



A CRITICAL ANALYSIS OF THE LEGISLATIVE FRAMEWORK ON THE PROTECTION OF GEOGRAPHICAL INDICATIONS IN SRI LANKA

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INTRODUCTION

Geographical indications (GI) simply entails the meaning, a labeling system which recognizes a product or goods originating from a special and unique geographical area having and possessing the unique characteristics. (Larson, 2007) In Sri Lanka, Ceylon Tea, Ceylon cinnamon, black pepper, blue sapphire from the City of Gems-Rathnapura, Panang Kaddi (palmyrah jiggery), Parithithurai Vadai (Point Pedro spicy flat vades), Malwana Rambutan, Siyane Pineapple, Jaffna Mango and Buffalo curd of Ruhuna, are some of the items that can be added to this list of origin-linked products (Punchihewa N. S., 2021). GI comes under the scope of intellectual property and is protected under the Intellectual Property Act. When compared with a trademark, the uniqueness of a GI is the link between the product and the geographical origin (territory or region) (Punchihewa N. S., 2017) TRIPS Agreement defines GI as indications which identify a product as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin. Even though the TRIPS Agreement specifically focuses on the protection of GI it doesn't specifically mandate a specific mechanism to the member countries to protect the GIs. The Agreement confers unfettered discretion to the member states to determine their own procedure in which the protection to be granted. Countries like India, Thailand have a separate legislation (sui generis protection) aimed at protecting the GIs. Preventive method of protection include unfair competition law and consumer protection. Sri Lanka possess both the preventive and positive method. Recently with the enactment of the Intellectual Property (Amendment) Act No 8 of 2022 (hereinafter Amendment Act), the registration process was introduced for the GIs and this was a long awaited amendment to the Intellectual Property Act. The registration of GIs was first brought up by 2018 (Amendment) Act No 7 of 2018 where new sub section (4A) was added immediately after subsection 4 of Section 161 of the Intellectual Property Act, No. 36 of 2003 and it empowered the Minister to prescribe any geographical indication in respect of any goods or products for the purpose of this Act. But the Act was not promulgated by the needful regulations for setting up the needful registration mechanism and the efforts. (Marsoof, S., 2017). In this backdrop the paper aims to analyze the new provisions of the Amendment Act which was enacted with the target of conferring and recognizing the GIs via registration process and to determine to which extent the aforesaid Amendment would be beneficial in giving due recognition to the GIs in the national and international sphere.

LITERATURE REVIEW

Sampath Punchihewa in his Article titled "Branding of Tourism-Related Products and Services for a Competitive Advantage in Sri Lanka an Intellectual Property Perspective" has defined a GI a source identifier that has great economic potential, especially for a developing economy like Sri Lanka. He further elaborates that when compared with a trademark, the uniqueness of a GI resides in the link between the product and the geographical origin (territory or region) it reflects. For this reason, a GI derives its characteristics from the region's unique environment, namely; the natural (climate, conditions of soil etc.) and human (historical context, intergenerational skills and know-how) factors (Punchihewa N. S., 2021)



In a co-authored Article titled “the protection on Geographical Indications in developing countries: A case study of Ceylon Tea” by Ruwanthika Ariyaratne and Sanath Wijesinghe, emphasized that GI serves as the marketing tool, providing consumers the information about special qualities and attributes of a product. They elaborate that it is not easy to establish a reputation as GI. It requires a long time, patient application and sustained commitment. Therefore the owners of GI are required to take measures against direct or indirect use of any false indications, unfair competition or any other malpractices in relation to GIs. (Ariyaratne,R.,Wijesinghe,S.S., 2015)

Naazima Kamardeen in her Article titled “The Potentials, and Current Challenges, of Protecting Geographical Indications in Sri Lanka” she points out that A sui generis system for GI protection is also based on a national registration system under which GIs are registered in a national registry administered by the national authorities. In addition to the general rules set by TRIPS, individual countries may set administrative procedures for the national protection and registration of GIs (Kamardeen,N., 2017).

An Article titled “Does Sri Lanka Need a System for Registering Geographical Indications?” by Althaf Marsoof highlights the need for a registration of the GI .He elucidates in recent times, industries that rely on GIs to promote their goods globally have raised concerns about the lack of a registration system for GIs in Sri Lanka. For instance, the Spices and Allied Products Producers’ and Traders’ Association, which represents the interests of Cinnamon producers, has taken the view that “GI registration will not only help [producers] to market and promote Sri Lankan spices and allied products but also to safeguard them against the violators of the law in the international market (Marsoof,S., 2017)

Many GIs have acquired valuable reputations which, if not adequately protected, could be misrepresented by dishonest commercial operators. False use of GIs by unauthorized parties is detrimental to consumers and legitimate producers. The former are deceived and are falsely led into believing that they are buying a genuine product with specific qualities and characteristics while they in fact get an imitation. The latter suffer damage because valuable business is taken away from them and the established reputation for their products is damaged. (Jain, 2009)

“The Potentials, and Current Challenges, of Protecting Geographical Indications in Sri Lanka” by Naazima Kamardeen emphasised that one major hurdle in the protection of GIs in Sri Lanka to date, namely, there is no registration-based system for GIs under the Sri Lankan GI regime. Instead, producers have to turn to the trademark system to obtain a trademark registration through which they can protect their geographical names. Generally, this involves applying for a certification or collective trademark under Sri Lankan trademark law. The lack of a registration-based system under the Sri Lankan GI regime has attracted criticism and raised concerns about the functionality, enforcement procedures, and level of protection and has prompted a call for an update to ensure that Sri Lankan products enjoy fuller protection (Kamardeen,N., 2017)

The new Amendment Act for registration for GI will enable products such as Ceylon Tea, Ceylon Cinnamon, Ceylon Pepper and Ceylon Cashew to register as Sri Lankan Geographical Indicators, thereby establishing a legal framework to stop counterfeiting under these names. (Parliament of Sri Lanka , 2022)

However, Sri Lanka has not been able to expand local protection for several other similarly unique products yet due to several reasons. The absence of a national registry in the sui generis system and



the costly nature of obtaining trademark protection, which require annual renewals, are among the most salient reasons. Added to this, the relevant authorities are not actively identifying potential products and encouraging stakeholders to protect their unique products. Furthermore, stakeholders, especially producers, are not aware of the GI system and there is no mechanism to support stakeholders to obtain local GI registration. The delay in local registration hinders the international registration as it is a prerequisite to go for international registration. (Rasangi, 2022)

METHODOLOGY

Methodology of this research paper is mainly founded on qualitative methodology. A desk review is undertaken in relation to the provisions of the Paris Convention, Lisbon Agreement, Madrid Agreement, and TRIPS Agreement, Intellectual Property Act and the Amendment Act which also comprise as primary sources of the research. The literature extracted in the Scholarly Articles, law journals etc comprise as secondary sources of the research.

RESEARCH OBJECTIVES

The main and foremost objective of this paper is to have an in-depth analysis of the legislative provisions of the new amendment Act and to analyze whether the new amendment has contributed substantially in protecting GI. The paper also strives to engage in a comparative analysis of foreign Jurisdiction in relation to the legislative framework which deals with GI.

RESULTS AND DISCUSSION

In the international context there are 4 main multilateral treaties which deal with the protection of GI. They are Paris Convention, Lisbon Agreement, Madrid Agreement and TRIPS

International Regime

The Paris Convention for the Protection of Industrial Property 1883 is the first multilateral agreement which included “indications of source or appellations of origin” as objects of protection. Even though the Convention identifies geographical indications it doesn’t define what is a geographical indication. Convention was the first multilateral agreement to provide specific rules for the repression of false and deceptive indications of source (O’Connor, 2005). Madrid Agreement on repression of false or deceptive indications of source aims to improve and expand the provisions of the Paris Convention regarding the repression of false indications of source. The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration was concluded in 1958. The Convention defines “appellation of origin”, the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors. Had Sri Lanka been a party to the Lisbon Agreement 1958, it would no doubt have made sense to incorporate a domestic registration system for GIs, as registration would have been necessary for the recognition and protection of GIs as such in the country of origin—a prerequisite to obtaining—international registration. Thus, unless Sri Lanka joins the special union comprising the signatories to the Lisbon Agreement 1958, the perception that domestic registration of GIs leads to—international registration is completely mistaken (Marsoof, 2017)

TRIPS, the overarching instrument under the WTO Agreement specifically deals with protection of GI. Article 22 of TRIPS defines Geographical indications as indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality,



reputation or other characteristic of the good is essentially attributable to its geographical origin. This article stipulates, Members shall provide the legal means for interested parties to prevent: (a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good; (b) any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967).

Intellectual Property (Amendment) Act No 8 of 2022

As per the Amendment Act 2022, section 6 inserts a new section 160 A to section 160 of the Main Act and defines GI as an indication which identifies any goods as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin. Goods include any manufactured or naturally available agricultural products foods wines spirits or any item of handicraft or industry. The same definition can be seen attributed to GI in the Intellectual Property Act No 36 of 2003 and the definition comes under the interpretation section to the chapter named marks and trade names. With the new amendment Act the definition was inserted to the chapter named geographical indications thereby making it perhaps easier to read and making the GI section more coherent.

Section 2(e) of the Indian Geographical Indications of Goods (Registration and Protection) Act, No. 48, (1999) 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 a 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 the 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. The definition seems to be an exhaustive one without leaving any ambiguity as to what constitutes the term any goods. It also says that any name which is not the actual name of the region or locality of that country is also eligible for protection as a GI. 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. So a wide meaning has given to both goods and indications.

Names which cannot be per se be registered

161A deals with admissibility of geographical indications for registration. The section also can be introduced as an exceptions which is also akin to the negative protection of GI .It lists out circumstances in which a GI is refused for registration .If a GI doesn't comply with the given definition if it is contrary to law, morality, religion ,accepted customs or public order or that is not or that ceases to be protected in the country of origin as a geographical indication or which has fallen into disuse in such country or if the GI is identical with the term customary in common language as the common name of the relevant good or that misleads or deceives the public as to the characteristics nature quality place of origin and production process of the good or its use or which constitutes the name of a plant variety or animal breed. Sub Article 3 of Article 22 of the TRIPS Agreement permits the legislation to refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public



as to the true place of origin. Sub Article 9 of Article 24 emphasize that no protection shall be afforded to the geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country. The Agreement only identifies several grounds for the basis of refusal for registration whereby the new amendment has expanded its horizon and thereby has introduced many grounds in which a GI can be refused for registration. In India as per the Geographical Indications of Goods (Registration and Protection) Act, No. 48, (1999) the use of which would be likely to deceive or cause confusion; or the use of which would be contrary to any law for the time being in force; or which comprises or contains scandalous or obscene matter; or which comprise or contains any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India or which would otherwise be disentitled to protection in a court or 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 or 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, as the case may be shall be refused to be registered. The registration of GI in India is subjected to a high scrutiny based on the grounds of refusal and the grounds are made clear and precise in determining whether to refuse or not.

Registration Procedure

Who can apply for registration?

GIs are collective interests where all producers in the region in which a particular product originates have an interest over a GI. (Marsoof, 2017) Section 161 B deals as to who can apply for registration and how a person can apply for registration. As per the section any association of persons or producers or any organization or authority established by any law representing the interests of the producers of any relevant goods can make the application for registration of the respective GI to the Director General. So it is apparent that the new law has recognized and has given the opportunity to a variety of people to apply for registration making the registration accessible to a wide range. The section gives a room for a wide interpretation so as to include not only producers but also consumers, public officials, divisions, government sectors, state enterprises, local administrations or any other government organizations, legal persons responsible for the geographical area in question. The collective nature of the interests of the GIs is shown by the section where the collective nature of interest can be seen in the Indian Act. The section ensures that the interests of producers of GI-related products are represented during the process of registration and the subsequent maintenance of those registrations. Section 11 of the Indian Act prescribes the application for registration of a GI. Section 11(1) states that any association or organization of producers or persons claiming to represent the interest of the producers can get the concerned goods registered by following a specific procedure.

The documents that has to be submitted along with the application is not clear and precise in the new Amendment Act. The Act should have made provisions to provide along with the application the name, address and nationality of the person making the application and the capacity in which the applicant is applying for registration, the geographical indication for which registration is sought, the geographical areas to which the geographical indication applies, the goods to which the geographical indication applies, the quality, reputation or other characteristic of the goods in respect of which the geographical indication is used, description, technical information, and documents explaining the physical, chemical and micro-biological characteristics a description of the raw materials and specific conditions of the production methods used and, , the authentic local techniques and conditions should



be included. A map of the territory of the county, region, or locality in the country, in which the goods originate or are being manufactured are required to be submitted when applying for registration. The section is also unclear whether the applicant is able to withdraw his application at any time before registration. Section 11(2) of the Indian Act lists the components of such an application. It must include a statement as to how the good is concerned with a specific territory, in respect of its inherent natural and human factors and production. Also, the respective class of goods, geographical map of the territory, particulars of its appearance and of the producers must be mentioned. Form GI-1 (which is mandated to be filled as a part of the procedure) suggests that the applicant group should identify an 'Inspection Body' which is responsible for quality control of the products within the GI.

Once the registration applications are submitted as per section 161B, if Director General is of the opinion that the GI is admissible under section 161 A he shall publish in gazette the application submitted within two months from date of receipt of the application as per section 161C. Section 161 D deals with opposition to registration if any person in public is in opinion that the GI published under section 161 C is inadmissible under section 161 A, within 3 months from date of publication shall send a notice of opposition to the registration of the GI specifying the grounds in which such GI is inadmissible for registration. The new Amendment Act provides for the possibility to oppose the proposed geographical indication registration. Any natural or legal person with a legitimate concern may file an opposition by sending a duly substantiated written notice of opposition to the Director General, and a copy of the opposition notice will be sent to the applicant. the applicant is expected to reply to the opponent with a counter-statement, within the three months from date of receipt of notice as prescribed by the Act .But the Act is silent as to the case when the opponent abandons the statement of opposition, whether it is the responsibility of the Director General to nevertheless consider the opposition and to make a final decision regarding the registration after requesting scientific or technical assistance of various independent bodies

Section 161 E stipulates the registration is valid for 10 years from date of application, unless it is cancelled. The protection validity period can be introduced as a conducive period for effective protection of GI. In India a ten-year renewable period is in place.

Chapter XXXIIIA deals with issue of certificate of registration and the register of GI .section 161F states upon the registration, Director General shall issue the certificate of registration to the applicant who shall be the owner of the GI .161G deals with the register of GI. A register of GI shall be kept and maintained by DG where all registered GI shall be recorded in the order of their registration. The Register shall include the name of the GI, number of registration name and address of the registered owner date of application and registration list of goods in which the registration of GI has been granted, summary of specification map of the geographical area, specification and associated control plan .Any person can by paying the prescribed fee examine the register ad obtain certified extracts

Chapter XXXIIIB deals with the rights of a registered owner and administration of register of GI .As per the section 161 H the registered owner of a geographical indication shall be entitled to in respect of goods of the same kind as those to which the geographical indication applies any direct or indirect use, misuse imitation or evocation of a GI not originating in the place indicated by the geographical indication or not complying with any other applicable requirement for using the GI even where the true origin of the goods is indicated or the GI is used in translated form or accompanied by expression , style ,kind ,type ,make , imitation ,method and produced in like similar can direct or indirect use or misuse imitation evocation of a GI which constitutes an act of unfair competition. any other practice likely to mislead consumers as to the true origin ,provenance or nature of the goods



including an agricultural products food wine or spirit handicraft manufactured and natural goods .for goods that are not of same kind as those to which the GI applies direct use or misuse of the GI

16I I emphasis any GI registered under the Act shall not become a generic which refers to the name that is generally known as the common designation of the good registered as a geographical indication.

Chapter XXXIIIC deals with cancellation of registration of GI .Section 16I J stipulates the grounds for the cancellation of GI. DG is empowered to cancel the registration upon several grounds such as if the GI lose their special characteristic as GI goods, if the registered owner fails to comply with the conditions and requirements or if the registered owner request to do so in writing to the director general or if the registered owner fails to renew the registration as per 16I E.

Chapter XXXIIID deals with the foreign GI whereas section 16I K empowers any foreign GI may be registered in Sri Lanka as long as such GI is protected in its country of origin as a GI or a certification mark .

Section 16I M permits an owner of a GI who has already registered GI as a certification mark to register the same as a GI under this Act .So the section gives the opportunity to the GI which was previously registered as collective marks to be registered under the new Act .The missed opportunity to the previous GIs has been conferred by giving the retrospective effect.

A way forward-Lessons from Serbia

Serbia has very recently even gone a step further by registering its very first geographical indication for services offered in Zlatibor, a mountainous region in western Serbia known for its “Golden Pines”.The geographical indication of origin in question refers to the provision of health-tourism services provided exclusively in the Zlatibor region, and more particularly on the territory of the municipality of Čajetina. Registered under the indication Čigota, a mountain pass in Zlatibor, this specific service epitomizes a well-balanced mixture of natural and human factors such as, on the one hand, clean air with low humidity, specific light ion concentrations, an absence of allergens, and high pH levels in water, and on the other, a highly skilled medical and diagnostics staff (Kojić, 2018).the inclusion of services under the gamut of GI can be recognized as an incredible shift in the world. Inclusion of services into the gamut of GI would also be taken as a fresh approach to the legislature in making new amendments in protecting GI and bringing them to the next level.

CONCLUSION

It is apparent that from the above analysis ,the provisions of the Amendment Act has provided a conducive legal background for the proper protection of the GIs .The registration procedure ,cancellation of the registration on some grounds, registration of GIs which were previously registered as certification marks, rights conferred to a registered owner of a GI could be treated as the most significant provisions in the Amendment Act .Via a concrete sui generis nature of protection ,the indications which are having specific and unique attributes, attached to the geographical area can be given due recognition in the national and international platform .

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