

## Trademark and WHO: A Legal Battle for Human Health

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### Abstract

Tobacco use remained the basic and leading cause of deaths of approximately 5.4 million people in the world per year and it is expected to increase more than 8 million people by 2030 if the tobacco consumption remains constant. WHO/FCTC is a very recent initiative by WHO which aims to reduce tobacco use by giving awareness to general public about the harmful effects of the tobacco use on health and environment and its terrible impacts on economy.

The aims and objectives of plain packaging are to reduce tobacco use and to save world from the devastating effects of tobacco use. It has been proved that plain packaging is an effective, inexpensive and powerful tool to dispel the effect of advertisements and show the ultimate truth about its use. The health warnings in shape of images call upon the emotional response and lead the tobacco consumer to reduce or quit the tobacco use. All activities on tobacco packages which promote tobacco use by any mean, whether they are trademarks, logos, colour scheme or graphics are banned.

The clash between the plain packaging and the trademark is that, the plain packaging distressed two main functions of trademark and hinders the right of the tobacco industry to use their trademark and take due benefit thereof. At the first hand, the plain packaging may jeopardize the function of a trademark to indicate its trade origin. Now on the one hand is welfare of the people and on the other hand sanctity of trademark law which ensure the welfare of the traders. Which principle of law would bifurcate their interest in just and fare manners?

**Keywords:** WIPO, PIPO, WHO, WHA, TRIPS, WTO, FCTC, Plain Packaging

### Introduction

Broadly speaking Intellectual Property Rights refer to the legal rights originated from the intellectual activities in the field of Science, Industry and literature. Different countries have framed laws to protect Intellectual Property Rights owing to, two basic reasons (*The Concept of Intellectual Property*, n.d., p. 3). One is to give statutory rights to the economic and moral interests of the creators and to recognize the right of the public to access to those creations, after a certain period of time, against economic and monopolistic rights. The second reason is the policy of the government to promote and encourage creativity and dissemination of technology. Actually Intellectual property rights grants certain time limited rights to control the use and production of commodities and subsequently safe guard the rights of the creators form different stake holders. Intellectual property rights are traditionally divided into two main branches i.e. industrial property which includes Patents, Trademarks and Geographical indication and Literary and artistic work which includes copyright and its related rights. First ever International convention for the protection of Industrial Property was concluded on 20 March 1883 that was Paris convention<sup>1</sup>. Another important convention for the protection of literary and artistic work was Bern convention<sup>2</sup>. Intellectual property rights are the emerging rights in all over the world and developed countries are earning huge economic profits

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<sup>1</sup> The Paris Convention for the protection of Industrial Property, was signed in Paris, France, on 20th March 1883, was one of the first intellectual property treaties. It established a Union for the protection of industrial property.

<sup>2</sup> The Bern Convention for the protection of literary and Artistic works usually known as Bern Convention, is an International agreement governing Copy Right, which was first accepted in Bern, Switzerland, in 1886.

from these rights by taking benefits of certain monopolistic privileges. So far as our current article is concerned our focus would be on one of the main component of first branch of Intellectual Property Rights i.e. Trademark.

What is a trademark? The answer is, anything or any sign which could be visually perceived or a specific sound or smell of any specific product, could be a trademark.(Hansen, 2009, p. 74) Any sign which distinguished a product from other products of same nature can be a trademark. Trademark entails a guarantee about the quality of a product. Thus consumer's trust is associated with the trademark. Trademark can be a sign, a symbol, a logo, package design or even a sound. WIPO (World Intellectual Property Organization) has defined the trademark as,

"A trademark is a distinctive sign which identifies certain goods or services as those produced or provided by a specific person or enterprise. ("Trademarks," n.d.)"

Trademark Ordinance, 2001 of Pakistan defines trademark as,

"Trademark" means any mark that could be presented graphically which is proficient of distinguishing goods or services of one enterprise from those of other enterprises(Trade Mark Ordinance, 2001, S. 2(xivii).) "

Trademark law provides protection to the marks which are distinctive but not ordinary("Trademark Legal Basics | Trademark Licensing Office | Iowa State University," n.d.). The generic and common names which describe the products itself cannot be protected as trademarks. The distinctiveness is one of the basic conditions for a valid trademark. For example "Apple" for computers is a distinctive mark but it cannot be used for apples itself.(Chaudhary & Iqbal, n.d., p. 18) Distinctiveness is judged with goods that are attached with the trademark. For example, Apple and Canon for computers and cameras respectively are the best examples of distinctiveness.

### **Historical Background**

History of trademark is as old as the history of trading goods itself. History of trademarks can be traced back to 3000 years ago(Chaudhary & Iqbal, n.d., p. 19). Some accounts of the history traced the origin of trademark protection from Greek and Roman times(Bently, Davis, & Ginsburg, n.d., p. 01), and some evidences traced its origin from British legal regime(Schechter, 1999, p. 20) which seem more authentic. Trademarks have evolved from the transportation of goods from one place to another. Traditionally, traders and farmers were used to mark their goods to indicate their ownership. These marks were called "proprietary marks". In the same way, merchants also marked their goods before consignment so that they can identify them in case of any disaster. These marks were called "merchant marks"(*The History and the Development of Trademark Law*, n.d.). Guilds were the trade organizations and they assured their customers about the quality of their goods. In case any member had low quality goods from guilds standard, guilds marked those goods so that unsatisfactory goods can be identified.(Bently & Sherman, 2008, p. 35) Traders had to affix these marks because trade organization's compulsion therefore these marks were also called "police mark".(Bently & Sherman, 2008, p. 36) Craftsmen also used to mark their unique paintings to identify the goods which they have created. These marks were also used to distinguish the goods but it is difficult to say that these marks were trademarks as in sense of today's modern world. The symbols which were used by the Romans during the transportation of the goods in Mediterranean Sea had been considered trademark almost like today.

Around the 10<sup>th</sup> century the usage of marks in shape of symbols among the traders had increased considerably. In the middle ages, through "proprietary marks", "merchant marks" and "police marks" the modern system of trademark had evolved. Gradually and with the advancement of

the Industrialization free trade were established and the marks began to be used frequently and a system of trademark law had developed resulting with the civil and the criminal litigation in case of violation.

France was the first country which introduced the law for the protection of company names in 1803(Duguid, 2009, pp. 3–37) and declared it a crime to use any name of the company without prior permission of the company's owner. After that in 1946(Morris, n.d., p. 03) America enacted Lanham Act for the protection of trademarks. Paris Convention<sup>3</sup> was the first International legislation concluded in 1883, for the protection of industrial property at international level<sup>4</sup>. Article 02 of the said convention required that the member states should protect the industrial property including trademarks of other member's states. The basic function of trademark is to facilitate the customer to identify goods of a particular company or to distinguish the products of one enterprise from other enterprise(P.C, n.d.) beside this following are the functions of trade mark(P.C, n.d.):

- Facilitate the consumer to distinguish the products of one undertaking from others;
- Work as advertising tool to promote brand image and reputation;
- A valuable asset of any company;
- A company can license or franchise its trademark and earn revenue(*General Information, what is a trademark*, n.d.);
- To restrict company to maintain the quality of its products.

### **Tobacco Use and Public Health**

It is an established fact that the use of tobacco causes death. First experimental evidence about the adverse effects of tobacco consumption came in 1761. John Hill, a physician, in London, claimed that snuff may cause nasal cancer which has been observed in several patients(Morris, n.d., p. 03). In 1836, Samuel Green, warned that smoking causes thousands of lung diseases and tens of thousands are dying from these diseases annually(*Why Tobacco is Public Health Priority.*). Tobacco consumption causes more than one dozen diseases. More than 5 million people are dying from direct use of tobacco products and 600 000 are dying from second hand smoke every year(“WHO | Reducing the appeal of smoking – first experiences with Australia's plain tobacco packaging law,”). It is directly responsible for 1 in 10 adult deaths(*Why Tobacco is Public Health Priority.*). Tobacco use is main cause of heart related diseases and it is estimated that 11% of deaths from heart disease are due to tobacco use(*Why Tobacco is Public Health Priority.,.*). Tobacco consumption plays a leading role in more than 70% deaths from lungs cancer and trachea. Tobacco use causes premature birth low weighted birth, and infant death (“Tobacco Use | Healthy People 2020,” n.d.).The Surgeon General's Report in America referred that the smoking is generally harmful for smokers as, it almost, troubles every organ of the body. Moreover, the report suggests that list of diseases due to smoking is increasing day by day and smoking is the basic cause of cervical cancer, kidney cancer, pancreatic cancer and stomach cancer(“2004 Surgeon General's Report Highlights,” 2019). One of the ingredients of tobacco products is nicotine. It approaches to brain within 10 second once it is inhaled and it is found in every part of body including breast milk once it has been

<sup>3</sup> Paris Convention signed in 1883 it provides two fundamental patent rights: (1) citizen or resident of any signatory country will enjoy in all signatory countries the rights each signatory country grants to its own citizens and residents; (2) citizen or resident of any signatory country, within 12 months (6 months for trademarks) after filing a patent in the home country, can file an application in any signatory country to receive the benefits of the original filing date. Its full name is 'International Convention For The Protection Of Industrial Property.' <http://www.businessdictionary.com/definition/Paris-Convention.html> last accessed on 22-01-2015.

<sup>4</sup> Ibid.

used (“2004 Surgeon General’s Report Highlights,” 2019). Carbon Monoxide binds haemoglobin in red blood cells and stop affected cells from carrying a full load of oxygen. If the tobacco use remains as it is, the death rate due to tobacco consumption is expected to increase 8 million people by 2030 (“2004 Surgeon General’s Report Highlights,” 2019).

Different measures have been adopted by the states at the national and international level to fight war against tobacco epidemic. WHO always remained the part of that struggle. Now WHO has introduced a legal instrument namely Frame work Convention On Tobacco Control (FCTC) in continuity of his struggle against tobacco use. WHO through Frame work Convention On Tobacco Control (FCTC) introduced the concept of Plain packaging and the Australia is the first country to implement WHO's legislation of plain packaging of tobacco products. The government of Australia is considering the plain packaging a long term investment for the preservation of public health (“WHO | Reducing the appeal of smoking – first experiences with Australia’s plain tobacco packaging law,” n.d.). Plain packaging aims to reduce tobacco consumption by reducing attractiveness, increasing noticeability of health warnings and images on tobacco packaging.

Tobacco industry is opposing the plain packaging laws on the ground that the measures taken by Australian government are repugnant to many International treaties. Tobacco Industry argued that there is no conclusive evidence that the measures introduced by the FCTC will necessarily reduce the tobacco intake. They argued that various studies had shown that the proposed labelling and packaging measures have no effect on the habitual smokers. They referred many studies in this context and argued that the new packaging and labelling measures could work as backfire. As Dr. Robert Ruiter and Dr. Gerjo Kok wrote a letter to the editor of European Journal of Public Health and express their concerns over plain packaging that the regular smokers have intention to quit the smoking when they notice fear arousing messages. However when they are asked to give up smoking their priority was other health behaviours as compared to quitting smoking. It has also been observed that the smokers paid more attention on less frightening messages (C. Ruiter & Kok, 2005, pp. 229–230). On the other hand, proponents of the plain packaging referred many studies which show that the plain packaging called upon emotional response from the smokers and they reduce the use of tobacco products or quit it. A Canadian report published in 1995, ‘When packages can’t speak: possible impacts of plain and generic packaging of tobacco products’ compared branded packs with plain packs and suggest that plain packs are perceived as ‘dull and boring’, cheap-looking and reduce the flair and appeal associated with smoking (Freeman, Chapman, & Rimmer, 2008a, p. 10). However, it seems plain packaging somehow affect the decision of the smokers whether they are regular smoker or occasional once.

### **Plain Packaging and the World Health Organization’s “Framework Convention on Tobacco Control (FCTC)”**

The FCTC (Frame Convention on Tobacco Control) is newly introduced international treaty. It is negotiated under the patronage of the World Health Organization (WHO) and entered into force on February 27, 2005 (Division & Health, n.d.-a). FCTC aims to protect the current and upcoming generations from distressing health, Social, environmental and economic impacts of tobacco consumption.

The new treaty on tobacco control is the first International legal instrument designed to encourage multilateral collaboration and action at the global and national level to reduce the growth and spread of the global tobacco outbreak. This treaty suggests international cooperation on tobacco control measures to be implemented by parties at national, regional and International levels.

Article 19<sup>5</sup>, of WHO's constitution authorises the organization to work for the protection of public health( *constitution world Health Organization \_en.pdf*, n.d.). World Health Assembly a high level policy making body of WHO, is also vested powers to adopt standards, made legislations and sign conventions for the protection of international public health. The idea to work on international tobacco control law was presented by the WHO expert committee on smoking control in 1973 which was chaired by Sir George Godber of United Kingdom. In 1989, Professor V.S. Mihajlov(Ayala, 2016), wrote an article on the possibility of an International Legal Framework for Tobacco Control. In 1993, a lawyer and law professor of the United States of America, Dr. Ruth Roemer, started a campaign for global tobacco control legislation(Division & Health, n.d.-b, p. 04). Roemer introduced the idea of International treaty law as a public health approach to tobacco control. Dr Roemer, with one of her colleague Dr Allyn Taylor<sup>6</sup> and an official of WHO Mr. Neil Collishaw<sup>7</sup>, prepare a draft that became the basis of Frame work Convention on Tobacco Control<sup>8</sup>.

In May 1995, World Health Assembly (WHA), in its 49<sup>th</sup> meeting adopted a resolution for the protection of public health on international level. As a result of resolution, WHO was requested to draft a feasibility report to be presented by the Director General in 97<sup>th</sup> session of the WHO Executive Board(Division & Health, n.d.-b). The report was named as "The Feasibility of an International Instrument for Tobacco Control". After the presentation of the feasibility report by Director General of WHO, the executive board of WHO adopted resolution "International Frame work Convention for Tobacco Control".

Despite adoption of tobacco control resolution, the treaty making process faced lack of political will and policy direction at international level. In 1998, newly elected Director General Dr. Gro Harlem Brundtland of WHO declared that tobacco control is his top priority and treaty making process witnessed a tremendous boom(Albuja, 2008). Under the supervision of new Director General negotiations for formulation of treaty started. 57<sup>th</sup> meeting of WHA(world Health Assembly) paved way for multilateral negotiations on WHO framework convention on tobacco control; two bodies were formulated, consisting of experts on different related fields, to prepare the draft and then submit it for final consideration and for the completion of the negotiations with member states(Roemer, Taylor, & Lariviere, 2005, p. 929). In early 2000, the body for the preparation of draft submitted proposed draft of tobacco control in WHA's 53rd session.

As expected, the tobacco industry opposed the treaty. On Dated 30<sup>th</sup> August 2000, Philip Morris communicated its concerns on FCTC to Director General Dr. Brundtland. He expressed his reservations on increased taxes on tobacco products, limitations on free trade("Tobacco industry in-

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<sup>5</sup> Article 19 of the WHO constitution "The Health assembly shall have authority to adopt conventions or agreements with respect to any matter within the competence of the Organization. A two-thirds vote of the Health Assembly shall be required for the adoption of such conventions or agreements, which shall come into force for each member when accepted by it in accordance with its constitutional processes"

<sup>6</sup> Dr. Allyn Taylor is affiliate professor of law, University of Washington School of law, She has a experience of 25 years as a practitioner, teacher and scholar in global health law, policy and organization. She has worked as a legal advisor on staff and as a consultant with World Health Organization since 1993 including serving as the senior legal advisor for the negotiation and adoption of the WHO Frame Work Convention Tobacco Control and WHO global code of practice on the International recruitment of the Health personnel. She developed the idea of FCTC, the first convention adopted by the World Health Organization, as part of her doctoral dissertation at Columbia school of law.

<sup>7</sup> Mr. Neil Collishaw is a research director at Physicians for smoke-free Canada, an organization that has existed since 1985. He has been working in the public health filed since 1969, more specifically full-time in anti tobacco struggle since 1981. He has first worked with Health Canada and than with WHO in 1990s.

<sup>8</sup> Ibid 21 at 25



terference with tobacco control,” n.d.), shocked images and proposed health warnings (“Letter from Peter Hendry’s to Gro Harlem Brundtland,” personal communication, n.d.).

In first session of negotiations, Ambassador of Brazil was elected as chairman and a bureau was established consisting of members from Australia, India, Iran, United States of America, South Africa and Turkey. This Bureau accepted the draft as a sound basis for the negotiation (World Health Organisation, 2005). The working group on negotiations along with collaboration of WHO held various sessions with different member states and intergovernmental organizations. The World Health Organization organized open public hearings in which 144 organizations and institutions took part and gave their consent for Frame work Convention on Tobacco Control (M.D., 2000). The negotiating body discussed each aspects of proposed draft on tobacco control and the draft witnessed various changes till 5<sup>th</sup> session of negotiating body. In 5<sup>th</sup> session six issues were indentified these were, advertising, promotion and sponsorship; Financial resources; illicit trade in tobacco products; liability and compensation; packaging and labelling; trade and health (Division & Health, n.d.-b). In this session substantial development were made in negotiation and consensus was built in several areas. The working group on negotiations issued a revised text of Frame work Convention on Tobacco Control on 15<sup>th</sup> January 2003. In the 6<sup>th</sup> and the final session of the negotiations body, it was agreed to present the draft before the WHA in his 56<sup>th</sup> meeting. The WHA in 56<sup>th</sup> meeting on 21 May 2003 unanimously adopted the WHO Frame Work Convention on Tobacco Control.

The 1<sup>st</sup> legislation of any state, restricting the sale of tobacco products to the children came in 1908 (“Key dates in the history of anti-tobacco campaigning,” 2017), when the parliament of UK passed an act which prohibited the sale of tobacco products to the children under the age of 16. This legislation is considered as first modern legislation on tobacco sale. The New Zealand was on top to ban the tobacco broadcasting on radio and television in 1963. After that, America in 1971 and Australia in 1976 had done the same (“Tobacco advertising ban in Australia,” n.d.). In 1980s, all the members’ states of OCED banned the advertisement of the tobacco products on radio and TV (Nelson, 2004, p. 2).

Australia has implemented “The Tobacco Plain Packaging Act 2011” on 1<sup>st</sup> December 2012<sup>9</sup>. The aims and objectives of the act have been mentioned in Article 03 of the act. The primary object of the act is to improve public health by taking measures discouraging public from tobacco intake and encourage them to cease its use. Those who have already stopped tobacco intake should be warned of the harmful effects of its re-intake. To achieve these goals, parliament has introduced some packaging measures to decrease the attraction to increase the effectiveness of health warnings displayed on tobacco packaging to properly communicate the harmful effects of tobacco products and restrain tobacco manufacturers from misleading the consumers about the harmful effects of the tobacco products (Tobacco Plain Package Act, 2011, S. 3(2)). The Act defines “the retail package” for tobacco. In this Act, container means anything which contains the tobacco products and it includes the container placed for the retail sale of the tobacco products, a large container in which small containers are placed for the retail sale of tobacco products or a plastic or other wrapper in which the tobacco products are covered for the retail sale. “An insert<sup>10</sup> has been explained as any-

<sup>9</sup>Different parts of the Bill are scheduled to commence on different dates:

<sup>10</sup>“Insert” referred in this act includes, anything placed in tobacco packaging that is not a tobacco product but not the things which are part of packaging.

thing placed in tobacco packaging that is not a tobacco product”. “An insert<sup>11</sup> means anything that is attached to retail packaging for tobacco products or form part of packaging”.

Chapter two of the act describes the requirements for the plain packaging and the appearance of the tobacco products in retail sale market. First part of chapter laid down the requirements for the bodily features, of the retail packaging, their colour and finishing of retail packaging, marks on retail packaging and wrappers. Second part of the chapter deals with the appearance of the trademarks in the retail packaging of the tobacco products.

### **The WHO Framework Convention on Tobacco Control (FCTC)**

Tobacco use remained the basic and leading cause of deaths of approximately 5.4 million people in the world per year and it is expected to increase more than 8 million people by 2030 if the tobacco consumption remains constant<sup>12</sup>. WHO/FCTC is a recent initiative by WHO which aims to reduce tobacco use by giving awareness to general public about the harmful effects of the tobacco use and its impacts on economy as well as environment.

According to tobacco manufactures, in the absence of any other advertisement tools the packets are sole way of advertisement of tobacco products. It is evident from the following statement of the industry “Our final communication vehicle with our customer is the packet itself. In the absence of any other marketing channel, our packaging is the sole communicator of our existence” (M, 1994).

Article 11 of the WHO FCTC emphasise on the packaging and labelling of tobacco products and requires that member states should harmonise their domestic laws in accordance with the standards laid down by the convention.

Article 11 requires that each party shall, after signing the convention within the period of three years, should adopt and implement effective measures to ensure that the packaging and labelling of tobacco products are not promoting the tobacco products and no message which is false, misleading and deceptive about the characteristics of tobacco products is being communicated by use of the packaging and labelling. Member states may remove any trade mark, figurative or descriptive mark which directly or indirectly creates a wrong impression about tobacco products.

Article 11 (b) enumerates that, each unit packet and packaging of tobacco products and any outside packaging and labelling of such products should also carry health warnings describing the harmful effects of tobacco use, and may include other appropriate messages<sup>13</sup>. The warnings and messages shall be approved by the competent national authority, it should be all-around, large, clear and legible. Moreover all these should be displayed on the 50% or more of the principle display area. Last but not the least it should be in the form of picture or pictograms.

Furthermore, article 11 (2), requires that each packet shall contain the information on relevant constituents and emissions of tobacco products as defined by national authority.

According to article 11(3) the information on packaging shall be in principle language. So that every person can understand the message with its essence. And 11(4) states that “outside packaging and labelling” in relation to tobacco products applies to any packaging and labelling used in retail sale of products<sup>14</sup>.

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<sup>11</sup>“Insert” referred in this act includes, anything that is attached to retail packaging for tobacco products, or forms part of the packaging ,

<sup>12</sup><http://www.itcproject.org/projects/thailand/thexecsummaryadults07pdf> (Last accessed on 11-02-2014).

<sup>13</sup> Text of the WHO FCTC.

### **Plain Packaging**

The description of plain packaging is as, “Plain packaging of tobacco products refers all tobacco products to be sold in generic packaging. All activities on tobacco packages which promote tobacco use by any mean, whether they are trademarks, logos, colour scheme or graphics are banned(Simon, n.d.). Tobacco manufacturers are allowed to print brand name only, on tobacco packages in a prescribed colour font and size(Simon, n.d.). The information about the hazard health effects of the tobacco product’s emissions and the constituents will be printed on the tobacco packages. Health warnings in shape of text and in shape of pictures would also be displayed on the principle display area of the tobacco product’s packages(Simon, n.d.).”

Strong evidence demonstrates that the tobacco industry deems tobacco packaging as a basic advertisement tool and marketing strategy to increase its market share (“WHO | Warn about the dangers of tobacco,” n.d.). Article 11, of WHO/FCTC introduced the concept of plain packaging. The aims and objectives of plain packaging are to reduce tobacco use and to save world from devastating effects of tobacco use. It has been proved that plain packaging is an effective, inexpensive and powerful tool to show the truth about its use. The health warnings in shape of images call upon the emotional response and lead the tobacco consumer to reduce or quit the tobacco use. The messages in shape of pictures communicate a clear and immediate message even to those people and children who cannot read(“WHO | Warn about the dangers of tobacco,” n.d.). At the same time they reduce attractiveness of the tobacco packages.

### **Clash between Plain Packaging and Trademark**

As already stated plain packaging would remove all the promotional activities like the use of logos, trademarks and graphics from the tobacco packaging. Even the brand name will also be restricted up to some extent and the tobacco producers may display their brand name in prescribed format and font size(Paladino, n.d., p. 8). The trade dress or trade get up which is also registered as trademark globally and protected internationally will also be banned(Paladino, n.d., p. 23). In short, plain packaging would eliminate all the fancy designs and graphics from tobacco packaging which, by any means, attract the consumers. The result would be that the packaging will appear lifeless, boring and disheartening to the eyes of consumers.

Tobacco industry, as expected, has shown its reservations on plain packaging and Philip Morris, expressed its opposition over the new legislation during the meeting with Dr. Brundtland, the director general of WHO(*Letter from Peter Hendry to Gro Harlem Brundtland*, n.d.). Tobacco industry considered the cigarette boxes as a mobile advertisement of their brand. The consumers keep the tobacco box with them once they opened it(Alemanno & Bonadio, 2011, p. 447)

The clash between the plain packaging and the trademark is that, the plain packaging disturbed two main functions of trademark and hinders the right of the tobacco industry to use their trademark and take due benefit thereof. At the first hand, the plain packaging may jeopardize the function of a trademark to indicate its trade origin(Alemanno & Bonadio, 2011, p. 457). Trade origin helps consumers to make a choice of a product. This function is impossible to fulfil if trademarks are not available on the products. Plain packaging in case of cigarettes disturbed a consumer’s ability to make a choice of specific brand as in case of generic or plain packaging there would be almost no difference between the cigarette boxes. Hence the consumer will fail to distinguish between the goods of different sources. Plain packaging would prevent trademark to serve their basic and essential purpose which is to help consumers in distinguishing the products of one company from others.



Secondly, trademarks also operate as “conveyor of the message”. Consumers purchase the product due to the brand image rather than relying on features or contents of the product. Because the brand image leaves an impact on consumer’s mind and behaviour and assure consumer about the quality of product. The brand image on tobacco products also effects the consumers decision about tobacco products and other things which is worrying for tobacco producers are the health warnings which not only will leave bad impact but also call upon an emotional response to cease the tobacco consumption. These steps will seriously damage the good will of any brand. These are basic functions of the trademark which is going to be disturbed by the plain packaging and this is the clash between plain packaging and the trademark.

In a relevant case, Guatemala, in 1983, implemented the WHO/ United Nations Children’s Fund International Code of Marketing Breast Milk substitute which also banned to use images of healthy and fat babies(Mokhiber, 1996, p. 69). The objective of the legislation was to protect the lives of the children and to create obstacles against the aggressive marketing strategies by baby food manufacturers. Removal of trademark and fancy packaging always remain the strategy of concerned authorities and it matters a lot on the sale and goodwill of the companies.

#### **Analysis of the Legal Battle between Public Health and Trademark**

To conclude, the case of plain packaging VS public health would be an everlasting impact either on public health or on the fate of Intellectual property rights. One thing has been proved beyond reasonable doubt that smoking causes horrible damage to human health and body. It has devastating effects on human body from head to toe. It has foreseen that if it has not been controlled, this will cause catastrophe on a very high scale for the humanity. Experts from all over the world declaring plain packaging as cure for this ailment. But this is the only one side of the picture other side being more complicated.

Intellectual Property Rights are the emerging rights in all over the world and if we trace the history of these rights, they have just the history of two to three centuries. Intellectual Property Rights secure the rights of the intellectuals and protect them from exploitation by different stake holders. These rights work as an incentive for the businessmen to spread their business all over the world and create different type of opportunities for the human beings. Intellectual property rights strained an enterprise to maintain the quality of their products thus, creating ease of quality for human beings. In short Intellectual Property Rights are rendering great services to humanity. To further expand hypothesis of everlasting impact either on Intellectual Property Rights or on public health. If the Plain packaging would not be implemented, tobacco will cause great devastation to humanity. On the other hand if it is implemented, the whole system of Intellectual Property Rights would be splintered because it will emerge as precedent and the case of plain packaging implementation would provide sound basis to restrict the Intellectual property rights. That is the reason that experts argued that all other possible steps should be taken to combat against tobacco before the implementation of the plain packaging. To respond this argument, proponent of the plain packaging argued that plain packaging along with psychological effect is the most effective tool of tobacco control.

Keeping aside all these reservations and taking into consideration all the aspects of the case, it culminates at the point that plain packaging should be implemented with its full spirit. Taking the objection raised by the opponents into account we may say that Australian plain packaging is nothing to do with the Article 2.1 and 15.4 of the TRIPS agreement because these articles are related to the registration of the trademark and it is provided by the Australian Act that nothing in this Act would affect the registration of the trademark. While article 16.1 of the TRIPS agreement conferred

negative right to the owner of the trade mark that is to prevent others from using that trade mark rather than right to use the trademark. In other words trademark rights are the negative rights: right to exclude rather than to use. In the same sense, Article 17 limiting the right of trademark holder permitting the state to impose limited exception on trademark.

The most important discussion in this case is to determine whether the measures taken by the plain packaging act are justified or unjustified. A leading expert of WIPO on trademarks, Nuno pires de Carvalho (De Carvalho, 2007) has well explained the concept of justifiability under article 20 of the TRIPS agreement (Freeman, Chapman, & Rimmer, 2008b, p. 586). He is of the opinion that surely Article 20<sup>15</sup> allows justifiable encumbrance, and obviously the justifiable encumbrance necessarily cause economic loss to the owner of the trademark. Furthermore, where it would be justifiable it could not be challenged Under TRIPS agreement in spite of the fact that how much that justifiable requirement is detrimental to the owner of the trade mark. It is very much clear from the text of the WHO/FCTC and Australian Plain Packaging Act that the packaging and labelling requirements are prescribed with an aim to warn the public about the harmful effects of the tobacco use and it is justified on account of public health. This very measure is also supported by the TRIPS agreement itself as article 8.1 recognises that the member states may adopt measures to protect public health. Article 8.1 is included in part 1 of the TRIPS agreement in which basic principles of the agreement is placed. Thus, Article 20 should be interpreted in the light of the article 8<sup>16</sup> of the agreement.

Another important point is Doha Declaration on TRIPS Agreement and Public Health. The Doha Declaration on TRIPS Agreement and Public Health<sup>17</sup> states clearly that the TRIPS agreement cannot and should not prevent the members from taking measures vital for the protection of public health and the TRIPS agreement should be construed in a manner supportive to the member's right to protect the public health. We may argue that the discussion that Article 20 should be interpreted in the light of the Doha Declaration on TRIPS Agreement on Public Health Article 7 and 8<sup>18</sup>. If we will see the article 20 in this sequence it seems indisputable that public health measures are justified under article 20 of the TRIPS agreement.

### **Conclusion and Recommendation**

In the global village mankind can protect and destroy themselves by collective efforts. Scientific advancement and economic interest of the capitalists may tend to destroy the environment and human health, however collective human wisdom can save humanity. In the present case the tobacco

<sup>15</sup> TRIPS agreement article 20. "The use of a trademark in the course of trade shall not be unjustifiably encumbered by special requirements, such as use with another trademark, use in a special form or use in a manner detrimental to its capability to distinguish the goods or services of one undertaking from those of other undertakings."

<sup>16</sup> Article 08 of the TRIPS agreement, "Members may, in formulating or amending their laws and regulations, adopt measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development, provided that such measures are consistent with the provisions of this Agreement."

<sup>17</sup> Doha declaration on TRIPS agreement and Public Health: We agree that the TRIPS Agreement does not and should not prevent members from taking measures to protect public health. Accordingly, while reiterating our commitment to the TRIPS Agreement, we affirm that the Agreement can and should be interpreted and implemented in a manner supportive of WTO members' right to protect public health and, in particular, to promote access to medicines for all.

<sup>18</sup> Doha declaration on TRIPS agreement and Public Health: In applying the customary rules of interpretation of public international law, each provision of the TRIPS Agreement shall be read in the light of the object and purpose of the Agreement as expressed, in particular, in its objectives and principles.

industry apparently legitimate interest of the protection and protection of their trade mark under Intellectual Property Laws are on the one side and health issue of mankind is on the other. WHO is protecting the human health whereas WTO is protecting monetary interest of the business industry. through TRIPS. The compromise on health can destroy mankind and compromise on monetary benefit can save mankind. Keeping in view the above analysis it is recommended that sense should prevail and WHO recommendations may be implemented by national legislatures in the shape of creating new legal regime.

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