonograms Treaty of 1996 (WPPT), where the definition of performer includes performers of expressions of folklore.

Copyright in the Dance

Copyright subsists in dramatic works that are original and in material form. A dramatic work “includes a piece for recitation, a choreographic work or entertainment in dumb show, the scenic arrangement or acting form of which is fixed in writing or otherwise, and a cinematography production where the arrangement, the acting form or the combination of incidents represented gives the work an original character.”²⁴

For a work to be original, it must have originated from the alleged author. In other words, it must be the result of the author's own unaided efforts and it must not have been copied from elsewhere. A traditional dance or ceremony may have been handed down through the generations being refined with each generation. Although traditional dance follows pre-existing themes, there is individual interpretation by the performers. In the same way that copyright was recognized as existing in artistic works of Indigenous artists that followed pre-existing traditional designs, copyright might exist in a dance performed by a group of Indigenous dancers who bring their own skill, talent and technique to a pre-existing dance.²⁵ This raises the issue of whether a dance could be a copyright work as a particular interpretation or choreography. A dance performance may arguably constitute a dramatic work under the Copyright Act.

The second criterion is that a work must be reduced to material form. Copyright cannot subsist in a spectacle or performance.²⁶ There is a clear requirement of fixation in Australian law before copyright vests in a dance. Indigenous dance is transmitted via oral means, and learned through performances. Unless the dance was recorded in material form, by way of film or notation, then the requirement of material form will not be satisfied.



Wik Apalech Dancers at the Launch of the National Museum of Australia, Canberra, 2000.
All rights reserved



Photos courtesy of Leonore Lancaster, then Arts Coordinator of Aurukun Arts and Craft Centre
Permission: Aurukun Shire Council, 2004.

Copyright in the Body Paintings

The designs painted on the dancer's bodies for the performances are significant identifiers of each clan. Whether a person is entitled to wear a design depends on a "series of qualifications," well defined in Indigenous customary laws.²⁷ Case law in copyright has considered body painting not to be a permanent medium, and therefore not protected by copyright law.²⁸ However, given that copyright protection has extended in recent years to protect new technology developments, this issue might also require reconsideration.

Copyright in the Photograph

Copyright subsists in photographs as artistic works. Photograph is defined in the Copyright Act as "a product of photography or of a process similar to photography, other than an article or thing in which visual images forming art of a cinematography film have been embodied, and includes a product of xerography, and "photographic" has a corresponding meaning."²⁹

Copyright in a photograph lasts for 50 years from the date of first publication³⁰, the author of a photograph is the person who took the photograph.³¹ According to Ricketson, it can be argued from this "that the mere taking of the photograph satisfies the correlative requirements of authorship and originality."³²

The photographer in this case exercised skill and talent in taking the photograph. Hence, there is copyright in the photograph, which vests in the photographer. The dancers, the subjects of the photograph, do not have a copyright interest.³³

The copyright owner of the photograph, has the rights to:

- to reproduce the work in a material form;
- to publish the work;
- to include the work in a television broadcast; and,
- to cause a television programme that includes the work to be transmitted to subscribers to a diffusion service.³⁴

In this matter, the photographer's actions and use of the photograph were within the scope of the exercise of his copyright under copyright law.

PASSING OFF AND MISLEADING AND DECEPTIVE CONDUCT

The legal action in this case was strengthened by raising passing off and trade practices issues.

The common law action of passing off provides a remedy to a plaintiff who can show loss arising from the defendant's representation that his or her own goods or services are those of the plaintiff.³⁵

Section 52 of the Trade Practices Act of 1974 (Cth) aims to protect consumers from any act of a corporation which is "misleading and deceptive." Section 53(d) prohibits a corporation from representing that goods have a "sponsorship, approval or affiliation" they do not have.

The postcards and the CDs were packaged with slogans such as “Aboriginal” and “authentic.” The postcard included a description at the back which made reference to “(t)he Wik nation people from Aurukun community.”

The statement is arguably misleading as it allows the public to believe that the postcards were “authentic”, and therefore the statement was a possible breach of section 52 of the Trade Practices Act.

Under trade practices, the following remedies are available to persons who can establish their case:

- An injunction restraining further production and sale of the articles. It is also possible to request an interlocutory injunction stopping the production of images urgently;
- General directive orders including corrective advertising;
- Account of profits may be available for fraudulent and not innocent infringements; and,
- Damages including loss of income and/or loss of bargain.

It was also argued that the statement and reproduction of the photograph on the products misled consumers and the general public to believe that the photograph was taken with the endorsement and approval of the **Wik** dancers and that there was some affiliation or sponsorship between the makers of the products and the dancers.³⁶

DEFAMATION

Defamation is a communication by one person to another in words, pictures or other material which adversely affects the reputation of a third party, or which causes a third person to be shunned and avoided, in circumstances where there is no proper defense.

As noted above, the reproduction of the images was culturally inappropriate and the context of the cover with non-**Wik** songs was also offensive. It was argued that given that the **Wik** dancers were identifiable in the photograph, they might have an action in defamation in that the publication of the photograph implied that the dancers allowed themselves to be photographed and the cultural material to be disseminated in a commercial and inappropriate way. This may also cause injury to the dancer's reputation implying that they have transgressed customary law and could jeopardize their rights to dance and wear the body designs. As the matter did not progress to court, these arguments were not tested.

HOW THE MATTER PROCEEDED

A letter of demand from the **Wik** dance group was sent to the manufacturers. A letter of demand is a written demand stating the terms with which one seeks to resolve a legal dispute prior to commencement of legal action. In some cases, sending a letter of demand can achieve results without the need for commencing expensive litigation. It is often the first step in commencing legal action prior to filing in the courts. The letter of demand for the **Wik** dance group sought the following:

- cessation of the production, sale and distribution of the postcards, CDs and cassette tapes featuring the unauthorized photograph;

- immediate removal of the photograph from the website;
- delivery-up³⁷ of all existing products which bear the photograph of the dancers. The court has power in equity to order a defendant to deliver up articles which have been made in contravention of the plaintiff's proprietary rights;³⁸
- written undertaking that they will no longer manufacture, import, distribute, offer for sale or display the photograph in any form of media;
- full account of income derived from sales; and,
- a written apology to the *Wik* Dance Group.

EXPECTED RESULTS

By coordinating the action the Cape York Land Council and the *Wik Apalech* dancers hoped to stop the unauthorized use of Indigenous materials of the Cape York people and to bring some understanding to the photographer and others about Indigenous cultural rights regarding dissemination of images and of performances. It was also felt that the image and the rights to control dissemination of the image were related to native title issues, and given that the *Wik* determination has not yet been finalized, it was necessary for the group to guard and protect all aspects of their cultural and intellectual property.

OUTCOME

After writing the letter of demand, the solicitor for the photographer and CD manufacturer responded stating that they were within their rights to reproduce the photograph. They stated that they would no longer use the image. However, they refused to give an apology or to pay any damages.

The use of the image on the postcards, CDs and cassettes was stopped and removed from the website. With respect to the CDs and cassettes, the photograph was removed from the cover and replaced with a photograph of another Indigenous dance group. The new group was clearly acknowledged.

FINANCIAL QUESTIONS

The matter was facilitated by the Cape York Land Council. The Cape York Land Council have their own legal advisers who provide advice in relation to native title and land related issues. The Cape York Land Council outsourced the case directly to lawyers specializing in copyright and intellectual property law.

The cost of obtaining professional advice regarding options and remedies were prohibitive for this group and for many other groups. Access to expertise is usually restricted due to the high cost of litigation. Once a group decides to take legal action, the cost involved in the initial steps may be more than the group's available funds. The costs involved in litigation preclude many Indigenous applicants from court, and therefore many test cases which could have advanced in the law are not run.

Costs were a major factor in the Indigenous groups not taking further action. The Cape York Land Council was unable to fund the action and was not in a position to apply for test case funding through the Aboriginal and Torres Strait Islander Commission (ATSIC). As a result, the action for passing off and misleading and deceptive conduct was not pursued.

LEGAL QUESTIONS

The legal question of this case in relation to copyright laws is whether performers have the exclusive right to authorize or prevent the taking of photographs of their performances? Under Australian law, this issue is unclear and it would seem that performer's rights extend only to sound and audiovisual recordings, and not to still photography.

In this case, the only legal basis for action was found in trade practices laws.

Had the matter gone to court, the legal issue would have been whether the products mislead consumers to believe that:

- there was a connection or association with the *Wik* peoples; and,
- the *Wik* peoples, or the *Apalech* dancers, had authorized the use of the photograph on the postcard and the internet.

A BETTER APPROACH

Written Agreements

Since the incident, Ang-Gnarra Aboriginal Corporation, the Laura Festival organizers, have adopted a written agreement concerning all photography and filming at the Festival. The agreements contain terms which require consent to be cleared by the performers and certain conditions for control of commercial photography. Approved photographers sign an agreement to state that any commercial photography will be done only with the consent of the performers.

Since the use of the agreement, there is greater control by Indigenous groups of their performances. In 1999, a photographer signed a Conditional Entry Contract with Ang-Gnarra and sought permission, from the peoples and the elders, to take photographs of individuals and groups attending the Festival. Many of the photographs were of Indigenous children in attendance as part of the Families Project, coordinated by an Aboriginal Health Organization and Apunipima Cape York Health Council. Permission was also sought to reproduce the images, which had been marketed as cards by an international charity. Eight percent of the wholesale price of the cards was donated to Apunipima Cape York Health Council. Each card stated the following: “(a) percentage of the wholesale cost of this card is donated to Apunipima Cape York Health Council”. Other local communities sought “in kind” support, in exchange for permission to take and use the photographs. Each community came up with a small project making use of the photographer's skills. For instance, the Kuranda group chose to participate in production of a poster to promote the local dance group; the Aurukun children were assisted with a photography project; and, the Mossman Gorge community are negotiating production of a flyer for a bush-walking tour.³⁹

Warnings and Notice

The organizers have also adopted the procedure of issuing warnings before certain performances, requesting that no photographs be taken. According to some media, this has had an impact on the exploitation of the performers at the Festival and also serves to increase general awareness of the issues.⁴⁰

CONCLUSION

Indigenous performances and ceremonies are important expressions of Indigenous cultures. Indigenous people exhibit and publicly perform their work at festivals attended by both non-Indigenous and Indigenous people. The performance of Indigenous dance, song and ceremony raise some pertinent issues with respect to the ability of intellectual property laws being able to protect cultural expressions.

The case points to a deficiency in the current Australian law of performer's rights protection under the Copyright Act which extends to aural and audiovisual recordings and broadcasting. There have been instances where Indigenous persons in Australia have been photographed without their consent and the image commercially exploited in an entirely different context.

Trade practices and passing off laws also have their limitations as the applicant must establish a reputation in order to stop the exploitation of their cultural material. The absence of protection of rights for traditional dance performance under intellectual property laws has left Indigenous peoples no other choice but to look elsewhere for protection.

Cultural Protocols

Protocols also could be a way of promoting practices consistent with Indigenous customs and beliefs. There is a Special Broadcasting Service (SBS) Protocol Guideline written by Lester Bostock with respect to the filming of Indigenous peoples. It contains information and guidelines to deal with cultural issues. For instance, with respect to the showing of images of deceased persons, Bostock recommends:

“Should a person originally filmed for a particular sequence in a film or television project subsequently die, the image of that person should be edited out or “blurred” so as to remove any distinguishing or identifying aspects before it can be publicly viewed by the clan/tribal groups from which the image originated. The extent of this prohibition will vary from clan group to clan group, and will depend on the particular group that the film or video is about.”⁴¹

There is evidence of Indigenous communities and commercial photographers collaborating to share the benefits from the exploitation of Indigenous imagery. One group is exploring a scheme for a commercial gallery of Indigenous approved images where copyright in the images is owned and distributed by an Indigenous trust. The images for use are cleared culturally and will include not just people but landscapes as well.

Indigenous Rights to Personal Images

It was noted in *Our Culture: Our Future* that many Indigenous people have expressed their concern for use of their images without their permission. It is generally not necessary to obtain the permission of a person to take their photograph as there is no general law of privacy in Australian law⁴² or rights of publicity.

Unless it is a commissioned portrait, the person who is the subject of a photograph does not have exclusive rights and cannot use copyright law to stop the photographer from dealing with the image commercially. Despite this, when recording the images of Indigenous people, there is a need to respect the cultural life of Indigenous people and seek the prior consent of a person with authority for commercial photography.

A photographer may also need to get a permit to take commercial photography on Aboriginal land. For instance, see the ***Uluru-Kata Tjuta National Park, Commercial Photography Guidelines***. As the following case illustrates, seeking the prior consent of those photographed, and the Indigenous custodians of the land can divert many problems: in 1998, Galarrwuy Yunupingu was alleged to have assaulted a photographer and damaged his camera and equipment.⁴³ Yunupingu was acting in his role as custodian to protect two Yolngu children whom the photographer had photographed while swimming naked. Yunupingu snatched a camera from the hands of the photographer and destroyed the film. The photographer was reported to have been a trespasser on Gumatj land as he did not have a permit to enter the land. Under the terms of the permit, there are conditions prohibiting commercial photography on Gumatj land without permission of a senior custodian. However, as the photographer had not applied and attained a permit, he was unaware of these conditions.

As noted by the Court:

“Under Yolngu law, if a stranger wishes to visit Gumatj land, it is expected that he approach a senior member of the land. He should approach the senior member with the purpose of seeking permission to enter the land and should receive the permission of that senior member before entering. The senior elder has a discretion. He can refuse permission to enter.”

“Another offence ... is the taking of photographs for commercial purposes, whilst on Gumatj land, without the permission of the senior elder or senior member. Under Yolngu law, the image of the land is valued highly. It is believed that the reproduction of an image of the land interferes with Yolngu law because it diminishes the integrity or the strength or the wholeness of the land.”

“The landscape includes ground, trees, rocks and streams - the landscape as well as the people on the land who identify with the land, and its spirits.”

“If a stranger trespasses or takes photographs for a commercial purpose without permission, he is expected to expiate his wrongdoing. Expiate means pay the penalty or make amends. This might involve giving compensation, or a criminal sanction and an apology.”⁴⁴

Yunupingu explained that photographing a person was an act of capturing that person's spirit. The Court was satisfied that as senior custodian of that clan, Yunupingu was responsible for the representation of Gumatj land. The Court found that Yunupingu's actions were consistent with this responsibility. The charges were dismissed.

Endnotes

- 1 The Laura Festival is organization by Ang-Gnarra Aboriginal Corporation in Cooktown, Queensland.
- 2 Cape Keer Weer region of Cape York Peninsula, Queensland.
- 3 **Wik Peoples v Commonwealth** (1996) 187 Commonwealth Law Reports 1.
- 4 Meeting with John Von Sturmer, Anthropologist, 10 October 2000.
- 5 There is also a woman accompanying the male dancers who was not shown in the photograph.
- 6 Clan names.
- 7 John Von Sturmer, Anthropologist, 10 October 2000.
- 8 Interview with John Von Sturmer, 10 October 2000.
- 9 Meeting with Wik Apalech Dancers, Aurukun, 13 September 2000.
- 10 Interview with Wik Apalech Dancers, Aurukun, 13 September 2000.
- 11 For information about Cape York Land Council see website, <<http://www.cylc.org.au>>.
- 12 Interview with Wik Apalech Dancers, Aurukun, 13 September 2000.
- 13 Interview with Wik Apalech Dancers, Aurukun, 13 September 2000.
- 14 Section 248G(1)(a), Copyright Act 1968 (Cth).
- 15 Section 248G(1)(b), Copyright Act 1968 (Cth).
- 16 Section 248G(2)(a), Copyright Act 1968 (Cth).
- 17 Section 248G(2)(d), Copyright Act 1968(Cth).
- 18 International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, (the Rome Convention).
- 19 Commonwealth of Australia, Performers' Intellectual Property Rights: Discussion Paper, December 1997.
- 20 Article 7, Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations.
- 21 See Article 14.
- 22 Compare the argument that each performer interprets and brings skill to his or her performance thereby creating a new work.
- 23 See WIPO/GRTKF/IC/3/10, para. 57 to 61.
- 24 Section 204, Copyright Act 1968 (Cth).
- 25 **Milpurruru v Indofurn.**
- 26 **Victoria Park Racing & Recreation Grounds Co v Taylor** (1937) 58 CLR 479.
- 27 Kenneth Maddock, "Copyright and Traditional Designs: An Aboriginal Dilemma", (1988) vol 2(34) Aboriginal Law Bulletin, p. 8.
- 28 Merchandising Corp of America Inc v Harpbond Ltd [1982] FSR 32.
- 29 Section 10(1) Copyright Act 1968(Cth).
- 30 Section 96, Copyright Act 1968(Cth).
- 31 Section 10(1), Copyright Act 1968(Cth).

32 Ricketson, Para 7.385, p. 98.

33 If it was a commissioned portrait, copyright vests in commissioner.

34 Section 31, Copyright Act 1968 (Cth). At the time the matter was being considered this was the relevant law. We note that there have been changes to the Copyright Act since the matter, so the Act now includes the right of communication to the public.

35 ***Reddaway v Banham*** (1896) AC 199.

36 Section 53(d), Trade Practices Act 1974 (Cth).

37 Handing over of all unsold products in possession of the infringing party.

38 ***Prince Albert v Strange*** (1849) 2 DeG & Sm 652.

39 Interview with Michael Winer, Cape York Partnerships, October 2000.

40 Interview with Nancia Guivarra, Away Producer, Radio National.

41 Lester Bostock, *The Greater Perspective: Protocol and Guidelines for the Production of Film and Television on Aboriginal and Torres Strait Islander Communities*, Special Broadcasting Service, Second Edition, 1997, p. 26.

42 There are other laws such as defamation and trade practices laws that might be relevant.

43 ***Colin Goodsell v Galarrwuy Yunupingu***, Court of Summary Jurisdiction, Northern Territory of Australia (Gillies SM), 20 February 1998, (1999) 4 Australian Indigenous Law Reporter 29.

44 ***Ibid.*** at p. 30.

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OVERVIEW

In 1997, t-shirts depicting Indigenous rock art from Eastern Arnhem Land were discovered being sold at a local market. Indigenous Australian rock art, as practiced in Arnhem Land, has been heralded as the world's longest continuing art tradition.¹ The rock art copied on the t-shirts came from rock walls painted many years ago in the Deaf Adder Creek region. The t-shirt design reproduced two types of rock paintings amalgamated into one design. Although painted some time ago, the rock art images remain highly significant to contemporary Indigenous life and custom. The rock art was first recorded in the late 1960s to 1970s, by a researcher, Eric Joseph Brandl.² Brandl received funding from the Australian Institute of Aboriginal Studies, now the Australian Institute of Aboriginal and Torres Strait Islander Studies, (the "Institute") to record rock art in East Arnhem Land.³ He undertook several fieldtrips to the area during the period from 1968 to 1972. Brandl's technique of recording the rock art was novel in that he adopted a process of photographing, drawing and isolating the rock art images to produce black ink line drawings (the "Brandl Works"). These drawings and photographs were published by the Institute in 1973 in a book entitled *Australian Aboriginal Paintings in Western and Central Arnhem Land, Temporal Sequences and Elements of Style in Cadell and Deaf Adder Creek Art*⁴ (the "Brandl Book"). The Brandl Book was the first publication of the Brandl Works. Moreover, images of the Deaf Adder rock art sites are rare and the site itself is restricted from public access. Given this, it was highly probable that the t-shirt manufacturers copied the images of the rock paintings directly from this unique publication.⁵

In copyright terms, the matter raised interesting legal issues. Firstly, the author of the rock art remained unknown. Further, the age of the rock was such that copyright was unlikely to subsist in the actual rock art. This was because the rock art was so old that it was created more than fifty years since the death of any likely artist. Hence, the Indigenous custodial group had no remedy under copyright against the t-shirt manufacturers. The novel aspect of the matter related to the copyright interests in the drawings of the rock art made by Brandl and the photographs of the Brandl Works that were published in the Brandl Book. The making of the drawings and the taking of these photographs created new copyright rights which were enforceable against third parties. In the interests of stopping the unwarranted copying of the rock art, the Institute took up the issue with the t-shirt manufacturers arguing that the legal rights to authorize reproduction of the Brandl Works and the photographs were infringed. On behalf of the Indigenous informants and Dr. Brandl, the widow of E. J. Brandl, the Institute followed up with a letter of demand to the manufacturers, which among other things, required immediate cessation of production and damages. The Company which had made the t-shirts agreed to cease production immediately and the matter was settled after lengthy negotiations.

THE TRADITIONAL CULTURAL EXPRESSIONS

The rock art images copied on the t-shirts are from a rock art site in the Deaf Adder region of the Northern Territory located just outside Kakadu National Park.⁹ Kakadu National Park is a World Heritage Area, listed for both cultural and natural heritage, which covers almost 20,000 square kilometers, and includes the traditional lands of a number of Aboriginal clan groups. Kakadu is managed jointly by its Aboriginal traditional owners and Environment Australia, a Commonwealth government agency charged with the responsibility for and management of the environment and heritage sites.

THE AUSTRALIAN INSTITUTE OF ABORIGINAL AND TORRES STRAIT ISLANDER STUDIES

The Institute is a statutory authority of the Commonwealth government charged with promoting Indigenous Australian cultures. The Institute is also an Indigenous Australian organization, with a Council of predominately Indigenous academics and an increasing proportion of Aboriginal and Torres Strait Islander members and staff.⁶ The main functions of the Institute include: -

- Undertaking and promoting Aboriginal and Torres Strait Islander Studies and encouraging other persons or bodies to conduct such research;
- Publishing the results of such studies;
- Assisting in training persons, particularly Indigenous Australians, as research workers in fields relevant to Aboriginal and Torres Strait Islander Studies.⁷

In an effort to meet these goals, the Institute: -

- Employs staff to conduct research, and to mentor and administer research projects conducted by others - particularly younger and Indigenous researchers;
- Funds a grants program;
- Commissions particular research projects to be done by independent researchers;
- Funds research fellowships;
- Undertakes consultancies;
- Publishes and otherwise makes available research reports and outcomes.⁸

The rock art in this area is considered to be amongst the finest and most extensive collections of rock art in the world, a visible reminder of Indigenous people's long and continuing association with the area.

The rock art figures that are copied on the t-shirts are *Mimi* art.¹⁰ As Brandl notes, "*For most Arnhem Landers the practice of painting on rock, and especially the meaning of the designs, have become associated with the past.*" Brandl notes that, according to Aborigines, "*these monochrome red paintings are the work of Mimi people or Mimi spirits.*"¹¹

The area where the rock art figures originates is referred to by local Aborigines as "*Balawurra*"¹² (or "Stoney Country")¹³, otherwise known as Mount Gilruth. The particular group of paintings was found overlaying earlier designs. According to their stylistic form and weapons, they are estimated to be approximately four to six thousand years old.¹⁴

To the Aboriginal people, the rock art is the cultural base for Aboriginal laws and customs. It is part of the continuum of culture and is linked to all aspects of Aboriginal life. According to Ms. Mandy Muir, a *Gadgadju* woman who lives in Kakadu National Park, the rock art tradition still continues today.¹⁵

Members of *Gadgadju* live in the outstations in the Kakadu National Park, having a strong connection to their land and its resources. The Park's Plan of Management contains provisions for the involvement of Aboriginal people in the Park's management including:

- Resource harvesting program which meet conservation criteria as agreed between the Director and a representative of the Northern Land Council;¹⁶
- Aborigines, not being traditional owners, but entitled by tradition to use the land may so enter and use the land.¹⁷

NORTHERN LAND COUNCIL

The Northern Land Council was originally formed in the early 1970s to recognize Aboriginal land rights in the Northern Territory. The ***Aboriginal Land Rights (Northern Territory) Act 1976*** sets out the roles and responsibilities of the Northern Territory's land councils which includes among other thing: to determine and express the wishes of Aboriginal people concerning the management of their land and legislations regarding their land; protect the interests of traditional Aboriginal owners of, and other Aborigines interested in Aboriginal land; and assist Aboriginal people to protect sacred sites, whether or not on Aboriginal land.¹⁸

The Northern Land Council, as the body statutorily charged with the responsibility of Indigenous land management in Northern Territory, is responsible for identifying the traditional owners of the region.¹⁹

The main artistic work copied from the Brandl Book is a group of human beings, which appears on the cover of the Brandl Book and is also reproduced inside the book. Brandl describes the rock paintings as "***Human beings in late Mimi style***, Deaf Adder Creek area, Mt. Gilruth, Site 7."

Brandl first traveled to the Deaf Adder region in 1965 and continued to visit and record the rock art sites and its significance through to the early 1970s. In 1970, when he undertook research in the Deaf Adder region, he was guided by Indigenous informants from the ***Ngalgbon*** people, ***Spider Murululmi*** and ***Mandarg***. Brandl credits the clan groups, ***Badmardi*** and ***Renbarnga*** as the custodians of the area. The descendants of Brandl's informants are now unknown to the Institute and Dr. Brandl.

Rock art issues for the local people arise often with respect to tourism. A major issue concerns those areas which are closed to tourists, such as the Deaf Adder site and those which are open to tourists, such as the Nourlangie Rock site. Another issue is the interpretation of the art and the cultural story by outsiders including the tourism operators.²⁰

The rock art t-shirts were discovered by Dr. Vivien Johnson at a flea market in Sydney being sold for approximately A\$30 each. She contacted Ms. Mandy Muir, then of Daluk Daluk Screen printing, and showed her the t-shirts. Ms. Muir advised that Daluk Daluk artists depict some of the rock art figures, those from the more open sites, and reproduced them onto t-shirts. For instance, a screen printed t-shirt of a local artist's impression of the "lightning man" which is featured on one of the main rock faces at Nourlangie Rock was produced and sold by Daluk Daluk. However, the ***Mimi*** figures from Deaf Adder have never been reproduced in this way.

Under the instructions of Ms. Muir, Dr. Johnson sought legal advice on whether the t-shirts were copyright infringements of the rock art and whether the unauthorized use of the ***Mimi*** rock art on t-shirts could be stopped.

DR. VIVIEN JOHNSON AND THE HOUSE OF ABORIGINALITY

Dr. Johnson has been examining the commercialization of Aboriginal cultures as part of her academic pursuits. She acts as a copyright "detective", having found many unauthorized reproductions of Indigenous art and teaches a class in Sociology on Aboriginality at Macquarie University in Sydney. Dr. Johnson is the Director of the House of Aboriginality, a multimedia project on the merchandising of indigenous imageries, which has so far produced the Copyrites national touring exhibition, a website and a CD-ROM. The House of Aboriginality Project is available for viewing online at <http://www.mq.edu.au/house_of_aboriginality>

RESEARCH UNDER THE AUSPICES OF THE INSTITUTE

In the early 1970s, the Institute (then called the Australian Institute of Aboriginal Studies) funded Brandl to undertake research and recordings of the rock art sites in Eastern Arnhem Land.²¹ The purposes of the funds were for the conducting of a survey of Aboriginal sites in an area of Arnhem Land. The funds covered costs for salary, travel, hire of vehicle, equipment,²² stationery, payment to informants, photographic supplies and aerial photographs.²³ Due to the complexity of accessing the area, Brandl undertook four fieldtrips to the region.²⁴ Access was restricted, and therefore a permit was required to enter the area. Additionally expertise and local knowledge were also required to identify the exact location of the sites.

The Institute's funding of Brandl was conditional on terms which were set out in the standard Research Agreement that was required to be signed by all researchers who were in receipt of Institute funding. Among other things, the Research Agreement included the following terms: -

- The researcher was required to "submit a detailed report setting out the results of his or her research."²⁵
- The Institute reserved the first right to publish the detailed report or any substantial study in the form of a monograph or book arising from the project.²⁶
- The researcher was required to deposit any photographic material with the Institute on completion of the project. This included any negatives of film exposed in connection with the project and colour transparencies taken in connection with the project. Under the Agreement, the photographic material was to be the property of the Institute and certain licences²⁷ were provided to the Institute to use and authorize the use of the copyright material, subject to consultation with the researcher.²⁸
- Copyright in all recordings, negatives, photographs, transparencies, cine films and tapes taken or recorded in the field in connection with the project vested with the Institute.²⁹

During the 1970s, focus of the research was very much on the scientific significance of the project.³⁰ Since then the focus of Indigenous research has evolved significantly over the past 30 years. Today the intellectual property results of a project often vest with the researcher or the nominated Indigenous community.

The Brandl Book was the result of research funded by the Institute and was therefore published by the Institute. In 1973, the Institute published the Brandl Book and reprinted it with amendments in 1982 and again in 1988.

In 1994, the Institute's Aboriginal Studies Press produced an *Encyclopaedia of Aboriginal Australia*. In 1992, the Institute sought the permission of Dr. Maria Brandl to include one of the images on the cover of the Encyclopaedia and the map. Full attribution was given as follows:

"Deaf Adder Creek, Arnhem Land, NT. A Deaf Adder Creek Mimi figure with its typical attributes, large headgear, ornaments on the arms and above the hips, the boomerang and the "aura" around the body."³¹

COPYRIGHT QUESTIONS

Copyright in the Rock Art

Copyright protects literary, dramatic, musical or artistic works that are original and in material form. Copyright continues to subsist until 50 years after the end of the calendar year in which the author dies³² and does not subsist in artistic works that are older than 50 years after the death of the artist. After this period, works are considered to be in the public domain. Once in the public domain, works can be used without having to obtain the consent of the original copyright owner. Under copyright laws, the *Mimi* rock art would likely to be viewed as ancient, therefore outside the 50 years protection period. This allows the rock art to be copied without redress under copyright laws.

There is the possibility that copyright could exist in recordings of rock art where a person copies it in a new medium, such as photographs, films and other artistic works. Therefore the person who produces the new work will have a copyright interest in those works. For example, a photographer who uses skill and technique to photograph rock art will have a copyright interest in the photograph.

A further issue, however, was the copyright vested in the publication and the drawings contained in the Brandl Book.³³ From comparison of the t-shirt and the two rock art t-shirts by Dr. Johnson, who prepared a report providing a detailed analysis of the original works of Brandl and the copied work on the t-shirts, it was apparent that the t-shirt designs had been copied directly from the Brandl Book. She concluded that the figures were most likely copied from the Brandl Book.

The Brandl Book being a copyright work contains information about the rock art sites including photographs of the rock art. The Brandl Book was perhaps the only record of the images in the particular form of reproductions. Given the remote location of the rock art site, it was unlikely that the graphic designers of the t-shirts had copied from the original rock art on site.

As there was sufficient evidence to argue that copyright existed in the works contained in the Brandl Book, the Institute was approached to take further action under copyright law to stop the manufacture of the t-shirts.

Copyright in the Photographs

Copyright subsists also in photographs as artistic works.³⁴ Similarly, copyright exists in photographs of underlying works, separate from underlying works themselves, if the photographer exercised some degree of skill and labour in taking the photograph.³⁵ Therefore as Brandl took photographs of the rock art employing skill in relation to angles and lighting effects³⁶ and transformed a three-dimensional form into a two-dimensional form³⁷, copyright vests in the resulting photographs. However, the copyright exists only in the photographs and not the underlying rock art, the reason being that copyright law requires that the author be an identifiable person or persons³⁸, and that the period of copyright protection for artistic works is generally the creator's life plus fifty years.³⁹ As the rock art is over 4,000 years old and the original author is unidentifiable, copyright law does not provide protection for the rock art. The photographer of the photograph is usually the copyright owner, however, a written agreement can override this.⁴⁰ By virtue of the Research Grant Conditions as expressed in the Research Agreement above, the Institute is the copyright owner of the photographs taken during the funded project.

Copyright in the Brandl Works

A review of the literature and consultations led Dr. Johnson to conclude that it was highly possible that Brandl was the first person to record the rock art sites in the Deaf Adder Creek region and publish them in the manner in which he did.⁴¹ In a progress report to the Principal of the Institute in 1970, Brandl writes:

"Many of the sites between Oenpelli and Jim Jim Falls are of the utmost importance for the study of Aboriginal art. With the exception of the ones around Oenpelli, none of these sites has been described in the literature and most of them are not known to the public. The Aborigines, of course, know of their existence...."

George Chaloupka, an archaeologist with knowledge of the area, stated that in 1970 Brandl recorded 80 sites in Deaf Adder Creek, prior to this much of the area was unrecorded.⁴² Additionally the sites were closed to the public and have been inaccessible since the passing of the Aboriginal Land Rights (Northern Territory) Act of 1976.

The procedure used by Brandl to record the rock art required skill and technique and Brandl did so by taking photographs and doing freehand drawings on site. The photographs required precision and skill, as certain sites had to be photographed in certain light and angles. For the images contained in the Brandl Book, Brandl adopted a unique method of isolating certain images and converting them into line drawings.⁴³ Many of the images were feint and many of the figures overlaid so Brandl used brush and Indian ink to go over the designs which were visible in the photographs or the negatives. Brandl's painting then formed a mask on the original photograph which he then dipped into a bleaching solution. The result was a black and white line drawing that was distinct and striking. The result was then rephotographed. According to Dr. M. Brandl this unique technique was the first to be applied to rock art recordings.

The crucial issue was whether Brandl's input in producing the sketches for the Brandl Book imparted a substantial degree of labour, skill and discrimination to produce an original work. That is, were his sketches the result of labour, skill and judgment expended on pre-existing material, and not just the spontaneous result of his imagination?⁴⁴

Evidence provided by Dr. Johnson indicated that the process Brandl used to record the rock art was as follows:

“The designs were converted to line drawings by various methods, mainly by inking them or large-scale prints from the negatives exposed in the field. After bleaching the prints, the remaining drawings were photographed and printed in the format required for publication. Freehand drawings and tracings were reduced in a similar manner.”⁴⁵

In comparing the Brandl illustrations to the original rock art, Dr. Johnson pointed out the following differences:

- Distinctive outlines in Brandl’s work whereas the original works were faint;
- The Brandl Works were different in colour (black ink); and
- Brandl isolated the figures in his works whereas in the original works there was overlapping of some figures.

Given this, it was considered that there was a reasonable basis to assert that Brandl’s isolation, copying and reproduction of the rock art images by the unique technique he adopted involved a sufficient degree of labour, skill and discrimination to create an original work within the meaning of the Copyright Act.

As copyright in artistic works lasts for 50 years after the death of the artist and Brandl died in 1974, copyright still subsists in his works. The copyright in the Brandl Works passed on to the Estate of which Dr. M. Brandl is the executor and sole beneficiary.

Copyright in the Brandl Book as a Published Edition

Copyright also subsists in a published edition⁴⁶, and the publisher owns copyright in the publication.⁴⁷ Copyright in the published edition protects the presentation embodied in the published edition. Publication copyright lasts for 25 years after the expiration of the calendar year in which the edition was first published.⁴⁸ Copyright in relation to a published edition of a literary, dramatic, musical or artistic work or of two or more literary, dramatic, musical or artistic works, is the exclusive right to make, by a means that includes a photographic process, a reproduction of the edition.⁴⁹

The Institute first published the book in 1973 and a second edition was published in 1988. The original publication contained a dedication “ to *Mandarg* and *Murulumi* and their descendants.”

The 1988 Edition repeats this dedication but also includes a copyright statement which reads:

“©Australian Institute of Aboriginal Studies 1988: apart from any fair dealing for the purpose of private study, research, criticism or review, as permitted under the Copyright Act, no part of this publication may be reproduced by any process whatsoever without the written permission of the publisher.”

The t-shirts could have been reproduced by copying the photographs in the Brandl Books using reprographic techniques. However, to be a copyright infringement of the published edition, the reproduction would have had to amount to a substantial reproduction of the reprographic form. In the case of a published edition copyright, what is protected is not a

particular arrangement of words, musical notes, or photographic representation. The quality of what is taken must be assessed by reference to the interest protected by copyright. The question of substantiality is a matter of degree in each case and will be considered having regard to all the circumstances.⁵⁰ In this instance, the cover image and some of the images within the edition may have been copied using the reprographic process. It could have been argued that had this been so, then the copying of the cover image, a striking element of the overall publication, amounted to a substantial reproduction of this rare published edition. However, had the action relied on this alone, there would have been difficulties in relying on copyright for a remedy.

DECISION-MAKING AND CONSENT

A significant issue in the matter was the identification of the relevant traditional custodians of the area as the original Indigenous informants are deceased.

Under the *Australian Institute of Aboriginal and Torres Strait Islander Studies Act 1989*, the Institute has the power to sue as it is a body corporate and has statutory authority.⁵¹ Being aware of the wishes of the Indigenous custodians in wanting to stop the mass production of the Deaf Adder rock art on t-shirts and the difficulties and complexities of the Indigenous custodians being themselves able to take action, the Institute's Council decided to take action against the t-shirt manufacturers as the Institute was the publisher of the book and body that had funded Brandl's research.

Additionally the Institute also wished to protect its collection and publications from unauthorized commercialization by unauthorized peoples, the subject of research past funded by the Institute. It was in a position to bring action because intellectual property rights were not recognized in rock art or in knowledge unless recorded in material form. The photographs and the Brandl Works are copyright works being the recorded expression of the rock art.

The Institute contacted Dr. M. Brandl, wife of the deceased author, who gave consent for the action to be taken. Dr. M. Brandl understood that the rock art images belonged to the *Badmardi* clan and was willing to assist with bringing a legal claim for copyright to stop the commercial use of the rock art images of t-shirts. She was willing to do this given that the Institute, an Indigenous organization and the publisher of the Brandl Book, was coordinating the action. She agreed on "the basis that the ownership rights of the designs concerned reside with the Indigenous Custodians (...). That was my late husband's view and continues to be mine."⁵²

ACTION COMMENCED

Action on the legal remedies commenced in January 1998 on the following bases:

- Infringement of copyright in the Brandl Works;
- Infringement of copyright in the Photographs prepared for publication; and
- Breaches of the Trade Practices Act 1974 (Cth) and Fair Trading Act.

Rights and Remedies

The copyright owner of an artistic work has the exclusive right to do all or any of the following acts:

- to reproduce the work in a material form;
- to publish the work.⁵³

The t-shirt is arguably a substantial reproduction of the Brandl Works and the photographs, although copyright infringement was never admitted by the t-shirt manufacturers.

A copyright owner of a work has the following remedies available to them against infringers:

- ***Injunction***. An injunction is a court order prohibiting the other party from continuing to infringe the other parties' rights.⁵⁴
- ***Delivery Up***. Delivery of infringing articles to the copyright owner, if the infringer is unable to deliver up, "conversion damages" may be payable.⁵⁵
- ***Account of Profits***. Payment of profits the infringer made in exploiting the infringing articles.⁵⁶
- ***Damages***. Payment of compensation⁵⁷ and in some circumstances additional damages may be available if the infringement is flagrant. (See Case Study 1, the ***Carpets Case***, where flagrancy damages were payable to the Indigenous artists because the defendant denied copyright ownership at the outset.)⁵⁸

In some circumstances, there may be criminal liability for copyright infringement, as in the case of large-scale piracy, and orders for seizure and delivery up can be made.⁵⁹

Before initiating the letter of demand, the copyright holders (the Institute and Brandl's widow) had some awareness of copyright laws. Dr. M. Brandl stated that she was aware that western copyright law vested legal rights in the recorded or written form. She and her husband, however, have always acknowledged cultural and moral rights in the underlying information remain with the Indigenous groups whose cultural information was recorded. The understanding of both the Institute and Dr. M. Brandl at the time action was commenced was that copyright was limited in its protection, protecting only the material form. Hence, the underlying works, and the rights of the ***Badmardi*** clan, were not protected by copyright. The reason for commencing action was to use legal rights to stop the copying of cultural works that were unprotected by copyright. The recognition and protection of Indigenous Cultural and Intellectual Property were important issues for the Institute.⁶⁰

Legal Questions

Was the t-shirt design a copyright infringement?

As the matter did not proceed to court, the copyright questions were never resolved. Once the letter of demand was sent to the t-shirt manufacturers they had agreed to stop production and the negotiations were settled on a "no admissions" basis.

However, had the matter gone to court the legal issue would have been whether or not the t-shirt design, produced by the t-shirt manufacturer (the "Company"), infringed copyright in the artistic work of the photograph. Reproducing a photograph of artistic works infringes copyright not only in the artistic work, but also in the photograph.⁶¹

Additionally, it is an infringement of copyright to authorize or to conduct any of the acts controlled by the copyright owner alone without the permission of the copyright owner,⁶² especially acts relating to a substantial part of an artistic work. These acts are outlined above.⁶³

Copyright infringement occurs also with the direct copying of an artistic work, especially if it is copying a “substantial part” of an artistic work. A substantial part of an artistic work does not necessarily refer to a large part of the work, but rather the “quality” of the part copied. This issue was discussed in the *Carpets Case* (see Case Study 1) where some of the carpets reproduced only parts of the artistic works. Under the Copyright Act, it is not necessary for an artwork to be an exact copy for it to infringe copyright. Copying occurs when an artwork has been substantially reproduced. Generally, to consider this, the Court will look at the striking similarities between the original artwork and the infringing copy. Quality is more important than quantity and depends largely on the nature of the parts taken from the original artwork.

According to Dr. Johnson, the t-shirt design was an amalgamation of two images in the Brandl Book, the cover work and another single figure, which appear on consecutive pages inside the Brandl Book. The issue for the court would have been whether this was a substantial reproduction of the Brandl Works.

Trade practices

The conduct of the t-shirt manufacturers also raised trade practice issues. Had the matter gone to court, the court would have had to decide whether the conduct of the Company was “misleading or deceptive” or “likely to mislead and deceive” consumers to believe that the t-shirts are made with the consent of the Indigenous peoples, the Brandl Estate or the Institute.⁶⁴ Further, given that the Brandl Images have such a connection with the Indigenous custodians, Brandl and the Institute, the court would also have had to decide whether the t-shirts mislead consumers to believe that there is some sponsorship, affiliation or connection with the t-shirt manufacturers, the Indigenous peoples, the Brandl Book and the Institute.⁶⁵ These issues were not decided or proved as the case was settled outside court.

How the Matter Proceeded

A letter of demand, a letter to the other party outlining the list of demands being sought before taking action in court, was sent to the Directors of the t-shirt manufacturers in December 1998. In many instances the desired response, or part of, may be achieved without taking legal action as was the case here.

Immediately, the Company responded in a without prejudice letter⁶⁷ stating that they did not believe that they had infringed copyright but agreed to cease production of the t-shirts and other products bearing the designs immediately. It was alleged by the Company that they had ceased production of the t-shirts on December 11, 1998.

Protracted settlement negotiations then ensued.

In order to ascertain the number of products that the Company had sold, the Institute sought inspection of the catalogues of products made by the Company. Several products other than those first found were considered by the Institute to infringe the copyright in the artistic works although this was not admitted by the Company, which in turn ceased production of the products considered.

During the settlement negotiations, a new t-shirt produced by the Company was found being sold in Sydney. While the design was not the one originally found by Dr. Johnson, it appeared to be derived from the same t-shirt design but incorporating African traditions. For instance, hooped earrings were drawn on the *Mimi* people, African style bags and a dog was included in the scene. The Institute took issue with the t-shirt design as well, being of the opinion that this was also an infringement of the Brandl Works with the aim of stopping production thereof.

Outcome

A deed of settlement was entered into between the parties, releasing the Company from any claims against it.⁶⁷ Among other things, the Deed required the Company to:

- confirm that production or dealing in the infringing items and any new designs had ceased;
- make a statutory declaration relating to the production and sale of the infringing items, which, according to the Company, yielded some A\$5,843 in profits;
- surrender unsold stock of the infringing items to the Institute - 414 t-shirts and tops were delivered to the Institute;
- publish an apology to the Institute, the Brandl Estate and the traditional owners of the rock art in West Arnhem Land; and
- pay the Institute a sum of money.

The Institute considered the apology to be an excellent outcome, since it was the public recognition of Indigenous rights and their transgression which was central to the Institute's instigating the action in the first place.

THE FOLLOWING APOLOGY WAS PUBLISHED IN THE AUSTRALIAN⁶⁹ NEWSPAPER

(The T-shirt Manufacturer) has, at the request of the Australian Institute of Aboriginal and Torres Strait Islander Studies (AIATSIS) agreed on a without admissions basis not to sell or distribute any of the products identified and described below which AIATSIS asserts reproduce images which are an infringement of the copyright of Dr Margaret Brandl⁶⁹ and of AIATSIS in certain artistic works appearing in the Publication entitled "Australian Aboriginal Paintings in Western and Central Arnhem Land, Temporal Sequences and Elements of Style in Cadell River and Deaf Adder Creek Art" by E. J. Brandl, reprinted with amendments in 1982 and again in 1988.

(The T-shirt Manufacturer) apologizes to AIATSIS and regrets any cultural or other harm that its activities may have occasioned to the Badmardi Clan, AIATSIS or Dr. Margaret Brandl"

FINANCIAL QUESTIONS

The Institute initiated the case on behalf of the Indigenous custodians and Dr. M. Brandl. The Institute engaged the services of specialist lawyers to work on the matter.

Legal fees were the largest cost expended as well as having Institute staff coordinating and providing instructions. The case required senior members of the Institute staff to allocate considerable time and resources to administer the matter and provide instructions to solicitors.⁷⁰

A specialist opinion was also sought from a barrister specializing in intellectual property and copyright law. This advice was given without charge.

Court action did not commence. However, had an application been filed in the Federal Court, there would have been court filing fees, barrister fees and fees for any expert witnesses required to give evidence. Further, by commencing action an applicant would be exposed to a potential cost award. If an applicant is unsuccessful in establishing his or her claim, the court can order the applicant to pay the legal costs of the other party.

CUSTOMARY LAWS AND REGIMES

The Institute took the action with regard to strictly legal issues. It was not within the Institute's charter to interpret or administer Indigenous customary laws. The customary laws and regimes were not part of this action. The case proceeded with a view to asserting the legal rights as a relatively expedient and less complex means of attaining an appropriate remedy. This result was achieved quickly and without the need for court proceedings to be commenced. An amount of damages was also handed over. The Northern Land Council is now expected to play a role in identifying the relevant traditional custodians concerning what shall be done with the damages awarded and the unsold products.⁷¹

CONCLUDING COMMENTS

Rock art represents the origins of Indigenous culture and belief systems. Indigenous Australians have often complained about their rock art being photographed and reproduced by graphic designers and artists not entitled to depict imagery. They complain that these images are exploited commercially without their permission or without any royalties being returned to them. In many instances, the use has been derogatory and without attribution.

In a submission to the *Stopping the Ripoffs Inquiry*, the National Indigenous Arts Advocacy Association (NIAAA) reported a "wandjina"⁷² being used as a logo for a surfboard.⁷³ Such use without the permission of the relevant clan group as a whole was considered inappropriate as the image was sacred, being from a particular site which was only permissible to certain members of clan groups. The surfboard manufacturer, at the request of the Kimberley Aboriginal Law and Culture Centre, discontinued use of the "wandjina."

Rock art is perceived to be in the public domain under copyright laws because the author is often unknown and the antiquity of the art is such that the period of protection, if applicable to begin with, would have expired. Also, beliefs as to origins and authorship mean that authorship is unknown.⁷⁴ For these reasons, it is often copied and commercialized by persons and entities other than the Indigenous custodians themselves.

The unauthorized use of rock art is an area of Indigenous traditional cultural expressions that raises special issues in relation to copying and wider dissemination. In Australia, Indigenous peoples are using the legal system and other means to protect their rock art from wholesale and unauthorized copying.

The recording and photography of rock art by others may cause copyright to vest in a new medium, for instance, a photograph or film or an artistic work. There is a need for the interests of Indigenous custodians of rock art images to be taken into account. The findings in *Bulun Bulun v R & T Textiles* (see Case Study 3) in relation to fiduciary obligations owed by

copyright owners of works embodying pre-existing designs may be relevant. Is a fiduciary obligation owed by those who record these sites to protect the interests of the collective clan? If Brandl's Estate and the Institute did not take action, would the courts allow the traditional custodian to take action to compel the copyright owner to take action against the infringer?

Another aspect is whether there were equitable rights to the copyright in derived works based on rock art - or other pre-existing designs. This issue was explored in *Bulun Bulun v R & T Textiles* but not established.

Despite these arguments, these types of copyright arguments are not altogether satisfactory as the legal rights to cultural material vest outside the clan. However, in the current legal system, this examples serves to show how the intellectual property system was invoked to protect underlying cultural materials not protected by copyright. The copyright owners of the Brandl Works and the photographs were willing to take action to respect the rights of the Indigenous peoples. As Dr. M. Brandl puts it, it is "an accident of the law" that creates rights in the material form and not the underlying information. Dr. Brandl feels that it is a responsibility to guard the integrity of such important cultural heritage material from unwarranted and wholesale copying for commercial purposes.

Ms. Muir has recently established a new screenprinting business which produced t-shirts of Indigenous arts. Her t-shirts are sold at the local Cultural Centre and are expected to be nationally distributed.

Today, Indigenous people take a more active role in the recording and maintaining rock art sites. Ms. Muir herself was involved in the maintenance and recording of sites in the Kakadu National Park.⁷⁵ In other states, the recording of cultural sites is also done by Indigenous persons. Each state and territory's cultural heritage authorities now employ Indigenous fieldwork to record and protect Indigenous cultural places.

With respect to funding of research, the Institute now has a Research Ethics Committee to evaluate proposals by applicants for funding. The Institute's *Guidelines for Ethical Research in Indigenous Studies*⁷⁶ have been developed to promote the "respect for an Indigenous people's inherent right to self-determination, and their right to control and maintain their culture and heritage."⁷⁷ According to Russell Taylor, Principal of AIATSIS, a common practice now is for researchers not only to follow these guidelines but also to include them explicitly in an agreement with an Indigenous community in the form of a written contract.⁷⁸ In many cases, the copyright and dissemination of the material is included as a term of such agreements.

Endnotes

- 1 George Chaloupka, *Journey in Time - The World's Longest Continuing Art Tradition - The 50,000 Year Story of the Australian Aboriginal Rock Art of Arnhem Land*, Reed New Holland, JB Books Australia, 1993, p. 15.
- 2 Deceased in 1974.
- 3 He also received funding from other sources such as the Department of Welfare.
- 4 E. J. Brandl, *Australian Aboriginal Paintings in Western and Central Arnhem Land, Temporal Sequences and Elements of Style in Cadell and Deaf Adder Creek Art*, Aboriginal Studies Press, Canberra 1973.
- 5 This was never admitted to by the manufacturers of the t-shirts.
- 6 Meeting with Russell Taylor, June 14, 2000, Canberra.
- 7 Section 5, Australian Institute of Aboriginal and Torres Strait Islander Studies Act 1989.
- 8 Russell Taylor, "Rock-Markings Research and Indigenous Australia", Original Paper prepared for presentation at the Third International Congress of the Australian Rock Art Research Association, AIATSIS, Canberra, June 2000.
- 9 Kakadu National Park was proclaimed in 1979. Amendments to the National Parks and Wildlife Conservation Act 1975 (Cth) and the Aboriginal Land Rights (Northern Territory) Act 1976 (Cth).
- 10 Spelt Mimi or Mimih are thin spirit figures that live in the cracks of rocks. From the dreaming stories of the Kunwinjku people of Western Arnhem Land. They are not considered creator beings, they are more like tricksters, long and thin, they have powers that allow them to disappear inside the rock face, where they have their own unique land and live much like humans. They are said to have taught humans many of their cultural skills i.e. how to hunt, butcher and cook game, and how to paint.
- 11 E. J. Brandl, op. cit., p. 165 and p. 167.
- 12 Interview with Mandy Muir, 30 July 2000.
- 13 Interview with Dr. Maria Brandl, 10 October 2000.
- 14 Communication with George Chaloupka, March 2001.
- 15 Meetings with Mandy Muir, Nouralangie Rock, 30 July 2000.
- 16 Clause 29.5.3, Kakadu Park Plan of Management.
- 17 Clause 29.5.6, Kakadu Park Plan of Management.
- 18 See the Northern Land Council's website at <www.nlc.org.au>.
- 19 See Northern Territory Land Rights Act (Cth).
- 20 Interview with Mandy Muir, 30 July 2000.
- 21 E.J. Brandl received approximately 4 grants from AIATSIS from 1970 - 73.
- 22 Traklet Handwinch and steel cable.
- 23 Document 69/812, Acceptance of Grant document signed on condition of Institute Document 68/872.
- 24 Dr. M. Brandl, herself an anthropologist, accompanied E.J. Brandl on some of the fieldtrips to the Deaf Adder Region.
- 25 Clause III.14.
- 26 Clause III.15.2. If the Institute did not exercise this right it could not withhold permission for the report or study to be published elsewhere and was required to inform the author within six months of the submission of the manuscript of its intention to publish or otherwise.

- 27 A licence is the right to exercise an act comprised in the copyright.
- 28 Clause III.17.1. AIATSIS has authorized use of the Brandl figures and consulted with Dr. M. Brandl. Note that consultation with the Indigenous community was not required. Compare this with AIATSIS current Research Guidelines.
- 29 Clause III.18.1.
- 30 Question 14, Application for Research Grant Guidelines. In the application for research, applicants were asked to state the scientific significance of the project.
- 31 AIATSIS, Encyclopaedia of Aboriginal Australia. The image has been removed from the current edition.
- 32 Section 32(2) Copyright Act 1968 (Cth).
- 33 ISBN: 0 85575 029 4.
- 34 Section 33(6), Copyright Act 1968, applies to photographs taken after 1 May 1969 when the Act commenced.
- 35 *Re Graves* (1869) 39 LJ QB 31.
- 36 Interview with Dr. M. Brandl.
- 37 Australian Copyright Council, *op. cit.*, p. 17.
- 38 Terri Janke, "The Application of Copyright and other Intellectual Property Laws to Aboriginal and Torres Strait Islander Cultural and Intellectual Property", *Art, Antiquity and Law*, Vol. 2, Issue 1, March 1997, pp. 13 – 26.
- 39 Section 32(2), Copyright Act 1968 (Cth).
- 40 Section 35(5), Copyright Act 1968 (Cth).
- 41 Dr. Vivien Johnson's Report prepared in 1998.
- 42 George Chaloupka, "From Palaeoart to Casual Paintings - The Chronological Sequence of Arnhem Land Plateau Rock Art" NT Museum of Arts and Sciences, Darwin, Australian 1984.
- 43 Chapter III, p. 71 of the Brandl Book.
- 44 *MacMillian & Co Ltd v K & J Cooper* (1923) 93 LJPC 113; *Interlego AG v Croner Trading Pty Ltd* (1992) 25 IPR 65.
- 45 Dr Johnson's Report.
- 46 Section 92, Copyright Act 1968 (Cth): Copyright subsists in a published of a literary, dramatic, musical or artistic work, or of 2 or more literary, dramatic, musical or artistic works, where:
 (a) the first publication of the edition took place in Australia; or
 (b) the publisher of the edition was a qualified person at the date of the first publication of the edition.
- 47 Section 100, Copyright Act 1968 (Cth).
- 48 Section 96, Copyright Act 1968 (Cth).
- 49 Section 88, Copyright Act 1968 (Cth).
- 50 *Nationwide News v CAL*, the court quoted Copinger and Skone James on Copyright (13th ed, 1991) at 175.
- 51 Section 4(2)(d), Copyright Act 1968.
- 52 A letter dated 4 January 1999 from Dr. M. Brandl to the Institute.
- 53 Section 31, Copyright Act 1968 (Cth).
- 54 Section 115(2), Copyright Act 1968 (Cth).
- 55 Section 115(2), Copyright Act 1968 (Cth).

- 56 Section 115(2), Copyright Act 1968 (Cth).
- 57 Section 115(2), Copyright Act 1968(Cth).
- 58 Section 115(4), Copyright Act 1968(Cth).
- 59 Sections 132, 133 Copyright Act 1968 (Cth).
- 60 See AIATSIS Principles and Guidelines.
- 61 Australian Copyright Council, Artists & Copyright: A Practical Guide, Publication #68v&, July 1997, p. 17.
- 62 Section 36, Copyright Act 1968.
- 63 See Rights of Copyright Owner.
- 64 Section 52(1), Trade Practices Act 1974(Cth).
- 65 Section 53, Trade Practices Act 1974(Cth).
- 66 Without making admissions and without exposure to liability in the interests of settling a legal matter.
- 67 Deed of Settlement signed by the parties dated 11 August 2000.
- 68 25 August 2000. The apology was also reproduced on the AIATSIS website and the t-shirt manufacturer website.
- 69 Referred to in this paper as " Dr. Maria Brandl."
- 70 Dr. Kingsley Palmer worked on the case.
- 71 Meeting with Dr. Kingsley Palmer, 2001.
- 72 The Wandjinas are very important creation ancestors of the Kimberley Aboriginal people and these images on rocks are representations of them in places where they changed their physical form and became Spirits.
- 73 Terri Janke, National Indigenous Arts Advocacy Association Inc, Submission to the Stopping the Rip-Offs, February 1995, p. 5.
- 74 See also Michael Blakeney, " Protection of Traditional Knowledge under IP Law" , 2000 European Intellectual Property Reports pp. 251 at 254 – 255.
- 75 Interview with Mandy Muir, 30 July 2000.
- 76 The Guidelines were developed in May 2000. A copy of the Guidelines is reproduced and available for downloading at <<http://www.aiatsis.gov.au/corp/docs/EthichGuideA4.pdf>>.
- 77 Russell Taylor, *Ibid*, p. 12.
- 78 *Ibid*, p. 14

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INTRODUCTION

Since 1999, Desart has successfully been using a registered trade mark and copyright and trade mark licensing to help Aboriginal and Torres Strait Islander artists exploit their art. Desart uses the trade mark to promote the authenticity and quality of the artworks, and licensing agreements for the production and marketing of a range of merchandised products including t-shirts, coasters, postcards and boots. The licensing scheme has been successful in increasing financial returns to the artists, and is an example of how Indigenous groups are managing intellectual property rights to protect and promote their traditional art.

WHAT IS A TRADE MARK?

For more general information on trade marks and the trademark application process, please refer to Case Study 2 entitled "Use of Trade Marks to Protect Traditional Cultural Expressions."

BACKGROUND INFORMATION ON DESART AND ART CENTRES

Desart, based in Alice Springs, is an Association of the Central Australian Aboriginal Art and Craft Centres. Incorporated in 1992, Desart represents 37 art centres¹ and its Executive is elected from the membership and consists of an all-Aboriginal committee.²

Desart is funded by the Aboriginal and Torres Strait Islander Commission (ATSIC) through the National Arts and Crafts Industry Support Strategy.³

Desart operates two galleries, one in Alice Springs and another in Sydney. Desart also assists their artists in national and international exhibitions.

Role of Art Centres

Aboriginal art centres are instrumental in the production of Aboriginal art. A former Desart Chairperson, Inawinytji Williamson, expresses the role of the centres in cultural maintenance: "It's important to keep these centres strong. They provide us with a way of passing on our culture through our artwork."⁴

Some art centres are situated in urban areas but many are located in remote areas of Australia. The art centres, Aboriginal owned and governed, operate as non-profit organizations and are each generally staffed by an arts adviser. The focus of the art centres is to encourage the production of art by local Aboriginal artists and to assist them with the sale and promotion of their work. The art centres assist Aboriginal artists to promote, collect, document, exhibit and market their visual art and craft works.⁵ Additionally, the art centre provides assistance with cultural maintenance and ceremonial support.

In most communities, art centres provide the only source of self-generated income for Aboriginal people. They play an important role in the financial well-being of communities but also provide an important platform for cultural maintenance and education. Aboriginal law and culture are the foundation for all the arts and crafts produced and sold through art centres and the means whereby Aboriginal identity is further defined and celebrated.

Promotion of the Art Centres

The art centres facilitate the production of Aboriginal arts and cultural expression in various media including printmaking, lithography, etching, batik, paintings (bark and canvas), prints, jewelry, silk inserts for greeting cards, ceramic and carved animals. These items are protected under copyright law as “artistic works” or “works of artistic craftsmanship.”

The art centres also enter into arrangements with manufacturers for the production of mass produced items including t-shirts, coasters, sarongs, postcards, greeting cards, and fabric for clothing and stationery.

A Desart survey undertaken in 1996 found that one third of the art centres claimed to have one or more current licensing agreements with external bodies. The survey noted “the majority of these centres simply responded to approaches from manufacturers rather than being proactive.”⁶

Role of Desart

Desart provides a range of advocacy and referral services to its art centre members including assistance with contracts, access to a broad range of Aboriginal products, training, curatorial assistance and exhibition development advocacy. The members of Desart are the art centres and not the individual artists.⁷ These centres in turn support approximately 3,100 Aboriginal artists and craftspeople.

Desart is also an important reference point for government departments and agencies, art organizations, galleries and agents. It disseminates information about the Indigenous⁸ arts industry, thereby promoting the industry and facilitating its growth and development for the future.

TRADITIONAL CULTURE

In producing their art, the artists incorporate many aspects of their traditional culture. The production of art may also include the recording of traditional stories to explain the “public” stories behind the artworks. These stories may be recorded in writing or by photographs, video, film and sound recording.⁹

Significance of the Art to Indigenous People

As well as providing an important income source, Indigenous art is significant to the ongoing maintenance of Indigenous culture. As noted by Inawinytji Williamson:

“Art is part of our expression; it’s part of our values; it’s all our families’ history which is being passed on to our children. It’s our culture and it’s part of our lives, and not separate to it. The artwork made in our art centres is very different at the different art centres. But it all shows how people can adapt their stories and histories to suit new ways of working. The designs come from stories in the sand and from our grandmothers and grandfathers telling the stories to the young children. The pictures come from the Tjukurpa¹⁰ also. They tell about the old days and they teach people how to live today. The art tells young people today about what the older people know. It’s very important and tells them where their family comes from.”¹¹

Dissemination of Traditional Culture/Promotion of Innovation and Creation

Indigenous art has been, and continues to be, one of the most effective ways of promoting and increasing the understanding, acceptance and appreciation of Australia's Indigenous cultures. For most non-Indigenous people, art is the first, and in some cases the only, point of contact they have with Indigenous cultures. The making of arts is therefore an important means through which Indigenous people communicate their relationship with the land, their stories and their contemporary view of the world.

“In the Aboriginal culture of Central Australia there is artificial separation between art and life. While there is an economic imperative to the present day production of art and craft, each finished piece represents the integration of the cultural, spiritual and social elements of the artist's life. The richness and diversity of the Aboriginal art and craft industry in Central Australia also reflects the integration of unique skills and technology of an ancient culture and the immense artistic and creative adaptability of Aboriginal people.”¹²

Jon Altman, who undertook a *Review in the Aboriginal Arts and Craft Industry* in 1989 notes:

“The marketing of Aboriginal art has been a contentious issue, primarily because it has received a great deal of government financial support for the last three decades. As so often in Indigenous policy, this opened it up to relentless public, parliamentary and media scrutiny.”¹³

“There are pressures to view the market of Aboriginal art as a commercial activity, with some expectation that demand will influence supply and that art production will enhance Aboriginal economic well-being (and even independence from state benefits). On the other hand, there is an Indigenous viewpoint, often strongly expressed, that Aboriginal art embodies living heritage, and its cultural integrity must be protected at any cost.”¹⁴

AUTHENTICITY ISSUES

According to Ron Brien, Executive Director of Desart in 2000, there has been growing concern in the Indigenous art industry regarding the provenance and authenticity of Aboriginal art. Private galleries, museums and consumers have demonstrated demand for ways of ensuring that a particular work of art was produced:

- by an Aboriginal or Torres Strait Islander; and,
- by the artist stated to be the artist.

The Desart trade mark functions as a certification mark, certifying the provenance and authenticity of the art works to which it is applied. The Association is introducing standards of practice within its member art centres. For instance, with each artwork, Desart's centres record the story of the artwork, its history and creation, thereby authenticating the artwork. The art centres also provide a history of the artists and a photo of the artist.

THE DESART TRADE MARK

As already noted, for more general information on trademarks and the trade mark application process, see Case Study 2 “Use of Trade Marks to Protect Traditional Cultural Expressions”. This section provides information specifically on the Desart trade mark. The Desart trade mark was developed to enhance the marketing of artistic works and to develop their licensing potential. The Desart trade mark is registered with IP Australia’s Registrar of Trade Marks.¹⁵ The application was lodged on January 20, 1999. The trade mark is depicted below.



The Application

When registering a trade mark, an applicant must indicate the class of goods or services for which registration is sought. Furthermore, the applicant must nominate the specific goods and/or services within that class in connection with which the trade mark is to be used. Desart chose a number of classes for registration including class 26 for clothing, t-shirts, footwear and headgear.¹⁶ The mark was registered with the legal assistance of local lawyers in Alice Springs.

Examination

Once lodged, a trade mark application is examined by the Trade Marks Office of IP Australia, and if the application is successful, trade mark rights will be effective as at the lodgment date. After the examination process, if a trade mark is accepted, the trade mark must be advertised in the Official Journal of Trade Marks. The Desart application was examined from the date of lodgment until March 31, 2000 when it was approved for registration. Throughout the examination process, there were several amendments made to the application and the Trade Marks Office corresponded with Desart’s legal representatives. The trade mark was advertised as accepted on April 20, 2000.

Fees

The cost of registering the Desart trade mark was approximately A\$1,340. This did not include the costs of legal fees charged by Desart’s lawyers for processing the application and negotiating with IP Australia’s examiners.

Opposition

There was no opposition to Desart’s application, and therefore it became registered and effective, retrospectively, from January 20, 1999 in the listed range of classes of goods and services.

Benefits of Registering the Mark

A registered trade mark increases the marketing power of the products and also allows, particularly in this case, for the safeguarding of authenticity. According to Desart, since its registration the mark has been effective in advancing the reputation and status of Desart as a collective organization representing the rights of artists.¹⁷

TRADE MARK 783368

The Desert Trade Mark is registered in the following classes:

Class 16	Paper, cardboard, stationery materials, artists' materials
Class 21	Glassware, porcelain, earthenware, household and kitchen containers
Class 24	Textiles and textile goods, bed sheets and covers, tablecloths and covers
Class 25	Clothing, t-shirts, footwear, headgear
Class 27	Carpets, rugs, mats, matting, floor coverings, wall hangings.

Use and Enforcement

The trade mark has been used for a number of purposes, including on licensed merchandise such as key rings, necklaces, t-shirts and footwear. Desert and the art centres license rights under copyright license agreements.

In 2000, when Sydney hosted the Olympics, Desert estimated its turnover from licensing of art to be approximately A\$180 million per annum.¹⁸ In my opinion, licensing revenue has reduced in 2003 mainly because in 2000 there was a greater amount of Aboriginal art products being made to cater for the inbound tourism. Further reduction of the market has occurred as the Australian tourism market itself has declined in terms of world travel due to a worldwide downturn in international travel in 2003.

The art centres are currently funded by ATSIC but are continually under the threat of having their subsidies withdrawn.¹⁹ The Desert licensing system offers potential for art centres to generate funds independently of government subsidies.

The trade mark is also used on exhibition catalogues, books and other publications produced by and under the license of Desert and its member art centres. According to Desert, the use of the trade mark by the various art centres has had the effect of unifying the industry. It has resulted in the setting of standards of terms for licensing agreements thereby providing protection for Indigenous artists and restricting potential cases of exploitation and infringement of artist's copyright.²⁰

ART CENTRE TRADE MARKS

Many of the Desert Art centres use trade marks for their individual art centres. For instance, Walkatjara Art Uluru, Keringke Arts and Papunya Tula use trade marks on its letterhead, invoices and tagging. Walkatjara Art Uluru is in the process of registering its mark. Keringke Arts is already a registered trade mark, while Papunya Tula is an unregistered mark.

Common Law Trade marks used alongside the Registered Desert Mark

The art centres have their own common law trade marks that they use alongside the Desert logo. According to Ron Brien, this in a sense strengthens the overall power of the trade mark.

Many art centres use common law trade marks. For example, Papunya Tula has the distinctive honey ant mark that it uses and attaches to all its products for licensing. The Desert mark is used alongside the local art centre trade marks. This is seen as being cost-effective and adding to the solidarity of Indigenous organizations such as Desert.²¹

COPYRIGHT

As mentioned above, the art centres produce a range of arts and cultural expressions. Many of these works meet the requirements of the Copyright Act (1968) and are protected by copyright notwithstanding they are 'traditional'. Copyright protects "artistic works" including:

- paintings, sculpture, drawing, engraving or photographs;
- a building or model of a building;
- a work of artistic craftsmanship.²²

Under the Copyright Act, a copyright owner has the exclusive right to use and reproduce his or her copyright works and to authorize others to use and reproduce them.

Copyright will subsist in an artistic work that is original and in material form. Copyright in an artistic work is separate from ownership of the physical painting itself (so, while I may buy a painting, I do not necessarily buy the copyright in it). The artist can sell, license and deal with the copyright in the artistic work in an effort to reap commercial return. Assignments of copyright must be in writing. An unlimited assignment of copyright gives the buyer the full copyright in the artistic work. This is the right to reproduce and authorize others to reproduce the artistic work for the copyright period (50 years after the death of the artist), all over the world and in all media.

Desart does not recommend that its artist members sell or assign copyright. This is because once copyright is assigned, the artist relinquishes all copyright and cannot exercise rights to control reproduction and dissemination of the artistic work. The assignment of copyright is not recommended where the artistic work relates to cultural or sacred material, particularly that which is communally owned.

The artworks often embody traditional designs and symbols of belonging. Styles are developed including Utopia and Papunya Tula. Art centres have a practice of photographing works prior to sale for the purposes of record keeping.

LICENSING AGREEMENTS

Desart has been active in licensing the rights to its trade mark together with rights to the artistic works from its member's art centres for merchandising and commercial manufacturing. This involves both copyright and trade mark licensing agreements. Licensing agreements can be used to grant rights in territory, defined period (term) and medium. Sometimes upfront fees are incorporated with royalty payments.

A licensing agreement is made when the copyright owner enters into a written contract with a manufacturer to allow the reproduction by the manufacturer of an image or number of images on or part of the manufactured product.

An artist can license the copyright in an artistic work to others to reproduce, sell, distribute and import his or her artistic work. Rights can be split into categories of:

- purpose e.g.: limited to media,
- time e.g.: limit of years,
- territory e.g.: limited only to Australia.

Artists can seek to negotiate the rights for such use taking into account fees, royalties, moral rights and attribution issues.

Some general terms that can be included in agreements are:

Payment/Fee

Royalties paid to artists are negotiated either in installments, up front or completion, or on delivery of the artistic work.

Copyright

The Indigenous artist should retain copyright and the nature of the licensed rights should be limited to those needed to produce the merchandise.

Time: The license is granted for a specific time period. For instance, an artist can grant another person the rights to reproduce her or his artistic works on t-shirts for three years. After the end of three years, the licensed rights cease.

Other important considerations for terms in an agreement are:

Alteration

An artist has the moral right of integrity by virtue of the Copyright Act (1968 as amended in 2000). This means that the artist has the right to not have his or her work subject to derogatory treatment.²³ "Derogatory treatment" refers to anything that results in the material distortion of, mutilation of, or material alteration" to the work.²⁴ A license agreement may include provisions that there is to be no alteration to the artwork without the prior consent of the artist. The alteration clause is especially important for Indigenous artists where cultural integrity issues are a foremost concern.

Attribution

An artist has the moral right of attribution also under the Copyright Act.²⁵ Attribution must be given clearly and reasonably prominent.²⁶ Attribution (or credit) clauses are also included to ensure that the artist's name, clan group and any information is included alongside each reproduction of the artist' work.

The effectiveness of licensing agreements to protect Indigenous cultural expression rests with the Indigenous artist's ability to negotiate their rights under contract. Contract law assumes that the two parties are on a level playing field in that they are both well informed and have equal bargaining capacity. For Indigenous people, there is limited access to legal advice and the reality is that there is an imbalance of power. The Arts Law Centre of Australia gives advice to many of the art centres regarding contracts for licensing²⁷and has some standard contracts that are available for sale.²⁸ In 2003, the Centre received funding to employ an Indigenous legal officer to develop and provide specialist advice to Indigenous artists and art centres.

E-COMMERCE

Desart is planning to establish a website that will explore e-commerce opportunities. Desart is currently sponsored by the Commonwealth Government's Department of Communications, Information Technology and the Arts (DOCITA), to develop a design for e-commerce facilities. Currently in its research and development phase, the e-commerce side of Desart's business is expected to be operational in the near future.²⁹ See the Desart's Website at www.desart.com.au.

DESART QUALITY ASSURANCE MARK

In 2000, Desart proposed to establish a Northern Territory (NT) Quality Assurance Label, which aimed to:

- develop a set of best practice standards in relation to the production and sale of Indigenous art and design; and,
- promote a brand to assist consumers to identify products and assist in the marketing of authentically produced NT Indigenous art.

It was noted in the preliminary documentation that for the label to be successful, there would be a need for extensive education and marketing campaigns. There are five stakeholder groups involved, namely, the artists, art centres, art galleries, consumers and the NT economy.

By introducing the Quality Assurance Mark, Desart hoped to develop a strong NT Indigenous arts brand. The Quality Assurance Mark was to be used by registered users who met standard eligible criteria. A Report commissioned by Desart into the establishment of the NT Quality Assurance Label recommended that the brand should complement the art centre's own brands and the NIAAA label.³⁰ On the NIAAA label, see Case Study 8 'Indigenous Arts Certification Mark'.

The proposed model applied to art centres and galleries, both Aboriginal and non-Aboriginal-owned. The rules of the use of the NT Quality Assurance Mark label would be set by the governing body with national representatives.

The Report identified the need for improving business practices to assist consumers in their purchase of authentic Indigenous art. According to the Report, there had been increased concern over the level of "carpet-bagging" in the Indigenous arts industry. "Carpet-bagging" refers to individual entities that deal with Indigenous art who exploit artists by selling at high profit margins with disregard for the rights of the artists and consumers. Heightened concerns over this issue had risen in light of various media reports. Gallery owners and consumers were calling for documented proof of equitable treatment before they buy.

The Report recommended that the NT Quality Assurance Mark be a registered trade mark incorporating a simple design with prominent branding. The rules for using the mark would include adherence to best practice standards that will be developed by the governing body. Such rules of use, like the NIAAA label, would aim to ensure that the art was identified as Aboriginal art, that is, it had been produced by an Aboriginal person. However, the NT Quality Assurance Mark would go further by introducing standards such as:

- the use of standard contracts for consignment, licensing, commission and purchasing;
- translation of key information into Aboriginal languages;
- adoption of record keeping practices for identifying works. For example, for works over A\$250, all users of the NT Quality Assurance Mark must include information on author, title, date of completion, catalogue number, dimension, medium and photograph.

The NT Quality Assurance Mark has not been established due to a shift in the focus of Desart in 2002. Desart has refocused the non-profit organization to concentrate on its role as an advocate for the needs of art centres and the Aboriginal Arts industry as a whole.³¹

TRADE PRACTICES ISSUES

There is no doubt that such certification marks are of great value in the Aboriginal arts market. The Aboriginal arts market contains many rip-off and pastiche items that imitate Aboriginal designs, and are not made by Aboriginal artists. Many of these works are labeled “authentic” or “Aboriginal products” when they are not.

Under the Trade Practices Act (1974), there are remedies for misleading and deceptive conduct.³² In the Carpets Case³³ (see Case Study 1), Justice Von Doussa found that labeling attached to carpets incorrectly stated that the carpets were produced with the permission of the artists and that royalties were being paid to them. This labeling was also attached to other carpets that had no Indigenous Australian association at all. By using such labeling, the carpet distributors were misleading consumers into believing that copyright in the artworks belonged to the company, or was licensed to it, or that the carpets were approved or made under the license and approval of the Aboriginal artists. In Von Doussa’s judgment, such false and misleading conduct amounted to an infringement of sections 52 and 53 of the Trade Practices Act (1974).

The Australian Competition and Consumer Commission (ACCC) is taking legal action against Australian Icon Products Pty Ltd. (“Australia Icon”), a Queensland-based souvenir manufacturer under section 52 of the Trade Practices Act (1974). Under this section, it is illegal for corporations to engage in conduct, in the course of trade or commerce, that is “misleading and deceptive or which is likely to mislead or deceive.”

Australian Icon makes a range of hand painted and carved products including didgeridoos, boomerangs and plates bearing “Aboriginal” designs. Some of these designs are made by Aboriginal people and whilst others are not.

The ACCC was granted interim orders on April 4, 2003 to prevent Australian Icon from describing a product as “Aboriginal art” or “authentic” if it was not created by a person of Aboriginal descent. The case is going to trial and the ACCC is seeking to require Australian Icon to implement a trade practices compliance program.³⁴

CONCLUDING COMMENTS

Desart, as a collective organization representing its art centre members, has been successful in introducing standards of practice concerning the management of intellectual property rights of Indigenous artists. The Desart trade mark is fast becoming one of the most prominent trade marks to be used by a wholly Indigenous run organization in the production, marketing, licensing and merchandising of Indigenous cultural products. It is an example of how Indigenous groups are also exploring ways of managing intellectual property rights to protect and promote traditional cultural expressions. The trade mark also allows the art centres to control the marketing of Aboriginal art and the intellectual property rights in art.

The Desart model is a commercial model for managing copyright interests of Indigenous artists. The model relies on effective management. To set up such a system, there is a need for legal, marketing and industry knowledge. Desart has been successful in pooling these to use the intellectual property system, particularly copyright and trade marks, to the benefit of Indigenous artists.

Current Situation

In 2003, Desart continues to represent Aboriginal artists and art centres. Its focus, however, is more on the advocacy role rather than that of licensing and business development.

As a result of the closure of Desart Aboriginal Enterprises Pty Ltd., Desart has stepped back from being directly involved in much of the licensing/product development on behalf of art centres. Desart now recognizes that the art centres are independently-operated small businesses that are capable of developing their own products.

Currently, many of the art centres' licensing agreements are up for renewal. This has prompted the art centres to analyze how effective the licensing arrangements have been in terms of, for example, royalties returned and recording of sales. One licensee who manufactures onshore has had relative success and continues to license artistic works from the Desart artists. There has also been other licensees that have not done so well. Some have indicated their wish to cease their licensing agreements. Another is in financial difficulties, owing royalties on its licensing agreements. This is mainly due to economic factors i.e. a drop in tourist numbers as well as competition from offshore manufacturing. Another factor is that licensees have recognized a need to redesign the product in order to keep it fresh in the market place.

Some art centres have changed focus to such an extent that they wish to focus on the fine arts market and no longer pursue licensing arrangements.

The high turnover at some art centres such as Walkatjara Arts Uluru Pty Ltd. has meant that they are ready to redesign and enter into new licensing agreements. Walkatjara Arts Uluru Pty Ltd. is looking into self-manufacturing and setting up an internal licensing agreement with their artists.

In the near future, Desart plans to reassess the use of the trade mark with its membership to ascertain whether to continue to develop other products under the Desart trade mark and whether Desart needs to seek out new categories to protect the new products.

Rose Wallis, current Desart CEO states:

“Three years on and the marketplace has welcomed the Desart trade mark and has supported it to varying levels. The high profile tourist outlet has maintained the product and continues to re-order from the manufacturers. The smaller operator, however, has been affected by the drop in tourist figures and is no longer stocking the product.”³⁵

Rose Wallis says that the Desart trade mark model can be recommended to other organizations provided that:

- there is a secure financial base of the organization;
- there is a realistic and flexible market analysis, i.e. broader than tourism market;
- there is conservative product development;
- there are reputable licensing agents and manufacturers; and
- there is long-term stability in the corporations involved in the advocacy/manufacturer/producer process.³⁶

Endnotes

- 1 Meeting with Ron Brien, Desart, August 2000.
- 2 Desart's Executive Committee consists of 5 Aboriginal artists members.
- 3 ATISC funds Desart for some of the arts adviser positions.
- 4 Inawinytji Williams in Nugent, *op cit*, page vii.
- 5 Aboriginal and Torres Strait Islander Commission, Indigenous Visual Arts and Crafts Resources Directory, ATISC, Canberra, 1998.
- 6 Felicity Wright, *Op Cit*, page 127.
- 7 Felicity Wright, The Art and Craft Centre Study, Volume 1 Report: A survey of thirty-nine Aboriginal community art and craft centres in remote Australia, undertaken by Desart Inc, 1999, published by ATISC, Canberra 1999, page 4.
- 8 Referring in this context to "Aboriginal and Torres Strait Islander."
- 9 Mary-Lou Nugent, *Desert Art*, *op cit*, page xii.
- 10 Central Desert Aboriginal word referring to "Dreaming" or "Dreamtime" as it is translated into English. Tjukurpa defines traditional Aboriginal law and religion and encompasses the land and its creation and all that exists.
- 11 Inawinytji Williamson, Director of Desart in 1997 in Mary-Lou Nugent, *Desert Art: The Desert Directory of Central Australian Aboriginal Art and Craft Centres*, Jukurrpa Books, Alice Springs, 1998, page vii.
- 12 Patricia D'Aranjo, Desart Inc, *Aboriginal art and craft centres of Central Australia*. Desart 1993.
- 13 John Altman, "Marketing Aboriginal Art" in S. Kleinert and Margot Neale, "The Oxford Companion to Aboriginal Art and Culture" Oxford University Press, Australia 2000, page 462.
- 14 ***ibid.***
- 15 For information on IP Australia, see their Website at <www.ipaustralia.gov.au>.
- 16 See Appendix 1 for full list.
- 17 Meeting with Ron Brien, then Executive Officer of Desart, Alice Springs, 1 September 2000.
- 18 Interview with Rob Brien, August 2000.
- 19 Felicity Wright, *Op Cit*, page 6.
- 20 Interview with Rob Brien, Desart, August 2000.
- 21 Interview with Rose Wallis, then Manager of Walkatjara Arts, July 2000.
- 22 "Work of artistic craftsmanship: is a legal term included in Section 10. Copyright Act 1968 (Cth).
- 23 Section 195AQ(2) Copyright Act 1968 (Cth).
- 24 Section 195AK, Copyright Act 1968 (Cth).
- 25 Section 189, Copyright Act 1968 (Cth).
- 26 Section 195AA, Copyright Act 1968 (Cth).
- 27 Interview Delia Browne, Executive Director, Arts Law Centre of Australia, June 2000.
- 28 The Arts Law Centre of Australia has a Website which publishes useful information sheets on copyright and the arts. See <www.artslaw.com.au>.
- 29 Interview, Neville King, IT Consultant to Desart, August 2000.

- ³⁰ Page 2, Report commissioned by the Desart Inc into the establishment of the NT Quality Assurance Label, Draft Report as at 25 August 2000, Prepared by Anderson Muller Consulting, South Australia.
- ³¹ Email correspondence from Rose Wallis, Executive Officer, Desart, dated 6 May 2003.
- ³² Section 52 Trade Practices Act 1974 (Cth).
- ³³ *Milpurrurru v Indofurn* (1995) 30 IPR 209. See Case Study 1 “The Carpets Case: M*, Payunka, Marika & Others v Indofurn”.
- ³⁴ Simon Etherington, “Aboriginal Style Art” in *Indigenous Law Bulletin*, April – May 2003, Vol. 5, Issue 24, page 18.
- ³⁵ Email correspondence from Rose Wallis, Executive Officer, Desart, dated 6 May 2003.
- ³⁶ Email correspondence from Rose Wallis, Executive Officer, Desart, dated 6 May 2003.

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Note : This Case Study was originally researched and written in 2000 and updated in 2003.

INTRODUCTION

The National Indigenous Arts Advocacy Association (NIAAA), a representative body for Indigenous artists, developed an Australian Indigenous arts certification system in the 1990s.

The system, which comprised two certification marks registered as trade marks and a notice for use by authorized retailers, was developed in response to the many imitation products that were flooding the Indigenous arts market and was designed to assist consumers to identify authentically produced Indigenous art and cultural products. The rationale was that consumers, in the interests of buying authentic products, would purchase goods and services bearing the certification mark in preference to others, providing benefits for Indigenous artists in the form of increased sales that would in turn encourage further production.

In 2000, two certification marks registered under the Trade Marks Act of 1995 were launched for use in connection with authentic Indigenous art products:

- the Label of Authenticity – for primary works made by Indigenous persons; and,
- the Collaboration Mark – for collaborative and manufactured products produced under license with Indigenous persons.¹

A third facet of the labeling system was a “ Notice for Use by Indigenous Arts Retailers ” , which incorporated two regular trade marks.

Approximately 160 artists have used the mark since its launch. However, the Label of Authenticity has failed to gain wide support at the primary production level, particularly among Aboriginal Arts and Craft Centres that are the major producers of Aboriginal art in the regions. The majority of persons sought permission from NIAAA to use the Collaboration Mark.

The future of the mark is now in doubt as NIAAA closed their offices in 2002, due to cessation of its funding.

This case study focuses on the rationale for the national Indigenous labeling system and the process of developing and registering the certification marks. It will also report on the use of the label and issues relating to the implementation of the labeling system.

The National Indigenous Arts Advocacy Association (NIAAA) was a non-profit organization dedicated to protecting Indigenous peoples’ rights, culture, cultural respect, protocols and values through the promotion and protection of Aboriginal and Torres Strait Islander arts and crafts.² Established in 1990, NIAAA has conducted cases including the Carpets Case, *M* v Indofurn Pty Ltd.*, for the advancement of Indigenous artists’ rights. In December 2002, the offices of NIAAA closed and the future of the organization remains uncertain.

BACKGROUND

A National Aboriginal and Torres Strait Islander Cultural Industry Strategy, undertaken by the Aboriginal and Torres Strait Islander Commission (ATSIC) in 1997, estimated the Indigenous arts industry to be worth almost A\$200 million per year.³ However, despite the lucrativeness of Indigenous art, Indigenous people are often not the ones to benefit and the percentage of returns to Indigenous people remains marginal. In 1989, the *Review of the Arts and Crafts Industry* estimated that Indigenous people received just over seven million dollars per year

from the sale of art and crafts.⁴ In 1997, the *Strategy* noted that the economic benefits to Indigenous artists had improved to approximately fifty million dollars per year, with the major portion of the benefits going to art traders rather than to the artists.⁵

Practices in the Indigenous Arts Industry

The growing consumer demand for Indigenous art has given rise to many unscrupulous and questionable practices within the Indigenous arts industry including:

Copyright Infringements

Indigenous artistic works have been copied without the permission of the artist or clan group⁶, for example, copying of traditional rock art from textbooks (See Case Study 6 “Unauthorized Reproduction of Indigenous Rock Art”). During the past five years, Indigenous artists have been successful in taking action for copyright infringement in the courts.⁷ These cases have raised awareness in the industry and reduced copyright infringements significantly.

Stylized designs of Indigenous art by non-Indigenous artists

Non-Indigenous artists have copied Indigenous styles and passed their work off as “Indigenous”.⁸ Many of these works have been labeled “authentic” or “genuine Indigenous products.” NIAAA estimated these types of stylized or pastiche designs deprived Indigenous artists of at least one hundred million dollars per year.⁹

Fakes

There have been several reports of artworks being sold by art dealers that were not painted by Indigenous artists as claimed.¹⁰

Misleading labeling

The presence of products marketed and labeled as “authentic” to indicate that the products were of Indigenous origin or had obtained the approval of Indigenous peoples is another growing concern. Some common misleading labels include “Authentic Aboriginal”, “Designed by Aboriginals” and “Royalties paid to Aboriginal artists and communities.” According to NIAAA’s investigations, many of these labels were false and misled consumers.¹¹

Unfair contracts

Indigenous artists often enter into contractual arrangements without legal advice and without a proper understanding of the terms and conditions¹² resulting in complaints of unfair terms within the licensing contracts. As a result, some Indigenous artists have entered into licensing contracts with oppressive terms and low royalties.

Use of Indigenous styles by other Indigenous artists

Another problem has been the appropriation of Indigenous art styles, stories and themes by Indigenous artists not associated with the particular style or dreaming stories they have depicted in their artwork.¹³ For example, Indigenous artists from Southern states painting *rarrk* or crosshatch styles, originating from Arnhem Land, Northern Australia, and an eastern Indigenous artists painting *wandjinas*¹⁴, creation beings that originate traditionally from the north west of Australia.

Main Objectives of an Authentication System

Since the early 1980s, Indigenous artists called for the establishment of an authentication labeling system for Indigenous arts and cultural products. NIAAA commenced consultations and research on a suitable model for a label of authenticity in 1993 and its representatives met with Indigenous artists and organizations, arts bodies and government departments. From the consultations, NIAAA derived the following main objectives for a national Indigenous Authenticity Label:

- to maintain the cultural integrity of Aboriginal and Torres Strait Islander art;
- to ensure a fair and equitable return to Aboriginal and Torres Strait Islander communities and artists for their cultural products;
- to maximize certainty for consumers as to the authenticity of Aboriginal and Torres Strait Islander-derived works, products, services;
- to maximize the multiplicity and diversity of Aboriginal and Torres Strait Islander art;
- to promote an understanding both nationally and internationally of Aboriginal and Torres Strait Islander cultural heritage and art.¹⁵

What is Authenticity?

Issues of authenticity are a major concern also for consumers interested in purchasing authentic products of Aboriginal art.¹⁶ The definition of “authentic” art differs according to various perspectives - consumer perceptions, retailers, manufacturers and producers. The research phase for the Label sought to ascertain the notion of authenticity from the point of view of the Indigenous producers. The following definition was born out of the consultation phase:

“[It is] a declaration by Indigenous Australian artists of identity with, belonging to, knowledge about, respect for and responsibility towards the works of art they create. Identity is about upbringing, beliefs, stories, cultural ways of living and thinking, and knowing what it is to be Aboriginal or Torres Strait Islander. Belonging means to be either connected with stories about country or connected with the experiences of history in being Indigenous in Australia. Knowledge is about the familiarity gained from actual experience and also having a clear and certain individual perception of expression. Respect and responsibility is about having regard for and looking after culture. It is about acting in a way which is sensitive to others and which does not exploit other peoples’ identity, knowledge and belonging.”¹⁷

The development of NIAAA’s labeling model was based on this definition of authenticity.

What type of Trade Mark?

There were several options for establishing a National Indigenous Authentication Mark, namely:

- an unregistered trade mark;
- a registered trade mark;
- a collective trade mark¹⁸;
- a certification mark;
- a mark protected under legislation such as that introduced to protect the Olympic rings and other Olympic insignia for the Sydney Olympic Games.¹⁹

The option of a certification mark was chosen as it went beyond identifying the source of the goods and services, being the function of regular trade marks. It allowed for the denotation of the quality and characteristics of the goods and services.

Funding for Implementation of the Authenticity Label Project

As a result of the research and planning phase, a business plan was developed. ATSIC, which provided the majority of funds for the Authenticity Label Project²⁰, provided funding through its National Arts and Crafts Industry Support Strategy for the development and implementation of the labels of authenticity. The Australia Council for the Arts provided funds for operational costs as well as the costs associated with the employment of a Project Manager for the Labeling system²¹ (as noted already, this funding has since ceased).

CERTIFICATION MARKS

A certification mark can be used prior to registration. At that stage, protection of the mark is based on copyright and passing off, rather than infringement of a registered trade mark.²² However, it is a better protection measure for certification marks to be registered because the registered owner can rely on registration as proof of rights.

Classes of Goods and Services

As with regular trade marks, it is necessary to indicate the class of goods or services for which registration is sought for the certification mark. That is, the specific goods or services within that class in connection with which the trade mark is intended to be used. The Label of Authenticity Mark and the Collaboration Mark were registered in a wide range of arts and cultural products covered by the labeling system (see boxes).

THE LABEL OF AUTHENTICITY CERTIFICATION MARK 772564

Class 2	Dyes for clothing, paints and paint boxes.
Class 4	Candles.
Class 8	Hand tools and implements including artists tools such as chisels.
Class 9	Recordings (whether on compact disc, video tape, software or any other medium) which feature Aboriginal art or craft works.
Class 14	Jewelry, precious stones and objects made of precious stones, watches and clocks, other works of art made of or with precious metals in this class, ornaments in this class.
Class 15	Musical instruments including indigenous instruments.
Class 16	Paper, cardboard and goods made from these material, printed matter, photographs, stationery, artists materials, paint brushes, instructional and teaching material, works of art or craft made of or on paper, lithographic works of art.
Class 18	Leather goods, art or craft works made on or with animal skins or hides, walking sticks, whips harness and saddlery.
Class 20	Furniture, mirrors, picture frames, works of art or craft made of or with wood including bark paintings, spears, shields, woomera and indigenous weapons, works of art or craft made of or on reed, bone, shell, mother of pearl and substitutes for these materials, wax plaster or plastic.
Class 21	Household or kitchen utensils and containers, combs and brushes (except paint brushes) brassware, porcelain and earthenware including works of art or craft made of or on porcelain, terra-cotta or glass.
Class 22	Works of art or craft made of or with ropes, string and other fibrous textile materials, fishing nets and baskets within this class.
Class 24	Textiles and textile goods, works of art or craft made on or with textiles.
Class 25	Clothing, footwear and headgear.
Class 27	Carpets, rugs, mats and matting, wall hangings.

**THE COLLABORATION MARK TRADE MARK
CERTIFICATION MARK 772566**

Class 2	Dyes for clothing, paints and paint boxes.
Class 4	Candles.
Class 8	Hand tools and implements including artists tools such as chisels.
Class 9	Recordings (whether on compact disc, video tape, software or any other medium) which feature Aboriginal art or craft works.
Class 14	Jewelry, precious stones and objects made of precious stones, watches and clocks, other works of art made of or with precious metals in this class, ornaments in this class.
Class 15	Musical instruments including indigenous instruments.
Class 16	Paper, cardboard and goods made from these material, printed matter, photographs, stationery, artists materials, paint brushes, instructional and teaching material, works of art or craft made of or on paper, lithographic works of art.
Class 18	Leather goods, art or craft works made on or with animal skins or hides, walking sticks, whips harness and saddlery.
Class 20	Furniture, mirrors, picture frames, works of art or craft made of or with wood including bark paintings, spears, shields, woomera and indigenous weapons, works of art or craft made of or on reed, bone, shell, mother of pearl and substitutes for these materials, wax plaster or plastic.
Class 21	Household or kitchen utensils and containers, combs and brushes (except paint brushes) brassware, porcelain and earthenware including works of art or craft made of or on porcelain, terra-cotta or glass.
Class 22	Works of art or craft made of or with ropes, string and other fibrous textile materials, fishing nets and baskets within this class.
Class 24	Textiles and textile goods, works of art or craft made on or with textiles.
Class 25	Clothing, footwear and headgear.
Class 27	Carpets, rugs, mats and matting, wall hangings.
Class 41	Educational and training services relating to Indigenous arts and crafts; entertainment, cultural activities or events relating to Indigenous arts or crafts.

The Design of the Trade Mark

The graphic for the Label of Authenticity was designed by an Indigenous artist, Peter Yandana McKenzie. It is a design of a boomerang in the colors of the Aboriginal flag²³ in a black triangle with a black border for the Label of Authenticity and a white border for the Collaboration Mark (see design below). The design has been criticized by Torres Strait Islanders as not being inclusive of Torres Strait Island communities.²⁴ The Torres Strait Islander people have their own flag in the colors blue, green, white and black.²⁵ In 2000, NIAAA indicated that they planned to develop a separate label for Torres Strait Islander artists which was to incorporate the design of the Torres Strait Islanders' flag.²⁶



Application

After consultations and design of the marks, they had to be registered with the government agency, IP Australia. A law firm, who acted for NIAAA on a pro-bono basis, undertook the legal work of drafting the rules that would govern use of the marks and overseeing the applications.

The applications for the marks were officially lodged for examination on September 8, 1998.²⁷ The Label of Authenticity was approved and officially registered in March 2000, taking almost twenty months for registration to be finalized. The Collaboration Mark passed the authorization stage undertaken by the Australian Consumer and Competition Commission (ACCC) in July 2002 and was approved by the Registrar of Trade Marks on August 1, 2003. According to NIAAA's lawyers, the delay was due to the heavy scrutiny of the mark by the ACCC in the authorization stage.²⁸ The delay for the Collaboration Mark registration may also have been due to the cessation of funding to NIAAA.

Examination

At the examination phase, the Trade Marks Office considered that there were grounds that might preclude the application from being registered. The most significant ground was that the NIAAA trade mark was considered to be substantially identical with, or deceptively similar to, that of Nike®. An adverse report was given to NIAAA asking them to clarify the situation.

Whilst the Registrar of Trade Marks accepted the Label of Authenticity for registration, it did so with an endorsement (limitation)²⁹ on use of the mark which limited use to "the colors black, red and yellow with a black border surrounding the triangular device, which border is in turn surrounded by a black border."³⁰

Opposition

Neither the Label of Authenticity or the Collaboration Mark received notices of opposition.

The Rules

An applicant for a certification trade mark must also file a copy of the Rules governing the use of the certification trade mark.³¹ The Rules set out the application process and the process by which a person will be allowed to use the certification trade mark (see Appendix).

Rights given by Registration

Once a certification trade mark is registered, the registered owner of the trade mark has the exclusive rights:

- to use the trade mark; and,
- to authorize others persons to use the trade mark, in relation to the goods and/or services in respect of which the trade mark is registered. The registered owner must, however, only use the certification trade mark in accordance with the rules governing its use.³⁷

When the registered owner allows another person (the approved user) to use the certification trade mark in relation to goods and services in respect of which it is registered, the approved user has the right to use the certification mark in accordance with the rules.³⁸

AUSTRALIAN COMPETITION AND CONSUMER COMMISSION (ACCC)

The Trade Marks Act of 1995 contains provisions for the Australian Competition and Consumer Commission (ACCC) to be involved in the approval process of certification marks.

Once the application for registration is filed, and the Registrar is satisfied that there are no grounds for rejecting it, the documents are sent to the ACCC. The ACCC considers the application and inspects the rules governing the use of the certification mark. The rules must set out the objective criteria for the certification process and provisions for dispute resolution in the event of refusal.

As part of the process, the ACCC consults within the industry regarding competition and whether the mark is likely to affect competition in the market. The ACCC assesses the rules and the management structure to ensure the mark is not anti-competitive. The ACCC, among other things, considers the following:

- whether the applicant (or any approved certifier) is competent to certify goods or services in respect of which the certification mark is to be registered.³²
- whether the rules governing the use of a certification mark are “detrimental to the public”, and otherwise satisfactory.³³

The ACCC can require or permit certain provisions to be included in the rules governing the use of a certification trade mark.³⁴ The ACCC must adopt a prescribed process.³⁵ The procedure is set out in four steps:

- initial assessment of the application;
- advertising of the initial assessment;
- holding of conferences if required;
- making a final decision on the application.

If the ACCC is satisfied that the applicant is competent to certify the goods and services and that there would not be any detriment to the public, the ACCC must give a certificate to that effect.³⁶ If the ACCC gives such a certificate, the Registrar of Trade Marks must accept the application or otherwise reject it.

In the case of the Label of Authenticity, the ACCC consulted with a range of industry bodies and government departments. According to NIAAA, the ACCC approval was the most complex part of the process. The ACCC approved the rules for the Label of Authenticity in 2000 and recently approval was given to the Collaboration Mark, as already mentioned.

Remedies

The registered owner of a trade mark who successfully establishes infringement has certain remedies. NIAAA, as the owner of the label, may also bring an action under the tort (delict) of passing-off and under the Trade Practices Act where the label has been copied, or otherwise used without authorization.

THE NATIONAL LABELLING SYSTEM

The national labeling system comprises of:

- Label of Authenticity – a registered Certification Mark;
- Collaboration Mark – a registered Certification Mark;
- Indigenous Arts Retail License – two registered service trade marks.

Label of Authenticity

The Label of Authenticity denotes that a product or service is derived from a work of art created by an Aboriginal or Torres Strait Islander person or people, and has also been reproduced, or produced and manufactured, by Aboriginal or Torres Strait Islander people.

Indigenous artists wanting to sell and market their goods and services can apply to NIAAA for permission to use the Label of Authenticity. Applicants must apply on the prescribed form.

Applicant must be Indigenous

An applicant must declare that he or she is an Aboriginal or Torres Strait Islander person.

As part of the application process, an applicant is required to obtain two signed forms from an Aboriginal Corporation (passed at a meeting) certifying that the applicant is an Indigenous person. NIAAA has adopted the three-pronged approach used by ATSIC and the Australian Government as follows:

- the applicant must be of Aboriginal or Torres Strait Islander descent;
- the applicant must identify as an Aboriginal or Torres Strait Islander; and,
- the applicant must be accepted as such in the Indigenous community in which the applicant lives or comes from, or with which the applicant identifies.³⁹

Once approved by NIAAA, or its Certified Approval Bodies, an approved Indigenous creator can purchase the labels and affix them to his or her art and cultural products.

Costs of Applying

The cost of applying is A\$30, which gives the Indigenous creator a year's license to use the Label of Authenticity on his or her cultural products. After this time, the creator must renew the license by paying a further A\$30 per year.

Rules for Use

Once approved, an applicant must comply with the rules for use of the label. The rules have incorporated terms for complying with Indigenous customary law. In particular, Rule 4.1 states that the Label can only be used for works which purport to encode, depict or reflect ceremony, legal knowledge, customs, stories, dreaming or ritual of traditional owners of land and are produced in accordance with any customs or laws of the relevant traditional owners and where permission of the traditional owners has been given for the creation of the work. This provision is aimed to alleviate the problem of Indigenous artists painting other styles that they have no claim or belonging to.

The rules also require that the Label can only be used in conjunction with information about the traditional group, language group or land the creator/artist is associated with including, if relevant to the work, “ the way in which they regard the Work as reflecting their indigenous heritage or experience.”⁴⁰

These rules capture and implement elements of the definition of authenticity developed by Indigenous people during the consultation stage.

Dispute Resolution

The Rules provide a confidential and binding dispute resolution process allowing for reconsideration or re-determination of any decision by NIAAA or an approved Certifier relating to any act or application.⁴¹ An unsuccessful applicant can elect to meet with NIAAA delegates in an attempt to resolve the dispute. Should the dispute remain unresolved, the Rules empower the Executive Director of the Aboriginal and Torres Strait Islander Arts Board or the Australia Council to appoint a qualified independent Indigenous person or body to determine the dispute.⁴²

The Collaboration Mark

The Collaboration Mark denotes that a product or service is derived from a work of art which has been created by an Aboriginal or Torres Strait Islander person or people who satisfy the definition, and which has been reproduced or produced and manufactured under fair and legitimate licensing arrangements with non-Aboriginal and Torres Strait Islander people.

The Indigenous artist and the producer or manufacturer must jointly apply to use the Collaboration Mark for manufactured products incorporating the work or contribution of the Indigenous artist. The terms of the license provide that the Collaboration Mark be used in accordance with the Rules.

Copyright Production Agreement

The producer/manufacturer must enter into a written agreement with a Certified Indigenous Creator for licensed use of the copyright in a particular artist's work or works. With respect to the Collaboration Mark, it must be shown by the applicants that the goods are to be commercialized pursuant to a “ written Agreement on fair trading terms.”⁴³

What are “ fair trading terms” ? Rather than having NIAAA or its representatives vet every single agreement, the rules set out criteria where NIAAA or its approved certifier shall have regard to in determining this. The criteria include:

- whether the Indigenous person who contributed to the work had the opportunity to obtain independent advice from NIAAA, an Arts Law Center or a legal adviser before signing the agreement;
- whether the Indigenous person is required to assign their intellectual property rights in the work without additional payment of consideration.⁴⁴

According to NIAAA, this allowed Indigenous artists the freedom to negotiate terms as they saw fit whilst at the same time providing a checklist of some measure of protection.⁴⁵

License Agreement

Once approved, the Licensee must enter into a written license agreement with NIAAA to use the Collaboration Mark in relation to the licensed goods and services on set terms and conditions. The agreement specifically states that the Collaboration Mark is to be used as part of labeling and packaging of Licensed Goods and " accompanied by information as to the identity of the Indigenous artist, the Indigenous community, language group and land to which he or she belongs." ⁴⁶ There are also terms that allow NIAAA to terminate the rights should the Licensee fail to comply with the terms. ⁴⁷

Costs for Use of Collaboration Mark

To use the Collaboration mark, the applicant must pay a non-refundable fee of A\$50. Once the application is approved, the applicant can purchase the labels for use on the relevant goods.

There is a sliding scale for cost of production of the Label for the Collaboration Mark, depending on the number required. For instance, for goods with a wholesale price of A\$20 or less, the costs to use the level for 2000 or more labels is A\$250. In most cases the manufacturer bears the cost of production of the mark, although some manufacturers pass this cost onto the artists. Companies with access to technology for electronic production can produce the Collaboration Mark at a reduced cost. ⁴⁸

In this way, the Collaboration Mark aims to encourage tradition-based creativity on fair terms and to improve the returns to Indigenous artists on sales of Indigenous derived arts and cultural products and services.

Dispute Resolution

If NIAAA refuses to approve or renew the Licensee's license to use the Collaboration Mark, reasons for refusal must be provided in writing. ⁴⁹ The Rules contain dispute resolution provisions similar to those established for Indigenous applicants for the Label of Authenticity.

Indigenous Arts Retail Licenses

To complement the certification marks, NIAAA also registered the Label of Authenticity logo and the Collaboration mark logo as registered trade marks. ⁵⁰ The registered marks provide a third aspect of the system - the Notice for use by Indigenous Arts Retailers. The Notice reproduces both the Label and the Collaboration marks in the form of a sticker to be affixed onto shop windows or doors. The Notice indicates to consumers that the retailer supports users of the Label of Authenticity and the Collaboration Mark and is supplied with products for sale under a licensing arrangement with NIAAA. It recognizes retailers and point of sale outlets as traders in Indigenous works or goods that had been created by Certified Indigenous Creators under the Label of Authenticity and the Collaboration Mark.

Costs for Retailers

Once approved, Retailers are granted the rights to display the Notice on their premises, for a cost of A\$250 per shop for a twelve months license.

BENEFITS OF THE LABELLING SYSTEM

There are many benefits for Indigenous artists, their communities, the art community, and the tourism industry. NIAAA lists the following benefits to be gained from the implementation of the labeling system:

- Indigenous artists will receive a fair and improved return on sales from Indigenous derived arts and cultural products and services;
- consumers will recognize products originating from Indigenous people who are speaking in the proper way about their stories;
- visitors will learn more about the different Indigenous traditional and contemporary styles of art and stories from across Australia;
- wholesalers and retailers will be encouraged to buy and sell authentic products created by Indigenous people;
- manufacturers and distributors would be encourage to enter into licensing arrangements with Indigenous artists;
- consumers will identify goods and services of Indigenous origin in preference to “copy-cat” products.⁵¹

At the launch of the Label, the Chair of NIAAA, the late Dr. Perkins stated that the Label was the first step towards preventing Aboriginal paintings, music, dance, poetry and tourism services from being exploited. For too long the power had been in other levels of the market. According to Dr. Perkins, the Label gives power and control back to the Indigenous artists and creators.⁵²

HOW THE SYSTEM PROGRESSED

Due to the ceasing of funding to NIAAA in 2002, the future of the Label of Authenticity system is uncertain. Whilst both marks remain registered, and are owned by NIAAA, there is presently no office to administer the label and implement the certification system.

During the two years in which the system operated, the Collaboration mark and retail license were the most successful components of the system. Approximately 160 Indigenous artists, mostly located in New South Wales from areas that were not serviced or represented by Aboriginal Arts and Craft Centres, registered to use the Label of Authenticity. However, many Indigenous artists considered that the A\$30 registration fee was prohibitive as a significant part of the artist community consisted of hobby artists whose income was insufficient to warrant the registration fee for the Label of Authenticity. Another factor contributing to the low uptake could have been the administrative nature of the application process.

However, of all the applications received, the majority were approved by the Committee and there has been only one unsuccessful application.

Active campaigning, via advertising and direct association with Indigenous artists, was conducted by NIAAA to encourage more applications from Indigenous artists. Some funding was obtained to assist artists to join through artists associations such as Desert, the Rainbow Serpent and ANKAAA.⁵³

NIAAA envisaged continued marketing of the Label. During the Olympics, material on the Label was distributed to incoming tourists. In 2000, NIAAA staff noted that they would like

to see increased funding support to enable a sustained marketing campaign for the Label. It was evident that there was a need for a strong marketing promotion for labels of this kind to work effectively.

With respect to the certification mark, NIAAA issued licenses to approved manufacturers of mass produced items. A handful of Indigenous artists have entered into agreements with manufacturers who now use the Collaboration Mark. For example, Leanne Hunter, an Indigenous artist, used the Collaboration Mark for a range of children's clothing manufactured and sold through Country Target in 2001.

The third stage of the system for retailers was developed in 2000. During 2000 to 2002, approximately 11 retailers used the Indigenous Arts Retail License.⁵⁴

Developments and Directions in 2000

In 2000, NIAAA reported that regulating the use of the Label of Authenticity was aimed at pursuing excellence in the marketing and the promotion of Indigenous art and culture.⁵⁵ NIAAA considered that the process would require further refinement and envisaged that the use of the marks be monitored to gauge success, with adjustments being made if necessary. Once the Label developed an adequate income stream, NIAAA considered the establishment of an independent not-for-profit body to manage and take over the ownership of the Label of Authenticity.

Marketing all aspects of the Labeling system was seen as a priority by NIAAA to ensure its successful development.

Monitoring of the labeling system to locate any copying or misuse of the Label was also identified as an important consideration for the future. As Wiseman noted, the enforcement of the rights under the Label was seen as part of increasing consumer confidence in the Label as a method of authentication.⁵⁶

Comments

The implementation of the Indigenous Authentication Labeling System is evidence of the economic value arts and culture has not only to Indigenous peoples but also to the Australian economy generally. The system has potential to provide a means by which Indigenous artists can strengthen their positions. To be effective, there is a need for a public education and awareness program to be conducted for the labels. The main focus of the certification system was the manufacturing area and a distinction was drawn in the industry between souvenir arts and fine arts. The Label provided protection for commercial sales and manufacturing of Indigenous arts and cultural products.

There is still, however, a need for new laws to protect Indigenous Cultural and Intellectual Property rights including the recognition and protection of communally owned works, and works which under copyright are considered to be in the public domain.

The success of the Label will depend on how well the system is implemented and monitored. Additional issues that still need to be addressed include:

i) Effect on Arts Market

In 2000, some Indigenous artists considered that labeling system could potentially interfere with the creative process, even leading to comments of the label being a “dog-tag”⁵⁷, and that its value in the fine arts market may be limited. The focus was on use of the Collaboration Mark for mass-produced items, in particularly the souvenir market.

Some Indigenous artists were apprehensive about the possibility that the work of Indigenous artists not participating in the labeling system would be perceived within the market as unauthentic. The marks are not the only means of identifying authentic Indigenous artistic and cultural work. There are other means of identifying authentic works – for instance, the production of artistic works from Aboriginal arts centres. These centres adopt logos and trade marks of their own to denote authenticity of origin (see, for example, Case Study 7 on the Desert trademark and copyright licensing scheme). The Label’s rules also expressly state that this is not an intended function of the Label.⁵⁸

ii) Regional and Local Access

In 2000, regional organizations such as Desert and the Association of Northern Kimberley and Arnhem Aboriginal Artists (ANKAAA), have developed regional labeling systems (as mentioned, see Case Study 7). Furthermore, individual arts center also use their own distinctive labeling systems. One issue was how the label would fit alongside the many existing labels used by arts centres. Will the artists from arts centres and regional organizations want to use the NIAAA label in addition to their own systems? According to NIAAA, the label could be used alongside regional or local labels. It would provide the consumer with certainty that what they are about to purchase has been through two systems of validation for authenticity.

There were relatively small numbers of artist applying for the label in regional and local bodies. Many regional bodies are already using their own trade marks and logos to sell and distribute their art via Aboriginal arts center networks. Many centers feel they do not need to apply for the NIAAA mark to show that their products are “authentic.” Moreover, the costs of the mark may preclude use by Indigenous artists, who have to pay for the cost of applying the label to their works.

Another issue was that the use of the Aboriginal colors only on the marks dissuades use by Torres Strait Islander artists. In 2000, NIAAA was hoping to overcome the problem by incorporating the Torres Strait Islander colors into the marks. Discussions had commenced with the Torres Strait Islander Coordinating Council, however, since funding has ceased, this possibility has not progressed.

iii) Copyright Licensing Education

In attempting to protect the contractual interests of Indigenous artists, NIAAA had included rules that the Collaboration Mark be used only with “fair and equitable contracts.” For this to work, artists needed access to independent legal advice regarding contract law and copyright law as well as royalty terms and manufacturing standards, which they don’t always have or can afford.

iv) Marketing

Marketing is the key to the success of the national label of authenticity system. For the system to work, consumers must know about the labels and care enough about “authenticity” to seek out the products that bear the marks.

v) Continuing Policy

In 2000, NIAAA had also hoped to support the Label with its wider arts policy. For instance, in 1996, NIAAA developed the following policy statement concerning non-Indigenous artists painting Indigenous designs:

“...NIAAA strongly urges non-Indigenous artists, writers and performers to respect the cultural and spiritual significance of Indigenous people and refrain from incorporating elements derived from Indigenous cultural heritage into their works without the informed consent of the traditional custodians. It is important that Aboriginal and Torres Strait Islander people have control over the development of their own forms of artistic and cultural expression, as well as its interpretation and use by others.”⁵⁹

Status of the Certification Marks in 2003

In December 2002, NIAAA closed its offices.⁶⁰ Its major funding bodies, ATSIC and the Australia Council, ceased funding in 2002, leaving many Indigenous artists concerned. Mundara Koorang, ex-Director of NIAAA, stated in the *Koori Mail*, “(t)he Label of Authenticity has now taken giant steps backwards and its resurgence, if possible, will be an uphill battle.”⁶¹

Since 2000, there has been a growth in the number of regional arts centres registering trade marks. According to Cathy Craigie, Director of the Aboriginal and Torres Strait Islander Arts Board of the Australia Council, “this allows for the each region to authenticate and promote their own works rather than have their works authenticated by a national body. This appears to be more appealing to artists than having their works and identities assessed by a national Committee they are not familiar with.”⁶² The development of regional marks is growing and these marks are now gaining market recognition. However, those areas that are not represented by funded Arts and Crafts Centres have no authenticity labeling system and are disadvantaged. There is value in having an integrated systems that allows for local, regional and state differences.⁶³

The Label has at least been an inspiration to other Indigenous groups in the Pacific region. In 2002, the New Zealand Toi Iho™ Maori Made Mark, which is based on the Label of Authenticity, was launched. The registered trademark was developed by Te Waka Toi, Creative New Zealand’s Māori Arts Board, in consultation with Māori artists. The Mark is currently being used with reported success. Whilst modeled on the Australian model, a different feature for the Maori Made mark is that artists who apply for it must also meet criteria of quality. This has raised concerns from artists whether “quality” can be judged objectively.⁶⁴ Despite this the mark appears to be in use and is sought after by Maori artists to use on their arts and craft products. Among the first 38 Māori artists to be awarded the “toi iho™” Maori Made Mark are carvers, sculptors, a fashion designer, a furniture designer, weavers, jewelers and multimedia artists.⁶⁵

Endnotes

- ¹ The Collaboration Mark currently under examination has, however, received approval by the Australian Competition and Consumer Commission.
- ² See NIAAA Website at <www.niaaa.com.au>.
- ³ ATSIIC, National Aboriginal and Torres Strait Islander Cultural Industry Strategy, prepared by Focus with the assistance of Sharon Boil & Associates, February 1997. p. 5.
- ⁴ Department of Aboriginal Affairs, The Aboriginal Arts and Crafts Industry: Report of the Review Committee, AGPS, Canberra, July 1989, note 69.
- ⁵ ATSIIC, and Office of National Tourism, National Aboriginal and Torres Strait Islander Tourism Industry Strategy, August 1997, p 5.
- ⁶ V. Johnson, Copyrites: Aboriginal Art in the Age of Reproductive Technologies, National Indigenous Arts Advocacy Association and Macquarie University, Canberra, 1996.
- ⁷ See for example M* & Others v Indofurn Pty Ltd (1995) 30 IPR 209 and Bulun Bulun & M* v R & T Textiles Pty Ltd (1998) 41 IPR 513.
- ⁸ One well reported example involved an 82-year-old non-Indigenous painter Elizabeth Durack who produced a number of paintings under the persona Eddie Burrup, an Indigenous male artist. Susan McCulloch, 'Revealed: Black art scandal', The Weekend Australian, 15–16 November 1997.
- ⁹ Interview with Keven Francis, then Executive Director, NIAAA, October 2000.
- ¹⁰ An Adelaide art dealer was charged for dealing with 22 fake paintings passed off as the works of Indigenous artist, Clifford Possum Tjapaltjarri, Peter Gotting, "Shame of Aboriginal Art Fakes", 17 July 2000.
- ¹¹ Michael McMahon, "What's in a Label?" NIAAA News, 1995, page 2.
- ¹² Terri Janke, Our Culture: Our Future - Report on Australian Indigenous Cultural and Intellectual Property Rights, Michael Frankel & Company, Sydney 1998, written for the Australian Institute of Aboriginal and Torres Strait Islander Studies and the Aboriginal and Torres Strait Islander Commission, page 41.
- ¹³ *Ibid*, page 38.
- ¹⁴ Striking figures represented by Indigenous people in the Kimberley region of Western Australia, featuring a halo effect around the face. Wandjinas are recognised as having a significant role in natural and spiritual events.
- ¹⁵ Marianna Annas, "The Label of Authenticity: A Certification Trade Mark for Goods and Services of Indigenous Origin, (1997) vol 3(90) Aboriginal Law Bulletin, pp 4 - 6.
- ¹⁶ See Christine Alder, "Challenges to Authenticity in the Aboriginal Art Market", Paper presented at the Art Crime Protecting Art, Protecting Artists and Protecting Consumers Conference convened by the Australian Institute of Criminology, 2 - 3 December 1999, Sydney.
- ¹⁷ Marianna Annas, "The Label of Authenticity: A Certification Trade Mark for Goods and Services of Indigenous Origin", Aboriginal Law Bulletin.
- ¹⁸ A collective trade mark is "a sign used, or intended to be used, in relation to goods and services dealt with or provided in the course of trade by members of an association to distinguish those goods and services from goods or services so dealt with or provided by persons who are not members of the association": Section 162, Trade Marks Act 1995 (Cth).
- ¹⁹ ***Sydney 2000 Games (Indicia and Images) Protection Act 1996 (Cth).***
- ²⁰ <http://www.niaaa.com.au/niaaa_news02.htm>.
- ²¹ *Ibid*.
- ²² ***Trade Marks Law***, Law Book Company, Loose-leaf Service, page 34

- 23 The Aboriginal Flag was designed by Harold Thomas in the 1970s. He is the copyright owner of the flag.
- 24 Discussions with Sam Pilot, previously Torres Strait Islander Cultural Development Officer, August 2000 and Aven Noah, Torres Strait Islander Media Association, August 2000.
- 25 Meeting with Island Coordinating Council staff who commissioned the flag design, August 2001.
- 26 Interview with Keven Francis, Executive Director, NIAAA.
- 27 It generally takes approximately 6 - 9 months for the application to be examined. An applicant can apply for expedition, which was what NIAAA did in this instance.
- 28 Meeting with Ross McLean and Rohan Singh, Baker & McKenzie Lawyers, March 2001.
- 29 The Registrar may accept a trade mark subject to conditions or limitations. See Section 33(2), Trade Marks Act 1995 (Cth). A limitation means limitations of the exclusive right to use a trade mark given by the registration of the trade mark including limitations of that right as to: (a) mode of use; or (b) use within any territory area within Australia; or (c) use in relation to goods or services to be exported. (Section 6, Trade Marks Act 1995 (Cth).)
- 30 See trade marks 772563 (Service Mark) and 772564 (Goods).
- 31 Section 173, Trade Marks Act 1995 (Cth).
- 32 Section 175(2)(a), Trade Marks Act 1995 (Cth).
- 33 Section 175(2)(b), Trade Marks Act 1995 (Cth).
- 34 Section 173(2), Trade Marks Act 1995 (Cth).
- 35 Regulation 16.3 of the Trade Mark Regulations 1995.
- 36 Section 175, Trade Marks Act 1995 (Cth).
- 37 Sections 171 and 20(1), Trade Marks Act 1995 (Cth).
- 38 Section 172, Trade Marks Act 1995 (Cth).
- 39 See ATSIIC Aboriginality Guidelines which are also adopted by other government agencies administering Aboriginal affairs and *Edwina Shaw & Anor v Charles Wolf & Ors*, [1998] 389 FCA (20 April 1998).
- 40 Rules 4.2 and 4.3, Label of Authenticity Rules.
- 41 Rule 9, Label of Authenticity Rules.
- 42 Rules 6.3, Collaboration Mark Rules.
- 43 Rule 3.1(i), Collaboration Mark Rules.
- 44 Appendix D of Collaboration Mark Rules sets out Trading terms.
- 45 Collaboration Mark Rules.
- 46 Clause 3.2 of Licence Agreement.
- 47 Clause 6 of Licence Agreement.
- 48 Interview with Keith Hall and Chris Harrison, NIAAA Staff, 2 March 2001.
- 49 Rule 3.0, Collaboration Mark Rules.
- 50 Marks 77253 and 772564 – Classes 35 and 42 – Services.
- 51 NIAAA, "The Label of Authenticity for the Indigenous Arts", NIAAA Newsletter, September 1999.
- 52 Dr. Perkins at Launch of Label.
- 53 Interview Keven Francis, NIAAA.

54 *Ibid.*

55 See NIAAA, Op Cit.

56 Leanne Wiseman, "The Protection of Indigenous Art and Culture in Australia: The Label of Authenticity" [2001] E.I.P.R Issue 1 at 22-23.

57 Terri Janke, "Money for Arts Sake," *Alternative Law Journal*, Vol 25, No 4, August 2000, page 190. The "dog tag" is the term used by Aboriginal people for the certificates issued exempting them from restrictive legislation and practices, and entitling them to vote.

58 Rule 10.1, Label of Authenticity Rules.

59 NIAAA Policy Statement 1996.

60 Debra Jopson, "Aboriginal seal of approval loses it seal of approval," *Sydney Morning Herald*, 14 December 2002.

61 Mundara Koorang, "The Time Has Arrived," *Koori Mail*, 11 December 2002, page 5.

62 Telephone attendance on Cathy Craigie, 5 September 2003.

63 Terri Janke, *Our Culture: Our Future*, page 207.

64 Discussions at Indigenous Art and Heritage & the Politics of Identify Conference held at Massey University, 8 July 2002, Session "Branding Indigenous Art and the implications for Intellectual Property Rights."

65 See <www.toiioho.com>.

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APPENDIX

*NIAAA'S LABEL OF AUTHENTICITY TRADE MARK** *CERTIFICATION RULES*

1. NIAAA and the Label of Authenticity

The National Indigenous Arts Advocacy Association is a non profit organisation dedicated to protecting Indigenous Australian peoples' rights, culture, cultural respect, protocol and values throughout the promotion and protection of indigenous arts and crafts. The label of Authenticity is a trade mark that was developed to enable the protection of Australian indigenous art, cultural products and cultural performances by way of a national certification system for the authentication of the works of Indigenous people. The Label of Authenticity enables people to easily identify products and performances as authentic works of Indigenous Australians and will help educate consumers about the diversity of traditional and contemporary Indigenous artistic expression, art and stories. Any indigenous Australian who meets the standards set by these Rules may apply for certification entitling that person to use the Label of Authenticity in relation to their works and to reap the benefits of the certification system.

The certification system is a two tiered system consisting of the Label of Authenticity and the Collaboration mark. The Label of Authenticity which is the subject of these Rules can only be used in relation to a work or service which is created, authored or produced wholly by an Indigenous person. The Collaboration mark can be used where the work or service is authored, created or produced by an Indigenous person with the assistance or input of a non-indigenous person or where a product or service incorporates the work of an Indigenous person, and the product or service is to be commercially exploited under a written agreement on fair trading terms.

2. Definitions

2.1 The following words and phrases will have the following meanings when used in these Rules unless the context otherwise dictates:

- (a) "Annual Fee" means the fee payable on application for renewal of certification as set out in the Annexures C to these rules.
- (b) "Application Fee" means the fee payable on application for certification as set out in Annexure C of these Rules.
- (c) "Approved Certifier" means those persons appointed in writing by NIAAA from time to time to consider applications for certification under these Rules. An Approved Certifier must:
 - (i) be a non-profit incorporated Indigenous community arts and/or cultural organisation, or e an ATSIC-funded organisation or other organisation of a similar nature approved by NIAAA; and
 - (ii) have knowledge of Indigenous communities within the area in which they are entitled to certify applicants.
- (d) "Certified Indigenous Creator" means and includes any person/s who has been certified in writing by NIAAA or an Approved Certifier as an Indigenous Person.
- (e) "Indigenous Person" means a person of Australian Aboriginal or Torres Strait Islander descent, who identifies as an Australian Aboriginal or Torres Strait Islander, and is accepted as such in an indigenous community.
- (f) "Label of Authenticity" means the trade mark which is the subject of Australian Trade Mark Application 772565 as depicted in Annexure "A" to these Rules.

*

Drafted by Baker and McKenzie Lawyers, Sydney, Ross McLean and Rohan Singh, 2000.
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- (g) "NIAAA" means the National Indigenous Arts Advocacy Association Inc or any not-for profit organisation which it appoints as its successor for the purpose of the Label of Authenticity and these Rules, upon that appointment receiving any necessary Australian Competition and consumer commission or other approval and becoming effective.
- (h) "Register" means the national database of Certified Indigenous Creators, to be kept by NIAAA and its Approved Certifiers, which will be available to the public for inspection upon request.
- (i) "Rules" means these Rules as amended from time to time, those amendments being effective after any necessary Australian Competition and Consumer Commission or other approval has been obtained by NIAAA.
- (j) "Work" means and includes any artwork, craftwork or other product or subject matter within the specification of goods for which the Label of Authenticity is from time to time registered as a trade mark in Australia, whether in electronic form or other media.
- (k) "Services" means and includes performances; lectures; productions (including the production of videos, films and television shows); providing information on the Internet or in other media; or other services within the specification of services for which the Label of Authenticity is from time to time registered as a trade mark in Australia, whether in electronic form or other media.

2.2 In this Agreement, unless the context requires another meaning:

- (a) a reference to:
 - (i) the singular includes the plural and vice versa;
 - (ii) legislation is a reference to that legislation as amended, consolidated, supplemented or replaced.

3. Who can use the Label of Authenticity?

3.1 The Label of Authenticity can be used in accordance with these Rules only by Certified Indigenous Creators on Works which they alone conceive and create, or in relation to Services which they alone conceive, create, perform or otherwise present in public.

3.2 All applications must be made in the form attached as Annexure "B" to these Rules or in such other form as NIAAA may reasonably require or allow, and be accompanied by:

- (i) the Application Fee; and
- (ii) an ATSI Confirmation of Aboriginality or Torres Strait Islander Descent Form or Label of Authenticity Confirmation of Aboriginality or Torres Strait Islander Form or other evidence that the applicant is an Indigenous Person; and

be supplemented by any further documents or information that NIAAA or its Approved Certifiers may reasonably require in order to decide whether or not the applicant is an Indigenous Person.

3.3 In deciding whether an applicant is an Indigenous Person, NIAAA may require an applicant to clarify or provide further evidence establishing that the applicant is a person of Australian Aboriginal or Torres Strait Islander descent, identifies as an Australian Aboriginal or Torres Strait Islander and is accepted as such in an indigenous community in which the applicant lives, or comes from or with which the applicant identifies. The applicant may trace his/her descent from a different indigenous community from the indigenous community with which they identify or in which they are accepted as indigenous.

3.4 An applicant must specify in the application the Works and/or Services in respect of which it intends to use the Label Of Authenticity, and inform NIAAA of any expansion of those Works or Services from time to time in writing in order for NIAAA to keep the Register accurate and to assist NIAAA in monitoring use of the Label of Authenticity. It is not necessary for a Certified Indigenous Creator to file a new application for additional Works or Services.

3.5 If NIAAA or its Approved Certifier is satisfied that an applicant is an Indigenous Person entitled to be certified as a Certified Indigenous Creator, it will issue a Certificate confirming that the applicant is certified to use the Label of Authenticity and will enter the applicant's name on the Register.

3.6 If NIAAA or its Approved Certifier is not satisfied that an applicant is entitled to be certified as a Certified Indigenous Creator, it will issue a written notice of its decision giving reasons for its refusal to certify the applicant.

3.7 NIAAA or its Approved Certifier should, within one month of the date of an application in an approved form, issue to the applicant either:

- (i) a Certificate confirming that the applicant is certified to use the Label of Authenticity; or
- (ii) a request for further evidence that the applicant is an Indigenous Person; or
- (iii) a written notice refusing to certify the applicant.

3.8 Each Certified Indigenous Creator is authorised to use the AuthenticityMark, in accordance with these rules, for 12 months from the date of the written Certificate issued under clause 3.5 of these Rules.

3.9 At the expiration of each twelve (12) months, a Certified Indigenous Creator who wants to continue to be authorised to use the Label of Authenticity in accordance with these Rules, may apply in writing to NIAAA or an Approved Certifier. Provided that the Certified Indigenous Creator's right to use the Label of Authenticity has not been terminated in accordance with clause 8 of these Rules, the request is in writing and the Annual Fee is paid, NIAAA or its Approved Certifier will issue a Certificate of Renewal confirming that the Certified Indigenous Creator is entitled to use the Label of Authenticity for a further twelve (12) month period. It is not necessary to provide evidence that the Certified Indigenous Creator is an Indigenous Person, within the meaning of these Rules.

3.10 If NIAAA or an Approved Certifier refuses to authorise the Certified Indigenous Creator to use the label of Authenticity for a further twelve (12) month period, it must provide the Certified Indigenous creator with its reasons for refusal in writing.

4. How must the Label of Authenticity be used?

4.1 In the case of Works or Services which purport to encode, depict or reflect the ceremony, law, knowledge, customs, stories, dreaming or ritual of the traditional Indigenous owners of particular land or to in some other sense belong to that land, the Label of Authenticity will only be used in connection with those Works or Services if they were produced in accordance with any customs or law of the relevant traditional indigenous owners of the land in question and if the Certified Indigenous Creator(s) who authored the Works or presents the Services has obtained any necessary permissions or approvals required under those customs or law for the creation, publication, sale and performance or other proposed dealing in the Works or Services.

4.2 In the case of Works, the Label of Authenticity can only be used as part of a label, package, covering, or other thing in which the Works are provided or which is applied to, woven in, impressed on or affixed to the Works if that thing also includes or is accompanied by information as to the identity of any Certified Indigenous Creator, the traditional indigenous people, language group and land to which he or she belongs, where they were living when the Work was authored if relevant to the production of the Work and the way in which they regard the Work as reflecting their indigenous heritage or experience.

4.3 The Label of Authenticity can only be used in relation to Services if any program, promotional material or other written or electronic material produced about or in connection with the Services also includes or is accompanied by information as to the identity of any Certified Indigenous Creator, the traditional indigenous people, language group and land to which he or she belongs, where they were living when the Services were authored if relevant to the authorship or production of the Service and the way in which the Certified Indigenous Creator regards the Service as reflecting their indigenous heritage or experience.

4.4 The Label of Authenticity must only be affixed to a Work or used in relation to a Service by its Certified Indigenous Creator or by those authorised on their behalf to do so with respect to that particular Work or Service. A Certified Indigenous Creator cannot licence, authorise or consent to others affixing the Label of Authenticity to Works which are authored, or produced in whole or in part by non-Indigenous persons, or in the case of Services, those which are presented or performed in whole or in part by non-Indigenous persons.

4.5 The Label of Authenticity must always be represented in the manner in which it has been registered or applied for as a trade mark without change to its features, colours, proportions or other characteristics. Other trade marks (including regional marks), features, stickers or other matter may be used with the Label of Authenticity provided that the Label of Authenticity is not obliterated or obscured in whole or part.

4.6 The Label of Authenticity must not be used in a way which is misleading or deceptive or otherwise contrary to any applicable law or regulation. Without limitation, any use must not be accompanied by any claim or representation that Certified Indigenous Creator enjoys the sponsorship, approval or endorsement of NIAAA or any of its delegates.

5. Ownership and Enforcement of the Label of Authenticity

5.1 NIAAA owns the Label of Authenticity and Certified Indigenous Creators who are authorised to use it by and under these Rules acquire no property or other rights in the Label of Authenticity. NIAAA derives and owns all goodwill and reputation created in the label of Authenticity through its use.

5.2 The Label of Authenticity comprises a logo, the copyright in which is owned by NIAAA. It is of the utmost importance to NIAAA and to the protection of the Label of Authenticity that all reproductions of the Label of Authenticity be consistent, of the highest quality and conform with the specifications for the label of Authenticity prescribed by NIAAA from time to time. Nothing in these Rules is intended to confer on a Certified Indigenous Creator the right to reproduce the label of Authenticity in any form. The Label of Authenticity can only be reproduced by NIAAA or by or on behalf of a Certified Indigenous Creator with the express written permission of NIAAA.

5.3 No application to register the Label of Authenticity or any similar trade mark, or any mark (brand or logo) which incorporates the Label of Authenticity or any similar mark, will be filed or made by a Certified Indigenous Creator.

5.4 No Certified Indigenous Creator will claim ownership or any other right or interest in the Label of Authenticity other than the right to use the Label of Authenticity pursuant to and in accordance with these Rules, or challenge the ownership of the Label of Authenticity by NIAAA.

5.5 If any Certified Indigenous Creator becomes aware of any unauthorised use of the Label of Authenticity or any similar mark it will bring this to the attention of NIAAA which will take such action as it decides is appropriate to enforce or protect its rights in that mark. No Certified Indigenous Creator may commence any infringement or other action in connection with the use of the label of Authenticity or any similar mark, name or brand by other persons but will provide any cooperation or assistance that is reasonably requested by NIAAA, at its expense, in support of any infringement or other such action that it decides to bring.

6. Compliance with these Rules

6.1 Within 14 days of receiving a request from NIAAA, a certified Indigenous Creator must provide information concerning their use of the Label of Authenticity on any Work or in relation to any Service including information on the creation and production of that Work or Service, details of where it is being sold or presented or performed, how the Label of Authenticity has been used in connection with the Work or Service and any other information reasonably necessary to enable NIAAA to check that the label of Authenticity is being used in accordance with these Rules.

6.2 A Certified Indigenous Creator must, upon the written request of NIAAA or an Approved Certifier giving not less than 48 hours notice:

- (i) provide samples of its use of the Label of Authenticity on its Works or in relation to Services;
- (ii) permit a delegate to enter its premises to inspect the use of the label of Authenticity on its Works, permit a delegate to view a presentation or production of the Service; and
- (iii) provide any other access reasonably necessary to enable NIAAA or its Approved Certifiers to be satisfied that the Label of Authenticity is being used in accordance with these Rules.

7. Powers of NIAAA

7.1 NIAAA has the right to delegate any one or more of its powers under these Rules to an appropriately qualified and independent nominee appointed in writing except that decisions as to whether an applicant is an Indigenous Person can only be delegated to an Approved Certifier. The decision of any such delegate will be binding and effective under these Rules in the same way as if it had been made by NIAAA.

7.2 NIAAA or its delegate must give reasons in writing for any decision that an applicant is not a Certified Indigenous Creator, or that a person's rights or status as a Certified Indigenous Creator are terminated pursuant to and in accordance with these Rules. All other powers, decisions, actions and notices can be given or made under these Rules without the need to give reasons.

8. Termination of Rights to use the Label of Authenticity

8.1 If any Certified Indigenous Creator makes any use of the Label of Authenticity in breach of these Rules then, in addition to any other rights or remedies that it might have whether arising under statute, common law or otherwise howsoever, NIAAA may give notice of the breach requiring that where possible the breach be remedied within 14 days or, if that is not possible, requiring that a written undertaking be given not to repeat that breach.

8.2 If the breach is not remedied or the written undertaking given (as the case may be) within 14 days, or any past undertaking given by that Certified Indigenous Creator is breached, then NIAAA may immediately give a written notice to the Certified Indigenous Creator terminating his or her right to use the Label of Authenticity on any Works created or produced after the date of the notice or any Services to be performed or presented after the date of the notice. From that date, that person will cease to be a Certified Indigenous Creator for the purpose of these Rules.

8.3 If NIAAA is made aware of new evidence which suggests that a Certified Indigenous Creator is not an Indigenous Person, and is satisfied after giving that person a reasonable opportunity to respond to that evidence that they are not an Indigenous Person for the purpose of these Rules, then NIAAA may immediately give written notice both of this decision, including its reasons, and of the termination of that person's right to use the Label of Authenticity from the date of the notice. From that date, that person will cease to be a Certified Indigenous Creator for the purpose of these Rules.

8.4 If the right of a Certified Indigenous Creator to use the Label of Authenticity is terminated in accordance with these Rules, NIAAA may require the Certified Indigenous Creator to deliver up, destroy or dispose of, in a manner approved by NIAAA, any labels, tags, bags or other items or materials on which the Label of Authenticity is affixed or otherwise appears.

8.5 NIAAA is not bound to accept any later application by any person, whose right to use the Label of Authenticity has been terminated, to be recognised or reinstated as a Certified Indigenous Creator.

8.6 If a person ceases to be a Certified Indigenous Creator, NIAAA or its Approved Certifier will remove that person's name from the Register.

8.7 The rights of NIAAA under clause 8.1 are in addition to any right that it may have to bring an action for trade mark infringement or any other action in respect of any use of the Label of Authenticity other than in accordance with these Rules and to seek or obtain injunctions, damages, an account of profits or other remedies in respect of that infringement or other action.

9. Dispute Resolution

9.1 A Certified Indigenous Creator or applicant for certification may request reconsideration of any decision of NIAAA or an Approved Certifier which relates to any act or application by them in connection with these Rules, by written notice to NIAAA.

9.2 Within 14 days of receiving a written notice, one or more delegates of the management of NIAAA will meet with the complainant to try to resolve the dispute at the Office of NIAAA or an office of an Approved Certifier.

9.3 If the dispute is not resolved at a meeting between the Certified Indigenous Creator/applicant and a delegate of NIAAA, the parties agree to appoint, within one month of the meeting referred to in clause 9.2, an appropriately qualified independent indigenous person or body to determine the dispute. In the event that the parties cannot agree on such a person to determine the dispute, the current Executive Director of the Aboriginal and Torres Strait Islander Arts Board, of the Australia Council will appoint such a person. The parties agree that any decision by an appropriately qualified independent indigenous person or body under this clause will be confidential and binding.

10. Other matters

10.1 Nothing in these Rules is intended or shall be used to suggest that Works in respect of which the Label of Authenticity is not used necessarily involve any misrepresentation as to their origin or authorship or that their quality or worth is necessarily inferior to Works in connection with which the Label of Authenticity is used pursuant to and in accordance with these Rules. NIAAA does not authorise or condone the making of any such representations, statements or suggestions whether by Certified Indigenous Creators or others.

10.2 NIAAA does not warrant or represent that the use of the Label of Authenticity is guaranteed to confer any financial or other benefit on the user and to the full extent allowed by law excludes any liability for any loss, damage or liability suffered or incurred by any person who uses the Label of Authenticity under these Rules, however that loss, damage or liability is caused (whether by the negligence of NIAAA or its servants or agents or otherwise). To the extent that any liability of NIAAA is not excluded by this clause it is limited, to the full extent allowed by law, to an obligation to supply the relevant services that it has provided under these Rules.

10.3 While NIAAA will use its reasonable best efforts to ensure that all uses of the Label of Authenticity are in accordance with these Rules it will not be responsible for any damage caused to any one Certified Indigenous Creator by the breach of these Rules by any other Certified Indigenous Creator or by any other person.

10.4 Certified Indigenous Creators who use the Label of Authenticity pursuant to these Rules do not do so as agents of NIAAA. NIAAA accepts no responsibility for their acts and omissions.

10.5 The coming into effect of these Rules, and any amendment to them, is subject to them being approved by the Australian competition Consumer Commission as required by section 178 of the *Trade Marks Act 1995*.

AUTHOR'S REPORT ON CONSULTATION

This paper reports on the research, consultations and investigations undertaken by Terri Janke in preparing the Case Studies on Intellectual Property and Traditional Cultural Expressions. It includes phone conversations, interviews, meetings and consultations that were conducted for the purposes of researching and writing the eight studies.

Sydney, 13 June 2000

I met with Mr. Wend Wendland, Head, Traditional Creativity and Cultural Expressions Section, Traditional Knowledge Division of the World Intellectual Property Organisation (WIPO) in Sydney on Monday 13 June 2000 to settle the Terms of Reference for the case studies and to finalize and sign the consultant's contract. Over the next three days, Mr. Wendland and I met with various officials and other key stakeholders in order to introduce and explain the objectives and nature of the case studies I would be preparing.

We first met with Libby Baulch, Executive Director and Ian McDonald, Legal Information Officer of the Australian Copyright Council. The Australian Copyright Council has produced two publications on Indigenous issues and copyright, *Indigenous Arts and Copyright* and *Protecting Indigenous Intellectual Property*.

We also met with staff of the Aboriginal and Torres Strait Islander Unit of the Australia Council, Frank Puccini (Acting Director), Rick Shapter, Programs Manager and Martin Munz, Program Manager. The Australia Council is the Federal Government's peak advisory and funding body for the arts. The Unit funds the National Indigenous Arts Advocacy Association and provided assistance with funding for *M* v Indofurn 30 IPR 209* (the "Carpets Case").

Mr. Wendland and I met with the late Kumantjayi Perkins, Chairperson, Daryl Wright (Board Member) and Keven Francis, Executive Director - all of the National Indigenous Arts Advocacy Association (NIAAA). NIAAA is an organization established to further the rights of Indigenous artists. It coordinated the Carpets Case and is the organization that established and currently administers the National Label of Authenticity.

Mr. Wendland and I met with Steven Bowditch of Aboriginal Traders Alliance and NSW Department of State and Regional Development to discuss the extent of commercial use of Indigenous intellectual property in the business sector.

Then we met with lawyers at the Arts Law Centre of Australia. The Arts Law Centre is a community legal centre that provides over the phone advice to artists, including Indigenous artists. Arts Law also has a website and informative newsletter that provides information on moral rights, licensing and other arts issues. We met with Delia Browne, Executive Director and Sally McCausland, Senior Legal Officer.

Canberra, 14 - 15 June 2000

On 14 June, Wend Wendland and I traveled to Canberra. We met principally with Susan Farquhar, Director and Stewart Atkins, Deputy Director of External Relations Section, IP Australia. We also met with other staff of IP Australia including Dr. Albin Smrdel, Director of Development and Legislation; Jessica Wyers, Development & Legislation; and, Helen Dawson, External Relations, to discuss the project.

We then attended the offices of the Department of Foreign Affairs and Trade to meet with members of the Inter-Departmental Committee on Indigenous Cultural and Intellectual Property including Tony Taubman, and Jane Kriegel, International Section of Department of Foreign Affairs and Trade; Maureen Grant-Thomson, Information and Security Law Division, Attorney-General's Department and Kristiane Herrman, Biotechnology & R & D Branch, Agriculture, Fisheries and Forestry. The purpose of the meeting was to explain and discuss the project.

We then visited the Institute of Aboriginal and Torres Strait Islander Studies (AIATSIS) and met with Russell Taylor, Principal, in relation to the Rock Art Case. AIATSIS is a statutory authority of the Commonwealth government with a Council of mainly Indigenous scholars and an increasing number of Aboriginal and Torres Strait Islander members and staff.

On 15 June, we met with representatives of the Aboriginal and Torres Strait Islander Commission (ATSIC) - Sonia Smallacombe, Manager of the Indigenous Cultural and Intellectual Property Taskforce and Michael Davis, Project Officer and Paul Burke of the Native Title Section. ATSIC had commissioned the report, ***Our Culture: Our Future: Report on Australian Indigenous Cultural and Intellectual Property Rights***.

We then visited the National Gallery of Australia to browse the Aboriginal art collection and met with Kathryn Wells, the consultant who worked on the initial consultation phase for the Label of Authenticity for the National Indigenous Arts Advocacy Association.

Canberra, 17 - 18 July 2000

On 17 July, I traveled to Canberra to conduct research at IP Australia. I met with Susan Farquhar, External Relations Section who organized my research at IP Australia Office in Phillip, Canberra.

I also met with Pat Ryan, Strategies and Project Section. Mr. Ryan provided me with information on IP Australia's functions and registration processes.

I met with Hugh Ness, Deputy Registrar of Designs who provided me with information on the Designs Registration system and the recent proposals for change. Hugh also advised me of the procedures and provided me with copies of submissions to the ALRC Review on Designs undertaken in 1994. At the Designs Office I also met with Ms Sharon Thomas, Designs Examiner. Together we conducted a detailed search of the Designs Registrar for types of Indigenous designs likely to be registered.

On 17 July, I also met with staff of ATSIC - Sonia Smallacombe, Manager of the Indigenous Cultural and Intellectual Property Taskforce and Megan Davis, Legal Section of ATSIC. The purpose of our meeting was to keep ATSIC informed of the progress of consultations.

On 18 July, whilst still visiting IP Australia, I met with Helen Hardie, Deputy Registrar, Trade Marks Office who provided me with an overview of trade marks appeals process. I spent most of the day with Dr. Noel Taylor, Trade Mark consultant with over twenty years experience in trade marks. Together Dr. Taylor and myself researched the trademark register to ascertain the extent of usage by Indigenous Australians.

I met briefly with Ross Wilson, Registrar of Trade Marks to advise him of the studies. We discussed Indigenous Cultural and Intellectual Property (ICIP) rights and the use of trade marks generally.

I met with Anna Pino, Assistant Director, Marketing, and Matt Skelly, Marketing section of IPAustralia. They provided information on the success of some Australian designs and trade marks.

Darwin, Jabiru and Yirrkala Fieldtrips, 30 July – 2 August 2000

On 30 July, I traveled to Kakadu National Park by car from Darwin. The trip by road took approximately three hours. I met with Mandy Muir, Indigenous screen printer, ranger and rock art expert at Cooinda. Together we viewed the rock art galleries at Nourlangie Rock and viewed the Cadell River Galleries from the escarpment area. We were unable to view the particular rock art sites which the Mimi figures originate, due to inaccessibility.

On 31 July, I traveled to Nhulunbuy in the Gove Peninsula area of Arnhemland. I met with Colin Lane, Coordinator of Yirrkala Landcare. We visited the nearby Aboriginal community Yirrkala Dhanbul Association, council organisation which provision of services and infrastructure to Yirrkala, the Aboriginal community where Banduk Marika comes from. Banduk was in Darwin as a relative had got suddenly sick and was taken to hospital.

On 31 July, I also met with Andrew Blake and Diane Blake at the Buku Larrngay Mulka, the Aboriginal Arts Centre at Yirrkala which sells and markets Banduk's work. There is also a museum at the Arts Centre which includes rare pieces of art and cultural history such as the Yirrkala church doors. At the museum, one of the carpets from the ***Carpet Case***, which reproduces ***Djanda and the Sacred Waterhole***, is displayed alongside information about the Carpets Case. We were shown around the museum by Will Stubbs, Coordinator.

On 1 August, I met with Mawalan Marika, Traditional Custodian of Rirratingu clan. Mawalan is the most senior member of the Rirratingu clan and is the person holding the rights to authorize others in the clan to paint the image of Yelangbara, and to disclose rights to the underlying knowledge.

I also met with staff of the Aboriginal and Torres Strait Islander Commission including (then) Commissioner of ATSIC Gatjil Djerkerri and Mrs. Andrea Collins, Manager ATSIC Nhulunbuy.

On 2 August, Banduk returned from Darwin and I met with her and Timmy Burarrwanga, at Banduk's home at Yirrkala beach. Timmy and Banduk have a role in traditional law, where Timmy must act as verifier of her knowledge. Timmy is himself an artist. Both Timmy and Banduk advised me of the importance of the traditional knowledge embodied in the painting, ***Djanda and the Sacred Waterhole***.

Yulara, 9 August 2000

On 9 August I was in Yulara, Northern Territory. I met with Ms Joanne Wilmot, Chair of the Board of Management of Uluru Kata Tjuta National Park and Paul Josif, Executive Officer of Office of Joint Management at Uluru Kata Tjuta National Park. Mr. Josif had attended a WIPO and IP Australia meeting in Sydney in February 2000. He, along with other Indigenous representatives, had met with Dr Kamil Idris, Director General of WIPO. The National Park has many intellectual property issues that arise in the course of its operation including filming, research and access to resources. In the near future, the Park intends to conduct their own ICIP inquiry and seek guidance from WIPO.

Alice Springs, 31 August – 2 September 2000

In Alice Springs I spent a day at Desart Offices to research files and to meet with Desart Committee Members. Desart is an umbrella organization representing 40 Aboriginal Arts Centres in Central Australia. Ron Brien, Executive Director, provided details of Desart structure and issues relating to the Desart Trade Mark study.

Whilst in Alice Springs, I also visited with CAAMA, Central Australian Aboriginal Media Association. I met with Merv Franey, Executive Officer and Chris Ross, Deputy Officer. CAAMA operates radio broadcasting services in the Centre for remote Indigenous communities. CAAMA also operates recording facilities and has produced many Indigenous sound recordings that are marketed and sold under the CAAMA music label.

Dubbo, 25 August 2000

I spent a day at Dubbo and met with Lewis Burns, Indigenous artist and didgeridoo maker. Lewis was sued by another party for trade mark infringement. Both Lewis and the other party had adopted similar words as their business name around the same time, and the other party had registered their name as a trade mark. The matter has settled under confidential terms. Lewis showed me around his gallery and workshop. We discussed his designs and artistic works. Lewis is the designer of the footed didgeridoo as mentioned in the Designs Study.

Aurukun, 11 September 2000

On 11 September, I traveled from Cairns to Aurukun in the West Cape York Region with Louise Goodchild, Principal Legal Officer with the Cape York Land Council (CYLC). The Wik people, from Aurukun, are one of the Cape Aboriginal communities that the CYLC assist in land matters.

We visited the Aurukun Shire Council Chambers and met with Councillor Jacob Wollomby and Gary Kleindon, Executive Officer. We addressed the full meeting of Councillors to advise them of the outcomes of the case, and the purposes of the WIPO Feasibility Study. The Councillors expressed that there were many issues pertaining to copyright and traditional knowledge. Councillor Wollomby noted issues with commissioned film footage being used commercially by the film-consultant who they had commissioned some years ago. The use of this footage by commercial channels when Wik issues are discussed by television news has caused a lot of fighting with local peoples. Issues include consent and how far the right of the film-consultant to use the film after the commissioned job has ended.

I also met with Ricky Maynard, Tasmanian Aboriginal photographer who is doing some work in Aurukun. We discussed copyright and photography generally.

We also met with Gladys Tybingoompa, a Wik woman who is quite famous in Australia for dancing at parliament house when the judgment was handed down for the Wik Native Title Case. She has in the past performed at the Laura Festival and was in fact performing with the Wik Apalech dancers in 1995 when the photograph in the "Protection of Dance" Study was taken. Her image was reproduced on t-shirts promoting the Laura Festival. She was not all together happy about this because the organisers had not sought her prior consent. She works with education and is a spokesperson on issues affecting the Wik. She said that she did not want to perform at Laura in future. "Why" I asked. "I have had lessons" she says. "First the t-shirt, now the photo."

We met with members of the Wik Apalech dance group that were photographed at the Laura Festival in 1995. They were all male members of the dance group photographed as follows:

Felix Yunkaporta
 Bruce Yunkaporta
 Marty Shortjoe
 Perry Yunkaporta
 Leon Yungaporta
 Patrick Koongotena
 and elder spokesperson, Joe Ngallanetta

The dancers spoke about their anguish and outrage in seeing their images used for commercial purposes.

Cairns, 12 September 2000

I returned to Cairns and met with Lani Ashby from the Cape York Land Council.

I also visited Jenuarrie, Indigenous Arts Officer at the Far North Queensland Aboriginal and Torres Strait Islander Unit of Arts Queensland. We discussed general copyright and trade marks issues. I also met briefly with artist Margaret Chatfield.

I met with Sandra Levers of ATSIC who is devising an arts and cultural strategy for Far North Queensland.

I met with Anthony Yagmoor, Financial Controller of Apunipima Health Services in Cairns on 12 September 2000 concerning the arrangement they have with the Photosphere for use of children's photographs on cards. Apunipima provide health services to the Indigenous communities on Cape York.

Thursday Island, 13 September 2000

I traveled to Thursday Island on 13 September and met with Aven Noah of Torres Strait Islander Media Association (TSIMA) and members of the TSIMA Board and staff including Wayne See-Kee, Emphraim Bani and George Dewis. TSIMA has a plan to develop regional protocols for protecting Indigenous Cultural and Intellectual Property and is seeking funding for an officer on staff to ensure proper consent is sought.

I also met with Walter Waia, Executive Officer of the Native Title Office at the Torres Strait Regional Authority; Paul Hayes, Native Title lawyer; Andrew Plate, Economic Development Officer and Peter Anderson, Secretary of the Island Coordinating Council. We spoke about the issues for Torres Strait Islanders; the use of the flag for commercial purposes and future directions in terms of cultural development. Walter is also an accomplished poet and traditional songwriter.

Unfortunately I could not meet up with Sam Pilot, ex-Cultural Arts Officer, as he was on Darnley Island, an outer island and was unable to travel to Thursday Island. We caught up by telephone on my return to Sydney.

Cairns, 15 September 2000

On 15 September 2000, the Cape York Land Council coordinated an open session for copyright and Indigenous arts, in Cairns. Over fifty people attended including Indigenous artist, David Hudson; Gallery owner, Greg Singh; Seth Fourmile, artist and Indigenous lawyer, Noel Pearson.

I met briefly with Robert Williams of Ang-Gnarra Aboriginal Corporation. Ang-Gnarra hosts the Laura Festival. Mr. Williams advised that the local Indigenous community also had some intellectual property issues with the unauthorised commercial use of photographs of Quinkin. The local people of this region are concerned that their sites are being exploited without their overseeing and without any financial returns to them as the owners of the land, and the cultural custodians of the rock art sites.

I also met with artists generally at the session including Indigenous artists Dale Oliver and Wayne Peckham (also executive member of NIAAA). Mr. Oliver recently won a case against a large manufacturer of Aboriginal t-shirts.

On 26 September, I spoke with Michael Winer on the telephone, Indigenous Business Institute for Cape York Partnerships. Cape York Partnerships is an organisation which aims to reduce the welfare dependencies of Aboriginal communities by exploring business opportunities. Michael Winer provided me with information on the Photosphere children cards. Royalties are paid to Apunipima Health Services for the use of Indigenous children's photographs on cards and proper attribution to the communities is given. The photographs were taken at the Laura Festival. This project is mentioned in the "Protection of Dance" Study.

General Consultations

I undertook extensive general consultations for the studies. This included:

- Attendance at the launch of the Collaboration Mark of the Label of Authenticity, launched in association with the Rainbow Serpent at Sydney International Airport - meetings with Ross McLean, Baker & McKenzie.
- Meetings with Michael Frankel, Raena Lea-Shannon and Greg Duffy, lawyers from Michael Frankel and Company. I was employed at Michael Frankel and Company when I acted for the Australian Institute of Aboriginal and Torres Strait Islander Studies in the Rock Art Case and at the time of writing *Our Culture: Our Future* Report.
- On 10 August, I interviewed via telephone Ms Rose Wallis, Coordinator of Walkatjara Arts Centre in Mutitjulu Community, Northern Territory. We spoke about the use of trade marks by Arts Centres generally and copyright issues.
- On 16 August, I spoke to Sam Pilot, ex-Cultural Arts Officer for the Torres Strait. We spoke about use of trade marks and copyright issues generally.
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- On 1 February 2001, I interviewed Kerry Spencer of Photosphere concerning the authorized use of photographs of Indigenous children reproduced on cards where royalties are paid to Apunupima Health Services. She and Debra Plueckhahn, the photographer provided information on the clearance procedures and benefit sharing, for the development of the cards.
- I met with Dr Larrissa Behrendt, Indigenous Australian Lawyer, Australian National University.
- On 8 November, I met with Keven Francis, Executive Director, National Indigenous Arts

- Advocacy Association in Sydney at the NIAAA Offices. I also met with Chris Harrison, Administrator and Keith Brandy, Label of Authenticity Education Officer for NIAAA.
- Leonora Lancaster, Arts Adviser for Aurukun Arts provided assistance with details of cultural clans and dances in the Protection of Indigenous Dance Study.
 - Nancia Guivarra, Producer of Awaye, Aboriginal and Torres Strait Islander arts program for Radio National, Australian Broadcasting Corporation provided some information concerning the Laura Festival 1999.
 - Dr John Von Sturmer - anthropologist, specialising in the Wik Aurukun region, met with me to discuss Wik clans and dance ceremonies.
 - I consulted with Ron Levy, Senior Legal Adviser of the Northern Land Council, concerning the Rock Arts Study.
 - I also met with Dr Linda Barwick, ethnomusicologist, specialising in the recording to traditional Indigenous music.
 - I met with Colin Golvan, barrister on the *Carpets Case*, *Yumbulul v Reserve Bank* and *Bulun Bulun v R & T Textiles*. Colin reviewed the *Carpets Case* study and provided me with Banduk's affidavits. He provided me general comments on copyright and traditional ritual knowledge and the fiduciary duty.
 - I met several times with Dr Vivien Johnson, academic and author of several publications on Copyright and Aboriginal Art. Vivien was the curator for the *Copyrites* exhibition for NIAAA in 1996 and authored the catalogue: *Copyrites: Aboriginal Art in the Age of Reproductive Technologies*. She is also the author of the House of Aboriginality CD Rom and website. The House of Aboriginality is an evolving multimedia project about the rip-offs industry which has arisen to exploit the popularity of Aboriginal art. The website aims to expose rip-offs and generally raise awareness of the issues of copyright and cultural integrity in the commercial application of Indigenous art. Vivien was consulted regarding the Rock Art Study. Vivien also provided feedback on the first draft.
 - I researched old files at the National Indigenous Arts Advocacy Association and met with several members of staff and the board including Phil Hall, Chris Harrison, Keith Hall and Mundara Korrang.
 - I discussed trade marks issues with a number of Indigenous peoples include Lorraine Peeters, Winangali; Will Stubbs, Buku-Larrangay; Michael Mansell, lawyer at Tasmanian Aboriginal Centre and Glen Brennan, Director of the Australian Sports Commission.
 - I contacted Murray Browne, lawyer from Canada, who has worked with First Nations groups in registering their trade marks.
 - I spoke with Wroth Wall, lawyer for the Bandjalang Aboriginal Corporation, concerning their trade mark applications.
 - I met with Ross McLean and Rohan Singh, lawyers from Baker and McKenzie, who drafted the rules of the Label of Authenticity and made the application for NIAAA's certification mark.
 - I participated in several seminar and conference including ATSIC Seminar "Arts for Money's Sake" which provides some findings for the Label of Authenticity study; "Talking: Protecting: Keeping" in Perth, held in November 2000 which provided findings on use of trade marks.
 - I consulted with John Bulun Bulun and Peter Danaja of Maningrida Arts on the first draft of the Bulun Bulun Study.
 - I consulted with Jill McKeough, Dean of University of New South Wales and leading intellectual property lawyer on the Designs Study.
 - Susan Farquhar of External Relations of IP Australia provided feedback on the trade marks, designs and label of authenticity drafts.
 - Victor Portelli, Deputy Registrar, Designs Office provided feedback on the designs study first draft.

- Dr Noel Taylor, Trade Marks Officer, IP Australia provided feedback on the trade marks study.
- Ian McDonald of the Australia Copyright Council provided me with feedback on the first drafts and also met with me to discuss the issues.
- Sally McCausland, SBS, also provided me with feedback on first drafts of the Studies.
- Angelina Hurley, Officer Manager, Terri Janke and Company assisted in editing and compiling the trade marks information.
- Roybnnne Quiggin, solicitor, also provided me with feedback, and assisted with research, re-writing and editing of the final drafts of the study.
- Sonia Cooper, Professional Assistant, Terri Janke and Company who assisting in clearing the rights for the images and trade marks.

To all the above persons and their respective companies and organisations, I am extremely grateful.

Concluding Comments

I would like to express my thanks to Mr. Wend Wendland of WIPO who assisted me greatly in the development of the terms of reference and the focus of the studies. His advice and guidance is greatly appreciated. Thanks also to Mmes Aimee Dunn-Courtial, Susanna Chung and Odile Conti of WIPO, for playing an indispensable role in the smooth running of the administrative aspects of this project from WIPO's side as well as in the final editing, design and formatting of this publication.

I enjoyed working on the project immensely as I am dedicated to the realisation of Indigenous Cultural and Intellectual Property Rights in national and international law and policy. I hope this shines through in the studies.

TERMS OF REFERENCE

The studies should examine and draw conclusions on specific and actual examples in which an indigenous or local community or other custodians of traditional cultural expressions (TCEs) have taken advantage of, or attempted to use, the intellectual property (IP) system to either protect TCEs or to further their own interests in the commercial application and utilization of TCEs. The studies should deal with each example or case separately. In doing so, the studies should as far as possible cover all of the following issues and questions in relation to each example or case:

The TCEs

A brief identification and description of the tradition-based innovation or creation that forms the subject matter of the study: its origin, creation, nature, use and significance within the relevant community. If necessary, a brief identification and explanation of the terminology used by the relevant person or community to describe the subject matter of the study.

A brief description of the TCE custodians, the relevant community, and the social, cultural and ecological context in which they live.

Decision-making and Consent

How was the decision to seek IP protection, initiate IP litigation or commercialize the TCEs (as the case may be) taken? Are the TCEs regarded as "collective"? If so, in what way(s)? Was the collective nature of the TCEs a problem from an IP perspective? How was it resolved? In the case of TCEs held by several TCE custodians or a community, who acted on behalf of the TCE custodians or community? How was this person selected? Were other communities relevant and, if so, were they consulted?

Rights and Remedies

What rights or interests were being infringed, or for which rights or interests was protection sought? Why did the TCE custodian take the IP action concerned, or invoke IP protection, as the case may be? To what extent was the TCE custodian aware of or familiar with the IP system before he/she embarked on the action concerned? What was the understanding of the nature and scope of the IP system before the action commenced?

What is his/her familiarity and understanding now? What other remedies or options (non-legal and legal) were available? Were any other remedies or options pursued in conjunction with the IP action taken?

Customary Law and Regimes

What part did customary law, practices and regimes play at any stage of the actions taken by the TCE custodians?

Benefits

What benefits did the TCE custodian or community initially seek in taking the action? Did the action result in the benefits sought? What role, if any, did IP instruments play in the delivery of these benefits: e.g., contracts enforced in accordance with IP instruments.

Financial Questions

What financial obligations did the action taken by the TCE custodian entail? What forms of financial outlay were involved (e.g., bonds of security, deposits, court costs, stamp duties, summons/application fees (litigation), application costs and renewal fees (industrial property registration), lawyers' fees and disbursements, costs incurred in negotiating license agreements)? How was the money raised? Was legal aid available? Did the financial obligations affect or impede the way in which the case was handled or conducted? If so, in what ways? What are the perceptions of the TCE custodian on this question?

Legal Questions

What form(s) of IP protection were deemed applicable, and why? In what ways was IP protection pursued? Was the attempt to protect the TCEs under IP successful? If so, in what ways? If not, in what ways and why not? Were any legal problems encountered? (e.g., problems with notions of authorship/inventorship, originality/novelty, the limited duration of IPRs)?

What advantages and disadvantages of existing IP principles were encountered by the TCE custodian? What recommendations for change, if any, to IP principles would the TCE custodians and other stakeholders suggest to enhance the usefulness of the IP system in the particular examples concerned?

Operational Questions

How did the TCE custodian(s) obtain legal advice and assistance in bringing this action? How did the TCE custodian engage with the administration of IP at the national level (including the relevant Government departments)? What are the experiences and perceptions of the relevant Government departments? What recommendations for change, if any, to international IP procedural rules would the TCE custodians and other stakeholders suggest to enhance the usefulness of the IP system in the particular examples concerned?

Third Parties

Were the rights or interests of third parties (such as a non-indigenous person or private sector entity) affected by the action taken by the TCE custodian?

Dissemination of TCEs/Promotion of Innovation and Creation

Did the IP protection of the TCEs contribute to the dissemination of the TCE that would otherwise not have been disseminated? Has the TCE protection encouraged the TCE custodian to innovate and create further? If the IP system was unsuccessful in protecting the TCEs, has this caused the TCE custodian not to disclose the TCEs, or discouraged further innovation and creation? Are disclosure, dissemination and promotion of TCEs relevant objectives for TCE custodians?

Commercialization of the TCEs

If one of the aims was to commercialize the TCEs, was this achieved, and if so, what role did IP protection play therein?

Expected Results

What were the expectations of the TCE custodian before taking the action? Have the expectations been met? If so, in what ways? If not, why not?

Enforcement of Rights

Where applicable, have the TCE custodians had to enforce IP rights in their TCEs? How have they done so? What were their experiences, and what are the lessons learned?

Conclusions

Generally, were difficulties and successes experienced in applying the IP system to TCEs, what lessons were learned and to what extent were divergences perceived between identified needs of TCE custodian and the protection provided by the existing IP system?

In the examples studied, what forms of the TCEs were not protected by IP?

What are the perspectives of the relevant Government departments on the particular examples studied? What are the consultant's conclusions on the examples studied?

BIOGRAPHY OF AUTHOR



Photo: Amanda James

Terri Janke is the Solicitor Director of Terri Janke & Company Pty Ltd, a law firm based in Sydney, Australia. The firm's charter is to advance the protection of Indigenous Australian people in respect of intellectual and cultural property matters. The firm represents Indigenous artists, cultural organisations, writers, musicians, filmmakers, broadcasting organisations, and others across many fields of the arts and cultural practice.

Terri is a graduate of the University of New South Wales from which she holds a Bachelor of Laws Degree and a Bachelor of Arts Degree. Terri is admitted as a Legal Practitioner of the Supreme Court of New South Wales and the High Court of Australia. Terri is also the Treasurer of Ngalya Indigenous Lawyers Association.

Terri is the author of ***Our Culture: Our Future: A Report on Australian Indigenous Cultural and Intellectual Property Rights***. This report was the result of a consultation project she undertook in 1997 – 1999, under commission by the Australian Institute of Aboriginal and Torres Strait Islander Studies and the Aboriginal and Torres Strait Islander Commission.

Terri has also written many papers and presented widely on issues relating to Indigenous cultural and intellectual property including a series of artform protocols guides for the Australia Council for the Arts, on the production of Indigenous performing arts, new media, writing, song and visual arts.

Terri is a descendant of the Meriam people of the Torres Strait Islands and has family connections in the Cape York region. She was born in Cairns, Queensland and lives in Sydney.

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