

Geographical Indications

Lesson 10

KEY CONCEPTS

■ Geographical Indications ■ Goods ■ Indication ■ Producers ■ Packages ■ Authorized User ■ Registered Proprietor ■ Registrar ■ International Conventions/Agreements

Learning Objectives

To understand:

- The legal framework provided for law regulating intellectual property residing in Geographical Indications in India.
- The legal position relating to geographical indications of goods in India.
- The legal machinery including international agreements and conventions governing the registration, renewal, infringement of geographical indications of goods.
- The important definitions and concepts relating to geographical indications of goods under Geographical Indications of Goods (Registration and Protection) Act, 2000.

Lesson Outline

- Introduction
- Geographical Indications
- Appellation of Origin
- Indication of Source
- The Geographical Indications of Goods (Registration and Protection) Act, 1999
- Effects of Registration
- Infringement of Registration Geographical Indications
- Geographical Indications and Trademarks
- Appeals, Offences and Penalties
- Remedies and Relief
- Registration Process
- International Conventions/Agreements
- Case Studies/Case Laws
- Lesson Round-Up
- Test Yourself
- List of Further Readings
- Other References (Including Websites / Video Links)

INTRODUCTION

In today's globalized economy, the protection and promotion of unique products and cultural heritage have become paramount. Geographical Indications (GIs) stand at the intersection of tradition, innovation, and economic development, offering a powerful tool for safeguarding the authenticity and quality of products originating from specific regions.

Geographical Indications (GIs), a crucial aspect of intellectual property law with far-reaching implications for both cultural preservation and economic development. Geographical Indications, often abbreviated as GIs, represent a form of intellectual property rights that protect products originating from specific geographical regions. These products possess unique qualities, characteristics, or reputations attributable to their geographical origin, making them distinct from similar products produced elsewhere.

At its core, a Geographical Indication is more than just a label; it encapsulates centuries of craftsmanship, local knowledge, and environmental factors that shape the distinct characteristics of a product. From the renowned Champagne of France to the intricate craftsmanship of Italian Parmigiano-Reggiano cheese, GIs provide consumers with assurance regarding the origin, quality, and authenticity of goods.

A geographical indication right enables those who have the right to use the indication to prevent its use by a third party whose product does not conform to the applicable standards. For example, in the jurisdictions in which the Darjeeling geographical indication is protected, producers of Darjeeling tea can exclude use of the term "Darjeeling" for tea not grown in their tea gardens or not produced according to the standards set out in the code of practice for the geographical indication.

However, a protected geographical indication does not enable the holder to prevent someone from making a product using the same techniques as those set out in the standards for that indication. Protection for a geographical indication is usually obtained by acquiring a right over the sign that constitutes the indication.

GEOGRAPHICAL INDICATION (GI)

A geographical indication (GI) is a sign used on products that have a specific geographical origin and possess qualities or a reputation that are due to that origin. In order to function as a GI, a sign must identify a product as originating in a given place.

"Geographical indication" is defined in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and in the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications.

In addition, the qualities, characteristics or reputation of the product should be essentially due to the place of origin. Since the qualities depend on the geographical place of production, there is a clear link between the product and its original place of production.

- 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.

As per Section 2(1)(e) of the Geographical Indications of Goods (Registration and Protection) Act, 1999 "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.

It may be noted that-

“Goods” mean any agricultural, natural or manufactured goods or any goods of handicraft or of industry and includes food stuff. [Section 2(1)(f)]

“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(1) (g)]

APPELLATION OF ORIGIN

A geographic indication is a label that distinguishes products coming from a certain area if their quality, reputation, or other qualities are strongly associated with their place of origin. Appellation of origin of goods is a designation that is contemporary or historical, official or unofficial, full or abbreviated name of a nation, urban or rural settlement, locality, or any other geographical location, which incorporates such a name or a derivative thereof and has become well-known as a result of its use in relation to the goods, the unique properties of which are solely determined by the environmental variables and (or) human factors peculiar to this geographical location.

“Appellation of origin” is defined in the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration and in the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications.

“Appellation of origin” means the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.”

An appellation of origin shall be the geographical name of a country, region or a locality, used to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors, and which is produced, manufactured or processed within a specific limited geographical area.

An appellation of origin is a special kind of geographical indication generally consisting of a geographical name or a traditional designation used on products which have a specific quality or characteristics that are essentially due to the geographical environment in which they are produced. Consumers are familiar with these products and often request them – even unknowingly – using their geographical name.

Examples for protected appellations of origin are “Bordeaux” for wine, “Noix de Grenoble” for nuts, “Tequila” for spirit drinks, or “Jaffa” for oranges.

What is the difference between a geographical indication and an appellation of origin?

Appellations of origin are a special kind of geographical indication (GI). GIs and appellations of origin require a qualitative link between the product to which they refer and its place of origin. Both inform consumers about a product’s geographical origin and a quality or characteristic of the product linked to its place of origin. The basic difference between the two concepts is that the link with the place of origin must be stronger in the case of an appellation of origin. The quality or characteristics of a product protected as an appellation of origin must result exclusively or essentially from its geographical origin. This generally means that the raw materials should be sourced in the place of origin and that the processing of the product should also take place there. In the case of GIs, a single criterion attributable to geographical origin is sufficient – be it a quality or other characteristic of the product – or even just its reputation.

INDICATION OF SOURCE

The geographical origin identified by a GI could be the name of a jurisdiction or territory. It could be a noun or an adjective. For example, 'Colombia' in Café de Colombia, 'Swiss' in Swiss Made for watches, identify the country associated with the GI. The GI could be the name of a region: 'Beaujolais' (for red wine produced in a region in the eastern part of France), 'Napa Valley' (for wine coming from a region in the US State of California), 'Pinggu peaches' (for peaches coming from a region in China), or 'Idaho' (for potatoes produced in the US State of Idaho). It could also be a more limited area like a locality, for example a town or a village. Names that are not geographical names are, according to the laws of several members, considered as GIs if they evoke a geographical location, for example, 'Cava' (for sparkling wines from a region of Spain), 'Vinho Verde' (for a Portuguese white wine), 'Fendant' (for a white wine from the Canton of Valais in Switzerland), or 'Feta' (for a Greek cheese in brine). These examples are not necessarily or automatically considered to be eligible for GI protection in countries beyond their country of origin.

An indication of source can be defined as an indication referring to a country, or to a place in that country, as being the country or place of origin of a product. It is important that the indication of source relates to the geographical origin of a product and not to another kind of origin, for example, an enterprise that manufactures the product. This definition does not imply any special quality or characteristics of the product on which an indication of source is used. Examples of indications of source are the mention, on a product, the name of a country, or indications such as "made in"

What is the difference between a geographical indication and an indication of source?

An indication of source can be defined as an indication referring to a country (or to a place in that country) as being the country or place of origin of a product. In contrast to a geographical indication, an indication of source does not imply the presence of any special quality, reputation, or characteristic of the product essentially attributable to its place of origin. Indications of source only require that the product on which the indication of source is used originate in a certain geographical area. Examples of indications of source are the mention, on a product, of the name of a country, or indications such as "made in", "product of", etc..

THE GEOGRAPHICAL INDICATIONS OF GOODS (REGISTRATION AND PROTECTION) ACT, 1999

The Register and Conditions for Registration

As per section 3, the Controller-General of Patents, Designs and Trade Marks appointed under sub-section (1) of section 3 of the Trade Marks Act, 1999, shall be the Registrar of Geographical Indications, for the purpose of discharging, under the superintendence and direction of the Registrar, such functions of the Registrar under the Act, as he may from time to time authorise them to discharge.

Geographical Indications Registry and offices thereof

For the purpose of the Act, there shall be established a Registry which shall be known as the Geographical Indications Registry. The head office of the Geographical Indications Registry shall be at such place as the Central Government may, by notification in the Official Gazette, specify, and for the purpose of facilitating the registrations of geographical indications, there may be established at such places as the Central Government may think fit branch offices of the Geographical Indications Registry.

The Central Government may, by notification in the Official Gazette, define the territorial limits within which an office of the Geographical Indications Registry may exercise its functions. There shall be a seal of the Geographical Indications Registry (Section 4).

Register of Geographical Indications

Section 6 of the Act states that a record called the Register of geographical indications shall be kept at the head office of the Geographical Indications Registry, wherein shall be entered all registered geographical indications with the names, addresses and descriptions of the proprietors, the names, addresses and descriptions of authorised users and such other matters relating to registered geographical indications as may be prescribed and such registers may be maintained wholly or partly on computer.

Notwithstanding anything contained in sub-section (1), it shall be lawful for the Registrar to keep the records wholly or partly in computer floppies or diskettes or in any other electronic form, subject to such safeguards as may be prescribed.

Where such register is maintained wholly or partly in computer floppies or diskettes or in any other electronic form under sub-section (2), any reference in the Act to any entry in the register shall be construed as the reference to the entry as maintained on computer floppies or diskettes or in any other electronic form, as the case may be.

No notice of any trust, express or implied or constructive, shall be entered in the register and no such notice shall be receivable by the Registrar.

Subject to the superintendence and direction of the Central Government, the register shall be kept under the control and management of the Registrar.

There shall be kept at each branch office of the Geographical Indications Registry a copy of the register and such other documents mentioned in section 78 as the Central Government may, by notification in the Official Gazette, direct.

The register shall be divided into two Parts called respectively Part A and Part B.

Part A

The particulars relating to the registration of the geographical indications shall be incorporated and form Part A of the register in the prescribed manner.

Part B

The particulars relating to the registration of the authorised users shall be incorporated and form Part of Part B of the register in the prescribed manner.

Registration to be in respect of particular goods and area

Section 8 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 the Registrar and in respect of a definite territory of a country, or a region or locality in that territory, as the case may be.

The Registrar shall classify the goods under sub-section (1), as far as may be, in accordance with the International classification of goods for the purposes of registration of geographical indications.

The Registrar may publish in the prescribed manner an alphabetical index of classification of goods referred to in sub-section (2).

Any question arising as to the class within which any goods fall or the definite area as referred to in sub-section (1) 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 under sub-section (3) shall be determined by the Registrar whose decision in the matter shall be final.

Prohibition of registration of certain geographical indications

The following goods shall not be registered as a geographical indication.

the use of which would be likely to deceive or cause confusion; or

the use of which would be contrary to any law for the time being in force; or

which comprises or contains scandalous or obscene matter; or

which comprises or contains any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India; or

which would otherwise be disentitled to protection in a court; or

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

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.

Explanation 1.—For the purposes of this section, “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.

Explanation 2.—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. (Section 8)

Registration of homonymous geographical indications

Subject to the provisions of section 7, a homonymous geographical indication may be registered under the Act, if the Registrar is satisfied, after considering the practical conditions under which the homonymous indication in question shall be differentiated from other homonymous indications and the need to ensure equitable treatment of the producers of the goods concerned, that the consumers of such goods shall not be confused or misled in consequence of such registration. (Section 10)


What are “homonymous” geographical indications?

Homonymous geographical indications (GI) are those that are spelled or pronounced alike, but which identify products originating in different places, usually in different countries. In principle, these indications should coexist, but such coexistence may be subject to certain conditions. For example, it may be required that they be used only together with additional information as to the origin of the product in order to prevent consumers from being misled. A GI may be refused protection if, due to the existence of another homonymous indication, its use would be considered potentially misleading to consumers with regard to the product’s true origin.

Application for registration

As per 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 under sub-section (1) shall contain—

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- 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 particulars as may be prescribed.

A single application may be made for registration of a geographical indication for different classes of goods and fee payable therefor shall be in respect of each such class of goods.

Every application under sub-section (1) 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 relates is situated:

Provided that where such territory, region or locality, as the case may be, is not situated in India, the application shall be filed in the office of the Geographical Indications Registry within whose territorial limits the place mentioned in the address for services in India as disclosed in the application, is situated.

Every applications under sub-section (1) shall be examined by the Registrar in such manner as may be prescribed.

Subject to the provisions of the Act, 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.

The Applicant has to be a legal entity and should be representing the interest of producers of the goods applied for. Any such organisation or association being not that of the producers may have to prove that they represent the interest of producers. Any Applicant Authority also has to prove that they represent the interest of producers.

An application for registration of a geographical indication is to be made in writing, along with the prescribed fees (as specified under First Schedule), and should be addressed to the Registrar of Geographical Indications. [Rule 12 & 13]

Withdrawal of acceptance

Where, after the acceptance of an application for registration of a geographical indication but before its registration, the Registrar is satisfied,—

- a) that the application has been accepted in error, or
- b) that in the circumstances of the case the geographical indication should not be registered or should be registered subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the application has been accepted, the Registrar may, after hearing the applicant if he so desires, withdraw the acceptance and proceed as if the application had not been accepted.

Advertisement of application

When an application for registration of a geographical indication has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted together with the conditions or limitations, if any, subject to which it has been accepted, to be advertised in such manner as may be prescribed.

Where after advertisement of an application—

- a) an error in the application has been corrected; or
- b) the application has been permitted to be amended under section 15,

the Registrar may, in his discretion cause the application to be advertised again or instead of causing the application to be advertised again, notify in the prescribed manner, the correction made in the application.

Opposition to registration

Section 14 states that any person may, within three months from the date of advertisement or re-advertisement of an application for registration or within such further period, not exceeding one month, in the aggregate, as the Registrar, on application made to him in such manner and on payment of such fee as may be prescribed allows, give notice in writing in the prescribed manner to the Registrar, of opposition to the registration.

The Registrar shall serve a copy of the notice on the applicant for registration and, within two months from the receipt by the applicant of such copy of the notice of opposition, the applicant shall send to the Registrar in the prescribed manner a counter-statement of the grounds on which he relies for his application, and if he does not do so, he shall be deemed to have abandoned his application.

If the applicant sends such counter-statement, the Registrar shall serve a copy thereof on the person giving notice of opposition.

Any evidence upon which the opponent and the applicant may rely shall be submitted in such manner and within the such time as may be prescribed to the Registrar, and the Registrar shall give an opportunity to them to be heard, if they so desire.

The Registrar shall, after hearing the parties, if so required, and considering the evidence, decide whether and subject to what conditions or limitations, if any, the registration is to be permitted, and may take into account a ground of objection whether relied upon by the opponent or not.

Where a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such notice neither resides nor carries on business in India, the Registrar may require him to give security for

the costs of proceeding before him, and in default of such security being duly given, may treat the opposition or application, as the case may be, as abandoned.

The Registrar may, on request, permit correction of any error in, or any amendment of, a notice of opposition or a counter-statement on such terms as he thinks just.

Registration

Section 16 provides for registration. It states that when an application for registration of a geographical indication has been accepted and either—

- a) the application has not been opposed and the time for notice of opposition has expired; or
- b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the Central Government otherwise directs, register the said geographical indication and the authorised users, if any, mentioned in the application and the geographical indication and the authorised users when registered shall be registered as of the date of the making of the said application and that date shall, subject to the provisions of section 84, be deemed to be the date of registration.

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 in such form as may be prescribed of the registration thereof, sealed with the seal of the Geographical Indications Registry.

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.

The Registrar may amend the register or a certificate of registration for the purpose of correcting a clerical error or an obvious mistake.

Application for registration as authorised user

Any person claiming to be the producer of the goods in respect of which a geographical indication has been registered under section 16 may apply in writing to the Registrar in the prescribed manner for registering him as an authorised user of such geographical indication.

The application under sub-section (1) shall be accompanied by a statement and such documents of facts as may be prescribed and required by the Registrar to determine as to whether such person is the producer of the goods referred to in that sub-section and such fee as may be prescribed. (3) The provisions of this Chapter relating to—

- a) the filing and examination of the application;
- b) the refusal and acceptance of registration;
- c) withdrawal of acceptance of application;
- d) advertisement of application;
- e) opposition to registration;
- f) correction or error in an amendment of the application; and
- g) registration;

shall apply in respect of the application and registration of authorised users referred to in sub-section (1) in the same manner as they apply for the application for registration and registration of the geographical indication.

Duration, renewal, removal and restoration of registration

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, 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 (which date is in this section referred to as the expiration of the last registration).

At the prescribed time before the expiration of the last registration of a geographical indication or the authorised user, as the case may be, the Registrar shall send notice in the prescribed manner to the registered proprietor or the authorised user, as the case may be, of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove the geographical indication or the authorised user, as the case may be, from the register:

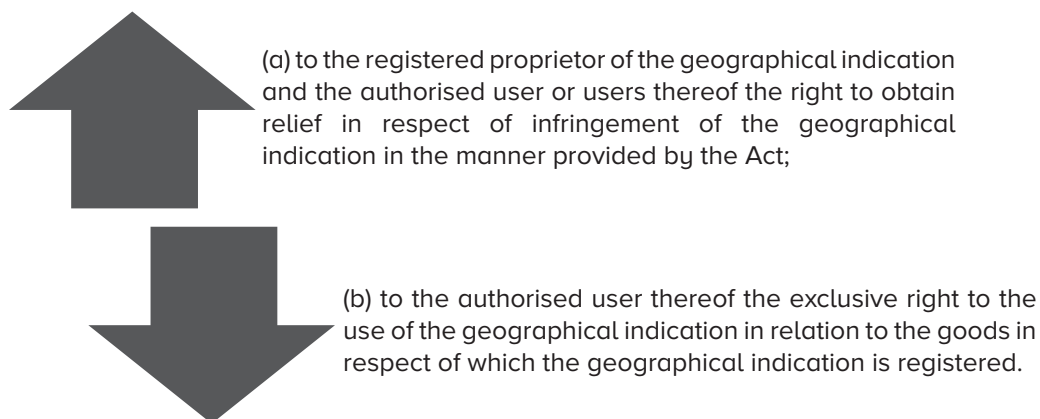
Provided that the Registrar shall not remove the geographical indication or the authorised user, as the case may be, from the register, if an application is made in the prescribed form and the prescribed fee and surcharge is paid within six months from the expiration of the last registration of the geographical indication or the authorised user, as the case may be, and shall renew the registration of geographical indication or the authorised user, as the case may be, for a period of ten years under sub-section (3).

Where a geographical indication or authorised user, as the case may be, has been removed from the register for non-payment of the prescribed fee, the Registrar shall, after six months and within one year from the expiration of the last registration of the geographical indication or the authorised user, as the case may be, on receipt of an application in the prescribed form and on payment of the prescribed fee, if satisfied that it is just so to do, restore the geographical indication or the authorised user, as the case may be, to the register and renew registration of the geographical indication or authorised user, as the case may be, either generally or subject to such condition or limitation as he thinks fit to impose, for a period of ten years from the expiration of the last registration.

EFFECT OF REGISTRATION

Rights conferred by registration

Subject to the other provisions of the Act, the registration of a geographical indication shall, if valid, give,—



The exclusive right to the use of a geographical indication given under clause (b) of sub-section (1) shall be subject to any condition and limitation to which the registration is subject.

Where two or more persons are authorised users of geographical indications, which are identical with or nearly resemble each other, the exclusive right to the use of any of those geographical indications shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by anyone of those persons as against any other of those persons merely by registration of the geographical indications, but each of those persons has otherwise the same rights as against other persons as he would have if he were the sole authorised user. (Section 21)

INFRINGEMENT OF REGISTERED GEOGRAPHICAL INDICATIONS

According to Section 22 of the Act, A registered geographical indication is infringed by a person who, not being an authorised user thereof,—

- a) 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 which misleads the persons as to the geographical origin of such goods; or
- b) uses any geographical indication in such manner which constitutes an act of unfair competition including passing off in respect of registered geographical indication.

Explanation 1.—For the purposes of this clause, “act of unfair competition” means any act of competition contrary to honest practices in industrial or commercial matters.

Explanation 2.—For the removal of doubts, it is hereby clarified that the following acts shall be deemed to be acts of unfair competition, namely:—

- i. 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;
 - ii. 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;
 - iii. 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; (c) 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.
- c) The Central Government may, if it thinks necessary so to do for providing additional protection to certain goods or classes of goods under sub-section (3), by notification in the Official Gazette, specify such goods or class or classes of goods, for the purposes of such protection.

Any person who is not an authorised user of a geographical indication registered under the Act in respect of the goods or any class or classes of goods notified under sub-section (2), uses any other geographical indication to such goods or class or classes of goods not originating in the place indicated by such other geographical indication or uses such other geographical indication to such goods or class or classes of goods even indicating the true origin of such goods or uses such other geographical indication to such goods or class or classes of goods in translation of the true place of origin or accompanied by expression such as “kind”, “style”, “imitation” or the like expression, shall infringe such registered geographical indication.

Notwithstanding anything contained in this section, where the goods in respect of which a geographical indication has been registered are lawfully acquired by a person other than the authorised user of such geographical indication, further dealings in those goods by such person including processing or packaging, shall not constitute an infringement of such geographical indication, except where the condition of goods is impaired after they have been put in the market.

Prohibition of assignment or transmission, etc.

Notwithstanding anything contained in any law for the time being in force, any right to a registered geographical indication shall not be the subject matter of assignment, transmission, licensing, pledge, mortgage or any such other agreement: Provided that 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. (Section 24)

GEOGRAPHICAL INDICATIONS AND TRADEMARKS*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.

Prohibition of registration of geographical indication as trade mark

Section 25 states that notwithstanding anything contained in the Trade Marks Act, 1999 (47 of 1999), the Registrar of Trade Marks referred to in section 3 of that Act, shall, suo motu or at the request of an interested party, refuse or invalidate the registration of a trade mark which—

(a) 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;

(b) contains or consists of a geographical indication identifying goods or class or classes of goods notified under sub-section (2) of section 22.

Protection to certain trade marks

Where a trade mark contains or consists of a geographical indication and has been applied for or registered in good faith under the law relating to trade marks for the time being in force, or where rights to such trade mark have been acquired through use in good faith either—

- a) before the commencement of the Act; or
- b) before the date of filing the application for registration of such geographical indication under the Act,

nothing contained in the Act shall prejudice the registrability or the validity of the registration of such trade mark under the law relating to the trade marks for the time being in force, or the right to use such trade mark, on the ground that such trade mark is identical with or similar to such geographical indication.

Nothing contained in the Act shall apply in respect of a geographical indication with respect to goods or class or classes of goods for which such geographical indication is identical with the term customary in common language as the common name of such goods in any part of India on or before the 1st day of January, 1995.

Nothing contained in the Act shall in any way prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to confuse or mislead the people.

Notwithstanding anything contained in the Trade Marks Act, 1999 (47 of 1999) or in the Act, no action in connection with the use or registration of a trade mark shall be taken after the expiry of five years from the date on which such use or registration infringes any geographical indication registered under the Act has become known to the registered proprietor or authorised user registered in respect of such geographical indication under the Act or after the date of registration of the trade mark under the said Trade Marks Act subject to the condition that the trade mark has been published under the provisions of the said Trade Marks Act, 1999 or the rules made thereunder by that date, if such date is earlier than the date on which such infringement became known to such proprietor or authorised user and such geographical indication is not used or registered in bad faith.

APPEALS, OFFENCES AND PENALTIES

Appeals to the High Court

As per Section 31, any person aggrieved by an order or decision of the Registrar under this Act, or the rules made thereunder, may prefer an appeal to High Court within three months from the date on which the order or decision sought to be appealed against is communicated to such person preferring the appeal.

No appeal shall be admitted if it is preferred after the expiry of the period specified under sub-section (1): Provided that an appeal may be admitted after the expiry of the period specified therefore, if the appellant satisfies the High Court that he had sufficient cause for not preferring the appeal within the specified period.

Adjudication of penalties

The Registrar may, by an order, authorise an officer referred to in section 3, to be adjudicating officer for holding an inquiry and imposing penalty under the provisions of this Act, in the manner as may be prescribed, after giving a reasonable opportunity of being heard. (Section 37A)

Appeal

Section 37B provides that whoever aggrieved by an order of the adjudicating officer under section 37A may prefer an appeal to the appellate authority, who shall be an officer at least one rank above the adjudicating officer, within a period of sixty days from the date of receipt of the order, as the Central Government may by notification authorise in this behalf. Every appeal under this section shall be preferred in such form and manner as may be prescribed.

An appeal may be admitted after the expiry of the period of sixty days if the appellant satisfies the appellate authority that he had sufficient cause for not preferring the appeal within that period.

No appeal shall be disposed of unless the appellant has been given a reasonable opportunity of being heard.

The appellate authority referred to in sub-section (1) shall dispose of the appeal within sixty days from the date of filing.

Notwithstanding anything contained in this Act, if the person fails to comply with the order of the adjudicating officer under section 37A or the order of the appellate authority under this section, as the case may be, within ninety days of such order, he shall, in addition to the penalty, be punishable with fine of one lakh rupees or imprisonment for a term which may extend to one year, or with both.

Penalty for applying false geographical indications

Any person who,—

falsifies any geographical indication; or

falsely applies to goods any geographical indication; or

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

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

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

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:

Provided 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. (Section 39)

Penalty for selling goods to which false geographical indication is applied

According to Section 40, any person who sells, lets for hire or exposes for sale, or hires or has in his possession for sale, goods or things to which any false geographical indication is applied or which, being required under section 71 to have applied to them an indication of the country or place in which they were made or produced or the name and address of the manufacturer, or person for whom the goods are manufactured or without the indications so required, shall, unless he proves,—

that, having taken all reasonable precautions against committing an offence against this section, he had at the time of commission of the alleged offence no reason to suspect the genuineness of the geographical indication or that any offence had been committed in respect of the goods; or

that, on demand by or on behalf of the prosecutor, he gave all the information in his power with respect to the person from whom he obtained such goods or things; or

that otherwise he had acted innocently,

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:

Provided 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.

Enhanced penalty on second or subsequent conviction

Whoever having already been convicted of an offence under section 39 or section 40 is again convicted of any such offence shall be punishable for the second and for every subsequent offence, with imprisonment for a term which shall not be less than one year but which may extend to three years and with fine which shall not be less than one lakh rupees but which may extend to two lakh rupees:

Provided that the court may, for adequate and special reason to be mentioned in the judgment, impose a sentence of imprisonment for a term of less than one year or a fine of less than one lakh rupees:

Provided further that for the purposes of this section, no cognizance shall be taken of any conviction made before the commencement of this Act. (Section 41)

Penalty for falsely representing a geographical indication as registered

As per section 42 of the Act, no person shall make any representation-

with respect to a geographical indication, not being a registered geographical indication, to the effect that it is a registered geographical indication; or

to the effect that a registered geographical indication is registered in respect of any goods in respect of which it is not in fact registered; or

to the effect that registration of a geographical indication gives an exclusive right to the use thereof in any circumstances in which having regard to limitation entered on the register, the registration does not in fact give that right.

If any person contravenes any of the provisions of sub-section (1), he shall be liable to penalty of a sum equal to one-half per cent. of the total sales or turnover, as the case may be, in business or of the gross receipts in profession as computed in the audited accounts of such person, or a sum equal to five lakh rupees, whichever is less.

For the purposes of this section the use in India in relation to a geographical indication of the words “registered geographical indication” or any other expression, symbol or sign like “R.G.I.” referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except-

- a) where that word or other expression, symbol or sign is used in direct association with other words delineated in characters at least as large as those in which that word or other expression, symbol or sign is delineated and indicating that the reference to registration as a geographical indication under the law of a country outside India being a country under the law of which the registration referred to is in fact in force; or
- b) where that other expression, symbol or sign is of itself such as to indicate that the reference is to such registration as is mentioned in clause (a); or
- c) where that word is used in relation to a geographical indication registered under the law of a country outside India and in relation solely to goods to be exported to that country for use in that country.

Offences by companies

Section 49 provides for offences by companies. It states that if the person committing an offence under this Act is a company, the company as well as every person in charge of, and responsible to, the company for the

conduct of its business at the time of the commission of the offence shall be deemed to be guilty of the offence and shall be liable to be proceeded against and punished accordingly:

Provided that nothing contained in this sub-section shall render any such person liable to any punishment if he proves that the offence was committed without his knowledge or that he exercised all due diligence to prevent the commission of such offence.

Notwithstanding anything contained in sub-section (1), where an offence under this Act has been committed by a company and it is proved that the offence has been committed with the consent or connivance of, or that the commission of the offence is attributable to any neglect on the part of, any director, manager, secretary or other officer of the company, such director, manager, secretary or other officer shall also be deemed to be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

Explanation.—For the purposes of this section,—

- a) “company” means any body corporate and includes a firm or other association of individuals; and
- b) “director”, in relation to a firm, means a partner in the firm.

REMEDIES AND RELIEF

Section 67 states that the relief which a court may grant in any suit for infringement or for passing off referred to in section 66 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or account of profits, together with or without any order for the delivery-up of the infringing labels and indications for destruction or erasure.

The order of injunction under sub-section (1) may include an ex parte injunction or any interlocutory order for any of the following matters, namely:—

- a) for discovery of documents;
- b) preserving of infringing goods, documents or other evidence which are related to the subject-matter of the suit;
- c) restraining the defendant from disposing of or dealing with his assets in a manner which may adversely affect plaintiff’s ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.

Notwithstanding anything contained in sub-section (1), the court shall not grant relief by way of damages (other than nominal damages) on account of profits in any case—

- a. where in a suit for infringement the defendant satisfies the court—
 - i. that at the time he commenced to use the geographical indication complained of in the suit he was unaware and had no reasonable ground for believing that the geographical indication of the plaintiff was on the register; and
 - ii. that when he became aware of the existence and nature of the plaintiff’s right in the geographical indication, he forthwith ceased to use the geographical indication in relation to good in respect of which it was registered; or
- b. where in a suit for passing off, the defendant satisfies the court—
 - i. that at the time he commenced to use the geographical indication complained of in the suit he was unaware and had no reasonable ground for believing that the geographical indication relating to the plaintiff was in use; and
 - ii. that when he became aware of the existence and nature of the geographical indication relating to the plaintiff he forthwith ceased to use the geographical indication complained of.

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.

REGISTRATION PROCESS

What Indications are not registrable ?

For registrability, the indications must fall within the scope of section 2(1)e of GI Act, 1999. Being so, it has to also satisfy the provisions of section 9, which prohibits registration of a Geographical Indication

the use of which would be likely to deceive or cause confusion; or

the use of which would be contrary to any law for the time being in force; or

which comprises or contains scandalous or obscene matter; or

which comprises or contains any matter likely to hurt the time being in force; religious susceptibilities of any class or section of the citizens of India; or

which would otherwise be dismantled to protection in a court; or

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

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.

Explanation 1 to section 9 says that for the purposes of this section, “generic names of indications” in relation to goods which although relates to the place of 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 an indication of the kind, nature, type of other property or characteristic of the goods.

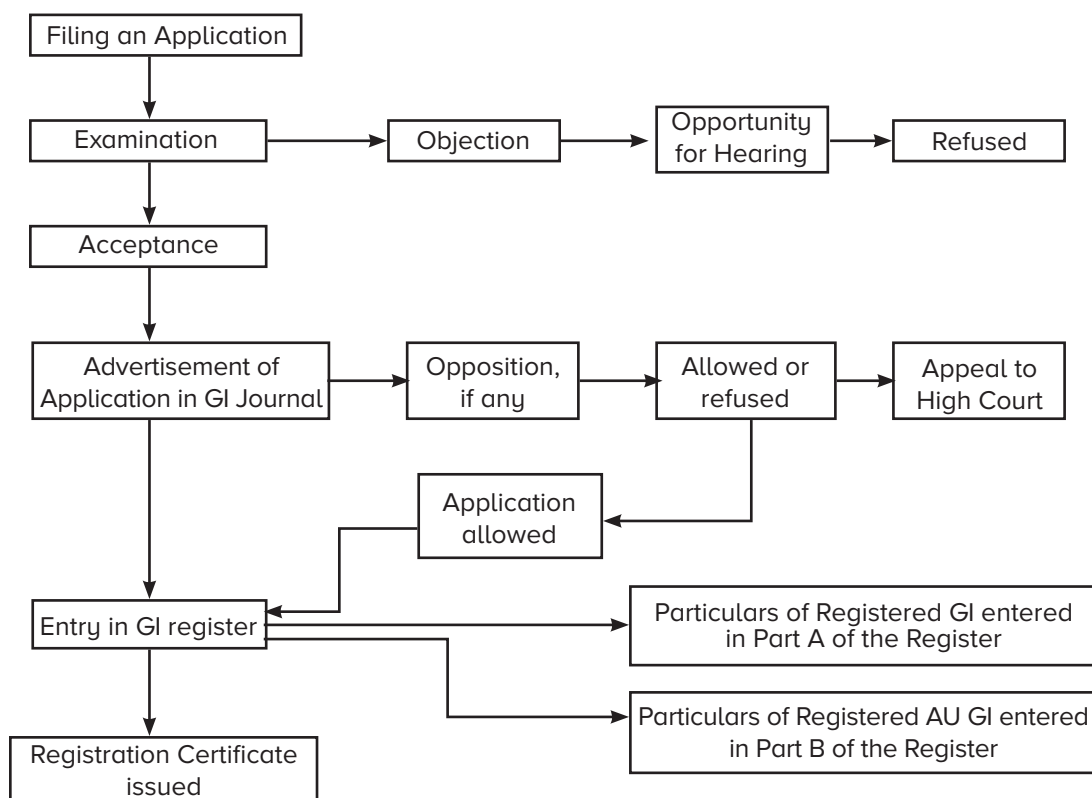
Explanation 2 further says that “in determining whether the name has become generic, account shall be taken of all factors including the existing situation in the region or place in which the name originates and the area of consumption of the goods.”

What is the benefit of registration of geographical indications?

Registration of GI is not compulsory but important because-

- *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.*
- *Registration to be prima facie evidence of validity in case of any suit.*
- *Registration affords better legal protection to facilitate an action for infringement.*
- *The registered proprietor and authorised users can initiate infringement actions.*
- *The authorised users can exercise the exclusive right to use the geographical indication.*

THE REGISTRATION PROCESS



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

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 G.I., if registered will be indicated accordingly in the register.

The Geographical Indication Registry is situated at Geographical Indications Registry, Intellectual Property Office Building, G.S.T. Road, Guindy, Chennai – 600032 having all-India Jurisdiction. Application or any other document may be filed directly in the GI Registry, Chennai, or may be sent by post or registered post or speed post or courier services.

The applicant must have an address for service in India. Generally, application can be filed by (1) a legal practitioner (2) a registered agent.

Step 2 and 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.

On receipt of the application, a number is allotted. Thereafter, the examiner scrutinizes the application to check whether it meets the requirements of the GI Act and the Rules. Deficiencies if any found through a preliminary examination would be communicated by the Examiner to the Applicant. The deficiencies need to be complied within the time limit mentioned in the communication. [Rule31]

Upon compliance of the deficiencies, the Registrar shall ordinarily constitute a Consultative Group of experts (not more than seven representatives) to ascertain the correctness of the particulars furnished in the Statement of Case. The Consultative Group is chaired by the Registrar of Geographical Indications. [Rule33]

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 months of acceptance shall be published in the Geographical Indications Journal.

After issuance of the Examination Report, submissions of the applicant would be considered. If no further objection is raised, the application would be accepted and published (within three months of acceptance) in the Geographical Indications Journal. [Rule, 34&38]

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 send a copy of the counter statement.
- If he does not do this he 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.

After advertisement of a Geographical Indication in the Geographical Indications Journal, any person may within three months oppose the registration of an application for GI. This period may be extended by a period, not exceeding one month, by making an application to the Registrar along with the prescribed fee. Such an application for extension shall be filed before the expiry of the period of three months. The Notice of Opposition shall be filed only before the Registrar of Geographical Indications at Chennai. [Section 14, Form GI-2]

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

Section 18 of the act provides that the registration of a geographical indication shall be for a period of 10 years and shall be renewed for a period of another 10 years on an application made in the prescribed manner and within the prescribed period and subject to the payment of the prescribed fees.

Step 9: Additional Protection to Notified Goods

Additional protection for notified goods is provided in the Act. [Section 22(3)]

An application may be made to the registrar in respect of goods notified by the central Government for additional protection for a registered geographical indication in Form GI-9 accompanied in triplicate along with a statement of case and shall be accompanied with the copy of the notification issued.

The application shall be made jointly by the registered proprietor of the Geographical indications in India and by all the producers of the Geographical indication.

Step 10: Appeal

Any person aggrieved by an order or decision may prefer an appeal to High Court within 3 months from the date on which the order.

INTERNATIONAL CONVENTIONS/AGREEMENTS**Paris Convention for the Protection of Industrial Property, 1883**

The Paris Convention applies to industrial property in the widest sense, including patents, trademarks, industrial designs, utility models (a kind of “small-scale patent” provided for by the laws of some countries), service

marks, trade names (designations under which an industrial or commercial activity is carried out), geographical indications (indications of source and appellations of origin) and the repression of unfair competition.

The Paris Convention, concluded in 1883, was revised at Brussels in 1900, at Washington in 1911, at The Hague in 1925, at London in 1934, at Lisbon in 1958 and at Stockholm in 1967, and was amended in 1979. The Convention is open to all States. Instruments of ratification or accession must be deposited with the Director General of WIPO.

The Convention lays down a few **common rules** that all Contracting States must follow. It states that-

- Indications of Source: Measures must be taken by each Contracting State against direct or indirect use of a false indication of the source of goods or the identity of their producer, manufacturer or trader.

The first major international agreement covering patents, designs and marks. Article 10 and 10ter of this Convention address false indications of the source of goods. They are as follows.

Article 10 - False Indications: Seizure, on Importation, etc., of Goods Bearing False Indications as to their Source or the Identity of the Producer.

- (1) The provisions of the preceding Article shall apply in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant.
- (2) Any producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party.

Article 10ter - Marks, Trade Names, False Indications, Unfair Competition: Remedies, Right to Sue.

- (1) The countries of the Union undertake to assure to nationals of the other countries of the Union appropriate legal remedies effectively to repress all the acts referred to in Articles 9, 10, and 10bis.
- (2) They undertake, further, to provide measures to permit federations and associations representing interested industrialists, producers, or merchants, provided that the existence of such federations and associations is not contrary to the laws of their countries, to take action in the courts or before the administrative authorities, with a view to the repression of the acts referred to in Articles 9, 10, and 10bis, in so far as the law of the country in which protection is claimed allows such action by federations and associations of that country.

The Paris Union, established by the Convention, has an Assembly and an Executive Committee. Every State that is a member of the Union and has adhered to at least the administrative and final provisions of the Stockholm Act (1967) is a member of the Assembly. The members of the Executive Committee are elected from among the members of the Union, except for Switzerland, which is a member ex officio. The establishment of the biennial program and budget of the WIPO Secretariat – as far as the Paris Union is concerned – is the task of its Assembly.

This international agreement was the first major step taken to help creators ensure that their intellectual works were protected in other countries.

Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (1891)

According to the Madrid Agreement, all goods bearing a false or deceptive indication of source, by which one of the Contracting States, or a place situated therein, is directly or indirectly indicated as being the country or place of origin, must be seized on importation, or such importation must be prohibited, or other actions and sanctions must be applied in connection with such importation.

The Agreement provides for the cases and the manner in which seizure may be requested and effected. It prohibits the use, in connection with the sale, display or offering for sale of any goods, of all indications in the nature of publicity capable of deceiving the public as to the source of the goods. It is reserved to the courts of each Contracting State to decide which appellations (other than regional appellations concerning the source of

products of the vine) do not, on account of their generic character, come within the scope of the Agreement. The Agreement does not provide for the establishment of a Union, governing body or budget.

The Agreement, concluded in 1891, was revised at Washington in 1911, at The Hague in 1925, at London in 1934, at Lisbon in 1958 and at Stockholm in 1967.

The Agreement is open to States party to the Paris Convention for the Protection of Industrial Property (1883). Instruments of ratification or accession must be deposited with the Director General of WIPO.

Article 1 of Madrid Agreement states that-

- (1) All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said countries.
- (2) Seizure shall also be effected in the country where the false or deceptive indication of source has been applied, or into which the goods bearing the false or deceptive indication have been imported.
- (3) If the laws of a country do not permit seizure upon importation, such seizure shall be replaced by prohibition of importation.
- (4) If the laws of a country permit neither seizure upon importation nor prohibition of importation nor seizure within the country, then, until such time as the laws are modified accordingly, those measures shall be replaced by the actions and remedies available in such cases to nationals under the laws of such country.
- (5) In the absence of any special sanctions ensuring the repression of false or deceptive indications of source, the sanctions provided by the corresponding provisions of the laws relating to marks or trade names shall be applicable.

Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (1958)

The Lisbon System is a practical and cost-effective solution for the International Registration of Appellations of Origin (AOs) and Geographical Indications (GIs), offering protection in 43 Contracting Parties, covering up to 72 countries, through a single registration procedure and one set of fees.

The Lisbon System sets a legal framework to facilitate the international protection of AOs and GIs in 43 Contracting Parties, covering 72 countries in Africa, Asia, Europe, Latin America and the Caribbean, without the difficulties and costs of filing and managing multiple registrations before different authorities. Through a single registration procedure with the World Intellectual Property Organization (WIPO), in one language and with only one set of fees in one currency, the Lisbon System grants registered AOs and GIs protection in several countries, based on the only legally binding international register. The Lisbon System can be used to protect AOs and GIs for any type of product, such as agricultural and foodstuffs, natural, artisanal and even industrial goods (find existing registrations on the Lisbon Express database).

Article 2 of The Lisbon Agreement provides for the protection of appellations of origin, that is, the “geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographic environment, including natural and human factors.

Article 3 states that “Protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as “kind,” “type,” “make,” “imitation”, or the like.”

International Protection

To qualify for international protection under the Lisbon System, AOs and GIs must be already protected as such in their Contracting Party of Origin, by means of either legislative or administrative provisions, judicial decisions

or any form of registration. The Lisbon System leaves ample flexibility on how this protection may be formalized at the national or regional level, which is determined by the applicable domestic legislation of the Contracting Party of Origin (e.g. domestic protection may take place through sui generis or trademark systems, special decrees, labeling or unfair competition laws etc.).

Unlike other global intellectual property registration systems, the main advantage of the Lisbon System is that it clearly defines the minimum level of protection to be granted to internationally registered AOs and GIs. Contracting parties are required to protect registered AOs and GIs in their territories against any usurpation and imitation, even if the true origin of the product is stated, or if the AO/GI is used in translated form, or accompanied by terms such as “kind,” “type,” “make,” “imitation” or the like. The Lisbon System also protects registered AOs and GIs against any other misleading practice as to the true origin or nature of the goods. Once registered under the Lisbon System, AOs and GIs can no longer be considered to have become generic terms serving to designate a type of product in those contracting parties that have not refused them protection. The basis for such protection is the only legally binding international register for AOs/GIs, directly enforceable in multiple jurisdictions. This makes the protection particularly effective and considerably eases the burden of proof when AO/GI operators seek to enforce protection of their AOs/GIs abroad.

Renewal

Under the Lisbon System, once the AO or GI is registered, the consequent international protection is potentially unlimited in time as there is no need to pay any additional fee to renew the registration. In principle, the international protection lasts as long as the AO/GI remains protected in its Contracting Party of Origin, subject to any refusal within the prescribed term or invalidation of its effects in the territory of a contracting party.

Since January 2010, Contracting States have had the option to issue a statement of grant of protection, thus improving communication regarding the status of international registrations in member countries. These statements can be issued by Contracting States that know, well before the expiry of the one-year refusal period under Article 5(3), that they will not issue a declaration of refusal of protection; or the statement can take the place of the notification of withdrawal of a refusal already given.

The Lisbon Agreement, concluded in 1958, was revised at Stockholm in 1967, and amended in 1979. The Lisbon Agreement created a Union which has an Assembly. Every State member of the Union that has adhered to at least the administrative and final clauses of the Stockholm Act is a member of the Assembly.

The Agreement is open to States party to the Paris Convention for the Protection of Industrial Property (1883). Instruments of ratification or accession must be deposited with the Director General of WIPO.

How is Geneva Act different from Lisbon Agreement?

The Geneva Act updates and enhances the existing international registration system protecting names that identify the geographic origin of products: the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration of 1958.

The Lisbon Agreement applies only to appellations of origin – a special kind of geographical indication for products that have a particularly strong link with their place of origin. The Geneva Act extends that protection to geographical indications alongside appellations of origin, to better take into account existing national or regional systems for the protection of distinctive designations in respect of origin-based quality products. It also allows certain intergovernmental organizations to join, making the international system of protection more inclusive.

Geneva Act of the Lisbon Agreement (as adopted on May 20, 2015)

The Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (“the Geneva Act”) was adopted in 2015 to modernize the Lisbon System. The Geneva Act extends protection to the broader category of Geographical Indications (GIs) in addition to Appellations of Origin (AOs), thus allowing more products (i.e. those not qualifying under the more stringent category of AOs) to benefit from

the international protection mechanism offered by the Lisbon System. Furthermore, the Geneva Act opens the Lisbon System to the accession of certain intergovernmental organizations (such as the European Union or the African Intellectual Property Organization). Owing to this additional flexibility, Lisbon users from different geographical areas are now able to ensure protection to their AOs/GIs in new important markets.

Protection Granted under the Geneva Act

The Geneva Act requires contracting parties to provide the legal means to prevent:

- (1) Use of the registered AO/GI on goods of the same kind when the goods do not originate in the area of origin or do not comply with other requirements for using the AO/GI;
- (2) Use of the registered AO/GI on goods of different kinds or services only under certain conditions (i.e. when a connection with the AO/GI reputation and/or with the AO/GI beneficiaries is implied, diluting or taking unfair advantage of the AO/GI reputation or damaging the interests of the beneficiaries);
- (3) Any imitation of the AO/GI, even if the true origin of the goods is indicated or when the AO/GI is translated or used with terms such as “type”, “style”, “kind”, etc. (e.g. “French style”);
- (4) Any other misleading practice as to the true origin, provenance or nature of the goods.

The extent of protection

Contracting Parties to the Act must provide legal means to prevent the use of an internationally registered appellation of origin or geographical indication in respect of goods of the same kind, or goods that are not of the same kind, or services, under certain conditions. They must also provide legal means to prevent any use amounting to the imitation of an appellation of origin or geographical indication.

A flexible international registration system

Countries and regional groups of countries protect appellations of origin and geographical indications in different ways – through sui generis laws (special laws that apply specifically or exclusively to geographical indications and/or appellations of origin), trademark laws, administrative provisions, or other legal means. The Geneva Act takes this diversity into account. Contracting Parties can use any type of legislation to protect products registered under the Lisbon System, provided that the legislation in question meets the requirements of the Act.

Maximum flexibility for Contracting Parties

The Geneva Act introduces several flexibilities into the Lisbon System. As well as choosing how to meet the requirements of the Act through domestic law – whether by resorting to a sui generis protection regime, the trademark system, or some other approach – each Contracting Party can also make various optional declarations when it accedes to the Act. For example, it can:

- request additional information concerning the link between the quality, characteristics or reputation of a product and its geographical origin; and/or;
- request that an application for registration be accompanied by a declaration of intention to use the appellation of origin or geographical indication in its territory; and/or;
- request payment of an individual fee to cover the cost of substantive examination of a new application for international registration.

Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), 1995

With the establishment of the world trade Organization (WTO), the importance and role of the intellectual property protection has been crystallized in the Trade-Related Intellectual Property Systems (TRIPS) Agreement. It was negotiated at the end of the Uruguay Round of the General Agreement on Tariffs and Trade (GATT) treaty in 1994. The general goals of the TRIPS Agreement are contained in the Preamble to the Agreement, which

reproduces the basic Uruguay Round negotiating objectives established in the TRIPS area by the 1986 Punta del Este Declaration and the 1988-89 Mid-Term Review.

The areas of intellectual property that it covers are: copyright and related rights (i.e. the rights of performers, producers of sound recordings and broadcasting organizations); trademarks including service marks; geographical indications including appellations of origin; industrial designs; patents including the protection of new varieties of plants; the layout-designs of integrated circuits; and undisclosed information including trade secrets and test data.

A product's quality, reputation or other characteristics can be determined by where it comes from. Geographical indications are place names (in some countries also words associated with a place) used to identify products that come from these places and have these characteristics (for example, "Champagne", "Tequila" or "Roquefort"). Protection required under the TRIPS Agreement is defined in two articles.

Article 22 to 24 provides for Geographical Indications.

Article 22- Protection of Geographical Indications

- (1) Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, 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.
- (2) In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:
 - i. the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;
 - ii. any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967).
- (3) A Member shall, ex officio if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin.
- (4) The protection under paragraphs 1, 2 and 3 shall be applicable against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.

Protection of Wines and Spirits:

Article 23 provides that interested parties must have the legal means to prevent the use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication. This applies even where the public is not being misled, there is no unfair competition and the true origin of the good is indicated or the geographical indication is accompanied by expressions such as "kind", "type", "style", "imitation" or the like. Similar protection must be given to geographical indications identifying spirits when used on spirits. Protection against registration of a trademark must be provided accordingly.

Exceptions:

Article 24 contains a number of exceptions to the protection of geographical indications. These exceptions are of particular relevance in respect of the additional protection for geographical indications for wines and spirits. For example, Members are not obliged to bring a geographical indication under protection, where it has become a generic term for describing the product in question. Measures to implement these provisions

shall not prejudice prior trademark rights that have been acquired in good faith. Under certain circumstances, continued use of a geographical indication for wines or spirits may be allowed on a scale and nature as before. Members availing themselves of the use of these exceptions must be willing to enter into negotiations about their continued application to individual geographical indications. The exceptions cannot be used to diminish the protection of geographical indications that existed prior to the entry into force of the TRIPS Agreement. The TRIPS Council shall keep under review the application of the provisions on the protection of geographical indications.

In addition the Agreement provides for certain basic principles, such as national and most-favoured-nation treatment, and some general rules to ensure that procedural difficulties in acquiring or maintaining IPRs do not nullify the substantive benefits that should flow from the Agreement. The obligations under the Agreement will apply equally to all Member countries, but developing countries will have a longer period to phase them in. Special transition arrangements operate in the situation where a developing country does not presently provide product patent protection in the area of pharmaceuticals.

The TRIPS Agreement is a minimum standards agreement, which allows Members to provide more extensive protection of intellectual property if they so wish. Members are left free to determine the appropriate method of implementing the provisions of the Agreement within their own legal system and practice.

CASE STUDIES/ CASE LAWS

Darjeeling Tea

Tea is India's oldest industry in the organized manufacturing sector and has retained its position as the single largest employer in this sector. Around 30 per cent of the world's tea is produced in the country. India is also the world's largest consumer of tea. However, on the export front India is facing huge competition from other key tea producing countries, such as Kenya, Sri Lanka and China. Darjeeling' tea is a premium quality tea produced in the hilly regions of the Darjeeling district West Bengal. Among the teas grown in India, Darjeeling tea offers distinctive characteristics of quality and flavour, and also a global reputation for more than a century. Broadly speaking there are two factors which have contributed to such an exceptional and distinctive taste, namely geographical origin and processing. The tea gardens are located at elevations of over 2000 meters above sea level.

History

The history of Darjeeling tea dates back to the 1840's, when India was a British colony. Before the arrival of the British, the forests of the region were known as Darjeeling today was inhabited by the Lepcha tribes. In 1828, while visiting this region located in the backdrop of the snow-clad Himalayan range, a young British called Captain Lloyd discovered the possibility of converting the region into a hill station or a sanitarium. In 1839, Darjeeling was handed over to Dr. A. Campbell, a civil surgeon, who got transferred from Kathmandu to Darjeeling to become the first Superintendent of the Darjeeling district, a position which he held for the next twenty two years. In 1841, Dr. Campbell brought the seeds of China variety of tea from Kumaon hills of North India and planted them near his residence in his Beech wood garden in Darjeeling, 2134 meters above the mean sea level. Seeing the success of Dr. Campbell's experimental tea nursery, the British Government decided to put out tea nurseries in the region in the year 1847. Even after the Indian independence from British rule in 1947, the British ownership continued in many tea gardens of Darjeeling. By the end of the 1970's, most of the tea gardens of Darjeeling were in the hands of Indian owners.

The major portion of the annual production of Darjeeling tea is exported, the key buyers being Japan, Russia, the United States, and the United Kingdom and other European Union (EU) countries such as France, Germany and the Netherlands. In order to ensure the supply of genuine Darjeeling tea in February 2000, a compulsory system of certifying the authenticity of exported Darjeeling tea was incorporated into the Indian Tea Act of 1953. The system makes it compulsory for all the dealers in Darjeeling tea to enter into a license agreement with the Tea Board of India on payment of an annual license fee.

Why Protect “Darjeeling Tea” as Geographical Indication

An adequate legal protection is necessary for the protection of legitimate right holders of Darjeeling tea from the dishonest business practices of various commercial entities. For instance, tea produced in countries like Kenya, Sri Lanka or even Nepal has often been passed off around the world as ‘Darjeeling tea’. Appropriate legal protection of this GI can go a long way in preventing such misuse. Without adequate GI protection both in the domestic and international arena it would be difficult to prevent the misuse of Darjeeling Tea’s reputation, wherein tea produced elsewhere would also be sold under the Darjeeling brand, causing damage to consumers and denying the premium price to Darjeeling tea industry. The industry is now waking up to the fact that unless Darjeeling Tea is properly marketed and branded, the survival of the industry may be at stake and GI protection along with stringent enforcement can go a long way in helping the industry to improve its financial situation.

Evolution of Legal Protection

The first attempt on the part of the Tea Board of India towards protection of the ‘Darjeeling’ brand was undertaken way back in 1983, when the ‘Darjeeling’ logo was created. The Tea Board obtained home protection for the Darjeeling logo as a certification trade mark under the Indian Trade and Merchandise Marks Act 1958 (now the Trade Marks Act, 1999). The registration was granted in class 30 in the name of the Tea Board in 1986. In the same year, the logo was registered as a trademark in several other countries [Refer Annexure A] like the UK, the USA, Canada, Japan, Egypt, and under the Madrid Agreement covering Germany, Austria, Spain, France, Portugal, Italy, Switzerland and former Yugoslavia. In the absence of a separate law dedicated exclusively to GI’s in India during that time, the word ‘Darjeeling’ was also registered under the Trade and Merchandise Marks Act 1958 in class 30 in the name of Tea Board in 1998. When the Geographical Indication Act in India was enacted in September 2003, the Tea Board applied for GI protection of ‘Darjeeling’ in October 2003. In October 2004, Darjeeling was granted the GI status in India to become the first application to be registered in India as a GI.

Rasogulla – A bitter battle over a sweet

The current dispute between West Bengal and Odisha over where the ever-popular sweet dessert “Rasgulla” first appeared. In support of a request made on behalf of the West Bengal State Food Processing and Horticultural Development Corporation Limited (WSFPHDCL) for gaining such designation, the GI registry of Chennai granted West Bengal the GI status to “Banglar Rasogolla” in the year 2017. The State of Odisha received the GI designation for the “Odisha Rasagola,” which is said to be manufactured in the Odisha village of Pahala. An application was submitted in 2018 on behalf of the State of Odisha by the Odisha Small Industries Corporation Limited (OSIC Ltd.) and Utkal Mistanna Byabasayee Samiti. The State of Odisha received the GI tag on “Odisha Rasagola” on July 29, 2019, according to the registrar.

There are many distinctions between the two dishes, which have been emphasised in the table below, despite the fact that the GI designation has been given to both States for the identical sweet dish.

Basis of Differentiation	Banglar Rasogulla	Odisha Rasagola
Name	Banglar Rasogulla	Odisha Rasagola
Claimed date of origin	1860’s	12 th Century
Historical Background	Made by Nobin Chandra Das, a renowned sweet producer of Bengal, at his home in Bagbazar, Kolkata which he later popularized in India	Rasagola was used as an offering in the temple of Lord Jaganath as a form of bhog on the last day of Rath Yatra since the beginning.
Colour	White	Brown
Texture	Spongy	Soft, tender
Taste	syrupey sweet dessert	Not very sweet

The Banglar Rasogulla of West Bengal received the GI tag from the Registrar of the Chennai GI office. The decision was made in this way primarily because the registrar was confident in the product's capacity to be registered because it was made with the state's ancient traditions in mind and possessed distinctiveness. The State of Odisha opposed to this on the grounds that the dish was a native of that state. But, the registrar rejected it, and the state did not oppose in line with the provisions of the act, therefore the application was not maintainable.

Later, an application was submitted in 2018 on behalf of the State of Odisha by the Odisha Small Industries Corporation Limited (OSIC Ltd.) and Utkal Mistanna Byabasayee Samiti. The Odisha Rasagola's distinctiveness is primarily apparent in its flavour, texture, and colour. The Rasagola is soft and sensitive, and it is brown in colour. Its flavour is also not overly sweet. The Odisha Rasagola is distinctive in nature due to all of these qualities. Moreover, the Rasagola sweet dish has been mentioned in historical literature written about Odisha, indicating the geographic origin of the meal to this region.

In light of these qualities and traits, it may be claimed that the registrar is justified in awarding separate GI tags for the same delicacy to two different States for their respective styles of the perennially popular Rasagola. The action is appropriate to safeguard the interests of the food producers in both states. Also, the differentiation between the two items safeguards consumers against fraud and maintains economic development for both governments. The use of distinct names and distinction also prevents future disputes between the two parties over homonyms.

Trading Corpn. of Pakistan (P) Ltd. vs. Union of India, 2023 SCC OnLine Del 7562, Delhi High Court dated November 28, 2023

Facts:

The present suit has been filed by the Plaintiff No. 1-Trading Corporation of Pakistan Pvt. Ltd., Plaintiff No. 2-Rice Exporters Association of Pakistan and Plaintiff No. 3- Basmati Growers Association (hereinafter, 'the Plaintiffs') seeking an injunction against the Defendant-Government of India from inter alia approving Super Basmati as approved evolved Basmati for the purposes of export.

The Plaintiff also challenged the Notification dated 24th May, 2006 issued by the Defendant-Department of Commerce, Government of India. Vide order 16th April, 2014, this Court framed issues in the suit.

Plaintiff filed the suit seeking

- permanent injunction directing the Defendant not to give effect to the impugned Gazette Notification dated 24th May 2006 permitting exports of evolved Basmati rice or any rice from India under the name/variety/classification/trade name of 'SUPER BASMATI';
- permanent injunction restraining the Defendant from permitting exports of rice under the name 'SUPER BASMATI' constituting passing off of the Plaintiffs' trans- border reputation of the 'SUPER BASMATI' name, label, quality, variety and classification of evolved Basmati rice;

Judgement:

It was submitted that that Basmati has also been registered as a geographical indication (hereinafter, 'GI') under the provisions of the Geographical Indications of Goods (Registration and Protection) Act, 1999 in India, bearing application no. 145 granted on 15th February, 2016.

It was observed that as per the Notification dated 18th September 2017 issued by the Ministry of Agriculture, the seed production of all varieties of Basmati rice notified under Section 5 of the Seeds Act, 1966, is restricted to the GI registered rice growing areas of Delhi, Punjab, Haryana, parts of UP and state of Jammu & Kashmir.

Court stated that "since there is no appearance on behalf of the Plaintiffs, and the suit has not been prosecuted effectively since 2020, and considering the Defendant's stand recorded as above, no further orders are called for in the present suit. The suit is, accordingly, dismissed for non-prosecution. All pending applications are also disposed of."

Scotch Whisky Association vs. J.K. Enterprises and Ors, MISC. PETITION No. 4543 of 2021, Madhya Pradesh High Court, dated December 18, 2023

Facts :

The Petitioner- Scotch Whisky Association (hereinafter 'The Petitioner') in the present case lays a challenge to the order dated 28.10.2021 passed in CS no. 07/2020 by the Commercial Court in District Indore, through which the application under Order VII Rule 11 (hereinafter O7/R11) has been partly allowed holding the suit to be maintainable only after impleadment of "Authorised User" (hereinafter 'AU') in terms of the mandate of Section 21 of the Geographical Indications of Goods (Registration and Protection) Act, 1999 (hereinafter 'GI Act'). Petitioner pleads that being a "Registered Proprietor" (hereinafter 'RP') of the Scotch Whisky Geographical Indication (hereinafter 'GI') has an independent right and entitlement to maintain the suit for infringement of the GI in his own independent capacity.

Petitioner had filed a GI Application no. 151 as the RP applicant for a grant of GI for Scotch Whisky earlier on 5th January 2009, on which the aforesaid notifications granting the status of GI to Scotch Whisky came to be issued, first in time being on 23rd September 2010. Thus petitioner is argued to be the RP, on whose application the 'Scotch Whisky' (hereinafter 'SW') attained the GI status in the country.

J.K. Enterprises (hereinafter 'JKE') is a partnership firm, with Defendant No. 2 & 3 as its partners, having its Head Office in Indore. Its manufacturing and packaging unit is situated in District Dhar and Indore. Other defendants are also engaged in the business of manufacturing and trading of whisky, being companies incorporated under the Companies Act. They are stated to be marketing and selling 'London Pride' whisky, which gives rise to the cause of action in the plaint.

Issue:

Whether under Section 21(1), RP can bring the suit for infringement in its own capacity or must join AU to make the suit maintainable. How should the word 'and' occurring under Section 21(1) be read and; conjunctively or disjunctively, as specifying two classes simpliciter, who can institute the suit for infringement of GI?

Judgement:

Court observed that "From the overall study of anatomy of the GI Act, the Rules of 2002 framed thereunder, it is clear that the application for grant of GI status can be filed by an applicant, who has to be a producer or any person entrusted as the RP. It is on the application of the RP or any other applicant that GI tag comes into existence, never otherwise. The RP can alternatively, even in the absence of AU as postulated under various provisions, institute an action or proceeding in his own right, one of them being a renewal of GI or for grant of additional protection. The RP needs to be informed and updated whenever any new AU is added to the register of any GI of good concerned. Thus the RP can very well be treated as an entity independent of AU, under the provisions of the GI Act for the purposes of obtaining or continuing with the GI tag of any good concerned.

The RP has an independent legal status and entitlement to relate himself to the GI tag of the good concerned under the Act as well as the Rules framed thereunder. As is clear from Section 17, AU has a right to get himself registered separately and claim protection of GI independently. However, the mere existence or registration of AU cannot operate to the complete exclusion of the RP so as to dislodge and displace him from claiming the protection of any GI or standing against infringement thereof.

Section 21 has also to be viewed in the larger scheme of the GI Act, titled 'Rights conferred by registration'. Section 20 preceding Section 21 placed under the same Chapter titled 'EFFECT OF REGISTRATION' in a negatively worded covenant debars any person from instituting any proceeding pertaining to the infringement of unregistered GI. The legislative intent is loud and clear that it is protecting only the registered GI, nothing more and nothing less. Section 21 thus is enacted to protect the registered GI, the unregistered version of which has no protection or identity available under the Act. The title of Section 21 indicates the end purpose and intent behind its enactment, which is the right arising out of an incident to registration. Clearly, when registration can be applied for by both RP or AU, then both entities shall equally be entitled to the rights flowing out of the same as its consequence thereof. It cannot be contended that without an application preferred under Section 11, a GI

tag can come into existence on its own and that the application under Section 11 has to necessarily be either by the RP, AU or both.

Thus the registration of GI gives equal recognition & rights to the RP as well as AU of obtaining the 'right to obtain relief' in the event of infringement of GI by any person. Section 21(1)(a) is different from Section 21(1)(b) and the difference in legislative drafting of the same further magnified the above interpretation. On one hand, Section 21(1)(a) accords RP and AU the 'right to obtain relief' for any infringement and Section 21(1)(b) on the other hand accords the 'exclusive right' to the use of goods whose GI is registered. The exclusive right to use is qua the world at large and cannot work to the exclusion of RP who is, as in the present case 'Bhagirathi' of the GI tag itself, the original applicant.

Petitioner is the 'Bhagirathi' of the GI tag in India as is luminescent from the notification of January 2009. Therefore, the legislature could not have been presumed to have conferred exclusive rights on the AU to the exclusion of RP itself, the originator of the very existence of a right. On the principles of *ubi jus ibi remedium*, viz., if there is a right, there is a remedy, therefore, RP would also have a right to file a restraint suit for grant of injunction against any unauthorised user of GI tag.

The word 'and' used under Section 21(1)(a) has to be treated as 'or', as otherwise the status of RP would be reduced below AU by any other interpretation. The interpretation of 'and' as 'or' or 'or' as 'and' has often been a subject matter of debate and depending on the legislative text and context, 'and' can be interpreted as 'or' or vice-versa as held in the matter of *Gujarat Urja Vikas Nigam Ltd. v. Essar Power Ltd., (2008) 4 SCC 755.*"

Court whilst referring to the registration certificates of GI/trademark issued in multiple other countries including the country of origin, viz. UK. The submission can't be doubted that Scotch Whiskey is internationally renowned as a whiskey pertaining to the Scottish province of UK. For this reason itself it has been recognised and acknowledged with a special GI tag across the world. The possibility of loss of business and damage to goodwill arising out of the use or misuse of brand of Scotch Whiskey can't be ruled out if during the trial later, it is established by the plaintiffs that JKE (Respondent) is infringing upon the registered GI of petitioner. However, whether the infringement has actually happened or not; whether the loss of business or damages as averaged in the suit by the petitioner is all a matter of trial, yet to be tested through evidence, exchange of pleadings and examination of witnesses. On the face of it, it can't be inferred that plaint of petitioner fails to disclose a 'cause of action' miserably and thus liable to be dismissed summarily.

Tea Board, India vs. ITC Limited C.S. 250 of 2010

In this case, plaintiff prayed for restraining the defendant from using or conducting or making in any manner or in any way carrying its business at the hotel situate in Kolkata by using in any manner whatsoever the name "DARJEELING LOUNGE" or any other name or mark or word which is phonetically or structurally similar or identical or deceptively similar to the registered geographical indication, "DARJEELING" the name and logo in the name of the plaintiff in any manner whatsoever and/or 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 as to the nature of the beverages sold at the said premises of the defendant so as to allude a nexus with the registered geographical indication in the name of 'DARJEELING' or logo and to confuse persons in any manner.

Court stated that-

"The allegations on use of the name of 'DARJEELING LOUNGE' by the defendant in respect of its refreshment lounge services constitutes an act of infringement under the Trade Marks Act, 1999 and Geographical Indications of Goods Act, 1999. Admittedly, the plaintiff has obtained only a certification Trade Mark under Chapter VIII of the T.M.M. Act, 1958 and not a regular trade mark as being issued under Section 23 of the said Act. In case of certification trade mark application of Sections 28 and 29 of the Trade Marks Act, 1999 are expressly excluded by Section 69(c) of the said Act of 1999. The rights of proprietors of certification trade mark are limited only to certify that a particular brand of tea originates from Darjeeling. When a trade mark is not registered under Section 23 of the Trade Marks Act, 1999, it does not attract the provisions of Sections 28 and 29 of the said Act. The certification trade mark of the plaintiff would stand infringed only in the event the defendant certifies that a particular tea is a 'Darjeeling Tea', that is to say, the tea is produced in the district of Darjeeling. It is never the case of the plaintiff's that the defendants at any point of time certified or even intended to certify any tea with the use of the lounge as

a 'DARJEELING LOUNGE'. This has no reference with regard to the geographical origin of the place of Darjeeling. Infringement of certification trade mark is confined only to Section 75 and that too, such infringement is restricted to the goods and services for which the certification trade mark is registered and it cannot be extended to any other goods and services. That apart, no such case has been made out for infringement of certification trade mark under Section 75 of the Trade Marks Act, 1999. Therefore, in my opinion, there is a clear difference between Section 28 and Section 29 of the Trade Marks Act, 1999, which is applicable to regular trade mark and that of Section 75 of the Trade Marks Act, 1999, which is applicable to only certification trade mark. At the same time, it is also not found that there has been any infringement under the Geographical Indications of Goods Act because the defendant's 'Lounge' is not relating to goods. Plaintiff's rights conferred by the registration of the word 'Darjeeling' is only in relation to tea. 'Darjeeling' is not a trade mark. It is only used to indicate geographical indication of a place of origin of tea originating from Darjeeling. The law relates to geographical indication is confined only to goods, which originates from the district of Darjeeling. The plaintiff does not own any right in the name of 'Darjeeling' for any goods other than tea as has been pleaded by the defendant in paragraph 18 of the written statement. The Geographical Indications Act can only extend to goods and admittedly, the defendant's lounge does not fall within the category of 'goods'. So also the allegation of passing off and unfair competition as alleged by the plaintiff does not appear to have any substance. Although, the allegation has been made about passing off but the plaintiff has not led any evidence to that effect. Without proper evidence and unless the allegation of passing off is substantiated by cogent evidence, mere statement on oath in plaint, is not sufficient to get a decree against the defendant in this regard. The plaintiff, however, has failed to prove the phenomena of passing off.

The plaintiff raises the issue that by its trademark registered under Chapter IX of the Trademarks Act had acquired any right other than the authority to certify that any tea marked with the name or logo of 'Darjeeling' is guaranteed to be 100% Darjeeling Tea originating from 87 tea gardens in the Darjeeling district of West Bengal mentioned in the certificate of registration. The right acquired under the certification trade mark is very limited. Section 78 of the Trademarks Act, 1999 deals with such limited right. This right is only to certify the good, namely, Tea, in this case, which originates from the district of Darjeeling. Section 2(e) of the TM Act, 1999 also corroborates the proposition. The definition of certification trademark in the TM Act, 1999, is set out below:

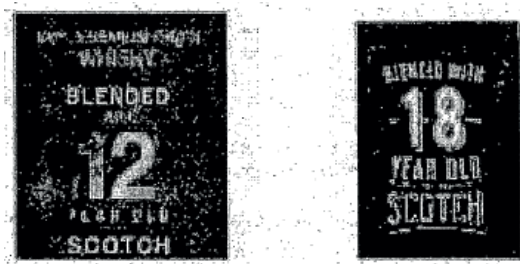
"2(e). Certification trade mark" means capable of distinguishing the goods or services in connection with which it is used in the course of trade which are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of the goods or performance of services, quality, accuracy or other characteristics from goods or services not so certified and registrable, as such Chapter IX in respect of those goods or services in the name as proprietor of the certification of that person,"

The defendant has stated that Section 2(e) read with Section 2(f) of the G.I. Act clearly indicates that the geographical indication is confined to goods. The statement of objects and reasons of the said Act also supports the submission of the defendant. In my view the whole object of the G.I. Act is to add to the economic prosperity to producers of 'goods' and promote 'goods' bearing Indian geographical origin for export. In fact the suit is misconceived and cannot be held to be maintainable under the G.I. Act. This question has been dealt with earlier and I do not feel it to repeat once again in deciding the issues referred to hereinabove. The plaintiff not being an user of the name 'Darjeeling' or seller of tea. There is no question on defendant's passing off its goods and services to the public as that of the plaintiff. It is again reiterated that in absence of any proper proof either documentary or oral, Court cannot come to a conclusion of passing off. Therefore, the issues referred to hereinabove are, accordingly, answered in the negative."

Scotch Whisky Association vs. Unibev Limited (01.02.2021 - DELHC) : CS(COMM)28/2021

In this case, it is stated that Scotch whisky is a world-renowned Geographical Indication originating from Scotland, UK which refers to whisky produce exclusively in Scotland. The said Scotch whisky is registered under No. 151 in class 33 of the Geographical Indication of Goods (Registration & Protection) Act, 1999. It is pleaded that in view of the statutory and common law rights of the plaintiff in the GI (Scotch Whiskey), any whisky which is not Scotch whisky, if sold or advertised bearing an expression or description or get-up or reference or indication to Scottish origin, is likely to mislead members of the trade and the public all over the world including India into believing that such whisky is Scotch whisky. Any such act would violate the plaintiff's statutory and common law rights in the GI "Scotch Whisky".

It is further stated that several whisky producers around the world including manufacturers of Scotch whisky, permanently use numerals on the front label of their labelling and packaging to highlight the age statement (a reference to the period of maturation) of their whiskies. It is common knowledge that a whisky with higher age statement commands a higher price as compared to the whisky of a lower age statement. The use of false and misleading age statements on whiskies violates the Scotch Whisky Regulation, 2009 and is an act of unfair competition amounting to infringement under Section 22(1)(b) of the GI Act. Reliance is also placed on Rule 1.3.7 of the Food Safety & Standards (Alcoholic Beverages) Regulations, 2018 (FSSAI Regulations) which mandates that the age of spirit whisky must refer to the youngest spirit.



In this case, defendant was with the motive to benefit from the reputation and goodwill of Scotch whisky, was selling and advertising its whisky under the brands “STROTTS” as blended Scotch whisky and also using the phrase “Product of Scotland”. Furthermore, defendant was also using untrue and misleading statements such as “Blended with upto 18 year old Scotch and Matured Indian Malts” etc in relation to its whiskies sold. Plaintiff filed an application seeking interim injunction restraining the defendant to engage in supplying, marketing, advertising, manufacturing etc, directly or indirectly, under the title “Scotch Whiskey” as it was not only infringing the plaintiffs rights but was also passing off the goods. Delhi High Court, while passing an order of interim injunction held defendant liable for infringement and also of passing off.

Court held that-

“In the present case as is obvious the defendants are using the phrase “blended with up to 18 years old scotch and matured Indian malts etc.”. It is not their case that this is the lowest maturity of the Scotch whisky which they are blending with the Indian malts. Prima facie, the manner in which the phrase/description is being used on the label of the whiskey indicates that the whisky is blended with scotch upto 18 years old etc. An unwary customer of average intelligence may get deceived to believe that the blend that is being used is only of an 18 years old scotch whisky and not of a scotch whisky with the lower age denomination. One can prima facie conclude that this is an attempt to pass off their whisky as blended with a higher quality blend 18 years old scotch etc. ignoring that scotch of other maturity may also have been used. No details were forthcoming as to what extent the 18 years old scotch is blended with matured Indian malts/other scotch whiskies. In fact, it was put to the learned senior counsel for the defendants that the defendants may consider giving the age of all the blended scotch whiskies on the label but such a suggestion did not receive a favourable response.

A prima facie case is made out by the plaintiff. There is an intent on the part of the defendants to pass off their goods as Scotch Whisky of a higher age brand. Accordingly, an interim injunction is passed in favour of the plaintiff and against the defendant directing the defendant to show on their advertisements, labels etc. the minimum age of the scotch whiskey that has been blended with the Indian malts.”

The State of Madhya Pradesh and Ors. vs. The Intellectual Property Appellate Board, Chennai and Ors. (27.02.2020 - MADHC) : Writ Petition Nos. 5798 and 9564 of 2016

In this case, petitioners prayed for quashing the order dated 05.02.2016 and sought cancellation of the Geographical Indication on ‘Basmati Rice’ registered as Geographical Indication No. 145, vide Certificate No. 238, dated 15th February 2015. Petitioners claims APEDA’s GI tag arbitrarily asserts the entirety of five States (Delhi, Punjab, Haryana, Uttarakhand, and Himachal Pradesh) and portions of two other States (Jammu &

Kashmir, and Uttar Pradesh). Petitioners also claimed the inclusion of 13 districts which actually grown basmati quality in the list by APEDA. The Supreme Court held that the High Court erred in not adjudicating of areas mentioned in APEDA's GI application. It set aside the impugned order and held that

“the petitioners cannot raise the dispute pertaining to over-inclusion of areas in the other States in those pending writ petitions”

LESSON ROUND-UP

- A geographical indication (GI) is a sign used on products that have a specific geographical origin and possess qualities or a reputation that are due to that origin. In order to function as a GI, a sign must identify a product as originating in a given place.
- 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.
- An appellation of origin shall be the geographical name of a country, region or a locality, used to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors, and which is produced, manufactured or processed within a specific limited geographical area.
- The indication of source relates to the geographical origin of a product and not to another kind of origin, for example, an enterprise that manufactures the product.
- Section 8 of the Geographical Indications Act, 1999 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 the Registrar and in respect of a definite territory of a country, or a region or locality in that territory, as the case may be.
- As per 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.
- A single application may be made for registration of a geographical indication for different classes of goods and fee payable therefor shall be in respect of each such class of goods.
- Any right to a registered geographical indication shall not be the subject matter of assignment, transmission, licensing, pledge, mortgage or any such other agreement: Provided that 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.
- Section 67 states that the relief which a court may grant in any suit for infringement or for passing off referred to in section 66 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or account of profits, together with or without any order for the delivery-up of the infringing labels and indications for destruction or erasure.
- GI are protected internationally with the help of various international instruments like Paris Convention, Madrid Agreement, Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, TRIPS Agreement.

GLOSSARY

- **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.
- **Appellation of origin**- It means the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.
- **Indication of source** - It can be defined as an indication referring to a country, or to a place in that country, as being the country or place of origin of a product. Examples of indications of source are the mention, on a product, the name of a country, or indications such as “made in”
- **Generic names or indications** - In relation to goods, generic names or indications 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.
- **Homonymous geographical indications (GI)** –GIs that are spelled or pronounced alike, but which identify products originating in different places, usually in different countries. In principle, these indications should coexist, but such coexistence may be subject to certain conditions are called Homonymous geographical indications.
- **Registered geographical indication**- Registered geographical indication or any other expression, symbol or sign like "R.G.I." referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register.
- **Registered Proprietor** - In relation to a geographical indication, it means any association of persons or of producers or any organisation for the time being entered in the register as proprietor of the geographical indication.

TEST YOURSELF

(These are meant for recapitulation only. Answers to these questions are not to be submitted for evaluation).

1. What is a geographical indication? How is a geographical indication different from a trade mark? List out the examples of possible Indian Geographical Indications?
2. Who can apply for the registration of a geographical indication? What is the benefit of registration of geographical indications? Who is a registered proprietor of a geographical indication?
3. Discuss the procedure for registration of geographical indications?
4. When is a registered geographical indication said to be infringed? Who can initiate an infringement action?
5. Is registration of a geographical indication compulsory and how does it help the applicant? How long the registration of geographical indication is valid?
6. List the matters prohibited for Registration under Geographical Indication Act? Also mention the Section under which prohibited matters are covered.
7. Under which instruments can a registered GI be protected worldwide? Explain

