

Geographical Indications under TRIPS Agreement and Legal Framework in India[†]: Part II

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Part I of the paper, which appeared in the previous issue of this journal, dealt with the basic issues of protection of geographical indications relating to TRIPS Agreement. This paper examines the concept of geographical indications and the law governing passing-off and its application as developed and applied by Indian courts. This paper also explains the statutory concept of geographical indications, goods and indications as defined in the Geographical Indications of Goods (Registration and Protection) Act, 1999 and gives a detailed account of legislative protection of geographical indications in India.

Keyword: Geographical indication, TRIPS Agreement, Passing-off, Legislative protection, Trademark

In 1999 India in compliance to its obligation under the TRIPS Agreement, has enacted the Geographical Indications of Goods (Registration and Protection) Act, 1999 (herein after referred to as the Act) along with the Geographical Indications of Goods (Registration and Protection) Rules, 2002. This new Act came into force with effect from 15 September 2003¹. Prior to this the Indian Judiciary in the absence of any legislation applied the principle of passing-off to protect geographical indications. They have entertained petitions in cases of infringement of geographical indications

that misleads the consumer as to the place of origin or constitute unfair competition. In such cases they have granted relief including grant of injunction restraining the defendant to use such indications. It is, therefore, necessary to refer to definition and the well-settled law governing passing-off action.

Concept of Geographical Indications as Developed and Applied by Indian Courts

In *Imperial Tobacco Co v Registrar, Trade Marks*² the Calcutta High Court

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explained to the following concept of 'geographic term' namely:

"Geographical terms and words in common use designate a locality, a country, or a section of country which cannot be monopolized as trade marks; but a geographical name not used in geographical sense to denote place of origin, but used in an arbitrary or fanciful way to indicate origin or ownership regardless of location, may be sustained as a valid trademark."³

Earlier to the Court observed:

A geographical name according to its ordinary signification is such mark inherently or otherwise incapable of registration subject to minor exceptions

Such territory, region or locality, as the case may be (Emphasis added)."

Law Governing Passing-Off: Approaches of Indian Judiciary

Concept and Scope of 'Passing- Off'

Kerly defines 'passing-off' as:

"an actionable wrong for the defendant to represent, for trading purposes, that his goods are those or that his business is that of the plaintiffs ..."⁴

Essentials of 'Passing-Off'

The House of Lords in *Erven Wrnink B V v Townend & Sons*⁵ had an occasion to explain the essentials of the cause of action for passing-off. Lord Diplock relied up the Halsbury's Laws of England, 4th edn Vol 48 para 144 at p 98 and ruled that the plaintiff must prove each of the following of five essentials in an action for passing-off:

- (i) a misrepresentation,
- (ii) made by a trader in the course of trade,
- (iii) to prospective customers of his or ultimate consumers of goods or services supplied by him,
- (iv) which is calculated to injure the business or goodwill of another trader, in the sense that this is a reasonably foreseeable consequence, and
- (v) Which causes actual damage to a business or goodwill of the trader by whom the action is brought.

Lord FASTER in the above case also formulated following five different elements for the actions of passing off which must be established:

- (i) plaintiff's business consists of, or includes, selling in England a class of goods to which the particular trade name applies,
- (ii) the class of goods is clearly defined, and that in the minds of the public, or a section of the public, in England, the trade name distinguishes that class from other similar goods,
- (iii) because of the reputation of the goods, there is goodwill attached to the name,
- (iv) the plaintiff, as a member of the class of those who sell the goods, is the owner of goodwill in England, which is of substantial value, and
- (v) the plaintiff, has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the

defendants selling goods, which are falsely described by the trade name to which the goodwill is attached.

In *Reckitt and Colman Products Ltd v Borden Inc*⁶ (the *Jif Lemon* case) Lord Oliver reduced the aforesaid five essentials elements evolved by Lord Diplock to three namely:

- (i) the existence of plaintiff's goodwill,
- (ii) a misrepresentation as to the goods or services offered by the defendant, and
- (iii) damage (or likely damage) to plaintiff's goodwill as a result of the defendant's misrepresentation.

The aforesaid view was reiterated in a number of decided cases.

In *Consorto de Proscuitto di Parma v Marks and Spencer*,⁷ Nourse LJ, also identified the ingredients of a passing off action as being comprised of three, namely:

- (i) The good will of the plaintiff;
- (ii) The misrepresentation made by the defendant; and
- (iii) Consequential damage.

The courts in India have also applied the above line of view. Thus in *Ellora Industries v Banarsi Dass*, the Delhi High Court had an opportunity to deal with the concept and scope of 'passing off' action. In paragraph 35 of his judgment, the court observed that the purchasers were likely to be misled into thinking that the defendant's firm had an intimate connection with the plaintiffs and even

misrepresentation of some connection with the plaintiffs was sufficient to constitute the tort of unfair trading now forming part of the law of passing-off.

Application of Passing-Off by Indian Courts

A survey of decided cases reveals that Indian courts have maintained the action of passing-off to protect geographical indications. *Scotch Whisky Association v Pravara Sakhar Shakar Karkhana Ltd*⁸ is a leading case on this subject. In this case the plaintiff, the Scotch Whisky Association, a company incorporated under the Companies Act of the United Kingdom instituted the passing-off action against the defendants; a manufacturer of various brands of Indian whisky known as 'Blended Scotch whiskey' or 'Blended with Scotch', under various brands, namely 'Drun Beater' and 'God Tycoon.' On these facts the Bombay High Court held:

- (i) The plaintiffs have sufficient interest and *locus standi* to prevent passing-off of Indian whisky manufactured by defendant as 'Scotch whisky' and to prevent damage to reputation and goodwill of Scotch whisky.
- (ii) The plaintiffs have made out a strong *prima facie* case that the defendants are passing-off their goods as Blended Scotch whisky or goods closely and substantially associated with Blended Scotch whisky when in fact they are not. The plaintiffs have, therefore, made out a case for grant of an interim injunction on merits of the case.

- (iii) The defendants are deliberately and intentionally passing-off their product as if 'Blended Scotch' although as a matter of law, even unintentional misrepresentation is also actionable. It is unfortunate that the defendants have resorted to unfair device by using the words 'Blended with Scotch' and indulged in colourable imitation and unfair trading in an attempt to reap harvest by appropriation of plaintiff's goodwill in Scotch whisky trade. The attempt of the defendants to justify the use of the words 'Blended with Scotch' has totally failed. The balance of convenience is in favour of the plaintiffs and not in favour of the defendants.
- (iv) The defendant is restrained from advertising or offering for sale or distributing in any country whisky which is not Scotch whisky with the description 'Blended with Scotch whisky' or 'Blended Scotch whisky' or 'Blended with six year old Scotch' or 'Blended with six year old Vatted Malt Scotch' or the word 'Scotch' or the impugned labels or the impugned carton which bear the mark 'Gold Tycoon' containing the word 'Scotch' or the description 'Blended Scotch whisky' or 'Blended with six year'.

From the aforesaid decision it is evident that the judiciary in India is affording adequate protection to geographical indications even the absence of any legislation in force. It is significant to note that such protection was afforded

much before the TRIPS Agreement came into force.

Geographical Name—It Can be Used as Trademark

Can geographical name, without any relevance to the trade be registered as a trademark? This issue was raised in *Imperia Tobacco Co. of India Ltd v Registrar of Trade Marks Another*.⁹ In this case, the Imperia Tobacco Company of India Ltd applied to the Registrar of Trade Marks for registration. The trademark for registration is a label, used as wrapper of packets of cigarettes bearing the device of snow clad hills in outline with the word 'Simla' written prominently in various panels of the label with small inscription that the content is a product of the appellant company. The Registrar rejected the application for registration. Thereupon the company filed an appeal before the Calcutta High Court. The Calcutta High Court while disallowing the appeal laid down the following principles:

- (i) The mark 'Simla' is a geographical name and the snow-clad hills in outline in the mark indicates its use in ordinary or geographical signification, so that the mark is neither a fancy or invented word nor one with a secondary meaning. As has been observed in Karly's Treatise (10th edition).
 "8.51. A word is not debarred from registration under section 9(1)(e) as a distinctive word merely because it is geographical and so cannot be registered under section 9(1)(d).

Some geographical names can be inherently adapted to distinguish the goods of particular traders, but only if it can be predicated that they are such names as it would never occur to any other trader in such goods to use. At the other extreme, the name of a major industrial area or city will be totally unregistrable in respect of almost any goods. In between come the marks calling for more or less evidence that they are distinctive in fact... It may tip the balance that the applicant can show that he has a natural or legal monopoly of the production of goods concerned in the place concerned; but that alone will not make a geographical name registrable without substantial evidence of distinctiveness."

- (ii) No trademark should be allowed to be registered which may hamper or embarrass the traders or trade now or in future in respect of the place or country which is proposed to be registered.

In view of the imprint of snow clad hills in outline in the trademark 'Simla' the ordinary or geographical signification is obvious and patent even though it has no reference to the quality or place of origin of the goods ... Further, registration of such trademark may hamper or embarrass the trade or traders in or around the locality in future as held by judicial authorities cited earlier in similar cases. Also 'Simla' is too prominent a city, the capital of Himachal Pradesh, well-known in the country and abroad and in its ordinary or geographical

significance it is inherently neither distinctive nor adapted to distinguishing the goods of the appellant as a particular trader from those of others, and is also hit by the provisions of Section 9 sub section (1), cl. (d) of the Trade and Merchandise Marks Act, 1958.

Remedies

The Court may grant the following civil remedies for infringement or passing-off.

- i. injunction;
- ii. damages;
- iii. account of profit.

Injunction

The order of injunction may include; (i) an *ex parte* injunction; or (ii) any *interlocutory* order for any of the following matters, namely:

- a. for discovery of documents;
- b. preserving or 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.

Interlocutory Injunction

It is well settled law that in granting or not granting an interim injunction, three factors have to be kept in view, namely; (i) the establishment of a *prima facie* case, (ii) the balance of convenience

between the parties, and (iii) whether if the interim injunction is not issued, it will cause, irreparable injury to the applicant.¹⁰

In India, courts have held in a series of cases that an interlocutory injunction will not generally be granted (i) where damages will provide an adequate remedy; (ii) unless there is a real probability of the plaintiff succeeding on the trial of the suit.

Final Injunction

The plaintiff will normally be entitled to a permanent injunction to restrain future infringements, if he succeeds at the trial in establishing infringement of geographical indications.

Damages

The court may grant nominal damage.

Account of Profit

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 indications complained of in the suit he was unaware and had no reasonable ground for believing that the geographical indications 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 indications, he

forthwith ceased to use the geographical indications in relation to goods in respect of which it was registered;

- (b) where in a suit for passing-off, the defendant satisfies the court:
 - (i) that at the time he commenced to use the geographical indications complained of in the suit he was unaware and had no reasonable ground for believing that the geographical indications relating to the plaintiff was in use; and
 - (ii) That when he became aware of the existence and nature of the geographical indications relating to the plaintiff he forthwith ceased to use the geographical indications complained of.

Legislative Protection of Geographical Indications

Prior to 1999, there was no specific legislation to regulate geographical indication. As mentioned earlier, it was in the year 1999 that India in compliance with its obligation under TRIPS Agreement enacted the Geographical Indications of Goods (Registration and Protection) Act, 1999. This Act seeks to provide for registration and better protection geographical indications relating to goods. It excludes unauthorized persons from misusing geographical indications. This would protect the interest of producers, manufacturers and thereby consumer from being deceived by the falsity of geographical origin to economic

prosperity of the producer of such goods and promote goods bearing geographical indications in export market. Unless a geographical indication is protected in the country of its origin, there is no obligation under the agreement under Article 22 of the TRIPS Agreement on for other countries to extend reciprocal protection. It is in this context that the Act was enacted.¹¹

The Act has been divided into nine chapters. Chapter I is preliminary which, *inter alia*, defines various terms used in the Act. Chapter II deals with the appointment, powers and establishment of Registry. It also provides for registration in respect to particular goods and areas and prohibition of registration. Chapter III deals with procedure and duration of registration. Chapter IV describes the effect of registration, Chapter V contains special provision relating to trademark and prior user. Chapter VI provides for rectification and correction of the Register. Chapter VI relates to appeals and Appellate Board. Chapter VII prescribes penalties and procedure. The last, i.e. Chapter IX is miscellaneous.

Statutory Definition of Geographical Indications

Section 2(e) of the Act defines 'geographical indications' in relation to goods to mean:

"An indication which identifies such goods as agricultural goods, natural goods or manufactured goods as originating, or manufactured in the territory of 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. For the purpose of the aforesaid, any name, which is not the name of country, region or locality of that country, shall also be considered as the geographical indications 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".

Concept of Goods

The Act¹² also defines 'goods' to mean any:

- (i) Agricultural goods
- (ii) Natural goods
- (iii) Manufacturing goods
- (iv) Goods of handicraft and foodstuff.

The above definition is not exhaustive but merely illustrative. It would not be out of place to mention that while the TRIPS Agreement refers to 'goods' the Indian Act classifies such 'goods'.

Meaning of Indications

The word 'indications' has also been defined¹³ to include:

- (i) any name (including abbreviation of a name);¹⁴
- (ii) geographical or figurative representation; or
- (iii) any combination or suggest the geographical origin or goods to which it applies.

A perusal of above definitions reveals that India has not only adopted the words used in TRIPS Agreement but provides a broader definition of 'geographical indications'. Further, 'goods' unlike TRIPS Agreement have been delineated. Indeed the Act separately defines the term 'indications'. Another significant feature is that the under the Act broad meaning has been given to the term 'goods'.

Procedure of Registration

Who can apply for registration?

- (i) any association of persons;
- (ii) producers; or
- (iii) any organization or authority established by or under any law representing the interest of the producers of the concerned goods.¹⁵

Whom to apply?

The application must be made to the Registrar. Under the Act, the Controller-General of Patents, Designs and Trade Marks appointed under sub-section (1) of section 3 of the Trade Marks Act, 1999 shall necessarily be the Registrar of Geographical Indications. He shall be assisted by such number of officer, which the Central Government may think fit.¹⁶

Where to file the application?

Every application shall be filed in the office of the Geographical Indications Registry within whose territorial limits, the territory of the country or the region or locality in the country to which the geographical indications relates is situated. Under section 5 there shall be established a Registry, which shall be known as Geographical Indications

Registry. The Head Office of the Geographical Indications Registry shall be at the place specified by the Central Government by notification.¹⁷ However, 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 limit the place mentioned in the address for services in India as disclosed in the application, is situated.¹⁸

Form and Manner of Application

The persons specified above who are desirous of registering a geographical indications in relation to such goods shall apply in writing to the Registrar in the prescribed form and manner and accompanied by such fees as may be prescribed for the registration of the geographical indications. A single application for registration of geographical indications in different classes goods can also be made.¹⁹

Contents of the Application

Every application for registration must contain:

- (a) a statement as to how the geographical indications 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 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;
- (b) the class of goods to which the geographical indications shall apply;
 - (c) the geographical map of the of the country, region or locality in the country in which the goods originate or are being manufactured;
 - (d) the particulars regarding the appearance of the geographical indications as to whether it is comprised of the words or figurative elements or both;
 - (e) a statement containing such particulars of the producers of the concerned good, if any, proposed to be initially registered with the registration of the geographical indications as may be prescribed; and
 - (f) such other particulars as may be prescribed.²⁰
- (i) the use of which is likely to deceive or cause confusion, or
 - (ii) the use of which would be contrary to any law for the time being in force, or
 - (iii) which comprises or contains scandalous or obscene matter, or
 - (iv) which comprises or contains any matter likely to hurt the religious feeling of any class or section of citizens of India, or
 - (v) which would otherwise be disentitled to protection in a court, or
 - (vi) which are determined to be generic names or indications of goods and are, therefore, not or ceased to be protected in the country of origin or which have fallen into disuse in that country, or
 - (vii) 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.

What goods and area can be registered?

Section 8 provides that a geographical indication may be registered in respect of:

- (i) any or all of the goods, comprised in such class of goods as may be classified by the Registrar, and
- (ii) definite territory of a country, or
- (iii) definite region in the territory, or
- (iv) definite locality in the territory.

Prohibition of Registration of Certain Geographical Indications

Section 9 prohibits the registration of geographical indications:

Duty of Registrar on Receipt of Application

- (i) On receipt of application the Registrar shall examine such application in the prescribed manner. He may refuse the application or may accept it absolutely or subject to such amendments, modification, conditions or limitations, if any, as he thinks fit. However, the case of refusal or conditional acceptance of application, he shall record in writing the grounds for such refusal

or conditional acceptance and the materials used by him in arriving at his decision.

- (ii) The Registrar shall classify the goods under sub-section (1) of section 8 as far as may be, in accordance with the international classification of goods for the purposes of registration of geographical indications.
- (iii) The Registrar may publish in the prescribed manner an alphabetical index of classification of goods referred to in sub-section (2)
- (iv) If any question arises 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) it shall be determined by the Registrar whose decision in the matter shall be final.

Withdrawal of Acceptance

Section 12 provides for withdrawal of acceptance of registration of geographical indications if:

- (a) the application has been accepted in error, or
- (b) 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.

In the aforesaid situation the Registrar may after hearing the applicants if he so desires, withdraw the acceptance and proceeds as if the application had not been accepted.

Advertisement of Application

Section 13 provides:

- (i) Where 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 condition or limitations, if any, subject to which it has been accepted, to be advertised in prescribed manner.
- (ii) 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 at in his discretion cause the application to be advertised again or instead of causing the application to be advertised again, notified in the prescribed manner, the correction made in the application.

Opposition of Application

Section 14 permits any person to oppose the application of registration. But such opposition must be made: (i) within 3 months from the date of advertisement

or re-advertisement of an application for registration; (ii) it should be in the prescribed form, prescribed manner and on payment of prescribed fee, and (iii) it should be addressed to the Registrar.

Correction and Amendment

Section 5 empowers the Registrar to carry out correction of any error and amendments in an application whether before or after acceptance, if any errors are found in the application.

Certification of Registration

Section 16 provides that:

- (a) When an application for registration of a geographical indication has been accepted and either (i) the application has not been opposed and the time for notice of opposition has expired; or (ii) the application has been opposed and the opposition has been decided in favour of the applicant, the Registrar shall register the said geographical indication and the authorized users, if any, mentioned in the application and the geographical indication.
- (b) On the registration of a geographical indication, the Registrar is required to the applicant and the authorized users along with a certificate of the registration in the prescribed along with the seal of the Geographical Indications Registry.
- (c) 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, treat the application as abandoned.

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

Duration, Renewal, Removal and Restoration of Registration

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

Registration

After the Registrar accepts an application for registration the geographical indications will be registered. Registration is a *prima facie* evidence of the validity of the geographical indications.

Effect of Registration

Unregistered Geographical Indications

No person shall be entitled to institute any proceeding to prevent or recover damages for the infringement of unregistered geographical indications. Further nothing in this Act shall be deemed to affect the right of action against any person for passing-off goods as the goods of another person.²¹

Rights Conferred by Registration

A registration of geographical indications shall, if valid, give to the registered proprietor and all authorized user whose name has been entered in the register, the right to obtain relief in respect of infringement of the

geographical indications. However, authorized users alone shall have the exclusive right to the use of the geographical indications in relation to the goods in respect of which the geographical indications is registered. This right is subject to the conditions and limitations to which the registration is subject. Two or more authorized users of a registered geographical indication shall have co-equal rights.²²

Special Provisions Relating to Trademarks and Prior Users

The registration of a trade mark may be refused or invalidated which: (a) contains or consists of a geographical indications 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 indications indicates, if use of such geographical indications in the trademark 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 indications identifying goods or class or classes of goods notified under sub-section (2) of section 22. Protection of certain trademarks.²³ The Act seeks to protect any trademark granted prior to the commencement of the Act. It says that any trademark granted and subsisting before the commencement of the Act shall not be invalidated.

Infringement or Registered Geographical Indications

A registered geographical indications is infringed by a person who, not being an

authorized user thereof, (i) uses such geographical indications by any means in the designation or presentation of goods that indicates or suggests that such goods originate in some other geographical area other than the true place of origin of the goods in a manner which misleads the public, or (ii) uses any geographical indications in such manner which constitutes an act of unfair competition including passing-off in respect of registered geographical indications, or (iii) uses another geographical indications to the goods which, although literally true as to the territory, region or locality in which the goods originate, falsely represent to the public that the goods originate in the region, territory or locality in respect of which such registered geographical indications relate.²⁴

Prohibition of Assignment or Transmission, etc.

Under section 24 any right to a registered geographical indication shall not be the subject matter of assignment, transmission, licensing, pledge, mortgage or any such other agreement.

Additional Protection of Certain Goods

The Central Government may by notification in the Official Gazette provide for additional protection for certain goods or classes of goods, which are notified. A geographical indications once lawfully acquired further dealing in such goods shall not constitute an infringement unless the goods are impaired after they have been put in the market.

Rectification and Correction of the Register

The Registrar or the Appellate Board may cancel or vary the registration of geographical indications or of an authorized user for the contravention or failure to observe the conditions entered on the Register. It enable any persons aggrieved by the absence or omission of any entry in the register without sufficient cause or any entry wrongly remaining on the register by any error or defect, to apply to the Appellate Board or the Registrar to pass appropriate orders. The Registrar and the Appellate Board are also empowered to *suo moto* after giving notice to the parties concerned and hearing them to pass appropriate orders canceling, varying or rectifying the register.²⁵

Appeals to the Appellate Board

Any person aggrieved by an order or decision of the Registrar under this Act, or the rules made there under, may file an appeal to the Appellate Board. Such appeal must be filed within three months from the date on which the order or decision is communicated to the aggrieved parties.²⁶

Enforcement of Geographical Indications of Goods

The remedies available for protection of geographical indications may broadly be classified into two categories:

- (i) Criminal remedies
- (ii) Civil remedies

Criminal Remedies

The Geographical Indications of Goods (Registration and Protection) Act, 1999 contains penal provision for violation of

various provisions relating to geographical indications given below:

- (i) Falsifying and falsely applying geographical indications to goods.²⁷
- (ii) Selling goods to which false geographical indications is applied.²⁸
- (iii) Falsely representing a geographical indication as registered.²⁹
- (iv) Improperly describing a place of business as connected with the geographical indications registry.
- (v) Falsification of entries in the register.

The punishment prescribed for the aforesaid offences varies from six months to three years imprisonment and a fine of not less than Rupees fifty thousand but may extend to Rupees two lakh. However, the court for adequate and special reasons in writing may impose lesser punishment

The Act³⁰ also prescribes for enhanced penalty for second or subsequent conviction. The term of imprisonment in such cases shall not be less than one year but it may extend up to three years and fine of not less than one lakh rupees which may extend up to two lakh rupees. The discretion is vested with the courts to impose a lesser punishment than the minimum punishment after recording in the judgment adequate and special reasons for awarding such lesser punishment. No cognizance would be taken of any conviction made before the commencement of this Act. The offence under the Act is cognizable.

Forfeiture of Goods

The Act³¹ empowers the Court to direct the forfeiture to Government of all the goods and things by means of or in relation to which certain offences mentioned therein have been committed. The court may either order for the forfeited goods to be destroyed or otherwise disposed of.

Search and Seizure

The Act empowers the Deputy Superintendent of Police to take cognizance of geographical indications offences and may search and seize things and articles involved therein

Civil Remedies

The suit for infringement has to be filed in court not inferior to that of a district court having jurisdiction. In any suit for infringement of geographical indications the defendant pleads that registration of the geographical indications relating to plaintiff is invalid, the court trying the suit shall:

- (i) if any proceedings for rectification of the register to the geographical indications relating to plaintiff or defendant are pending before the Registrar or the Appellate Board, stay the suit pending the final disposal of such proceedings;
- (ii) if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the geographical indications relating to plaintiff or defendant is *prima facie* tenable, raise an issue regarding the same

and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the Appellate Board for rectification of the register.³²

Conclusions

The aforesaid discussion leads us to the following conclusions:

The Indian Judiciary has played a significant role particularly in the absence of any enforced legislation to protect geographical indications. It has applied the common law principle of passing-off as suited under Indian conditions in cases of geographical indications. The courts have granted injunction restraining the defendants from advertising and offering for sale or distribution in any country goods (including wines and spirits) where they indulge in colourable imitation and unfair trading to reap harvest by exploiting the goodwill of any goods or products which is essentially attributable to specific geographical area and is used in relation to particular goods originating from any country, region or locality, as the case may be. Thus the Indian courts are giving effect to Articles 22 and 23 of the TRIPS Agreement even before it came into existence.

India in compliance to its obligation under the TRIPS Agreement has also taken legislative measure by enacting the Geographical Indications of Goods (Registration and Protection) Act, 1999 along with the Geographical Indications of Goods (Registration and Protection) Rules, 2002. This Act would go a long way to protect geographical indications

and provide a model for other countries to follow. Indeed this is a step forward to the TRIPS Agreement.

Notes and References

- 1 See Gazette of India, Extra, Part II, Section 3(ii), dated 15th September 2003, p2, No 834
- 2 AIR 1977 Cal 413
- 3 *Id* at 422
- 4 See Kerly, *Law of Trade Marks and Trade Names* (12th ed) para 1602
- 5 1970 RPC 31
- 6 (1990) 1 All ER 873
- 7 (1991) RPC 351
- 8 AIR 1992 Bom 294
- 9 AIR 1997 Cal 413
- 10 Sec 37, Specific Relief Act, 1963
- 11 See Statement of Objects and Reasons of the Bill
- 12 Section 2(f)
- 13 Section 2(g)
- 14 Section 2(h)
- 15 Section 11(1)
- 16 *Ibid*
- 17 In exercise of the powers conferred by Section 5 of the Geographical Indications of Goods (Registration and Protection) Act, 1999 (48 of 1999), the Central Government hereby establishes the Geographical Indications Registry with all India jurisdiction at Chennai and also specifies Chennai as the place of its head office at 434, Guna Complex, Tey nampet, Annasalai, Chennai – 600 018. [See Gazette of India, Extra., Part II Section 3(ii), dated 15th September, 2003 p 2, NO 834.]
- 18 Section 11(4)
- 19 Section 11(3)
- 20 Section 11(2)
- 21 Section 20
- 22 Section 21
- 23 Section 25
- 24 Section 31
- 25 Section 22
- 26 Sections 27, 28 and 29
- 27 Sections 38 and 39
- 28 Section 40
- 29 Section 42
- 30 Section 41
- 31 Section 46
- 32 Sections 57 and 66