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**HOW TO PROTECT “MĀNUKA HONEY” THROUGH
DIFFERENT INTELLECTUAL PROPERTY FRAMEWORKS**

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Mānuka honey, from the nectar of the Leptospermum scoparium tree, is a premium product worth over 500 million NZD to the New Zealand economy. In recent years, Australian producers have also started to use the term to describe their Leptospermum honey. To protect the market share of New Zealand producers and product quality The Manuka Honey Appellations Society has sought to register certification trade marks in various nations so that the “mānuka honey” may only be used by New Zealand producers. This paper examines the different intellectual property mechanisms by which the sign “mānuka honey” could be protected for New Zealand producers. Four mechanisms are examined: (a) certification trade marks; (b) extended passing-off; (c) Fair Trading legislation; and (d) independent geographic indication registration systems, across five jurisdictions: New Zealand, Australia, the United Kingdom, the European Union, and the United States. This paper concludes that MHAS’ approach of seeking registration of certification trade is the most effective. In Part II the paper examines the consequences of the certification trade mark process and compares it to what would occur under an independent geographic indication system. The paper finds that the certification trade mark process has neglected to adequately acknowledge pre-existing kaitiaki interests but also recognises that recent changes such as the creation of the Mānuka Charitable Trust are a positive response.

Key words: *mānuka honey, geographic indication (GI), certification trade marks, extended passing-off.*

Contents

<i>I</i>	<i>Introduction</i>	4
<i>II</i>	<i>Part I – Feasible Frameworks</i>	7
<i>A</i>	<i>The TRIPS Agreement</i>	7
<i>B</i>	<i>Certification Marks</i>	8
<i>C</i>	<i>Extended Passing-Off</i>	16
<i>D</i>	<i>Fair Trading Provisions</i>	20
<i>E</i>	<i>Independent Geographical Indication Registration Systems</i>	22
<i>F</i>	<i>Conclusion on Feasible Mechanisms</i>	25
<i>III</i>	<i>PART II – Implications of Each Approach</i>	26
<i>IV</i>	<i>Conclusion</i>	32
<i>V</i>	<i>Bibliography</i>	34

I Introduction

Coined “liquid gold”¹ mānuka honey is a premium product that is worth over 500 million NZD to the New Zealand economy.² It derives special value from its purported health benefits.³ It is made from the nectar of the mānuka tree (*Leptospermum scoparium*)⁴ which is native to south-east Australia and New Zealand.⁵

As New Zealand producers of mānuka honey cultivated the reputation of monofloral mānuka honey some Australian producers started calling their *Leptospermum* honey “mānuka honey”⁶ too, despite Australians having typically named it “Tea Tree” or “Jelly Bush” honey.⁷ There are concerns about the impact this will have on the perception of mānuka honey⁸ but more importantly the entrance of Australian mānuka honey producers has provided New Zealand producers with competition in key overseas markets, threatening revenue. In fact, Australia’s mānuka honey industry is estimated to increase to 1.27 billion AUD by 2027.⁹

Due to the threat to this valuable business opportunity, a body representing approximately 90 per cent of all mānuka honey producers in New Zealand,¹⁰ the Mānuka

¹ “Mānuka honey at \$1800 a jar takes 'liquid gold' to a whole new level” *I News* (online ed, 30 October 2018).

² Figures in the year to March 2021, from the Exporter Regulatory Advice Service and Economic Intelligence Unit *New Zealand Honey Exports* (Ministry of Primary Industries, Factsheet, June 2021).

³ *TM application no. 1025914 Manuka Honey* [2018] NZIPOTM 7 at [20].

⁴ José Derraik “New Zealand manuka (*Leptospermum scoparium*; Myrtaceae): a brief account of its natural history and human perceptions” (2008) 11(2) *New Zealand Garden Journal* 4 at 4.

⁵ *TM application no. 1025914 Manuka Honey*, above n 3, at [18] and [23].

⁶ This paper will use “mānuka honey” when referring to the term, whereas the physical product will simply be called mānuka honey.

⁷ *TM application no. 1025914 Manuka Honey*, above n 3, at [24]. The Australian Manuka Honey Association beg to differ with the New Zealand narrative, claiming that the first use of the term “Manuka honey” is to be found in Tasmania see Australian Manuka Honey Association “History: The origins of Manuka Honey” (last accessed 4 September 2021) <manukaaustralia.org.au>. Also see *Manuka Honey Appellation Society Incorporated v Lawrence Michael Howes* [2021] ATMO 64 at [6], [16] and [20].

⁸ *TM application no. 1025914*, above n 3, at [27].

⁹ James Fyfe “Australian beekeepers says mānuka dispute with NZ will drive them out of business” *Newshub* (online ed, New Zealand, 31 March 2021).

¹⁰ *TM application no. 1025914 Manuka Honey*, above n 3, at [3].

Honey Appellations Society Incorporated (MHAS) has sought to gain intellectual property rights (IPRs) to the term “mānuka honey”. The goal of MHAS’ endeavours is to ensure that only New Zealand producers of mānuka honey may label it as such.¹¹ MHAS’ role has now been taken over by the Mānuka Charitable Trust (MCT),¹² nevertheless, this paper will, for simplicity, refer to MHAS for *Part I* because even the most recent intellectual property decisions still refer to MHAS. The implications of the creation of the Mānuka Charitable Trust will be discussed in *Part II* where it is more relevant.¹³

Part I of this paper seeks to examine what intellectual property mechanisms are available to ensure only New Zealand producers have exclusive use of the term “mānuka honey”. In other words, how can “mānuka honey” be construed as a geographical indication (GI). A GI can simplistically be defined as a sign that indicates where a product geographically originates from.¹⁴ “Champagne” is a quintessential example of a GI recognised in New Zealand.¹⁵ There are various mechanisms by which GIs can be protected with the availability and applicability differing country by country.¹⁶

The mechanisms which will be examined in this paper are (a) certification marks;¹⁷ (b) independent GI registration systems; (c) extended passing off and; (d) consumer protection laws. Certification marks are a type of trade mark that permit only those products that meet

¹¹ *TM application no. 1025914 Manuka Honey*, above n 3, at [3]-[4].

¹² Mānuka Charitable Trust & Te Pītau Ltd “Naumai haere mai – introducing Mānuka Charitable Trust” (last accessed 4 September 2021) <<http://www.mct.nz>>.

¹³ As far as the author is aware, the most recent trade mark decisions still refer to Mānuka Honey Appellations Society see, for example, *Manuka Honey Appellation Society Incorporated v Lawrence Michael Howes*, above n 7.

¹⁴ The definition is more complex than this and will be examined later.

¹⁵ Susy Frankel *Intellectual Property in New Zealand* (2nd ed, LexisNexis, Wellington, 2011) at 660-61.

¹⁶ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 56-57; *EU-NZ Free Trade Agreement Negotiations: Protection of Geographical Indications in New Zealand* (Ministry of Business, Innovation and Employment & Ministry of Foreign Affairs and Trade, Discussion Paper, December 2019) at [24].

¹⁷ In New Zealand “certification marks” are properly referred to “certification trade marks”, however, for brevity this paper will contend with the term “certification marks”.

specified criteria, such as geographic origin, to use the mark.¹⁸ Another registration mechanism is that of independent GI registration systems.¹⁹ Independent GI registration systems are similar to certification marks but may have different rules creating different obligations and rights. A third way to protect marks that denote geographical origin is the tort of extended passing off, a creature developed by the common law courts.²⁰ Lastly, consumer protection laws can also prohibit the use of certain marketing techniques where these may for instance mislead the consumer about the geographic origin of a product.²¹ New Zealand's section 9 of the Fair Trading Act is an apposite example.²²

Protections must be sought in each nation where the sign is to be protected, each with a unique set of laws.²³ Therefore, this paper will focus on canvassing the mechanisms in Australia, United Kingdom (UK), United States (US), European Union (EU) and to the largest extent New Zealand. These jurisdictions have been selected as they represent jurisdictions in which MHAS has already applied for certification marks and they represent some of the largest identified export markets.²⁴

In *Part I* this paper finds that despite, the hurdles relating to non-distinctiveness and descriptiveness, MHAS' approach of seeking certification marks was the most expedient mechanism to gain the protection of the sign "mānuka honey". Independent GI registration is not possible under New Zealand's current system and nor is it elsewhere because domestic registration is a prerequisite. Although, New Zealand's current system may change given New

¹⁸ Graeme Austin "Anglo and EU Frameworks for Certification and Collective Trademarks" in Ginsburg and Calboli (Ed) *Cambridge Handbook on International and Comparative Trademark Law* (Cambridge University Press, Cambridge, 2020) 296 at 296.

¹⁹ Dev S. Gangjee "Sui Generis or Independent Geographical Indications Protection" in Ginsburg and Calboli (Ed) *Cambridge Handbook on International and Comparative Trademark Law* (Cambridge University Press, Cambridge, 2020) 256 at 257.

²⁰ *EU-NZ Free Trade Agreement Negotiations*, above n **Error! Bookmark not defined.**, at [24]. See Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 567-569 for a discussion as to whether passing off is in fact a tort.

²¹ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 597.

²² Fair Trading Act 1986, s 9.

²³ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 58.

²⁴ The status of trade mark applications can be found by searching on the World Intellectual Property Office (WIPO) website at <www3.wipo.int>.

Zealand's current Free Trade Agreement negotiations with the EU. The common law action of passing-off would be a time and money intensive route to take, especially considering that protection via this mechanism will likely encounter the same difficulties faced by registration for the certification marks without some of the added benefits. Lastly, protection through consumer protection laws would lack certainty and the protection is susceptible to erosion. The conclusion is that certification marks are the right way to go, but if that fails then political action as part of New Zealand's Free Trade Negotiations may be one way to secure protection for New Zealand mānuka honey producers in the EU.

Part II of this paper first looks at who has control and ownership under certification mark and independent registration mechanisms. Further, it considers whether prior kaitiaki interests have been sufficiently acknowledged in the processes thus far. Secondly, the differences in enforcement and offence types between the different mechanisms are considered, finding that there is little difference.

II Part I – Feasible Frameworks

A The TRIPS Agreement

On the 1st of January 1996, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) came into force for most developed countries.²⁵ It is an extensive multi-lateral agreement between all members of the World Trade Organization (WTO).²⁶ The TRIPS agreement sets minimum standards for intellectual property protection including GIs and trade marks, although members are free to determine the appropriate method of implementing the protections of the Agreement.²⁷

²⁵ John Revesz *Trade-Related Aspects of Intellectual Property Rights* (Productivity Commission, Staff Research Paper, May 1999) at 5.

²⁶ World Trade Organization "Overview: the TRIPS Agreement" (last accessed 4 September 2021) <www.wto.org>.

²⁷ Marrakesh Agreement Establishing the World Trade Organization 1967 UNTS 3 (opened for signature 15 April 1994, entered into force 1 January 1995), annex 1C (Agreement on Trade-Related Aspects of Intellectual Property Rights) [TRIPS Agreement], art 1.

B Certification Marks

1 An overview of the law on certification marks

Although not expressly included in the TRIPS Agreement, certification marks are a type of trade mark²⁸ and are defined in later WTO publications. Article 15 of the TRIPS Agreement states that a trade mark is any sign capable of distinguishing the goods or services of one undertaking from those of another.²⁹ Included in the definition of “sign” are words, letters, names and any combination of such signs.³⁰ Newer WTO publications define certification marks as “marks that certify or guarantee certain properties or the origin of a product”.³¹ In New Zealand, they are signs that distinguish, in the course of trade, goods or services certified in respect of some characteristics from goods or services not so certified.³² Comparing this definition to Article 15 of the TRIPS agreement it is evident that the definition of certification marks reflects their slightly different purpose

As of yet, certification marks are the only mechanism by which MHAS has sought to protect “manuka honey” and so this is where the analysis starts.

2 Certification mark registration in New Zealand

When MHAS initially applied for the “mānuka honey” certification mark the application was provisionally rejected.³³ In response, MHAS requested a hearing, the key issues being whether the sign was not registrable because it lacked distinctiveness for the purposes of s 18(1)(b) and s 18(1)(c) of the Trade Marks Act.³⁴ New Zealand’s statutory

²⁸ Gustavo Leonardos *TRIPS’ Trademark, Geographical Indications and Trade Secret Provisions – A Latin American Perspective* (Luiz, Leonardos & Cia, Paper for Presentation, 8-11 November 1995) <www.llip.com> at 12.

²⁹ TRIPS Agreement, above n 27, Article 15.

³⁰ TRIPS Agreement, above n 27, Article 15.

³¹ World Trade Organization “Module III – Trade Marks” <www.wto.org> at 54.

³² Trade Marks Act 2002, s 5(1).

³³ *TM application no. 1025914 Manuka Honey*, above n 3, at [51].

³⁴ *TM application no. 1025914 Manuka Honey*, above n 3, at [51].

scheme provides that where a sign is non-distinctive this is an absolute ground for refusing registration of a trade mark,³⁵ including certification marks.³⁶

Under s 18(1)(b) of the Trade Marks Act, a sign is non-distinctive if it has no distinctive character.³⁷ Further, section 18(1)(c) states that the commissioner must not register a trade mark that consists of signs that may serve, in trade, to designate a characteristic such as the kind of good or the good's geographical origin.

However, subsection (2) of section 18 mandates that the Commissioner not refuse to register a trade mark under subsection (1)(b), (c), or (d) if the mark has acquired a distinctive character.³⁸ This provision reflects that there are different types of distinctiveness, factual and inherent.³⁹ Inherent distinctiveness is the prima facie distinctiveness that a sign has before any evidence is examined. In contrast, factual or acquired distinctiveness is based on evidence that shows that the sign has garnered some distinctive meaning through use of the sign.⁴⁰ Further, more factual distinctiveness is required where the inherent distinctiveness is low.⁴¹

The Assistant Commissioner, Ms Glover, first accepted that the distinguishing function of a certification mark differs from the distinguishing function of an ordinary trade mark.⁴² The Intellectual Property of New Zealand's (IPONZ) Practice guidelines state that the examiner should assess certification marks by considering the requirements set out in section 18(1)(b) by keeping in mind the nature of a certification mark – a mark capable of distinguishing the goods certified from goods not so certified.⁴³

³⁵ Trade Marks Act 2002, s 17.

³⁶ Trade Marks Act 2002, s 5(1).

³⁷ Trade Marks Act, s 33(1)(b).

³⁸ Trade Marks Act 2002, 18(2).

³⁹ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 526 - 527.

⁴⁰ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 524.

⁴¹ *TM application no. 1025914 Manuka Honey*, above n 3, at [60].

⁴² *TM application no. 1025914 Manuka Honey*, above n 3, at [55].

⁴³ New Zealand Intellectual Property "Practice guidelines – Certification marks" Office <www.iponz.govt.nz> at 5.3.1.

Ms Glover found that “mānuka honey” was a certification mark because it is capable of differentiating the honey bearing the mark from honeys not so certified by geographic origin.⁴⁴ In reaching this conclusion, she found that the reference to a well-known native tree, identified by a Māori name, would indicate to consumers that the honey comes from New Zealand.⁴⁵

She noted that this point was somewhat moot because New Zealand has had a historical import ban on honey and so there were no non-New Zealand honey’s on the market,⁴⁶ but contended that she had not known that such a ban existed and that previous case law indicated that the assessor’s experience can be relevant.⁴⁷ A consumer, unaware of the ban, would assume that mānuka honey originates from New Zealand due to the connotations of the mark.⁴⁸

Lastly, Ms Glover found that the application was supported by a sufficient proportion of relevant entities, including the Federation of Māori Authorities (a national Māori business network) so that the tension between those who would like to use the mark and those who were advocating for its registration was not sufficiently large to prevent registration.⁴⁹

The Assistant Commissioner also had no issue with the proposed amendment to regulations stipulating that honey which may lawfully be named mānuka honey in New Zealand and is produced in New Zealand may use the mark.⁵⁰

As a result, the trade mark was accepted and has been advertised. The mark is currently opposed by the Australian Manuka Honey Association, an Australian organisation representing some Australian honey producers in their fight to retain their right to use the term mānuka honey on their products.⁵¹ The opposition hearing is due to commence later this year.

⁴⁴ *TM application no. 1025914 Manuka Honey*, above n 3, at [63].

⁴⁵ *TM application no. 1025914 Manuka Honey*, above n 3, at [63].

⁴⁶ *TM application no. 1025914 Manuka Honey*, above n 3, at [64].

⁴⁷ *TM application no. 1025914 Manuka Honey*, above n 3, at [65].

⁴⁸ *TM application no. 1025914 Manuka Honey*, above n 3, at [66].

⁴⁹ *TM application no. 1025914 Manuka Honey*, above n 3, at [69-70].

⁵⁰ *TM application no. 1025914 Manuka Honey*, above n 3, at [4] and [84].

⁵¹ Australian Manuka Honey Association “About Us” (2021) <manukaaustralia.org.au>.

Shortly before the IPONZ hearing, applications were filed with the Waitangi Tribunal to halt the application process,⁵² the claimants feared that registration would give MHAS exclusive use and control of the mark.⁵³ As the Waitangi Tribunal had made no orders at that time, the Assistant Commissioner continued to carry out her duties under the Trade Marks Act.⁵⁴

Although Māori interests will be discussed in greater detail in *Part II* of this paper it is interesting to note that the Assistant Commissioner did not consider whether the trade mark would be likely to offend a significant section of the community, including Māori.⁵⁵ If it did, this would have been an absolute ground for not registering the trade mark.⁵⁶

Finally, the decision highlights a juxtaposition between the definition of a certification trade mark and absolute reasons to refuse registration. A certification mark is a sign capable of distinguishing in respect of origin, material, quality etc,⁵⁷ but s 18(1)(c) prevents the Commissioner from registering a trade mark that consists only of signs that may serve to designate the kind, quality, geographical origin etc of the good or service.⁵⁸ This would seem to make it difficult for certification marks that refer to a characteristic of the good (which is often the point) to be registered unless it can be shown to have acquired distinctiveness under s 18(2). Such lack of clarity could create obstacles to a lay person's ability to access justice. The UK approach discussed later, would provide a more satisfactory resolution to this issue.⁵⁹

3 *Certification mark registration in overseas jurisdictions*

⁵² *TM application no. 1025914 Manuka Honey*, above n 3, at [87]; Janet Mason “Statement of Claim Seeking an Urgent Hearing” (Wai 2721, 1.1.001, 14 March 2018); Janet Mason “Statement of claim on behalf of Cletus Maanu Paul and others” (Wai 2706, 1.1.001, 5 February 2018).

⁵³ Wai 2721 “Statement of Claim Seeking an Urgent Hearing”, above n 52, at [41]; Wai 2706 “Statement of claim on behalf of Cletus Maanu Paul and others”, above n 52, at [41].

⁵⁴ *TM application no. 1025914 Manuka Honey*, above n 3, at [88].

⁵⁵ Trade Marks Act 2002, s 17(1)(c).

⁵⁶ Trade Marks Act 2002, s 17.

⁵⁷ Trade Marks Act 2002, s 5(1).

⁵⁸ Trade Marks Act 2002, s 18(c).

⁵⁹ See page 13.

Like New Zealand, Australia, the UK, the EU, and the US define certification marks as signs that distinguish, in the course of trade, goods certified in respect of characteristics from goods not so certified.⁶⁰ However, the EU definition expressly excepts geographical origin as a characteristic to which a certification mark can pertain,⁶¹ meaning MHAS could not rely on arguments premised on the idea that the “mānuka honey” denotes a New Zealand product.⁶² This rule is to encourage protection through the EU’s independent GI registration systems instead.⁶³

The requirement for distinctiveness of certification marks is common to all the jurisdictions examined in this paper. Section 3(1) of the UK Trade Marks Act 1994 (the UK Act) is near identical to s 18 of the New Zealand Act.⁶⁴ The EU requirement for distinctiveness is also similar.⁶⁵ The Australian Trade Marks Act (the Australian Act) provides no separate test for distinctiveness. The focus is merely on whether the trade mark is capable of distinguishing goods certified from those not certified,⁶⁶ looking at the inherent and factual capability.⁶⁷ However, in *British Sugar* Jacob J, in relation to the UK Act, held that there was little difference between the meaning of “capable of distinguishing” and “of distinctive character”.⁶⁸ In the US, a mark may not be registered if it is merely descriptive of the goods,⁶⁹ but this will not prevent registration if the mark has become distinctive of the applicant’s goods.⁷⁰ This illustrates that in New Zealand, the UK, Australia, the EU and the US for a sign to be registered as a

⁶⁰ Trade Marks Act 2002, s 5(1); Trade Marks Act 1994 (UK), s 50; Trade Marks Act 1995 (Cth), s 169; Regulation 2017/1001 on the European Union trade mark [2017] OJ L154/1, Article 74; Trademark Act (Lanham Act) 15 USC § 1127.

⁶¹ Regulation 2017/1001 on the European Union trade mark [2017] OJ L154/1, Article 83.

⁶² European Intellectual Property Office *Refusal of Application No 017285421 Manuka Honey* (30 April 2019) at 1.

⁶³ Austin “Anglo and EU Frameworks for Certification and Collective Trademarks”, above n 18, at 298.

⁶⁴ Trade Marks Act 1994 (UK), s 3(1).

⁶⁵ Regulation 2017/1001 on the European Union trade mark [2017] OJ L154/1, Article 7.

⁶⁶ Trade Marks Act 1995 (Cth), s 177.

⁶⁷ Trade Marks Act 1995 (Cth), s 177(2).

⁶⁸ *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 (EWHCC) cited in Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 523.

⁶⁹ Trademark Act (Lanham Act) 15 USC § 1052(e).

⁷⁰ Trademark Act (Lanham Act) 15 USC § 1052(f).

certification mark it must have distinctive character, whether inherent or factually acquired or both even where this requirement is not explicitly expressed.

The US and UK frameworks have extra rules for certification marks which serve as indications of geographical origin. The UK Act has additional provisions under the heading “Indication of geographical origin” stating that:⁷¹

Notwithstanding section 3(1)(c), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

Section 3(1)(c) states that a trade mark must be refused registration if it consists solely of signs which designate, among other things, geographical origin.⁷² Similarly, under the US regime certification marks can be primarily geographically descriptive, even though this would cause a mark to be rejected in a trademark or service mark application.⁷³ These provisions acknowledge the fact that geographic certification marks tend to be high in inherent descriptiveness which makes it difficult to reach the requisite distinctiveness to register the mark, although, these provisions do not remove the need to show factual distinctiveness instead. As mentioned above, New Zealand does not have a like provision to guide a reader through this juxtaposition.

The limitations of the US exception are best exemplified in *re Cooperativa Produttori Latte e Fontina Valle D’Acosta* where it was held that “Fontina” was a generic name for a cheese rather than a certification mark indicating regional origin because non-certified producers outside that region also use the term for their non-certified cheeses.⁷⁴ Registration was refused.⁷⁵ This suggests, that although leeway is given to certification marks that are geographically descriptive, some level of factual distinctiveness is still required. Moreover, the

⁷¹ Trade Marks Act 1994 (UK), sch 2 s 3.

⁷² Trade Marks Act 1994 (UK), s 3(1)(c).

⁷³ Trademark Act (Lanham Act) 15 USC § 1052(e).

⁷⁴ “Geographical Indication Protection in the United States” (United States Patent and Trademark Office, date unknown) at 4; *In re Cooperativa Produttori Latte E Fontina Valle D’Acosta* 230 USPQ 131 (1986).

⁷⁵ “Geographical Indication Protection in the United States” (United States Patent and Trademark Office, date unknown) at 4; *In re Cooperativa Produttori Latte E Fontina Valle D’Acosta* 230 USPQ 131 (1986).

provisions refer to indications of “regional origin”. Therefore, the leniency towards geographic description is unlikely to assist the registration of “mānuka honey”.

Therefore, the common hurdle for “mānuka honey” in all the above-mentioned jurisdictions is to show that it has, in the eyes of law, acquired sufficient distinctiveness in each respective jurisdiction.

4 Outcomes of certification mark registration attempts

MHAS’ application for “mānuka honey” in Australia is the only guaranteed outcome to date – it will not be registered. IP Australia (the Australian Intellectual Property Office) deemed that the mark was a descriptive term, not capable of distinguishing a product from those of other traders.⁷⁶ The Examiner held that “manuka honey” merely describes the type of honey – honey made from the mānuka plant. Moreover, the Examiner determined that it would be inappropriate to grant a monopoly over the term “manuka honey” as other producers would need to use the term, including Australian producers.⁷⁷ The application has now lapsed meaning the decision will not be appealed.⁷⁸

In contrast, the United Kingdom Intellectual Property Office (UKIPO) approved the certification mark so that it could be advertised in 2017. The trade mark has been opposed by the British honey manufacturers Rowse and the Australian Manuka Honey Association.⁷⁹ The UK hearing will be in the latter half of 2021.

Similarly to Australia, the EU Intellectual Property Office (EUIPO) initially rejected MHAS’ application as it decided that consumers would understand the term to mean “honey from the nectar of the manuka tree”, and therefore there was no difference between the term

⁷⁶ Letter from Glen Rieschick (Examiner at IP Australia) to Manuka Honey Appellations Society (applicant of TM No. 1752903 Manuka Honey) regarding Exam Response (6 May 2016); Iain Freeman “IP Australia tells New Zealand to “buzz off” (20 October 2017) Lavan <www.lavan.com.au>.

⁷⁷ Letter from Glen Rieschick to Manuka Honey Appellations (6 May 2016), above n 76; Iain Freeman “IP Australia tells New Zealand to “buzz off””, above n 76.

⁷⁸ IP Australia “Trade mark 1752903” (3 August 2017) <search.ipaustralia.gov.au>.

⁷⁹ “Trade mark number UK00003150262” Intellectual Property Office <trademarks.ipo.gov.uk>

submitted for registration and the term ordinarily used.⁸⁰ EUIPO was persuaded by the public interest that signs describing the characteristics of goods or services for which registration is sought should be free to use.⁸¹ An appeal from this decision is currently pending.⁸²

One of the issues that the USPTO (United States Patents and Trade Marks Office) found with the mark is the fact that it is merely descriptive and there is a likelihood of confusion with other registrations.⁸³ It will be for MHAS to respond to these issues and any other concerns the Office may have.

Intellectual property is territorial by nature.⁸⁴ For example, leading intellectual property academic Frankel notes that the citation of foreign registration is of limited value in support of an application in New Zealand.⁸⁵ The same can be said for other nations too. This is perhaps one reason why despite the consistencies in the general rules to be applied, MHAS' success has differed across jurisdictions.

Another reason is the difference in facts that relate to each jurisdiction, in particular facts relating to use, acquired distinctiveness and the prominence of competition in the market. For example, in MHAS' IPONZ (New Zealand) an important factor was New Zealand's ban on importing honey and so the Assistant Commissioner could be confident that mānuka honey in the New Zealand market had exclusively been produced in New Zealand.⁸⁶ This conclusion was not available to IP Australia in respect of the Australian market.

Furthermore, the nuances in the law are critical for the success of "mānuka honey" in each jurisdiction. A strong argument before the New Zealand Assistant Commissioner was that mānuka honey denoted to consumers that the honey was produced in New Zealand. Under the

⁸⁰ *Refusal of Application No 017285421 Manuka Honey*, above n 62, at 4.

⁸¹ *Refusal of Application No 017285421 Manuka Honey*, above n 62, at 3 and 6.

⁸² European Union Intellectual Property Office "Manuka Honey 017285421" (last accessed 5 September 2021) <euipo.europa.eu>.

⁸³ Letter from Ryan Cianci (United States Patent and Trade Mark Office examining attorney) to Lynn Jordan (Kelly IP, LLP) regarding Suspension Letter of Manuka Honey trade mark (2 September 2020).

⁸⁴ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 28.

⁸⁵ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 58.

⁸⁶ *TM application no. 1025914 Manuka Honey*, above n 3, at [61].

EU regulations, the certification mark cannot designate geographical origin and so the case for “mānuka honey” will have to solely rest on the notion that “mānuka honey” tells the consumer that it is *Leptospermum scoparium* honey with a specific genetic profile that can only be produced in New Zealand.

It is evident that “mānuka honey” does not have a clear-cut case for registration in any jurisdiction meaning the factual, legal and cultural nuances across jurisdictions will be decisive. The main issue is that the sign has very little inherent distinctiveness.⁸⁷

C *Extended Passing-Off*

Passing off protects the goodwill that traders have established with customers,⁸⁸ and can prevent the use of names or marks by competitors.⁸⁹ The tort has also been extended in a series of cases, which is best described by Frankel:⁹⁰

This extended tort protects not the reputation of the individual trader in a particular name, but the reputation of a group of traders in a descriptive name often, but not necessarily, derived from the geographical region in which their products originates.

Typically, passing off will be satisfied if the plaintiff can show that they have garnered goodwill in the jurisdiction in which the claim is brought and that the defendant is using the sign or get-up which is associated with that goodwill leading the public to believe that goods are associated with the plaintiff (referred to as the misrepresentation), and thereby causes damage.⁹¹

⁸⁷ For a more in-depth analysis of “Descriptive” words being held to be “distinctive” see Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 650.

⁸⁸ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 564.

⁸⁹ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 564.

⁹⁰ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 571.

⁹¹ This is a summarised version of the test found in *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 All ER 873 (HL) at 880, applied in *Frucor Beverages Ltd v Red Bull GmbH* HC Auckland CIV-2009-404-006525, 12 February 2010. See also Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 566.

For MHAS to maintain a passing off action against overseas producers they will need to show that the New Zealand producers have been able to win sufficient goodwill in relation to the term “mānuka honey” considering the size and distribution of prospective consumers.⁹² It will likely be sufficient for MHAS to show that the overseas producers have caused damage to the goodwill of New Zealand producers by impairing the distinctiveness of the mark.⁹³ However, it is unclear whether MHAS’ inability to show damage, as they are just a trade association, will deny them standing to sue.⁹⁴ A New Zealand mānuka honey producer may have to bring proceedings instead as they will in fact suffer loss in sales etc.

The Court of Appeal in *Chocosuisse* held that if the words are no more than descriptive, one cannot found an action in passing off.⁹⁵ The Court also cited with approval the trial judge’s statement that the words needed to have a “discrete reputation”.⁹⁶ In the case, *Cadbury* was looking to use the term “Swiss” for their chocolate. At trial, Laddie J concluded that Swiss Chocolate had a distinct reputation, not just because the products came from Switzerland but because Swiss Chocolate had a reputation for quality.⁹⁷

Applying the logic in *Chocosuisse*, MHAS will need to show that “mānuka honey” means more than just honey produced from *Leptospermum scoparium*. The extent to which the courts will be willing to recognise that depends on whether they think that mānuka honey, in the eyes of consumers, denotes a New Zealand product. One factor will be whether the use of an indigenous word suggests that the good is produced in the country in which those indigenous people have historically lived. In the end, a clear demonstration of a secondary meaning of “mānuka” will have to be shown.⁹⁸

⁹² *Hansen Beverage Company v Bickfords (Australia) Pty Ltd (ACN 053 240 261) and Another* (2008) 79 IPR 174 at [34].

⁹³ *Wineworths Group Ltd v Comite Interprofessionel du Vin de Champagne* [1992] 2 NZLR 327 at 332.

⁹⁴ *Chocosuisse Union des Fabricants Suisse de Chocolat v Cadbury Ltd* [1999] RPC 826 (CA).

⁹⁵ *Chocosuisse Union des Fabricants Suisse de Chocolat v Cadbury Ltd* [1999] RPC 826 (CA).

⁹⁶ *Union des Fabricant Suisses de Chocolat v Cadbury Ltd* (1997) 41 IPR.

⁹⁷ *Union des Fabricant Suisses de Chocolat v Cadbury Ltd* (1997) 41 IPR.

⁹⁸ Katharine Saunders "Choccosuisse - The New 'Extended Extended' Passing Off" (2001) 32 VUWLR 351.

The exact definition of what is meant by “mānuka” is crucial. In *Chocosuisse*, Laddie J further elucidated that:⁹⁹

no proprietor currently using the name in relation to his goods can prevent any new competitor of his making or selling goods to which the name can accurately be applied and from using the name for that purpose. The current users of the descriptive word can only use their shared interest to prevent others from using it on products for which it is not a proper description.

This shows the limitations of the protections afforded under extended passing off. Again, MHAS cannot prevent legitimate use of the word and therefore a key factor is determining what mānuka means. Does it include the Australian *Leptospermum* species or overseas *L. scoparium*?

More broadly, Laddie J’s exposition shows the similarities between certification marks and extended passing off. However, there are important practical differences. Registered marks are easier to protect in some cases.¹⁰⁰ For passing off, the plaintiff’s goodwill and the damage to it need to be established, whereas for a registered mark the plaintiff must merely show that the defendant infringed the mark with identical or similar goods.¹⁰¹ This provides more certainty and clarity when legal action needs to be taken.

The Australian common law position may be different yet again. “Champagne” was not protected in Australia as a wine coming solely from that region in France, produced by *methode traditionnelle*, as it was in New Zealand.¹⁰² In the *Australian Champagne* case, for example, Franki J held that confusion had reigned for too long, and there was insufficient geographic distinctiveness for “champagne” to mislead Australian consumers.¹⁰³ Therefore, it seems unlikely that an extended passing off action would avail MHAS’ quest to protect mānuka honey in Australia. There are numerous Australian manuka honeys in Australian supermarkets,¹⁰⁴

⁹⁹ *Union des Fabricant Suisses de Chocolat v Cadbury Ltd* (1997) 41 IPR at 6.

¹⁰⁰ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 597.

¹⁰¹ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 598.

¹⁰² *Comite Interprofessionel du Vin de Champagne v N L Burton Pty Ltd* (1981) 38 ALR 664 at 671.

¹⁰³ Anna Sharpe “Protecting Business Reputation in Australia – section 52 of the Trade Practices Act and Passing Off” (1983) *Federal Law Review* (13) 254 at 266. <<http://classic.austlii.edu.au>>.

¹⁰⁴ Coles “manuka honey” (last accessed 5 September 2021) <shop.coles.com.au>.

which may signal that by now mānuka honey’s “geographic distinctiveness” has eroded so as no longer to be sufficient. The case for “manuka honey” in Australia seems analogous to that of “Champagne” in the 1980s. In a recent failure of MHAS to oppose the registration of the trade mark “Australian Manuka” the Hearing Officer noted that “Champagne” is now protected on a register for geographical indications due to a ‘claw-back’ policy.¹⁰⁵ The Officer considered whether such a policy would aid MHAS’ opposition but decided that it would not as mānuka in relation to honey, connotes its floral source regardless of location.¹⁰⁶ Additionally, the Officer dismissed the idea that passing-off would be a viable cause of action.¹⁰⁷

It would seem strange if passing off could undermine the certification mark decisions made by IP Australia unless there was a drastic change in consumer perception. Rather, the tort of extended passing off is best seen as a protection mechanism for those who have omitted to register a trade mark, rather than a way to circumnavigate the system.

The US also protects unregistered trade marks. In *Institut National Des Appellations v. Brown-Forman Corp*, the Trademark Trial and Appeal Board held that “Cognac” was a valid common law regional certification mark, rather than a generic term.¹⁰⁸ This was found since purchasers in the United States primarily understand the “Cognac” designation to refer to brandy originating in the Cognac region of France, and not to brandy produced elsewhere.¹⁰⁹ In this case the *Institut* already performed a certification function and the term met the definition of a certification mark as defined in the Lanham Act.¹¹⁰ *Brown-Forman* had merely objected that consumers did not know that.¹¹¹ In contrast to the *Institut* MHAS does not (currently) certify honey produced in New Zealand. Again the common law protection would only have been afforded where registration would have been possible.

¹⁰⁵ *Manuka Honey Appellation Society Incorporated v Lawrence Michael Howes*, above n 7, at [24].

¹⁰⁶ *Manuka Honey Appellation Society Incorporated v Lawrence Michael Howes*, above n 7, at [27].

¹⁰⁷ *Manuka Honey Appellation Society Incorporated v Lawrence Michael Howes*, above n 7, at [28].

¹⁰⁸ “Geographical Indication Protection in the United States” (United States Patent and Trademark Office, date unknown) at 6.

¹⁰⁹ “Geographical Indication Protection in the United States” (United States Patent and Trademark Office, date unknown) at 6.

¹¹⁰ *Institut National Des Appellations d'Origine v. Brown-Forman Corp.* 47 USPQ 2d 1875 (1998) at footnote 8.

¹¹¹ *Institut National Des Appellations d'Origine v. Brown-Forman Corp.* 47 USPQ 2d 1875 (1998).

Overall, it seems that a common law action will not allow the sign “mānuka honey” to bypass the requirements it would need to satisfy in order to obtain protection as a certification mark in the respective jurisdictions discussed above.

Trade mark law has to balance the need to protect competition by allowing traders to distinguish themselves but also needs to ensure that it does not overreach and stifle competition.¹¹² These concerns, alongside others, have been carefully considered to craft the relevant trade mark legislation and it would undermine the separation of powers if considered policy considerations could be bypassed by common law means where the facts have not changed.

D Fair Trading Provisions

Fair Trading provisions generally have a different purpose to trade marks (registered or unregistered). They attempt to protect consumers, whereas trade marks protect the trader who has gained goodwill.¹¹³ Despite this, the requirements to protect a sign under fair trading legislation is similar to those under passing-off.

Australian and New Zealand legislation prohibits persons from engaging in conduct that is misleading or likely to mislead while in trade.¹¹⁴ The Australian Act also provides specific provisions preventing businesses from making misleading representations about the country of origin of goods, but those provisions will be of limited relevance to the “mānuka honey” issue as the sign makes no explicit reference to a country.¹¹⁵

¹¹² Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 567.

¹¹³ See Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 574.

¹¹⁴ Fair Trading Act 1986, s 9; Competition and Consumer Act 2010 (Cth), sch 2 s 18.

¹¹⁵ “Avoiding unfair business practices: a guide for businesses and legal practitioners” (Commonwealth of Australia, 2010) <www.accc.gov.au> at 13.

Under the Lanham Act in the US, a civil action can be brought by anyone who believes they are likely to be damaged by a person's misleading representation, while in commerce, which is likely to cause confusion as to the characteristic of the commercial activity.¹¹⁶

In the UK, Consumer Protection regulations prevent misleading commercial practices.¹¹⁷ Misleading practices include those where a product is advertised in a way that creates confusion with any distinguishing marks of a competitor and is likely to cause the average consumer to make a transaction which they would otherwise not have taken.¹¹⁸

Unlike passing off, the fair trading provisions do not necessarily require a loss to be suffered by the competitor reflecting the purpose of the provisions - to protect the consumer.¹¹⁹ This provides an advantage to plaintiffs under this cause of action. However, the issue of whether there was "misleading" conduct in the first place remains. This again depends on what consumer's perceive "mānuka honey" to mean. This is especially important as the Court of Appeal in New Zealand held that a state of "wonder or doubt in the minds of people" is insufficient to constitute misleading conduct.¹²⁰

Fisher J in *Magellan Corporation Ltd* outlined that a plaintiff in a Fair Trading Act case will normally need to establish (1) its own established reputation in relation to the name in question (2) that the defendant's use is so similar that it will likely mislead a significant number of consumers; and (3) it is appropriate to grant a remedy.¹²¹ The test outlined (although neither exclusive nor conclusive) bears striking similarity with the elements of an extended passing off action bar the need to show loss. This further demonstrates, MHAS will broadly have to prove their distinct claim to the sign "mānuka honey" to protect it via the fair trading provisions, this

¹¹⁶ Trademark Act (Lanham Act) 15 USC § 1125.

¹¹⁷ The Consumer Protection from Unfair Trading Regulations 2008 (UK), reg 5.

¹¹⁸ The Consumer Protection from Unfair Trading Regulations 2008 (UK), reg 5.

¹¹⁹ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 572.

¹²⁰ *Taylor Bros Ltd v Taylors Group Ltd* [1988] 2 NZLR 1 (CA) at 39; see also Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 576.

¹²¹ *Magellan Corporation Ltd v Magellan Group Ltd* (1995) 6 TCLR 598 (HC) at 608-608 cited in Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 593.

puts a burden on the plaintiff in a litigation scenario that is absent in the case of a registered trade mark.

Furthermore, the continued production of goods labelled “mānuka” but produced outside of New Zealand will corrode what is left of consumer perceptions, if any, that mānuka honey is solely a New Zealand product.

E Independent Geographical Indication Registration Systems

GI protection via certification marks, passing-off and fair trading provisions have already been examined so far. Finally, GI’s can be protected through an independent (sometimes called *sui generis*) registration system.¹²²

Australia and the US have independent GI registration for wines only, otherwise relying on certification marks.¹²³ Therefore, mānuka honey cannot be registered in those nations. In contrast to the US and Australia, the EU has extensive GI registration systems and are a proponent of their use.¹²⁴ The requirements for GI registration in the UK, for the purposes of this paper, are to a large extent similar to those of the EU. Therefore, there will be no separate analysis for potential UK registration.¹²⁵ “Mānuka honey” is not registrable as a GI in the EU nor the UK because GI registration in those jurisdictions requires registration in the host nation first.¹²⁶

New Zealand’s independent GI registration system only accommodates wine and spirits.¹²⁷ However, currently, New Zealand is negotiating a Free Trade Agreement (FTA) with

¹²² Gangjee “*Sui Generis* or Independent Geographical Indications Protection”, above n 19, at 257.

¹²³ Gangjee “*Sui Generis* or Independent Geographical Indications Protection”, above n 19, at 261.

¹²⁴ Gangjee “*Sui Generis* or Independent Geographical Indications Protection”, above n 19, at 258.

¹²⁵ “Protect a geographical food or drink name” (Department for Environment, Food & Rural Affairs (UK), 6 January 2021) <www.gov.uk>.

¹²⁶ Kimberlee Weatherall at “Does the Unfair Competition Approach to Geographical Indications of Origin Have a Future?” in Ginsburg and Calboli (Ed) *Cambridge Handbook on International and Comparative Trademark Law* (Cambridge University Press, Cambridge, 2020) 271 at 276. See also TRIPS Agreement, Article 24(9).

¹²⁷ Geographical Indications (Wine and Spirits) Registration Act 2006.

the European Union (EU),¹²⁸ and one of the topics to be negotiated are proposals by the EU on a common GI framework between the EU and NZ that would allow the registration of numerous EU GIs in New Zealand and the registration of New Zealand GIs in the EU.¹²⁹ This paper will briefly examine how the EU's proposed changes to the New Zealand system may allow for the registration of "mānuka honey" as a GI.

The EU proposes the expansion of New Zealand's GI registration framework to enable the protection of foodstuff GIs.¹³⁰ Honey is likely encompassed by this definition. The EU's own GI food register accommodates honey under category 1.4 "Other products of animal origin (eggs, honey, various dairy products except butter, etc.)."¹³¹ Therefore, mānuka honey as a product type would be registrable.

It is not necessary that the GI be the typical name of the place from which the product originates like "Champagne". The EU has already accommodated the likes of Feta in its GI registration system. "Feta" does not denote a place. Conceptually, "mānuka honey" may be conceived of as an indirect GI. An example of an indirect GI is the image of a famous mountain in Switzerland, the Matterhorn, that identifies that a product comes from Switzerland according to Swiss law.¹³²

The EU GI systems specifically require that for a GI to be registered a link between the geographical area and a quality of the product is shown.¹³³ This reflects a key aspect of the definition of GIs in the TRIPS agreement, that they have a characteristic that is "essentially attributable" to the geographic origin that is indicated by the sign.¹³⁴ The author of this paper suggests that the link requirement does well to balance the relaxed rules regarding the

¹²⁸ *EU-NZ Free Trade Agreement Negotiations*, above n 16, at [1].

¹²⁹ See *EU-NZ Free Trade Agreement Negotiations*, above n 16128.

¹³⁰ *EU-NZ Free Trade Agreement Negotiations*, above n 16, at [34].

¹³¹ European Commission "eAmbrosia - the EU geographical indications register" (1 August 2021) <ec.europa.eu>.

¹³² World Trade Organization "Module IV - Geographical Indications" <www.wto.org> at 25.

¹³³ European Commission "Guide to Applicants: How to compile the single document" <ec.europa.eu> at section 5.

¹³⁴ TRIPS Agreement, Article 22.1.

descriptiveness of GIs, in effect, justifying a group of trader's exclusive right to a term that is otherwise generic.

Evidence of the link must be forthcoming for the sign to be registered as GI.¹³⁵ Per leading academic Gangjee TRIPS recognises two broad pathways for linking a product to place: (i) the seemingly more objective, physical qualities or characteristics route, or (ii) the apparently subjective reputation option.¹³⁶

Pursuing pathway one, mānuka honey could lean on the health benefits and the underpinning organic composition as a characteristic of the product. These characteristics stem from the mānuka honey tree which is only native to New Zealand and Southern Australia. Further, tests which can differentiate Australian "mānuka" from New Zealand "mānuka" are available, which would help demonstrate that the characteristics are linked to New Zealand and not beyond.¹³⁷ This approach shows that mānuka honey's health qualities can be essentially attributed to New Zealand's unique flora composition. There is a prima facie case to be made for GI registration under the EU scheme.¹³⁸

Another basis on which to distinguish New Zealand's mānuka honey from the Australian products is the idea that mānuka's current reputation as a panacea is a continuation of Māori use of the plant for its health benefits; the value of mānuka honey draws on centuries of traditional knowledge specific to New Zealand.¹³⁹ There are thousands of EU GIs and the link requirement has often been interpreted liberally, New Zealand "mānuka honey" would stand a good chance in satisfying it.

Although mānuka honey cannot, currently, be registered as GI under the independent registration systems examined, New Zealand's ongoing FTA negotiations with the EU may

¹³⁵ Regulation 1151/2012 on Quality schemes for Agricultural Products and Foodstuff [2012] OJ L343/1, Article 8(c)(ii) requires evidence of the link as an essential part of the application.

¹³⁶ Gangjee "Sui Generis or Independent Geographical Indications Protection", above n 19, at 264.

¹³⁷ *Manuka Honey Appellation Society Incorporated v Lawrence Michael Howes*, above n 7, at [26].

¹³⁸ Contrast *Manuka Honey Appellation Society Incorporated v Lawrence Michael Howes*, above n 7, at [26].

¹³⁹ Waitangi Tribunal *Ko Aotearoa Tēnei: A Report into Claims Concerning New Zealand Law and Policy Affecting Māori Culture and Identity* (Wai 262, 2011) vol 1 at 67.

lead to an overhaul of the New Zealand system which would allow registration in New Zealand which would, in turn, pave the way for registration in the EU and UK.

The final approach is that of political compromise instead of establishing a whole new independent registration system. New Zealand could individually negotiate the exchange of specific GIs and conditions related to their use.¹⁴⁰ This has been done before, such as the Canada-European Union Comprehensive Economic and Trade Agreement (CETA).¹⁴¹ The benefits are that such an agreement allows flexibility to protect those GIs that nations see as most valuable, but they could also lead to greater complexity and inconsistencies.¹⁴²

F Conclusion on Feasible Mechanisms

The certification mark process has presented difficulties for mānuka honey and jurisdictions seem split as to whether the sign can be registered as a certification mark. Passing off would provide no easier mechanism for protecting the sign either but would burden MHAS with establishing goodwill each time an action was brought to protect against infringements. Similar to passing off, fair trading provisions, although they do not necessarily require proof of loss, will also place a burden on the plaintiff to show there was misleading conduct. This is not an easy threshold to meet. Lastly, a GI system akin to the EU's would lend itself well to protecting "mānuka honey" but it will be years until such a system is established. The analysis illustrates that despite the difficulties that the certification mark route has presented it is the most expedient mechanism available to MHAS to protect the sign.

Expedience is key where commercial assets are concerned, however, the next part of this paper will consider the political, practical and legal ramifications of the current approach.

¹⁴⁰ Kimberlee Weatherall "Does the Unfair Competition Approach to Geographical Indications of Origin Have a Future?", above n 126, at 289.

¹⁴¹ Comprehensive Economic and Trade Agreement, Canada-EU (signed 30 October 2016) at Article 20.18.

¹⁴² Kimberlee Weatherall "Does the Unfair Competition Approach to Geographical Indications of Origin Have a Future?", above n 126, at 289.

III PART II – Implications of Each Approach

Since the filing of the various certification marks, MHAS have been replaced by the Mānuka Charitable Trust (MCT) and its associated company Pitau Ltd and is now responsible for spearheading the mānuka honey intellectual property fight.¹⁴³ The trust is focused on protecting, preserving and enhancing the Mana and Mauri of Mānuka treasures.¹⁴⁴

According to Te Taumata, a Māori interest group, the current intellectual property regime in New Zealand is inadequate to protect Māori rights.¹⁴⁵ This is because it requires an identifiable owner, commercial exploitation and provides only a limited period of protection.¹⁴⁶ In contrast, Māori interests are generally held on behalf of the community and are enduring,¹⁴⁷ although, Māori do not necessarily view their knowledge assets as being in the public domain.¹⁴⁸ The “mānuka honey” certification mark endeavour has recognised the shortcomings of the current system by using available legal mechanisms to remedy them, however, this paper argues that there is more that could be done.

The current certification mark process has not paid sufficient respect to the existing rights associated with “mānuka honey”, effectively treating the sign as part of the public domain by permitting use of the mark free of charge.¹⁴⁹ The proposed regulations of the certification mark only require that the honey be produced in New Zealand and meet the definition of mānuka honey.¹⁵⁰ These open and general criteria mean that large honey

¹⁴³ Mānuka Charitable Trust & Te Pītau Ltd “Naumai haere mai – introducing Mānuka Charitable Trust” (last accessed 4 September 2021) <<http://www.mct.nz>>.

¹⁴⁴ Mānuka Charitable Trust & Te Pītau Ltd “Naumai haere mai – introducing Mānuka Charitable Trust” (last accessed 4 September 2021) <<http://www.mct.nz>>.

¹⁴⁵ Te Taumata “Submissions to the Hon. Minister Nanaia Mahuta Minister of Māori Development on Māori Interests and Geographic Indicators” (8 May 2020) at 51 < www.tetaumata.com > at 51.

¹⁴⁶ Te Taumata “Submissions to the Hon. Minister Nanaia Mahuta Minister of Māori Development on Māori Interests and Geographic Indicators”, above n 145, at 51.

¹⁴⁷ Te Taumata “Submissions to the Hon. Minister Nanaia Mahuta Minister of Māori Development on Māori Interests and Geographic Indicators”, above n 145, at 51.

¹⁴⁸ Frankel *Intellectual Property in New Zealand*, above n **Error! Bookmark not defined.**, at 116.

¹⁴⁹ *TM application no. 1025914 Manuka Honey*, above n 3, at [5].

¹⁵⁰ *TM application no. 1025914 Manuka Honey*, above n 3, at [4].

producers such as Comvita, Arataki and Mother Earth could benefit from the use of the mark without acknowledging the traditional mātauranga Māori which has recognised the health benefits of the mānuka plant.¹⁵¹ After all, it is the health benefits that make mānuka honey so valuable.

The Waitangi Tribunal in Wai 262 thought that kaitiaki have valid rights in respect of the mātauranga Māori associated with the taonga species.¹⁵² Therefore, the commercial exploitation of mātauranga Māori must give proper recognition to the prior interests of kaitiaki.¹⁵³ In addition, as te reo Māori is the “core of Māori culture and mana”,¹⁵⁴ the use of the language for commercial gain should also recognise Māori interests. Especially, where the Māori term adds value by complementing the product’s physical properties with an added air of mysticism and spiritual power which may be an attraction for overseas purchasers. Further, the “Māoriness” of the term is being leveraged to support the certification mark applications.¹⁵⁵ In summary, “mānuka honey” is associated with mātauranga Māori and, both the plant and the word itself are taonga. These are strong interests that deserve recognition.

One way to readily recognise Māori interests could be to implement a charge which is a fixed percentage of the revenue derived from an organisation’s “mānuka honey” products, with royalties paid to Māori that possess kaitiaki interests in mānuka honey and the associated mātauranga Māori. The imposition of such a charge would be an affirmation of Article Two of te Tiriti o Waitangi which guarantees Māori te tino rangatiratanga¹⁵⁶ over their taonga,¹⁵⁷ and would meaningfully recognise that there were prior interests. A proportional system would not overburden small operations but will ensure that those who gain more from the use mark also pay back more. Additionally, the maximum amount payable should be capped. Naturally, the details of such a system would need to be carefully considered and investigated and is beyond

¹⁵¹ Wai 262 vol 1, above n 139, at 67.

¹⁵² Wai 262 vol 1, above n 139, at 94.

¹⁵³ Wai 262 vol 1, above n 139, at 95.

¹⁵⁴ A quote attributed to Sir James Henare from Wai 262 vol 1, above n 139, at 151.

¹⁵⁵ See Gerard Hutching “Hey Australia - keep your hands off New Zealand's mānuka honey” *Stuff* (online ed, New Zealand, 5 March 2019); also see Julie Iles “Mānuka trademark in the UK excludes Australian beekeepers” *Stuff* (online ed, New Zealand, 19 December 2017).

¹⁵⁶ Rangatiratanga is translated as “Māori authority and control” in Wai 262 vol 1, above n 139, at 43.

¹⁵⁷ Wai 262 vol 1, above n 139, at 43.

the scope of this paper. Moreover, the proportion of interests of different iwi and hapū would also need to be considered.

The people and entities behind the endeavour to protect “mānuka honey” have mitigated some of the issues that arise from protecting a Māori term across the globe by choosing to use a certification mark. The restrictions imposed on the owner of the certification mark owner support the recognition of other interests. The owner of the mark cannot prevent anyone who meets the criteria in the regulations from using the mark.¹⁵⁸ This has allowed those with little prior connection to the mark to benefit (as discussed above) but also ensures that those with legitimate kaitiaki interests are not excluded from using the mark. Furthermore, the owner of the certification mark is, in many jurisdictions, not allowed to trade in the goods of the kind certified.¹⁵⁹ This prevents the mark from being used maliciously for commercial gain, even if it is transferred to a disingenuous entity.

Furthermore, the certification mark process has now been placed into the hands of the Mānuka Charitable Trust & Pitau Ltd who focus on protecting the Mana and Mauri of Mānuka treasures and conducts hui with related to Māori interests.¹⁶⁰ The previous owners of the applications, MHAS, gained approval from certain Māori interest groups but it was not clear how it further considered Māori interests.¹⁶¹ In fact, several claims were filed with the Waitangi Tribunal to halt the certification mark process claiming, inter alia, that no recognition had been given to the fact mānuka as a plant and word is a taonga belonging to Māori.¹⁶² Although the Claimants of the Wai 2706 and 2721 claims were mistaken when they claimed that registration of the mark would have given MHAS exclusive use and control over the term “mānuka honey”

¹⁵⁸ In New Zealand see for example “Practice guidelines: Certification marks” New Zealand Intellectual Property Office <www.iponz.govt.nz> at 6.4.3. To see this rule in relation to the “manuka honey” application see *TM application no. 1025914 Manuka Honey*, above n 3, at [76].

¹⁵⁹ See Trade Marks Act 2002, s 14; see Trade Marks Act 1994 (UK), sch 2 s 4; see Regulation 2017/1001 on the European Union trade mark [2017] OJ L154/1, Article 83. Compare with Trade Marks Act 1995 (Cth), s 169 where it is noted that the owner of the certification mark may use the mark.

¹⁶⁰ Te Taumata “Introducing the Mānuka Charitable Trust” <www.tetaumata.com> (12 March 2021).

¹⁶¹ *TM application no. 1025914 Manuka Honey*, above n 3, at [70].

¹⁶² Wai 2721 “Statement of Claim Seeking an Urgent Hearing”, above n 52, at [30]; Wai 2706 “Statement of claim on behalf of Cletus Maanu Paul and others”, above n 52, at [30].

(see above),¹⁶³ proper consultation by MHAS may have resolved these concerns before they were filed with the Waitangi Tribunal.

The present use of a trust and hui is an effective step towards recognising Māori interests. The creation of a trust means that the trustees who are the legal owners of the mark are obligated to act in line with the purposes of the trust rules. For example, the Mānuka Charitable Trust's rules state that one purpose is to enhance and protect the mana of the Taonga.¹⁶⁴ This is important to ensure that those decisions that must be taken by owners, such as enforcing the mark, are in fact taken. Users of the mark can only enforce the mark if the owner permits them or sometime after the owners have refused.¹⁶⁵ For example, in New Zealand, there is a two-month gap, during which time real commercial damage could occur.¹⁶⁶ Admittedly, users would still have recourse to fair trading and passing off causes of action.¹⁶⁷ The owner of the mark is also responsible for applying to the respective Intellectual Property Offices to change the regulations of the mark if that is required.¹⁶⁸ This may be necessary where new detrimental practices emerge, such as some adverse form of genetic engineering perhaps. The trustee's fiduciary obligations mean that there is greater security and accountability that the mark will be protected and administered effectively. Hui are also crucial in understanding the perspectives of various interested parties.

¹⁶³ Wai 2721 "Statement of Claim Seeking an Urgent Hearing", above n 52, at [41]; Wai 2706 "Statement of claim on behalf of Cletus Maanu Paul and others", above n 52, at [41].

¹⁶⁴ Pita William Tipene "Trust Rules for the Manuka Charitable Trust" (7 February 2020) at [5]. Information regarding Charitable Trusts is publicly available at <app.businessregisters.govt.nz>.

¹⁶⁵ Trade Marks Act 2002, s 103. See also Trade Marks Act 1994 (UK), s 30(3) where licensees may bring proceedings after 2 months if the owner fails to bring proceedings or immediately if the owner refuses to. See also Regulation 2017/1001 on the European Union trade mark [2017] OJ L154/1, Article 25 where the exclusive licensee may bring proceedings if owner does not bring proceedings within an appropriate period, despite formal notice.

¹⁶⁶ Trade Marks Act 2002, s 103.

¹⁶⁷ See Trade marks Act 2002, s 88 which states that nothing in the Act affects the law relating to those causes of action.

¹⁶⁸ For New Zealand see Trade Marks Act 2002, s 79.

GIs under independent registration systems are often administered by government bodies and public organisations.¹⁶⁹ If “mānuka honey” did become a GI under the purview of a government body, the Crown would need to ensure to not breach its Treaty of Waitangi obligations. There have already been Crown hiccups concerning “mānuka honey”. For example, when the Ministry of Primary Industries (MPI) set the technical definition of what constitutes mānuka honey under New Zealand law in 2018, many producers who were previously selling their honey as “mānuka honey” did not meet the new technical standard.¹⁷⁰ What they had previously sold as mānuka honey was downgraded to bush honey.¹⁷¹ One estimate suggested that MPI’s definition for mānuka honey exports would have forced 40% to 70% of mānuka honey currently exported to be relabelled as “bush honey”.¹⁷² Bush honey is generic honey that does not have the same market attraction. NZ Beekeeping were not consulted and the decision by MPI was later reversed.¹⁷³ MPI’s new definition is the product of extensive consultation.¹⁷⁴ The setting of a technical standard had significant impacts such as changing the value of land where mānuka grows and mānuka plants themselves.¹⁷⁵ The Crown would need to consider whether it would be worthwhile creating a separate body that oversees decisions made in relation to the GI and considers Māori interests, this role could be filled by the Mānuka Charitable Trust & Pitau Ltd.

Despite the difficulty in construing Māori interests in Western intellectual property systems, overall advocates for the “mānuka honey” certification mark have done well to place other mechanisms in place to engage with Māori interests. However, this paper suggests that

¹⁶⁹ KPMG *Protection and Control of Geographical Indications for Agricultural Products in the EU Member States* (European Union Intellectual Property Office, December 2017) at 4; and generally see at 17; Gangjee “*Sui Generis* or Independent Geographical Indications Protection” above n 19, at 260.

¹⁷⁰ Brittany Baker “Reclassification of export mānuka honey may breach Treaty of Waitangi” (23 January 2018) *Stuff* <www.stuff.co.nz>.

¹⁷¹ Baker “Reclassification of export mānuka honey may breach Treaty of Waitangi”, above n 170.

¹⁷² Baker “Reclassification of export mānuka honey may breach Treaty of Waitangi”, above n 170.

¹⁷³ Nine-to-Noon “Beekeepers welcome MPI U-turn on Manuka honey” *Radio new Zealand* (Online ed, New Zealand, 30 January 2018) <www.rnz.co.nz>.

¹⁷⁴ Ministry of Primary Industries “Mānuka honey testing” (10 March 2021) <www.mpi.govt.nz>.

¹⁷⁵ Baker “Reclassification of export mānuka honey may breach Treaty of Waitangi”, above n 170.

kaitiaki rights should be recognised further by a charge which would provide some financial benefit.

For the mānuka honey GI to be effective in protecting any legitimate interest, misuse of the sign needs to be policed. Gangjee notes that the frequency and extent of compliance checks and enforcement could have an impact on the quality and reputation of the products that use the GI and is therefore very important.¹⁷⁶

The Mānuka Charitable Trust's rules state that one of the guiding principles for the discretion of the trustees is the "prompt, effective and professional action should be taken against misappropriation of Taonga, cultural or otherwise, wherever it may occur".¹⁷⁷ How this principle would manifest in policing and enforcing violations or infringements is not clear but the principle is wide-reaching suggesting that trustees would ensure that compliance checks and enforcement will be carried out in such a way that "mānuka honey" will retain its valuable image.¹⁷⁸

Under independent GI registration systems the burden of enforcement, among other administrative duties, is often placed on a government body.¹⁷⁹ During the EU-NZ Free Trade negotiations, the EU proposed that New Zealand provide enforcement action for GIs by public authorities,¹⁸⁰ as is typically done in the EU.¹⁸¹ This means that EU businesses do not need to pursue infringements halfway around the world. Therefore, if New Zealand can gain GI status for "mānuka honey" under the EU's independent registration system, this would substantially reduce the burden of enforcement of GI infringements. Under the certification mark system, the Mānuka Charitable Trust & Pitau Ltd will have to potentially initiate expensive proceedings overseas to protect the mark.

¹⁷⁶ Gangjee "*Sui Generis* or Independent Geographical Indications Protection", above n 19, at 268.

¹⁷⁷ Pita William Tipene "Trust Rules for the Manuka Charitable Trust" (7 February 2020) at [5].

¹⁷⁸ See also the powers under Trade Marks Act 2002 ss 55 and 63.

¹⁷⁹ Gangjee "*Sui Generis* or Independent Geographical Indications Protection", above n 19, at 260.

¹⁸⁰ *EU-NZ Free Trade Agreement Negotiations*, above n **Error! Bookmark not defined.**, at [85].

¹⁸¹ *KPMG Protection and Control of Geographical Indications for Agricultural Products in the EU Member States* (European Union Intellectual Property Office, December 2017) at 4; and generally see at 17.

The possible penalties for offences under the different regimes are also a valuable consideration as harsher penalties can have a larger deterrent effect against infringement. Trade mark statutes often have criminal provisions to deal with certain types of trade mark infringements such as counterfeiting.¹⁸² In contrast, under New Zealand's current GI registration legislation for wines and spirits infringements of GIs are enforced through s 9 of the Fair Trading Act.¹⁸³ The Fair Trading Act does not have imprisonable offences nor are infringement offences criminally recorded.¹⁸⁴

The Discussion Paper on the EU's proposal for a new GI registration system in New Zealand does not mention the addition of criminal offences.¹⁸⁵ This reflects that in the EU criminal sanctions for GI infringements depend on the national laws of the Member States with most States having some form of specific criminal sanction.¹⁸⁶ This illustrates that "mānuka honey" will be protected overseas by provisions creating criminal offences whether it is protected through a certification mark or independent GI registration.

IV Conclusion

Mānuka honey is extremely valuable. There are two prominent perspectives at play. One where New Zealand producers are pursuing certification mark protection across the globe to obtain a monopoly to a term that merely describes a type of honey. The other is that "mānuka honey", a te reo Māori term, denotes a product coming from New Zealand with unique characteristics and therefore only New Zealand producers should be entitled to use it.

MHAS were right in pursuing certification mark protections to achieve their goal, they are the most efficient way to protect the term for New Zealand producers. Non-registered

¹⁸² For New Zealand see Trades Marks Act 2002, pt 4 sub-pt 2; for the UK see Trade Marks Act 1994 (UK), s 92; for Australia see Trade Marks Act 1995 (Cth), pt 14; for the EU see Regulation 2017/1001 on the European Union trade mark [2017] OJ L154/1, Article 137.

¹⁸³ *EU-NZ Free Trade Agreement Negotiations*, above n **Error! Bookmark not defined.**, at [83].

¹⁸⁴ Fair Trading Act 1986, s 40G.

¹⁸⁵ *EU-NZ Free Trade Agreement Negotiations*, above n **Error! Bookmark not defined.**

¹⁸⁶ *KPMG Protection and Control of Geographical Indications for Agricultural Products in the EU Member States*, above n 181, at 12.

approaches would lead to potentially heavy litigation against other traders which would be expensive and time-consuming.

An independent GI registration is not tenable but a new system for foodstuffs may eventuate in New Zealand after negotiations with the EU regarding a Free Trade Agreement. Such a system would likely allow the registration of mānuka honey as a New Zealand GI which would be a catalyst to registration overseas.

The certification mark process has, up until recently, sacrificed consideration of different interests for expediency. The result is that large New Zealand industry players will benefit despite potentially lacking kaitiaki relations with mānuka honey. Overall, there has not been any meaningful recognition of the mātauranga Māori and the kaitiaki relationships in relation to the plant and the language as taonga. The creation of the Mānuka Charitable Trust, however, is a positive step.

In terms of enforcement and punishment, there is little difference between certification mark and a hypothetical independent GI registration, although owners of the mark may struggle to enforce certification marks overseas. Therefore, an independent GI system where enforcement is taken on one's behalf may be beneficial. However, even an independent GI registration will only protect nations with compatible systems of which there are far fewer.

We will have to await the decisions of intellectual property offices around the world to see whether another approach (other than certification marks) is required, but it is unlikely that the buzz surrounding mānuka honey is going to go anytime soon.

Word count

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