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NEW ZEALAND TRADE MARKS ACT 2002
AND ITS REFERENCES TO MĀORI
—
A CRITICAL DISCUSSION

LLM RESEARCH PAPER

ADVANCED LEGAL STUDIES (LAWS 582)

LAW FACULTY
VICTORIA UNIVERSITY OF WELLINGTON

2005

R971 RUSTLER, M. New Zealand Trade Marks Act 2002



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ABSTRACT

New Zealand established the Trade Marks Act 2002 to meet the substantial changes in trade mark matters over the past 50 years. Particular focus was placed on improving the protection of trade mark rights for business and economic interests. As Māori groups' concerns regarding the former Trade Marks Act intensified, the Governments also began extensive consultation of Māori, revealing the dilemma for Māori cultural property when forced under Western-oriented trade mark law systems.

This research paper analyses the new Act with respect to its references to Māori. It focuses on the unique sections 17(1)(b)(ii) and 177 to 180 and the Governments' aims and intentions that underpin these regulations.

Analysis of the paper aims to show the meaning of the law in trade mark practice, with regard to Māori and business people. The paper is based on the thesis that the Act is dishonest legislation. It argues that the Government presented the law as a significant improvement in all relevant matters; in particular, as law that for the first time provides Māori knowledge and cultural heritage with legal protection.

It is shown, however, that the Act neither provides business/economic interests, nor Māori with satisfying law. The paper concludes that the Governments were not interested in revealing their actual intentions in trade mark matters. The Governments' political interests did not allow them to exclusively focus on business and economic interests. Therefore, the Governments introduced a few Māori regulations.

This research paper contains approximately 12,413 words (excluding abstract, table of contents, bibliography and footnotes).

I INTRODUCTION

Perhaps the most fundamental intellectual property right possessed by an indigenous people is the right to define what their intellectual property is, the right to determine the extent and meaning of the body of knowledge which shapes, and is in turn shaped by, the cultural heritage.¹

New Zealand introduced new trade mark law, the Trade Marks Act 2002, which was enforced on 20 August 2003 and replaced the Trade Marks Act 1953. The Governments aimed at responding to changes and developments in intellectual property, both on national and international levels. The Governments were ambitious in creating legislation which takes developments into account that have happened within the last 50 years. Paul Sumpter summarised the new Act with the words “[t]he new law is, in a sense, simply a tidying-up process of a culmination of changes.”²

Obtaining a more effective and smoothly operating trade mark system in accordance with modern trade and business requirements was a fundamental reason for establishing the Act.³ Another important aim was to react to Māori who have been increasingly expressing complaints about trade mark law during the past years.

Māori lawyer Maui Solomon explained the Māori concerns: “[T]he Western intellectual property rights legal system has been placed on a direct collision course with the customary intellectual property rights system of indigenous people.⁴ Trade mark law causes troubles for their cultural integrity because “trade marks may potentially involve the

¹ M Jackson *Te Pupuri nga Taonga Tuku Iho o nga Tipuna, Protecting the Treasure of our Ancestors* quoted in Robert Jahnke and Huia Tomlins Jahnke “The Politics of Māori Image and Design” [2003] 7(1) *He Pukenga Kōrero, A Journal of Māori Studies* 5, 7.

² Paul Sumpter *Trade Marks in Practice* (Lexis Nexis New Zealand Ltd, Wellington, 2004) Preface vii.

³ The strongest influence came probably from TRIPs, the Trade Related Aspects of Intellectual Property Rights Agreement (15 April 1994) 1869 UNTS 299; (1994) 33 ILM 81. It came into effect on 01 January 1995 and was signed by New Zealand on 15 April 1994. At the same time New Zealand have got a member of the World Trade Organisation (WTO) <<http://wto.org>> (last accessed on 23 February 05) in 1994.

⁴ Susy Frankel and Geoff McLay *Intellectual Property in New Zealand* (Lexis Nexis Butterworth, Wellington, 2002) 99 quoting Maui Solomon “Indigenous People Rights versus Intellectual Property Rights” in Tomas (ed) *Collective Human Rights of Pacific Peoples* Human Rights Commission, 2000, 63.

misuse or appropriation of Māori [words], symbols or other matters which can be categorised as a “sign” under trade mark law.⁵

This paper deals essentially with the new Act in respect to references to Māori. Its sections 17(1)(b)(ii) and 177 to 180 directly address Māori. These provisions contain measures which should prevent use or registration of trade marks which offend Māori feelings and refer to the establishment of an Advisory Committee. The paper critically analyses the meaning of these sections focussing on whether the new law takes Māori concerns into account and, if so, to what extent. Analysis of the wording of these sections in the context to aims of Governments and legislators takes centre stage.

Thereby I focus on an interesting peculiarity of the law comparing the wording of these sections to the pretended and actual aims of the Governments. It is argued that the law does not reflect aims which Governments and legislators have expressed during law reform. The paper assumes that the law is based on a compromise between various opinions and demands on trade mark law. The Government had the goal to establish legislation which meets as many as possible demands that have been expressed over the last years to ease opposing opinions regarding the interaction of trade mark law and Māori matters.

Analysis of this paper shows that sections 17(1)(b)(ii) and 177 to 180 are dishonest legislation which pretends to meet needs of Māori. In fact, these sections are based on unclear meaning and a compromise between different, for the most part political demands. Despite the Government having made efforts to consider Māori concerns and, for the first time, established trade marks legislation which expressly mentions Māori concerns, I conclude that this legislation ultimately does not appropriately regulate trade mark matters and take regard of cultural and intellectual property of Māori.

This paper is structured in seven parts.

⁵ Susy Frankel and Geoff McLay *Intellectual Property in New Zealand*, above n 4, 116.

The first part contains an introduction to the topic and the critical questions in this area.

The second gives a brief review of trade mark law and explains the nature and principles of trade marks rights.

The third part outlines the problems of Māori in respect to trade mark law, using examples of the trade marks practice. The differences between current trade mark law systems and Māori understanding are shown. It is argued that current trade mark law is unable to provide an appropriate legal frame for Māori cultural and intellectual property.

Section four of the paper presents in a brief overview the Governments' responses during reforming trade marks law to concerns which Māori have expressed.

The fifth part analyses in detail sections 17(1)(b)(ii) and 177 to 180 of the Act. It is mainly focused on meaning and interpretation of their wordings. The examination is made by means of the legal wordings of trade mark statutes from other countries and also of the New Zealand's former Trade Marks Act 1953. Analysis shows that interpretation of this section is difficult and causes uncertain results due to undefined and ambiguous language. Further, this part discusses the Advisory Committee and its significant attributes. Here it is focussed on the unique establishment of a Māori Trade Marks Advisory Committee and its legitimacy.

Section six analyses the intentions and aims of the Governments. Also the Ministry of Commerce's considerations regarding law reform and its recommendations to the Governments are examined. It is shown that the goals the Government expressed regarding the new Act do not conform to its actual intentions. The paper also questions for what reasons the Government did not reveal its true intentions.

The seventh part of this paper shows the negative effects of the new law on trade mark practice, in particular regarding Māori as indigenous people and New Zealand business communities.

The conclusion summarises my considerations and makes a personal suggestion for a possible approach.

The paper concentrates on sections 17(1)(b)(ii) and 177 to 180, although there are a few other sections in the Act, which refer indirectly to Māori, for example section 73(1).⁶

II *BRIEF DIGEST OF THE BACKGROUND*

Trade marks provide trade mark proprietor or registered user with the right to exclusively use the trade mark⁷ and “prevent others from using that trade mark [on or] in relation to particular goods and services.”⁸

Trade marks rights are very “valuable assets in a business.”⁹ A trade mark distinguishes a good or service from others goods or services.¹⁰ For example, the Nike trade mark serves the public for identifying the product within the range of shoes and implies a quality product. Thus the Nike trade mark ultimately serves the producer, Nike, since the trade mark increases merchandising.

Likewise the public links specific products with advertisements or recommendation of others, relates them to a specific producer and then buys the product. The brand Kellogg’s is such an example. If consumers prefer Kellogg’s products as cereal product, they look for the Kellogg’s brand on products. Due to the recognition of the brand the consumers buys Kellogg’s cereals. Thus the entire product sale increases and ultimately so does the economic growth of the producer Kellogg, what shows the value of trade marks. Kellogg is consequently interested in defending actions of other competitors that might minimise the recognition effect of their brand in public. The trade mark law system provides the right tool for this.

⁶ Trade Marks Act 2002, s 73(1) allows a “culturally aggrieved” person to attack a trade mark registration at any time under the provision that the trade mark registration was not registrable under Part 2 of the Trade Marks Act 2002.

⁷ Trade Marks Act 2002 s 10(1)(a)

⁸ Trade Marks Act 2002 ss 5(trade mark)(a)(ii), 89, 90, 101. Also Susy Frankel and Geoff McLay *Intellectual Property in New Zealand*, above n 4, 17.

⁹ James & Wells “Introduction to intellectual property in New Zealand” in Matthew Heaphy, Brookers Ltd (ed) *Intellectual Property Law in New Zealand* (Brookers Ltd, Wellington, 2003) ch 1.1.

¹⁰ Ministry of Commerce *Intellectual Property Reform Bill – Maori Consultation Paper*, above n 6, 13.

Trade mark rights also allow their proprietors/registered users to sell or to give licences of trade marks. Trade marks can further serve as security in business deals.¹¹ Thus the protection of trade marks is a very important part of the commercial world of business. Trade marks influence the value of the goodwill and, consequently, the economic values of the entire business.

III MĀORI CONCERNS ABOUT TRADE MARK LAW

Māori are indigenous people in New Zealand what means that their cultural origins are different from the cultural understanding of the majority of New Zealand inhabitants. The latter view is usually characterised as a Western perspective.

The establishment of intellectual property law system goes back to Western understanding, where the terms of cultural property and intellectual property were invented and now are regarded as separate legal entities.¹² Trade mark law is only one part of intellectual property law.

The Ministry of Commerce¹³ defined cultural property, also called folklore, as “usually refer[ing] to physical evidence of a certain stage of a culture’s development, such as works of art or archaeological and historical objects.”¹⁴

In contrast, intellectual property generally covers intangible things like “knowledge, ideas or secrets” resulting from people using their intellect.¹⁵ Western countries introduced intellectual law to provide an incentive for people to develop and produce innovations. The ultimate intention was to advance economic and social progress.¹⁶

¹¹ Trade Marks Act 2002 ss 10(1)(b),(c),(d).

¹² Ministry of Commerce *Intellectual Property Reform Bill – Maori Consultation Paper*, above n 10, 5.

¹³ Now the Ministry of Economic Development.

¹⁴ Ministry of Commerce *Intellectual Property Reform Bill – Maori Consultation Paper*, above n 10, 5.

¹⁵ Ministry of Commerce *Intellectual Property Reform Bill – Maori Consultation Paper*, above n 10, 5.

¹⁶ Ministry of Commerce *Intellectual Property Reform Bill – Maori Consultation Paper*, above n 10, 6.

Māori, however, do not distinguish between cultural and intellectual property. Aroha Te Pareake Mead mentioned, in this context:¹⁷

...[W]e [Māori] cannot separate our 'culture' from the 'intellect' anymore than we can separate our intellect from our heart, or our future from our past... cultural and intellectual property is one and the same... while it might be an academic issue for some, it is an insult to us.¹⁸

Knowledge is the underlying principle and key element of the current distinction between cultural and intellectual property law.¹⁹ Māori have troubles with the treatment of knowledge by intellectual property law. Māori think differently about what constitutes knowledge and how law should treat knowledge. In particular, trade mark law would not completely protect Māori words, symbols, sounds or smells. In fact, trade mark law delivers rights that relate to knowledge but does not prevent misuse or appropriation of knowledge. Trade marks only provide their users or proprietors with the exclusive right to use them in relation to specific goods or services.²⁰ These rights are “private rights, of limited duration, which depend generally on novelty and disclosure.”²¹

In contrast, Māori gain knowledge from their ancestors, who pass their cultural/traditional knowledge from generation to generation.²² This means that Māori knowledge neither is novel nor should be revealed. For example, Māori signs like the Māori word *mana*²³ or the symbol of the *koru* spiral²⁴ go back to the knowledge of Māori ancestors.

¹⁷ Robert Jahnke and Huia Tomlins Jahnke “The Politics of Māori Image and Design”, above n 1, 7.

¹⁸ A Mead *Cultural and Intellectual Property Rights of Tangata Whenau. Women in science* (The Research Unit for Māori Education, Wellington, 1993) (footnote in original).

¹⁹ Robert Jahnke and Huia Tomlins Jahnke “The Politics of Māori Image and Design”, above n 1, 6-7.

²⁰ See above II in detail.

²¹ Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing II* (Report of the Meeting with the Select Commerce Committee, Wellington, 13 November 2001) 4 quoting Maui Solomon in a discussion before the committee on 01 November 2005.

²² Ministry of Commerce *Intellectual Property Reform Bill – Maori Consultation Paper*, above n 10, 9. Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing II*, above n 21, 4.

²³ Herbert W Williams, *Dictionary of the Maori Language* (7ed, Legislation Direct, Wellington, 2000): Māori *mana* for English *integrity, charisma, prestige* but also in a geographical sense.

²⁴ Herbert W Williams, *Dictionary of the Maori Language*, above n 23: Māori *koru* means English folded, blue flowered koru, apostrophe, carved spiral pattern.

Nevertheless, often local manufacturers or small consultant companies of New Zealand register or use Māori signs as trade marks. They hope to increase marketability of products or services when associated with Māori culture or used as geographical indications. For example, a transport service company in Porirua acting under the name Mana Coach Services Ltd uses the Māori name *mana*.²⁵ Also the logo of Auckland City community arts facility once contained the *koru* spiral.²⁶ In addition, smells which go back to traditional Māori knowledge are commercially used. So New Zealand Living Nature sells skin care products²⁷, made out of *manuka* oil and extracts from *harakeke*, which have a spiritual meaning in Māori culture.²⁸

Māori collectively possess knowledge in the form of guardianship, for example, “the wisdom of *tipuna*²⁹ and the principle of *kaitiakitanga*³⁰.”³¹ This concept, however, does not conform to trade mark law. Sections 5(owner)(a) and (b) of the new Trade Marks Act require that individual persons, body corporates or collective associations (the latter in case of a collective trade mark a) are allowed as registrable trade mark owners.³²

Further, trade mark law protects trade marks for only a restricted time, which is contrary to Māori understanding. The underlying idea is “to limit the scope and duration of monopolies.”³³ For example,

²⁵ Mana Transport Service Ltd, Porirua, Wellington, Homepage <www.manacoach.co.nz> (last accessed 04 February 2005).

²⁶ Michael Smythe, for CREATIONZ Consultants “Submission to the Commerce Committee on the Trade Marks Bill 2001”. The current homepage of Artstation, Auckland City community arts facility, however, shows a new, different logo missing out the *koru* spiral <<http://www.aucklandcity.govt.nz/whatson/arts/artstation/default.asp>> (last accessed on 22 February 2005).

²⁷ [thepharmacy.co.nz](http://www.thepharmacy.co.nz) Australia and New Zealand, homepage for Living Nature skin products <<http://www.thepharmacy.co.nz/thepharmacy/livingnature>> (last accessed on 22 February 2005).

²⁸ Herbert W Williams, Dictionary of the Maori Language, above n 23: Māori *harakeke* for English flax leaf and Māori *manuka* is New Zealand tea tree.

²⁹ Herbert W Williams, Dictionary of the Maori Language, above n 23: Māori for English ancestor, grandparent.

³⁰ Herbert W Williams, Dictionary of the Maori Language, above n 23: Māori for English guardianship.

³¹ Robert Jahnke and Huia Tomlins Jahnke “The Politics of Māori Image and Design”, above n 1, 7.

³² According to the Māori Trust Boards Act 1955, ownership by a body corporate is possible which comprises also trusts boards which Māori iwi already use as alternative. For example, the Aorangi Māori Trust Board or the Arawa Māori Trust Board.

³³ Ministry of Commerce *Intellectual Property Reform Bill – Maori Consultation Paper*, above n 10, 9.

sections 57(1), 58, 59 and likewise 62 to 68 and 73 to 75 of the Trade Marks Act regulate the scope of trade mark rights. Māori, however, expect to obtain rights to cultural or intellectual property without artificial limitations.³⁴

Another problem is also that “Māori attribute spiritual and cultural significance to certain words, images and locations.”³⁵ This means that Māori signs in trade marks might cause problems according to Māori view. A trade mark containing Māori signs is then inappropriate to Māori understanding when Māori feel offended by its use or registration in relation to goods or services the trade mark is applied to.

An example is the former trade mark where the picture of a chief illustrated food products. This was offensive to Māori because “[w]ithin Māori culture the conjunction of food and carved imagery is often perceived as problematic since Māori conceived cooked food as neutralising agent of *tapu*”³⁶.³⁷ Thus, the head of a chief cannot be positioned on food, for example butter, because this lifts the *tapu* of Māori chief.³⁸

Also, the Danish company Lego created a mood of excitement amongst Māori, when using Māori name *pōhatu* for hi-tech toys.³⁹ Māori were concerned because *pōhatu* stands for stone or rock,⁴⁰ which for Māori embodies sacred spirits and is perceived as living thing. Thus the use of *pōhatu* is inappropriate in relation to artificial hi-tech warriors serving as a children’s toy.

³⁴ Robert Jahnke and Huia Tomlins Jahnke “The Politics of Māori Image and Design”, above n 1, 7; Ministry of Commerce *Intellectual Property Reform Bill – Maori Consultation Paper*, above n 10, 9.

³⁵ IPONZ *Practical Guidelines, Trade Marks Act 2002 –Absolute Grounds: General* (Wellington, 08 August 2003) <<http://www.iponz.govt.nz/pls/web/dbssiten.main>> (last accessed on 07 March 2005) 36.

³⁶ IPONZ *Practical Guidelines, Sections 177-180 of the Trade Marks Act 2002, Maori Advisory Committee & Māori Trade Marks* (Wellington, 16 September 2004) <<http://www.iponz.govt.nz/pls/web/dbssiten.main>> (last accessed on 16 February 2005), 3.3: ... *tapu* can be interpreted as ‘sacred,’ or... ‘spiritual restriction’ or ‘implied prohibition’, containing a strong imposition of rules and prohibitions. A person, object or place, which is *tapu*, may not be touched or come into human contact. ... Māori consider ‘rangatira (chief)’ and ‘whakairo (carving)’ to be *tapu* and ‘food’ to be *noa*. ... [T]o associate something that is extremely *tapu* with something that is *noa* signifies an attempt to lift the *tapu* of the rangatira and whakairo – and therefore appears offensive.

³⁷ Robert Jahnke and Huia Tomlins Jahnke “The Politics of Māori Image and Design”, above n 1, 20.

³⁸ Robert Jahnke and Huia Tomlins Jahnke “The Politics of Māori Image and Design”, above n 1, 20.

³⁹ Kim Griggs “Maori take on hi-tech Lego toys” (26 October 2001) *BBC News* <<http://news.bbc.co.uk/1/hi/world/asia-pacific/1619406.stm>> (last accessed on 22 February 2005).

⁴⁰ Herbert W Williams *Dictionary of the Maori Language*, above n 23: Māori *pōhatu* or *pōwhatu* for English *stone, rock*.

Summarising these preceding considerations, it manifests that Māori knowledge is not completely regarded by trade mark law, which causes troubles for Māori *taonga*⁴¹ and cultural integrity.⁴² However, trade mark legislation has not the legitimate goal to completely protect Māori knowledge or cultural heritage. Trade mark law only guarantees an exclusive right to the legitimate owner/user of the trade mark right. The protection of Māori cultural/traditional knowledge is not a particular legal aim.⁴³

Nevertheless, Māori do not stand alone with this dilemma. It relates to all indigenous people, like Hawaiians, Aborigines or Indians for example.⁴⁴

IV THE GOVERNMENTS' RESPONSE TO MĀORI CONCERNS

The National Government assigned the Ministry of Commerce⁴⁵ to review New Zealand entire intellectual property rights legislation. This also included reform of the Trade Mark Act 1953 since the law was approximately 50 years old. The Ministry of Commerce became aware of Māori concerns regarding trade mark law in 1990 after the Ministry had released a discussion paper containing particular recommendations on intellectual property law.⁴⁶ Thus the Ministry interrupted legislative work and subsequent consultations with Māori were established.⁴⁷ Several na-

⁴¹ Herbert W Williams *Dictionary of the Maori Language*, above n 23: Māori for English *treasure, property*.

⁴² Mataatua Declaration on Cultural and Intellectual Property of Indigenous People 1993 s 2(3): "Note that existing protection mechanisms are insufficient for the protection of Indigenous Peoples Cultural and Intellectual Property Rights." Also Maori Trade Marks Group, Ministry of Commerce *Maori Trade Marks: A Discussion Paper*, above n 42, 11, 16-17.

⁴³ See above II in detail.

⁴⁴ See for example regarding the Hawaiians, Robert Jahnke and Huia Tomlins Jahnke "The Politics of Māori Image and Design", above n 1, 11-14.

⁴⁵ The name of the Ministry of Commerce was changed into Ministry of Economic Development during reform of the Trade Mark Act 1953.

⁴⁶ Ministry of Commerce *Review of Industrial Property Rights, Patents, Trademarks, and Designs: Possible Options for Reform* (vols 1 and 2, Wellington, 1990). In 1991 this paper was followed by recommendations of the Ministry in Ministry of Commerce *Reform of the Trade Marks Act 1953: Proposed Recommendations* (Wellington, 1991).

⁴⁷ See also Te Puni Kokiri *Maori and Trade Marks Consultation Plan* (Wellington April 1999) (Obtained under Official Information Act 1982, Request to the Intellectual Property Team, Ministry of Economic Development).

tional hui were held.⁴⁸ In 1995, the Ministry created the Māori Trade Marks Consulting Group. The purpose of this group was to analyse Māori concerns regarding intellectual property and likewise to make recommendations on new trade mark legislation.⁴⁹

Due to recommendations of the Māori Trade Marks Consulting Group a Consultative Group was called in, which also formerly advised the Commissioners of Trade Marks at IPONZ⁵⁰ in questions of registrability of trade marks of Māori text or imagery. The then created Māori Trade Mark Advisory Committee, which I will analyse below in *V C*, traces back to recommendation of this group.⁵¹

Thus New Zealand Governments have been well informed of the problems which trade mark law causes for Māori cultural and intellectual property.

V SECTION 17(1)(b)(ii) “ABSOLUTE GROUNDS FOR NOT REGISTERING TRADE MARK: GENERAL” – AN ANALYSIS

A Wording Of Section 17(1)(b)(ii)

Section 17(1)(b)(ii) of the Trade Marks Act regulates the absolute grounds of not registering a trade mark in general and says:

The Commissioner **must not** do any of the following things:

- (a) ...
- (b) register a trade mark or part of a trade mark if -
 - (i) ...
 - (ii) the Commissioner considers that its use or registration **would be likely to offend a significant section of the community, including Maori.**

⁴⁸ Four hui in 1994 and a series of eight in May and June 1997. See in general Ministry of Commerce *Ministry of Commerce Consultation on the Reform of the Trade Marks Act 1953: Notes of Hui Discussion* (Wellington, April 1999) (Obtained under Official Information Act 1982, Request to the Intellectual Property Team, Ministry of Economic Development).

⁴⁹ Maori Trade Marks Group, Ministry of Commerce *Maori Trade Marks: A Discussion Paper*, above n 42, 7.

⁵⁰ Intellectual Property Office of New Zealand.

⁵¹ Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing II*, above n 21, 2-3.

The section substitutes the former section 16(1) of the repealed Trade Marks Act 1953, which then said:⁵²

(1) **It shall not be lawful** to register as a trade mark or part of a trade mark **any scandalous matter** or **any matter the use of which** would be likely to deceive or cause confusion or **would be contrary to law** or **morality** or would otherwise be disentitled to protection in a Court of justice.

The wording of section 17(1)(b)(ii) of the new Trade Marks Act is quite different from the former wording of section 16(1) of the Trade Marks Act 1953. The new section 17(1)(b)(ii) is also “undoubtedly unique” as shown by the comparison to other trade marks acts from the United Kingdom⁵³, Singapore⁵⁴ and Australia,⁵⁵ on which New Zealand Trade Marks Act 2002 is otherwise based.

For example, the current United Kingdom Trade Marks Act 1994 says that a trade mark should not be registered if the trade mark is “contrary to public policy or to accepted principles of morality”.⁵⁶ In accordance with the Australian Trade Marks Act, a trade mark is not allowed for registration if it “contains or consists of scandalous matter”.⁵⁷

New Zealand legislators usually uses legal regulations of these countries, mostly the United Kingdom and Australia, as instructive legal framework for establishing new law and, likewise, in general regarding New Zealand’s new Trade Marks Act.⁵⁸ Nevertheless, section 17(1)(b)(ii) and also sections 177 to 180 are exceptional cases. In my view, New Zealand legislators introduced these exceptions for special reasons.

⁵² Trade Marks Act 1953 s 16(1).

⁵³ Trade Marks Act 1994 (UK). Brendan Brow, QC and Paul Sumpter *Intellectual Property 2003* (Seminar presentation to the Law Society, Wellington, April 2003) 5: Many invasions of the Trade Marks Act (UK) were brought via the Singapore Trade Marks Act 1998 into New Zealand’s Trade Marks Act.

⁵⁴ Trade Marks Act 1998 (Singapore).

⁵⁵ Trade Marks Act 1995 (Australia).

⁵⁶ Trade Marks Act 1994 (UK) s 3(3)(a).

⁵⁷ Trade Marks Act 1995 (Australia) s 42(a).

⁵⁸ Brendan Brow, QC and Paul Sumpter *Intellectual Property*, above n 53, 5. Susy Frankel “Towards a Sound New Zealand Intellectual Property Law” in Susy Frankel and Tim Smith (eds) *Essays on Intellectual Property Law and Policy* (Victoria University of Wellington Law Review, Wellington, 2001) 47-74, 74-75.

B Meaning Of Section 17(1)(b)(ii)

Paul Sumpter suggested with regard to section 17(1)(b)(ii) that “[t]his provision, the precise wording of which is undoubtedly unique, seems to be designed especially for the benefit of Māori.”⁵⁹ I will examine this rule in detail to show whether his allegation is correct and section 17(1)(b)(ii) in fact provides particular advantages for Māori concerns. This section of the paper focuses on the wording and interpretation of section 17(1)(b)(ii).

1 Previous section 16(1) of the repealed Trade Marks Act 1953 “Prohibition of registration of deceptive, etc., matter”

What were the reasons for New Zealand legislators setting a rule like section 17(1)(b)(ii) which is significantly different to the wording of former section 16(1) of the repealed Trade Marks Act 1953?

The new wording of section 17(1)(b)(ii) includes terms of “must not” instead of formerly “shall not” in section 16(1) of the Trade Marks Act 1953. This states that the Commissioner of Trade Marks⁶⁰ should not have discretionary power, which previously - at least in theory- may give him/her some discretion regarding registrability of trade marks. The new wording of section 17(1)(b)(ii) contains a stronger statement of what is prohibited by law. This consolidates the grounds of refusal regarding trade marks. The Trade Marks Act’s heading of subpart 2 to the section 17(1)(b)(ii) strengthens this assumption since it is called the “absolute grounds for not registering trade mark”.⁶¹

The legislators used language and words which completely differ from the former wording of section 16(1) or other sections of the repealed Trade Marks Act 1953.

⁵⁹ Paul Sumpter *Trade Marks in Practice*, above n 2, 40.

⁶⁰ In the following paper called “the Commissioner”.

⁶¹ Another argument is subpart 3 of the Trade Marks Act containing “relative grounds for not registering trade mark”, where the Commissioner “may register a trade mark” in comparison to subpart 2 “absolute grounds”.

The former section 16(1) addressed the common understanding of generally accepted morality⁶² and respect⁶³ that exists in New Zealand society.⁶⁴

In contrast, the new wording of section 17(1)(b)(ii) shows a different view because it responds only to offensiveness caused by trade mark use. This amplifies the previous focus which was limited with regard to morals and ethical behaviour. For example, the section is very likely to cover cultural offensiveness. But it also defines and reduces the scope of relevant issues; for example registration of trade marks which are only in poor taste has been forbidden under previous section 16(1) but now not necessarily under the section 17(1)(b)(ii).⁶⁵

In addition, section 17(1)(b)(ii) sets some benchmarks – as I will describe below in detail – of whose perspective is decisive regarding offensiveness of a trade mark. Since the former section 16(1) lacked any benchmarks except to common morality, its wording mainly responds to generally accepted standards of the public and reflects the predominant perceptions of an average New Zealander.⁶⁶ The new section allows the Commissioner to consider a greater range of the different perspectives which exist in New Zealand with respect to section 17(1)(b)(ii) and potential offensive use or registration of trade marks.

In summary, in comparison to the former section 16(1), section 17(1)(b)(ii) appears to provide some more differentiated results because it focuses on perspectives of specific groups instead of the general public's view.

⁶² Trade Marks Act 1953 s 16(1): "... contrary to ... morality".

⁶³ Trade Marks Act 1953 s 16(1): "... any scandalous matter".

⁶⁴ IPONZ *Practical Guidelines, Trade Marks Act 2002 –Absolute Grounds: General*, above n 35, 32-33, explains beyond the literally meaning also the wider meaning of former section 16(1) by making references to United Kingdom policy in trade mark cases, like *Hallelujah Trade Mark* [1976] RPC 605, 607-608, 610 Registrar's Hearing Officer Myall.

⁶⁵ See also IPONZ *Practical Guidelines, Trade Marks Act 2002 –Absolute Grounds: General*, above n 35, 34 referring to Dick Lexic Limited's Application (25 March 2003) OHIM Fourth Board of Appeal R111/2002-4 (Dick & Fanny case).

⁶⁶ However, in IPONZ *Practical Guidelines, Trade Marks Act 2002 –Absolute Grounds: General*, above n 35, 32-34, IPONZ explains that beyond the literally meaning also "a not insubstantial number of persons" and "small sections of the community" qualify for "contrary of morality" in accordance with former section 16(1), citing *Hallelujah Trade Mark* [1976] RPC 605, 607-608, 610 Registrar's Hearing Officer Myall and 635 Simon Thorley QC.

Referring to trade marks containing Māori signs, the former section 16(1) previously did not provide great possibilities for the Commissioner to refuse the inadequate use of trade marks, which included Māori signs.⁶⁷ Although the Ministry of Commerce noted that section 16(1) would prevent trade marks containing inadequate Māori signs,⁶⁸ practical experience in the past confirms the opposite result. Between late 1996 and 2001 the Commissioners at IPONZ regarded a relatively small number of 14 trade mark applications⁶⁹ as “scandalous” and “contrary to morality” in accordance with former section 16(1).⁷⁰ Most those applications were withdrawn and only two trade mark applications were refused due to formal objections.⁷¹ One of those two applications contained characteristic Māori signs. In this application, the Māori word *Aoraki*, the Māori name for New Zealand’s Mount Cook⁷² was used.⁷³

In contrast, between July 1998 and June 1999, IPONZ noticed 445 trade mark applications which included Māori text or imagery.⁷⁴ This comparison shows that the former section 16(1) was not able to deal with Māori concerns regarding inappropriate use/registration of Māori signs. This is because section 16(1) lacked regulation/use of trade marks which are inappropriate to a traditional Māori context.

⁶⁷ See also Minister for Enterprise and Commerce *Trade Marks Act 1953: Proposals for Reform* (prepared for the Chair of the Cabinet Economic Committee, Wellington, April 1999) (Obtained under Official Information Act 1982, Request to the Intellectual Property Team, Ministry of Economic Development) Appendix A, 3.

⁶⁸ Trade Marks Focus Group *Notes of the Trade Marks Focus Group* (Trade Marks Group Meeting, Wellington, 25 October 1995) (Obtained under Official Information Act 1982, Request to the Intellectual Property Team, Ministry of Economic Development) 3-4.

⁶⁹ For example, *Trademark application no 640995, CUM AND GO in Class 25; Trademark application no 634881, Puta in Class 25; no 308186, CLIT in Class 25 or no 606777, Far-Q in Class 25*; all trade marks are abandoned in the meantime.

⁷⁰ Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing III* (Report to the Chair of the Commerce Committee, Wellington, 07 December 2001), 10. Also Minister for Enterprise and Commerce *Trade Marks Act 1953: Proposals for Reform*, above n 57, 8.

⁷¹ Trade Marks Act 1953 ss 26(2), 27(2), 16(1). *Trademark application no 314865, Bullshit in Class 32* (19 July 2001) Assistant Commissioner Gallagher. The *trade Mark Application no 20208917 and 208918, Aoraki in Class 9 and 16* (23 March 2001) (Commissioner unknown), however, was not considered at a formal hearing but was rejected by an Examiner during the examination process because the applicant did not overcome an official objection that registration of the trademark might be offensive to Maori.

⁷² Herbert W Williams, *Dictionary of the Maori Language*, above n 23: Māori for Mount Cook.

⁷³ Application was made in several classes like 9, 16, 35, 38, 42. For example, *Trade Mark Application no 20208917 and 208918, Aoraki in Class 9 and 16* (23 March 2001) Journal 1462.

⁷⁴ Minister for Enterprise and Commerce *Submission for Cabinet Economic Committee* (prepared for the Chair of the Cabinet Economic Committee, Wellington, 16 September 1999) 29.

The preceding argument is also consistent with the considerations during the long legislation process regarding a new Act. In April 1999, the previous National Government Cabinet reached consensus on the assessment that the Trade Marks Act 1953 on the whole - thus including the former section 16(1) - contained criteria, which reflected neither the current situation in New Zealand nor gave consideration to the society's requirements or the needs of business communities in New Zealand.⁷⁵ The National Government focused for the most part on the common obsolescence of the previous trade mark legislation, which being over 50 years old, did not comply with international developments in trade mark law⁷⁶ or with the changes of New Zealand business world. The Cabinet did not expressly mention that Māori concerns, in particular, would have been the reason to change the former section 16(1).

However, due to the consultations with Māori and the submissions by the Ministry of Commerce and the Cabinet Economic Committee, also the subsequent Labour-Alliance Government has been advised on Māori concerns regarding the current trade mark law system.⁷⁷

Considering the alteration of the wordings in both sections and the efforts regarding analysis of the dilemma of Māori, I conclude that new section 17(1)(b)(ii) of the Act indicates that New Zealand legislators and Governments followed the intention to respond to Māori concerns regarding trade marks containing Māori signs. The Governments and legislators' intentions will be examined below in detail.⁷⁸

⁷⁵ Cabinet Minute Cabinet Infrastructure and Environment Committee "Trade Marks Bill" (21 March 2001) FIN (01) 28 (Obtained under Official Information Act 1982 Request to the Intellectual Property Team, Ministry of Economic Development) 1 referring to Cabinet Minute "the Trade Marks Act" (26 April 1999) M11/3C and (28 July 1999) M19/2D and (22 September 1999) M24/6D. Also Minister for Enterprise and Commerce *Trade Marks Act 1953: Proposals for Reform*, above n 57, 8 and Appendix A, 3.

⁷⁶ In the nineties several new trade mark legislations were introduced in England (1994), see above n 55, Australia (1995), see above n 55, Singapore (1998), see above n 54 and also New Zealand's signature under the international Intellectual Property Rights Agreement TRIPS (1994) and membership of the WTO (1994), above n 3.

⁷⁷ Ministry of Commerce *Review of the Trade Marks Act 1953: Advisory Committee to the Commissioner of Trade Marks* (prepared for the Minister for Enterprise and Commerce, Wellington, 15 September 1999) (Obtained under Official Information Act 1982, Request to the Intellectual Property Team, Ministry of Economic Development) 1.

⁷⁸ See below in XI in detail.

Here I analyse the literal meaning of the section's wording and consider its adequate interpretation. Therefore, I will split up either single words or word combinations. In addition, I will focus on the cohesive meaning of the different word sections.

(a) "A section of the community"

The *Concise Oxford English Dictionary*⁷⁹ defines a "section" as "a distinctive group with a larger body of people or things". A section might embrace groups of gay people or Methodists, but also bigger groups, such as Pacific Islanders, Christians or even women. This is because they are all a part of New Zealand community⁸⁰ and these groups have specific characteristics, which makes them distinguishable in relation to all other people living in New Zealand. Māori are likely to qualify. Due to their recognition as indigenous people of New Zealand and the different cultural roots in comparison to the remaining New Zealanders, Māori are "a distinctive group with a larger body of people".

However, the statement of "a larger body of people" does not indicate how many people exactly comprise "a section" due to the adjective "larger" describes a vague, rather than a clearly definite number of people. This shows that the definition of a "section of the community" is very broad and covers many different communities existing in New Zealand. Therefore, the words "a section of the community" provide only broad and indefinite results.

(b) "A significant section of the community"

The additional word "significant" means that only "important, noteworthy or consequential"⁸¹ sections of the community are the relevant criteria for refusals of trade mark registration under section

⁷⁹ Soanes, Catherine and Angus Stevenson (eds) *Concise Oxford English Dictionary* (11ed, Oxford University Press, Oxford, New York, 2004).

⁸⁰ In my view, the term "the community" does not need not to be analysed in detail since it refers, due to its singular use, to all people living in New Zealand and thus all inhabitants of New Zealand.

⁸¹ Soanes, Catherine and Angus Stevenson (eds) *Concise Oxford English Dictionary*, above n 71, significant.

17(1)(b)(ii). However, “significant” itself does not explain which particular context makes “a section of the community” significant in terms of section 17(1)(b)(ii). Therefore, different contexts might change the criteria of what qualifies “a significant section” for section 17(1)(b)(ii) and might also apply for broad ranges of different groups.⁸² This, however, causes indeterminate practical results if the law is applied. New Zealand legislators commented that this would provide flexibility in applying the law and would allow the Commissioner to regard changes within communities and also modifications of values or perspectives of New Zealand’s society.⁸³

Also section’s 17(1)(b)(ii) additional condition of “offensiveness” regarding a trade mark might influence which groups are considered as “significant sections of the community”. This might also modify which “section of the community” qualifies as “significant”. The term of “offensiveness” is discussed below under (d) in detail.

Thus, “a section of the community” can be “significant” for several reasons.⁸⁴ One of those reasons can be the geographical origin. For example, the Māori Whanganui tribe is geographically significant in terms of this section because this tribe was originally located in the Whanganui river area of New Zealand.

The “significance” of a section can further be applied with respect to the size of a population. This indicates that a “noteworthy” and therefore large numbers of people or communities as a group of “significance”. The IPONZ Practical Guidelines state in this context that “[t]he significant section of the community may be a minority that is nevertheless substantial in number.”⁸⁵ However, the term “substantial in number” is lacking definition and does not explain the particular size of the section, what could have been used as a benchmark. Nonetheless, since all Māori groups together have a size of approximately 15 per cent of New

⁸² For example, Simpson Grierson “Submission to the Commerce Committee on the Trade Marks Bill 2001”.

⁸³ Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing III*, above n 70, 8.

⁸⁴ Barbara Sullivan, Trade Mark Lawyer in Trade Marks Focus Group *Draft Notes of the Trade Mark Focus Meeting* (Wellington, 16 April 1996) (Obtained under Official Information Act 1982, Request to the Intellectual Property Team, Ministry of Economic Development) 3-4.

⁸⁵ IPONZ *Practical Guidelines, Trade Marks Act 2002 –Absolute Grounds: General*, above n 35, 34.

Zealand's population,⁸⁶ Māori are a "substantial number." Thus, Māori are considerable as "a significant section of the community". However, the regard of Māori as entire population does not consider the different Māori classifications, for example, individual tribes or sub-tribes within the Māori population.⁸⁷

Finally, "a section" might also be "significant" in a cultural or historical context. The entire Māori population but also the particular Māori groupings can be regarded by a culturally "significant section in the community" due to their status as indigenous people. In addition, the cultural identity of Māori makes Māori remarkably distinctive to the rest of New Zealand's "community," who are mostly Western European. The different approach of Māori regarding trade marks law system⁸⁸ further indicates that the specific Māori culture is "significant" in comparison to other communities in New Zealand. The interpretation as culturally "significant" is very likely to be the most important criteria regarding Māori since this legal interpretation might provide also small Māori groups⁸⁹ with the opportunity to claim "offensiveness" of a trade mark.

The preceding analysis shows that these terms embrace a wide scope of meanings of the words "significant section." This also includes Māori population. The words, however, are lacking clearly defined scope. In particular, the range of groups in New Zealand – all potential groups in terms of section 17(1)(b)(ii) - requires a particular benchmark of what makes "a section of the community" "significant". In a legal context, this is likely to cause uncertainty in trade mark practice, in particular for the Commissioner and a trade mark applicant/user because the words do not provide guidance as to what kind of groups actually qualify as "significant sections of the community" and what groups do not.

⁸⁶ Maui Solomon "Intellectual Property Rights and Indigenous Peoples Rights and Obligations" *In Motions Magazine* <<http://www.inmotionmagazine.com/ra01/ms2.html>> (last accessed on 24 February 2005).

⁸⁷ Regarding differentiations of Māori population see below under VB2(c) in detail.

⁸⁸ See above III in detail.

⁸⁹ Regarding Māori groups like tribes (*iwi*), sub-tribes (*hapū*) and family tribes (*whānau*) see below V B 2(c) in detail.

(c) “A significant section of the community, including Māori”

The words “including Māori” question the preceding conclusions if this would mean that only Māori turn “a section of the community” into a “significant section” and other groups are excluded.⁹⁰ Then section 17(1)(b)(ii) should exclusively respond to Māori concerns. In contrast, Pansy Wong, MP, stated that these words indicate that Māori are the main “significant section of the community”.⁹¹ In addition, it is also possible that Māori do not qualify as “significant section” but should nevertheless be considered.

The literal meaning, however, does not confirm these assumptions. The words “including Māori” refer to “a significant section of the community”. “Including Māori” serves as an explaining amendment. The comma after “community” indicates this. The comma after “community” in relation to “including Māori” implies that Māori are “a significant section of the community.” This shows that Māori are covered by the terms of “a significant section of the community”.

This conforms to the Commerce Committee who stated that the words “signal an intent on the part of the Government to recognise the concerns of Māori ... with regard to intellectual property law, and that Māori have status as the government’s Treaty⁹² partner.”⁹³ Also, the Legal Advice, given by the Ministry of Justice, stressed that section 17(1)(b)(ii) is only consistent with the New Zealand Bill of Rights Act,⁹⁴ if other ethnical sections of the community” also qualify.⁹⁵

However, the term “Māori” does not explain how Māori are defined in this context, as the Hon Richard Prebble, MP, mentioned.⁹⁶ The word Māori comprises Māori population on the whole, but is also used for single Māori iwi (tribes), hapū (sub-tribes) or individual Māori whānau (family tribes). If “Māori” is considered with respect to “significant sec-

⁹⁰ Baldwin Shelston Waters “Submission to the Commerce Committee on the Trade Marks Bill 2001”.

⁹¹ (01 August 2001) 593 NZPD 10605-10606.

⁹² Treaty of Waitangi.

⁹³ Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing III*, above n 58, 12.

⁹⁴ New Zealand Bill of Rights Act 1990 ss 5, 19(1) and Human Rights Act 1993 s 21.

⁹⁵ Ministry of Justice *Legal Advice. Compliance with the New Zealand Bill of Rights Act 1990: Trade Marks Bill 2001* (prepared for the Attorney-General, Wellington, 19 June 2001) 25, 26 (Obtained under Official Information Act 1982, Request to the Bill of Rights/Human Rights Team, Ministry of Justice).

⁹⁶ (19 November 2002) 604 NZPD 2239.

tion”, individual and very little groups of Māori also can be subsumed under section 17(1)(b)(ii). This is because Māori iwi, hapū and even Māori whānau might be “significant sections” due to their cultural distinctiveness and character, even though these Māori groups do not enclose a substantial number of people.⁹⁷

The consideration of all Māori groups, including very little tribes, however, might cause serious problems in trade mark practice. Many different Māori groups, for example thousands of different whānau, exist. They all might feel offended by particular trade marks. Therefore, trade mark users/proprietors cannot rely on their trade mark rights. Section 17(1)(b)(ii) would then allow the smallest groups to attack trade mark registration, even though the existence of this tribe or its particular cultural feeling had never been known before. This might cause serious uncertainty. It also reduces the protection of trade mark rights. Considering the possible effects on trade mark practice, it is questionable whether this trade mark legislation aims to provide single and very small Māori groups with such rights. In my view, this interpretation is contrary to the principles of trade mark law because this would substantially reduce the rights of trade mark user/proprietors.

Nevertheless, Te Puni Kokiri preferred the additional amendment of “iwi”, “hapū” and “whānau” to section 17(1)(b)(ii). In contrast, the Ministry of Commerce did not agree with Te Puni Kokiri since they thought “iwi, hapū and whānau would fall within a ‘significant section of the community’.”⁹⁸ The Ministry of Commerce’s view gained acceptance regarding the ultimate wording of section 17(1)(b)(ii).

However, I cannot agree with this opinion because the wording does not clearly reflect this meaning. Furthermore, the wording does not define what Māori groups “Māori” covers and what groups it excludes. The wording is very likely to cause discussions about whether single, small Māori whānau could also claim a particular trade mark

⁹⁷ Maori Trade Marks Group, Ministry of Commerce *Maori Trade Marks: A Discussion Paper*, above n 42, 23.

⁹⁸ Ministry of Commerce *Trade Marks Act 1953: Trade Marks containing Māori imagery, words or symbols* (prepared for the Minister for Enterprise and Commerce, Wellington, 23 February 1999) (Obtained under Official Information Act 1982, Request to the Intellectual Property Team, Ministry of Economic Development).

use/registration as offensive to their feelings. A clear interpretation of this words, however, is still lacking. Therefore, I conclude that the construction put on the words “including Māori” does not show which Māori groupings expressly qualify. Even though this section refers to Māori, the meaning of “including Māori” remains ambiguously and causes uncertainty regarding the results on trade marks practice.

(d) “Would be likely to *offend* a significant section of the community, including Māori”

Here I examine the particular meaning of the word “offend”. Section 17(1)(b)(ii) does not define what “offend” actually means. The IPONZ Guidelines -citing the *Macquarie Dictionary*- suggest defining “offend” in section 17(1)(b)(ii) by “to irritate in mind or feeling, cause resentful displeasure in; to give offence or cause displeasure”.⁹⁹

Section 17(1)(b)(ii) does not specify which areas are subject to “offensiveness.” “Offensiveness” can relate to many areas; people’s susceptibilities can be offended in relation to their culture,¹⁰⁰ religion, morals and ethical qualities,¹⁰¹ family or social standards,¹⁰² traditional or historical values but also to mere common standards of proper behaviour¹⁰³. Section 17(1)(b)(ii) is lacking in restriction or specification regarding “offend” on purpose since “offend” should be applied in an “inherently dynamic” way. This traces back to the Ministry of Economic Development, who was afraid that some prescriptive criteria might cause inflexibility and make the Commissioner’s examination difficult.¹⁰⁴ The word ap-

⁹⁹ IPONZ *Practical Guidelines, Trade Marks Act 2002 –Absolute Grounds: General*, above n 35, 32.

¹⁰⁰ Maori Trade Marks Group, Ministry of Commerce *Maori Trade Marks: A Discussion Paper*, above n 42, 22 suggest that “‘offensive’ should include cultural offensive and culturally inappropriate.” See also *Ngati Rangatahi Whanaunga (Association) v Planning Tribunal* (30 November 1994) and (13 February 1995) HC WN CP31/95, 11 Neazor J regarding a claim in accordance to the Resource Management Act 1991 where “cultural offensiveness” was discussed.

¹⁰¹ In *Ceremalus v Police* [1991] 7 CRNZ 678 (HC) Tompkins J dealt with “offensive” regarding the question whether the presence of a nudist at a beach in the vicinity of others behaved in disorderly or “offensive” manner.

¹⁰² “Offensive” in relation to odour or noise was considered in *Wilson v Selwyn DC* [2005] NZRMA 76 (HC).

¹⁰³ In *Amor v New Plymouth District Council* [2001] NZRMA 221 Williams J considered the plaintiff’s allegation of “visually offensive” with respect to Building Act 1991 s 64(4) which also refers to “offensive.”

¹⁰⁴ Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing III*, above n 70, 8.

pears to cover a broad variety of meanings, with respect to the before-mentioned areas of, for example, culture or religion.

However, this interpretation might not conform to the New Zealand Bill of Rights Act 1990. New Zealand legislation requires that law does not interfere with rights obtained according to this Bill of Rights Act.¹⁰⁵

Section 14¹⁰⁶ provides the right to freedom of expression. The right to freedom of expression applied to trade mark law means that people are free to use and register trade marks and likewise express personal opinions.¹⁰⁷ A very broad interpretation of “offensiveness” might restrict or completely abolish the right to freedom of expression. This would happen if any susceptibility - irrespective of whatever matter and form - qualifies in terms of section 17(1)(b)(ii) and allows extensive attacks of trade mark rights. This restricts the people’s right to freely choose the signs of their trade mark and thereby to express personal opinions. For example, if the merely vague or uncomfortable feeling of a small Māori group with regard to the use of trade marks in general would already allow them to claim rights in accordance with section 17(1)(b)(ii), the protection of trade mark rights would be reduced to a minimum. Thus “offend” should be restrictively interpreted.

New Zealand legislation often uses the adjective “offensive”, relating to the same word family as “to offend”. For example, the Resource Management Act 1991 or the Sentencing Act 2000 refers to “offensive”.¹⁰⁸ There are many cases referring to “offensive.” In *Flint v Hellaby Peach Products*,¹⁰⁹ a case under the Food and Drug Act 1969 about a foreign body in food, “offensive” meant “disgusting”, “nauseous” or “repulsive”. According to *Minhinnick v Water Services Ltd*¹¹⁰ “offensive” requires in the Resource Management Act 1991 a subject matter that has

¹⁰⁵ New Zealand Bill of Rights Act 1990 s 5.

¹⁰⁶ New Zealand Bill of Rights Act 1990 s 14.

¹⁰⁷ New Zealand Bill of Rights Act 1990 s 14, however, does not provide the right to own trade marks.

¹⁰⁸ Resource Management Act 1991 ss 15B(1)(c), 17(3)(a); Sentencing Act 2000 s 71(1)(j); or also Harassment Act 1997 s 4(1)(e).

¹⁰⁹ *Flint v Hellaby Peach Products* [1974] 1 NZLR 718, 721 Wilson J.

¹¹⁰ *Minhinnick v Water Services Ltd* 1998] 1 NZLR 294 (CA).

or is “likely to have an adverse effect on the environment.” In *Hosking v Runting*¹¹¹ “highly offensive” is similar to “significant humiliation, loss of dignity or injury to feelings.” In section 22(2) of Companies Act 1993 it has the meaning of being “an obscene nature, or contrary to public policy, or likely to offend any particular nature, or community or any particular religion”.¹¹²

But the application of interpretation attributed to other legislations does not explain the meaning of 17(1)(b)(ii). These legislations regulate other law as trade mark law and deal with different issues. Even though there might be little relation to trade marks, these laws aim to govern specific problems. Other legislation does not specify what it clearly means regarding trade mark rights.

In contrast, the Practical Guidelines of IPONZ¹¹³ refer to trade mark cases from the United Kingdom regarding interpretation of section 17(1)(b)(ii).

The *Hallelujah Trade Mark* case¹¹⁴ deals with interpretation of the words “contrary to morality” in section 11 of the former United Kingdom Trade Marks Act 1938. Registrar’s Hearing Officer Mr Myall found that “the use of a mark ... ha[s] to offend the generally accepted mores of the time.”¹¹⁵ He decided that the trade mark *Hallelujah* in relation to clothing is “contrary to morality” because “registration would be reasonably likely to offend the religious susceptibilities of a not insubstantial number of persons.”¹¹⁶ Regarding section 17(1)(ii), this would mean that “offend” refers to religious and moral standards that communities of a not too small size in New Zealand have.

¹¹¹ *Hosking v Runting* [2005] 1 NZLR 1, 35 (CA). In the context to a tort claim of breached privacy the judges referred to the Privacy Act 1993 s 66(1)(b)(iii) regarding the interpretation of what it “highly offensive.”

¹¹² Ministry of Economic Development, Company Office, Business and Registries Branch *Company names* (Wellington, 20 April 2000) <http://www.med.govt.nz/ri/co_reg/coynames.html> (last accessed on 08 March 2005).

¹¹³ IPONZ *Practical Guidelines, Trade Marks Act 2002 –Absolute Grounds: General*, above n 35, 32-34.

¹¹⁴ *Hallelujah Trade Mark* [1976] RPC 605 (footnote in original).

¹¹⁵ *Hallelujah Trade Mark*, above n 114, 610.

¹¹⁶ *Hallelujah Trade Mark*, above n 114, 610.

In *Ghazilian's Trade Mark Application*,¹¹⁷ the meaning of “contrary to ... accepted principles of morality” in section 3(3)(a) of the current United Kingdom Trade Marks Act¹¹⁸ was discussed in the context of an application to register the trade mark *Tiny Penis* in relation to clothing. Simon Thorley QC, acting as the Appointed Person stated:¹¹⁹

The dividing line is to be drawn between offence which amounts only to distaste **and offence which would justifiable cause outrage or would be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values.**

The application of this argument to section 17(1)(b)(ii) means, on one hand, that the likelihood of mere outrage of “a significant section of the community” would satisfy the conditions of this section. His reference to outrage, however, is lacking in details about the form and range of outrage. On the other hand, it would indicate that besides religious standards – as found in *Hallelujah Trade Mark* case¹²⁰ - also the continuity of current family and social values are criteria regarding the interpretation of “offend”.

More recently, the Fourth Board of Appeal of OHIM¹²¹ considered in *Dick Lexic Limited's Application*¹²² the meaning of “contrary to public policy or accepted principles of morality” in accordance with section 3(3)(a) of the United Kingdom Trade Marks Act 1994 by means of the trade mark application *Dick & Fanny*. They concluded that trade marks which merely “raise a question of taste” - as *Dick & Fanny* did – do not qualify in the terms of section 3(3)(a). Regarding New Zealand section 17(1)(b)(ii) this means that trade “marks that are in poor taste” could be subsumed under this section.¹²³

¹¹⁷ *Ghazilian's Trade Mark Application* [2002] RPC 628 (footnote in original).

¹¹⁸ Trade Marks Act 1994(UK).

¹¹⁹ *Ghazilian's Trade Mark Application*, above n 117, 635.

¹²⁰ *Hallelujah Trade Mark*, above n 114, 610.

¹²¹ Community Trade Marks Office in United Kindom.

¹²² *Dick Lexic Limited's Application* (25 March 2003) OHIM Fourth Board of Appeal R 111/2002-4 (footnote in original). The OHIM Appeal discussed the registrability of the trade mark *Dick & Fanny*.

¹²³ *IPO NZ Practical Guidelines, Trade Marks Act 2002 –Absolute Grounds: General*, above n 35, 34.

In summary, an application of these English cases to section 17(1)(b)(ii) would mean that trade marks are “offensive” where they are likely to undermine morals, religious, family or social values, or also outrage “a significant section of the community” and exceed a mere question of poor taste.

However, I consider those English decisions as being not applicable to interpreting section 17(1)(b)(ii) since those refer to the United Kingdom Trade Marks Acts¹²⁴ and not to the current Act. Both United Kingdom Acts are different in wording if compared to section 17(1)(b)(ii). Furthermore, the United Kingdom sections¹²⁵ contain wordings which are only similar to section 16(1) of New Zealand Trade Marks Act 1953¹²⁶ but not to section 17(1)(b)(ii). However, as I said under *V A and B 1*, section 16(1) and the new section 17(1)(b)(ii) are observably distinct in their wordings.

Section 17(1)(b)(ii) is lacking in references to “morality” which the English cases particularly consider. In addition, New Zealand legislators¹²⁷ and the National Government¹²⁸ -later continued by the Labour-Alliance Government- decided to thoroughly alter the former wording and to abolish references regarding “morality” in order to establish a unique legislation that better meets the needs of New Zealand. These facts indicate that interpretation of section 17(1)(b)(ii) should not be done by means of these English cases since they do not take account of the different wording and aims of this section. Since New Zealand had consciously decided to create unique trade mark legislation, unique interpretation should be subsequently applied. An application of English

¹²⁴ Trade Marks Act 1938 (UK) ss 11, 17(2) and Trade Marks Act 1994 (UK) s 3(3)(a).

¹²⁵ Trade Marks Act 1938 (UK) ss 11, 17(2) and Trade Marks Act 1994 (UK) s 3(3)(a).

¹²⁶ “[C]ontrary ... to morality” in accordance to Trade Marks Act 1953 s 16(1) in relation to “contrary ... to accepted principles of morality” in accordance to Trade Marks Act 1994 (UK) s 3(3)(a) and also in relation to “contrary to morality” in accordance to Trade Marks Act 1938 (UK) ss 11. See also above *V A*.

¹²⁷ Ministry of Commerce *Reform of the Trade Marks Act 1953: Proposed Recommendations* (Wellington, 1991).

¹²⁸ Cabinet Minute Cabinet Economic Committee “Review of the Trade Marks Act 1953” (13 April 1999) ECO (99) 34 (Obtained under Official Information Act 1982, Request to the Intellectual Property Team, Ministry of Economic Development); Cabinet Minute Cabinet Economic Committee “Review of the Trade Marks Act 1953” (22 September 1999) ECO (99) M6/4 (Obtained under Official Information Act 1982, Request to the Intellectual Property Team, Ministry of Economic Development).

legislation means to return to former trade mark law what excludes application of the new rules. All efforts put into creating unique legislation for New Zealand's specific needs would be neutralised.

Therefore, I conclude that the application of the English decisions to section 17(1)(b)(ii) is not an adequate approach for interpretation. I suggest that an interpretation ought to focus on the actual aims and needs of New Zealand rather than on English considerations regarding United Kingdom law. New Zealand has chosen to introduce unique trade mark law in section 17(1)(b)(ii). It should move on and develop independent approaches regarding the meaning of the words "would be likely to offend a significant section of the community, including Māori". Otherwise, it set up new trade mark legislation but the law's practical results do not reflect a particular change.

- (e) "The Commissioner considers that its use or registration would be likely to offend a significant section of the community, including Maori."

Section 17(1)(b)(ii) requires the Commissioner to decide whether a trade mark use/registration is likely to offend someone or not. However, the section is lacking in explanation of how this decision is to be made. Basically two interpretations are possible. First, the words "[t]he Commissioner considers ..." imply that the Commissioner is allowed to follow his/her personal opinions. In contrast, second, the Commissioner's decision could also be an objective test.

There are many cases in New Zealand jurisdiction regarding the terminology "offensive" which examine what kind of test should therefore apply. For example, in *P v D*¹²⁹ judges said that a claim of offensiveness requires an objective test considered by a reasonable person of ordinary sensibilities. Also in *Ceremalus v Police*¹³⁰ Tompkins J stated "the test is

¹²⁹ *P v D* [2000] 2 NZLR 591, 602 (HC) also deals with a tort claim regarding an allegation of breached privacy.

¹³⁰ *Ceremalus v Police*, above n 101, 678 Tompkins J.

objective [and regards] offensive in the mind of a reasonable man ... whose views are representative of the community.”

Also the IPONZ Guidelines¹³¹ state that the Commissioner should “objectively” consider, “from the point of view of ‘right-thinking members of the public’.” IPONZ Guidelines apply the English case *Hallelujah Trade Mark*¹³² where Simon Thorley QC commented that “[a] right thinking member ... will be able, objectively, to assess whether or not the mark in question is calculated” in terms of section 3(3)(a) of United Kingdom Trade Marks Act 1994.¹³³

Regarding section 17(1)(b)(ii), this means that neither the personal opinion of the Commissioner nor the specific view of the offended group should be decisive since IPONZ and the English case¹³⁴ expressly refer to “objectively”. But also the New Zealand legislation indicates an objective test due to references to “a reasonable person of ordinary sensibilities” which conforms to “representative views of the community.”

In addition, the Commerce Committee’s Commentary to the Trade Marks Bill¹³⁵ states that section 17(1)(b)(ii) originally provided that the Commission had to consider “on reasonable grounds.” This should prevent claims of unsubstantial or frivolous offensiveness.¹³⁶ The words were later omitted since one might misunderstand that “the Commissioner did not have to consider and act reasonably”.¹³⁷ These words imply an objective test since they indicate a decision based on reasons that everyone comprehends and considers as reasonable – irrespective of personal opinions. The right to appeal regarding the Commissioner’s fi-

¹³¹ IPONZ *Practical Guidelines, Trade Marks Act 2002 –Absolute Grounds: General*, above n 35, 33-34.

¹³² *Hallelujah Trade Mark*, above n 106.

¹³³ *Hallelujah Trade Mark*, above n 106, 635.

¹³⁴ *Hallelujah Trade Mark*, above n 106.

¹³⁵ Trade Marks Bill 2001 (the commentary).

¹³⁶ Cabinet Minute Cabinet Economic Committee “Review of the Trade Marks Act 1953”, above n 128, 34 para i.iii referring to Minister for Enterprise and Commerce *Trade Marks Act 1953: Proposals for Reform* (prepared for the Chair of the Cabinet Economic Committee, Wellington, 07 April 1999) Appendix A 3 (Obtained under Official Information Act 1982, Request to the Intellectual Property Team, Ministry of Economic Development) (footnote in Original).

¹³⁷ Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing III*, above n 58, 11.

nal decision confirms this argument because judges are exclusively able to examine objectively found decisions with regard to law.¹³⁸

However, in terms of IPONZ and New Zealand case law, the objective test does not say what “right-thinking members of the public” or “reasonable persons with views representing the community” means and who they are. Problems arise when the Commissioner is to decide whether the specific perspective of the offended group still qualifies in terms of “right-thinking or representing the community’s views.” This happens in particular, if the subjective feeling of a group appears extreme, alien or abstruse compared to the well-known susceptibilities of the most part of the New Zealand population. Then it becomes quickly disputable whether the offensiveness of this group fulfils the requirements of a “right-thinking” or “reasonable” man’s perspective or not. In addition, in case the offended group is exceptionally small or commonly unknown, the Commissioner faces troubles in evaluating which perspective is relevant. This is because section 17(1)(b)(ii) does not determine what the words “right-thinking or reasonable person of ordinary susceptibilities” say in detail. Although the Commissioner might get additional advice regarding a specific group –what refers to the institution of an advisory committee as discussed in *V C* – the Commissioner’s decision remains difficult regarding which groups are “right-thinking members” and what feelings are reasonable and thus qualify as “right-thinking members.”

Therefore, section 17(1)(ii) is very likely to cause serious problems in the future. This is in particular, if an increasing number of small communities of exceptional susceptibilities file objections to the Commissioner since this effects the trade mark rights of trade marks owners/users. In the worst case, trade mark right owners have to be afraid of many objections of different groups with exceptional susceptibilities.

¹³⁸ Trade Marks Act 2002 s 170.

C Sections 177 to 180

Section 17(1)(b)(ii) and 177 to 180 accompany each other due to references to Māori. Their interaction is the subject of analysis in this section.

1 General overview

Sections 177 to 180 contain rules regarding the introduction of an Advisory Committee,¹³⁹ its function,¹⁴⁰ membership¹⁴¹ and internal procedure.¹⁴² These sections are linked to section 17(1)(b)(ii) since this Committee advises the Commissioner in decisions regarding section 17(1)(b)(ii). Section 178 mentions:¹⁴³

[T]he committee is to advise ... whether the proposed use or registration of a trade mark that is, or appears to be, derivative of a Maori sign, including text and imagery, is, or is likely to be, offensive to Maori.

The close relation between sections 177 to 180 and 17(1)(b)(ii) does only disconnected when a trade mark is or is likely not derivative from Māori. In this case the sections 177 to 180 do not apply, but section 17(1)(b)(ii). In practice, however, trade marks of Māori origin are usually offensive to Māori or Māori groups as the examples I have given above show.¹⁴⁴

This Committee is exclusively created for Māori, although the Act does not specifically mention this. However, sections 178 and 179(2) do not refer to groups other than Māori. This makes this Committee unique for Māori matters.

Between October 2003,¹⁴⁵ when the Committee was established,

¹³⁹ Trade Marks Act 2002 s 177(1).

¹⁴⁰ Trade Marks Act 2002 s 178.

¹⁴¹ Trade Marks Act 2002 s 179.

¹⁴² Trade Marks Act 2002 s 180.

¹⁴³ Trade Marks Act 2002 s 178.

¹⁴⁴ See above under III.

¹⁴⁵ The Trade Marks Act 2002 came into force on 20 August 2003.

and 11 May 2004.¹⁴⁶ the Committee examined 333 trade marks which they considered as containing Māori signs.¹⁴⁷ It found that eight trade marks out of those 333 were likely to offend Māori or required closer examination.¹⁴⁸

2 *Significant attributes of the Advisory Committee*

This Committee comprises five members holding knowledge in Māori arts, culture or language or close connection to Māori iwi but also business and/or legal expertise.¹⁴⁹ The Commissioner appoints Committee and members and may alter both.¹⁵⁰

This Trade Marks Advisory Committee¹⁵¹ was established for the following purposes:¹⁵²

[T]o minimize the risk that the Crown may inadvertently register as trade marks Māori text and imagery where registration would cause offence to Māori. ... It was also thought that ... a Committee would provide the opportunity to more effectively manage the Crown/Māori relationship and minimize the Treaty-based risk of the Crown.

The Act contains only rudimentary regulation. Sections 177 to 180 provide a mere framework for regulations, for example regarding power, function, membership, or remuneration. These are to be determined between Commissioner and Committee.¹⁵³ It is expected that over time

¹⁴⁶ Last meeting of the Māori Trade Marks Advisory Committee for the year 2003 ending June 2004.

¹⁴⁷ IPONZ *Maori Trade Marks Advisory Committee Annual Report 2004* (Wellington, 03 December 2004) <<http://www.iponz.govt.nz/pls/web/dbssiten.main>> (last accessed on 16 February 2005).

¹⁴⁸ IPONZ *Maori Trade Marks Advisory Committee Annual Report 2004*, above n 147.

¹⁴⁹ IPONZ *Maori Trade Marks Advisory Committee* (Wellington, 30 July 2004) <<http://www.iponz.govt.nz/pls/web/dbssiten.main>> (last accessed on 16 February 2005) mentions the names and specific expertises of each Committee member.

¹⁵⁰ Trade Marks Act 2002 ss 177(1), (2), and 179(1).

¹⁵¹ IPONZ officially uses this name for the Advisory Committee in accordance with Trade Marks Act 2002, ss 177 to 180.

¹⁵² Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing II*, above n 21, 9.

¹⁵³ Trade Marks Act 2002 s 180 regarding the procedure of the Committee. In general, see Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing II*, above n 21, 8, 9, 11-14.

they both will develop a satisfactory form of cooperation.¹⁵⁴

However, since the introduction of this Committee in October 2003, official information about the completed work of the Committee, for example guidelines regarding the Commissioner's advice, is very thin and still appears to be at a preliminary stage.¹⁵⁵ This provides an unreliable basis regarding clear results by the new Act and thus leads to uncertainty in trade mark practice.

Despite the section's words "the Commissioner considers" and IPONZ's statement¹⁵⁶ that the Committee's advice "is not binding on the Commissioner" it is disputable who the final decision in section 17(1)(b)(ii) makes, the Commissioner or the Committee. It seems also unsure how far the Commissioner actually need and depend on the Committee's opinions. Furthermore, to what extent do the Committee's opinions influence the Commissioner's final decision regarding section 17(1)(b)(ii)?

The Commissioner is not able to gain knowledge in all different perspectives of all Māori groups. Therefore, the Commissioner is to rely on the Committee's expertise and considerations. The Commissioner's power lies in only applying the law. Whenever the Commissioner lacks sufficient knowledge, it is very likely to that he/she will strictly follow the Committee's directions due to the absence of other options. Thus the Commissioner directly applies the Committee's suggestions because it is impossible for him/her to properly evaluate the allegation of offensiveness. This causes an increase of the Committee's power. It also restricts the Commissioner's supposed strong position at the same time. Thus the Committee actually makes the decisions in section 17(1)(b)(ii). Additional problems might arise when the Commissioner considers the Committee's estimation regarding a trade mark as wrong, even though

¹⁵⁴ Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing II*, above n 21, 12-14.

¹⁵⁵ For example, see IPONZ *Maori Trade Marks Advisory Committee Annual Report 2004*, above n 147, as the most current document on the IPONZ website.

¹⁵⁶ IPONZ *Practical Guidelines Amendments, Sections 177-180 of the Trade Marks Act 2002*, *Maori Advisory Committee & Māori Trade Marks* (Wellington, 24 September 2004) <<http://www.iponz.govt.nz/pls/web/dbssiten.main>> (last accessed on 16 February 2005) 2.

his/her knowledge in this particular case is not enough to make a decision by him/herself. Neither the Act nor IPONZ mention this problem or suggest solutions.

3 *Legitimacy of the Advisory Committee*

Sections 177 and 180 do not refer to groups other than Māori¹⁵⁷ and also the entire Act does not provide provisions that allow the establishment of other committees, since sections 178 and 179(2) expressly mention an Advisory Committee only attributed to Māori. IPONZ uses the name Māori Trade Marks Advisory Committee for this committee.¹⁵⁸

This circumstance questions the legitimacy of this Māori Committee with regard to other groups besides Māori. In parliamentary debates several Parliament Members, such as Stephen Franks,¹⁵⁹ the Hon Tony Ryall¹⁶⁰ or Judith Collins¹⁶¹ continuously expressed concerns that the law privileges Māori compared to other groups without giving particular reasons for this. This would reinforce separation between Māori and other communities. In their opinion, an exclusive Māori Advisory Committee discriminates significant other communities and thus causes racism. They also complained that the Commissioner's absence of knowledge turns the Committee into actual judges regarding offensive trade mark use/registration.¹⁶²

Therefore, the Māori Advisory Committee might be (prima facie) discriminatory in criteria of race or ethnic origin. This Committee might infringe the New Zealand Bill of Rights Act 1990, namely the right to freedom from discrimination in accordance with sections 19(1) and 5.¹⁶³ Nevertheless, the Trade Marks Bill has passed. The legislation was considered as being coherent with New Zealand Bill of Rights Act 1990 and

¹⁵⁷ See above under V C 1.

¹⁵⁸ See for example, IPONZ *Practical Guidelines, Sections 177-180 of the Trade Marks Act 2002, Māori Advisory Committee & Māori Trade Marks*, above n 156.

¹⁵⁹ (01 August 2001) 593 NZPD 10601-10602 and (19 November 2002) 604 NZPD 2278, 2306.

¹⁶⁰ (19 November 2002) 604 NZPD 2270-2271.

¹⁶¹ (19 November 2002) 604 NZPD 2337.

¹⁶² See above V C 2 in detail.

¹⁶³ New Zealand Bill of Rights Act 1990 ss 5, 19(1) and Human Rights Act 1993 s 21(1)(f)(g).

also with its right to freedom of discrimination.¹⁶⁴ Inter alia mainly the urgently expressed need for this institution was cited as key justification when the Bill passed.¹⁶⁵ The ability to introduce other committees, if strongly needed, was mentioned as another justification for the trade mark legislation.¹⁶⁶ Due to these reasons the Ministry of Justice considered the Māori Advisory Committee as either prima facie consistent with section 19(1)¹⁶⁷ or at least justified as a “reasonable limit” in terms of section 5¹⁶⁸ and thus consistent with the Bill of Rights Act.

However, the Māori Advisory Committee might also infringe the rules of natural justice. Since these rules provide anyone with the right “to be heard by an impartial adjudicator,”¹⁶⁹ other communities in New Zealand might complain of being discriminated due to the lack of other advisory committees. Without such institution these groups do not have the opportunity to bring their concerns forward. It might be a mere question of time until other communities will claim their rights before court.

Since sections 178 and 179(2) regarding an Advisory Committee exclusively mention Māori and lack references to other groups, the Act does not allow other groups to establish their Committee. This would require beforehand alterations of sections 178 and 179(2) or some additional provisions in order to provide the legal requirements for the establishment of other Committees.

The legislators were aware of this problem during the legislation process. They made great efforts to avoid allegations regarding discrimination of other groups. One example is that the former amendment “the majority of members which must be Māori” to section 177(1) was omit-

¹⁶⁴ Ministry of Justice *Legal Advice. Compliance with the New Zealand Bill of Rights Act 1990: Trade Marks Bill 2001*, above n 95, 25-31 in particular.

¹⁶⁵ Ministry of Justice *Legal Advice. Compliance with the New Zealand Bill of Rights Act 1990: Trade Marks Bill 2001*, above n 95, 29.

¹⁶⁶ Ministry of Justice *Legal Advice. Compliance with the New Zealand Bill of Rights Act 1990: Trade Marks Bill 2001*, above, n 95, 30.

¹⁶⁷ New Zealand Bill of Rights Act 1990, s 19(1): “Everyone has the right to freedom from discrimination on the grounds of discrimination in the Human Rights Act 1993.”

¹⁶⁸ New Zealand Bill of Rights Act 1990 s 5: “[T]he rights and freedoms contained in this Bill of Rights may be subject only to such reasonable limits prescribed by law as can be demonstrably justified in a free and democratic society.”

¹⁶⁹ Geoffrey A Flick *Natural Justice Principles and Practical Application* (2ed, Butterworths, Sydney, 1984) 26. The natural justice rules *audi alteram partem* and *nemo debet esse iudex in propria causa*.

ted since “the proposed amendment would ... appear to raise Bill of Rights issues [and] it is uncertain that ... a justification could be achieved.”¹⁷⁰

In section 17(1)(b)(ii), the suggestion to use Māori language, for example ‘*tangata whenua*’¹⁷¹ as a substitution for “significant section of the community” was quickly denied.¹⁷² This should minimise potential claims regarding preferential treatment of Māori or discrimination of other groups.¹⁷³

The Commerce Committee also could not reach agreement on the wording of sections 178 and 179 (which both expressly mention Māori) in its commentary to the Bill.¹⁷⁴ In contrast, the wording of sections 177 and 180 (without Māori references) found consensus. This might also indicate with how much care the legislators acted regarding the potential criticism of disparity between Māori and other groups when they developed the new legislation.

In summary, the purpose of those sections 177 to 180 is the exclusive establishment of an Advisory Committee for Māori. Discussions regarding committees for other groups appear to have been based on avoiding criticism in terms of disparity or discrimination rather than on actual intentions to consider the feelings of other groups of New Zealand’s community.

¹⁷⁰ Ministry of Economic Development *Trade Marks Bill: Clause 177* (prepared for the Chair of the Commerce Committee, Wellington, 15 February 2002) para 6: They reached this agreement after the consultation of the Ministry of Justice.

¹⁷¹ Herbert W Williams *Dictionary of the Maori Language*, above n 23: Māori for English *peoples from the country*.

¹⁷² Trade Marks Focus Group *Notes of the Trade Marks Focus Group Meeting* (Wellington, 31 January 1996) 8 (Obtained under Official Information Act 1982, Request to the Intellectual Property Team, Ministry of Economic Development): citing Trade Mark lawyer Barbara Sullivan.

¹⁷³ Trade Marks Focus Group *Notes of the Trade Marks Focus Group Meeting*, above n 172, 8.

¹⁷⁴ Trade Marks Bill 2001 (the commentary) ss 178, 179.

VI INTENTIONS OF THE GOVERNMENTS AND LEGISLATORS

This part examines whether the law of sections 17(1)(b)(ii) and 177 to 180 - as previously analysed under *V* - is logically consistent with the aims and the intentions of New Zealand Governments and legislators.

This examination is based on the thesis that the Act does not reflect these aims and intentions. This is in fact dishonest legislation since New Zealand Governments did not want to reveal their actual intentions.

This section of the paper argues that the Governments kept their actual goals regarding trade mark law reform in secret in order to serve their political interests, and obtain law reform that seemingly combined Māori expectations with the demands of business people without substantial economic and public excitement. Comparison of sections 17(1)(b)(ii) and 177 to 180 to the Governments' and legislators' behaviours shows that the introduction of Māori to New Zealand trade marks law did not comprise the willingness to create law especially for Māori, although the sections' wording sound doubtlessly unique.

A The National Government

When the National Government¹⁷⁵ decided to embark on trade mark law reform, it released policy objectives for a new legislation. These were to:¹⁷⁶

- i promote business practices which will make New Zealand firms more competitive internationally;
- ii reduce the costs of doing business and the costs of complying with legislation;

¹⁷⁵ The plan of law reform goes back to the National Government. During law reform and until the Trade Marks Bill 2001 passed, the Government's leading parties changed to a Labour-Alliance coalition.

¹⁷⁶ Cabinet Minute Cabinet Industry and Environment Committee "Trade Marks Bill" (01 May 1997) CIE: (97) 34 para b. The National Government's broader policy objectives are illustrated under i-vi and the specific objectives under vii-viii. (Obtained under Official Information Act 1982 Request to the Intellectual Property Team, Ministry of Economic Development).

- iii enable New Zealand's distinctive characteristics to be effectively utilised by businesses;
- iv provide certainty for property rights;
- v ensure the Government meets its Treaty of Waitangi obligations;
- vi treat communities in New Zealand consistently;
- vii more clearly establish the scope of the rights that can be obtained under trade mark legislation;
- viii reduce the overall costs associated with obtaining a trade mark;

The objectives are for the most part regarding the reduction of costs,¹⁷⁷ and the strengthening of property rights.¹⁷⁸ In addition, the improvement of requirements for business people¹⁷⁹ and the increase of economic growth were main goals. Māori were not expressly mentioned. The National Government clearly focussed on needs of business people and New Zealand's economic progress. Māori concerns did not to play an important role at all or at least not more than other ethnic groups of New Zealand. The policy goals express the political view of the National party, reflecting the right wing of New Zealand's politics.

Object v refers to obligations regarding the Treaty of Waitangi.¹⁸⁰ This does address Māori because the Treaty represents the fundamental obligations of New Zealand legislation to Māori.

Item vi mentions the Government's obligation to guarantee freedom of discrimination in accordance with New Zealand Bill of Rights Act¹⁸¹ which forbids unequal treatment of communities in New Zealand. This responds to Māori since they are regarded as a community of New Zealand.¹⁸²

In summary, the National Government mainly focused on the improvement of the legal framework for business and economic needs. Māori concerns played a rather subordinated role.

¹⁷⁷ See above VI B objectives ii and viii.

¹⁷⁸ See above VI B objectives iv and vii.

¹⁷⁹ See above VI B, in particular objectives i and iii.

¹⁸⁰ In particular Treaty of Waitangi art 2.

¹⁸¹ New Zealand Bill of Rights Act 1990 ss 19(1), 5.

¹⁸² Regarding differentiation between Māori on the whole and Māori groupings in particular see above V B 2(c).

B The Ministry of Commerce / the Ministry of Economic Development¹⁸³ and the Select Commerce Committee

The Ministry began in 1991 to examine Māori approaches regarding the trade mark law system, after the National Government had appointed it with reviewing the former Trade Marks Act 1953.¹⁸⁴ Due to the work of the established Māori Trade Marks Focus Group and extensive consultations with Māori the Ministry gained substantial knowledge of the problems regarding Māori cultural heritage when forced under current trade mark law system. These sources were available for the Ministry to make recommendations to the National Government and later the Labour-Alliance Government regarding measures of the new Trade Marks Bill.

The Ministry's recommendations included changing of former section 16(1) into the unique wording of section 17(1)(b)(ii).¹⁸⁵ The current wording of section 17(1)(b)(ii) was only altered by a few omitted words in comparison to the Ministry's recommendations.¹⁸⁶ The Advisory Committee, regulated by sections 177 to 180, was also established on the Ministry's suggestion.¹⁸⁷ In summary, these facts indicate that the Ministry made substantial efforts to understand the problem of Māori with respect to trade mark law.

The Ministry's efforts were the first, significant steps taken to analyse this problem. This would have been a good starting position for law reform and designing clear and easily applicable legislation. In a context to Māori, this would have meant law that clearly answers the questions of whether the law regards Māori concerns and, if so, on what extent.

However, as the analysis of sections 17(1)(b)(ii) and 177 to 180 showed,¹⁸⁸ the wording of section 17(1)(b)(ii) contains undefined and

¹⁸³ The name of the Ministry of Commerce was altered into Ministry of Economic Development during reform of the Trade Mark Act 1953. In this part of the paper this Ministry is subsequently called "the Ministry".

¹⁸⁴ Ministry of Commerce *Reform of the Trade Marks Act 1953: Proposed Recommendations* (Wellington, 1991), see also above V.

¹⁸⁵ Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing II*, above n 21, 2-3.

¹⁸⁶ The words "on reasonable grounds" were omitted in s 17(1)(b)(ii). See also V B 2(e) in detail.

¹⁸⁷ Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing II*, above n 21, 2-3.

¹⁸⁸ See above V B 2 in detail.

untested terminology that makes their legal interpretation disputable and remains uncertain in the practice. With regard to the substantial efforts which the Ministry undertook to examine Māori problems, it appears peculiar and also questionable that the Ministry did not suggest rules that more clearly regulate who is allowed to claim offensiveness of a trade mark and also when.¹⁸⁹

In addition, the Ministry was aware that their suggested legislation did not appropriately deal with cultural heritage of indigenous people. Also several submissions to the Trade Marks Bill, mostly filed by Wai 262 claimants¹⁹⁰ and also by business people, for example artists, pointed this out.¹⁹¹ Furthermore, the Ministry also knew that trade marks law exclusively targets trade mark issues and thus does not automatically include the legal protection of cultural heritage of the indigenous people such as Māori.¹⁹² Nevertheless, the Ministry neither suggested nor even seriously considered the establishment of legislation that would meet the needs of Māori, even though this might require a separate law system *sui generis*, particularly designed for Māori and in parallel to trade mark law.

However, the Ministry preferred to follow the Government aims. It stuck to the policy objectives of the National Government¹⁹³ and amended only a few new ideas with regard to Māori. The Ministry imposed these concepts on each other – irrespective of whether such synthesis provides Māori with satisfying results or reduced the protection of trade mark rights in practice. The Ministry stated regarding their suggestion of section 17(1)(b)(ii):¹⁹⁴

The provision ... represents a compromise. It is an endeavour to put in place practical arrangements that balance the interest of Māori

¹⁸⁹ See above V B 2 and V C 2.3 in detail.

¹⁹⁰ This is an ongoing claim before the Waitangi Tribunal, known as Wai 262.

¹⁹¹ Ministry of Economic Development *Clause by Clause Analysis of Submissions on the Trade Mark Bill Clauses 1 to 70* (Wellington, 29 November 2001). Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing III*, above n 58, 6-7.

¹⁹² For example, Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing II*, above n 21, 3-4; also Trade Marks Bill 2001 (the commentary), 13. In general, see also above II and III.

¹⁹³ See above VI A in detail.

¹⁹⁴ Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing III*, above n 58, 9.

(and other significant sections of the community) and persons seeking to register a trade mark.

Furthermore, the Ministry's decision to add the words "including Māori" in section 17(1)(b)(ii) was based on the intention to merely introduce the word "Māori." However, this should not aim to provide Māori with greater rights than other groups or communities. The Ministry commented this:¹⁹⁵

The wording signal[s] an **intent** on the part of the government to recognise the concerns of Māori that have been expressed over a long period with regard to intellectual property law, and that Māori have status as the government's Treaty partner.

Similar statements can be found in the commentary of the Commerce Committee to the Trade Marks Bill. There the Committee reported that "[t]he bill is intended to ensure that our trade mark law better meets the needs of the business community and addresses *some* Māori concerns regarding the inappropriate registration of Māori words and symbols as trade marks."¹⁹⁶

These words indicate that Māori concerns were not treated with particular regard. The words "to ensure" with regard to business needs and the word order (business needs come first before Māori) affirm this argument. The Bill also merely "addresses" (instead of "intends to ensure") "some Māori concerns" (not all their concerns) what shows only restricted consideration of Māori.

Considering the preceding examinations, I conclude that the Ministry recommended trade mark law that shows a mixture of different goals (mainly Māori and business/economic interests) since it is grounded on the idea of compromises. This position, however, neither allows the Government to set up law that turns the results, which were found by the examinations of Māori concerns, into adequate regulations; nor it pro-

¹⁹⁵ Ministry of Economic Development *Trade Marks Bill: Supplementary Briefing III*, above n 58, 12.

¹⁹⁶ Trade Marks Bill 2001(the commentary), 2.

vides trade mark rights with such law that improves or satisfies business people and New Zealand's economic.¹⁹⁷

C The Labour-Alliance Government

This section of the paper examines the Labour – Alliance Government's behaviour regarding the new trade mark legislation. It has been said that the Government acted in a disputable way. Therefore, here the reasons for its behaviour will be scrutinised.

After the problems between the Māori concepts and the current trade mark law system were analysed and shown in detail, two strong contrary opinions developed with regard to trade mark law reform. These opinions likewise reflected the views of the political left and right wing of New Zealand regarding trade mark legislation.

One opinion, mainly represented by the left wing parties, focused on the lack of protection of Māori knowledge and cultural heritage and wanted to improve the Māori influence on legislation.

The other view, taken by the political right wing, was concerned about the legitimate privilege of Māori compared to other ethnical groups since the privileged position would cause disparity and unfair treatment. The right wing also stressed that this privilege ultimately damages the foundations of trade mark law and thereby causes negative effects on trade mark practice.

In summary, the Government was faced with the following dilemma: on one hand the new trade mark legislation should provide a better regard and protection of Māori and their cultural and intellectual property. On the other hand, the law should please demands which deny a privileged Māori influence on trade mark legislation and want to improve trade mark rights only with respect to business interests.

However, as I have shown before, these opinions are contrary to each other since they follow completely different principles and aims, in particular, the current trade mark law system is exclusively designed

¹⁹⁷ See below in VII in detail

for the effective protection of trade mark rights and does not intend to protect Māori knowledge and cultural property.¹⁹⁸ Therefore, a satisfying synthesis of both approaches in law might be very difficult and consists of immanent problems. However, the Government was well informed about this dilemma.¹⁹⁹ The Government was also aware that sections 17(1)(b)(ii) and 177 to 180 reflect the mere attempt to compromise the different demands of Māori but also those of business people and New Zealand's economy.

In fact, as the Trade Marks Bill was introduced to Parliament, the Bill was heavily criticised due to its Māori references in sections 17(1)(b)(ii) and 177 to 180. For example, Hon Tony Ryall, MP, cited Jack Hodder, an intellectual property lawyer who warned that this causes "a clash of philosophy of individual property rights and collectiveness notions of cultural property."²⁰⁰ Stephen Franks, MP, opposed for the most part. He continuously attacked the legislation by expressing concerns about a unilateral, privileged treatment of Māori. In his view, this would cause racism in New Zealand. He also criticised indefinite and untested wording of sections 17(1)(b)(ii) and 177 to 180 very often.²⁰¹

Despite the harsh criticism of the law and several demands of political opponents in Parliament to explain the meaning of the law and reconsider its possible negative results on the trade mark practice, the Government, however, remained silent. The ongoing strong attacks against the legislation did not induce the supporters of the Bill to defend the sections 17(1)(b)(ii) and 177 to 180 or - at least make some efforts - to rebut the opponents' assertions.

Furthermore, the Labour-Alliance Government greeted the new law with enthusiasm. It stressed that trade marks law now meets the modern standards of trade mark business of New Zealand's economy and also takes regard of Māori interests. The Government pointed out

¹⁹⁸ See above II and III in detail.

¹⁹⁹ See above in III.

²⁰⁰ (19 November 2002) 604 NZPD 2271, 2305.

²⁰¹ (01 August 2001) 593 NZPD 10601-10603; (19 November 2002) 604 NZPD 2299-2300, 2306-2307, 2336, 2353, 2354.

that the new Act would combine Māori and business interests and is therefore unique legislation. For the first time in New Zealand's trade mark law, legislation would respond to requirements and expectations of Māori. Furthermore, the legal requirements for business people would improve since the law provides a better protection of trade mark rights.²⁰²

Despite the ongoing criticism of the Bill in Parliament, the Government only briefly mentioned the problems and did pay not much attention to those. When the Bill was read in Parliament, several Ministers and members of the leading parties (left wing) congratulated themselves to this legislation.²⁰³

For example, the Hon Laila Harré, Associate Minister of Commerce and member of the Alliance party, stressed that the new law particularly adapts to trade mark related developments on national and international areas and thus leads to a better protection of trade mark rights.²⁰⁴ Regarding Māori, she stated:²⁰⁵

[T]he bill is not a panacea. It does not...deal with all ... issues that surround the protection of our indigenous cultural heritage. The bill is nevertheless a very positive measure, and one of which this Government is very proud. It will put into law new safeguards for aspects of Māori cultural heritage.

She also mentioned "Māori have been incredibly generous with the use of their culture... It is about time that we recognise their rights to see some protection of their cultural heritage respected through our legislative processes."²⁰⁶ However, her gratitude towards Māori generosity seemed not to cover the establishment of a law which would appropriately protect Māori cultural and intellectual property.

In addition, the Government seemed to be comfortable with giving merely brief statements of substantial content. For example Rick

²⁰² In detail see below (same paragraph).

²⁰³ (01 August 2001) 593 NZPD 10598-10610 (first reading), in particular 10598-10600 and (19 November 2002) 604 NZPD 2268-2358 (second and third reading), in particular 2347-2348.

²⁰⁴ (01 August 2001) 593 NZPD 10598-10600.

²⁰⁵ (01 August 2001) 593 NZPD 10599.

²⁰⁶ (01 August 2001) 593 NZPD 10599.

Barker, MP, mentioned, "I have much pleasure in supporting the Trade Marks Bill."²⁰⁷ So did many member of the left wing,²⁰⁸ irrespective of the continuously provocative comments of the right wing.²⁰⁹ During all hearings of the Bill, no Parliament member explained for what reasons sections 17(1)(b)(ii) and 177 to 180 should pass.²¹⁰ Even the few, more detailed comments contained rather mere catchwords than proper reasoning. For example, Metiria Turei, MP, and member of the Greens commented that the legislation provides at least limited protection of Māori cultural property.²¹¹

Another interesting aspect can be found in the explanatory note to the Bill that the Government released after the Bill had passed.²¹² There the Government used the same wording that the Commerce Committee had recommended in their commentary to the Bill.²¹³ For the "general policy statement"²¹⁴ of the Bill the Government omitted the word "some" from the Committee's words "[t]he bill...addresses *some* Māori concerns." Therefore, the final wording regarding the general policy statement to the Bill says that the law "addresses Māori concerns" - irrespective of the fact that the Bill had not been altered with respect to an improved legal regard of Māori concerns.

Furthermore, these words became section 3(c) of the Act which defines the purpose of the legislation. There, Māori concerns are located on third position out of five others. A list of positions shows the ranking and thus the legal relevance of each position. Therefore, section 3(c)

²⁰⁷ (01 August 2001) 593 NZPD 10601.

²⁰⁸ See also David Benson-Pope, MP in (01 August 2001) 593 NZPD 10603: "I am pleased to rise in support of the bill" or Chris Carter, MP in (01 August 2001) 593 NZPD 10605: "I rise to support this excellent bill." Or Hon Marian Hobbs, Minister of Environment in (01 August 2001) 593 NZPD 10606: "I am absolutely delighted to support ...the Trade Marks Bill."

²⁰⁹ For example, Pansy Wong, MP in (01 August 2001) 593 NZPD 10605 or Hon John Luxton, MP in (01 August 2001) 593 NZPD 10606.

²¹⁰ (01 August 2001) 593 NZPD 10598-10610 (first reading) and (19 November 2002) 604 NZPD 2268-2358 (second and third reading).

²¹¹ (19 November 2002) 604 NZPD 2276-2278 and 2351-2353.

²¹² Trade Marks Bill 2001(the explanatory note).

²¹³ Trade Marks Bill 2001(the commentary), 2 (Introduction): "This Bill ... is intended to ensure that New Zealand's trade mark law better meets the needs of the business community and addresses some Māori concerns regarding the registration of Māori words and symbols as trade marks." See also above VI B in detail.

²¹⁴ Trade Marks Bill 2001(the explanatory note) (General policy statement).

implies that the Act regards Māori concerns to a not minor extent. This implication, however, does not conform to the practical results which the Act actually shows.

In summary, the Government's behaviour leads to the conclusion that the Government tried to pretend that the new law considers Māori concerns with a better regard than it actually does. Therefore, I think that the unclear wording of sections 17(1)(b)(ii) and 177 to 180 ultimately served the Government since the hidden controversy would cause less excitement in politics and the public. The small but definite citation of Māori in law should please the demands of the side that support Māori concerns. But likewise its consideration of Māori concerns should be so little or at least minor in its impacts on trade mark practice that the needs of business people and New Zealand's economy are still met. The unclear and undefined wordings of the sections reflect this thesis because such law allows various interpretations of what is actually meant by the law. Vagueness regarding the meaning of the law prevented a too strong criticism regarding the new law since the real impacts on the trade mark practice were not predictable then. This behaviour also shows that the Government wanted to hide the continuously existing problems regarding Māori in order to calm down opposing opinions and to get the law quickly passed. The law passed off as –with regard to trade mark business but also to Māori– a significantly improved trade mark law. Therefore, I conclude that the new Trade Marks Act is grounded on dishonest intentions and thus is dishonest legislation.

VII NEGATIVE IMPACTS

This part examines the negative impacts this Act causes. These negative effects trace back to unclear trade mark regulations and the unsuccessful attempt to combine Māori issues with trade mark matters.

Here it is argued that this affects Māori but also business people as regular trade mark proprietors/users, since the law neither meet the

needs of Māori regarding cultural property nor the business people's interests regarding trade mark rights as business values.

First, the effects on trade mark practice of business people are examined.

The legal requirements regarding the use and registrability of trade marks containing Māori signs are unclear. Therefore, the trade mark users/proprietors cannot rely on protection of their trade mark rights.

This is likely to decrease the use of Māori signs in trade marks, since business people need a certain legislation regarding their business values. Business people will refrain from using Māori signs or even geographical names since they must be afraid of losing their trade mark rights by Māori groups claiming offensiveness. In particular, the undefined words "including Māori" in section 17(1)(b)(ii) will cause problems in the practice. Since "Māori" refers in general to Māori groups, even very small ones with exceptional and peculiar opinions might claim rights to object a specific trade mark. Stephen Franks, MP mentioned in colourful language:²¹⁵

[C]ause 17 in particular, ensures that every little group of crackpots that decides it wants to try to assert a quasi-ownership of part of its language can go in there and make sure that no business person will want to use that part of the language.

In addition, due to section 73(1)²¹⁶ users or proprietors of trade marks containing Māori signs can never completely rely on their rights since section 73(1) provides "an aggrieved person (which includes a person who is culturally aggrieved)" with the right of attacking trade mark registration at any time. The mere declaration that a trade mark was not registrable under section 17(1)(b)(ii) at the date of application is sufficient to interfere with trade mark registrations.

Thus it is irrelevant whether a trade mark proprietor/user is aware that a specific Māori group feels offended, even though this Māori

²¹⁵ (19 November 2002) 604 NZPD 2307.

²¹⁶ Trade Marks Act 2002 s 73(1).

group is very small or expresses exceptional opinions. The uncertain legal position is very likely to reduce the usage of Māori signs in trade marks.

Furthermore, trade mark rights embody great economic advantages, for example merchandising values.²¹⁷ Therefore, trade mark proprietors/users either will abandon their trade marks -containing Māori signs- to reduce the danger to lose a trade mark and its merchandising effect. Or they will have to spend a substantial amount of time and money on making extensive consultations with Māori to minimise these risks. This, however, means additional efforts for business people since this requires having consultations of many groups of Māori iwi, hapū or whānau.

For example, Artstation, the Auckland City community arts facility, put great efforts into using the Māori words *Toi Tu* for their logo. According to John Eadon,²¹⁸ Artstation made “extensive consultation with the local Iwi and representatives from other Iwi” to ensure the appropriate use of Māori words.

Uncertainty in law also cuts off great parts of economic opportunities. For example, Māori signs in trade marks can easily be used to merchandise New Zealand products. These signs in trade marks distinctively indicate geographical origin of goods/services and serve as a distinction of New Zealand goods/services from others. This might increase the products’ sale.

In addition, trade marks are active marketing measures to stimulate tourism. They give a unique picture of New Zealand by showing signs of Māori culture or typical local fauna and flora, such as the kiwi and the silver fern do as probably New Zealand’s most famous signs.

²¹⁷ See above II in detail.

²¹⁸ John Eadon, Manager Artstation, Auckland City community arts facility, to the author of this paper (24 February 2005) email: <John.Eadon@aucklandcity.govt.nz>.

However, the kiwi and the silver fern likewise embody spiritual meanings according to Māori understanding and can cause negative affects on Māori cultural/intellectual property.

As shown before, current trade mark law systems and also the new Act inappropriately deal with Māori, although the Governments made efforts to create law which takes account of Māori concerns. Indefinite and uncertain legal provisions were established which do not provide clear and reliable results. Furthermore, the Government stressed that the new law significantly responds to Māori concerns - irrespective of the actual facts. This is very likely to stop or at least postpone considerations of developing and erecting laws which provide adequate results regarding Māori. For years the creation of parallel legislation sui generis, designed for the needs of Māori, has been demanded. This desire is still expressed, even after the new trade mark legislation has been enforced.²¹⁹

Summarising the previous analysis, I come to the conclusion that the law negatively affects Māori and the business trade mark practice.

VIII CONCLUSION

Recapitulating the analysis of this paper, I have come to the conclusion that the new Trade Marks Act does not keep what it promises, namely a big improvement with regard to trade mark right protection and - for the first time in New Zealand's trade mark legislation- regard for Māori concerns. New Zealand Government established a dishonest legislation that despite urgent needs for a law reform – the previous Act was over 50 years old and obsolete for a long time - neither provides Māori cultural and intellectual property with satisfying results nor appropriately meets business and economic interests.

²¹⁹ For example, most recently Reuben Schwarz "Patent overhaul will bring NZ law into line" (07 February 2005) *The Dominion Post* (Wellington) C11.

When the Trade Marks Bill was discussed in Parliament, the Labour-Alliance Government was aware of the problems that underpin the new law. The Government had detailed knowledge regarding the contrary approaches of the Māori and the the Western-oriented trade mark law system and thus also regarding the Bill's only limited protection of Māori knowledge and cultural heritage. Also political contrarians and submissions and recommendations to the Bill pointed out that sections 17(1)(b)(ii) and 177 to 180 due to ambiguous and abstract wording cause difficulties in predicting the legal results in trade mark practice.

Nevertheless, the Government preferred to stick to the legislation irrespective of the expressed criticism. The Government aimed to establish a legislation that served its political interests since an, on one hand, merely moderate introduction of Māori matters but, on the other hand, visible consideration of Māori by law avoided a mood of excitement in public and political life. This allowed the Government to follow its actual aims and intentions which entailed to quickly pass new trade mark legislation and to extensively improve the protection of trade mark rights with particular regard to business and economic interests.

This legislation negatively affects both the New Zealand business community and the Māori. The supposedly better protection of Māori cultural and intellectual property by law, in particular, will prevent or at least to postpone developments of a legislation *sui generis* for Māori as indigenous people. Reliance on international legal frameworks, that embrace a few intentions to develop protective systems for indigenous people (still only in form of preliminary drafts), does not satisfy Māori interests because the international projects are continuously lacking in improvement and complete legislation that is ready to be applied.²²⁰ In my opinion, New Zealand was - due to its analysis regarding

²²⁰ Only very preliminary results exist, namely (preliminary) drafts of legal regulations. For example, United Nation Educational, Scientific and Cultural Organisation *Preliminary Report of the Director-General containing two preliminary Drafts of a Convention of the Protection of Cultural Contents and Artistic Expressions* (3 March 2005) CLT-2005/CONF.203/CLD.4; World Intellectual Property Organisation, *Information Note by WIPO Secretariat on Draft Convention on the Protection of the Diversity of Cultural Contents and Artistic Expressions* (12 November 2004). <http://www.wipo.int/ik/en/cooperation/documents/unesco_wipo_en.pdf> (last accessed on 28 March 2005); World Intellectual Property Organisation *Draft Provision on the Protection of Traditional Cultural Expressions/Expressions of Folklore (TCEs)*, (20 August 2004) WIPO/GRTKF/IC/7/3; World

the contradiction of the Māori approach and the trade mark law system- in a good starting position to establish a law system that would protect Māori knowledge and cultural heritage. The Government would have done better with the establishment of separate legislations, one law that deals with Māori concerns and a Trade Marks Act that concentrates on trade marks matters.

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