

(Published in the GNLIU Law Review Volume 1, Issue 1 August 2008)

FITTING A SQUARE PEG IN A ROUND HOLE: CAN TRADEMARKS PROTECT GEOGRAPHICAL INDICATIONS?

Geographical indications: Unfamiliar entrant in the familiar territory of brands?

We live in an era where national markets are increasingly beginning to acquire an international semblance with products from every nook and corner of the world occupying our supermarket shelves, a phenomenon caused by rapidly shrinking international trade barriers, thanks to the World Trade Organization (WTO). For consumers, while there is a wide choice and variety, there is also a great risk of deception as to quality and other characteristics professed by the brand under which a product is sold. It is not unusual that consumers often miss or skip the fine print that attempts to project the truth about the product, albeit in a diminutive manner. Part of the job of a trademark lawyer lies in this minefield of consumer innocence, because one of the basic premises upon which brand or trademark protection is based is that the consumer has a right not to be deceived as to origin, source or quality of the product purchased.

Hence it becomes essential for any crusader of brands to be able to discern the various brands, their functions, the nature of rights associated with them, the kind of ownership etc. For example, while JOHNNIE WALKER BLACK LABEL can be registered as a trademark, SCOTCH WHISKY, the product sold under the said brand may not be; or while MONTE CARLO is a well-known trademark for wool products, WOOLMARK is a mark certifying the quality and quantity of the wool used in a particular wool product. In other words, the functions of JOHNNIE WALKER BLACK LABEL, MONTE CARLO, WOOLMARK and SCOTCH WHISKY for the respective products are different and one cannot substitute for the function of another. JOHNNIE WALKER BLACK LABEL and MONTE CARLO are trademarks for Scotch whisky and wool products respectively and signify their respective sources or proprietors; WOOLMARK is a certification trademark certifying the quantity and quality of wool in a particular product; and SCOTCH WHISKY is a geographical indication for a fine whisky originating only in Scotland. Hence, while trademarks, certification trademarks and geographical indications are all brands having identifying functions in the general sense, trademarks identify the source of products, certification trademarks certify certain characteristics and qualities of the product from those which are not so certified by the proprietor and geographical indications identify a product to originate from a certain geographical region and also possess

certain characteristics, qualities and reputation essentially attributable to that geographical region.

Having looked at the differing functions of these three concepts, it would be oversimplifying things, if not being naïve, to believe that trademark law can protect all the three concepts. This paper is provoked by the lack of uniform approach towards protection of geographical indications and the international approach to its protection through trademark law. Three recent judicial pronouncements from France, Switzerland and the USA by three different judicial bodies, concerning the rights in 'DARJEELING', a famous geographical indication from India, are examined to discuss the issues raised by such lack of uniform approach.

Trademarks and geographical indications: How far they are similar?

Geographical indications and trademarks are both brands in the larger sense of the term¹. For the same reason, geographical indications are often confused with trademarks. These two concepts differ from each other in many respects. While

¹ Some of the definitions of 'brand' as defined by Webster's Third New International Dictionary of the English Language, 1993 Edition, Published by Merriam Webster Incorporated are as follows:

- (a) A mark of a simple, easily recognized pattern made by burning with a hot iron to attest manufacture or quality or to designate ownership;
- (b) A class of goods identified as being the produce of a single firm or manufacturer
- (c) To impress indelibly

Hence, a brand can designate quality, ownership or make; it can even mean an indelible impression.

trademarks are private monopoly rights, geographical indications are collective community rights; trademarks identify the source of the product, whereas geographical indications identify the geographical origin and indicate that the product possesses certain qualities and characteristics which are inextricably linked to the geography concerned; while trademarks rights may be assigned, rights in a geographical indication may not be assigned; while trademark rights can be created overnight by adopting them, rights in geographical indications are rooted in public perception and are recognized over a period of time; while trademarks may be created with 'intent to use', geographical indications may not be².

Hence, conceptually, the two terms are different and the nature of rights conferred by the property in these two concepts is also different. Yet, it is observed that geographical indications are often used and treated on par with trademarks for various reasons including ignorance of the conceptual differences and lack of proper legislation in the respective jurisdictions to address the issues raised by the interplay between these two concepts.

International framework for the protection of trademarks and geographical indications

² Nair Latha, Kumar Rajendra, "Geographical Indications: A search for Identity", by Lexis Nexis Butterworths, 2005, p. 6

Internationally, trademark law and practice have been streamlined and the procedures are more or less uniform, barring certain differences in the mode of protection in civil law and common law countries. While civil law countries insist on registration as opposed to use for protection, in common law countries, use of a mark gives superior rights over registration. However, this does not affect or vary the degree of protection afforded to a particular trademark.

While geographical indications are not a new concept, their importance as intellectual property representing collective community rights has been brought to the forefront only by the WTO Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS). In other words, the relevance of geographical indications as intellectual property rights came to be noticed, at the rate at which it is being noticed today, only after the advent of WTO. Till then, Europe was perhaps the only region having a clear awareness of the rights in geographical indications, that too specifically concerning wine and cheese products. Although there is a separate section altogether dealing with geographical indications in TRIPS (Section 3), as far as compliance of TRIPS is concerned, most member countries have chosen not to enact separate legislation for the protection of geographical indications. Instead, some have relied on existing trademark provisions such as collective and certification marks and some others have issued

ordinances or included additional provisions in their trademark law to protect these rights. The end result being that, unlike trademarks, there are no streamlined processes, uniform laws or approach for the protection of geographical indications globally.

Interestingly, TRIPS Agreement has separate sections for the protection of trademarks (Section 2, Articles 15 to 21³) and geographical indications (Section 3, Articles 22 to 24⁴) indicating that the WTO clearly intended that member countries protect both these rights separately and independently of each other.

These two sections provide specific definitions to the concept of trademarks and geographical indications and cast specific obligations on member countries to provide for the protection of these rights. However, despite this international framework, most member countries of WTO have turned a blind eye to the distinct and different personalities of the two concepts. The consequences of such state of affairs is that while a particular name may be protected as a geographical indication in India, in the USA it will be protected as a certification trademark, in Japan one may try to protect it as a collective mark and in Russia, if fortunate, one could

³ Article 15 deals with what is protectable subject matter of trademarks; Article 16 deals with the exclusive rights conferred on the owner of a registered trademark; Article 17 deals with exceptions to protection; Article 19 deals with requirement of use of a trademark; Article 20 deals with special requirements; and Article 21 deals with licensing and assignment.

⁴ Article 22 deals with definition of geographical indications and their protection at a general level; Article 23 deals with the additional protection for geographical indications for wines and spirits; and Article 24 deals with the exceptions to protection.

register it as a trademark. Consequently, while the international approach to protection of trademarks is streamlined and uniform, it is uneven, inadequate and dissatisfactory if not abysmal towards geographical indications, a situation which has a distasteful impact on the protection of geographical indications. Considering that geographical indications also serve as brands for collective, communal group in marketing their products, this is a situation that warrants immediate attention at the international level.

The chaos created by this peculiar approach is palpable in three recently decided cases involving the well-known geographical indication DARJEELING by three judicial bodies, namely, the Trade Marks Trial and Appellate Board (TTAB), USA, Court of Appeal Paris and the WIPO Arbitration and Mediation Center dealing with Country Code Top Level Domain names (CCTLD).

DARJEELING: Whose cup of tea is it?

DARJEELING is a unique and special tea originating in the Darjeeling district of the State of West Bengal in eastern India. This famed tea is cultivated only in the 87 tea gardens located in Darjeeling, which are at an altitude of 2000 meters above the mean sea level. The regions where the said tea is grown form part of the foothills of the Himalayas. The unique and complex combination of agro climatic conditions in these regions, coupled with the

production regulations imposed by the Tea Board has lent the tea its distinctive and naturally occurring quality and flavour.

Besides being the first registered geographical indication under India's Geographical Indication of Goods (Registration & Protection) Act, 1999, both the DARJEELING word and logo are also registered as certification trademarks in India under the Trademarks Act, 1999. While this may appear as an oddity to many, the experience of the Tea Board India, who holds and administers all these registrations under the trademark law and the geographical indications law, is that without a dual domestic registration under the trademark law and geographical indication law, international enforcement of its rights is difficult, if not impossible.

The reasons behind this are that two of the major markets for DARJEELING tea, namely, the UK and the USA enforce the rights in geographical indications through certification trademark regime. Hence, to enforce its certification trademarks overseas in respect of the DARJEELING word and logo marks, Tea Board should have systems in place in India for enforcing the same and, therefore, a corresponding registration as a certification trademark is warranted despite the registration under its geographical indications law. Further, to register as a geographical indication in

jurisdictions such as the EU, it is essential to have a registration under the geographical indications law as well.

The color of protection of the name DARJEELING, therefore, varies from one jurisdiction to another. Hence, while it is registered as a certification trademark in Australia, the UK, and the USA, in Canada it is registered as an 'official mark'. Again in Austria, Benelux, France, Italy, Lebanon, Portugal, Spain and Switzerland it is registered as a collective mark. Finally, in Egypt, Japan and Russia, it is registered as a trademark. Thankfully, its home country protects it under a geographical indication law as well. Most certainly, the owners of well known trademarks such as LIPTON and TWININGS which sell DARJEELING tea under these brands never had to countenance such a strange situation, protecting their marks under various heads in all the above jurisdictions.

The year 2006 brought a mixed bag of good and bad luck to Tea Board India as far as the international protection of DARJEELING was concerned. Three different judicial bodies mentioned above, before whom the Tea Board was defending / contesting the rights in the name DARJEELING, issued their orders; two in favour of Tea Board and one against. Two of these orders were passed in August 2006 and the third one in November 2006. Let us examine these orders in their chronological order.

Decision of the Panel in the WIPO Arbitration and Mediation Center in the case of Tea Board India v. Delta Lingerie (Dispute No. DFR 2006-0003) (*Unreported*)

On June 12, 2006, a complaint was filed by Tea Board, with the World Intellectual Property Organization's (WIPO) Arbitration and Mediation Centre (hereinafter the "Centre") against the registration of the domain name <<darjeeling.fr>> by the respondent Delta Lingerie, a French company engaged in the manufacture and marketing of women's lingerie, hosiery and undergarments (hereinafter, 'Delta') under the trademark "DARJEELING". After complying with the formalities, the Centre forwarded a notice of the complaint to Delta and Delta filed its response. Subsequently, on August 3, 2006, the Centre appointed a single arbitrator in the matter.

In the complaint, Tea Board argued as follows:

- It is a statutory authority established in 1953 and its operations include promotion of tea, and in particular DARJEELING tea;
- It holds a number of registrations for the mark DARJEELING word and logo including in particular a logo mark with the

name 'DARJEELING' and the depiction of a woman holding two tea leaves as a collective mark for the territory of France as well as a collective mark in EU for the name DARJEELING covering the territory of France both in class 30 for the product 'tea';

- It is aggrieved by the registration by Delta of the domain names <darjeeling.tm.fr> and <darjeeling.fr> on 11 June 1997 and 3 July 2001 respectively because it infringed Tea Board's intellectual property rights.
- In connection with its mandate for the promotion of tea, it has established a certification program intended to monitor the production of Darjeeling tea and its supply chain and that this certification program relied mainly on the use of the DARJEELING logo and name, which is an exclusive property of the producers, exporters and traders approved by the Tea Board in this connection.
- Hence, Delta registered the domain names without its authority or consent when it had no legitimate interest in the name DARJEELING.
- Besides, Delta is attempting to create an association with the famous name DARJEELING by riding on its world-wide reputation and thus diluting the reputation and image of the aforementioned registered marks in respect of DARJEELING.
- Such attempts are evident from the fact that Delta is using a

leaf logo as part of its trademark and is providing an administrative contact address for the domain name <darjeeling.tm.fr> as tea-bog@wanadoo.fr.

- Delta was indeed aware of the Tea Board's rights in the name DARJEELING as the Tea Board has repeatedly opposed its registrations for the mark DARJEELING in jurisdictions including France.

Based on the above arguments, the Tea Board wanted the said domain names to be transferred to it.

Delta in its response claimed as follows:

- It holds rights in the trademark "DARJEELING" in several countries of the world, and in particular the following trademarks:
 - French trademark DARJEELING No. 94 515 068, filed on 12 April 1994 and renewed on 12 April 2004, in class 25;
 - EU trademark DARJEELING No. 528018, filed on 3 April 1997 in class 25;
 - EU trademark DARJEELING No.1973973, filed on 13 November 2000 in class 38.
 - French semi-word trademark under No. 98 744 998,

filed on 5 August 1998, in class 25.

- EU semi-word trademark No. 4189742, filed on 14 January 2005 in class 25.

- Further, it has owned the DARJEELING trade name for more than twelve years and has been regularly using the same;
- Tea Board is fully informed of its rights in the mark DARJEELING because of the many opposition procedures filed by the Tea Board against its DARJEELING trademark in various countries. Omission on the part of the Tea Board to indicate this in its complaint amounts to bad faith.
- Further, all of the oppositions filed by the Tea Board were dismissed on grounds that the Tea Board did not adduce sufficient evidence to prove the reputation of name DARJEELING and/or on grounds that the products sold by Delta were in no manner identical, similar or even related and that therefore there was no risk of confusion in the consumers' minds.
- Accordingly, the existence of any risk of confusion between the two trademarks is baseless
- Delta registered the two disputed domain names in strict

compliance with the rules and that when several companies may potentially claim rights in a same word, the Association Française pour le Nommage Internet en Coopération (AFNIC) grants their claims according to the chronological order of reception according to the “first in first served” rule.

- Further, Delta argued that the Board could not have registered the domain names forming the subject matter of dispute, at the date on which Delta itself registered the same because only from November 2001 were foreign companies entitled to register domain names in France in respect of which they own trademark rights in France. Prior to that date, they needed either to own a French trademark (which is not the case for the Board), or prove that since 1999 they had a trade name or corporate name corresponding to the requested domain name (which again the Board is unable to meet).

Based on the above, Delta argued that, by adopting this procedure, the Tea Board seeks to circumvent the .fr naming procedures, and in particular Article 22 of the AFNIC Naming Charter.

Having considered the arguments of both the sides, the panel issued its decision on the complaint rejecting Tea Board’s request for the transfer. In arriving at the said decision, the panel

considered the following:

- Tea Board's numerous oppositions against Delta's marks were dismissed by various authorities so far;
- The products sold by the Tea Board and Delta are totally separate and do not create any risk of a confusion in the minds of consumers.
- AFNIC applies the 'first come, first serve' rule and according to the chronological order of receipt of applications and accordingly, Delta was the first to apply.
- On the date of registration of the disputed domain names by Delta, the Tea Board did not meet the requirements imposed by the AFNIC naming Charter in order to register a ".tm.fr" or ".fr" domain name.
- Lastly, the <darjeeling.fr>, domain name, which is the only domain name used by Delta, refers to a website featuring the products sold by Delta, which are separate and bear no relation to the products sold by the Tea Board. Accordingly, there is no risk of confusion in the minds of the public.

While refusing the request of Tea Board to transfer the domain names in its name, the panel found that the registration and use by Delta of the disputed domain names were made in good faith and in strict compliance with the AFNIC Charter, and, therefore, may not be considered as infringing the rights of

third parties and in particular the Tea Board's rights.

Decision of the TTAB, USA in the opposition filed by Tea Board against the trademark 'DARJEELING NOUVEAU' by the American company, Republic of Tea (US TTAB Opp. No. 91118587; 23 Aug 2006)⁵

The Trademark Trial and Appeal Board (TTAB) in the United States of America has upheld Tea Board, India's opposition to the mark DARJEELING NOUVEAU in respect of 'tea' filed by Republic of Tea (hereinafter, ROT) and has also rejected ROT's counterclaim for cancellation of the DARJEELING certification mark on grounds of genericness. ROT was a licensee of Tea Board's own certification trademark for the DARJEELING logo, before the TTAB. The decision in the fiercely defended opposition was issued on August 23, 2006 by three judges of the TTAB.

In the opposition, Tea Board claimed to administer and regulate under an elaborate system of control all stages of cultivation, processing, promotion and sale of Darjeeling tea in both the domestic and overseas market. It submitted that the 87 gardens where this famed tea is grown are registered with the Tea Board and it makes regular checks and inspections and also certifies all

⁵ See <http://www1.uspto.gov/web/offices/com/sol/foia/ttab/other/2006/91118587.pdf> for the full text of the order

Darjeeling tea which is intended for export to originate from the 'specified region of the district of Darjeeling West Bengal, India'.

Tea Board's opposition to DARJEELING NOUVEAU was mounted on the premise that it has common law and statutory rights in the certification marks 'DARJEELING' and 'DARJEELING logo' (a pictorial representation of a woman holding tea leaves in a roundel); it exercises control over use of the same by others to certify that tea sold under the said DARJEELING marks is 100% Darjeeling tea and meets the other criteria laid down by it; it has been using the DARJEELING marks at least since 1987 in the United States and ROT's DARJEELING NOUVEAU mark when applied to tea is likely to create confusion and deception and dilute the distinctive character of the DARJEELING marks.

In its defense, ROT filed a counter claim for cancellation of the DARJEELING mark on the ground that it was generic. ROT argued that the Tea Board had failed to exercise legitimate control over the mark DARJEELING and consequently, it has lost its significance as an indication of geographic source and the consuming public viewed DARJEELING as a type of tea. ROT further argued that Tea Board's failure to police the mark resulted in unlicensed and unregulated use of DARJEELING in connection with non-Darjeeling tea. It pointed to the fact that there was no

certification mark program in place in the United States prior to 1987 and that the Tea Board had never initiated any legal action against a third party for misuse of the DARJEELING mark. In support of its claims, ROT relied on survey evidence, dictionary definitions and third party usage of DARJEELING and the lack of widespread use of DARJEELING logo by third parties.

In response, Tea Board argued that it conducted educational programmes and participated in trade shows to increase consumer awareness of DARJEELING; the past and current certification scheme for use of the DARJEELING marks constituted adequate control; ROT had not demonstrated a single instance of misuse of the DARJEELING mark in connection with non-genuine Darjeeling tea and use of the term DARJEELING in various publications (dictionaries, books, newspaper articles etc.) and the evidence offered by ROT, all support the non-generic usage and understanding of the DARJEELING geographic certification mark.

Upon consideration of the arguments, the TTAB held that there was insufficient evidence to establish the DARJEELING mark as generic and observed as under:

- The test for determining whether a mark is generic is its primary significance to the relevant public;

- The mere fact that there was no formal certification system prior to 1987 is not in itself evidence that DARJEELING has lost significance as a mark;
- The determinative question was whether the control exercised by the Tea Board was adequate;
- Mere fact of misuse is not sufficient to raise an inference that the control was not adequate especially when there was no information about the nature and extent of misuse of DARJEELING;
- Tea Board has demonstrated that control was in fact maintained and it took affirmative steps to introduce the certification program in 1987 and instituted increasingly tighter control by introducing revised certification schemes from time to time in response to changing needs and circumstances;
- The survey evidence, dictionary definitions, media usage etc. all fail to show that Darjeeling has a generic meaning - in fact not a single instance of use of Darjeeling in a lower case 'D' was shown which may signify use in the manner of a generic designation.

The TTAB also held that the current certification scheme constitutes "adequate control" and regarded Tea Board's ongoing efforts to educate the public (e.g., by attending trade shows and distributing literature on Darjeeling tea) as further evidence of the

Tea Board's overall system of controlling consumer understanding.

To support its likelihood of confusion argument, the Tea Board argued that since under US law, a certification mark owner is at par with a trademark owner, ROT as an authorized seller of genuine DARJEELING tea should not be permitted to name its product DARJEELING NOUVEAU. ROT argued that purchasers of its goods would not be confused as its product consisted entirely of Darjeeling tea and genuineness of the product has to be a relevant consideration. It accordingly offered to amend its specification of goods to 'tea entirely from the Darjeeling region of India'.

Rejecting the above argument, the TTAB held that the fact that a user's products may be genuine is not a defense to a likelihood of confusion claim instead it serves to enhance an association with the certification mark owner. ROT's offer to amend its specification of goods was made in an effort to overcome the likelihood of confusion and because such amendment cannot overcome the likelihood of confusion, it does not merit consideration.

The TTAB concluded that confusion was likely on the grounds that:

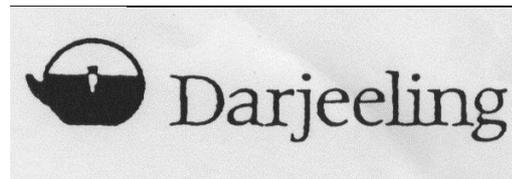
- DARJEELING is an inherently distinctive and a strong certification mark for reasons including that Darjeeling tea has been sold in the United States for the past 50 years; it is recognized by those in the trade and tea aficionados as a geographical indication; DARJEELING has no meaning apart from its geographical meaning and it is defined in a number of dictionaries as a place known for tea from that region;
- The DARJEELING word mark and the DARJEELING NOUVEAU mark when considered in entirety are similar in sound, appearance, meaning and overall commercial impression and the disclaimer of 'DARJEELING' from ROT's mark does not detract from the otherwise strong similarity between the marks; and
- The marks were used on identical goods, the channels of trade as well as the purchasers for such goods were identical.

Since it decided the issue of likelihood of confusion in Tea Board's favour, the TTAB did not deem it necessary to consider the issue of dilution of the 'DARJEELING' marks.

Court of Appeals decision, Paris in Tea Board v. Jean-Luc Dusong⁶



Versus



This was an appeal filed by Tea Board India against a decision rendered by the Court of First Instance, Paris in favor of one Mr. Jean-Luc Dusong in respect of his use of the trademark “DARJEELING” with the device of a teapot as depicted above in respect of goods other than Darjeeling tea in classes 16, 35 and 41. While objecting to the said registration through a civil suit before the Court of First Instance in Paris, the Tea Board argued that this would deceive customers into believing that these products and services, though not related to tea, were somehow associated with the superior quality and reputation enjoyed by Darjeeling Tea. In July 2005, the Court of First Instance had held that the use by Mr.

⁶ Tea Board of India v Jean-Luc Dusong Paris Court of Appeals, 4th Chamber, Reg No 05/20050 (22 Nov 2006).

Dusong of the above mark was not unlawful and that it did not constitute deception. Further, it rejected the argument of Tea Board on deception and had held, inter alia, that Mr. Dusong's mark was not deceptive as it related to dissimilar goods and imposed a cost of Euros 4000 on Mr. Dusong as costs of the proceedings.

The Tea Board appealed the said decision and sought the following among other reliefs in its appeal:

- Declare that the registration of a trademark containing the name "DARJEELING" and the representation of a teapot violates the Indian geographical indication DARJEELING and is damaging to the interests which the TEA BOARD represents on behalf of the right holders of DARJEELING;
- Nullify the above trademark registered by Mr. Dusong to in classes 16, 35 and 41;
- Prohibit Mr. Dusong from using the geographical indication DARJEELING in any form whatsoever and dismiss all the claims made by Mr. Dusong;

- Sentence Mr. Dusong to pay the sum of 2,000 euros to towards the infringement of the indication of origin DARJEELING;
- Order the publication of the decision to be made in three newspapers or magazines of Tea Board's choice at the expense of Mr. Dusong up to a maximum amount of 5,000 euros for all the publications;
- Order the decision for entry in the national trademark register;

The Court of Appeals after hearing both the parties issued an order on November 22, 2006 upholding Tea Board's claims and finding as follows:

- On the basis of various materials, scholarly works and encyclopedias placed before it by the Tea Board, it was evident that 'DARJEELING' qualified as a geographical indication for a tea having unique attributes and originating in the Darjeeling district in India and hence entitled to be protected as such within the meaning of the TRIPS Agreement and the Paris Convention.

- Even if Mr. Dusong was using the mark in respect of dissimilar goods and services, he was still riding on the superior reputation of Darjeeling Tea and freely benefiting from the same. This amounts to a parasitic act and an act of unfair competition under Article 10bis of the Paris Convention (to which both India and France are signatories), which calls for sanctions against acts which are contrary to honest industrial and commercial uses.
- By adopting the name 'DARJEELING' along with the device of a teapot, Mr. Dusong has also attempted to benefit from the fame and economic value associated with this geographical indication. Even if there was no risk of confusion associated with such use by Mr. Dusong, it would undermine and dilute the distinctive nature of this prestigious geographical indication.
- The name "DARJEELING" could not be registered as a trademark because when applied to different goods and services, it evokes in the consumer's mind the universe of tea in said region of India. Thus, only the producers, traders and exporters from this region can benefit from this origin.

Accordingly, the court nullified the registration granted to Mr. Dusong for the mark "DARJEELING" with the teapot device and

injunctioned him from using the name “DARJEELING” in any context whatsoever. Further, the court authorized the Tea Board to have the order or its extracts published in three French or foreign newspapers or journals of its choice at the expense of Mr. Dusong up to a maximum of Euros 5000. Besides the above, the court also directed Mr. Dusong to pay costs up to Euros 2000 to the Tea Board.

Can trademarks protect geographical indications?

In all the three cases above, the rights relied on by the Tea Board to protect its geographical indication DARJEELING were trademark rights through certification trademark registration. Not surprisingly, each of those decisions arrived at different opinions on the Tea Board’s rights in the name ‘DARJEELING’ essentially because the scope of protection offered to geographical indications by trademarks is, inadequate, if not inappropriate. So what else ails the protection of geographical indications other than the lack of a uniform approach?

Considering that both trademarks and geographical indications have source identifying functions, geographical indications have perhaps got a raw deal as far as their protection is concerned in two other aspects, namely, as domain names and as well-known names. As seen in the DARJEELING.fr case, one oft-encountered

abuse of geographical indications in the digital era is their registration as domain names or parts thereof by unrelated and unauthorized third parties. The current policy governing the Uniform Domain Name Dispute Resolution Policy (UDRP) mechanism is restricted only to abusive registrations of trademarks. The abusive registration of geographical indications does not fall within the scope of the policy. The Recommendations of the Tenth Session of the World Intellectual Property Organization (WIPO) Standing Committee on the protection of Trademarks, Industrial Designs and Geographical Indications, although analysed in detail the suggestions of various member countries and stake holders, took a soft stand on the issue. Extracts highlighting the apparently weak stand taken by WIPO in its recommendations and relevant to the discussion herein are reproduced below⁷:

This is a difficult area on which views are not only divided, but also ardently held.

The question for decision, however, is whether there is a solid and clear basis in existing international law which can be applied so as to prevent erosion of the integrity of geographical indications and enhance the credibility of the DNS.

⁷ See http://www.wipo.int/edocs/mdocs/sct/en/sct_10/sct_10_6.pdf

We believe that there are two fundamental problems in endeavoring to apply the existing international legal framework to prevent the bad faith misuse of geographical indications in the DNS.

The first problem is that the existing international legal framework for the prohibition of false and deceptive indications of geographical source and the protection of geographical indications was developed for, and applies to, trade in goods. The Paris Convention, the Madrid (Indications of Source) Agreement and the TRIPS Agreement all deal with the misuse of geographical identifiers in relation to goods. There is, thus, not a ready and easy fit between these rules and predatory and parasitic practices of the misuse of geographical indications in the DNS. The mere registration of a geographical indication as a domain name by someone with no connection whatsoever with the geographical locality in question, however, cheap and tawdry a practice, does not appear to be, on its own, a violation of existing international legal rules with respect to false indications of source and geographical indications. Such a registration may violate existing standards if it is associated with conduct relating to goods.

Secondly, there is a major problem in respect of applicable law because of the different systems that are used, at the

national level, to protect geographical indications.

.....

We believe, therefore, that the existing international framework would provide only a partial answer to the perceived problems of false indications of source and geographical indications within the DNS. Furthermore, because of the need to resort to a choice of applicable law to resolve the question of the recognition of the existence of a geographical indication, very complicated questions would be involved in the application of the UDRP in this area.

.....

It is recommended that no modification be made to the UDRP, at this stage, to permit complaints to be made concerning the registration and use of domain names in violation of the prohibition against false indications of source or the rules relating to the protection of geographical indications.

To a right holder in a geographical indication, the aforesaid stand is appalling and disheartening.

The other issue of protection to well-known geographical indications against use on dissimilar goods and services is also something where no firm stand has been taken by WIPO or the international IP community. It is pertinent to note here that such a

protection is not available even to geographical indications relating to wines and spirits protected under Article 23 of TRIPS, apparently offering a higher level of protection. Art. 23 in its current form confers on a protected geographical indication for wines and spirits an absolute protection against any use of such geographical indication even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style” etc. It further states that the registration of a trademark containing or consisting of a geographical indication for wines and spirits shall be refused or invalidated with respect to such wines and spirits not having this origin. Even if Article 23 type of protection is extended to other products such as DARJEELING tea, it would not extend the scope of absolute protection to dissimilar goods. It would be a moot point to consider whether proponents who seek extension of Article 23 protection to geographical indications relating to products other than wines and spirits should make a strong pitch for widening the scope of absolute protection towards this. In this connection, it may be relevant to point out that WIPO Recommendations on Well-Known Trade Marks adopted by member countries recognize that a well-known trademark registered as such in a jurisdiction could be enforced against the use of identical or similar marks on dissimilar goods. The factors for determination of a mark as a well-known mark as per the recommendations include without limitation the following:

- The degree of knowledge or recognition of the mark in the relevant sector of the public;
- The duration, extent and geographical area of any use of the mark;
- The duration, extent and geographical area of any promotion of the mark, including advertising or publicity or the presentation at fairs or exhibitions of the goods and / or services to which the mark applies;
- The duration and geographical area of any registrations, and / or any applications for registration of the mark, to the extent that they reflect use or recognition of the mark;
- The record of successful enforcement of the mark, in particular, the extent to which the mark was recognized well-known by competent authorities;
- The value associated with the mark;

These Recommendations have been incorporated into the national laws of some countries⁸. In keeping with this, why should not a similar protection be extended to well-known geographical indications, especially, since such geographical indications as brands of collective communities play an important role in the economic, cultural and social well-being of a country and are thus to be considered at a higher level than trademarks?

⁸ See for example, Section 11(6) of the (Indian) Trademarks Act, 1999

Apart from the above, geographical indications also face discrimination in protection if they do not belong to certain product categories. For instance, Europe today has no law to protect geographical indications pertaining to handicrafts. While this may not affect Europe, it certainly has an impact on many Asian countries which have hundreds of handicraft and textile geographical indications⁹.

That compels one to state that the international protection of geographical indications through trademark law is akin to equating apples with oranges when apples should really be equated with apples. Even at the level of international trademark communities, members of developed countries very often consider discussions on geographical indications to be excessive as such issues are not dealt with often by them. These discussions are always given a Southern aura instead of focusing on their brand value that needs to be protected. There are many odds that right holders of geographical indications need to fight against to ensure that these are protected uniformly at the international level like any other intellectual property.

So, are geographical indications any less as brands? Well, from the current treatment of the same at the international level, that seems to be the most appropriate conclusion. Unless there is sufficient

⁹ For instance, in India, the Geographical Indications Registry have till date registered over 40 geographical indications from the date of coming into effect of the Indian law on the subject in September 2003. About 70% of these are textile and handicraft products.

international political will to protect them and approach their protection in a streamlined fashion globally, like in the case of trademarks, the brand value possessed by geographical indications can never be exploited to the fullest extent by their legitimate right holders. Till such time this is done, geographical indications will be indulgently discussed in international fora as a Southern issue or studied by academics as a grey area, thereby doing a total dis-service to the intellectual property contained in them.

© 2008, Latha R Nair, New Delhi India

[The author is a partner with the New Delhi based intellectual property law firm, K&S Partners]