

Legislative Measures and Initiatives on Geographical Indications Protection in India

MymoonaWani

Research Scholar

Faculty of Law, Aligarh Muslim University, Aligarh

Abstract

Geographical names now known as Geographical Indications have played significant role in International commerce. For many centuries, products have been advertised and sold based upon the name of the specific region in which they originate. As international commerce expanded after the Industrial Revolution, governments of developed countries became concerned about the protection of GIs in the international market. Due to the increasing demand for quality products all around the world, Indian producers and manufacturers realized the importance of having a distinguishable product to compete in the international market. With this objective India steadily moved towards the recognition of importance of geographical indications both at national and international level.

It is in such a scenario that India took steps to enact legislations for protection of Intellectual Property in compliance with the TRIPS Agreement. The legislation namely Geographical Indications (Registration and Protection) of Goods Act, 1999 is one such step. India by introducing Geographical Indication (Registration and Protection) Act 1999 (GI Act), which is a sui generis legislation, innovated a legal protection for its geographical indications at the national level. In this paper, an effort has been made to critically analyze the existing national legal framework for protecting GIs and new measures in this field have been proposed.

Keywords: Geographical Indications, India, Geographical Indications (Registration and Protection) of Goods Act, 1999, Darjeeling Tea, Challenges, IPR, Patent, Trademarks, TRIPS Agreement

Introduction

Over the recent past, Geographical Indications (GI) has emerged as a significant form of Intellectual Property Rights (IPR) issue in the Indian context. GI helps a community of producers to differentiate their products from competing products in the market and build goodwill around their products, often fetching a premium price. From consumer's point of view, GIs act as a signalling device, which helps them identify genuine quality-products and also protect them against counterfeits. In view of their commercial potential, adequate legal protection of GIs becomes necessary to prevent their misappropriation. Although India has had in its possession a considerable number of products that could qualify for legal protection as geographical designators, the initiatives to exploit this potential begun only recently when the country established a sui generis system of GI protection with the enactment of 'the Geographical Indications of Goods (Registration and Protection) Act, 1999, coupled with the 'Geographical Indications of Goods (Registration and Protection) Rules, 2002. The Act, which became operational with effect from 15 September 2003, was drafted as part of the exercise in

the country to set in place national IPR laws as much in compliance with India's obligations under the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs) of the World Trade Organisation (WTO) so as to take advantage of the 'minimum' standards of GI protection that the TRIPs sets out for the WTO members to comply with in their respective national legislations.

Analysis of the GI Act

Prior to enactment of GI Act, there was no law for the protection of geographical indication in India. The need and justification for this law has been aptly stated in the statement of object and reasons as under:

At present there is no specific law governing geographical indications of goods in the country which could adequately protect the interests of producers of such goods. Exclusion of unauthorised persons from misusing geographical indications would serve to protect consumers from deception, add to the economic prosperity of the producers of such goods and also promote goods bearing Indian geographical indications in the exports market. Unless a geographical indication is protected in the country of its origin there is no obligation under the agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs) for other countries to extend reciprocal protection. India would, on the other hand, be required to protection to goods imported from other countries which provide for such protection. In view of the above circumstances, it is considered necessary to have a comprehensive legislation for registration and for providing adequate protection for geographical indications.

Until recently and in past, protection from such misuse of geographical indications was granted through passing off action in courts or through certification marks. However, in order to provide better protection to geographical indications, the Parliament enacted Geographical Indications of Goods (Registration and Protection) Act, 1999²⁸ which is quite similar and in lines with the New Zealand GI Act. This received the assent of the President of India on the 30th December 1999.

This Act seeks to provide for registration and better protection of geographical indications relating to goods. It excludes unauthorised 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 for other countries to extend reciprocal protection. It is in this context that the Act was enacted.²⁹ 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 provisions 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.

Some Salient and Important Features of the Act

(a) Definitions

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 county, 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 preparations of the goods concerned takes place in such territory, region or locality, as the case may be.

(b) Meaning of Indication

The word indication has also been defined to include:

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

(c) Concept of Goods

The Act 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.

(d) 'Producer' in relation to goods, means any person who –

- (i) if such goods are agricultural goods, produces the goods and includes the person who processes or packages such goods;
- (ii) if such goods are natural goods, exploits the goods;
- (iii) if such goods are handicraft or industrial goods, makes or manufactures the goods, and includes any person who trades or deals in such production, exploitation, making or manufacturing, as the case may be, of the goods.

The TRIPs definition refers to goods in general; the Indian GI Act specifies the goods to be either agricultural goods or natural goods or manufactured goods that can qualify as a GI. Further, in the Indian Act, if a producer applies for a GI for a manufactured good, he or she must make sure that at least one of the activities of either the production or processing or preparation of the good must take place in the territory. In that sense, the GI Act is more restrictive than the TRIPs definition.

This can be explained by taking "Darjeeling tea" as an instance. Darjeeling tea involves manufacture because the green tea leaves plucked from the tea bushes have to go through a range of rigorous processing stages before turning into the final product (called "made-tea"), which is ultimately sold in the market. Now even if the tea leaves are plucked from Darjeeling region, the GI Act will not allow the final product to be designated as Darjeeling tea, unless the processing also takes place within the Darjeeling region. The TRIPs definition will, however, allow the final product to be designated as Darjeeling tea, even if the processing takes place outside Darjeeling, because no matter where the processing takes place, the given quality or

characteristics (such as flavour, etc.) of the final product will essentially be attributable to its geographical origin.

As for a given quality, reputation and other characteristic, TRIPs does not clarify any of these requirements further. Thus TRIPs is silent on whether these requirements imply only such qualities and characteristics, which may be attributed to ‘natural factors’ (e.g. climate, topography, etc.), or whether those characteristics that result from ‘human factors’ e.g. specialised skills of artisans) may also be covered under the definition contained in Article 22.1. Unlike TRIPs, the GI Act explicitly mentions ‘human factors’.

Section 11 (2) (a) of the GI Act, which stipulates what an application for GI registration should contain, refers to the geographical environment, with its inherent natural and ‘human factors’. Again as per section 32 (1) of the GI Rules, an application for a GI is required to be supported by ‘the detailed description of the human creativity involved’ and ‘the particulars of special human skill involved’. The significance of the explicit reference to ‘human factors’ in the GI Act may be appreciated when judged in the light of the fact that India has in its possession numerous handicrafts and handloom products that are apt to be protected as GIs and in the production of these items specialised human skills and craftsmanship play a significant role.

Various Stages of Filing and Grant of GI

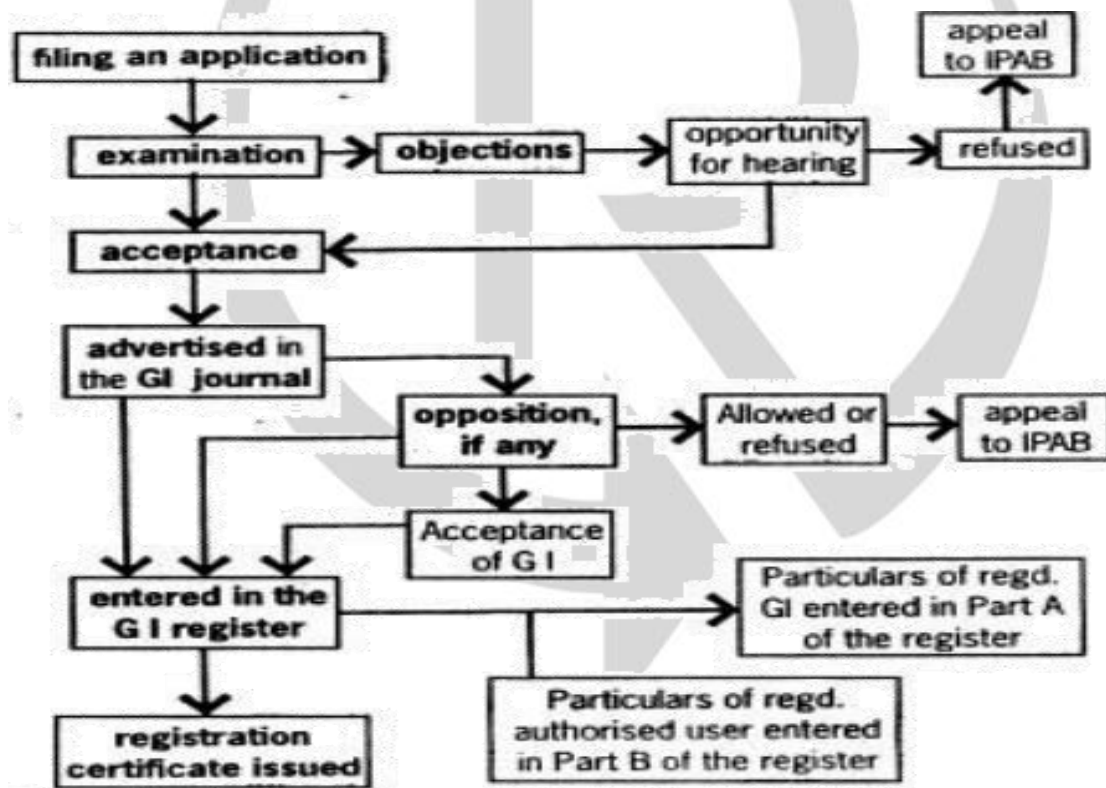


Figure: GI Registration Process in India

Registration of Geographical Indication

The protection is granted to geographical indications through registration. The registering authority is the Registrar of Geographical Indications.

(a) Who can apply for registration?

- (i) any associate of persons;

- (ii) producers; or
- (iii) any organisation or authority established by or under any law representing the interest of the producers of the concerned goods.

(b) Whom to apply?

The application must be made to the Registrar under the Act, the Controller-General of Patents, Designs and Trademarks appointed under sub-section (1) of section 3 of the Trademarks 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.

A full-fledged modern patent office and the country's first geographical indication (GI) registry was put up in Chennai which is really a good step forward in this field. This registry will satisfy the requirements mentioned in the Act further supplementing it.

(c) 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.

(d) Contents of the application

The application for registration must contain the following:

- (i) a statement as to how the geographical indication serves to designate the goods as originating from the concerned territory in respect of specific quality, reputation or other characteristics which are due exclusively or essentially to be geographical, environmental, with its inherent natural and human factors, and the production, processing or preparation of which takes place in such territory, region or locality;
- (ii) the class of goods to which the geographical indication shall apply;
- (iii) the geographical map of the territory of the country or region or locality in which
- (iv) the goods originate or are being manufactured;
- (v) the particulars regarding the appearance of the geographical indication as to whether
- (vi) it is comprised of the words or figurative elements or both;
- (vii) a statement containing such particulars of the producers of the concerned goods, if
- (viii) any proposed to be initially registered with the registration of the geographical
- (ix) indication as may be prescribed; and
- (x) such other particulars as may be prescribed.

On acceptance of this application the registrar of geographical indications shall advertise it. Any person may oppose it within three months from the date of advertisement or extended period of not more than one month. The registrar shall, after hearing the parties, if so required, decide whether and subject to what conditions or limitations, if any, the registration is to be permitted. Thus, where the application has not been opposed and the time for notice of opposition has expired; or the application was opposed and it has been decided in favour of the applicant, the registrar shall register the said geographical indication and the authorised users if any, so mentioned in the application.

Once a geographical indication is registered, any producers of the concerned goods may apply to the registrar for registering him as an authorised user for such geographical indication.

(e) Effect of registration

No person shall be entitled to institute any proceeding to prevent or recover damages for the infringement of an unregistered geographical indication. This forbids the institution of proceedings for injunctions or for damages. Nothing in the Act of Geographical Indications of

Goods shall be deemed to affect the right of actions against any person for passing off goods as the goods of another person or the remedies in respect thereof.

(f) Prohibition of registration of certain geographical indications

Following geographical indications are not registrable under the Act:

- (i) the use of which would be likely to deceive or cause confusion;
- (ii) the use of which would be contrary to any law for the time being in force;
- (iii) which comprises or contains scandalous or obscene matter;
- (iv) which comprises or contains any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;
- (v) which would otherwise be disentitled to protection in a court;
- (vi) 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;
- (vii) Which are determined to be generic names or indications of goods and are, therefore, not or ceased to be protected in their country of origin, or which have fallen into disuse in that country. Generic name or indication means the name of goods which although relates to the place or the region where the goods was originally produced or manufactured, has lost its original meaning and has become the common name of such goods and serves as a designation for as indication of the kind, nature, type or other property or characteristic of the goods.

The registration of a GI shall be for a period of ten years but may be renewed from time to time for an indefinite period.

(g) Rights conferred by registration

It is mandatory to get a geographical indication registered in order to claim any rights in respect of such indication under the Act. However, the rights of action against person for passing off goods as the goods of another person or the remedies in respect thereof shall remain unaffected.

The registration of a geographical indication shall give:

- (i) to the registered proprietor and the authorised user or users the right to obtain relief in respect of infringement of such geographical indication;
- (ii) to the authorised user the exclusive right to the use of the geographical indication in relation to the goods in respect of which the geographical indication is registered.

(h) Special provisions relating to trademarks and prior users.

The Registrar of Trademarks shall, *suomotu* or at the request of an interested party, refuses or invalidates the registration of trade mark which contains or consists of a geographical indication as it would lead to expropriation of a public property by an individual leading to confusion in the market.

The Geographical Indications Act protects a trade mark which contains or consists of a geographical indication which has been applied for or registered in good faith under the trademarks law or where such trademarks have been used in good faith before the commencement of the Act or before the date of filing of an application for registration of a geographical indication. This Act shall not apply to geographical indication with respect to goods or class or classes of goods which have become the common name of such goods in India on or before 1st January 1995. This Act protects the right of any person to use his name or the name of his predecessor in business except where such name is liable to cause confusion or

misled the public. This Act provides that no action in connection with the use of registration of a trade mark shall be taken after five years from the date from which such use or registration which infringes any geographical indication registered under this Act has become known to the registered proprietor or the authorised user.

(i) Infringement of the registered geographical indication

A person, who is not an authorised user of a registered geographical indication, infringes it when he:

- (i) uses a such geographical indication by any means in the designations or presentation of goods that indicates or suggests that such goods originate in a geographical area other than the true place of origin of such goods in a manner which misleads the persons as to the geographical origin of such goods; or
- (ii) user any geographical indication in such manner which constitutes an ‘act of unfair competition’ including passing off in respect of registered geographical indication; or
- (iii) uses another geographical indication to the goods which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the persons that the goods originate in the territory, region or locality in respect of which such registered geographical indication relates.

It is also an infringement to use a geographical indication in respect of goods not originating in the place indicated by such geographical indication, even if true origin of such goods is also indicated, and the geographical indication is accompanied by expression such as “kind”, “style”, “imitation” or the like expression.

(j) Additional protection of certain goods

The Central Government may by notification in the Official Gazette provide for additional protection for certain goods which are notified. A GIs once lawfully acquired their dealing in such goods shall not constitute an infringement less the goods are impaired after they have been put in the market.

(k) Rectification and correction of register

The register or the Appellate Board may cancel or vary the registration of GIs or of an authorised user for the contravention or failure to observe the conditions entered on the register. It enables any person aggrieved by the absence or omission of any entry in the register without sufficient cause or any entry wrongly on the register by the error or defect, to apply to the Appellate Board or the register to pass appropriate orders. The Registrar and the Appellate board can suomoto after giving notice the parties concerned and hearing them, pass appropriate orders for cancelling, varying or rectifying the register.

(l) 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.

Remedies for Infringement of a Geographical Indication

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

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

Civil Remedies

The Act provides for the following civil remedies for infringement of a registered geographical indication;

- (a)** Injunction
- (b)** Damages or account of profits
- (c)** Delivery up of the infringing labels and indications.

These remedies are inclusive, not exhausting and the court may provide some other remedies in addition to the aforesaid, such as Anton Piller order.

(a) Injunction

Injunction includes- temporary injunction and permanent injunction. Further, the court may also order an ex parte injunction for-

- (i)** discovery of documents;
- (ii)** preserving of infringing goods, documents or other evidence which are related to the subject matter of the suit; and
- (iii)** Restraining the defendant from disposing of, or dealing with his assets in a manner which may adversely affect plaintiffs ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.

The aforesaid remedy of injunction is more effective and can prevent a greater harm to the plaintiff.

(b) Damages or account of profits

The remedy of damages or account of profits is not cumulative but alternative. The plaintiff has to elect one of the two remedies at an earlier stage of the suit. The remedy of damages (other than nominal damages) or account of profits may be denied where defendant satisfies the court that he was unaware and had no reasonable ground for believing that the geographical indication of the plaintiff was registered when he connected to use it; and that when he became aware of the existence and nature of the plaintiffs right in the geographical indication, he forthwith ceased to use it.

(c) Delivery-up of the infringing labels and indications

It is in the discretion of the court to order the defendant to deliver up infringing labels and indications for destruction or erasure. The court by taking relevant circumstances into account may or may not order for such remedy. All the aforesaid remedies are also available for passing off action. Passing off actions are initiated against the infringement of unregistered geographical indications.

Criminal Remedies

Criminal remedies are more effective than civil remedies because the former can be disposed off quickly. The pendency of a civil suit does not justify the stay of criminal proceeding in which the same question is involved. Since criminal proceedings directly strikes at the honour and social status of an infringer, in some cases he comes for a settlement out of court to save his prestige. Chapter VIII of the Act deals with offences and penalties for such offences

The Act contains penal provision for violation of various provisions relating to geographical indications given below.

- (a)** Falsifying and falsely applying geographical indications to goods.
- (b)** Selling goods to which false geographical indications is applied.
- (c)** Falsely representing a geographical indication as registered.

- (d) Improperly describing a place of business as connected with the geographical indications registry.
- (e) 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 Act 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 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 element of mensrea is essential for conviction. If mensrea is lacking, the accused may be acquitted. The court may, however, where a person is convicted or acquitted because of lack of mensrea, direct the government to forfeit all goods and things by means of, or in relation to which the offence has 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 without warrant if he is satisfied that any of the offences has been or likely to be committed and all the articles so seized shall be produced before the Judicial Magistrate of the first class or Metropolitan Magistrate, as the case may be as soon as practicable. However, a police officer before making any such search or seizure shall obtain the opinion of the Registrar on the facts involved in the offence and shall abide by such opinion. A person having an interest in may article seized to file an application to the Judicial Magistrate of the first class or the Metropolitan Magistrate, as the case may be, for restoration of such article seized.

The interpretation of certain terms used in the Act is worth mentioning since it helps avoiding confusions and lack of understanding both for judiciary and common man. The expression “indication” has been defined inclusively to include any name geographical or figurative representation or any combination of them conveying or suggesting the geographical origin of goods to which it applies. Thus “indication” suggests or conveys the origin or source of the goods. It may be in the form of name (in full or abbreviation) or representation (geographical) or figurative) or combination of them; for e.g., the name “Scotch” indicates the origin of Whisky as form Scotland. “Darjeeling” is a geographical representation for indicating the origin of tea from Darjeeling (India), the figure of TajMahal on a tea brand.

The definition of geographical indication in the Act is very comprehensive. The important point is that a good should also have an identifiable quality, reputation or other characteristics attributable to its geographical origin. In case of manufactured goods, method of production or process would become an important parameter, what it would mean at the ground level is that people interested in obtaining geographical indication must establish such features in a distinctive manner which may not be an easy task in many situations and may require technical inputs.

Miscellaneous Provisions

No suit or other legal proceedings shall lie against any person in respect of anything which is in good faith done or intended to be done in pursuance of this Act. Every person appointed under this Act shall be deemed to be a public servant. Stay of infringement proceedings can be ordered. A stay of a suit for infringement of a geographical indication shall not preclude the court from making an interlocutory order during the period of stay. In certain cases, specified therein the application for rectification of register should be made to the Appellate Board. Where a geographical indication has been applied to the goods on sale or in contract for sale of goods, there is an implied warranty that the geographical indication is a genuine geographical indication and not falsely applied. The Registrar is empowered with the powers of a civil court, including award of reasonable costs. The Registrar shall have the power to review his own decision. Where the Registrar exercises any discretionary power vested in him adverse to an applicant, such person should be given an opportunity of being heard. The evidence before the Registrar should be normally in the form of affidavit only and in addition to be may take oral evidence.

In case of death of a party to a proceeding during the course of the proceeding, the Registrar on proof to his satisfaction may allow substitution of successor of the party or may allow the proceeding to continue with the surviving parties. The Registrar is empowered to extend the time for doing of act subject to conditions. If the Registrar is of the opinion that the applicant has defaulted in prosecution of his application, he may by notice require the applicant to remedy the defect within a specified time after giving him an opportunity of being heard. He may treat the application as abandoned unless the default is remedied within the time specified by him.

A suit for the infringement of geographical indication shall be instituted only before a district court. The relief which a court could grant in an action for infringement or passing off includes injunctions, damages, or at the option of the plaintiff account of profits. The court may also order for the delivery up of the infringement labels and indications for destruction or erasure. An injunction order may include an ex parte injunction or any interlocutory order including discovery of document, preserving of infringing goods, restraining the defendant from disposing of or dealing with his assets adversely affecting the plaintiff's ability to recover damages or other pecuniary remedies which may be finally awarded by court. The court shall not grant relief by way of damages (other than nominal damages) on account of profits:

- (a)** If the defendant satisfies the court that he was unaware and had no reasonable ground for believing that the geographical indication of the plaintiff was on the register (in case of suit of passing off the geographical indication was in use); and that
- (b)** When he became aware of the existence and the nature of the plaintiff's right, he forthwith ceased to use the geographical indication.

In every proceeding under rectification and correction of the Register authorised user of a geographical indication has to be impleaded.

A certified copy of any entry in the register or any document of indexes mentioned in sec.77 and sealed with the seal of Geographical Indications Registry shall be admitted in evidence in all courts and in all proceedings without further proof or production of the original. A certificate issued by the Registrar as to any entry, matter or thing, he is authorised to do shall be prima facie evidence of the entry having been made and of the contents thereof. The Registrar and other officers shall not be compelled to produce the Register or any other document in his custody in any legal proceedings, the content of which can be proved by the

production of a certified copy issued under this Act, or appear as a witness to prove the matter therein recorded unless ordered by the court for special reasons.

The Central Government may, by notification, require that goods of any class specified in the notification which are made or produced outside India and imported into India to apply an indication of the country or place in which such goods are made or produced with the name and address of the manufactures.

The Appellate Board may grant a certificate of validity of a registered geographical indication or the authorised user in any legal proceedings relating to rectification of the register, and if, in any subsequent legal proceedings as to its validity comes up the said registered proprietor or the authorised user, as the case may be, will be entitled to recover the full cost charges and expenses as between a legal practitioner and his client.

A person, who is a legal practitioner, or a person registered in the prescribed manner as a geographical induction agent, or a person in the sole and regular employment of the principal can appear before the Registrar duly authorised.

The Registrar should maintain:

- (a) An index of registered geographical indications.
- (b) An index of geographical indications in respect of which applications for registration are pending.
- (c) An index of the names of the proprietors of registered geographical indications, and
- (d) An index of the names of authorised users.

The documents such as register, the indexes mentioned in sec. 77 and any other document as the Central Government may specify be open to public inspection at the Geographical Indications Registry. Any person may, on an application to the Registrar and on payment of such fee as may be prescribed, obtain a certified copy of any entry in the register or any document. The Central Government shall place before both the Houses of Parliament once a year a report regarding the execution by or under the Registrar.

Challenges and Problems in the Post-GI Act Regime

The Government of India has established the Geographical Indications Registry with all-India jurisdiction at Chennai, where the GIs can be registered. Authorities claim that this Act has two key characteristics; (i) protection of producers against counterfeiting and misleading commerce, and (ii) striking of balance between trademark and GI protection. According to this Act, once a GI is registered, any person claiming to be the producer of the good designated by the registered GI can file an application for registration as an authorised user. The GI Act is to be administered by the Controller General of Patents, Designs, and Trademarks-who is the Registrar of GIs. The registration of a geographical indication is for a period of ten years. Renewal is possible for further period of ten years. If a registered GI is not renewed, it is liable to be removed from the register.

There are a number of issues and concerns in the context of harnessing the potential commercial benefits out of GI registration in India. Perhaps the biggest concern is near complete absence of an effective post GI mechanism in the country. Which domestic registration of a GI is a relatively easy task and there has been some progress on this account over the last 9 years, it is important to understand that only registration of goods perse does not fulfill the objectives of the Act, unless it is backed by sound enforcement mechanism both, in domestic and export markets. In fact, the enforcement of the Act in other countries is a

much more complicated venture as this may pose a variety of constraints including technicalities involved in the registration process in various foreign countries, exorbitant expenses involved in appointing a watch-dog agency to get information on misappropriation; and huge financial resources needed for fighting legal battles in foreign lands. The Government's role is vital in the post GI mechanism because without government support, most producer groups do not have the wherewithal to effectively defend and promote their GI brand in India, perhaps only in the case of one good i.e. Darjeeling Tea, the Tea Board has had some success in defending against misappropriation in a few countries because they have the financial capacity to do so.

Though the Act defines the cases when a registered GI is said to be infringed, it is silent on the mechanism and provisions to fight against the infringement and this is an area where the government needs to play a larger role. In the opinion of Rajnikant Dwivedi, Director of Human Welfare Association, an association based in Varanasi working with handloom weavers, benefits of GI protection under the GI Act will actually depend on how effective is the post GI mechanism. "Banarasee Saree Weavers Continue to be a distressed lot idle looms have not begun functioning and unscrupulous practices of selling imitation products in the name of Banarasee Saree have not been curbed. Mr. Anil Singh, Director-Need, a Lucknow based organisation and also an applicant in GI registration for Lucknow Chikan craft says that GI may leave the artisans community completely high and dry as the awareness level on GI, the most basic recipe for success of any policy, is alarmingly dismal. The post GI mechanism must have adequate provision for promotion and continuous awareness building. Chikan Craft, being an eco-friendly, gender sensitive craft, has huge potential to increase the bargaining power of the producers; however, this potential has not been tapped. Attempts have been made by the State Government to tap this potential by merging GI promotion with the department of tourism, promoting producer companies and other promotional measures. However, these efforts remain restricted to a few areas where civil society is alive. One of the key concerns that Mr. Singh points out is that a majority of producers do not have the capacity to report and fight an infringement case.

At present, the action related to GI appears concentrated on registration of GI goods and in many cases the state governments are acting in haste. The identification and registration is happening without adequate due diligence. Applicants often do not assess the commercial status /prospects of a GI product in the domestic and export markets; the potential of its GI status in contributing to its future growth; and the socio-economic implications of its GI protection for the communities involved in its supply chain. As a result, the larger and the real objectives of the Act are by passed, often leading to frivolous and consequential registration. Moreover, as GIs are a collective rights and not an individual right, the registration process offers an opportunity for community level sensitization and awareness. However, in the haste to register GIs, this opportunity is lost. The awareness and involvement in the registration process of even GI goods remain reduced to the level of a few selected stakeholders. This has in some cases led to seriously erroneous omissions and commission, defeating the large purpose of the GI Act. In case of Madhubani painting error has been pointed out. Madhubani painting on paper is registered as GI under class 16 which implies that Madhubani painting on cloth is not protected.

Another lacuna is that the definition of 'producer' in the Act does not distinguish between a real producer, retailer or dealer. As a result of this discrepancy, the benefits of the Act may not percolate down to the real producer. Various economically powerful intermediaries may still

continue their control over markets and the real producers may still be dependent on these intermediaries for market access. Even if GI protection would yield financial benefits, in such a scenario, firms with superior bargaining positions (located on the upper stream of the supply chain) may end up appropriating a disproportionate share of the economic value generated from securing protection.

Conclusion

The GI Act, which came into force, along with the GI Rules, with effect from 15 September 2003, has been instrumental in the extension of GI status to many goods so far. The central government has established the Geographical Indications Registry with all-India jurisdiction, at Chennai, where right-holders can register their GI. Unlike TRIPS, the GI Act does not restrict its special protection to wines and spirits alone. The central government has discretion to decide which products should be accorded higher levels of protection. This approach has deliberately been taken by the drafters of the Indian Act with the aim of providing stringent protection as guaranteed under the TRIPS Agreement to GI of Indian origin. However, other WTO members are not obligated to ensure Article 23-type protection to all Indian GI, thereby leaving room for their misappropriation in the international arena. Registration of GI is not compulsory in India. If registered, it will afford better legal protection to facilitate an action for infringement. Once a GI is registered in India, it becomes relatively easier to seek protection in other countries, particularly the member countries of WTO.

Reference

- B. L. Wadehra, Law Relating to Patents Trademarks Copyright Designs and Geographical Indications 513 (Universal Law Publishing Co. Pvt Ltd, Delhi, 2000)
- Id., Section 13(1)
- Id., Section 14 (5)
- Id., Section 18 (1)
- Id., Section 2 (1)
- Id., Section 2 (f)
- Id., Section 20
- Id., Section 20 (2)
- Id., Section 21 (k)
- Id., Section 22 (3)
- Id., Section 25
- Id., Section 40
- Id., Section 41
- Id., Section 42
- Id., Section 46
- Id., Section 50
- Id., Section 55
- Id., Section 56
- Id., Section 57
- Id., Section 58
- Id., Section 6 (6)
- Id., Section 60
- Id., Section 61
- Id., Section 62

- Id., Section 63
- Id., Section 64
- Id., Section 67 (1)
- Id., Section 68
- Id., Section 69
- Id., Section 70
- Id., Section 71
- Id., Section 72
- Id., Section 77
- Id., Section 78
- Id., Section 80
- Id., Section 9
- Id., Section 14 (1)
- Id., Sections 38 and 39
- Kasturi Das, 'Protection of Geographical Indications: An Overview of Select Issues with Particular Reference to India' Working Paper 8, Centre for Trade and Development (centad), New Delhi, India (2007)
- Kasturi Das, Protection of Geographical Indications: An Overview of Select Issues with Special Reference to India, Working Paper: 8; Centad, Delhi (2006)
- L Nair & R Kumar, *Geographical Indications: A Search For Identity* 5 (Lexis Nexis Butterworth's, New Delhi, 2005)
- Section 11 of Geographical Indications of Goods (Registration and Protection) Act, 1999
- Section 2 (g) of Geographical Indications of Goods (Registration and Protection) Act, 1999
- Section 31 of Geographical Indications of Goods (Registration and Protection) Act, 1999
- Section 67 (3) of Geographical Indications of Goods (Registration and Protection) Act, 1999
- W.R. Cornish, Intellectual Property 246 (Universal Law Publishing Co. Pvt. Ltd., Delhi, 2001)
- WTO and TRIPs – An Indian perspective, *available at:* <http://www.indiaonline.com/legal/feat/wtrr.html>. (Accessed on September, 2014)