

Legal Issues
In
Geographical Indications & Appellations of Origin, Associated & Series
Trademarks and Shape Marks & Features

Legal Issue- I

Whether private enterprises can own Geographical Indications (GIs)?

Relevant Provisions

❖ **Section 11(1) of the Geographical Indications of Goods (Registration and Protection) Act, 1999**

- *“Application for registration – (1) Any association of persons or producers or any organisation or authority established by or under any law for the time being in force representing the interest of the producers of the concerned goods, who are desirous of registering a geographical indication in relation to such goods shall apply in writing to the Registrar in such form and in such manner and accompanied by such fees as may be prescribed for the registration of the geographical indication.”*

❖ **Rule 32(6)(a) of the Geographical Indication of Goods (Registration & Protection) Rules 2002 (“the GI Rules”)**

- *“(6) the statement contained in the application shall also include the following:—(a) an affidavit as to how the applicant claim to represent the interest of the association of persons or producers or any organization or authority established by or under any law”*

GI for Chinnor Rice

- ❖ The Applicant, Chinnor Seeds Producer Company Limited, was a private trading enterprise with business in seed production.
- ❖ Application contrary to the scheme of the GI Act which is concerned with commercial production of a GI product (in this case “rice” which is distinguished from “seeds”).
- ❖ Questionable whether private entity is entitled to seek GI registration as it can only represent its own interest and not those of the producers of the goods in the geographical area.
- ❖ Applicant argued that it is a lawfully established company and is an association of rice growers that can be joined by any Chinnor growing farmer in the Balaghat district.
- ❖ It was observed that only 51 of the total 1250 producers of Chinnor Rice were associated with the Applicant.

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GI for Tirupati Laddus

- ❖ Plea against the GI for Tirupati Laddus, applied for by Tirumala Tirupati Devasthanam (TTD).
- ❖ Petitioner argued that there was no industrial purpose here and granting monopoly to a single producer would defeat the purpose of GI and would be against Section 11(1) of the Geographical Indications of Goods (Registration & Protection) Act, 1999.
- ❖ Violation of Section 11(1) read with Rules 32(5) and 32(6)(a)&(f) (as GIs are supposed to be collective community rights of protecting a group of producers).
- ❖ TTD is the sole producer and beneficiary under the GI tag.

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Judicial Interpretation

❖ **Subhash Jewellery v. Payyannur Pavithra Ring Artisans [2013 (55) PTC 197 IPAB]**

- IPAB ordered the removal the GI '*Payyannur Pavithra*' ring in the name of the society from the Register holding that there was no evidence of the desire of the producers to come together to protect the GI.
- The application ought to have named those producers, whether they make or manufacture the ring or whether they trade or deal in the making or manufacture of rings and also that such production takes place in Payyannur.
- **Observed:** Mere claim that the society is named Payyannur Pavithra Ring Artisans and Development Society would not suffice.

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Legal Issue- II

Whether fluid trademarks are registerable as a series trademark?

Introduction & Relevant Provisions

- ❖ Fluid trademarks are variations of the originally registered trademarks which coexist with the original marks and are made in an attempt to build or improve consumer interest and strengthen brand loyalty.
- ❖ Variations typically retain basic elements of the original with new elements so as to continue acting as a source identifier.
- ❖ **Sections 2(m), Trade Marks Act, 1999**
 - *“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;”*
- ❖ **Section 15, Trade Marks Act, 1999**
 - *“(3) Where a person claiming to be the proprietor of several trade marks in respect of the same or similar goods or services or description of goods or description of services, which, while resembling each other in the material particulars thereof, yet differ in respect of—(c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark;”*

Judicial Interpretation

❖ **Louis Vuitton Malletier v. Dooney Burke [454 F.3d 108 (2d Cir. 2006)]**

- *“To qualify for registration under § 2, or to establish protectability under § 43(a), “a mark must be sufficiently `distinctive' to distinguish the registrant's goods from those of others.” A plaintiff can establish a mark as distinctive by showing that the mark is “inherently distinctive,” i.e., intrinsically capable of identifying its source, or by demonstrating that the mark has acquired “secondary meaning”.”*
- *“Vuitton's Multicolor mark, consisting of styled shapes and letters — the traditional Toile mark combined with the 33 Murakami colors — is original in the handbag market and inherently distinctive. The Toile pattern, on which it is based, has been a famous indicator of Louis Vuitton for over a century. The new Multicolore mark was created as a source-identifier for Vuitton in the new millennium. It is a strong mark. The mark earned praise and became famous almost instantly. We agree with the district court that the Multicolore mark is protectable both because it is inherently distinctive and because it has acquired secondary meaning.”*

Legal Issue- III

Are unregistered shapes protectible under passing off under the Trade Marks Act?

Relevant Provisions

❖ Section 2(1)(zb) of the Trade Marks Act, 1999

- *““trade mark” means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and—”*

❖ Section 2(d) of the Designs Act, 2000

- *““design” means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of section 2 of the Trade and Merchandise Marks Act, 1958...”*

Judicial Interpretation

❖ **Mohan Lal and Ors. v. Sona Paint & Hardwares and Ors [(2013) 55 PTC 61 (Del)]**

- *“...passing off action may perhaps be maintainable provided the mark has attained secondary meaning. In our opinion, the issue before us is limited to whether a remedy by way of passing off action would be available qua a registered design used as a trademark by the plaintiff - we are not inclined to comment on the quality of evidence which may be required, if at all, to be produced by the plaintiff to prove whether the mark has acquired the necessary secondary distinctive meaning, for him to secure success, in the action instituted in that behalf.”*

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❖ **Carlsberg Breweries A/S v. Som Distilleries and Breweries Ltd. [AIR 2019 Delhi 23]**

- If the elements of registered design are not being used as a trade mark in its strict sense but rather as a larger trade dress get up of the product, presentation of the product through its packaging and so on, both cause of action – infringement of design and passing off – can lie together.

Judicial Interpretation (Contd.)

- ❖ **Super Smelters Limited & Ors. v. SRMB Srijan Private Limited [2020 (81) PTC 101[Cal][DB]]**
 - Rather than granting monopolies to the shape of an article, the law of passing off merely recognizes the existence of a monopoly over that shape that is held by the proprietor.
 - A registered design, after its expiry, may not lose its distinctiveness and end up fulfilling all the requirements of a trademark.
 - In that scenario, not recognizing that mark as a trademark because that would extend the design monopoly would be to conflate two things that exist completely independent of each other.

THANK YOU!

Questions?

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