

Legal Issues in ‘Use of a geographical name in a mark’

Issue: Whether including a geographical name automatically disqualifies a trademark for registration?

Relevant Legal Provisions

❖ Section 9(1)(b), The Trade Marks Act, 1999 –

“(1) The trade marks–

*(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, **geographical origin** or the time of production of the goods or rendering of the service or other characteristics of the goods or service;*

Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.”(Emphasis supplied)

Relevant Legal Provisions (Contd.)

❖ Section 35, The Trade Marks Act, 1999 –

*“Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interface with any **bonafide use by a person** of his own name or **that of his place of business**, or of the name, or **of the name of the place of business**, of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods or services.”* (Emphasis supplied)

Relevant Judicial Decisions

❖ *Imperial Tobacco Company of India Limited v. The Registrar of Trademarks.* [AIR 1977 Calcutta 413]

“25. Geographical terms and words in common use to designate a locality, a country, or a section of country cannot be monopolized as trademarks; but a geographical name not used in geographical sense to denote place of origin but used in an arbitrary or fanciful way to indicate origin or ownership regardless of location, may be sustained as a valid trade mark...” (Emphasis supplied)

“39. The propositions of law in respect of geographical names have been referred to above and in view of the imprint of snow clad hills in outline in the trade mark 'Simla' the ordinary or geographical signification is obvious and patent even though it has no reference to the quality or place of origin of the goods as at present advised. Further, registration of such trade mark may hamper or embarrass the trade or traders in or around the locality in future as held by judicial authorities cited earlier in similar cases. Also 'Simla' is too prominent a city, the capital of Himachal Pradesh, well known in the country and abroad and in its ordinary or geographical significance it is inherently neither distinctive nor adapted to distinguish also nor capable of distinguishing the goods of the appellant as a particular trader from those of others.” (Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ *Geepee Ceval Proteins and Investment Pvt Limited v. Saroj Oil Industry* [2003 (27) PTC 190]

“8. ... The word 'Chambal' is a geographical name and a geographical name can be registered as a trade mark if its distinctiveness is proved. Therefore, Section 9 of the Act does not put a blanket ban on the registration of a geographical name as a trademark..... Having regard to the case law cited and the fact of the present case, prima facie, it may be held at this stage that Chambal, although it is a geographical name, is capable of becoming a trademark and action for passing off based on it could be maintained.” (Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ *Hi-Tech Pipes Ltd. v. Asian Mills Pvt. Ltd, 2006 (32) PTC 192 Del. [2006 (32) PTC 192]*

“31. The paragraph referred to by learned counsel for the defendant from the treatise of McCarthy on Trademarks and Unfair competition propounds the principle of false advertising which would arise by geographical designation that is used with the goods which do not come from the place named by the designation. The trade mark in question is ‘Gujarat’. It is general in nature since it cannot be said that the whole of Gujarat is known for any particular business/trade. The treatise of P. Narayanan also explains that for purposes of registration, a geographical name may be so registered upon evidence of acquired distinctive character by use of the word as a trademark in relation to particular goods/services. The position is more or less same with the other examples given by the defendant in relation to registration of Liverpool Cables, Glastonburys’ slippers, Simla for Tobacco and Cigarettes which have been explained in the judgments referred to above.” (Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ *Dubai Islamic Bank v. Union Of India & Ors* [W.P. (C) 12749/2019]

“11. The mark - 'DUBAI ISLAMIC BANK - THE BETTER WAY TO BANK' is clearly a composite mark, which does not just have the words 'Dubai' and 'Bank', but also has a slogan. Such a mark should not have been refused simply on the basis of the fact that there is an indication of the geographical origin i.e., the word DUBAI. Obviously, when a bank seeks a trade mark registration, the word 'Bank' usually appears in the mark. The appearance of the said word would not by itself make the mark inherently descriptive or make it lack distinctiveness. A perusal of the illustrative list above shows that the names of most banks use a geographical name, the word 'Bank', as also a slogan...” (Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ *Armasuisse v. The Trade Mark Registry & Anr.* [2023/DHC/000019]

“36. Even it is accepted for a moment that the impugned mark is a Swiss appellation/geographical indication under Swiss laws, the same is of no effect as the Swiss laws have no force and applicability within India and from my personal knowledge SWISS MILITARY is not registered as a geographical indication in India under the provisions of the Geographical Indication (Registration and Protection) Act, 2002.” (Emphasis supplied)

“153. This impression is not attributable solely to the red-and-white colour scheme of the mark. The words SWISS MILITARY‘ have a large part to play in the impression that the mark would carry. It would be folly to analogize a mark such as SWISS MILITARY‘ with a mark such as, for example, PETER ENGLAND‘ which, as a phrase has no etymological meaning at all, so that it becomes instantly fanciful, and can, therefore, be kept out of the reckoning. SWISS MILITARY‘, however, conjures up an instant mental picture of the Swiss military establishment. A mental connection with Switzerland is, therefore, inevitably made. That, by itself, satisfies the requirement of —causing confusion|| envisaged by Section 9(2)(a). (Emphasis supplied)

Conclusion

- ❖ Section 9(1)(b) of the Trade Marks Act, 1999 clearly prohibits naming a trademark on geographical origin. However, Section 35 envisages that a person who uses the place of his business as its trademark in a *bona fide* manner can do so and nothing in the Act can interfere with the said use.
- ❖ In order to secure registration of geographical names in trademark is through proving that geographic name used in trademark has no relation whatsoever with the goods for which it is applied.
- ❖ A secondary significance or an acquired distinctiveness is also paramount for registration of a geographical name sans the name of a major city, town, country, industrial hub, or a major commercial hub/place and the name should not describe the origin of goods.

THANK YOU!
Questions?

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