GEOGRAPHICAL INDICATIONS OR TRADEMARKS? THE DICHOTOMY RESOLVED

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The Calcutta High Court has very recently dismissed a nine year old suit by the Tea Board of India against ITC that alleged infringement of the Board's certification marks and Geographical Indication (GI) rights in the term "Darjeeling". The Board had claimed that the use "Darjeeling" for a premier executive lounge in the name of "Darjeeling Lounge" by ITC in its five star hotel, Sonar, violated its GI rights and asked for a compensation of Rs. 50 crores! Although, the Board has taken active steps to ensure that its rights were protected by securing a GI over "Darjeeling" as well as a certification mark, it was not sufficient. The Court discussed that the rights by registration as a GI were enforceable only in respect of goods and not for services. Owing to this, it was held that the use of the term in the name of the defendant's lounge did not fall in the category of "goods", which for the Plaintiff was confined only to tea. The Court was of the view that as the Board was merely in possession of the GI as well as certification trademark registration under the Trade and Merchandise Marks Act, 1958, but did not obtain a registered trademark under the provisions of the Trademark Act, 1999, the Board would not have full powers on the trademark. The Court noted that registration as a certification mark would not confer the same rights as that of a registered trademark. This comes as a blow to all those having merely obtained GI registrations over certain products. In the interest of future enforcements, it would be suggested that applicants must along with a GI registration also obtain trademark registrations to acquire exclusive rights over the use of a mark. Anand and Anand's view: This highlights the importance of registering trademarks to enforce actions even in context to Geographical Indications.

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