

Geographical names are no different from other marks if secondary meaning established



The issue that arose for consideration before the High Court of Delhi in this case was whether the adoption by the defendant of the mark 'BIKANER' in respect of its snacks and sweets was in violation of the plaintiff's mark 'BIKANERWALA' in respect of identical goods. 'Bikaner' is a place in the State of Rajasthan in India. 'BIKANERVALA', loosely translated, means, 'the one from Bikaner'.

The plaintiff's case was that it had been in the business of manufacturing and marketing ethnic foods including sweets and snacks for over the last 100 years. In the year 1981, it coined the trade mark "BIKANERVALA" and in 1992 an artistic label was created along with the said mark and had been in use since then. It claimed that due to the high quality products sold by the plaintiff following international standards of hygiene and freshness and due to the employment of highly advanced manufacturing plants and fully automated processing units and high quality in-house packaging, it enjoyed an unparalleled reputation amongst the public. In or around 2004, the plaintiff came across the adoption by the defendant of the mark "BIKANER" along with a similar label which imitated the script and artistic font of the plaintiff's mark.

A suit was filed against the defendant and an ex-parte order was passed on April 2009. While confirming the ex-parte order, the Court observed that while the fact that the defendant's mark consisted of a geographical name did seem to dilute the allegation of infringement, the plaintiff had been able to show that it had coined and adopted the mark in question for more than twenty years and had been using the same in respect of marketing its goods with a large turnover which testified its reputation. Court, therefore, held that if a plaintiff established that a geographical name mark had acquired a vital degree of secondary significance in relation to its products and services, then it would be protected.