

# Law relating to Geographical Indications of Goods

## Lesson 16

### KEY CONCEPTS

■ Geographical Indication ■ Goods ■ Indication ■ Infringement

### Learning Objectives

#### To understand:

- Registration of Geographical Indication
- Prohibits Registration of certain Geographical Indications
- Prohibition of Registration of Geographical Indication as Trade Marks
- Duration of Registration

### Lesson Outline

- Application for Registration
- Effect of Registration of Design
- Copyright on Registration
- Infringement of Geographical Indication
- Offence & Penalty
- Lesson Round-Up
- Test Yourself
- List of Further Readings
- Other References

## REGULATORY FRAMEWORK

- Geographical Indications of Goods (Registration and Protection) Act, 1999
- The Geographical Indications of Goods (Registration and Protection) Rules, 2002

## INTRODUCTION

The desire of mankind for quality and genuine premium products such as silk, cotton and spices, having distinct characteristics originating from a particular region, have over centuries created an impact on human civilization which has resulted in discovery of new sea routes and new continents. These identifications became so important that these regions started specializing in producing these unique products, which led to identifying such goods as originating from a particular region, which over a period of time has become renowned globally. Rising demand for such products among the consumers, gave rise for counterfeit products, which began to tarnish the image of genuine products. A effort to safeguard the interest of the producers and consumers led to evolution and conceptualization of “Geographical Indications”.

Every region has its claim to fame. Each fame and reputation was carefully built up and painstakingly maintained by the masters of that region, combining the best of nature, man and traditionally handed over from one generation to the next for centuries. Gradually, a specific link between the goods and place of production evolved resulting in growth of geographical indications.

Geographical Indications of Goods are that aspect of industrial property which refers to a country or to a place situated therein as being the country or place of origin of that product. Typically, such a name conveys an assurance of quality and distinctiveness which is essentially attributable to the fact of its origin in that defined geographical locality, region or country.

Geographical Indications covered under Articles 22 to 24 of the WTO Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement, which was part of the Agreements concluding the Uruguay Round of GATT negotiations.

“Geographical Indications” as being used currently includes both the above concepts and it refers to “... indications which identify a good as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.” (Article 22.1 of the TRIPS Agreement). Consequent upon India joining as a member state of the TRIPS Agreement a sui-generis legislation for the protection of Geographical Indications was enacted in 1999.

***The object of the Geographical Indications of Goods (Registration and Protection) Act, 1999 is three fold, firstly by specific law governing the geographical indications of goods in the country which could adequately protect the interest of producers of such goods, secondly, to exclude unauthorized persons from misusing geographical indications and to protect consumers from deception and thirdly, to promote goods bearing Indian geographical indications in the export market.***

*Examples of Indian Geographical Indications are: Darjeeling Tea, Kanchipuram Silk Saree, Alphonso Mango, Nagpur Orange, Kolhapuri Chappal, Bikaneri Bhujia, Agra Petha etc.*

## Geographical Indication

Geographical indication in relation to goods means an indication which identifies such goods as agricultural goods, natural goods or manufactured goods as originating, or manufactured in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of such goods is essentially attributable to its geographical origin and in case where such goods are manufactured goods one

of the activities of either the production or of processing or preparation of the goods concerned takes place in such territory, region or locality, as the case may be.

It may be noted that any name which is not the name of a country, region or locality of that country shall also be considered as the geographical indication if it relates to a specific geographical area and is used upon or in relation to particular goods originating from that country, region or locality, as the case may be. [Section 2(e)]

#### **Geographical Indication**

- *It is an indication.*
- *It originates from a definite geographical territory.*
- *It is used to identify agricultural, natural or manufactured goods.*
- *The manufactured goods should be produced or processed or prepared in that territory.*
- *It should have a special quality or reputation or other characteristics.*

*It may be noted that:*

*Goods means any agricultural, natural or manufactured goods or any goods of handicraft or of industry and includes food stuff.*

*Indication includes any name, geographical or figurative representation or any combination of them conveying or suggesting the geographical origin of goods to which it applies.*

#### **Example of Registered Geographical Indications**

Darjeeling Tea (word & logo); Pochampalli Ikat ; Salem Fabric; Chanderi Sarees; Solapur Chaddar; Solapur Terry Towel; ; Kotpad Handloom fabric ; Mysore Silk ; Kota Doria; Mysore Agarbathi; Kancheepuram Silk ;Bhavani Jamakkalam ; Kullu Shawl ; Madurai Sungudi ; Madur kathi; Banaras Zardozi; Gorgonzola (Food Stuff, Italy); Wooden Mask of Kushmand; Gobindobhog Rice; Kashmiri Hand Knotted Carpet, Orissa Pattachitra; Berhampur Patta (Phoda Kumbha) Saree & Joda; Madhubani Paintings; Raktsey Karpo Apricot of Ladakh etc.

#### **Indication**

Indication includes any name, geographical or figurative representation or any combination of them conveying or suggesting the geographical origin of goods to which it applies. [Section 2(g)]

#### **Prohibition of Registration of Certain Geographical Indications**

Section 9 of the Act prohibits registration of certain geographical indications. They are as follows:-

- (a) the use of which would be likely to deceive or cause confusion; or
- (b) the use of which would be contrary to any law for the time being in force; or
- (c) which comprises or contains scandalous or obscene matter; or
- (d) which comprises or contains any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India; or
- (e) which would otherwise be disentitled to protection in a court; or
- (f) which are determined to be generic names or indications of goods and are, therefore, not or ceased to be protected in their country of origin, or which have fallen into disuse in that country; or

- (g) which, although literally true as to the territory, region or locality in which the goods originate, but falsely represent to the persons that the goods originate in another territory, region or locality, as the case may be;

shall not be registered as a geographical indication.

It may be noted that “generic names or indications”, in relation to goods, means the name of a goods which, although relates to the place or the region where the goods was originally produced or manufactured has lost its original meaning and has become the common name of such goods and serves as a designation for or indication of the kind, nature, type or other property or characteristic of the goods.

However, in determining whether the name has become generic, account shall be taken of all factors including the existing situation in the region or place in which the name originates and the area of consumption of the goods.

### Registration of Geographical Indication

Section 8 of the Act provides that a geographical indication may be registered in respect of any or all of the goods, comprised in such class of goods as may be classified by a region or locality in that territory, as the case may be the Registrar and in respect of a definite territory of a country.

The Registrar may also classify the goods under in accordance with the International classification of goods for the purposes of registration of geographical indications and publish in the prescribed manner in an alphabetical index of classification of goods.

Any question arising as to the class within which any goods fall or the definite area in respect of which the geographical indication is to be registered or where any goods are not specified in the alphabetical index of goods published shall be determined by the Registrar whose decision in the matter shall be final.

### Application for Registration

Under section 11 any association of persons or producers or any organisation or authority established by or under any law for the time being in force representing the interest of the producers of the concerned goods, who are desirous of registering a geographical indication in relation to such goods shall apply in writing to the Registrar in such form and in such manner and accompanied by such fees as may be prescribed for the registration of the geographical indication.

The application shall contain –

- A single application may be a statement as to how the geographical indication serves to designate the goods as originating from the concerned territory of the country or region or locality in the country, as the case may be, in respect of specific quality, reputation or other characteristics of which are due exclusively or essentially to the geographical environment, with its inherent natural and human factors, and the production, processing or preparation of which takes place in such territory, region or locality, as the case may be;
- the class of goods to which the geographical indication shall apply;
- the geographical map of the territory of the country or region or locality in the country in which the goods originate or are being manufactured;
- the particulars regarding the appearance of the geographical indication as to whether it is comprised of the words or figurative elements or both;
- a statement containing such particulars of the producers of the concerned goods, if any, proposed

to be initially registered with the registration of the geographical indication as may be prescribed; and

- such other prescribed particulars.

Application maybe made for registration of a geographical indication for different classes of goods and fee payable therefore shall be in respect of each such class of goods.

Every application shall be filed in the office of the Geographical Indications Registry within whose territorial limits, the territory of the country or the region or locality in the country to which the geographical indication elates is situated.

Every application shall be examined by the Registrar in such manner as may be prescribed.

The Registrar may refuse the application or may accept it absolutely or subject to such amendments, modification, conditions or limitations, if any, as he thinks fit. In the case of refusal or conditional acceptance of application, the Registrar shall record in writing the grounds for such refusal or conditional acceptance and the materials used by him in arriving at his decision.

### Registration

Section 16 provides that on the registration of a geographical indication, the Registrar shall issue each to the applicant and the authorised users, if registered with the geographical indication, a certificate sealed with the seal of the Geographical Indications Registry.

It may be noted that where registration of a geographical indication is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice to the applicant in the prescribed manner treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

### Step by Step Guide on Geographical Indication of Goods Registration Process

#### **Step 1 : Filing of application**

Please check whether the indication comes within the ambit of the definition of a Geographical Indication under section 2(1)(e) of the Act.

The association of persons or producers or any organization or authority should represent the interest of producers of the concerned goods and should file an affidavit how the applicant claims to represent their interest.

- Application must be made in triplicate.
- The application shall be signed by the applicant or his agent and must be accompanied by a statement of case.
- Details of the special characteristics and how those standards are maintained.
- Three certified copies of the map of the region to which the GI relates.
- Details of the inspection structure if any to regulate the use of the GI in the territory to which it relates.
- Give details of all the applicant together with address. If there is a large number of producers a collective reference to all the producers of the goods may be made in the application and the GI. If registered will be indicated accordingly in the register.

#### **Step 2 & 3: Preliminary Scrutiny and Examination**

- The Examiner will scrutinize the application for any deficiencies.

- The applicant should within one month of the communication in this regard, remedy the same.
- The content of statement of case is assessed by a consultative group of experts will versed on the subject.
- The will ascertain the correctness of particulars furnished.
- Thereafter an Examination Report would be issued.

**Step 4: Show Cause Notice**

- If the Registrar has any objection to the application, he will communicate such objection.
- The applicant must respond within two months or apply for a hearing.
- The decision will be duly communicated. If the applicant wishes to appeal, he may within one month make a request.
- The Registrar is also empowered to withdraw an application, if it is accepted in error, after giving on opportunity of being heard.

**Step 5: Publication in the Geographical Indications Journal**

Every application, within three month of acceptance shall be published in the Geographical Indications Journal.

**Step 6: Opposition to Registration**

- Any person can file a notice of opposition within three months (extendable by another month on request which has to be filed before three months) opposing the GI application published in the Journal.
- The registrar shall serve a copy of the notice on the applicant.
- Within two months the applicant shall sent a copy of the counter statement.
- If he does not do this be shall be deemed to have abandoned his application. Where the counter-statement has been filed, the registrar shall serve a copy on the person giving the notice of opposition.
- Thereafter, both sides will lead their respective evidences by way of affidavit and supporting documents.
- A date for hearing of the case will be fixed thereafter.

**Step 7: Registration**

- Where an application for a GI has been accepted, the registrar shall register the geographical indication. If registered the date of filing of the application shall be deemed to be the date of registration.
- The registrar shall issue to the applicant a certificate with the seal of the Geographical indications registry.

**Step 8: Renewal**

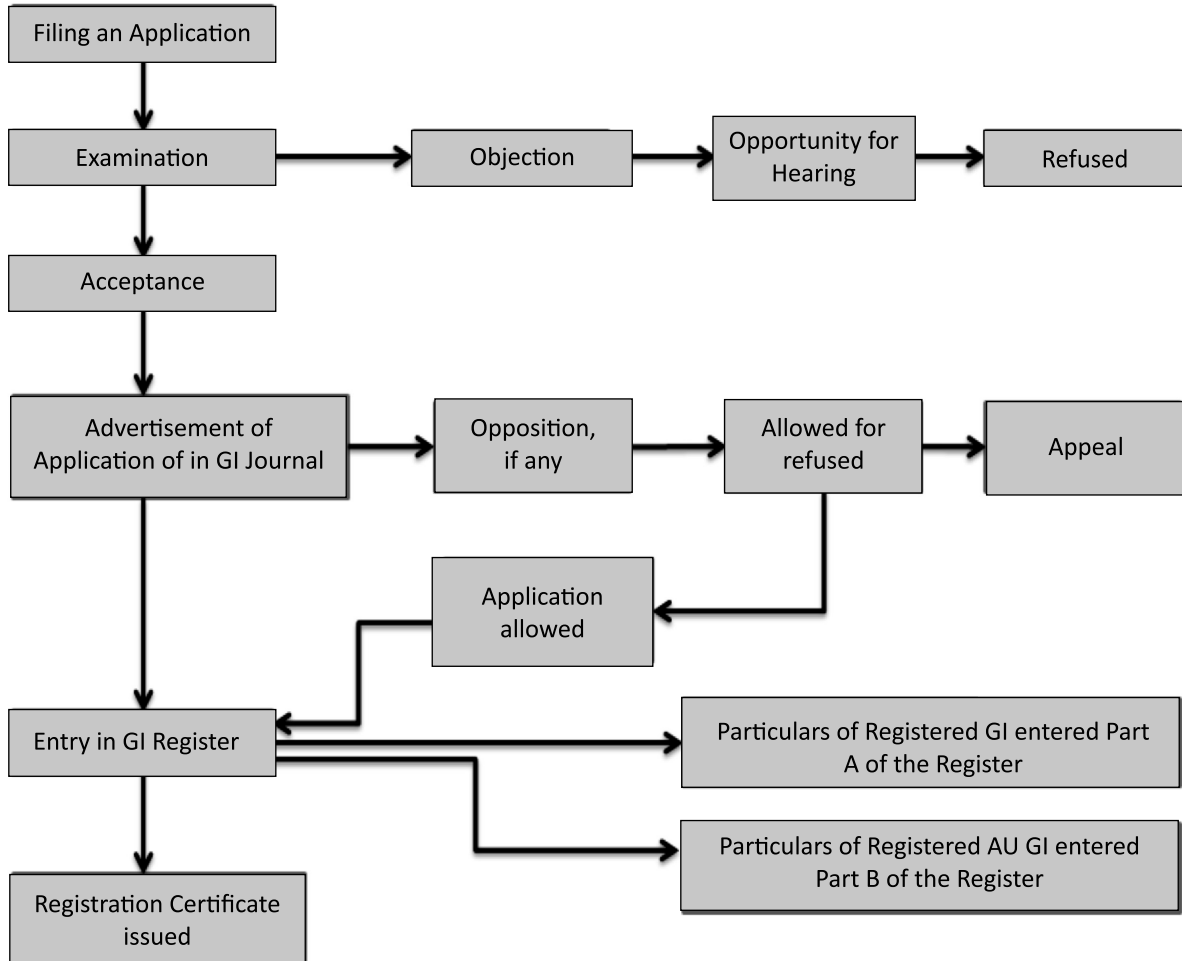
A registered GI shall be valid for 10 years and can be renewed on payment of renewal fee.

**Step 9: Additional Protection to Notified Goods**

Additional protection for notified goods is provided in the Act.

**Step 10: Appeal**

Any person aggrieved by an order or decision may prefer an appeal .

**Geographical Indications Registration Workflow**

Source: <https://ipindia.gov.in/the-registration-process-gi.htm>

**What is the benefit of registration of Geographical Indications?**

- ***It confers legal protection to Geographical Indications in India.***
- ***Prevents unauthorised use of a Registered Geographical Indication by others.***
- ***It provides legal protection to Indian Geographical Indications which in turn boost exports.***
- ***It promotes economic prosperity of producers of goods produced in a geographical territory.***

**Duration of registration**

Section 18 of the Act deals with duration, renewal, removal and restoration of registration of Geographical Indication. The registration of a geographical indication shall be for a period of ten years, but may be renewed from time to time in accordance with the provisions of this section.

The registration of an authorised user shall be for a period of ten years or for the period till the date on which the registration of the geographical indication in respect of which the authorised user is registered expires, whichever is earlier.

The Registrar shall, on application made in the prescribed manner, by the registered proprietor or by the

authorised user and within the prescribed period and subject to the payment of the prescribed fee, renew the registration of the geographical indication or authorised user, as the case may be, for a period of ten years from the date of expiration of the original registration or of the last renewal of registration, as the case may be.

### **Infringement of Unregistered Geographical Indication**

As per section 20 of the Act a person shall not be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered geographical indication.

### **Infringement of Registered Geographical Indications**

As per section 22 a registered geographical indication is infringed by a person who, not being an authorized user thereof uses such geographical indication by any means in the designations or presentation of goods that indicates or suggests that such goods originate in a geographical area other than the true place of origin of such goods in a manner goods; or which misleads the persons as to the geographical origin of such goods; or uses any geographical indication in such manner which constitutes an act of unfair competition including passing off in respect of registered geographical indication.

It may be noted that “act of unfair competition” means any act of competition contrary to honest practices in industrial or commercial matters. The following acts shall be deemed to be acts of unfair competition, namely:

- all acts of such a nature as to create confusion by any means whatsoever with the establishment, the goods or the industrial or commercial activities, of a competitor;
- false allegations in the course of trade of such a nature as to discredit the establishment, the goods or the industrial or commercial activities, of a competitor;
- geographical indications, the use of which in the course of trade is liable to mislead the persons as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

A registered geographical indication is infringed by a person who, not being an authorised user thereof uses another geographical indication to the goods which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the persons that the goods originate in the territory, region or locality in respect of which such registered geographical indication relates.

#### ***When is a registered Geographical Indication said to be infringed?***

- ***When an unauthorised user uses a geographical indication that indicates or suggests that such goods originate in a geographical area other than the true place of origin of such goods in a manner which mislead the public as to the geographical origin of such goods.***
- ***When the use of geographical indication result in an unfair competition including passing off in respect of registered geographical indication.***
- ***When the use of another geographical indication results in false representation to the public that goods originate in a territory in respect of which a registered geographical indication relates.***

### **Assignment or Transmission**

Section 24 of the Act prohibits assignment or transmission of geographical indication. It states that any right to a registered geographical indication shall not be the subject matter of assignment, transmission, licensing, pledge, mortgage or any such other agreement. However, on the death of an authorised user his right in a registered geographical indication shall devolve on his successor in title under the law for the time being in force.

### Prohibition of Registration of Geographical Indication as Trade mark

Section 25 of the Act provides that the Registrar of Trade Marks shall, suo-motu or at the request of an interested party, refuse or invalidate the registration of a trade mark which contains or consists of a geographical indication with respect to the goods or class or classes of goods not originating in the territory of a country, or a region or locality in that territory which such geographical indication indicates, if use of such geographical indications in the trade mark for such goods, is of such a nature as to confuse or mislead the persons as to the true place of origin of such goods or class or classes of goods.

#### *How a Geographical Indication is different from a Trade Mark?*

- ***A trade mark is a sign which is used in the course of trade and it distinguishes goods or services of one enterprise from those of other enterprises.***
- ***Whereas a geographical indication is an indication used to identify goods having special characteristics originating from a definite geographical territory.***

In the case of *Tea Board, India vs. ITC Limited (GA No. 3137 of 2010 CS No. 250 of 2010)*, Judgement dated 20 April, 2011 plaintiff moved an interlocutory application for temporary injunction for restraining the defendant from using or conducting or making its business at the hotel by the name “DARJEELING LOUNGE”. Application stated that usage of the word “DARJEELING” in the name and logo by defendants is passing off or attempting to pass off its business or services so as to discredit the fame of Darjeeling tea as a geographical indication and/or to mislead persons.

Hon'ble Calcutta High Court *inter alia* observed that passing-off as in Section 20(2) of the GI Act has to be seen in the light of what it implies in trade mark law. As to whether any goods or services are passed off as some other goods or services would depend on a variety of factors ranging from the nature of the marks, their resemblance, the nature of the goods and services, the similarity of the character of the goods and services, the mode of accessing the goods or services and other surrounding circumstances.

The word “Darjeeling” - as precious to tea as it may be as champagne to sparkling wines of that province in France - cannot be exclusively claimed by the plaintiff by virtue of its registration as a geographical indication or as a certification trade mark. Even for a case of passing-off, the use of “Darjeeling” by a person other than the plaintiff can be complained of if the word or the geographical indication has any nexus with the product with which it is exclusively associated upon the registration. It is not necessary to consider whether a “Darjeeling Tea Stall” selling only hot cups of tea can entitle the plaintiff to carry a complaint in respect thereof or a “Darjeeling Tea House” selling all varieties of packaged tea can be said to be in derogation of the plaintiff's rights. The defendant's “Darjeeling Lounge” is an exclusive area within the confines of its hotel which is accessible only to its high-end customers. The lounge is a place where such customers and accompanying visitors may frequent, and even sip Darjeeling tea or any other beverage or drink, but there is scarcely any likelihood of deception or confusion in the lounge being named “Darjeeling” for the plaintiff to be granted to any order that it seeks.

As to the case of dilution, the name “Darjeeling” has been extensively used in trading and commercial circles for decades before the GI Act was enacted. In a case of dilution by blurring, it is the uniqueness of a mark which is protected even in a case where there is no likelihood of confusion. But the word “Darjeeling” has been and continues to be so widely used as a business name or for like purpose for so long that the plaintiff's recent registration would, *prima facie*, not entitle it to enjoy the kind of exclusivity that it asserts.

**OFFENCES, PENALTIES AND PROCEDURE****Meaning of Applying Geographical Indications**

Section 37 of the Act provides that a person shall be deemed to apply a geographical indication to goods who:

- (a) applies it to the goods themselves; or
- (b) applies it to any package in or with which the goods are sold, or exposed for sale, or had in possession for sale or for any purpose of trade or manufacture; or
- (c) places, encloses or annexes any goods which are sold, or exposed for sale, or had in possession for sale or for any purpose of trade or manufacture, in or with any package or other thing to which a geographical indication has been applied; or
- (d) uses a geographical indication in any manner reasonably likely to lead to the belief that the goods in connection with which it is used are designated or described by that geographical indication; or
- (e) in relation to the goods uses a geographical indication in any sign, advertisement, invoice, catalogue, business letter, business paper, price list or other commercial documents and goods are delivered to a person in pursuance of a request or order made by reference to the geographical indication as so used.

A geographical indication shall be deemed to be applied to goods whether it is woven in, impressed on, or otherwise worked into, or annexed or affixed to, the goods or to any package or other thing.

**Falsifying and Falsely Applying Geographical Indications**

Section 38 states that a person shall be deemed to falsify a geographical indication who, either:

- (a) without the assent of the authorised user of the geographical indication makes that geographical indication or deceptively similar geographical indication; or
- (b) falsifies any genuine geographical indication, whether by alteration, addition, effacement or otherwise.

A person shall be deemed to falsely apply to goods a geographical indication who, without the assent of the authorised user of the geographical indication:

- (a) applies such geographical indication or a deceptively similar geographical indication to goods or any package containing goods;
- (b) uses any package bearing a geographical indication which is identical with or deceptively similar to the geographical indication of such authorised user, for the purpose of packing, filling or wrapping therein any goods other than the genuine goods of the authorised user of the geographical indication.

Any geographical indication falsified or falsely applied referred to as a false geographical indication.

In any prosecution for falsifying a geographical indication or falsely applying a geographical indication to goods, the burden of proving the assent of proprietor shall lie on the accused.

**Penalty for Applying False Geographical Indications**

According to Section 39 of the Act, any person who:

- (a) falsifies any geographical indication; or
- (b) falsely applies to goods any geographical indication; or
- (c) makes, disposes of, or has in his possession, any die, block, machine, plate or other instrument for the purpose of falsifying or of being used for falsifying, a geographical indication; or

- (d) applies to any goods to which an indication of the country or place in which they were made or produced or the name and the address of the manufacturer or person for whom the goods are manufactured is required to be applied under section 71, a false indication of such country, place, name or address; or
- (e) tampers with, alters or effaces an indication of origin which has been applied to any goods to which it is required to be applied under section 71; or
- (f) causes any of the things above-mentioned in this section to be done, shall, unless he proves that he acted, without intent to defraud,

be punishable with imprisonment for a term which shall not be less than six months but which may extend to three years and with fine which shall not be less than fifty thousand rupees but which may extend to two lakh rupees.

It may be noted that the court may, for adequate and special reasons to be mentioned in the judgment, impose a sentence of imprisonment for a term of less than six months or a fine of less than fifty thousand rupees.

### Special Provisions Relating to Applications for Registration from Citizens of Convention Countries

Section 84 empowers Central Government may by notification in the Official Gazette, declare such country or group of countries or union of countries or Inter-Governmental Organisations to be a convention country or convention countries for the purposes of the Act for the fulfillment of a treaty, convention or arrangement with any country or a country which is a member of a group of countries or union of countries or Inter- Governmental Organisations outside India which affords to citizens of India similar privileges as granted to its own citizens.

#### LESSON ROUND-UP

- Geographical indication in relation to goods means an indication which identifies such goods as agricultural goods, natural goods or manufactured goods as originating, or manufactured in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of such goods is essentially attributable to its geographical origin and in case where such goods are manufactured goods one of the activities of either the production or of processing or preparation of the goods concerned takes place in such territory, region or locality, as the case may be.
- Goods mean any agricultural, natural or manufactured goods or any goods of handicraft or of industry and includes food stuff.
- Indication includes any name, geographical or figurative representation or any combination of them conveying or suggesting the geographical origin of goods to which it applies.
- The object of the Geographical Indications of Goods (Registration and Protection) Act, 1999 is three fold, firstly by specific law governing the geographical indications of goods in the country which could adequately protect the interest of producers of such goods, secondly, to exclude unauthorized persons from misusing geographical indications and to protect consumers from deception and thirdly, to promote goods bearing Indian geographical indications in the export market.
- Any association of persons or producers or any organisation or authority established by or under any law for the time being in force representing the interest of the producers of the concerned goods, who are desirous of registering a geographical indication in relation to such goods shall apply in writing to the Registrar in such form and in such manner and accompanied by such fees as may be prescribed for the registration of the geographical indication.

