

Intellectual Property Magazine

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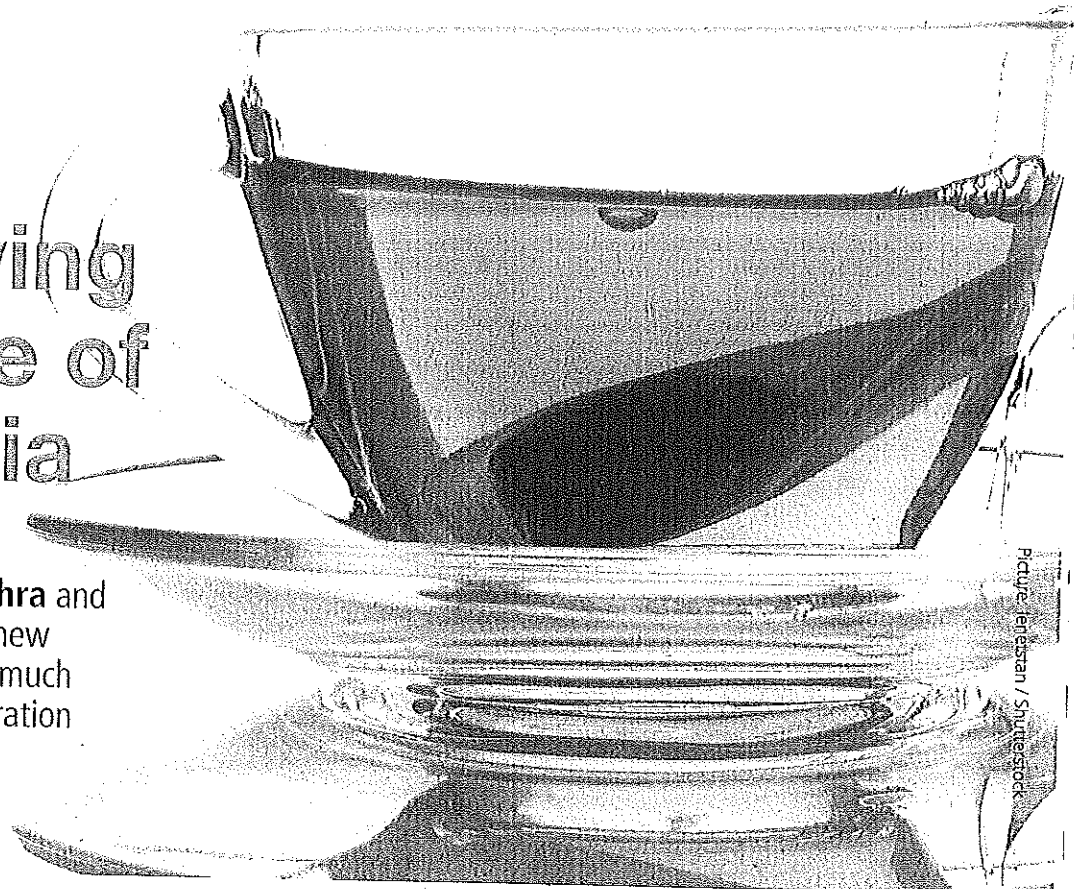
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The evolving landscape of GIs in India



Remfry & Sagar's **Devika Mehra** and **Devika Bahadur** describe a new manual intended to provide a much needed road map on GI registration in India

Geographical Indications (GIs) are a unique type of intellectual property that give legal and institutional recognition to the crucial role often played by natural factors and/or human skill in shaping the qualities of certain products. GIs are evolving rapidly in India and are taking a shape and form distinct to India's rich and varied heritage. Nearly eight years into a hitherto unexplored form of intellectual property, the fledgling Indian GI machinery is finding its feet and has released a new manual to facilitate smooth and quick GI registrations.

In compliance of its obligations under the TRIPS Agreement, India enacted a *sui generis* legislation for protection of GIs in India – the Geographical Indications of Goods (Registration and Protection) Act, 1999¹ accompanied by the Geographical Indications of Goods (Registration and Protection) Rules, 2002², which came into force on 15 September 2003. The rationale for GI protection, much like trademarks, is twofold – protection of interests of producers so as to prevent unscrupulous competitors from free-riding on their reputation, and protection of consumers from misleading use of GIs by unauthorised persons. The Indian legislation

has also been enacted with the additional objective of promoting goods bearing Indian GIs in the export market.

GI jurisprudence and practice has evolved in the West largely in the context of wines and foodstuffs having unique geographically-imparted qualities. However, given India's diverse historical and cultural influences, a majority of GIs have been keenly adopted as a means of protecting traditional handicrafts, textiles and manufactured goods. A quick glance at the numbers released by the GI Registry show that out of 156 total GIs registered to date³, a whopping 115 are for handicrafts (including textiles), foodstuffs and manufactured goods, while only 41 are for agricultural products.

Another circumstance that had motivated the Indian government to enact GI legislation was its experience with protecting 'Basmati rice' in the face of the US 'Texmati' patent, and the menace of teas from Kenya and Sri Lanka being passed off as "Darjeeling Tea". In fact, it was the Tea Board of India which registered the first two GIs in India – the word Darjeeling and the now well-recognised logo of a woman holding two tea leaves and a bud in a roundel with the name 'Darjeeling' displayed on top.

Recently, these GIs became the subject of India's first GI suit before the Calcutta High

Court. The judgment is a significant landmark in Indian GI jurisprudence as it is the first to define the boundaries of GI protection in India. The Division Bench upheld the order passed by the single judge, which limited the rights of the GI holder specifically to the goods the GI was registered for and refused to extend protection across unrelated goods and services. Thus, a 'Darjeeling Lounge' at a five-star hotel in Kolkata, ITC Sonar Bangla, was held to not violate the Tea Board's registration of the 'Darjeeling' GI for tea. Significantly, the court did not uphold a passing off plea either, in the absence of a clear 'nexus' between the impugned activities and the specific goods covered under the GI. The court clearly said that the word 'Darjeeling' cannot be claimed exclusively by the Tea Board, given how ubiquitous the word is in India. Interestingly, the Tea Board seems to have had greater success in protecting their GI in jurisdictions other than India.

In one of its most successful defences of the Darjeeling GI worldwide, the Tea Board won an appeal at the Court of Appeals in Paris⁴, nullifying a trademark registration in the name of one Jean-Luc Dusong for the name 'Darjeeling.' In sharp contrast to the stance taken by the Indian court, which

denied cross-category enforcement of GI rights, the Parisian court extended protection to the Indian GI across wholly different goods and services – books, journals, artwork, engraving, exhibitions, distribution, communication and consultancy. The Paris Court of Appeals specifically sought to restrain the impugned mark from free-riding on the 'attractive power stemming from the international reputation' of Darjeeling tea. The Calcutta High Court, on the other hand insisted on a tangible 'nexus' between the allegedly infringing activities and the specific goods covered by the GI, reflecting a more cautious and stringent approach to the issue of dilution.

The Trade Mark Trial and Appeal Board in the US also rejected an application for registration of a trademark application for 'Darjeeling Noveau' by the Republic of Tea Inc⁵ in Class 30. Here, the Board rejected the contention of the Republic of Tea that the word 'Darjeeling' had become generic and was no longer associated with teas emanating from the Darjeeling region in particular. It is interesting that the Indian court cited the same ubiquity of the name 'Darjeeling' to deny the Tea Board exclusive use of the mark.

The manual

The practice of the GI Registry has been evolving over the last decade, with GI filings growing at a steady pace. As per figures provided by the GI Registry⁶, since its inception, 233 GI applications have been filed for registration and 156 GIs have been registered. The labyrinth of procedure is often confusing even for legal practitioners to navigate, more so in the terrain of geographical indications, a field relatively unfamiliar to most intellectual property lawyers and prospective applicants in India. The new Manual of Geographical Indications (Practice and Procedure) published by the Office of Controller General of Patents, Designs and Trade Marks provides the much-needed roadmap.

Comments were invited on a draft manual published by the Office of Controller General of Patents, Designs and Trade Marks on 31 March 2011. Incorporating recommendations made by various stakeholders, the final Manual of Geographical Indications (Practice and Procedure) was released on 25 July 2011. Largely replicating provisions from the GI Act and accompanying rules, along with clarifying comments, the manual seeks to act as a practical guide to prospective applicants and GI practitioners to enable speedy prosecution of GI applications. The manual, however, is just a guide and does not have the force of law. It will be revised from time to time based

on interpretations by the courts, statutory amendments and inputs from stakeholders.

In the preface to the manual, P. H. Kurian, the then Controller General of Patents, Designs and Trade Marks, notes that GI applications have been filed in varying conformity with the provisions of the Act and rules. This has resulted in voluminous applications and duplication of information and documentation. Varying interpretation of procedural requirements is also leading to preliminary formal objections being raised causing delay in registration. In light of such problems, the new manual is a significant step towards providing greater clarity and consistency in the system of GI registration.

One of the most significant elements of the new manual in terms of standardising application procedures is the section which outlines the contents of a GI application in a simplified, systematic and streamlined manner. In particular, the manual envisages all necessary documentation to be furnished as annexes to the Application Form or the Statement of Case. This, it is hoped, will go a long way in dealing with the problems of duplication of information and voluminous documentation.

The GI Act provides for both, ordinary and convention applications. The manual clarifies that a convention application may be made for registration of a GI from a convention country, along with proof of registration/filing of the GI in the home country. Ordinary applications may be made for registration of Indian GIs.

The manual also plugs a gap in the existing rules by detailing the constitution and functioning of the consultative group, which is entrusted with examining a GI application. The group is to be chaired by the Registrar of GIs while the remaining members are to be drawn from any organisation, authority or persons well-versed in the law of geographical indications. The manual provides for a detailed presentation to be made by the applicant before the consultative group, and empowers the consultative group to recommend amendments or even visit the production area for their purpose. The observations/comments of the group are taken into account by the Registrar in issuing an examination report pertaining to the application. In outlining the scope of operation of the consultative group, the manual provides the GI registration process with a higher level of systematisation.

Given its rich cultural heritage and varied historical influences, India has a profusion of local traditions embodied in handicrafts, textiles and agri-foods, and the Indian GI Act has established an institutional machinery

for their registration and protection. After a sluggish start, GI applications in India are picking up. Interestingly, even a cursory look at GI figures shows that 48% of total GIs registered in India come from just four out of 28 Indian states⁷. It is apparent that the potential for GI applications from the rest of the country has been barely tapped. The manual has therefore, come at a perfect time; not only to provide a fillip to GI applications, but also to help evolve an efficient and systematic institutional structure, which will be prepared to handle the spate of GI applications that are sure to proliferate in the months to come.

Footnotes

1. Hereinafter referred to as the 'Indian GI Act' or 'the Act'.
2. Hereinafter referred to as the 'Indian GI Rules' or 'the Rules'.
3. As of 1 October 2011.
4. *Tea Board of India v Jean-Luc Dusong*, Case No 05/20050 <http://www.lawoftea.com/files/arr_t_dusong.pdf> (Paris Court of Appeal, 22 November 2006).
5. *Tea Board of India v Republic of Tea, Inc*, 80 USPQ2d 1881 <<http://www.uspto.gov/web/offices/com/sol/foia/ttab/2/dissues/2006/91118587.pdf>> (TTAB January 2006).
6. As of 1 October 2011.
7. 75 out of 156 registered GIs come from the four southern states of Andhra Pradesh, Karnataka, Kerala and Tamil Nadu as of 1 October 2011.

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