

GAP Analysis on the Protection of Traditional Cultural Expressions/Expressions of Folklore

Comments of the United States of America

GENERAL

At the twelfth session of the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (the “IGC” or the “Committee”), the members of the Committee requested the Secretariat to prepare a working document describing existing obligations, provisions and possibilities at the international level for the protection of Traditional Cultural Expressions/Expressions of Folklore (TCEs/EoF), identifying “gaps,” if any, in the international framework, and related considerations, and describing options to address any identified gaps.

In response to this request, the Secretariat has produced a useful working document that will help to facilitate the work of the Committee. Over the last several sessions, the United States and many other delegations have stressed the importance of focusing the Committee’s attention on concrete, achievable outcomes to address specific issues and concerns related to the protection of TCEs/EoF. By cataloguing and describing existing legal and other options for the protection of TCEs/EoF, the Secretariat will help to accelerate the Committee’s work. Consistent with the request of the IGC, this document is largely descriptive in nature, appropriately drawing on information in other IGC documents. In the view of the United States, gathering and organizing this relevant information in a single place itself will facilitate deliberations within the IGC.

With the goal of the document clearly confined, the objective of these comments is similarly circumscribed. First, these preliminary comments offer recommendations on how certain information provided by the Secretariat for the use of the Committee might be stated with greater clarity, precision, and/or balance. Second, these comments highlight options that, on preliminary basis, appear to merit the close attention of the Committee. The difficult task of substantively evaluating the identified gaps in the international framework, along with the options to address those gaps and related policy issues, must take place in the course of the Committee’s deliberations.

Looking ahead, much work remains to be done. First, in the view of the United States, the Committee will need to closely examine each identified gap, with a view toward reaching an enhanced mutual understanding of these unmet needs. As this analysis correctly points out, a consensus has yet to emerge within the IGC on these important issues. Second, the IGC will need to match the identified gap more closely with the options to address it. The United States continues to believe that this aspect of our deliberations will be enriched significantly by the exchange of national experiences. Third, the Committee will need to explore in greater depth the specific options and

related policy considerations briefly discussed in this document. Finally, mindful of the need to accelerate our work, the Committee will need to prioritize discussion of those options that hold the greatest promise of delivering concrete outcomes or otherwise significantly advancing the work of the Committee.

SPECIFIC

WORKING DEFINITIONS OF TCEs

Defining Traditional Cultural Expressions

Paragraphs 5-6. In paragraph 5, the document usefully points out there is “no internationally settled or accepted definition” of TCEs and that defining the subject matter of protection of TCEs “has long been one of the most fundamental challenges associated with the protection of TCEs.” The Secretariat helpfully notes that defining the subject matter of protection of TCEs will help to determine the applicability of IP protection for TCEs.

Characteristics of TCEs

Paragraphs 7-9. In paragraph 8, the Secretariat accurately observes that traditional creativity may range in age from the distant past to the contemporary period. However, the use of the somewhat awkward phrase “truly old,” in the view of the United States, may raise more questions than it answers. Accordingly, in the second sentence of paragraph 5, the Secretariat should substitute the following language: “First, TCEs may consist of pre-existing materials dating from the distant past that were once developed by “authors unknown” through”

In paragraphs 7-9, the concept of community-oriented creativity appears to focus on the creative expressions of relatively narrowly defined traditional cultures. The difficulty is that the word “community” often is used to refer to expressive materials produced by groups other than traditional communities (for example, works produced by a religious group). To clarify the narrow scope of the intended usage, the United States recommends that the modifier “traditional” be inserted before “community” in paragraph 9 (and elsewhere in the document as appropriate).

Forms of TCEs

Paragraphs 10-14 discuss the broad range of forms of TCEs (tangible, intangible, and mixed forms). Within this universe, the Secretariat usefully takes a “focused and concrete” approach in its analysis, seeking to identify specific types of TCEs that may have been used in ways that raise specific issues and concerns for traditional communities. The United States believes that such a pragmatic approach will accelerate the work of the Committee.

Meaning of Protection

Paragraphs 15-18. In paragraph 15, the Secretariat interprets the meaning of the term “protection” in the February 2008 IGC decision as confined to “protection in an IP sense.” For the purpose of this analytical exercise, the United States believes that the interpretation of the IGC decision is reasonable because the Committee requested analysis of the “obligations, provisions, and possibilities” for the protection of folklore at the international level.

At the same time, for reasons discussed more fully below, the United States believes that a broad range of other considerations (legal and non-legal) remain highly relevant to the work of the Committee, including the threshold determination of whether there is an unmet social, cultural or economic need, and, if so, whether such a need is best addressed through the IP system, some other option(s), or at all.

Protection, Preservation and Promotion

In paragraph 22, the United States notes the distinction made between “protection” (legal protection) and “preservation” (or “safeguarding”) and “promotion” (primarily referring to the identification, documentation, transmission, revitalization and promotion of cultural heritage). For the purpose of advancing the understanding of the Committee of “obligations, provisions, and possibilities” for the protection of folklore at the international level, as discussed above, the United States views the distinction as helpful for this exercise.

The United States nonetheless believes that it should be left to Member States, in the end, to address the specific, identified unmet need, using the most appropriate policy option. Providing “legal protection” through national legislation, for example, would make little sense if the actual threat to the TCE at issue is preservation-related (such as inability or lack of capacity of a community to transmit the TCE), possibly leading national policy-makers to over-protect the TCE (in the legal sense) and under-protect it (in the preservation sense).

Consistent with such a comprehensive approach, the United States notes with approval the acknowledgement in this document that preservation and promotion play a “valuable and complementary” role in protecting TCEs. The analysis also usefully points out that national policy-makers may address needs that are not met within an IP framework through cultural heritage preservation laws, among other non-IP laws (paragraph 35); lists a broad range of public policy issues (including the safeguarding and preservation of cultural heritage) (paragraph 76) that bear on the protection of TCEs; and notes the option of States to provide IP-like protection for TCE subject matter in cultural heritage laws (paragraph 80).

With these considerations in mind, and to more precisely state the boundaries for this exercise set by the IGC, the second sentence in paragraph 22 should be revised as follows: “While instruments and programs for the preservation and promotion of TCEs

as such are valuable and complement the protection of TCEs, consistent with the February 2008 decision of the IGC, the focus of this analysis is on the legal protection of TCEs.”

With a similar goal, paragraph 24 should be revised as follows: “To provide this analysis with an appropriately specific focus, and in line with the IGC’s decision of February 2008, it is proposed that the immediate focus of this analysis be on those objectives that are specifically related to the IP protection of TCEs.” Finally, the United States believes that the difficult task of evaluating these legal options, and the even more daunting challenge of resolving the differences in the underlying policies, must take place during the course of the IGC’s deliberations.

Objectives in relation to the protection of TCEs

Paragraphs 23-25, 71 note various sources that have been cited to identify the diverse policy objectives for the protection of TCEs, including documents produced by the IGC. Of these, in view of the United States, the United Nations Declaration on the Rights of Indigenous Peoples expresses the aspirations of certain indigenous peoples. Nonetheless, to clarify the nature of this source, the United States recommends the third sentence be rephrased as follows: “The United Nations Declaration on the Rights of Indigenous Peoples has been cited as a source that reflects the aspirations of indigenous peoples.” Similarly, in paragraph 71 (which discusses the legal and policy environment for the protection of TCEs), the third sentence should be revised as follows: “The protection of TCEs is also under discussion in certain human rights and indigenous issues forums, and the United Nations Declaration on the Rights of Indigenous Peoples offers language on the protection of TCEs.”

Specific forms of protection for TCEs

Paragraphs 26-29. Drawing on earlier IGC documents, this section sets forth a catalogue of issues and concerns that have been raised regarding the protection of TCEs (paragraph 27) and suggests the value of closely matching forms of protection with specific identified concerns.

The meaning of “gaps”

Paragraphs 30-33. Paragraph 31 usefully notes that the concept of a “gap” implies an “unmet economic, cultural or social need.” Consistent with this definition, the United States believes national experiences should continue to inform the IGC’s deliberations wherever possible. Paragraph 31 appropriately points out that identifying such unmet needs, and whether they should be filled, is a “matter for decision by Member States.”

Gaps not directly addressed

Paragraphs 34-38 canvas a variety of meanings of gap that fall outside the scope of this analysis. In paragraph 34, while acknowledging the “profound conceptual”

differences in the perspectives of indigenous peoples and those that inform the conventional IP system, the Secretariat helpfully notes that this analysis cannot address, much less bridge, such fundamental conceptual divides. In the last sentence of paragraph 34, it would be useful to insert the word “dynamic” before “rules” to militate against any misleading inference that indigenous normative systems are themselves static.

Paragraphs 36-37 discuss two additional “gaps” in protection that are not directly addressed in this analysis: “operational” gaps (such as the inability to meet a need because of the lack access to legal advice or inadequate financial resources) and “ownership” gaps (resulting from the inherent difficulty of establishing ownership claims in “shared TCEs” that overlap traditional communities or national boundaries). Although the United States believes that limiting the scope of this analysis will help the Committee to focus on concrete outcomes, we also note that IGC participants will need to return to the very complex and important issue of ownership of TCEs. The United States also notes that a discussion of issues related to the capacity of Member States to use existing IP tools to protect TCEs may lead to concrete outcomes.

In paragraph 38, the Secretariat briefly discusses “gaps inherent in the IP system” (such as those arising from the operation of exceptions and limitations). In the view of the United States, the discussion of the inherent limitations of IP systems is useful but incomplete. In particular, paragraph 38 should also take into account policy considerations that establish the boundaries of IP systems, including policies relevant to determining the scope of protectible subject matter. Accordingly, the United States recommends adding the following new third and fourth sentences in paragraph 38: “The boundaries of IP systems, which include decisions about the scope of protectible subject, often reflect important policy considerations such as freedom of expression and the protection of the public domain. For a discussion of such policy considerations, *see also* paragraph 76.”

ANALYSIS

Literary and Artistic Works

Existing Protection

Paragraphs 40-43 usefully canvas existing international obligations, provisions, and possibilities that are or may be related to the protection of literary and artistic TCEs, including the “originality” requirement; the Berne provision for the protection of unknown authors (Article 15.4), copyright protection for collections and compilations of TCEs; economic and moral rights; fixation; and protection for recordings and documentation of TCEs.

The discussion of existing protection, in the view of the United States, is largely balanced. However, the United States notes that the limited discussion of the function of ethnographic recording (as noted in the last sentence of paragraph 43(a)) and the role of recording and documentation in scholarly research (as noted in paragraph 45(g)) may

have the unintended consequence of overstating the possible tension between indigenous groups and preservation professionals. To address this concern, at least in part, the Secretariat may wish to cross-reference the development of modern codes of ethics in the preservation field, which are discussed in paragraph 99.

Identified Gaps

Paragraphs 55-56 provide a helpful overview of possible gaps in the protection of literary and artistic TCEs, including the originality of pre-existing works; the lack of protection for “style” under copyright law; the inability to identify specific author(s) for communally produced works; copyright’s term of protection limitation; copyright exceptions and limitations applicable to TCEs; the copyright status of works adapted from TCEs in the public domain; and ownership issues related to recordings and documentation of TCEs.

The United States notes that many of the IP doctrines described above, including copyright’s originality requirement, limited term of protection, and maintaining a robust public domain, are based on fundamental policies and values, which the United States shares with many other countries. These paragraphs illustrate the tension between such fundamental doctrines and the aspirations of traditional communities to obtain legal protection for TCEs. As IGC participants evaluate specific options, the underlying difficulty of reconciling such differences should not be underestimated.

Options

Paragraphs 82-103 set forth a rich list of options for addressing possible gaps in the protection of literary and artistic TCEs, including the judicial recognition of communal rights on the basis of equity; communal moral rights; clarification of the scope of Article 15.4 of the Berne Convention; *domaine public payant*; orphan works; resale royalty right; the use of unfair competition principles to protect stylistic elements of TCEs; derivative works based on TCEs; protocols, codes of conduct, contracts and other practical tools; registers and databases; and collective management.

The United States believes that this menu of options should be extremely useful in assisting IGC participants to identify practical solutions to addressing issues and concerns related to the protection of TCEs. However, mindful of the need to accelerate our work, as noted above, Committee members will need to prioritize discussion of those options that hold the greatest promise of delivering concrete outcomes or otherwise significantly advance the work of the Committee.

Of these options, the United States believes that it would be very useful IGC to clarify and discuss the use of protocols, codes of conduct, contracts and other practical tools for the protection of TCEs (briefly discussed in paragraphs 99-100), including capacity-building aimed at strengthening the ability of traditional communities to use these tools to address their specific issues and concerns related to the protection of TCEs.

Paragraphs 90-91 discuss the possible usefulness of drawing on concepts from the current public policy discussion on “orphan works” to enrich the discussion in the IGC on the protection of TCEs. At this time, the United States does not have a specific comment on the merit of the proposal. However, we wish to point out the approach taken in orphan works legislation currently under consideration by the U.S. Congress follows a “limitations of remedies” approach, rather than a compulsory licensing approach, which may be suggested in paragraph 91. To address this issue, we suggest deleting the word “similar” before “legislation” in the second sentence of paragraph 91 and inserting the words “orphan works.”

Paragraph 94 lays out a range of possible options to protect the reputational interest associated with the TCEs (typically embodied in the “style” of the traditional object), including the use of certification marks; truth in advertising and labeling laws; geographical indications; and unfair competition or trade practices law.

Of these, the United States believes that deeper Committee engagement on the use of unfair competition or trade practices law to protect the reputational interest associated with TCEs holds the promise of advancing our work. The United States also supports additional Committee work on the use of certification marks and truth in advertising and labeling laws to protect this aspect of TCEs. Without prejudice to the merits of the option, the United States does not support further work on geographical indications within the IGC at this time.

Performances of TCEs

Existing Protection

Paragraphs 44-50 set forth a useful inventory of the existing international obligations, provisions, and possibilities that are or may be related to the protection of the performances of TCEs, including protection already available under the 1996 WIPO Performances and Phonograms Treaty (WPPT); protection for traditional designs and contemporary adaptations of traditional designs, and potential protection for secret TCEs under common law and unfair competition law.

Identified Gaps

Paragraphs 57-58 identify possible gaps in the protection of performances of TCEs under international related rights norms, including the limited term of protection for performances fixed in a sound recording and the limitation of protection under the WPPT to aural performances.

Options

Paragraphs 104 identifies a number of options for addressing possible gaps in protection of performances of TCEs, including the use of protocols, codes of conduct,

contracts and other practical tools; special stand-alone laws; and the extension of the WPPT to include protection for audiovisual performances of expressions of folklore.

Of these, the United States believes it would be beneficial to clarify and discuss the use of protocols, codes of conduct, contracts and other practical tools for the protection of performances of TCEs, including capacity-building aimed at strengthening the ability of traditional communities to use these tools to address their specific issues and concerns related to the protection of TCEs.

The United States also believes it would be valuable for the Secretariat to further clarify and for IGC participants to discuss WPPT Article 7 and other provisions that are relevant to the protection of expressions of folklore, along with any identified gaps in such protection. Building on this foundation, IGC participants may wish to exchange information based on their recent national experiences in implementing WPPT Article 7 and other relevant provisions.

Designs

Existing Protection

Paragraphs 47 notes that industrial design protection may be available for contemporary adaptations of traditional designs.

Identified Gaps

Paragraph 59 discusses a number of possible gaps in the framework for the protection of traditional designs and their contemporary adaptations, including the fact that pre-existing traditional designs are not protected, the shorter term of protection for designs, and the requirement to comply with formalities to secure protection.

Options

Paragraphs 94, 98, and 104 usefully identify a number of options for protecting reputational interests in traditional designs and contemporary adaptations of traditional designs, including the use of certification marks; truth-in-advertising and labeling laws; geographical indications; and unfair competition or trade practices law. The analysis also notes that collections, compilations, and databases provide some protection for traditional designs and their contemporary adaptations. Practical tools such as protocols, codes of conduct, and contracts also are available for immediate protection.

The United States notes that providing protection for traditional designs, which may be embodied in handicrafts and other creative arts, and contemporary adaptations of such designs, implicate a range of important IP policy considerations, including maintaining robust public domain. The United States believes that such policy considerations play, as generally noted at paragraph 73, an important role in identifying

“gaps” in design protection in the first instance and in discussing options, if any, to address such gaps.

With such considerations in mind, the United States nonetheless believes that it would be useful to deepen the understanding of the Committee of how the principles of unfair competition law may be used to protect elements of traditional designs. The United States also believes that a presentation by the Secretariat and discussion by IGC participants of practical tools for the protection of designs (such as protocols, codes of conduct, and contracts) would be beneficial.

Secret TCEs

Existing Protection

Paragraphs 48-50 usefully canvas existing protection for sacred TCEs at the international level, including the availability in some jurisdictions of common law protection for information conveyed in confidence and international norms of unfair competition.

In paragraphs 48-49, the Australian case of *Foster vs. Mountford* is discussed to illustrate the proposition that the publication of information of great religious or cultural significance that is disclosed to researchers in good faith and in confidence may constitute an actionable “breach of confidence.” Additional references to the case are made in paragraphs 61, 63, and 106.

The discussion of *Foster v. Mountford* accurately states that injunctive relief may be available to indigenous groups as a remedy for the disclosure of secret TCEs under certain circumstances in some jurisdictions. However, the United States observes that the facts of the case also touch on important countervailing policy considerations, including freedom of expression. The United States also notes that modern ethical codes governing the recording of TCEs, which are pertinent to the facts in *Foster*, have been adopted to avoid such cultural harms in the first instance.

Viewed in this way, the extensive discussion of the case may have the unintended effect of overstating the tension between indigenous groups and scholars and understating the importance of related policy considerations. To help to strike the appropriate balance, paragraph 48 might be revised as follows:

In the Australian case *Foster vs. Mountford* (1976) 29 FLR 233, for example, an indigenous community in Australia was able to enjoin the publication of images and information about sacred sites, objects and other TCEs which were of deep religious and cultural significance to the group and which were disclosed to an anthropologist in good faith and in confidence. For a discussion of related, important policy considerations, *see* paragraph 76, and for a discussion of related modern codes of conduct pertinent to recordings and documentation of sacred TCEs, *see* paragraph 99 of this document.

Identified Gaps

Paragraphs 61-63 usefully note that Article 39 of the TRIPs Agreement and Article 10*bis* of the Paris Convention could provide a framework for protecting secret TCEs under circumstances. However, the document identifies a number of possible gaps in the international framework, including that unfair competition legal doctrines have been applied principally in commercial settings.

Options

Paragraph 106 identifies a number of options to protect sacred TCEs, including promissory estoppel; protocols, codes of conduct, contracts and other practical tools; and registers and databases. Of these, as discussed more fully below, the United States believes that it would be beneficial for the Committee to deepen its understanding of the use of protocols, codes of conduct, contracts and other practical tools, and registers and databases to protect sacred TCEs.

The United States notes that providing protection for secret TCEs implicates a range of important policy considerations, including freedom of expression, respect for the rights and interests and claims of indigenous and other traditional communities, and the recognition of customary laws (noted, among others, in paragraph 76). Discussion of policy issues of such wide cultural and social importance, in the view of the United States, at once have an important claim on the attention of the Committee but also press the limits of the Committee to craft solutions within the IP system.

With such considerations in mind, the United States nonetheless believes that it would be useful to deepen the understanding of the Committee on the use of registers, inventories, and databases for documentation while ensuring confidentiality and secrecy of the most culturally sensitive information (as noted in paragraph 102). Likewise, updated information on the use of protocols, codes of conduct, contracts and other practical tools to address the special concerns of protecting secret TCEs would be extremely beneficial.

Indigenous and traditional names, words and symbols

Existing Protection

Paragraphs 51-54 canvas the possible use of applicable principles and doctrines in unfair competition and trademark law to protect indigenous names, words and symbols with respect to both uses from outside the traditional community (“defensive protection”) and inside the community (“positive protection”).

Identified Gaps

Paragraphs 64-66 note that the trademark concepts of “contrary to morality” and “contrary to public order” are not necessarily tailored to address issues and concerns of the traditional community related to the use indigenous names, words and symbols outside of the community. The United States believes that role of trademark offices in making determinations under these standards, and the concept of the public in trademark law, should be stated with greater clarity. In particular, the United States recommends that paragraph 65 be revised as follows:

Although this protection seems generally adequate, a “gap” may exist in that the concepts of “contrary to morality” and “contrary to public order” are broad concepts that are implemented under national laws, regulations, and case law, which establish the applicable standards of public morality or public deception in a particular country. These standards, as applied to trademark applications, differ significantly across national laws, as does the concept of the public against which deception or offensiveness is measured.

Options

Paragraph 107 reprises options for the protection of indigenous names, words and symbols, including “sui generis” provisions in national trademark laws (which may be implemented through regional organizations); protocols, codes of conduct, contracts and other practical tools; special stand-alone laws; and registers and databases. Of these, the United States believes that it would be beneficial for IGC to undertake further work on the use of protocols, codes of conduct, contracts and other practical tools, and registers and databases to protect indigenous names, words and symbols.