

UNIVERSITY OF CAPE TOWN
FACULTY OF LAW
SCHOOL FOR ADVANCED LEGAL STUDIES
AN ANALYSIS OF THE REGISTRATION OF
TRADITIONAL PRODUCT NAMES, TERMS, SYMBOLS
AND OTHER CULTURAL EXPRESSIONS AS
TRADEMARKS IN NAMIBIA

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LIST OF ABBREVIATIONS

TK	Traditional Knowledge
TCE	Traditional Cultural expressions
TRIPS	The Agreement on Trade-Related Aspects of Intellectual Property Rights
WIPO	World Intellectual Property Organisation
ARIPO	Africa Regional Intellectual Property Organisation
IGC	Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore
IPR	Intellectual Property Rights
GI	Geographical Indication
IP	Intellectual Property
IPLAA	Intellectual Property Laws Amendment Act (South Africa)

CHAPTER 1: INTRODUCTION

1.1 Background of the Study

Protection of traditional knowledge¹ and traditional cultural expressions² of indigenous communities is one of the most contentious and complicated issues on both international and national agendas. The historical development of the protection of intellectual property³ in the wake of the industrial revolution and its subsequent jurisprudential justification, based on private property rights, pushed TK and the practice based on it, outside the purview of the formal intellectual protection regime.⁴

There is substantial evidence that TK has in past decades been used in a range of industries and has accordingly led to new products as well as the development of existing products. Evidence of this can be found in the areas of special foods and beverages, the cosmetic sector, personal care, agriculture, horticulture and pharmaceuticals.⁵ Industries sometimes make use of this knowledge to formulate new products, which they do in a slightly different manner so as to market the products as their own.

Currently, there are certain products in Namibia that use the traditional terms of products as trademarks. Despite the fact that some of these terms are not registered with the Ministry of Trade and Industries, these owners enjoy common law protection under trademark law. This is especially so for well-known products such as *Omaere* milk, which is a product of the Namibia Dairies (Pty) Ltd. The term *Omaere* is used by the OvaHerero and OvaHimba speaking communities of Namibia and Botswana to refer to traditionally processed curdled milk. The Namibian Dairies (Pty) Ltd has been making use of this name for one of their curdled milk products for more than 15 years.

¹ Hereinafter referred to as TK.

² Hereinafter referred to as TCE.

³ Hereinafter referred to as IP.

⁴ Tripathi "Traditional knowledge: Its significance and implications" in *Indian Journal of Traditional Knowledge* 99.

⁵ Laird & Wynberg 'Access and Benefits-Sharing in Practice: Trends in Partnerships Across Sectors' 8.

During this period the company has done such excessive marketing of the product that this name has come to be regarded as their trademark. Reviewing it from this perspective, one can conclude that no-one else could use this name to refer to their milk products, as it has come to be considered as a product of the Namibia Dairies.⁶

This dissertation thus aims to investigate whether traditional product names, terms, symbols and other cultural expressions can be used as trademarks under the Namibian legal system. In making this determination the dissertation will critically analyse the previous Namibian trademark laws and the Industrial Properties Act 1 of 2012. To this end this dissertation seeks to investigate whether the relevant trademark provisions necessarily prohibits the registration of traditional product names, terms, symbols and other cultural expressions as trademarks and provides recommendations for the protection of indigenous communities against the misappropriation of these TCEs. In addition, the dissertation will analyse the different options available for the protection of TK and TCE. This will be done by studying the system that was adapted under the Swakopmund Protocol on the Protection of Traditional Knowledge and Expressions of Folklore⁷ as well as the system under the South African Intellectual Property Laws Amendment Act No 28 of 2013.

1.2 Rationale for the Study

Protection of TK and TCE is necessary to prevent the erosion and disappearance of traditional methods of doing things and of the traditions themselves.⁸ The World Intellectual Property Organisation (WIPO) Report on Fact-finding Missions acknowledges that for most of the countries that were under review in Southern Africa, the protection of TK is seen as a means of preventing unauthorised exploitation.⁹ However, this is not all. Other

⁶ Andima T (26 April 2013) Namibia: Protecting Your Intellectual Property <http://allafrica.com/stories/201304260909.html?viewall=1> [Accessed 5 April 2014].

⁷ Adopted by the Africa Regional Intellectual Property Organisation (ARIPO) 2010.

⁸ WIPO *Report on Fact-finding Missions on Intellectual Property and Traditional Knowledge* 86.

⁹ *Ibid.*

objectives include protection from misappropriation, stimulation and promotion of innovation and creativity based on TK and TCE. Therefore, the purpose of trademark law protection with regard to TCE is to authenticate that the product is from a particular traditional community and that it is prepared in a similar manner to how it is prepared by that particular traditional community. In addition it will also prevent third parties from misappropriating TCE from the indigenous communities. Due to the scope of this dissertation, the research has been confined almost exclusively to the protection of TCE through trademarks.

1.3 Focal research questions

1. Are traditional product names, terms, symbols and other cultural expressions of indigenous communities in Namibia prohibited from registration as trademarks?
2. How can traditional product names, terms, symbols and other cultural expressions of the indigenous communities be protected under the Namibian Trademark laws?

1.4 Methodology

The methodology that was used in this study was mainly desktop-based. Furthermore, library, internet sources, documented cases and previous minutes from WIPO documents were also analysed. An extensive review of books and articles was undertaken in order to capture the views of some of the commentators and authors on the subject under review. Overall, the chief research tools were books, reports and journal articles.

1.5 Chapter outline

Chapter 1

This chapter chiefly dealt with the background of the study, rationale, methodology and chapter outline.

Chapter 2

This Chapter investigates the historical development of trademark laws in Namibia and also the development of 'foreign words' as trademarks. The chapter also looked at why there is a need for trademark protection

Chapter 3

This Chapter investigates the requirements of trademarks registration under the Industrial Properties Act 1 of 2012 of Namibia and the applicability of these to traditional products. It further analyses whether it is possible for traditional product names, terms, symbols and other cultural expressions to be registered under the current trademark laws in Namibia. The chapter has additionally investigated the applicability of the common law to those products that already use TCE.

Chapter 4

This chapter investigates the different approaches available for the protection of TCE under trademark law. It specifically studies the approach under the Swakopmund Protocol on the Protection of Traditional Knowledge and Expressions of Folklore and the Intellectual Property Laws Amendment Act No 28 of 2013 of South Africa. The main purpose of the study of the different systems is to ascertain the possible system Namibia can adopt.

Chapter 5

This chapter concludes the study and makes the necessary recommendations based on the findings of the paper.

CHAPTER 2: HISTORICAL DEVELOPMENT OF TRADEMARK LAWS IN NAMIBIA

2.1 Background

The law relating to trademarks in Namibia has its origin in both common law and statutes. The Namibian trademark legislation, in similarity to South African legislation, has largely been derived from the British statutes. In Britain, the necessity for trademark legislation arose in the 18th century due to inadequacies of the common law to regulate trademarks at the time.¹⁰ An example of these inadequacies is the right to property in trademark, which was an adjunct of, and inseparable from, the goodwill of the business. This could only be acquired by the adaption and public use of the trademark as such.¹¹ This was a long and expensive process because it meant that in any action brought by a proprietor, the proprietor had to prove the title to the mark afresh by adducing evidence of use and the reputation acquired thereby through previous use.¹²

Inadequacies such as these eventually led to the passing of the Trade Mark Registration Act of 1875. This Act made provision for the formal registration of trademarks in respect of goods and established that such registration comprised *prima facie* proof of the proprietor's right to the exclusive use of the mark in relation to the goods in respect of which they were registered.¹³ The Act placed limitations upon the type of mark to which the benefits of registration would be extended and sought to exclude therefrom, marks that were not considered fit subject matter for monopolistic rights.¹⁴ In addition the Act also made it a condition for registration of trademark before bringing an action for infringement.¹⁵ It provided that, for a trademark to be registrable, it had to consist of defined essential particulars

¹⁰ Webster & Page *South African Law of Trademark 2*.

¹¹ For a discussion of these inadequacies see Webster and Page *South African Law of Trademark 2*.

¹² *Ibid.*

¹³ Section 3 of Trade Mark Registration Act of 1875.

¹⁴ Section 6.

¹⁵ Section 1.

to which other matters could be added.¹⁶ These particulars were the name of an individual represented in a particular or distinctive manner, the signature of the individual or firm; or any distinctive device, mark, heading, label or ticket.¹⁷

The 1875 Act was repealed by the Patents, Designs and Trade Marks Act, 1883. This Act substantially re-enacted its provisions, but added to the list of essential particulars of a mark 'a fancy word or fancy words not in common use.'¹⁸ This formulation gave rise to difficulties and was substituted in the 1888 Act by the phrase 'an invented word or invented words, or a word having no reference to the character or quality of the goods, and not being a geographical name.'¹⁹

The Trademark Act of 1905 repealed the earlier legislation and introduced, in place of essential particulars, a general category of 'any other distinctive mark'.²⁰ This Act, for the first time in trademark legislation defined a 'trademark', included in this definition not only marks that are already in use but also marks 'proposed to be used'.²¹ This completed the process of extending the possibility of registration to marks not yet in use, so that proprietors could be assured of the protection of the statute for their marks before incurring the expense of commencing use.²²

The Act also stated that not all trademarks are registrable and that only some marks are registrable. For words as marks, the Act provided that only words that have no direct reference to the character or quality of the goods and words that are not according to their ordinary signification of a geographical name or surname, can be registered.²³ Up until this point in the British law, none of the trademark legislations has ever made provision for, or made mention of, traditional products or protection of TCE under trademark

¹⁶ Section 10.

¹⁷ Ibid.

¹⁸ Section 64.

¹⁹ Section(s) 64(1)(d) & (d)

²⁰ Section 64(3) of the Patents, Designs and Trade Marks Act, 1883.

²¹ Trade Mark Act 1905, section 3.

²² Webster & Page *South African Law of Trademark* 3.

²³ Trademarks Act of 1905, section 9.

law. This is because during that period it was not deemed pertinent to protect TK and TCE under trademark law.

2.2 Trademark Legislation in Namibia

Shortly after the creation of machinery for registration of trademarks in Britain in 1875, similar enactments were passed in the colonies including the Republic of South Africa.²⁴ One such important Act was the Patent, Designs, Trademarks and Copyright Act 9 of 1916 of South Africa, of which sections 96-140 are specifically related to trademarks. These provisions were based on the 1905 British Act. Section 13 of the Patents, Designs, Trade Marks and Copyright Proclamation 17 of 1923 originally made the provisions of this Act relating to trademarks applicable to the then South West Africa (now Namibia). The 1916 Act established a Trade Mark office to keep a register of trademarks. Even though Namibia was at the time administered by South Africa, it maintained an independent trademark register.²⁵

The portions of the Designs, Trademarks and Copyright Act were subsequently replaced by the Trademarks Act 62 of 1963 in South Africa, and by the Trade Marks in South West Africa Act 48 of 1973 in South West Africa. The Trade Marks in South West Africa Act²⁶ was the governing law of trademarks in Namibia until 2012, when parliament passed the Industrial Property Act 1 of 2012, which is the main statute that governs trademarks. Among others, the Act provides for the registration, protection and administration of industrial trademarks, certificate marks and trade names.²⁷ The Industrial Property Act also repealed in its entirety all the legislation that previously governed trademark law in Namibia.²⁸

²⁴ At that time Namibia, or South West Africa back then, was included in the territory of the Cape Province.

²⁵ John & Kernick *South Africa: trade marks & names* ix.

²⁶ Trade Marks in South West Africa Act 48 of 1973.

²⁷ Chapter 4 of the Act.

²⁸ The Patents, Designs, Trade Marks and Copyright Act of 1916 and any amendments thereto insofar as they were applicable to Namibia; the Patents, Designs and Trade Marks Proclamation of 1923; The Patents, Trade Marks and Copyright Proclamation of 1940 and the Trade Marks in South West Africa Act No. 48 of 1973.

2.3 *The need for trademark protection*

The general principle of trademark law can be summed up in the quote of Lewis Sebastian,²⁹ who in as early as 1878 wrote that:

'...a man is not to sell his own goods under the pretence that they are the goods of another man; he cannot be permitted to practice such a deception nor to use the means which contribute to that end. He cannot therefore be allowed to use names, marks, letters or other *incidicia* by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person.'³⁰

The function of trademarks is to give the purchaser a satisfactory assurance of the make and quality of the article he is buying.³¹ Because of the mark on the particular article, the purchaser will act on the faith of the mark being genuine and representing a quality which he/she has found on previous accessions a similar mark to indicate.³² It is after and on these considerations that the purchaser purchases the product.

It can be deduced from the above that the main functions of trademarks are:

- 1) to distinguish the goods or services of one trader from those of his / her competitors;
- 2) to guarantee the quality of goods or service; and
- 3) to assist in the advertising of the goods or services.³³

The protection of trademarks is beneficial to the public, since it enables them to make purchases with the confidence that they are getting the product that they require. At the same time, trademarks are also beneficial to the traders or manufacturers since they afford them the means of securing the benefits of custom that they deserve and which is intended for them.³⁴

Sebastian³⁵ states that although the object of a trademark is to indicate quality, a mere English adjective or a word in common use, which indicates quality and nothing more (not serving to connect the goods with any

²⁹ Sebastian *Law of Trademarks* 1.

³⁰ Ibid.

³¹ Ibid.

³² Ibid.

³³ Gerntholtz *A basic guide to the Law of Trademarks* 3.

³⁴ Sebastian *Law of Trademarks* 4.

³⁵ Sebastian *Law of Trademarks* 2.

particular manufacturer or seller) cannot be appropriate as a trademark.³⁶ The reason for this is that no person can be permitted to exclude others from the use of words common to all. However, marks that do serve to indicate the production of certain manufacturers, though at the same time subject to variation for purposes of denoting different qualities, are entitled to protection.³⁷

2.4 *The development of words as trademarks in Law*

Under the British Act of 1875, new marks consisting solely of words were not registrable. Even though composite marks comprising of words and other elements such as signature or devices were admissible, there was no statutory protection for word-marks, consequently word-marks were regulated by common law and in equity.³⁸ No English trademark statute has ever made specific provisions for marks in languages other than the English. Nevertheless, according to Gredley, long before the 1875 Act, owners of marks containing terms in foreign language or script could in certain circumstances prevent their use by trade rivals.³⁹ This was so in the case of *Gout v Aleploglu*⁴⁰ where the plaintiff was a maker of watches for the Turkish and Levantine market. He marked his watches in Turkish with his name and the Turkish word *Pessendede*, meaning warranted, followed by his initials 'R.G'. The defendants started to manufacture and export watches similarly marked. It was held that the plaintiff had acquired, by long previous usage, the exclusive right to designate his watches by the Turkish word *Pessendede* in Turkish characters.⁴¹

Under the 1875 Act the registration of foreign words as trademarks was mostly allowed under the s 10 that admitted 'special and distinctive words'.⁴² The position was later changed by the 1883 Act which increased the registration of purely word marks to be registered by admitting a 'fancy

³⁶ Sebastian *Law of Trademarks* 2.

³⁷ *Ibid.*

³⁸ Gredley 'Foreign-language words as Trademarks' in *Perspectives on Intellectual Property* 86.

³⁹ *Ibid.*

³⁷ *Gout v Aleploglu* 1833 6 Beav. 69 n.

⁴¹ Trademarks Registration Act of 1875.

⁴² Trademarks Registration Act section 10.

word or words not in common use' under its section 64.⁴³ The fancy word had to be non-descriptive when used as a trademark for the goods in question. For example, the word cannot make reference to any description or designation of where the article is made or what its character is.⁴⁴ Section 64 was so narrowly interpreted that it was said to have become practically inoperative and the section was also heavily criticised.⁴⁵ Due to this shortcoming, the statutory position with regard to foreign words changed from 1888 onwards. A mark could be registered if it consisted of or contained 'an invented word or words'⁴⁶ or 'a word or words having no reference to the character or quality of goods, and not being a geographical name'.⁴⁷ Guidelines were also developed for dealing with problems that arose with foreign language terms and according to Gredley in practice they were subject to special scrutiny.⁴⁸ For example, the rules made no reference to marks in foreign languages and all applications were to be made in English⁴⁹.

A notable decision on foreign terms as trademarks is the case of *Solio*.⁵⁰ In this case it was established that foreign language words might qualify as invented words. The court further stated that although they did not fall within this category, because they were unknown in the English language, they are also not barred from registration simply because they alluded to the character or quality of goods. After this decision section 9 of the Trade Marks Act of 1905 modified certain passages in the 1888 Act. The Act retained the statutory provision on 'invented words', but replaced the provision that stated that 'words having no reference to character or quality of the goods and not being a geographical name' with section 9 (3) that stated that 'word or words having no direct reference to the character or quality of the good ... and not

⁴³ Section 64 of the Patent, Designs and Trade Marks Act of 1883.

⁴⁴ *Waterman v Ayres* 1888 5 R.P.C 31, CA.

⁴⁵ Kerley *The law of Trade Marks, Trade Names and Merchandise Marks*.

⁴⁶ Section 10.

⁴⁷ *Ibid.*

⁴⁸ Gredley 'Foreign-language words as Trademarks' in *Perspectives on Intellectual Property* 87.

⁴⁹ Trade Mark Rules of 1875-1877.

⁵⁰ *Eastman Photographic Materials Company's Application (Solio)* 1898 15 RPC 476, HL.

being according to its ordinary signification a geographical name or a surname'.⁵¹

Worth noting is the fact that Namibian law has evolved and is no longer the same as the English law. For example under the British Law 'words having a direct reference to the character or quality of the goods' are not registrable unless evidence of its distinctiveness has been adduced.⁵² No special requirements are laid down in the Namibian law with regard to such marks.⁵³ Within the South African legal system, like that of Namibia, the registration of words that would be likely to inconvenience other traders should not be made the subject of a trademark monopoly. It does not unduly limit the very natural predilection of traders to incorporate in their trademarks skilful or covert allusion to the nature or character of their goods or services.⁵⁴

The present law on the registrability of foreign language terms is that where the word has a meaning in the foreign language, its registrability must turn to the question of whether or not there is a relationship between the word in the foreign language and the goods or services in question and if there is, the next inquiry should be whether the meaning of the word should be generally known in this country.⁵⁵ The rule against the registration of words for a product as trademarks is that the registration will deprive members of the community the right that they possess to use the existing vocabulary as they please.

Of relevance is the fact that although the history of trademark law dealt with foreign words to the English language as trademarks, it has never dealt with traditional terms or names of products as trademarks. The reality is that the issue on the protection of TK and TCE under the umbrella of IP law, specifically trademark law, is a very new concept that needs a lot of investigation and discussion in order to find out how it will fit into the whole spectrum of trademark law protection in Namibia.

⁵¹ Section 9(3) Trademarks Act of 1905.

⁵² Section 9(1) of the British Act of 1938.

⁵³ Webster & Page *South African Law of Trademark* 34.

⁵⁴ Ibid.

⁵⁵ Webster & Page *South African Law of Trademark* 46.

2.5 The definitions of traditional knowledge and traditional cultural expressions

There are no universal definitions of these two terms as they tend to be difficult to define. In 2005, WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore,⁵⁶ published draft articles for the protection of TK and TCE. These articles included the definitions of these two terms as follows:

“Traditional cultural expressions” or “expressions of folklore” are any forms, whether tangible and intangible, in which traditional culture and knowledge are expressed, appear or are manifested.’

TK on the other hand has been defined as follows:

‘The content or substance of knowledge resulting from intellectual activity in a traditional context, and includes the know-how, skills, innovations, practices and learning that form part of traditional knowledge systems, and knowledge embodying traditional lifestyles of indigenous and local communities, or contained in codified knowledge systems passed between generations. It is not limited to any specific technical field, and may include agricultural, environmental and medicinal knowledge, and knowledge associated with genetic resources.’⁵⁷

The manifestations of TK in the broad sense are tremendously diverse. TK ranges from artistic expressions,⁵⁸ TCEs, to traditional medicines and healing knowledge, agricultural systems on the conservation of the biodiversity and protection of the environment. TK is said to be the information in a given community, based on experience and adaption to a local culture and environment, which has developed over time and will continue to evolve in response to change in environmental and social needs.⁵⁹ This knowledge is used to sustain the community and its culture and to maintain the genetic resources necessary for the continual survival of the community.⁶⁰

The distinction between TK and TCE is that TCE is mainly in the realm of copyright and trademarks, while TK deals mainly with patents, the novelty

⁵⁶ Hereafter to be referred to as IGC.

⁵⁷ Ibid.

⁵⁸ Examples are songs, dances and clothing.

⁵⁹ Hansen and Van Fleet *Traditional knowledge and intellectual property* 3.

⁶⁰ Ibid.

and non-obvious requirement.⁶¹ Just like there can be an overlap between patents, trademarks and copyrights so can there also be overlaps between TK and TCE.⁶²

Worth noting is that the term ‘traditional’ used in describing this knowledge does not imply that the knowledge is old or untechnical in nature, but that this knowledge is ‘tradition-based’. It implies that the knowledge is created in a manner that reflects the traditions of the communities, therefore not in relation to the nature of the knowledge itself, but to the way in which that knowledge is created, preserved and disseminated.⁶³ The WIPO IGC defined *traditional-based* as referring to knowledge system creations, innovations and cultural expressions that have generally been transmitted from one generation to another. This knowledge is generally regarded as pertaining to particular people or their territory and is constantly evolving in response to a changing environment and time.⁶⁴ Categories of TK could include TCE.⁶⁵ TCE in relation to trademarks may refer to tradition-based designs, marks, names and symbols.⁶⁶

2.6 An overview of the protection of traditional knowledge and traditional cultural expression

The contribution of TK and TCE to commercial industries has been acknowledged in various fora. Nevertheless, some commentators on the subject are of the opinion that the dominant system in place, which has been defined to be the western legal system of defining and protecting IP is not an adequate system towards the protection of collectively held TK that has been passed down through generations.⁶⁷ It is argued that while Western IP systems focus on the needs and the rights of the individual person, and in the case of trademark this being the reputation in which the right is vested;

⁶¹ Hughes 2012 *San Diego L. Rev* 1218.

⁶² Ibid.

⁶³ Hansen & Van Fleet *Traditional knowledge and intellectual property* 3.

⁶⁴ WIPO (20 May 2002) document number WIPO/GRTKF/IC/3/9.

⁶⁵ Ibid.

⁶⁶ Ibid 11.

⁶⁷ Riley *Indigenous intellectual property rights x*. See also Arowolo *Intellectual Property Rights, Traditional Knowledge System and Jurisprudence in Africa* 9.

indigenous communities tend to place individuals within a larger context of group or relationships and memberships, whose interests overtake the interest of the individual person.⁶⁸ It is therefore relatively clear that TK is not owned by any individual within the community; but is communally held and activated through the actions and practices of the entire community.⁶⁹

The unique problems inherent in protecting TK and TCE have been discussed on various international, regional and national platforms for many years, ranging from the United Nations Economic, Scientific, and Cultural Organisation,⁷⁰ to the Convention on Biological Diversity to the World Intellectual Property Organisation WIPO, African Regional Intellectual Property Organisation (ARIPO) and others. While many sets of guidelines for protecting indigenous IPR have come out of these ongoing meetings, the biggest problem that remains in this regard is that all nations are recognised as being sovereign entities and as such the nation itself will prioritise the protection of TK/TCE, its violation and regulation.⁷¹

2.7 Modes of protection for traditional knowledge

The TK and TCE were created and is still being created for cultural and community reasons and not primarily for commercial gain. Third parties tend to misappropriate and commercialise certain aspects of TK and TCE. This brings the importance of TK and TCE into collision with the existing commercial realities.⁷² Various approaches have been put forward for the protection of TK and TCE. At the forefront of these proposals are IPR protection and the *sui generis* system of protection.⁷³

The IPR provide legal protection in the form of exclusive rights to individuals or corporate entities over their creative accomplishments for a limited time and in the case of trademarks, for a period of ten years subject to

⁶⁸ Riley *Indigenous intellectual property rights X*.

⁶⁹ Ibid.

⁷⁰ See the UNESCO's Recommendation on the Protection and Safeguarding of Folklore and Traditional Knowledge 1989.

⁷¹ Riley *Indigenous Intellectual property rights X*.

⁷² Van der Merwe 2010 *Potchefstroomse Elektroniese Regsblad* 2-10.

⁷³ This system will be discussed in detail in Chapter 4.

renewal.⁷⁴ Fundamentally, IPR focuses on the promotion of economic exploitation of human creativity, with the view of advancing the rights of the frontiers of knowledge through further research and development.⁷⁵ Article 1 of the Paris Convention of the Protection of Industrial Property⁷⁶ defines the scope of industrial property under paragraph 3 as follows:

‘Industrial property shall be understood in the broadest sense and shall apply not only to industry and commerce proper, but likewise to agricultural and extractive industries and to all manufactured or natural products, for example, wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers, and flour.’⁷⁷

From this provision, in terms of the Paris convention it is possible to protect TK under the IPR protection. Article 7 in addition provides for the protection of collective marks belonging to associations, the existence of which is not contrary to the law of the country of origin, even if such association does not possess an industrial or commercial establishment.⁷⁸ Therefore, if an indigenous community forms an association that is legally legitimate in the country of origin, it is possible for them to collectively acquire collective marks.⁷⁹

A lot of the traditional communities have experienced difficulties in attempting to protect their knowledge through the existing system of IP. This is inherently due to TK failure to satisfy the requirements of IP protection.⁸⁰ It is said that many of the incompatibilities between TK and IPR started to surface with the rapid global acceptance of the conventional IP concepts and standards.⁸¹ This incompatibility occurs when ownership of TK is inappropriately claimed or when TK is used by individuals or corporations that belong to the communities, especially in developing countries.⁸² It is

⁷⁴ Section 157 of the Industrial Property Act.

⁷⁵ Sackey et al *African Health Monitor*, 14, 89-102.

⁷⁶ The Paris Convention for the Protection of Industrial Property of 1883.

⁷⁷ Ibid.

⁷⁸ Article 7 of the Paris Convention.

⁷⁹ Mugabe *Intellectual property protection and traditional knowledge* 97-125.

⁸⁰ Ibid.

⁸¹ Sackey et al *2010 African Health Monitor* 96.

⁸² Ibid.

further argued that the existing IP system increases the risk of misappropriation and may as a result be responsible for the loss of TK.⁸³

Even though laws for trademark, geographical indicators⁸⁴, trade designs, patents and copyrights as instruments of IP offer some sort of protection to TK and TCE, their effectiveness is limited.⁸⁵ The most prominent difficulties that can be identified in the protection of existing IP laws to TK and TCE includes the difficulty of identifying ownership of the knowledge because conventional IP regimes are based on the notion of individual property ownership.⁸⁶ This concept is alien to traditional communities where ownership of knowledge is collective.

The other problem that arises is the long period of time that the knowledge has existed. This results in the argument that TK was already in the public domain before protection was sought. This argument is, however, disputed by the indigenous communities who reason that the TK belongs to their communities and not to the society at large and consequently cannot be said to be in the public domain.⁸⁷ Van der Merwe⁸⁸ is of the opinion that if IPR are created in respect of TK, the part of the TK created will be alienated from its communal ownership and will become private property when the protection ceases. Furthermore, the part of the TK so removed will fall within the public domain to be used by anyone without any restrictions.⁸⁹

Another alternative mode of protection of TK, as a result, has been identified and that is the *sui generis* protection approach. The *sui generis* protection meaning 'of its own kind' is a very special type of protection for TK; as it indicates that the protection granted exists independently from other types of IPR protections because of its distinctiveness.⁹⁰ Such a system would enable a focus on defining values and standards that could be applied to the protection of TK and also to safeguard its continuance of existence

⁸³ Sackey et al 2010 *African Health Monitor* 97.

⁸⁴ Hereinafter referred to as GIs.

⁸⁵ Sackey et al 2010 *African Health Monitor* 98.

⁸⁶ Ibid.

⁸⁷ Van der Merwe 2010 *Potchefstroomse Elektroniese Regsblad* 6.

⁸⁸ Ibid.

⁸⁹ Ibid.

⁹⁰ Sackey et al 2010 *African Health Monitor* 96.

and development.⁹¹ In the protection of the IPR of traditional people, this approach is not completely free of IPR.⁹² Consequently, if a country follows the *sui generis* approach, it may choose how to define and implement this system and decide which measures it will adopt to protect specific TK.⁹³

2.8 The need for the protection of traditional cultural expressions under trademark law

The protection of TK and TCE is necessary to prevent the erosion and disappearance of tradition. Additionally, the protection is seen as a means of preventing unauthorised exploitation and poaching of TK.⁹⁴ However, there are concerns that have been raised about protecting TK and TCE within the sphere of IP laws. This is said to be problematic because indigenous knowledge is generally considered to be communally held or shared by a number of people who are often not clearly identifiable and generally no clear legal evidence exists as to where the idea originated from.⁹⁵ Nevertheless when it comes to trademark law regard is not given to how knowledge has come to be in the community or to whom in the community the knowledge originated from. Regard is, however, given to the general opinion of the community. Therefore, because of the mark, the consumers will be buying that product on the premise that such particular product is from the particular community that the sign or word is associated with. Thus, there is a need for mechanisms to be put in place to prevent third parties from misappropriating traditional terms and products and marking them as such.

Trademark law will thus protect consumers from being deceived into believing that they are buying, for example, a traditional beverage when in fact that particular beverage is not related to the traditional community. Traditional product terms and the products themselves are deeply rooted in the communities from where they arise. If an organisation or third party, who

⁹¹ Sackey et al 2010 *African Health Monitor* 97.

⁹² Arowolo *Intellectual Property Rights, Traditional Knowledge System and Jurisprudence in Africa* 9.

⁹³ Ibid.

⁹⁴ WIPO *Fact Finding Mission Report* 25.

⁹⁵ Hart & Vorster *Indigenous Knowledge on the South African Landscape: Potential for Agricultural Development* 9-12.

does not belong to the community, copies the product and is the first to register this product term as a trademark, the product term will be detached from the community. As a result no other person will be able to register or commercially use the term for that particular product. However, if there is a special law that offers protection for communities in such cases then traditional communities will not lose ownership of the identity of their product, terms and names. The law of trademarks is well placed to protect traditionally recognised names or symbols since the lifespan of traditional names and symbols are perpetual in nature and the trademark law can accommodate this type of knowledge because trademark protection is permanent in nature.⁹⁶

2.9 Traditional knowledge and traditional cultural expression protection in Namibia

Namibia is a land of diverse cultures, traditions and traditional communities. To date there are approximately 49 recognised traditional communities in Namibia.⁹⁷ Each community holds distinct TK and TCE. This knowledge has been used for centuries by indigenous communities under local laws, customs and traditions to ensure their survival. This has been transmitted, and has evolved, from generation to generation.

The recognition of indigenous status is a conceptual challenge in Namibia, as it is elsewhere in Africa. There is no specific legal protection under Namibian law to protect the rights of indigenous people; however the Namibian Constitution⁹⁸ under Article 18 recognises the right to culture. The only mention of the term 'indigenous' is in reference to a group of people, found in the *Traditional Authorities Act 25 of 2000* under s (1) (b). The Act states that:

“traditional community” means an indigenous homogeneous, endogamous social grouping of persons comprising of families deriving from exogamous clan which share a common ancestry,

⁹⁶ Panizzon & Cottier *Traditional Knowledge and Geographical Indications* 23.

⁹⁷ Hinz “Traditional courts in Namibia – Part of the judiciary? Jurisprudential challenges of traditional justice”, in *The Independence of the Judiciary in Namibia* 149.

⁹⁸ The Constitution of the Republic of Namibia Act 1 of 1990.

language, cultural heritage, customs and traditions, who recognises a common traditional authority and inhabits a common communal area, and may include the members of that traditional community residing outside the common communal area.⁹⁹

Despite the absence of specific legal provisions for the protection of the rights of indigenous people, the notions of TK and TCE, indigenous knowledge and indigenous peoples have acquired wide usage in international debates on sustainable development as well as those on issues of IP protection. This has led to the protection of TK and TCE being imported through international laws by virtue of Article 144 of the Constitution. Namibia is known to have ratified a plethora of international IP treaties and conventions. Article 144 of the Namibian Constitution states that:

'Unless otherwise provided by this Constitution or Act of Parliament, the general rules of public international law and international agreements binding upon Namibia under this Constitution shall form part of the law of Namibia.'¹⁰⁰

The effect of this provision is that the general rules of international law and agreements binding on Namibia are directly incorporated into the municipal laws and can be enforced by the municipal institutions particularly the courts.¹⁰¹ Regardless of that, there is still a need for legislation to be passed for the protection of TK and TCE within Namibia rather than just relying on the international instruments that Namibia is signatory to.

2.10 Conclusion

Following the extensive analysis of the laws applicable to trademarks in Namibia, it is noticeable that currently, there is no legal redress that addresses the protection or commercialisation of TK/TCE; and there are no legal instruments that deal with collective ownership of TK for the benefit of indigenous knowledge holders. With regards to the protection of traditional

⁹⁹ Section (1) (b) of the Traditional Authorities Act 25 of 2000.

¹⁰⁰ Article 144 of the Constitution of the Republic of Namibia Act 1 of 1990.

¹⁰¹ Tshosa 2010 *Namibia Law Journal* 27.

terms, names, signs and other cultural expressions as trademarks, the *WIPO Fact-finding Missions* revealed that little evidence regarding the practical importance of unlawful or inappropriate use of traditional names existed, in fact in the majority of the reports the topic on traditional names was hardly mentioned.¹⁰² Namibia is a land rich in diversity and there is a need for it to have laws that are specifically aimed at the protection of TK and TCE to prevent the use of traditional terms and the poaching of products. The core of the next chapter will be an analysis of whether it is possible TCE to be registered under the current trademark laws in Namibia.

¹⁰² WIPO *Report on Fact-finding Missions on Intellectual Property and Traditional Knowledge* 25.

CHAPTER 3: THE PROTECTION OF TRADEMARKS UNDER THE NAMIBIAN LEGAL SYSTEM

3.1 Introduction

In Namibia, the governing legislation of trademarks is the Industrial Property Act 1 of 2012. The main purpose of the Act, in terms of trademarks, is to provide for the registration, protection and administration of trademarks, collective marks, certification marks and geographical indications and matters incidental to trademarks. The Act only regulates registered trademarks. Unregistered trademarks are governed by common law.¹⁰³

Over the years, traditional communities have complained of the unauthorised use of their TK and TCE by third parties. There are ongoing negotiations both at international and national levels on the best way to protect TK and TCE. Currently, there is no law in Namibia that specifically provides for the protection of TK or TCE. This chapter seeks to investigate whether the current trademark laws in Namibia are able and adequate enough to provide protection for TCE. To this end the chapter will outline the requirements for trademark registration under the Industrial Act¹⁰⁴ and common law to explore whether traditional product names, words, symbols and other cultural expressions will meet the requirements set out in these laws. In addition the chapter will also, through a case study, look at the appropriateness of geographical indications¹⁰⁵ and certificate marks in protecting TCE.

3.2 Positive and defensive protection of traditional knowledge

The main purpose of the IP system is the protection of material against the unauthorised use by third parties. This can include TK and TCE.¹⁰⁶ Currently,

¹⁰³ Rutherford "The law of trademarks" in *Intellectual Property in South Africa* 71.

¹⁰⁴ The Industrial Property Act 1 of 2012.

¹⁰⁵ Hereafter to be referred to as GI.

¹⁰⁶ WIPO *What is intellectual Property Law?* Available at http://www.wipo.int/export/sites/www/freepublications/en/intproperty/450/wipo_pub_450.pdf [accessed 20 July 2014].

there are ongoing negotiations on the best mode to protect TK/TCE, whether by existing IPRs or by a stand-alone *sui generis* system. In the mean time, while a solution is being sought, TK/TCE is still a living reality in need of protection and the solution for now is through IP.

Solutions to protect TK within the IP system are being sought in the form of positive protection or defensive protection.¹⁰⁷ The active assertion of rights is known as positive protection.¹⁰⁸ There are two aspects of positive protection of TK by IP rights, one aspect is concerned with the prevention of unauthorised use and the other is concerned with active exploitation of TK by the indigenous community itself.¹⁰⁹ In various regions around the world, indigenous communities have used IP rights to stop the misappropriation of TK by third parties. In addition, they also used IP rights as the basis for commercial gain and dealing with third parties outside the indigenous community.¹¹⁰

While the positive protection strategy is based on obtaining and asserting rights in the protected material, a defensive protection is intended to prevent third parties from asserting or acquiring the right over TK subject matter.¹¹¹ In terms of trademarks, what is mostly needed are measures to exclude or oppose trademark rights making use of TK subject matters or creating a misleading link with a traditional community.¹¹²

3.3 Protection of trademarks for traditional products under the Namibian legal system

The main function of a trademark is to indicate the badge of origin of the goods or services by distinguishing goods or services of one trader from those of another trader.¹¹³ Even so, where there are no similar goods or services at the time of registration, the trademark must still be able to

¹⁰⁷ Dutfield 2006 *ICTSD Issue Paper 16*.

¹⁰⁸ WIPO, IGC document WIPO/GRTKF/IC/6/8.

¹⁰⁹ *Ibid.*

¹¹⁰ WIPO, *Traditional knowledge* 104.

¹¹¹ WIPO, IGC document WIPO/GRTKF/IC/5/6.

¹¹² *Ibid.*

¹¹³ Rutherford "The law of trademarks" in *Intellectual Property in South Africa* 82.

distinguish the trader's goods or services, should such similar goods or services come into existence.¹¹⁴ Trademarks also serve to guarantee the quality or character of the goods or services. This function implies a guarantee to the consumers that the quality of the goods or services will be consistent with that to which the consumers have become familiar to.¹¹⁵ In addition, trademarks are also used to market and sell goods that originate from the same proprietor.¹¹⁶

Trademark laws have relevance to the protection of TK, especially TCE in various forms. Undeniably, there is an increased use of indigenous words, signs and symbols in the course of trade by both indigenous and non-indigenous entities. This has caused various concerns to the indigenous communities who complain that their words, symbols, signs and other cultural expressions are used as trademarks by non-indigenous entities without proper consent.¹¹⁷ Accordingly, indigenous communities now seek protection from exploitation and to be recognised as the custodians of the TCE.¹¹⁸

The Namibian legal system provides for a dual system of trademarks protection. As such, trademarks are either protected under statute or under common law. These two areas of law complement each other and have a common foundation.¹¹⁹ Even so, there are substantial differences between the protection of trademarks under statutory law and the protection under common law.¹²⁰ These two laws will be discussed separately to assess whether each of these laws can provide sufficient protection for traditional products.

3.4 Statutory protection of trademarks in Namibia

There are certain benefits that indigenous people stand to gain if they can successfully register their words, symbols, signs and other cultural expressions as trademarks. Trademarks will provide certain economic rights

¹¹⁴ Webster & Page *South African law of Trade Mark* 34-64.

¹¹⁵ Zografos *Intellectual property and traditional cultural expressions* 52.

¹¹⁶ *Ibid.*

¹¹⁷ Janke *Minding Culture* 30.

¹¹⁸ *Ibid.*

¹¹⁹ Dean 1998 *S. Afr. Mercantile L.J.* 89.

¹²⁰ *Ibid.*

to the indigenous owners of a registered mark, which will allow them to take action against traders who attempt to compete with them by using the same or similar marks.¹²¹ Additionally, trademarks provide the means for indigenous businesses to promote their products and services as authentic.¹²² Be that as it may, these benefits can only be gained by the indigenous communities if they can successfully meet the requirements of trademark registration under the Act.

Section 131 of the Namibian Industrial Property Act, defines a trademark to mean that which is other than a certification or a collective trademark; a mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing those goods or services from the same kind of goods or services connected in the course of trade with any other person.¹²³ The Act further states that a mark means any sign capable of being represented visually, including a device, name, signature, word, letter, numeral, figurative element, shape, colour or container for goods, or any combination of such signs, the list of what can be considered a mark is not exhaustive.¹²⁴ The Act does not define any of the concepts covered by a mark; however, in *Phillip Electronics NV v Remington Consumer Products Ltd*,¹²⁵ it was stated that a mark is 'anything which can convey information.' Although the Industrial Property Act does not explicitly provide for protection of tradition knowledge; the argument is that since a mark is anything that conveys information, trademark may apply to TCE provided that they fulfil the requirements for the definition of a trademark. Pertinently it must consist of a mark that can be represented graphically and the mark must be distinctive.¹²⁶

¹²¹ Janke *Minding Culture* 30.

¹²² *Ibid.*

¹²³ Industrial Property Act 1 of 2012, section 131.

¹²⁴ Section 131.

¹²⁵ *Phillip Electronics NV v Remington Consumer Products Ltd (No. 1)* 1998 RPC 283 at 298.

¹²⁶ Section 136 of the Industrial Property Act of 2012.

3.4.1 Registrability of trademark

In order for a mark to be registrable, the Act requires that the goods or services of a person in respect of which it is proposed to be registered must be distinguishable from the goods or services of other persons, either generally or, where the trademark is proposed to be registered subject to limitations, in relation to use within those limitations.¹²⁷ A trademark is considered to be capable of distinguishing goods or services of one trader from that of another trader if, at the date of application for registration, it is inherently capable of so distinguishing or if it became capable of distinguishing by reason of prior use thereof.¹²⁸

The object of Section 134 is to investigate the registrability of trademarks at the date of its application. It is clear that even though the trademark need not to be original in the copyright sense, or novel and non-obvious in the patent sense, it does need to be distinctive. Generally, it has been noticed that some of the difficulties in the application of the novelty and originality requirement to TK is that such knowledge may pass the subject matter of copyright or patent protection, but it tends to fail the novelty or originality threshold.¹²⁹ However, distinctiveness in trademark law is less demanding than copyright originality and patent law novelty and the chances of the marks of indigenous people passing the test for distinctiveness are very high.¹³⁰

3.4.2 Distinctiveness of a mark

Distinctive marks are a crucial requirement in trademark law. It goes without saying that if a mark is not distinctive, it is not possible to indicate the product's badge of origin. Consequently the owner will not have a right to claim exclusive use of the mark on the basis of goodwill protection.¹³¹ In order

¹²⁷ Section 134 (1).

¹²⁸ Rutherford "The law of trademarks" in *Intellectual Property in South Africa* 86.

¹²⁹ Frankel *Victoria University of Wellington Legal Research Papers* 14.

¹³⁰ The discussion of Copyright and Patents are beyond the scope of this paper therefore it will not be discussed in detail here.

¹³¹ Bachman "Inherent Distinctiveness" in *J. Corp. L.* 501.

to establish whether a mark is distinguishable within the meaning of the provision of the Act, the enquiry can be done at two stages.

The first stage is whether the mark was, at the date of application for registration, capable of inherently distinguishing the appellant's goods from those of another person; and, if the answer to the first question is no, the enquiry does not just end there as the next question will be whether the mark was distinguishable by reason of its use to date.¹³² These two requirements will be unpacked in the discussion that follows.

3.5 *Inherent distinctiveness*

A mark is inherently distinctive if, by its intrinsic nature, the mark can serve to identify a particular source of a product. It was stated in *Beecham v Triomed*¹³³ that for a mark to be inherently distinctive, the mark has to be so unique, unusual or unexpected in the relevant market that one can assume without proof that it will automatically be perceived by the consumers as an indicator of origin.¹³⁴ There are some guidelines developed over time to help determine the eligibility for registration on the basis of inherent distinctiveness. These guidelines have been categorised as generic, descriptive, suggestive and fanciful or arbitrary. They will each be discussed more in detail below.

3.5.1 *Generic marks*

Generic marks are marks that through public use can no longer be distinguished by product's badge or origin. According to Rutherford,¹³⁵ these are marks that have become ordinary names for goods or services that they are used for. Escalator, zipper, cellophane and aspirin are some of the examples of what were once trademarks, but are now generic names.¹³⁶

¹³² *Beecham v Triomed* 2003 (3) 639 (SCA) paragraph 20.

¹³³ *Ibid.*

¹³⁴ Bachman "Inherent Distinctiveness" in *J. Corp. L* 507.

¹³⁵ Rutherford "The law of trademarks" in *Intellectual Property in South Africa* 89-90.

¹³⁶ WIPO 2009 *What you don't know about trademarks*.

Generic marks are not inherently distinctive, consequently they are prohibited from registration under section 137 (e) of the Act.¹³⁷ This section provides that marks that consist exclusively of a sign or an indication that has become customary in the current language or in the *bona fide* and established practice cannot be registered.¹³⁸ The rationale for this exclusion is based on the premise that if the law allowed the exclusive use of such a mark, manufacturers will not be able to compete with trademark holders as they will not be able to call their products by the common name without infringing on that mark.¹³⁹

3.5.2 Descriptive marks

Descriptive marks are as a general rule not inherently distinctive and as such are not registrable.¹⁴⁰ Under the Act section 137(d) provides that ‘a mark that consists exclusively of a sign, or indication which serves trade to designate the kind of quality, quantity, intended purpose, value, geographical origin or time or mode of production of the goods or rendering of services’ is not registrable and cannot be validly registered.¹⁴¹ The reason for excluding descriptive marks is that the vocabulary of the English language is common property that belongs to all and no single person or organisation should be allowed to prevent other members of the community from using a word for purposes of description that have reference to the quality or character of goods.¹⁴² The other reason for exclusion from registration is that descriptive marks are generally not distinguishable. They can however be registered if they have become distinguishable through prior use.¹⁴³

¹³⁷ The Industrial Property Act 1 of 2012.

¹³⁸ *Ibid.*

¹³⁹ *Bachman J. Corp. L* 509.

¹⁴⁰ There is an exception to this rule that provides that descriptive marks can be registered if the owner can show by reference of prior use that the mark is distinguishable. This will be discussed in detail under the topic ‘Distinctiveness by prior use’.

¹⁴¹ Section 137 (d) of the Industrial Properties Act.

¹⁴² *Century City Apartments Property Services CC and Another v Century City Property Owners Association* 2010 (3) SA 1 (SCA).

¹⁴³ Rutherford “The law of trademarks” in *Intellectual Property in South Africa* 89.

3.5.3 Suggestive terms

Suggestive terms are distinguishable and as such are registrable as trademarks. In *Abercrombie & Fitch Co. v. Hunting World, Inc.*,¹⁴⁴ the decision that established the spectrum of trademark distinctiveness in the United States of America, it was stated that a term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods.¹⁴⁵ Suggestive marks thus suggest rather than describe the quality of the goods or services. Suggestive marks give a hint at one or some of the attributes of the product.¹⁴⁶

3.5.4 Arbitrary and fanciful marks

Arbitrary words are words that have meaning; however, the meaning of the word has no relation to the product to which the mark is being used. Some examples of this can be found in the mark of Apple or Blackberry for cell phones and computers; the use of these marks for gadgets is arbitrary. On the other hand, a term is fanciful if it has been invented solely for use as a trademark.¹⁴⁷ Fanciful words are words without any intrinsic or real meaning. The term KODAK, which is a trademark of Eastman Kodak company, is used for photographic equipment and is a fanciful term. This word did not exist until it was coined by its creators.¹⁴⁸ Arbitrary and fanciful marks are inherently distinctive and as such can be registered as trademarks.

3.5.5. Distinctiveness by prior use

A mark is said to be distinguishable by prior use, if through use, the mark becomes recognised by consumers in the marketplace as a badge of origin. However, the mark must still distinguish the goods or services of one trader from that of another trader.¹⁴⁹ In the case of *Cadbury v Beacon Sweets and*

¹⁴⁴ *Abercrombie & Fitch Co. v. Hunting World, Inc.* 1976 537 F.2d 4 (2d Cir.).

¹⁴⁵ *Abercrombie & Fitch Co. v. Hunting World, Inc.* 1976 10.

¹⁴⁶ Bachman 1997 J. Corp. L 510.

¹⁴⁷ Ibid.

¹⁴⁸ Ibid.

¹⁴⁹ Rutherford "The law of trademarks" in *Intellectual Property in South Africa* 86.

Chocolates,¹⁵⁰ it was made clear that although distinctiveness may be acquired by reason of prior use of the mark, it is important to always bear in mind that it is a requirement that there should be distinctiveness in order to qualify for registration as a trademark that is determinative.¹⁵¹ The court in this case went further to clarify this by stating that distinctiveness and not prior use is always the criterion.¹⁵² Therefore, it was stated in *South African Apartheid Museum at Freedom Park v Stainbank and Another*¹⁵³ that prior use may contribute to distinctiveness, but does not in itself create it.¹⁵⁴ Consequently, previous advertising and selling under a particular name does not, in itself, confer distinctiveness.¹⁵⁵

From the discussion of distinctiveness by prior use it can be concluded that existing products in Namibia that use traditional product names, can acquire trademark registration for these names without the consent or approval of the traditional communities. However, they can only do so if they are able to prove that the name has become distinctive through use and that the consumers have come to regard the particular product name as emanating from that particular producer. In the case of *Omaere*, if Namibia Dairies (Pty) Ltd (NamDairies) can successfully show that *Omaere*, through use, is capable of distinguishing its goods from that of any other trader, then the company can successfully claim the word *Omaere* as its trademark. Currently, *Omaere*, by use of the word, has become distinctive as a product of NamDairies. The first thing that comes to mind for many of the Namibian people at the mention of *Omaere*, is the *Omaere* from NamDairies. NamDairies can successfully register the word *Omaere* as a trademark and prevent other people including the OvaHerero Traditional Communities from using the word in future. Since there is currently no law in Namibia that prevents instances like this, the traditional product names and other cultural expressions can be misappropriated and permanently removed from the

¹⁵⁰ *Cadbury v Beacon Sweets and Chocolates* 2000 (2) SA 771 (A).

¹⁵¹ At para 9.

¹⁵² *Ibid.*

¹⁵³ *South African Apartheid Museum at Freedom Park v Stainbank and another* 2010 ZAGPJHC 143.

¹⁵⁴ *Ibid* paragraph 19.

¹⁵⁵ *Ibid.*

indigenous communities without any benefits accruing to the local communities.

3.5.6 Grounds to refuse the registration of Traditional cultural expressions as trademarks

A mark is registrable if it meets the requirements laid down in the Act. The Act also prohibits some marks from registration if they are inherently unregistrable. These are marks that are unregistrable because of their specific nature and there being statutory grounds for their exclusion. These grounds are to be found under s 137 of the Industrial Property Act. The prohibition can either relate to the form that the mark takes or to its meaning. The following grounds can be used by the traditional communities to prevent the registration of some of their words, names or cultural expressions.

3.5.6.1 Protection against offensive use

Section 137 (c) prohibits the registration of marks that are ‘contrary to public order or morality’. The concepts of ‘contrary to morality’ or ‘contrary to public order’ are very broad concepts, which require a value judgement to be made by the trademark registries. According to Zografos,¹⁵⁶ the offences may relate to cultural offences in the case of TCE. In some communities, the TCE identifies and reflects the community’s cultural and social identity as well as its values. More often than not they carry religious and spiritual meanings and perform various spiritual and cultural functions.¹⁵⁷

The communities seek to protect themselves against illicit or improper use of words, symbols and other expressions, which words or symbols bear a specific cultural or spiritual connotation.¹⁵⁸ Some words, names or symbols of indigenous origin may have a specific symbolic value that goes beyond the plain meaning of the word and such symbolic meaning suffers or can even be destroyed when the word or sign is used in the wrong context.¹⁵⁹ This is

¹⁵⁶ Zografos 2012 *Indigenous peoples’ innovation* 147.

¹⁵⁷ Kur & Knaak *Protection of traditional names and designations* 227.

¹⁵⁸ Kur & Knaak *Protection of traditional names and designations* 241.

¹⁵⁹ *Ibid.*

especially so when third parties misappropriate the traditional words, symbols or signs. The use in this context might be detrimental to the indigenous community, which has an interest in safeguarding its integrity.¹⁶⁰ Because of the cultural and spiritual nature of TCE, emphasis has been placed by the traditional communities in the prevention of insulting, derogatory and culturally and spiritually offensive use of the sacred TCE.¹⁶¹ If a word that registration is sought for is offensive to any particular indigenous community in the country, the Registrar can refuse to register it as a trademark.¹⁶²

3.5.6.2 *Protection against deceptive use*

Section 137 (c) provides an absolute ground for refusal of the registration of marks that are inherently deceptive, or if the use is likely to mislead or deceive the public or other traders with regard to the characteristic of the goods or services for which they are intended to be used. The deception of the mark will relate to the origin, nature, quality or characteristics of the goods or services.¹⁶³ This will happen for example, if a sign indicates that the product for which it is being used is from a certain geographical origin or traditional community, whereas it originates from a different region, or is not associated with that traditional community. In terms of traditional product names, the registration of a name or a word that is perceived by the general public to be connected with a particular traditional community, while in fact the product is not in any way connected to that traditional community, will be considered to be deceptive. This would be considered as sufficient grounds to refuse to register the mark, or its removal from the register if already registered.¹⁶⁴ Under this requirement, the deception caused will essentially depend on the perception and understanding of the society.

3.6 *Common law*

Trademarks that are not registered are known as common law trademarks. Their protection is governed mainly by the common law rules of passing off. Common law trademarks may be used by indigenous communities to protect

¹⁶⁰ Ibid.

¹⁶¹ Ibid.

¹⁶² Section 137 (c).

¹⁶³ Ibid.

¹⁶⁴ Kur & Knaak *Protection of traditional names and designations* 241.

the goods that they have acquired goodwill and a reputation in.¹⁶⁵ Equally, this area of law can also be successfully used by organisations that currently use traditional product names as marks. As was discussed at the beginning of this chapter, common law protection is also extended to unregistered trademarks. For example organisations such as NamDairies (Pty) Ltd, that currently use the name *Omaere* for its milk, enjoy common law protection and can prevent other traders from using this name. The Industrial Property Act protects common law trademark rights. It does so by providing under section 132 (2) that nothing in the Act may detract from the right of any person to institute proceedings and enforce any rights under common law.

The owner of an unregistered trademark may rely on section 137 (c) to oppose the registration of a trademark on the basis that he/she has made use of the trademark. To be recognised as the rightful owner of a trademark under common law, the owner has to prove that he/she had acquired common law trademark rights in the mark. This is done by producing proof that he/she has originated, acquired or adopted the trademark and has used it to the extent that it has gained the reputation as indicating that the goods in relation to which it is used belong to the plaintiff.¹⁶⁶ In *Oils International (Pty) Ltd v Wm Penn Oils Ltd*,¹⁶⁷ it was stated that extensive use creates the intangible property rights in an unregistered trademark, this being common law.

In the judgement of the High Court of Namibia, in the case of *Elisenheim Property Development Company (Pty) Ltd v Guest Farm Elisenheim & Others*¹⁶⁸ it was stated that at common law a trademark would only become a form of property in consequence of its use by a trader who can claim to have acquired a repute in the mark in question. This would entail establishing that the mark has become distinctive in the minds of the purchasing public in distinguishing the goods or services from other similar

¹⁶⁵ Janke *Minding culture: case studies on intellectual property and traditional cultural expressions* 38.

¹⁶⁶ *Moorgate Tobacco Co Ltd v Philip Morris Inc.* 1984 (56) ALR 19 as approved in the case of *Elisenheim Property Development Company (Pty) Ltd v Guest Farm Elisenheim & Others* 2013 (A 295/2012) NAHCMD 187.

¹⁶⁷ *Oils International (Pty) Ltd v Wm Penn Oils Ltd* 1965 (3) SA 64 (T) 70G.

¹⁶⁸ *Elisenheim Property* (A 295/2012) NAHCMD para 61.

goods or services rendered by others.¹⁶⁹ Accordingly, in order to succeed with establishing ownership of a mark under common law, the plaintiff would be required to adduce evidence of its use of the distinctive trademark and documentary evidence to establish that the mark has become distinctive.¹⁷⁰ The onus of proof for common law trademark is similar to establishing a passing off action.¹⁷¹

3.6.1 *The act of passing off*

The act of passing off is a genus of the law of Delict of unlawful competition that is based on the *actio legis aquiliae* under Roman Dutch law. This is an action based on damages for a wrongful and culpable act that causes patrimonial harm or damages to another.¹⁷² In the case of *Dunn & Bradstreet (Pty) Limited v SA Merchants Combined Credit Bureau (Cape) (Pty) Limited*,¹⁷³ it was stated that the broad and ample basis of the *lex aquilia* is available in this field for the recognition of rights of action even where there is no direct precedent in our law.

Passing off can be defined to be a representation by one person, whether intentionally or negligently, that his goods or services are that of another or are associated with that of another.¹⁷⁴ In order to determine whether a representation made amounts to passing off, one enquires whether there is a reasonable likelihood that members of the public may be confused into believing that the goods or services of the one is, or is connected with, that of another.¹⁷⁵ For this action to be successful, the plaintiff has to prove that:

- a. He/she has acquired goodwill or reputation in the getup,
- b. The defendant has made a misrepresentation, whether direct or indirect, that is likely to confuse the public, and

¹⁶⁹ Ibid paragraph 60.

¹⁷⁰ Ibid paragraph 61.

¹⁷¹ *Adcock-Ingram Products Ltd v Beecham SA (Pty) Ltd* 1977 (2) SA 434 (W) 436H-437E.

¹⁷² Klopper "The right to attract custom and unlawful competition" in *Law of Intellectual Property in South Africa* 25.

¹⁷³ *Dunn & Bradstreet (Pty) Limited v SA Merchants Combined Credit Bureau (Cape) (Pty) Limited* 1968 (1) SA 209.

¹⁷⁴ Kloppers "The right to attract custom and unlawful competition" in *Law of Intellectual Property in South Africa* 25.

¹⁷⁵ *Capital Estate and General Agencies (Pty) Limited v Holiday Inns Inc.* 1977 2 SA 916 (A) 929C.

- c. The deception has caused, or is likely to cause, damages to plaintiff's goodwill.

3.6.2 Reputation

Fundamental to a passing-off action is that the trademark must have a sufficient reputation and that use of a confusingly similar mark by another person will cause the public to believe that the goods or services of the defendant are connected to the goods or services of the plaintiff.¹⁷⁶ The reason for establishing a reputation in the trademark is simply because without such reputation there is nothing to protect.¹⁷⁷

Reputation deals with the opinion that the relevant section of the community holds of the goods or products of the plaintiff. A reputation means that the get-up or the trademark has become associated in the mind of the public with goods emanating from the plaintiff and by itself this get-up has become distinctive of his goods.¹⁷⁸ The reputation must have existed at the time the defendant entered the market and also when the misrepresentation was committed.¹⁷⁹ Reputation is proven by showing the awareness of the public of a particular product. However, in the case of *SC Johnson & Son Inc. v Klensan (Pty) Ltd t/a Markrite*,¹⁸⁰ it was held that the mere fact that there was large-scale advertising, or even a substantial sale, does not in itself prove the existence of a reputation. On the other hand, it seems that the courts can infer the existence of a reputation from these factors if no direct evidence is available.¹⁸¹

After proving reputation the plaintiff has to prove to the court that the representation made by the defendant's trademark has caused deception or confusion to the public that the goods or services of the defendant are those or are related to those of the plaintiff. It was stated in *Hoescht Pharmaceuticals (Pty) Ltd v The Beauty Box (Pty) Ltd*¹⁸² that:

¹⁷⁶ Ramsden *Guide to Intellectual Property Law* 361.

¹⁷⁷ *Ibid.*

¹⁷⁸ *Ibid.*

¹⁷⁹ *Ibid.*

¹⁸⁰ *SC Johnson & Son Inc. v Klensan (Pty) Ltd t/a Markrite* 1982 (4) Sa 579 (T).

¹⁸¹ *GPS Restaurante BK v Cantina Tequila (Mexican Connection)* CC 1997 (1) ALLSA 603 at 609.

¹⁸² *Hoescht Pharmaceuticals (Pty) Ltd v The Beauty Box (Pty) Ltd* 1987 (2) SA 600.

'Confusion per se does not give rise to an action for passing-off. It does so only where it is the result of a misrepresentation by the defendant that the goods which he offers are those of the plaintiff or are connected with the plaintiff. That has not been shown. The cause of any confusion is probably to be found elsewhere.'¹⁸³

How then does this apply to traditional products? Again, the example of the word *Omaere* that had been used and marketed by NamDairies for more than 15 year now will be used. One can say that the company has acquired a reputation with this product over the years and the word *Omaere* has become distinct to the product of NamDairies. It goes without saying that under the current laws, the company can successfully prevent other persons from making use of the word *Omaere* in trade, including the indigenous communities where the word originally emanates from.

Currently the only way indigenous communities can prevent occurrences like this is by the use of defensive mechanisms to prevent the misappropriation of TCEs. The indigenous communities can, for example, also object to the claims of false connection to it by third parties who use TCE in a way that misleads consumers by suggesting a connection with a particular traditional community that is not true.¹⁸⁴

3.7 *Certification and collective mark*

Certification marks are one of the special types of marks that are specifically excluded from the definition of mark.¹⁸⁵ Its main function is to inform the public that certain characteristics of the product or services marketed and sold under the mark are of a certain standard stipulated by the proprietor of the mark. Section 187 (2) provides that geographical names or other indications of origin may be registered as certification or collective trademarks. The Act further lays down the procedure for the registration of these type of marks.¹⁸⁶ A certification mark is used for example, to guarantee

¹⁸³ At 619 D.

¹⁸⁴ Zografos *Intellectual property and traditional cultural expressions* 220.

¹⁸⁵ See the section on the definition of a mark.

¹⁸⁶ Section(s) 187-190.

the origin of the product, the material, mode of the manufacturer and quality of the goods or services.¹⁸⁷

Certification marks can be used by TCE holders to indicate that their products or services are produced by a traditional community that is found in a particular region. For instance, in Namibia, the product is produced according to TK methods that meet a certain standard.¹⁸⁸ Certification marks are mostly advantageous for traditional communities since they allow collective use of the mark so long as the users meet the set standard. Particularly, certification and collective marks have been used in some regions of the world to protect TCE; however, in most of these instances, they have been used to protect art and craft.¹⁸⁹

Certification trademarks are valuable and can be used by traditional communities; however, they have some limitations. Worth stating is the fact that even though such marks provide trademark protection against the use of the certification marks, they do not stop third parties from making counterfeit cultural products without applying the certification mark.¹⁹⁰

3.8 *Geographical indications*

The GI have come to be known as geographical names or words associated with places that are used to identify the origin, quality, reputation or other characteristics of the product. Traditionally, GIs have been associated with agricultural products, foodstuff, wines and spirits; however, since the recent debates on the protection of TK and TCE, GIs have been seen to be potentially useful in the protection of the TK/TCE of the traditional communities.¹⁹¹

In terms of Article 22 of the TRIPS Agreement,¹⁹² GI are indicators that identify a product as originating in the territory of a particular country, or a region or locality in that territory, where a given quality, reputation or other

¹⁸⁷ Zografos *Intellectual property and traditional cultural expressions* 108.

¹⁸⁸ Rutherford "The law of trademarks" in *Intellectual Property in South Africa* 82.

¹⁸⁹ The Toi Iho trademark in New Zealand, Alaska's Silver hand Program in Alaska and the Indigenous Art Certification System in Australia are some of the world's famous marks that protect Craft and Arts of indigenous communities in those regions.

¹⁹⁰ Frankel *Victoria University of Wellington Legal Research Papers* 10.

¹⁹¹ Zografos *Intellectual property and traditional cultural expressions* 164.

¹⁹² Hereinafter referred to as TRIPS

characteristic of the product is essentially attributable to its geographical origin.¹⁹³ The concept of GIs refers to an intellectual property right that is recognised by legal bodies of various countries and international organisations.¹⁹⁴ GI's are similar to trademarks only to the extent that they both function as source indicators. However, the fundamental distinction lies in the fact that while trademark identifies goods or services as originating from a specific producer, GIs do not identify the producer, but the geographical region from where the product originates.¹⁹⁵ Some of the most well-known and famous GIs are *champagne* from France, *tequila* from Mexico and *Swiss Chocolates* from Switzerland.

According to Singhal,¹⁹⁶ GIs are designed to reward goodwill and reputation created over many years. In fact, they do not confer a right over the use of certain information, but simply control who can use certain words, symbols or signs.¹⁹⁷ Looking at it from this vantage point some proponents of GIs suggest that GIs can be used by the TK holders as a form of identification that a particular traditional product does originate from a specific country, territory or region.¹⁹⁸ This will afford the holders of the TK, once the GI has been registered, the right to prevent third parties from taking unfair advantage of the reputation of the TK from TK holders of longstanding.¹⁹⁹

Most developing countries and their indigenous communities seek to protect their geographically significant names, symbols or words for the use of these traditional communities and to prevent third parties from misappropriating these names. In recent years, there have been several suggestions that GIs can and should be used to provide some kind of protection to TCE.²⁰⁰ The rationale for this is the notion that GI's and TK have

¹⁹³ TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C.

¹⁹⁴ Ackermann & Russo *Adding value to traditional products of regional origin: A guide to creating a quality consortium* 5.

¹⁹⁵ Tong "Intellectual Property and Traditional Knowledge" in *Law of Intellectual Property in South Africa* 380.

¹⁹⁶ Singhal *Journal of Intellectual Property Law & Practice* 733.

¹⁹⁷ *Ibid.*

¹⁹⁸ Tong "Intellectual Property and Traditional Knowledge" 381.

¹⁹⁹ Frankel *Victoria University of Wellington Legal Research Papers* 6.

²⁰⁰ WIPO *Geographical Indicators: An introduction*
http://www.wipo.int/export/sites/www/freepublications/en/geographical/952/wipo_pub_95_2.pdf [Accessed 25 August 2014].

common features and aims, for example GIs are said to be suitable for use by communities to protect their marks or products because they are based on collective traditions and a collective decision-making process.²⁰¹ In protecting TCE it is important to note that GIs protect goods and they are only of assistance where the knowledge is associated with a defined geographical area. Goods requiring protection by the GI must already enjoy a commercial reputation.²⁰²

The GI system also does not come without limitations. One of the striking limitations is the fact that GIs will only be able to protect tangible TCE.²⁰³ The other problem associated with GIs is that the knowledge that is associated with the GI is not protected and thus can still be misappropriated by third parties.²⁰⁴

The next section will, by illustration of a case study of Ethiopia Heritage Coffee, show some of the implications involved when choosing to protect TK and TCE. The case study is significant to the discussions because it raises various important points that are significant to the topic under discussion, namely the registration of traditional words as trademarks, certification marks and GI's. In addition it also deals with the protection of TK/TCE as trademarks, certification marks and GI's.

3.9 Case study of Ethiopia Heritage Coffee

3.9.1 Background

Ethiopia is the producer of some of the finest coffee in the world. These coffees have unique flavours and aromas that are inherent to the Coffee produced in the Ethiopian regions.²⁰⁵ The most notable are the heritage coffees that are known as Harar, Yirgachefe and Sidamo. It must be stressed that the flavours of these coffees are not just as a result of the soil and

²⁰¹ Singhal *Journal of Intellectual Property Law & Practice* 733.

²⁰² Singhal *Journal of Intellectual Property Law & Practice* 733-734.

²⁰³ Zografos *Intellectual property and traditional cultural expressions* 188.

²⁰⁴ Ibid.

²⁰⁵ Mengistie *Intellectual Property as a Policy Tool for Development* 32.

climate of Ethiopia, but are also as a result of the cultivation methods used and developed by the Ethiopian farmers for many generations.²⁰⁶

In 2004, the government of the Federal Republic of Ethiopia launched the Ethiopian Coffee Trademarking and Licencing Incentive.²⁰⁷ The main purpose of this incentive was to provide for a practical solution to overcome the longstanding gap between what the coffee farmers received for the coffee beans and what the retailers charged for the coffee when sold in different retail outlets across the globe.²⁰⁸ The goal was to achieve extensive recognition of the distinctive quality of the Ethiopian coffee as a brand and also to position themselves strategically in the sociality of the coffee market. This protects the ownership of names that are of Ethiopian origin so as to prevent their misappropriation by third parties.²⁰⁹ This strategy ensured Ethiopian ownership over the valuable coffee designations that represent the commercial reputation and goodwill of its fine coffee.²¹⁰

3.9.2 *The choice on the type of protection*

When the Ethiopian government was faced with the challenge of how best it could use IPR's to obtain exclusive ownership of the Ethiopian coffee names, in order to achieve wider international recognition and maximise the returns, it had to make a choice about which of the IPR will best protect its coffee.²¹¹ Geographical indicators, certification marks and trademarks were identified as possible IP tools to protect the names of the coffee.²¹²

One would have been persuaded to believe that GIs were the best option since the coffee was made in Ethiopia and also named after the regions in Ethiopia that made them famous; however, this option was disregarded. Some of the reasons for this were that the products are not confined to one locality, but grown in multiple localities. In addition the

²⁰⁶ O'Kicki 2008 *Loy. U. Chi. Int'l L. Rev.*, 6, 316.

²⁰⁷ Hereinafter to be referred to as The Incentives.

²⁰⁸ WIPO *The Coffee War* available at <http://www.wipo.int/ipadvantage/en/details.jsp?id=2621> [accessed 25 August 2014]

²⁰⁹ *Ibid.*

²¹⁰ Mengistie *Intellectual Property* 32.

²¹¹ WIPO *The Coffee War*.

²¹² Mengistie *Intellectual Property* 32.

designations were not protected by GIs in Ethiopia and setting up a system was said to be impractical and too expensive.²¹³

Certificate marks were also seen to be inappropriate to provide for protection since they only denote that a certain product meets specific requirements and standards and do not necessarily prevent misappropriation.²¹⁴ In addition, it was recognised that certificate marks entailed unnecessary administrative and financial burden, which may be difficult to maintain by the government and the farmers.²¹⁵ Consequently, it was found that trademarks that served to designate distinctive features and products were appropriate to effectively realise the objectives of the initiative.²¹⁶ Trademarks, in addition, granted the government of Ethiopia the legal right to exploit, licence and use the trademarked names in relation to coffee goods to the exclusion of other traders.²¹⁷

3.9.3 *The Proceedings in USA*

The Ethiopian Intellectual Property Office (EIPO) filed trademark applications with the United States Patent and Trademarks Office (USPTO) in 2005 for Harar, Yirgachefe and Sidamo. The National Coffee Association (NCA) representing coffee roasters from USA filed an objection to the trademarks, namely Harar and Sidamo. The grounds for the objection was that Harar and Sidamo were generic terms for coffee from the Karar and Sidamo regions of Ethiopia and therefore did not meet the requirement for trademark registration.²¹⁸ USPTO turned down the application for both Harar and Sidamo.²¹⁹ EIPO filed rebuttals against the USPTO decisions with supporting evidence demonstrating that the terms had acquired distinctiveness.

²¹³ WIPO. *The Coffee War*.

²¹⁴ *Ibid.*

²¹⁵ Mengistie *Intellectual Property* 33.

²¹⁶ *Ibid.*

²¹⁷ WIPO *The Coffee War*.

²¹⁸ *Ibid.*

²¹⁹ *Ibid.*

3.9.4 *The Outcome*

The outcome of the application proceedings was that the government of Ethiopia and one of the roasters of NCA, Starbucks Coffee Corporation, reached a mutually beneficial agreement regarding the distribution, marketing and licencing of Ethiopia's heritage coffee. Starbucks agreed to sign a voluntary trademark licensing agreement that acknowledged Ethiopia's ownership of Harar, Yirgachefe and Sidamo names regardless of whether or not trademark registration had been granted.²²⁰ In 2006, the USPTO granted the rebuttal for the trademark in Harar and in 2008 a trademark was granted for Sidamo.²²¹

3.10 *Lessons from Ethiopia for other developing countries*

The farming of coffee by the farmers in the different Ethiopian regions is the TK of the people who live in those regions. This is because the Ethiopian coffee farmers are an identifiable group of people in a given community who have used, and continue to use, information that is based on experience and adoption to a local culture and environment.²²² There are many benefits that will accrue to Ethiopia by choosing trademarks over GIs to protect their heritage coffee.

For example, the GI system will require the country to have an internal registration and certification process that will require a lot of resources.²²³ According to O'kicki, this is virtually impossible for countries like Ethiopia who have very little infrastructure to develop.²²⁴ The process of starting and maintaining GI registration and certification is said to be burdensome to developing countries as this will require them to utilise valuable resources in order to be able to enter the international market place and to lay claim to

²²⁰ Mengistie *Intellectual Property* 33.

²²¹ *Ibid.*

²²² O'Kicki 2008 *Loy. U. Chi. Int'l L. Rev* 328.

²²³ O'Kicki 2008 *Loy. U. Chi. Int'l L. Rev* 331.

²²⁴ *Ibid.*

their own TK. Thus by seeking trademark protection, Ethiopia avoided the incurring cost for the establishment and implementation of the GI system.²²⁵

It is still too early to determine whether the initiative taken by Ethiopia will succeed in the long run, however, the Ethiopian experience provides developing countries, including Namibia, with valuable information that may aid them as they develop their own IP system. Accordingly, assessing whether to assert trademarks in TK is the best strategy for other developing countries will depend on the country's infrastructure, the type of government, the country's IP assets and their financial, legal and marketing support.²²⁶ The Ethiopian Trademarking and Licencing Incentives provide evidence that developing countries can participate in international trade and claim ownership of their TK without GI protection when it is not suitable for the country to do so.

3.11 Some of the disadvantages of using the Namibian Industrial Property Act to protect traditional knowledge and Traditional Cultural Expressions

After an analysis of some of the provisions of the Act, one now has to ask whether the current law can adequately protect the TCE of the Namibian indigenous communities. Trademark law is an area of IP law that can be used to protect TCE, however, it is not a perfect area. One of the notable disadvantages of using the trademark law to protect TCE is the limits of that protection in relation to the 'use in trade.' The Act only protects marks that are, or will be, used in trade. This requirement relates to registration and the benefits that flow from the exclusive right regime of trademark law. The Act requires that the trademark must be used in trade, or proposed to be used in trade, and that this use is maintained. However, if the requirement for use is not met over a period of time there is a possibility that the mark will be removed from the trademark register for non-use on application by an interested person.²²⁷

²²⁵ Visser 2004 *Poor People's Knowledge* 207-40id.

²²⁶ O'Kicki 2008 *Loy. U. Chi. Int'l L. Rev* 335.

²²⁷ Section 176.

The other requirement that is needed by the Trademarks Act in order to register a trademark is that the mark must be 'distinguishing those goods or services from the same kind of goods or services connected in the course of trade with any other person'.²²⁸ Thus even though the mark of a traditional community may meet the requirement of mark under the Act, it may not meet the requirement for trademark because the indigenous communities in some cases just want to protect their marks from misappropriation and may not be using the mark to distinguish the goods and services in trade nor will they be applying it to goods and services.²²⁹ In most instances TK used by the communities is not used in trade or commerce, but is used by the communities for subsistence and survival. Using existing trademark registration procedures to protect TCE requires squeezing indigenous interest into a system designed to meet the interests of trade and commerce.²³⁰ The position on use for unregistered trademarks is equally the same as that under the Act so even under common law there is no recourse for indigenous communities who will not be using their knowledge for trade or commerce.

Another problem that may arise on registration of a trademark or a traditional community under the current Act is the question of determining who the owner of the TCE is. Under trademark law the requirement is that the owner of the trademark will be the one who will use the mark, however, there is no requirement for use in an indigenous community because the right to use is based largely on the association of the user to the traditional community and not on the notion of exclusive use that is found under statutory and common law.²³¹ The concept of joint ownership is provided for under section 163 of the Act; however, the section requires identifiable joint owners other than a community. According to Frankel, to overcome this problem the community may nominate an owner to use trademark registration to protect the community's rights; however, this will raise

²²⁸ Section 131.

²²⁹ Frankel 2011 *Victoria University of Wellington Legal Research Papers* 16.

²³⁰ *Ibid.*

²³¹ *Ibid.*

unnecessary issues such as whether the registered owner is the true owner.²³²

The other problem that is noticeable in the use of conventional IP to protect TCE is the fact that the protection measures must be in compliance with the TRIPS Agreement. An example of a problem that may arise in the protection of TCE within the IP systems is to be found under the South African IPLAA. Section 28N provides that the minister may confer the status of an indigenous community under IPLAA to groups of other country. However, this will only be possible if the particular community is recognised as such in their country of origin. Nkomo²³³ is of the view that this approach is not in compliance with the TRIPS. According to Nkomo²³⁴ one of the essential principles under the TRIPS is the most favoured nation doctrine. This principle is to be found under Article 4 of the TRIPS, which requires that any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other WTO members. Therefore, using the South African approach, if the minister confers indigenous community status to a community in country A and the same community is found in country B, regardless of whether this community is recognised as an indigenous community in country B or not in terms of Article 4 of the TRIPS, South Africa must recognise the community in country B.

3.12 Conclusion

The TCE can be protected by trademark laws. It is clear that there are some limitations in each of the IPRs discussed above. Equally, there are also huge advantages that can be derived by the indigenous communities. The question that was posed at the beginning of this chapter was whether the current trademark laws in Namibia are able and adequate enough to provide for TCE protection. From the discussions above, it is clear that trademark laws are able to protect TCE; however, it is also equally clear that the

²³² Frankel 2011 *Victoria University of Wellington Legal Research Papers* 16. Some of the solutions to this problem can be found in Chapter 4, which deals with the possible types of systems that can be used to protect traditional knowledge.

²³³ Nkomo 2013 *Comparative and International Law Journal of Southern Africa* 272.

²³⁴ *Ibid.*

protection offered by trademarks is not adequate enough. Trademarks can only protect marks that are used or proposed to be used in commerce. The next chapter will look at the policy options available to protect TCE.

CHAPTER 4: DIFFERENT APPROACHES FOR THE PROTECTION OF TRADITIONAL KNOWLEDGE AND TRADITIONAL CULTURAL EXPRESSION

4.1 Introduction

Intellectual property (IP) is a set of principles and rules that discipline the acquisition, use and loss of rights and interests in intangible assets susceptible to being used in commerce.²³⁵ The subject matter of IP is highly dynamic and so are its rules and principles. Over the past years, IP has evolved at a fast pace. In some areas existing legal mechanisms have been adapted to the characteristics of new subject matter.²³⁶ For areas like TK/TCE, problems have been experienced in the adaptation of the existing principles of IP to these sections of law.²³⁷

Initiatives for the protection of TK reflect a wide range of concerns and policy objectives. These objectives differ from region to region and from one traditional community to another; however, they can be categorised into four main categories.²³⁸ Firstly, the TK holders stress the difficulties they encounter in preventing and controlling the commercial use of their TK by third parties and also the fact that they do not get any benefit from this commercialisation.²³⁹ Secondly, TK holders have expressed concerns about the inappropriate and offensive use of their TK.²⁴⁰ Thirdly, they would like to be attributed for their TK as well as to be able to object to false attribution.

²³⁵ WIPO IGC. *Elements of a Sui generis System for the protection of traditional Knowledge*.

²³⁶ For example the patent system has had to adapt to biotechnological innovations and new processes of using Information technology devices. Copyrights have therefore been broadened in order to meet the challenges of computer software, protection of database and electronic commerce.

²³⁷ TK for the purpose of this discussion is understood to include expressions of folklore.

²³⁸ WIPO *Report on Fact-finding Missions on Intellectual Property and Traditional Knowledge*.

²³⁹ Zografos *Intellectual property and traditional cultural expressions* 1.

²⁴⁰ Zografos *Intellectual property and traditional cultural expressions* 5, states that inappropriate use takes two forms. Firstly it can be by distortion where traditional cultural expressions are adopted for marketing purposes without the consent of the particular traditional community or when the TCE has a sacred and cultural significance and the usage of the TCE outside the their traditional context may cause great offence and undermine the social organisation of the traditional community. It has also been observed that some industries promote non-indigenous products and business by using traditional names or signs as brand names or trademarks.

Lastly, the TK holders want to ensure the identification and preservation of the existing TK, dissemination and its continuing evolution.²⁴¹

This chapter will explore the different options available for the protection of TK and TCE. It will initially look at the progress made at the international fora for the protection of TCE. In addition a study of the Swakopmund Protocol and the South African Intellectual Property Amendment Act will be done to look at the different approaches adopted by these two instruments to protect TCE.

4.1 A brief overview of international and regional legal efforts to protect traditional knowledge

Over the past years, there have been several differing approaches on the protection of TK and TCE. One view is that TK and TCE can be protected by the existing IPR and the other view is that TK does not qualify for IPR protection because in most instances, it does not meet the formal requirement needed for protection. In fact, some scholars have described the knowledge to be too old and already in the public domain.²⁴² The division on the best way to protect TK and TCE left the world divided with no consensus on a single system that will regulate TK and TCE.

There are various limitations on the adequate protection of TK and TCE by the use of existing IP systems.²⁴³ Be that as it may IPRs have been successfully used in the past to protect against the misuse and misappropriation of TCE. The most prominent ones are the laws of trademarks, certificate marks and geographical indications.²⁴⁴

Notably, international effort and interest to protect TK²⁴⁵ can be traced to 1970 when WIPO and the United Nations Educational, Scientific and Cultural Organisation (UNESCO) recognised the need to develop measures to protect expressions of folklore, mostly linked to national, cultural and

²⁴¹ Zografos *Intellectual property and traditional cultural expressions* 5.

²⁴² For example Gervais 2001 *Fordham Intell. Prop. Media & Ent. LJ* 929.

²⁴³ Some of these limitations have been discussed under the previous chapter.

²⁴⁴ This has been discussed in the previous chapters.

²⁴⁵ For the purpose of this discussion TK includes TCE.

artistic heritage and patrimony. This led the two organisations to join efforts to develop measures to protect TCE. In 1982, the Model Provision for National Laws on the Protection of Expressions of Folklore against Illicit Exploitation and other Prejudicial Actions, was adopted.²⁴⁶ The model established a *sui generis* system of intellectual property-type protection for TCE. The aims of the Model reflected the necessity to maintain an appropriate balance between the protection against abuse of TCE and the freedom and encouragement of their further development and determination.²⁴⁷

The other phase began in the late 1980 and culminated with the adoption of the Convention on Biological Diversity (CBD)²⁴⁸ in 1992. Under the Convention the most important TK provision is Article 8 (j) that expects that member States should subject to their national legislations:

‘...respect, preserve and maintain knowledge, innovations and practices of indigenous and local communities embodying traditional lifestyles relevant for the conservation and sustainable use of biological diversity and promote their wider application with the approval and involvement of the holders of such knowledge, innovations and practices and encourage the equitable sharing of the benefits arising from the utilization of such knowledge, innovations and practices.’²⁴⁹

The CBD expressly recognised the importance of TK in the conservation, management and development of biodiversity and its components and as such requires member parties to take steps to protect TK, innovation and protection of indigenous and local communities. The CBD also calls for prior informed consent,²⁵⁰ participation of indigenous and local communities and benefit sharing as a condition for the use of TK.²⁵¹ These principles became very important in the protection of TK and were not only limited to biodiversity.

²⁴⁶ UNESCO-WIPO 1982 *Model Provisions for National Laws on the Protection of Expressions of Folklore Against Illicit Exploitation and Other Prejudicial Actions*.

²⁴⁷ Zografos *Intellectual property and traditional cultural expressions* 8.

²⁴⁸ Convention on Biological Diversity 1760 UNTS 79; 31 ILM 818 (1992).

²⁴⁹ Convention of Biological Diversity Article 8(j).

²⁵⁰ Article 15(5).

²⁵¹ Article 1 generally states the concept of benefit sharing. Articles 15(7), 16 and 19 specifically indicate that benefits derived from the uses of genetic resources should be fair and shared equitably.

In 2001, as a result of the WIPO's interest and institutions competence in IP as well as its mandate to protect intellectual property right, an international process was launched to explore how to legally protect TK and TCE.²⁵² The fact-finding missions were designed to enable WIPO to identify the IP needs and expectations of traditional holders. The purpose of the report was to provide information to, amongst others, WIPO member states, TK holders and interested parties on the IP needs of the TK holders expressed to WIPO during the fact finding missions.²⁵³ This report is said to be the most comprehensive collection to date of legal anthropological data relating to the ongoing effort to develop legal answers to the challenges posed by universal demands to protect TK.²⁵⁴

The United Nations Declaration on the Rights of Indigenous Peoples²⁵⁵ was adopted in 2007. The declaration is said to be the most important international non-binding instrument addressing indigenous people's rights, including the protection of their IP, collective creations and innovations. Specifically Article 31 (1) of the Declaration provides that:

'Indigenous peoples have the right to maintain, control, protect and develop their cultural heritage, traditional knowledge and traditional cultural expressions, as well as the manifestations of their sciences, technologies and cultures, including human and genetic resources, seeds, medicines, knowledge of the properties of fauna and flora, oral traditions, literatures, designs, sports and traditional games and visual and performing arts. They also have the right to maintain, control, protect and develop their intellectual property over such cultural heritage, traditional knowledge, and traditional cultural expressions.'²⁵⁶

Article 31 (2) further declares that States, in conjunction with the indigenous communities, will take effective measures to protect and recognise these rights.

International initiatives for TK protection have been rapidly followed by a series of regional and national initiatives. Important and milestone-setting in

²⁵² WIPO *Report on Fact-finding Missions on Intellectual Property and Traditional Knowledge* 15.

²⁵³ Ibid.

²⁵⁴ Hinz 2011 *Namibian Law Journal*, Volume 3 Issue 1.

²⁵⁵ United Nations Declaration on the Rights of Indigenous Peoples.

²⁵⁶ Article 31(1).

Southern Africa is the Swakopmund Protocol on the Protection of Traditional Knowledge and Expressions of Folklore²⁵⁷ that was adopted by the ARIPO. Other countries such as South Africa have also adopted laws to specifically provide for protection of the IP of their indigenous people.

4.2 The Work done by the WTO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore

In 2000, WIPO established the Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC).²⁵⁸ The main purpose of IGC was to establish how TK and TCE should be best recognised and protected under the international and domestic laws.²⁵⁹ Soon thereafter, the countries of the world had become divided on the best mode of protection for TK and TCE. The developed countries supported the IP legal approach and the developing countries supported a *sui generis* legal approach because they felt that TK and TCE were not strictly IP in nature, but were cultural and unique to the community life and heritage of their indigenous people.²⁶⁰ The developing countries also felt that TK/TCE required special and general perpetual succession.²⁶¹

Within the IGC, it has been conceded that some aspects of TK and TCE may be protected under the IP system; however, it has also been well known that the IP system alone is inadequate to meet the needs of TK holders and that an alternative to, or an overhaul of, the current system is needed to protect IPR of the indigenous communities.²⁶²

The IGC has recognised the indigenous community's needs and suggested that those needs that cannot be met by the existing IP framework could perhaps be met through an establishment of a *sui generis* system and or through the use of non IP mechanisms. This can be done through laws

²⁵⁷ Hereafter to be referred to as the Swakopmund Protocol.

²⁵⁸ Further reading on the creation of the IGC document WO/GA/26/6.

²⁵⁹ Ibid.

²⁶⁰ A detailed discussion on the proposals made by the different group of countries can be found in WIPO ICG document WIPO/GRTKF/IC/4/15.

²⁶¹ Ibid.

²⁶² Ibid.

relating to, for example, cultural and other human rights, dignity and defamation.²⁶³ Currently, IGC is busy engaging in text-based negotiations with the objective of reaching an agreement on an international instrument(s), which will ensure the effective protection of TK and TCE.²⁶⁴

4.3 Different options for the legal protection of traditional cultural expressions

At the root of the debates on the protection of TK is the statement that IP law, as it stands in international treaties, domestic legislation and decided cases, does not protect TK.²⁶⁵ At the core of these debates is the question of whether IPR or a *sui generis* system will adequately protect the rights of indigenous communities.²⁶⁶ IP systems are diverse in nature and in terms of the policy goals that they intend to achieve. The primary purpose of most of the branches of IP systems is to protect and promote human intellectual creativity and innovation.²⁶⁷ For trademark and geographical indications, the aim is to protect the goodwill and reputation of the products or services under the mark.

Under the trademark system, there are registration and renewal formalities that are said to be an obstacle for use of the system by traditional and indigenous communities. Communities have also expressed concerns over the use by third parties of words, names, designs, symbols and other distinctive signs in the course of trade and registering them as trademarks.²⁶⁸ Locating ownership of the TCE is also another problem in its protection because the TCE is shared by more than one indigenous community either in the same national territory or in different territories. For example, within Namibia one may find that the OvaHerero and the OvaHimba communities share some TCE. Furthermore the San Communities are not only found in

²⁶³ WTO Gap analysis Annex 1 p11 paragraph 37.

²⁶⁴ They also seek an instrument that will best protect genetic resources and traditional knowledge.

²⁶⁵ Hinz *Namibian Law Journal* 104.

²⁶⁶ Arowolo *Intellectual Property Rights* 24.

²⁶⁷ Sackey et al 2010 *African Health Monitor* 90.

²⁶⁸ WIPO *Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore* 11.

one country, but are scattered all over Southern Africa and live chiefly in Angola, Botswana, Namibia, South Africa, Zambia and Zimbabwe.²⁶⁹ This is a major problem especially when dealing with ownership of the TCE. The IGC has made a few suggestions to overcome this problem. It has made suggestions such as co-ownership of rights and allowing the communities to separately hold rights in the similar TCEs²⁷⁰ or to vest the right in the state or a statutory body.²⁷¹

There are various options available for Namibia for the protection of TK/ TCE, through:

1. existing IP Laws and legal systems;
2. extended or adopted IP rights specifically focussed on TK;²⁷² or
3. A new stand- alone *sui generis* system which gives rights in TK as such.

The next section will outline the system that was adopted through the Swakopmund protocol and the one that is adopted by South Africa. The main purpose of studying these systems is to provide a framework for Namibian in order to establish which system will best suit the needs of the Namibian indigenous communities.

4.4 The sui generis protection of traditional knowledge

Sui generis is a Latin phrase that means 'of its own kind'; therefore, a *sui generis* approach for the protection of TK/TCE means this system will be unique in its characteristics outside the known framework of IP systems.²⁷³ It is a regime specially tailored to meet the needs of the indigenous communities to protect TK and TCE.²⁷⁴ For example, such a system would enable a focus on defining values and standards that could be applied to the

²⁶⁹ *Bushman People traditions and Cultures* Available at <http://www.africancraftsmarket.com/Bushman-people.htm> [Accessed 9 July 2014].

²⁷⁰ Emphasis has been placed on allowing customary Laws and protocols to be determinant.

²⁷¹ WTO Gap analysis Annex 1 p12 paragraph 39. This issue will be discussed in detail below.

²⁷² This will be a *sui generis* aspect of IP laws.

²⁷³ Wekesa 2006 *The African Technology Policy Studies Network* 3.

²⁷⁴ *Ibid.*

protection of TK.²⁷⁵ A distinct *sui generis* system is seen as an alternative to the existing IP system because it is perceived to be able to adequately accommodate all the concerns of indigenous communities and at the same time prevent third parties from misappropriating the knowledge.²⁷⁶ Be that as it may, it has been acknowledged that the system will not be completely free of IPR in the protection of rights of the indigenous communities.²⁷⁷ The system may consist of some of the standards of IP protection combined with other forms of protection or it may not consist of any of the IP protection to protect TK.²⁷⁸ Notably, the *sui generis* system can be defined and implemented differently in one county from another, depending on the needs of the traditional communities of the particular country.

The *sui generis* system recognises the concept of group ownership. It also seeks to protect TK in perpetuity and does not require any formalities for the protection to come into effect.²⁷⁹ Traditional property rights are collective or communal in nature while IPR are inherently individual in nature.²⁸⁰ Individuals may hold the knowledge for their own use, however, according to Dutfield²⁸¹ the ownership is in most instances subject to the customary law and practice and based on the collective consent of the community.

On the recommendation of the IGC, it was proposed that since TK is holistic in nature and has a need to respond to cultural context, the *sui generis* system should not require the separation and isolation of the different element of TK,²⁸² but should rather take a systematic and comprehensive approach. The Swakopmund protocol is one of the instruments that put the *sui generis* protection of TK into practical use. The approach adopted by this protocol will be discussed in the following discussion followed by a discussion of how customary law can fit into the *sui generis* protection.

²⁷⁵ Wekesa 2006 *The African Technology Policy Studies Network* 3.

²⁷⁶ Arowolo *Intellectual Property Rights*, 24.

²⁷⁷ WIPO, IGC [20 September 2002] document WIPO/GRTKF/IC/4/8.

²⁷⁸ Dutfield 2006 *ICTSD Issue Paper* 16.

²⁷⁹ Bizer 'Sui Generis Rights for the Protection of Traditional Cultural Expressions: Policy Implications' in *Sui generis Rechte* 133.

²⁸⁰ *Ibid.*

²⁸¹ *Ibid.*

²⁸² *Ibid* 46.

4.4.1 *The Swakopmund Protocol on the Protection of Traditional Knowledge and Expressions of Folklore*

On 9 August 2010 the African Regional Intellectual Property Organisation (ARIPO) passed the Swakopmund Protocol on the Protection of Traditional Knowledge and Expressions of Folklore (Protocol) during the diplomatic conference held in Swakopmund. The protocol was signed by nine member states²⁸³ and was to come into effect three months after its sixth ratification.²⁸⁴ The Protocol was mostly inspired by the work done by WIPO, especially by the IGC. Remarkably, the protocol granted a high importance to customary law.²⁸⁵ This is commendable especially since TK/TCE belongs to the indigenous communities and as custodians of TK it is just right that their laws regulate the system.

The Protocol came at the right time when the debate on the protection of TK was at its peak. It recognised the intrinsic value of TK and the rights of holders and custodians of TK and expression of folklores to the effective and efficient protection against all acts of misuse, unlawful exploitation or exploitation of TK and folklores.²⁸⁶ The Protocol further expressed the need to respect traditional knowledge systems, traditional cultures and folklore, as well as the dignity, cultural integrity and intellectual and spiritual values of traditional and local communities.²⁸⁷ It goes further to say that the contributions made by such communities to conserve the environment, attain food security, preserve their cultural heritage and promote health should be recognised. Their contribution to the progress of science and technology was also acknowledged.²⁸⁸ In addition, the preamble stresses that:

‘...legal protection must be tailored to the specific characteristics of traditional knowledge and expressions of folklore, including their collective or community context, the intergenerational nature of their development, preservation and transmission, their link to a community’s

²⁸³ Botswana, Ghana, Kenya, Lesotho, Liberia, Mozambique, Namibia, Zambia and Zimbabwe.

²⁸⁴ Section 27.3.

²⁸⁵ Ngombe 2011 *The Journal of World Intellectual Property* 403-411.

²⁸⁶ The Protocol uses Expression of Folklores instead of traditional cultural expressions.

²⁸⁷ Preamble of the Swakopmund Protocol.

²⁸⁸ Ibid.

cultural and social identity, integrity, beliefs, spirituality and values, and their constantly evolving character within the community concerned.²⁸⁹

The main purpose of the Swakopmund Protocol is to protect TK holders against any infringement of their rights and to protect expressions of Folklore against misappropriation, misuse and unlawful exploitation beyond their traditional context.²⁹⁰

The Protocol still makes use of the term 'expression of folklores' instead of TCE.²⁹¹ The Protocol defines 'expression of folklore' as any form, whether tangible or intangible, in which traditional culture and knowledge are expressed, appear or are manifested, and comprise the following forms of expressions or combination thereof, including 'verbal expressions, such as but not limited to stories, epics, legends, poetry, riddles and other narratives; words, signs, names, and symbols'.²⁹²

On the other hand, TK has been defined to refer to 'any knowledge originating from a local or traditional community that is the result of intellectual activity and insight in a traditional context'.²⁹³

The Protocol further defines other terms; however, it asserts that the specific choice of terms to denote the protected subject matter falling under TK and expression of folklores may be determined at the national level of the contracting state.²⁹⁴ The Protocol defines exploitation as including manufacturing, importing, offering for sale, selling or using beyond the traditional context.²⁹⁵ Section 3 obligates member states to establish a national authority in its territory to implement the Swakopmund Protocol.²⁹⁶

Part three of the Protocol is specifically devoted to the protection of expressions of folklore, which from the definition includes words, symbols,

²⁸⁹ Ibid.

²⁹⁰ Section 1.1.

²⁹¹ For the purpose of the current discussion of the Swakopmund protocol the term 'expression of folklores' will be used.

²⁹² Section 2.1.

²⁹³ Section 19.2.

²⁹⁴ Section 2.2.

²⁹⁵ Section 7.3.

²⁹⁶ In terms of Section 14 the Competent Authority will be entrusted with the awareness raising, education, guidance, monitoring, registration of traditional knowledge, dispute resolution and any other activity relating to the protection of traditional knowledge of the community. Section 14.2 Provides that the Authority will also be entrusted with the task of advising the holders of protected traditional knowledge in defending their rights.

names and signs.²⁹⁷ Accordingly, protection is extended to expressions of folklores, whatever the mode of their expressions, which are:

- a. The products of creative and cumulative intellectual activity, such as collective creativity or individual creativity where the identity of the individual is unknown; and²⁹⁸
- b. Characteristics of a community's cultural identity and traditional heritage and maintained, used or developed by such community in accordance with the customary laws and practices of that community.²⁹⁹

The criteria adopted by the Protocol is broad and can include a range of subject matters, based on the principle that expression of folklores should have a connection to the community both in its preservation and transmission from one generation to another.³⁰⁰ An important element of the Protocol is the fact that protection of expression of folklores is not bound to any formalities.³⁰¹ In addition, the duration of protection is unlimited as long as the criteria for recognition of knowledge as being traditional are maintained.³⁰²

Remarkably, the Protocol makes provisions for instances where two or more communities in the same or different countries share the same expression of folklores. In this case then, the relevant national competent authorities of the Contracting States and the ARIPO office will register the owners of the rights of those expression of folklores, this being the regional mechanism for the administration and management of such rights.³⁰³ Some arguments have been raised as to how problems can be resolved where an indigenous community is found in more than one country. The practical implications of this can be found in the scenario of the San community who are scattered all over Southern Africa. ARIPO through the Swakopmund Protocol has proposed a solution to this under Section 17; however, problems may still arise where an indigenous community is found in a contracting state of the ARIPO and also in a non-contracting state. For example, the San community is found in ARIPO member states and South Africa;

²⁹⁷ Section 2.1.

²⁹⁸ Section 16 (a).

²⁹⁹ Section 16 (b).

³⁰⁰ Nkomo 2013 *Comparative and International Law Journal of Southern Africa* 263.

³⁰¹ Section 16.1.

³⁰² Section 13, the criteria as stated in Section 4.

³⁰³ Section 17.4 in addition section 22.4 provide for instances where two or more communities are in different countries then the ARIPO offices will be responsible for all the activities.

however, South Africa is not party to the ARIPO, and has its own laws that regulate TK. This will create problems and conflicts in the determination of ownership of the TK/TCE because each community in the different state may want to benefit from or receive recognition for the TK.³⁰⁴ The solution then in instances like this is trans-boundary co-operation between the States. Wekesa³⁰⁵ proposes that a regional indigenous body be set up, with minimum intervention from the states, to deal effectively with the TK/TCE in the trans-boundary context. This issue is far from settled and has a lot of implications in practice.

Ownership of the expression of the folklores is vested in local and traditional communities to:

‘...(a)whom the custody and protection of the expressions of folklore are entrusted in accordance with the customary laws and practices of those communities; and (b) who maintain and use the expressions of folklore as a characteristic of their traditional cultural heritage.’³⁰⁶

The fair and equitable sharing of benefits generated by the commercial or industrial use of the knowledge is to be part of the mutual agreement between the indigenous community and the third party.³⁰⁷ In addition, section 10 provides that any person using TK beyond its traditional context must acknowledge its holders, indicate its source and, where possible, its origin. In addition, such knowledge should be used in a manner that respects the cultural values of the holders.

State parties have an obligation to provide adequate and effective legal measures to ensure that the relevant communities can prevent the taking place without the particular community’s free and prior informed consent of:

‘...in respect of words, signs, names and symbols which are such expressions of folklore, any use of the expressions of folklore or derivatives thereof, or the acquisition or exercise of intellectual property rights over the expressions of folklore or derivatives thereof, which disparages, offends or falsely suggests a connection with the community concerned, or brings the community into contempt or disrepute...’³⁰⁸

³⁰⁴ For a detailed discussion on this issue see Nkomo 2013 *Comparative and International Law Journal of Southern Africa*, 257-273.

³⁰⁵ Wekesa 2006 *The African Technology Policy Studies Network 2*.

³⁰⁶ Section 18.

³⁰⁷ Section 9.

³⁰⁸ Section 19.2 (b).

Section 20 provides for the exceptions and limitations applicable to protection of expression of folklore.

The Protocol is an important conceptualisation of the *sui generis* protection of TK and TCE. Other regions of the world and any interested country can use it as a model for the *sui generis* protection of TK and TCE. The Protocol gives recognition and confirmation of customary law. In countries such as Namibia, the Protocol confirms the importance of customary law and gives this an additional international blessing. It also acknowledges that all the efforts to protect TK will only work when there is provision for the law that is closest to TK, this being customary law.³⁰⁹ In addition, the Protocol also links the use of TK to the principle of prior informed consent and the principle of benefit sharing.³¹⁰ Above all, the Protocol offers an approach to determine the holders of TK and TCE and this has influence on the ongoing debates about the need to concretise TK rights, and also the realm of legally protected interests in intercultural communications.³¹¹

4.4.2 The role that customary law can play in the protection of traditional knowledge in Namibia

Today, there is no African country that is free of African traditions and free of some elements that belong to western modernity. Before the arrival of colonialism in Namibia, the indigenous communities had lived for centuries according to their own distinctive laws which were passed orally from one generation to another. According to Hinz,³¹² Namibia followed the model of regulated dualism. Under this model, the state confirms traditional governance and African customary law.³¹³ Each of these systems enjoy their own place, separate from the authority structures of the state government and the law of the state.³¹⁴ A plural legal system occurs when countries have more than one source of law in their legal systems

³⁰⁹ Hinz *Environmental Law And Policy* 380.

³¹⁰ Section 9 and 19.

³¹¹ Hinz *Environmental Law And Policy* 380.

³¹² Hinz *Human rights Law* 63.

³¹³ *Ibid.*

³¹⁴ *Ibid.*

that has largely developed over a period of time as a result of colonial inheritance, religion and deep rooted socio-cultural factors.³¹⁵

Customary law is a complex, dynamic system that has constantly evolved in response to a wide variety of internal and external influences.³¹⁶ Customary law often sits alongside human rights law, land laws and IP law to protect TK. Under the Protocol, customary law has a central role to play in identifying TK and TCE,³¹⁷ in determining the rights of the holders³¹⁸ and in the resolution of local and trans-boundary conflicts over ownership of rights.³¹⁹

Traditional communities have argued over the years that in order to protect TK against misuse and misappropriation the law that should govern this should be based upon their customary laws.³²⁰ This will be done by the inclusion of customary and indigenous laws and protocols as part of a wider set of tools for the protection of TK and TCE.³²¹ These tools may encompass:

‘...existing intellectual property systems, adapted intellectual property systems with *sui generis* elements, and new stand-alone *sui generis* systems, as well as non-intellectual property options such as trade practices and labelling laws, liability rules, use of contracts, regulation of access to genetic resources, and remedies based on such torts (delicts) as unjust enrichment, rights of publicity and blasphemy.’³²²

In Namibia, customary law is recognised as a source of law, the Constitution of Namibia lays a foundation for its constitutional recognition under Article 66, which states that:

‘Both the customary law and the common law of Namibia in force on the date of Independence shall remain valid to the extent to which such customary or common law does not conflict with this Constitution or any other statutory law.’³²³

The Constitution places customary law on the same footing as common law, however, if customary law is inconsistent with any of the

³¹⁵ Adejumo *The Effectius Newsletter Issue 3 1*.

³¹⁶ Hinz “Traditional governance and African customary law: Comparative observations from a Namibian perspective” *Human rights and the rule of law in Namibia* 56.

³¹⁷ Section 4 and 16.

³¹⁸ Section 18 (a).

³¹⁹ Section 22(1) and 24.

³²⁰ WIPO, “Customary Law and Traditional Knowledge” in *Background Brief No.7 3*.

³²¹ *Ibid.*

³²² *Ibid.*

³²³ Article 66 (1).

constitutional provisions or statute then the customary law will have to be reviewed.³²⁴ Customary law has been defined in the Traditional Authorities Act³²⁵ as meaning ‘the customary law, norms, rules of procedure, traditions and usage of a traditional community in so far as they do not conflict with the Namibian Constitution or with other written law applicable in Namibia.’³²⁶

The Swakopmund Protocol does not define what a traditional community is; however, in Namibia there are established laws that provide for the protection and representation of traditional communities.³²⁷ The Traditional Authorities Act makes provision for the establishment of traditional authority by a traditional community.³²⁸ A traditional community is defined by the Act as:

‘...indigenous homogenous, endogamous social grouping of persons comprising of families deriving from exogamous clan which share a common ancestry, language, cultural heritage, customs and traditions, who recognise a common traditional authority and inhabits a common communal area, and may include the members of the traditional community residing outside the common communal area...’³²⁹

This Act has been described as a constitution of traditional governance.³³⁰ There are about 49 officially recognised traditional communities in Namibia.³³¹ Most of these traditional communities have their own customary laws and tradition. The Act further defines the functions and powers of these traditional institutions.³³² The Act provides the traditional authorities as the custodians of TK, have the function to uphold, promote, protect and preserve the culture, language, tradition and traditional values of that traditional community.³³³ It is the overall responsibility of the traditional authorities to supervise and ensure the observance of the customary law of the community by its members.

³²⁴ Ruppel & Ruppel-Schlichting *The Journal of Legal Pluralism and Unofficial Law* 40.

³²⁵ Traditional Authorities Act 25 of 2000.

³²⁶ Section 1.

³²⁷ Two of the shortcomings that the Swakopmund Protocol have been criticised for are 1) it does not define what is meant by a traditional community and 2) it does not deal with how to identify the appropriate community representatives.

³²⁸ Section 2.

³²⁹ Section 1.

³³⁰ Hinz “Customary law and the environment” in *Environmental Law and Policy in Namibia towards Making Africa the Tree Of Life* 363.

³³¹ Ruppel & Ruppel-Schlichting *The Journal of Legal Pluralism and Unofficial Law* 39.

³³² Section 7.

³³³ Section 3 (1) (c).

A far reaching provision in the Act is section 3 (3) (c) that provides that the Traditional Authority in the performance of its duties and functions under the Act may make customary law.³³⁴ The law-making power of the traditional authorities will be very important for undertaking that deal with the protection of TK where there is no existing customary law, rules or procedures that deals with the protection of the particular TK.

Various existing *sui generis* systems make reference to customary laws as an alternative or as supplements to the creation of IP rights over TK.³³⁵ Customary law can be used to determine ownership of TK/TCE and also by the traditional communities as a legal basis for their legal rights over the TK and also as a factual element in establishing a community's collective rights over TK and TCE.³³⁶ Customary law can also be used to determine the protection criteria of TK or TCE.³³⁷ It can also be used as a means of determining the procedures to be followed in securing the community's consent for the use of the TK or TCE. Traditional societies often have highly-developed, complex and effective customary systems for protecting TK.

Traditional societies often have highly- developed, complex and effective customary systems for protecting TK.³³⁸ Be that as it may, this system also does not come without its shortcomings. The shortcomings are said to be based on inadequate enforcement measures and adherence to them are seen as a voluntary matter.³³⁹

4.5 The protection of traditional knowledge by a sui generis system within the Intellectual Property system in South Africa

Another system that Namibia could adopt for the protection of TK and TCE is the protection by a *sui generis* approach within the conventional IP system. This system was first adopted in South Africa.

³³⁴ Section 3 (3) (c).

³³⁵ Sackey et al 2010 *African Health Monitor* 90.

³³⁶ Ibid 98.

³³⁷ Section 16 of the Swakopmund Protocol.

³³⁸ Sackey et al 2010 *African Health Monitor* 98.

³³⁹ Ibid.

4.5.1 Background

In an effort to recognise, affirm, develop, promote and protect Indigenous Knowledge Systems in South Africa, cabinet led by the Department of Science and Technology (DST), adopted the Indigenous Knowledge System policy in 2004. The Policy noted that due to the unique and holistic nature of indigenous knowledge system certain complications may arise in applying TK to the existing IPRs; however, the policy counter argues that these issues may be reconciled by working within the framework of the TRIPS using different forms of IPRs such as the *sui generis* form of protection to complement the current system of IP.³⁴⁰ Pursuant to this the Department of Trade and Industry formulated a policy document on the protection and commercialisation of indigenous knowledge. The main aim of this policy is to recognise and protect indigenous knowledge as a form of IP and to enable and promote their commercial exploitation for the benefit of indigenous communities from whom the knowledge originates.³⁴¹

The enactment of the Intellectual Property Amendment Act (IPAA)³⁴² is in consequence of these policy considerations. The Act amends various laws in order to provide for the protection of relevant manifestation of indigenous knowledge as a specie of IP.³⁴³ In addition the Act also gives constitutional recognition of the importance of cultural values and the freedom to participate in cultural activities by the indigenous people of South Africa.³⁴⁴

4.5.2 Trademark protection

Of importance for the topic under discussion is the amendment of the Trademarks Act, in order to provide for the recognition of indigenous terms and expression and for the registration of such terms and expressions as trademarks, to create for this purpose a further part of the trademark register,

³⁴⁰ Indigenous Knowledge Systems by the Department of Science and Technology.

³⁴¹ Notes taken from the Speech by Wilmot James in the Introduction of the Traditional Knowledge Bill Available at <http://www.pmg.org.za/files/130912protection.pdf> [Accessed 21 July 2014].

³⁴² Intellectual Property Amendment Act 28 of 2013 (South Africa).

³⁴³ The Act amends the Performer's Protection Act 1967; The Copyright Act No. 98 of 1978; Trademark Act 194 of 1993 and the Designs Act No. 195 of 1993.

³⁴⁴ Section 30 and 31 of the Constitution of the Republic of South Africa Act 108 of 1996.

to provide for the recordings of indigenous terms and expressions and to provide for further protection of geographical indications. In addition the Act provides for the establishment of a National Council in respect of Indigenous knowledge, a National Database for the recording of indigenous knowledge and a National Trust and trust fund for the purpose of indigenous knowledge.

The Act also provides for the establishment of a community protocol. This protocol will be developed by the indigenous communities themselves. It will provide for the structures of the indigenous community and its claims to indigenous cultural expression or knowledge and indigenous terms or expression or geographical indication. Details of the appointed representative of the indigenous community in whose name the traditional term or expression or the geographical indication must be registered.³⁴⁵ The Protocol will have details such as the indigenous term or expression or geographical indication that is being registered and the justification for the community claiming rights to it.³⁴⁶ In addition it must also provide procedures for prospective users of such indigenous cultural expression or geographical indications, to seek the community's prior informed consent and to negotiate mutually agreed terms and benefit sharing between the community and the third parties.³⁴⁷

The Act introduces the concept of derivative indigenous terms or expression, which is defined as any term or expression, applied to any form of indigenous term or expression recognised by an indigenous community as having an indigenous or traditional origin, and a substantial part of which was derived from indigenous cultural expression or knowledge irrespective of whether the derivative was done before or after IPAA.³⁴⁸

Part 12A of the Act deals with certification trademarks and collective trademarks. A far reaching provision is Section 43 (B) IPAA, which provides that traditional terms or expressions do not constitute a trademark, and any person who has rights in respect of a traditional term or expression prior to the commencement of the Act will also not be able to hold trademark rights in

³⁴⁵ Section 43 D (6) (b).

³⁴⁶ Section 43 D (6) (c).

³⁴⁷ This provision is amended in Section 2 of the Trademark Act No. 194 of 1993.

³⁴⁸ Amendment of Section 2 of the Trademark Act 194 of 1993.

the term or expression. Section 43C (1) further provides that if a traditional term or expression was registered as a trademark before the commencement of the Act, then it could be removed from the register. However, a traditional term or expression constitutes a certification trademark, collective trademark or a geographical indication.³⁴⁹

In order for a traditional term or expression to be registered as a certification or collective trademark, the goods or services of an indigenous community in respect of which it is registered or proposed to be registered must be distinguishable from the goods or services of another community or person, either generally or where it is subject to limitations, in relation to those limitations.³⁵⁰ The Act, in addition, provides for the registration of GI as certification or collective marks and the Registrar should clearly indicate in the register that the certification or collective mark is a geographical indication.³⁵¹

In terms of the registration of derivative indigenous terms or expression, the Act provides that the term or expression will not be registered without:³⁵²

- (a) the prior informed consent from the indigenous community;
- (b) the disclosure of the indigenous cultural expression or knowledge to the Commission; and
- (c) a benefit sharing agreement between the parties being concluded.

The Act defines an indigenous community as any recognisable community of people originating from, or historically settled in, a geographical area within the borders of South Africa who are deemed to be juristic persons in terms of the Act.³⁵³ However, some indigenous communities are to be found in neighbouring countries of South Africa. The Act does not deal with the issue of how to solve these problems.

³⁴⁹ Section 43B.

³⁵⁰ Section 43B (3).

³⁵¹ Section 43B (4) & (5).

³⁵² Section 43B (6).

³⁵³ Section 43 D (3).

4.5.3 Unregistrable trademarks

Like the Trademarks Act,³⁵⁴ the IPAA also provides for unregistrable trademarks. In terms of Section 43 C. (1) traditional terms, expressions and geographical indications cannot be registered as trademarks if:

- (a) the mark consists exclusively of a sign or an indication that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value or other characteristics of the goods or services; or mode or time of production of the goods, or of rendering the services.
- (b) marks that consist exclusively of a traditional term or expression and which in the *bona fide* and established practices of trade have become indicative of, or are generally associated with, the goods or services in respect of which the marks are sought to be registered.³⁵⁵

The provision for unregistrable is almost the same as the ones found in the Trademarks Act. As in the Trademarks Act a mark that is initially unregistrable can be registered, if it has come to be distinctive by reasons of prior use and from the reading of this provision. Even where a traditional term or expression has come to be distinctive by prior use it cannot be registered as a trademark, but only as a certificated mark, collective mark or a geographical indication.³⁵⁶ Remarkably, traditional terms, expressions or geographical indications after registration cannot be removed from the register for non-use.³⁵⁷

The Act differentiates between the terms of protection for the marks. Accordingly the protection of derivative indigenous terms or expressions of knowledge is 10 years subject to renewal and the protection of indigenous terms or expressions or geographical indication is in perpetuity.³⁵⁸

4.5.4 Criticism of the Intellectual Property Amendment Act

The passing of IPAA has not gone without criticism. In fact before its enactment the Act has been opposed by various IP attorneys and jurists in

³⁵⁴ Trademarks Act No. 194 of 1993.

³⁵⁵ Section 43 D (3).

³⁵⁶ Section 43B read with Section 43 C.

³⁵⁷ Section 43 D (18).

³⁵⁸ Section 43E.

South Africa. Of these are the criticisms by the then Deputy Chief Justice of the Supreme Court of Appeal, Justice Louis Harms, who argued that the law sought to introduce a new form of IP law, traditional IP law, into the existing statute that would be difficult to understand, especially from the lenses of the existing IP legal regime.³⁵⁹

The disapproval of IPLAA, before coming in to law, was so severe that Prof Owen Dean³⁶⁰ drafted the Traditional Knowledge Bill,³⁶¹ which was introduced by Dr Wilmot James to Parliament. The Bill introduced the stand alone *sui generis* protection of TK as opposed to the *sui generis* protection within the conventional IP system. The argument behind the introduction of the new Bill was that IPLAB could not effectively achieve the objects of protecting TK and in addition it will affect aspects of IP laws that have been developed over the years, in line with the international obligations.³⁶²

The main purpose of the Bill was, amongst others, to protect TK as a new category of IP, to decide how these IPR would be protected, to provide for ownership of the TK and IPR and other matters related to TKs.³⁶³ Trademarks are specifically dealt with under Chapter 3 of the Bill. The Bill provides for a special category of indigenous trademarks, which are defined as 'traditional mark'. According to section 1 of the Bill traditional marks mean:

- a) a certificate trademark as described in section 42(1) of the Trademarks Act;
- b) a collective mark as described in section 43(1) of the Trademarks Acts;
- c) a trademark as defined in Section 2 of the Trademarks Act; which evolved in, or originated from, a traditional community³⁶⁴

Unlike IPLAA, under the Bill a trademark as defined under section 2 of the Trademarks Act could protect TCE and not just through certificate marks, collective marks or GIs. According to the Bill, in order to qualify for protection,

³⁵⁹ Harms 2009 *Tydskryf vir Hedendaagse Romeins-Hollandse Reg* 175.

³⁶⁰ Owen Dean is a professor of law at the University of Stellenbosch, South Africa and is incumbent of the Anton Mostert Chair of Intellectual Property Law.

³⁶¹ A copy of this bill is available at: <http://blogs.sun.ac.za/iplaw/files/2013/03/Protection-of-Traditional-Knowledge-Bill.pdf> [Accessed 21 July 2013]

³⁶² These were some of the reasons that were given by Wilmot James in the Introduction of the Traditional Knowledge Bill.

³⁶³ Traditional Knowledge Bill.

³⁶⁴ Section 1 of the Traditional Knowledge Bill.

the traditional mark should be presented graphically, represented by or on behalf of the originating traditional community and must be recognised as being derived from, and characteristic of that community by a person outside of the community.³⁶⁵ Section 14 provides for traditional mark rights and provides that traditional marks will be deemed to be eligible for registration as marks under the Trademarks Act, subject to the provisions of the Trademarks. According to s 14(2) a protected mark shall be deemed to be a mark falling within a mark that is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to law, be *contra bonos mores* or be like to give offence to a class of persons. The section further provides that the mark should be open to objection when sought to be registered by any other party apart from the owner of the protected traditional mark, or someone acting on his authority.³⁶⁶

The duration of the TK mark rights are to be endured indefinitely.³⁶⁷ The traditional mark rights are to lapse and cease to have any force or effect if the traditional mark is registered as a certificate mark, collective mark or trademark under the Trademarks Act.³⁶⁸ The Bill also makes provision for common law action of passing and unlawful competition. The Bill provided that a protected traditional mark shall be deemed to be well known and enjoy repute amongst a substantial number of persons.³⁶⁹

After a series of sessions by the Parliamentary Portfolio Committee on trade and Industry the Bill was rejected. Some of the reasons given by the committee for rejection of the Bill are that the protection of TK is uncompetitive and that TK should be protected under the umbrella of IP.³⁷⁰ The committee concluded at that time that the IP Laws Amendment Bill, which incorporated the protection of TK into the existing IP legislation, was the correct approach.³⁷¹ Consequently the objections and criticism of IPLAB

³⁶⁵ Section 13 of the Traditional Knowledge Bill.

³⁶⁶ Section 14 (2) of the Traditional Knowledge Bill.

³⁶⁷ Section 15.

³⁶⁸ Section 16.

³⁶⁹ Section 17.

³⁷⁰ Report of the Portfolio Committee on Trade and Industry on the Protection of Traditional Knowledge Bill.

³⁷¹ *Ibid*, para 7.

was fruitless because despite the objections to the Bill, this was agreed to by the President and published in the Government Gazette on 10 December 2013.

4.6 Conclusion

This chapter has dealt with the systems on the Protection of TK. It outlined the historical development of the systems proposed to protect TK at the international forums. The discussion then moved on to discuss *the sui generis* approach with particular attention to the approach adopted by the Swakopmund Protocol and how customary law will assist in the protection of TK. The chapter also discussed the approach taken by South Africa, which is a *sui generis* approach within the existing conventional IP system. From the discussion it is clear that no single system has yet been adopted universally for the protection of TK. However, the system that looks most promising in the protection of TK and TCE is the stand-alone *sui generis* system like the one adopted in the Swakopmund Protocol. This system will be more convenient to set up and the fact that no registration formalities are needed makes it ideal for the registration and protection of TCE. It is conceded that the Swakopmund Protocol is not a perfect instrument, however, it is a good starting point for the protection of TK.

CHAPTER 5: CONCLUSION

There has been a great deal of debate over the past few decades on the best methods to protect TK and TCE. International communities, TK holders and national policymakers have all made tireless efforts to find the best solution to this problem. What is clear is that countries and traditional communities have to think long and hard about the best mode of protecting their TK/TCE, especially with regard to the longterm benefits for their protection. The debates on how to protect TK and TCE are still ongoing. To date work on the protection of TK has progressed gradually and little has emerged in the way of comprehensive binding law in most countries, including Namibia.³⁷² In most instances the instruments that are proposed as solutions, do not satisfy all the concerns of indigenous communities.

The importance of trademarks in everyday day life cannot be exaggerated. Traditional symbols, words, names and other cultural expressions have also been used by third parties as trademarks without the consent or approval of the indigenous communities. At the centre of the research was the question of whether traditional product names, terms and other cultural expressions of indigenous communities are eligible for registration as trademarks.

This dissertation has outlined the historical development of trademarks in Namibia. This was done with a particular focus on words that are foreign to the English language as trademarks. To this end it dealt with the issue of how in the past foreign words that were used or proposed to be used as trademarks were treated; and how the jurisprudence around them evolved. Worth noting is the fact that none of these laws had ever made provisions for TK/TCE. Consequently the laws that were applied to foreign words in the past will be applied to TCE especially to the traditional product names and words as trademarks, in absence of any special laws that deal with TCE. What is evident from the analysis of the past laws is that foreign words will be able to be registered as trademarks provided that the word does not have direct

³⁷² Zografos, *Intellectual property and traditional cultural expressions* 1.

reference to the character or quality of the product or service and is not according to its ordinary signification of a geographical name.³⁷³

There are currently no laws in Namibia that are specifically targeted at the protection of the TK or TCE of the indigenous community. By illustration of the *Omaere* case study, the study concluded that undeniably there is a need for such laws in order to prevent the misappropriation of TK and TCE and also the necessity for their protection.

The central question posed in Chapter three was whether the Industrial Property Act and common law are able and adequate to protect TCE. This was done by looking at the registration requirements of a trademark. The study concluded that trademark laws are able to protect TCE, however, the protection of TCE under trademark laws is not sufficient. For example trademarks can only be registered by the indigenous communities if they intend to use the mark in trade. However, in some instances the communities just seek to prevent the misappropriation of the marks and not necessarily to use the marks.

Furthermore, there is a risk of misappropriation of TCE from the indigenous communities by organisations that currently make use of TCE as trademarks.³⁷⁴ This is especially so for product names such as *Omaere*, which even though not registered still enjoy common law protection. Therefore it is suggested that Namibia pass laws that specifically protect TK and TCE and prevent their misappropriation by third parties.

The main objective of Chapter 4 was to explore the different options available for the protection of TK and TCE. The study observed development in the protection of TK/TCE and most importantly the contribution made by the IGC since 2001, in establishing how TK and TCE should be best recognised and protected under international and domestic laws. IGC has made progress since 2001, however, it is still busy engaging on text-based negotiations with the object of reaching an agreement on an international

³⁷³ Webster & Page *South African Law of Trademark* 3.

³⁷⁴ An example of this is *Omaere*.

instrument or international instruments that will ensure effective protection of TK and TCE.³⁷⁵

The chapter concluded that for the protection of TK and TCE, States have various options to choose from in order to adequately provide for the protection of the knowledge of the indigenous communities. The study explored the protection offered by the *sui generis* protection, analysed the provisions of the Swakopmund Protocol in the protection of TCE and how customary law can be used to protect TCE. In addition an analysis of the protection of TK/TCE within the conventional IPR was done through the South African IPLAA. The study concluded that the system that will protect TK and TCE adequately is the approach adopted by the Swakopmund Protocol, which is the *sui generis* approach that is specifically tailored for the protection of traditional knowledge.

This dissertation recommends that Namibia design laws that are specially tailored for the protection of TK and TCE and the prevention of the misappropriation of TK and TCE by third parties. The laws to be adopted by Namibia should be based on the *sui generis* system for the protection of TK and TCE. Before creating these laws the government should consult with the indigenous communities through holding workshops that facilitate their views and inputs being captured.

The laws that will be developed in Namibia for the protection of TK and TCE must take into consideration the needs and the customary laws of the indigenous communities. The laws should allow for the indigenous people to have access to just and fair procedures for resolving disputes and to effective remedies for the infringement of their IPR over their TK/TCE. Indigenous people should have the right to freely pursue their economic, social and cultural development as reinstated in various human rights instruments. Indigenous communities have the primary responsibility of protecting their IP through customary laws, customs and regulations administered through their own institutions and decision-making procedures.³⁷⁶ The Government of Namibia will need to take effective measures to ensure that indigenous

³⁷⁵ For more information about IGC work visit <http://www.wipo.int/tk/en/igc/>.

³⁷⁶ WIPO/GRTKF/IC/27/INF/9.

communities are empowered to exercise these rights at local, national, regional and international levels.

It is recommended that the law provides that access to and use of the TK/TCE should require prior and informed consent from the Indigenous community in accordance with the customary laws of that community. Failure to do so would be an infringement of the IPR of the indigenous community.

BIBLIOGRAPHY

Statutes

Constitution of the Republic of Namibia Act 1 of 1990.
 Constitution of the Republic of South Africa Act 108 of 1996.
 Copyright Act No 98 of 1978.
 Designs Act No.195 of 1993.
 Industrial Property Act 1 of 2012.
 Intellectual Property Amendment Act 28 of 2013 (South Africa).
 Patents, Designs and Trademarks Proclamation of 1923.
 Performer's Protection Act No. 11 of 1967
 The Constitution of the Republic of Namibia Act 1 of 1990.
 The Patents, Designs, Trademarks and Copyright Act of 1916
 Trademark Act No.194 of 1993.
 Trademark Act of 1905.
 Trademark Registration Act of 1875.
 Trademarks Act No 194 of 1993.
 Trademarks and Copyright Proclamation of 1940.
 Trademarks in South West Africa Act No. 48 of 1973.
 Traditional Authorities Act 25 of 2000.

Cases

Abercrombie & Fitch Co. v. Hunting World, Inc. 1976 2nd Cir. 537 F.2d 4.
Adcock-Ingram Products Ltd v Beecham SA (Pty) Ltd 1977 (2) SA 434 (W).
Beecham v Triomed 2003 (3) 639 (SCA).
Cadbury v Beacon Sweets and Chocolates 2000 (2) SA 771 (A).
Capital Estate and General Agencies (Pty) Limited v Holiday Inns Inc. 1977 2 SA 916 (A).
Century City Apartments Property Services CC and Another v Century City Property Owners Association 2010 (3) SA 1 (SCA).
Dunn & Bradstreet (Pty) Limited v SA Merchants Combined Credit Bureau (Cape) (Pty) Limited 1968 (1) SA 209.

Eastman Photographic Materials Company's application (Solio) 1898 15 RPC 476, HL.

Elisenheim Property Development Company (Pty) Ltd v Guest Farm Elisenheim & Others (A 295/2012) [2013] NAHCMD 187 (5 July 2013).

Gout v Aleploglu 1833 (6) Beav. 69 n.

GPS Restaurante BK V Cantina Tequila (Mexican Connection) CC 1997 (1) ALLSA 603.

Hoescht Pharmaceuticals (Pty) Ltd v The Beauty Box (Pty) Ltd 1987 (2) SA 600.

Moorgate Tobacco Co Ltd v Philip Morris Inc. 1984 (56) ALR 19.

Oils International (Pty) Ltd v Wm Penn Oils Ltd 1965 (3) SA 64 (T) 70G.

Phillip Electronics NV v Remington Consumer Products Ltd (No. 1) [1998] RPC.

SC Johnson & Son Inc. V Klensan (Pty) Ltd t/a Markrite 1982 (4) SA 579 (T).

South African Apartheid Museum at Freedom Park v Stainbank and another 2010 ZAGPJHC 143.

Waterman v Ayres; In the Mater of the Waterman Trade Mark 1888 (5) R.P.C 31, CA.

Books

Ackermann N & Russo F *Adding value to traditional products of regional origin: A guide to creating a quality consortium* (2010) United Nations Industrial Development Organization, Vienna.

Arowolo A *Intellectual Property Rights, Traditional Knowledge System and Jurisprudence in Africa* (2012) Ababa Press LTD Ibidan.

Gerntholtz R *A basic Guide to the Law of Trademarks* (1990) Allegreto (Pty) Ltd Cape Town.

Hansen S & Van Fleet J *Traditional knowledge and intellectual property: A handbook on issues and options for traditional knowledge holders in protecting their intellectual property and maintaining biological diversity* (2003) American Association for the Advancement of Science Washington DC.

- Hart T Vorster I *Indigenous Knowledge on the South African Landscape: Potential for Agricultural Development* (2006) SRC Press Cape Town.
- John & Kernick *South Africa: Trademarks & Names including Commentary & Acts* (1984) John & Kernick Pretoria.
- Kerley DM *The law of Trademarks, Trade Names and Merchandise Marks* (1984) Sweet & Maxwell London.
- Laird S & Wynberg R *Access and Benefits-Sharing in Practice: Trends in Partnerships Across Sectors* (2008) Secretariat of the Convention on Biological Diversity Montreal.
- Panizzon M & Cottier T *Traditional Knowledge and Geographical Indications: Foundations, Interests and Negotiating Positions* (2006) NCCR and World Trade Institute.
- Ramsden PA *A Guide to Intellectual Property Law* (2011) Juta and Company Ltd Cape Town.
- Riley M (Ed) *Indigenous intellectual property rights: legal obstacles and innovative solutions* (2004) Rowman Altamira.
- Sebastian LB *Law of Trademarks and Their Registration, And Matters Connected Therewith* (1978) Stevens and Richardson Printers London.
- Webster GC & NS Page *Webster and Page: South African Law of Trademark, Unlawful Competition, Company Name and Trading Style* 3rd ed (2011) Butterworth Durban.
- Webster GC & Page NS *South African Law of Trademarks, Unlawful Competition, Company Names, and Trading Styles* (1986) Butterworth.
- Zografos D *Intellectual property and traditional cultural expressions* (2010) Edward Elgar Publishing.

Chapters in Books

- Bizer K et al "Sui Generis Rights for the Protection of Traditional Cultural Expressions: Policy Implications" in Bizer K et al (eds) *Sui generis*

- Rechte zum Schutz traditioneller kultureller Ausdrucksweisen* (2013) University of Göttingen Göttingen 131-139.
- Gredley E “Foreign-language words as Trademarks” in Dawson N & Firth A (eds) *Perspectives on Intellectual Property: Trademarks Retrospective* (2000) Sweet & Maxwell London 83-108.
- Hinz M O “Traditional courts in Namibia – Part of the judiciary? Jurisprudential challenges of traditional justice” in Horn N & A Bösl (eds) *The Independence of the Judiciary in Namibia* (2008) Konrad Adenauer Foundation Windhoek 149-173.
- Hinz MO “Customary law and the environment” in Ruppel OC (ed) *Environmental Law And Policy In Namibia Towards Making Africa The Tree Of Life* (2013) Hans Seidel Foundation Windhoek 359-38.
- Hinz, MO “Traditional governance and African customary law: Comparative observations from a Namibian perspective” in Horn N & A Bösl (eds) *Human rights and the rule of law in Namibia* (2008) Konrad Adenauer Foundation Windhoek 59-89.
- Klopper HB “The right to attract custom and unlawful competition” in Kloppers H (ed) *Intellectual Property in South Africa* (2011) LexisNexis South Africa 3-64.
- Kur A and Knaak P “Protection of traditional names and designations” in von Lewinski (ed) *Indigenous Heritage and intellectual property: genetic resources, traditional knowledge, and folklore* 2008 Kluwer Law International The Netherlands.
- Rutherford B “The law of trademarks” in Kloppers H (ed) *Law of Intellectual Property in South Africa* (2011) LexisNexis South Africa 71-139.
- Tong LN “Intellectual Property and Traditional Knowledge” in Kloppers H (ed) *Law of Intellectual Property in South Africa* (2011) LexisNexis South Africa.
- Visser CJ “Making intellectual property laws work for traditional knowledge” in M. Finger and P. Schuler (eds) *Poor People’s Knowledge: Promoting Intellectual Property in Developing Countries* (2004) Oxford University Press and the World Bank Washington DC 207-240.

Journals

- Bachman TL "Inherent Distinctiveness, Product Configuration, and Product Groups: The Developing Law of Trade Dress" 1997 *J. Corp. L.*, 23, 501-520.
- Dean O "Quo Vadis South African Trademark law?" 1998 *S. Afr. Mercantile L.J.* 89-110.
- Dutfield G "Protecting Traditional Knowledge: Pathways to the Future" 2006 *ICTSD Issue Paper no. 16*, ICTSD, Geneva.
- Frankel S "Trademarks and traditional knowledge and cultural intellectual property rights" 2011 *Victoria University of Wellington Legal Research Papers* Volume 1 Issue No 6, 2011 1-39.
- Gervais DJ "Internationalization of intellectual property: New challenges from the very old and the very new" 2001 *Fordham Intell. Prop. Media & Ent. LJ*, 12, 929-991.
- Harms LTC "A few negative trends in the field of intellectual property rights" 2009 *Tydskryf vir Hedendaagse Romeins-Hollandse Reg (THRHR)*, Vol 72(2) 175-191.
- Hinz MO "The Swakopmund Protocol on the Protection of Traditional Knowledge and Expressions of Folklore" 2011 *Namibian Law Journal*, Volume 3 Issue 1 101-112.
- Hughes J "Traditional Knowledge, Cultural Expression, and the Siren's Call of Property" 2012 *San Diego L. Rev* 49, 1215-1265.
- Ngombe LY "The Protection of Folklore in the Swakopmund Protocol Adopted by the ARIPO (African Regional Intellectual Property Organization)" 2011 *The Journal of World Intellectual Property*, 14(5) 403-411.
- Nkomo ML "South Africa's proposed intellectual property law: the need for improved regional cooperation" 2013 *Comparative and International Law Journal of Southern Africa* 46(2), 257-273.
- O'Kicki M "Lessons Learned from Ethiopia's Trademarking and Licensing Initiative: Is the European Union's Position on Geographical Indications

Really Beneficial for Developing Nations” 2008 *Loy. U. Chi. Int'l L. Rev.*, 6, 311-339.

Ruppel O C & Ruppel-Schlichting K “Legal and Judicial Pluralism in Namibia and Beyond: A Modern Approach to African Legal Architecture?” 2011 *The Journal of Legal Pluralism and Unofficial Law*, 43 (64), 33-63.

Sackey AKA Kasilo OM & World Health Organization. “Bureau régional pour l'Afrique Intellectual property approaches to the protection of traditional knowledge in the African Region” 2010 *African Health Monitor*, 14, 89-102.

Singhal S “Geographical indications and traditional knowledge” 2008 *Journal of Intellectual Property Law & Practice* 3(11) 732-738.

Tripathi SK “Traditional knowledge: Its significance and implications” 2003 *Indian Journal of Traditional Knowledge* Vol 2(2) 99-106.

Tshosa O “The status of international law in Namibian national law: A critical appraisal of the constitutional strategy” 2010 *Namibia Law Journal*, 2(1), 3-27.

Van der Merwe A “Can traditional knowledge be effectively covered under a single "umbrella"?” 2010 *PER: Potchefstroomse Elektroniese Regsblad*, 13(4), 2-10.

Wekesa M “What Is Sui Generis System Of Intellectual Property Protection?” 2006 *The African Technology Policy Studies Network*.

Zografos JZ “The Branding of Traditional Cultural Expressions: To Whose Benefit?” 2012 *Indigenous peoples' innovation* 147-163.

International Instruments

Convention on Biological Diversity 1760 UNTS 79; 31 ILM 818 of 1992.

Paris Convention for the Protection of Industrial Property of 1883.

Swakopmund Protocol on the Protection of Traditional Knowledge and Expressions of Folklore of 2010.

UNESCO-WIPO Model Provisions for National Laws on the Protection of Expressions of Folklore Against Illicit Exploitation and Other Prejudicial Actions of 1982.

United Nations General Assembly, *United Nations Declaration on the Rights of Indigenous Peoples : resolution / adopted by the General Assembly*, 2 October 2007.

WIPO Publications

Intellectual Property Organisation (WIPO) *Intellectual property needs and expectations of traditional knowledge holders: WIPO Report on Fact-finding Missions on Intellectual Property and Traditional Knowledge (1998-2999) 2001* WIPO Geneva.

Janke T (Ed) *Minding culture: case studies on intellectual property and traditional cultural expressions* 2003 (No. 781) WIPO.

Mengistie G *Intellectual Property as a Policy Tool for Development: The Ethiopian Fine Coffee Designations Trade Marking & Licensing Initiative Experience* 2011 World Intellectual Property Organization.

Mugabe J 'Intellectual property protection and traditional knowledge.' *World Intellectual Property Organization. Intellectual Property and Human Rights*. 1999 Geneva, WIPO, 97-125.

Internet Sources

Adejumo AO "The Effect of Plural Legal Systems on International Human Rights Law and Practice And Its Impact On Women" in 2010 *The Effectius Newsletter Issue 3 1-4*.
http://www.effectius.com/yahoo_site_admin/assets/docs/Adetouns_article1.11_980958.pdf [Accessed 16 July 2014]

Andima T (26 April 2013) "Namibia: Protecting Your Intellectual Property" available at <http://allafrica.com/stories/201304260909.html?viewall=1> [Accessed 5 April 2014].

Bushman People traditions and Cultures
<http://www.africancraftsmarket.com/Bushman-people.htm> [Accessed 9 July 2014]

Indigenous Knowledge Systems by the Department of Science and Technology (9 November 2010)
<http://blogs.sun.ac.za/iplaw/files/2013/03/Indigenous-Knowledge-Systems-Impact-of-policies-of-Department-of-Science-Technology.pdf>
 [Accessed 19 July 2014].

Report of the Portfolio Committee on Trade and Industry on the Protection of Traditional Knowledge Bill [PMB 3 – 2013] (6 November 2013)
<http://www.pmg.org.za/atc131107-report-portfolio-committee-trade-and-industry-protection-traditional-knowledge-bill-pmb-3-2013> [Accessed 16 August 2014].

Wilmot J *Protection of Traditional Knowledge Bill*
<http://www.pmg.org.za/files/130912protection.pdf> [Accessed 21 July 2014].

WIPO IGC, *Elements of a Sui generis System for the protection of traditional Knowledge* (30 September 2002) Document no WIPO/GRTKF/IC/4/8. Available at
http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_4/wipo_grtkf_ic_4_8.pdf
 [Accessed 15 July 2014].

WIPO IGC, (15 March 2004) *Defensive Protection Measures Relating to Intellectual Property, Genetic Resources and Traditional Knowledge: An Update* document WIPO/GRTKF/IC/6/8
https://www.google.co.za/url?sa=t&rct=j&q=&esrc=s&source=web&cd=1&cad=rja&uact=8&ved=0CBwQFjAA&url=http%3A%2F%2Fwww.wipo.int%2Fedocs%2Fmdocs%2Ftk%2Fen%2Fwipo_grtkf_ic_6%2Fwipo_grtkf_ic_6_8.doc&ei=1ycSVIqKBYXearOwgMAB&usq=AFQjCNEb5umCW IJSBZcFgbbFxbmnU W9Q&sig2=sxS2ejkXwVyuQ5ueO6rjsQ&bvm=bv.75097201,d.d2s [Accessed 8 July 2014]

WIPO IGC, *Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore: Draft Gap Analysis* [11 October 2008]
http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_13/wipo_grtkf_ic_13_4_b_rev.pdf [Accessed 8 July 2014].

WIPO IGC, *Matters concerning intellectual property and genetic resources, traditional knowledge and folklore* (25 August 2005) Document WO/GA/26/6

www.wipo.int/edocs/mdocs/govbody/en/wo_ga_26/wo_ga_26_6.doc
[Accessed 10 July 2014].

WIPO IGC, *Overview of Activities and Outcomes of the Intergovernmental Committee* (3 April 2003) Document WIPO/GRTKF/IC/5/6
http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_5/wipo_grtkf_ic_5_12.pdf [Accessed 19 July 2014].

WIPO *The Coffee War: Ethiopia and the Starbucks Story*
<http://www.wipo.int/ipadvantage/en/details.jsp?id=2621> [Accessed 28 June 2014].

WIPO *The protection of Traditional Cultural Expressions: Draft Articles*
http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_22/wipo_grtkf_ic_22_ref_facilitators_text.pdf [Accessed 4 August 2014].

WIPO *The Protection of Traditional Knowledge: Draft Article*
http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_21/wipo_grtkf_ic_21_ref_facilitators_text.pdf [Accessed 4 August 2014]

WIPO *Traditional knowledge* [10 November 2010] <http://www.wipo.int/tk/en/tk/>
[Accessed 20 June 2014].

WIPO *What is intellectual Property Law?*
http://www.wipo.int/export/sites/www/freepublications/en/intproperty/450/wipo_pub_450.pdf [Accessed 20 July 2014]

WIPO *What you don't know about trademarks* (November 2009)
http://www.wipo.int/wipo_magazine/en/2009/06/article_0010.html [Accessed 30 June 2014]

WIPO, *Geographical Indicators: An Introduction*
http://www.wipo.int/export/sites/www/freepublications/en/geographical/952/wipo_pub_952.pdf [Accessed 27 June 2014].

WIPO, "Customary Law and Traditional Knowledge" *Background Brief no. 7*
Available at http://www.unutki.org/downloads/File/Background_Brief-ENG-N7.PDF [accessed 16 July 2014]

WIPO, *Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore, Traditional Knowledge*

Operational Terms and Definitions [20 May 2002]
http://www.wipo.int/edocs/mdocs/tk/en/wipo_grtkf_ic_3/wipo_grtkf_ic_3_9.pdf
[Accessed 15 April 2014].