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A Tool of Differentiation: Geographical Indication

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ABSTRACT

Geographical indication as the name suggests, is an indication, whether in the form of name or sign, used on goods that have a specific geographical origin and possess qualities that are due to the place of origin. Geographical indication establishes the authenticity of goods and refrain it from being misused by dishonest commercial operators. GI is an aspect of Industrial property which refer to indicating geographical origin referring to a place or a country situated therein as being the place or country of origin of that particular product. It establishes a differentiation among various products, having similar qualities in order to protect the sincerity of the place of origin of that product, and because of which the place is known in the world.

Keywords: *Indication, Origin, Qualities, Authenticity.*

I. INTRODUCTION

Like trademark or commercial names, Geographical Indications (GIs) are distinctive signs which permit the identification of the products in the market. GIs convey the cultural identity of a nation, region or a specific area, they make it possible to add value to the natural riches of a country and to the skills of its population and they give local products a distinguishable identity. If the GIs are used in a proper way and are well protected, they can become an effective marketing tool of great economic value.

Geographical Indications has, over the years, emerged as one of the most contentious Intellectual property rights issues in the realm of the World Trade Organization's (WTO's) agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS).

TRIPS defines GI as any indication that identifies product as originating from a particular place, where a given quality, reputation or other characteristics of the product are essential attributable to its geographical origin.

In India the Geographical Indication of Goods (Registration and Protection) Act, 1999 protect the GIs.

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II. INTERNATIONAL TREATIES OF GEOGRAPHICAL INDICATION

A number of international treaties deals with partly or entirely with the protection of geographical indication. There are a number of relevant treaties administered by World Intellectual Property Organization (WIPO), as well as Agreement on Trade Related Aspect of Intellectual Property Rights (TRIPS) of the World Trade Organization (WTO) to protect GI.

(A) The **PARIS CONVENTION** of 1883, applies to the intellectual property rights in the widest sense, including patents, trademarks, industrial design, utility models, trade names, geographical indication and repression of unfair competition. The provisions of the convention fall into three main categories :-

1. **National treatment** – the convention provides that each contracting state must grant the same protection to nationals of the contracting states that it grants to its own nationals. Nationals of non-contracting states are also entitled to national treatment under the convention if they are domiciled or have a real and effective industrial or commercial establishment in a contracting state.
2. **Right of Priority** – this is given in the case of patents, marks and industrial designs. The right means that, on the basis of a regular first application filed in one of the contracting states, the application may within a period of time (12 months for patents and utility marks and 6 months for trademarks and industrial design), apply for protection in any of the other contracting states.
3. **Common rules** – the convention lays down a list of common rules for all the contracting states.
 - i. **Patents** - patents granted in different contracting states for the same invention are Independent of Each other -: the granting of a patent in one contracting state does not oblige another contracting state to grant a patent.
 - ii. **Marks** – the Paris Convention does not regulate the conditions for filing and registration of marks which are determined in each contracting state by domestic law. Where a mark has been duly registered in the country of origin it must, on request, be accepted for filing and protection in its original form in the other contracting country.
 - iii. **Industrial Design** – it must be protected in each contracting state and protection may not be forfeited in the ground that articles incorporating the design are not manufactured in that state.
 - iv. **Trade names** – protection must be granted to trade names in each contracting state without there being an obligation to file or register the names.

- v. **Indication of sources** – 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.
- vi. **Unfair Competition** – each contracting state must provide for effective protection against unfair competition.

(B) The **Madrid Agreement for the Repression of False or Deceptive Indications of Sources of Goods** of 1891 states that all goods bearing a false or deceptive indication of source by which, one of the contracting states, or place situated therein, is directly or indirectly, indicated as being the place or country of origin, must be seized on importation or such importation must be prohibited.

The agreement provides for the cases and manners in which seizure may be requested or effected. It prohibits the use of any indication which may deceive the public as the source of the goods.

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

The agreement is open to states that are a party to Paris Convention for the protection of industrial property.

(C) 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 product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographic environment including natural and human factors.” – article 2.

Such denominations are registered by International Bureau of WIPO in Geneva upon the request of the competent authority of a contracting state. The International Bureau keeps the international register of appellations of origin and formally notifies the other contracting states of the registration. It also publishes them in the Lisbon system’s official bulletin Appellations of origin.

According to article 5(3) a contracting state may within the time period of one year ensure that it would not be able to provide protection to a registration within its territory with the reason for the refusal of protection.

Article 3 states that a registered appellation will be protected against usurpation or imitation, even when used in translation or accompanied by words such as “type” or “kind” and may not be deemed to have become generic in a contracting state as long as it continues to be protected

in the country of origin.

Since January 2010, contracting have had the option to issue a statement of grant of protection, thus improving the communication regarding the status of international registration in member countries.

The Lisbon agreement concluded in 1958, as revised in Stockholm in 1967 and amended in 1979.

(D) The Agreement on Trade Related Aspect of Intellectual Property provides standard rules of protection of geographical Indications through article 22 to 24 of part II Section III. The agreement defines geographical indication as indications which identify goods as originating in the territory of a member, or a region or locality in that territory, where the quality and reputation are essential to its geographical location (article 22.1).

In respect to all geographical in indications, interested parties must have legal means to prevent the use of geographical indication which misleads the public s to the geographical location of the good, and use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention act. (Article 22.2).

The registration of a trademark which uses a geographical indication in a way that misleads the public about the true place of origin must be invalidated ex officio if the legislation so permits at the interest of a party. (Article 22.3)

According to Article 23 the interested parties must have the legal means to prevent the use of geographical indication identifying wines for wines to originating in the place indicated by geographical indication.

Article 24 provides various exceptions to protections of geographical indications. These exceptions are of particular relevance in cases of wines and spirits. The exceptions cannot be used on protections of geographical indications that existed prior to the entry into TRIPS agreement. The TRIPS council shall keep under review the provisions n the protection of geographical indication.

III. THE INDIAN GEOGRAPHICAL INDICATION ACT

India has put in place a *sui generis* system of protection of Geographical indication. The legislation that deals with the protection of Geographical indication is the “Geographical Indication of goods (Registration and Protection act) act, 1999” (GI act) and the “Geographical Indication of goods (Registration and Protection) act, 2002 (GI rules). India enacted its geographical indication legislation to put the national intellectual property rights of the country

in accordance with India's obligation under the TRIPS agreement. Under the purview of the GI act along with the GI rules, which into effect on 15th of September 2003. The central government has established the Geographical Indications Registry with all-India jurisdiction at Chennai, where right- holders can register their GI.

Unlike TRIPS, the central government has not limited the Geographical Indication act to wines and spirits. It has been left on the discretion of the government to decide which product needs highest level of protection.

The definition of Geographical Indication included in section 1 (3) (e) of the Indian GI act clarifies that for the purpose of this clause, any name which is not the same of a country, region or locality f that country shall also be considered as GI if it related to a specific geographical location and is used in relation to particular goods originating from that country, region or locality. This provision enables the protection to symbols other than geographical names such as "basmati".

Rights of Geographical Indication Holder

The right to prevent the use of geographical indication by some other party whose product does not stand on the given standards. The registration of a GI gives its owner an authorized right to protect it against infringement. Section 20(1) of the GI act states that no person shall be entitled to obtain the rights of infringement against an unregistered GI. The GI is registered for a period of 10 years in India, and it can be renewed from time to time for a period of further 10 more years.

For example- in India the Darjeeling Tea geographical indication is protected, and the GI right holders of Darjeeling tea can exclude the tear "Darjeeling" for tea which is not grown their tea garden and not produce according to the given standards of the geographical indication.

IV. CASE LAW – TEA BOARD OF INDIA VS ITC LTD

(A) Arguments given by Plaintiff

According to the plaintiff, defendant has infringed the registered geographical indication rights having a fraud and malice intention and the rights of the plaintiff are being hampered in this way –

- a) The defendant has fraudulently used the tag of geographical indication in naming ne of its business premise s "Darjeeling Lounge" which is a registered GI.
- b) The defendant having malice intention used the name "Darjeeling" for the presentation and sale of ich it sells in such lounge.

- c) The defendant has disguised his customers by suggesting that the goods which it sells at the said “Darjeeling Lounge” originated in the said geographical location.
- d) The defendant by using the registered GI as hampered the rights of the plaintiff as the defendant misleads the customers by telling that the products are originated from the designated place of origin.
- e) The use of the name “Darjeeling” for the purpose of the publicity and selling of goods has created an unfair competition and the plaintiff can use his right of passing off and other rights for the matter.
- f) The defendant’s use of the name “Darjeeling” for naming the lounge and for the purpose of publicity and selling of goods has created an unfair competition and the plaintiff an use his right of passing off and other rights for that matter.
- g) He defendant by using the impugned name “Darjeeling” for naming the lounge has as threatened the commercial activities of the persons who are actually in the business of Darjeeling tea.
- h) Therefore, the use of the word “Darjeeling” for the purpose of naming the lounge is a serious threat to the trade of existing business of tea and a high disregard to the registered GI tag given to the particular product.
- i) The wrongful act of the defendant of using the word “Darjeeling” and logo is highly misleading to the general public as regards to the nature or manufacturing process, characteristics and suitability of the products in the lounge.

In order to prevent the defendant from violating the rights of the plaintiff moved an interlocutory application for temporary injunction to restrain the defendant from infringing the rights in any possible way.

(B) Arguments by the defendant

According to the defendant there is no cause of action for filing the suit s it was barred by limitation. Since the plaintiff had only certification trademark, no right or cause of action could arise for the plaintiff under such certification trademark against the defendant using “Darjeeling Lounge” in view with the trademark act. As per the defendant the suit is not maintainable under section 26 of the Geographical Indications Act.

(C) Judgement

The hon’ble justice Sahidullah Munshi f Calcutta High Court, opined that the suit by Tea Board was barred by limitation provided under section 26(4) of the Geographical Indications Act

which is for 5 years.

The court went into the merits of the case and justice Munshi observed that – “ It is also not found that there has been any infringement under the Geographical Indications of goods act, because the ‘Lounge’ is not relating to goods. Plaintiff’s right conferred by the registration of the word “Darjeeling” is only in relation to tea. “Darjeeling” is not a trademark. It is only used to indicate geographical indication of the place of origin of tea from Darjeeling. The law related to geographical indication is confined to goods. The plaintiff does not hold the right on the word “Darjeeling” except for the good (tea). The geographical indication act can only extend to goods and admittedly, the defendant’s ‘Lounge’ does not fall in the category of goods.

The hon’ble court further found that there is no unfair competition under the definitions of the Geographical Indications act as the business area of plaintiff and defendant is totally different and among the 87 tea estates none of them had raised this issue. The Board also claimed that its right under the Trademark act,1999 also stood violated because of the term “Darjeeling” for the lounge. However, the court noticed that the Board only had certification trademark within the meaning of section 2(e) of Trademark act, 1999, which does not amount to a registered trademark. The certification trademark gave the board the authority to certify that the concerned tea is from Darjeeling region.

The court stated that there is difference between the defendant’s “DARJEELING LOUNGE” and the plaintiff’s “DARJEELING TEA’s” right under Trademark act or GI act and the allegations are baseless and the court dismissed the suit for Rs. 10 Lakh.

V. CONCLUSION

Every region, place, location, state and country have some qualities that makes it famous, it could be a good tourist spot, could have historical monuments or produce something so special that it could not be found in any other place in the world. Therefore, it becomes essential to protect the goods that are particular to a region to enhance its uniqueness. Geographical indication as the name suggests, indicates the origin of a good. Geographical indication as a tool of differentiation means that the birth place of a product can be used to differentiate it from the various other goods that may have similar qualities. In India, geographical indication is given to – Silk from Mysore, Coorg Orange from Karnataka, Arani Silk from Tamil Nadu, Blue Pottery of Jaipur from Rajasthan, Leather Toys of Indore from Madhya Pradesh to name a few. Therefore, GI protection plays an important role in protecting the distinctiveness of a product produced in a particular region.

VI. REFERENCES

- <https://ipindia.gov.in/gi.htm>
- https://ipindia.gov.in/writereaddata/Portal/IPOAct/1_49_1_gi-act-1999.pdf
- <https://ipindia.gov.in/registered-gls.htm>
- <https://www.mondaq.com/india/trademark/785150/case-study-tea-board-of-india-vs-itc-ltd>
- https://www.wipo.int/geo_indications/en/faq_geographicalindications.html
- <https://legislative.gov.in/sites/default/files/A1999-48.pdf>.
