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# A Study Unlocking the Conflict Between The Plain Packaging of Tobacco Products and The Value of Trademark Rights

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<b>TABLE OF CONTENTS</b>		
<b>S.No.</b>	<b>TITLE</b>	<b>PAGE No.</b>
<b>CHAPTER 1: INTRODUCTION</b>		
	Executive Summary	4
1.1	Description of the topic	4
1.2	Significance of the Study	7
1.3	Objectives of the Study	8
1.4	Hypothesis	8
1.5	Research Questions	9
1.6	Scope of the Study	9
1.7	Research Methodology	9
1.8	Chapterization	9
<b>CHAPTER 2: Plain Packaging of Tobacco products: The Historical and Social Context</b>		
2.1	Early Advocacy for Plain Packs	11
2.2	The WHO Framework Convention on Tobacco Control (WHO FCTC)	12
2.3	Guidelines for Implementation of Article 11 of the WHO FCTC	17
2.4	International Developments and Initiatives Pertaining to Tobacco Control and Especially Plain Packaging Measures	19
<b>CHAPTER 3: The Legitimacy of Plain Packaging Under International Intellectual Property Laws</b>		
3.1	The Paris Convention- Overstatement of the Right to Registration and Defining the Right to Use a Trademark	23
3.2	The TRIPS Agreement and The Plain Packaging in Context	28
<b>CHAPTER 4: Implications of Ongoing Disputes Concerning Plain Packaging of Tobacco Products- Australia's Big Win</b>		
4.1	Background	36
4.2	Journey of Plain packaging In Australia	38
4.3	Summary of the Plain Packaging Act, 2011	40

4.4	Effect of Tobacco Plain Packaging Measure on Smoking Prevalence	44
4.5	Tobacco Industry's Response to the Tobacco Plain Packaging Act, 2011	46
<b>CHAPTER 5: Legality of Plain Packaging Schemes in India</b>		
5.1	Background	51
5.2	COTPA and the Move to Pictorial health Warnings on Tobacco Packs	52
5.3	The Need for Plain Packaging in India	55
5.4	Operational Aspects of Plain Packaging in India	56
<b>CHAPTER 6: Conclusion &amp; Suggestions</b>		
6.1	Conclusion	62
6.2	Summation of Chapters	63
6.3	Recommendations	64
<b>Bibliography</b>		67

## **CHAPTER 1: INTRODUCTION**

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### **EXECUTIVE SUMMARY**

In Australia, since December 1, 2012 all the tobacco products are being sold in plain standardised packaging free of fancy logos, colours, trademarks etc, instead 85% of the pack should be covered with a graphical and pictorial health warning with the purpose of making the consumers aware of the toxic effects of tobacco consumption. The present research is inspired by the determined attempts made by Australian Government in the context of implementing plain packaging of tobacco products and how we can implement the same in India.

In India, The Cigarettes and other Tobacco Products (Prohibition of Advertisement and Regulation of Trade and Commerce, Production, Supply and Distribution) Act, 2003 (hereinafter referred to as COTPA) and The Cigarettes and other Tobacco Products (Packaging and Labelling) Rules, 2008 (hereinafter referred to as Rules, 2008) were amended in 2014 wherein the size of health warning on the principle display areas of the packaging of tobacco products increased from 40% to 80%. Both the legislations are clearly within the legislative power and capacity of the Parliament and also represent an effective medium of implementing India's obligations under the WHO FCTC, 2003. Unsurprisingly, like other nations, In India also the tobacco industry responded very aggressively and challenged it before Karnataka HC who quashed the order. Thereafter, an SLP was made before the Hon'ble SC, wherein the order of 85% of health warning was reinstated.

Thus, the much threatened litigation brought in by the tobacco industries of the world against the proposed regulations on plain packaging of tobacco products is rather vexatious. To be precise the legal actions by tobacco companies are a part of the strategy to frustrate the introduction and implementation of above stated legislations and amendment.

“The Time is ripe” for India and being one of the largest tobacco producing country of the world, India can set an example for other developing jurisdictions to pave their way for a legislation regarding plain packaging of tobacco products.

### **1.1 DESCRIPTION OF THE TOPIC**

On 28<sup>th</sup> June, 2018 Australia triumphed in a major trade dispute over its pioneering plain tobacco packaging law, with World Trade Organization judges rejecting a complaint brought by Cuba, Indonesia, Honduras and Dominican Republic. The judgment is a clear manifestation of the duty, world owes, under the WHO's FCTC, 2003. It would be pertinent to note that the framework convention recognizes factors such as global marketing, transnational tobacco

advertising, promotion and sponsorship, and the international movement of contraband and counterfeit cigarettes which have contributed to the explosive increase in tobacco use. As a result of which, the convention under its Article 11 requires that the warnings and messages on the packaging of tobacco product should be 50% or more of the principal display areas but shall not be less than 30% of the principal display areas, and also that the warnings shall be large, clear and visible. In addition, the guidelines for implementation of Article 11 endorses measures to restrict or prohibit the use of logos, colours, brand images or promotional information on packaging other than brand names and products names displayed in a standard colour and font style.

Tobacco control, if we see, is a contentious issue. Each year, the tobacco epidemic is estimated to kill nearly six million people, including more than 600,000 non-smokers who are exposed to tobacco smoke and by 2030, if nothing is done, tobacco could kill eight million people a year.<sup>1</sup> Sad, but the truth is revealed by WHO, has predicted that India will have the fastest rate of rise in deaths attributable to tobacco in the first two decades of the twenty-first century and many of these deaths will occur in the productive years of adult life.<sup>2</sup> The WHO has in its report on the Global Tobacco Epidemic in 2008 (reiterated in 2017 report) proposed the MPOWER package which covered:

M= Monitor Tobacco use and Prevention Policies;

P= Protect People from Tobacco Smoke;

O= Offer Help to Quit Tobacco Smoke;

W= Warn About the Dangers of Tobacco;

E= Enforce Bans on Tobacco Advertising, Promotion and Sponsorship;

R= Raise Taxes on Tobacco.<sup>3</sup>

This dissertation will emphasize on the legal aspects associated with 'W' and 'E' with some consideration on 'P'.

Since mid-1970s many countries like USA, Australia, Canada have already been putting in efforts to regulate consumption of tobacco. in the recent past. World has witnessed all the efforts

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<sup>1</sup>World Health Organization. Tobacco Fact Sheet. May 2012. Available from: [http:// tiny.cc/gg6xfw](http://tiny.cc/gg6xfw).

<sup>2</sup>Reddy, S, Gupta P, *Report on Tobacco Control in India* (Ministry of Health and Family Welfare 2004) <[https://www.who.int/fctc/reporting/Annex6\\_Report\\_on\\_Tobacco\\_Control\\_in\\_India\\_2004.pdf](https://www.who.int/fctc/reporting/Annex6_Report_on_Tobacco_Control_in_India_2004.pdf)> accessed on 1 April 2019.

<sup>3</sup>World Health Organization, *WHO Report on the Global Tobacco Epidemic, 2017: Monitoring tobacco use and prevention policies*(WHO2017)<<https://apps.who.int/iris/bitstream/handle/10665/255874/9789241512824-eng.pdf;jsessionid=47DA9249D733C66E4295C55CAA9B414C?sequence=1>> accessed 21 April 2019.

Australia has made and implemented to control the harmful health effects of tobacco. The biggest step in this arena is the implementation of the legislation for plain packaging of tobacco products.

### **Why do we need plain packs and how they are relevant to India?**

Article 11 and 13 of the WHO FCTC provides for the purpose of plain packs, which includes:

1. Reducing the attractiveness of tobacco products;
2. Eliminating the effects of tobacco packaging as a form of advertising and promotion;
3. Addressing package design techniques that may suggest that some products are less harmful than others;
4. Increasing the noticeability and effectiveness of health warnings.<sup>4</sup>

It would be pertinent to note that reduction of consumption of tobacco is not the only purpose served by plain packaging. It also focuses on the reducing the appeal of products so that more people don't get attracted to it. It focuses on raising the awareness amongst people about the harmful effects of tobacco.

The purpose of the Irish plain packaging measure is described in the Explanatory and Financial Memorandum accompanying the Public Health (Standardised Packaging of Tobacco) Bill 2014 stating:

*"...[I]reland's public health policy objective in relation to tobacco control is to promote and subsequently move toward a tobacco free society. The Government is implementing a comprehensive suite of reforms to reduce smoking and its harmful effects. As part of these reforms the Government is committed to introduce legislation requiring standardised packaging of tobacco products, to remove one of the last remaining frontiers for tobacco advertising."<sup>5</sup>*

Packaging of tobacco products has been of the primary and most essential tool of the tobacco industry to advertise and promote their products in order to attract more people towards it, as governments of various nations have been constantly putting prohibitions on tobacco advertisement and promotion. The packs of tobacco were being designed by the tobacco industry in a very fancy and attractive manner as they believed that packaging promoted their product not only at the time of sale of that product but also post sale. It is the tendency of the consumers to boastfully display packaging of a branded tobacco product and using it as an external denotation of their status. Moreover, the tobacco industry, by using fancy advertisements, catchy taglines and bright attractive colours on the packs aim to target the youth

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<sup>4</sup>World Health Organization Framework Convention on Tobacco Control, Article 1.

<sup>5</sup>Public Health (Standardised Packaging of Tobacco) Bill 2014.

and adolescents specifically in order to make them addicted until their adulthood. A substantial number of peer reviewed studies that examine plain packaging support the conclusion that the measure reduces the attractiveness and appeal of tobacco products.<sup>6</sup>

Furthermore, after the implementation of plain packaging legislation by Australia, there are clear evidence supporting the objective of the policy that it reduces the attractiveness and appeal of the product and encourages people to quit smoking. Another observation that can be made in this background is that due to plain packaging not only the smokers treat it as less appealing but it also reduces exposure of the product to public. This evidence includes studies conducted in Australia showing increased urgency among smokers to quit, a significant and sustained increase in calls to Quitline (A service that assists consumers in quitting tobacco use) and increased rates of quitting cognitions and quit attempts among adult smokers.<sup>7</sup>

In addition, the health warning which are required to be printed on the packs of tobacco products helps to raise awareness amongst smokers as well non-smokers about the hazards of consuming tobacco and also encourages them to take a step towards quitting it.

## **1.2 SIGNIFICANCE OF STUDY**

The relationship between intellectual property and health has now become one of the significant theme of research. At this juncture, when the country is gradually entering the phase of introducing schemes like “Aayushman Bharat”, thereby meeting the requirements of WHO FCTC, a dire need was felt to address the problem of tobacco consumption and its impact on public health.

This research will make an attempt to assess the effectiveness of laws related to the plain packaging of tobacco products in India and its conflict with the trademark rights of tobacco industries. It shall undertake an analysis of the Australian scenario for plain tobacco packaging including the legislation and the cases. Thereafter, suggestions will be accorded regarding whether the plain packaging regulation be treated as a next logical step for controlling tobacco consumption in India. Such conflicts are essential to be addressed as they touch the very root of the matter. Such issues are qualitative by nature. Adequate analysis of the same through such

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<sup>6</sup>White CM, Hammond D, Thrasher JF, Fong GT, ‘The potential impact of plain packaging of cigarette products among Brazilian young women : an experimental study’ (2012) BMC Public Health <<https://bmcpublichealth.biomedcentral.com/articles/10.1186/1471-2458-12-737>> accessed 20 May 2019.

<sup>7</sup>DurkinS, Brennan E, Coomber K, Zacher M, Scollo M, Wakefield M., ‘Short-term changes in quitting-related cognitions and behaviours after the implementation of plain packaging with larger health warnings: findings from a national cohort study with Australian adult smokers’ (2015) 24(2) Tobacco Control <[https://www.law.ox.ac.uk/sites/files/oxlaw/oscola\\_4th\\_edn\\_hart\\_2012quickreferenceguide.pdf](https://www.law.ox.ac.uk/sites/files/oxlaw/oscola_4th_edn_hart_2012quickreferenceguide.pdf)> accessed 27 May 2019.

research will not only make significant addition to existing knowledge bank but also play a vital role in resolving or framing policy for the country.

### **1.3 OBJECTIVES OF THE STUDY**

The researcher through the research seeks to achieve the following objectives-

1. To assess the feasibility of introducing plain packaging in India and to assess if this public health measure contravenes any existing Indian legislation.
2. To identify the key barriers in the implementation of the plain packaging regulation in the backdrop of the Australian experience, and the global interest and emphasis on plain packaging of tobacco products.
3. To identify and review the Private Members Amendment Bill on plain packaging in India besides 'Cigarettes and Other Tobacco Products (Prohibition of Advertisement and Regulation of Trade and Commerce, Production, Supply and Distribution) Act, 2003' (COTPA).
4. To analyse the national and international laws and policies that could potentially be used by the tobacco industry to challenge a decision of implementing plain packaging in India.
5. To analyse the legacy of Judiciary in India and other foreign jurisdictions and to recommend best ways which could help in strengthening the existing framework.

### **1.4 HYPOTHESIS**

In the light of the WHO FCTC, the much threatened legal actions by tobacco industry is to frustrate the introduction and implementation of regulation of plain packaging of tobacco products.

1. The plain packaging of tobacco products is not a violation of trademark law or policy.
2. The plain packaging of tobacco products is consistent with the international law in the fields of health, intellectual property, and trade.
3. The plain packaging of tobacco products is consistent and in consonance with The Constitution of India, 1950; The Consumer Protection Act, 1986; The Competition Act, 2002; and The Legal Metrology Act, 2011.
4. The rule of covering 85% packaging of tobacco products with graphical health warning has been a failure in order to decrease the rate of consumption of tobacco.



## **1.5 RESEARCH QUESTIONS**

Following are the research questions which the researcher addresses in the dissertation:

1. What is the concept of plain packaging of tobacco products and how does it impacts the essence, Nature and purpose of Trademark law?
2. What is the role of International Organizations in the effectual implementation of the scheme of plain packaging of tobacco products?
3. What are the emerging judicial trends in India, Australia and other foreign jurisdictions in relation to the plain packaging of tobacco products?
4. What is the existing jurisprudence in India for plain packaging of tobacco products and is there an effectual application of existing legislations?
5. What are the perceptions and reactions of the Indian populace about plain packaging for all tobacco products?

## **1.6 SCOPE OF THE STUDY**

This dissertation attempts to incorporate all recent developments in the field of trademark law as a result of implementation of the plain packaging of tobacco products. The primary limitation of this study is that it shall only deal with legal and policy matters pertaining to the subject. The researcher has limited the comparative study of regional laws related to the subject matter to India and Australia. Meanwhile, the relevant legislations of other nations can be referred for more clarity and for furthering the understanding of the subject matter and topics thereunder.

## **1.7 RESEARCH METHODOLOGY**

The Research Methodology adopted for research is Doctrinal by nature. The data collection in this research will be mostly primary in nature based on detailed analysis of various documents, case laws and studies in various books, articles and websites. This includes materials from books, publications, newspaper reports, articles, websites and juristic writings where facts are critically analysed and conclusions are drawn from them. Also the views of various judges and other experts would be cited to discuss certain issues.

## **1.8 CHAPTERIZATION**

Following is the scheme of chapterization:

1. **Introduction to Plain Packaging of Tobacco Products and its Impact on Trademark Law (Scheme of Synopsis).**

The first chapter deals with the introductory part of this dissertation. It shall encompass relevant definitions, scope of study, limitations, research methodology and the hypotheses. This chapter shall also include the research questions and the literature that researcher shall address and refer in following chapters.

**2. The Plain Packaging of Tobacco Products: The Historical and Social Context**

This chapter explains the background, concept, significance and importance of the plain packaging of tobacco products. In furtherance, the researcher heavily relies upon the WHO FCTC, 2003 and the relevant legislations of other foreign jurisdictions for appreciating the concept. It shall also deal with the tobacco industry's response vis-à-vis their trademark rights on the implementation of the plain tobacco packaging regulations through judicial decisions.

**3. The Legitimacy of Plain Packaging Under International Intellectual Property Laws**

This chapter considers the arguments that there is a right to use trademarks under the TRIPS Agreement. In doing so, it also engages in a detailed analysis of Article 20 of TRIPS. It explains why no right of use exists under either TRIPS and the very limited role that Article 20 of TRIPS has in the context of the debate surrounding the legislation.

**4. Australian Experience with Plain Packaging and its Implications**

This chapter is all about the recent developments in Australia, being the first country to implement the plain tobacco packaging regulation. The chapter shall contain a comparative analysis of the legislation in Australia with India with the help of case laws.

**5. The Legality of Plain Packaging Schemes in India with Particular Reference to Trademark Law**

The researcher in this chapter assesses the legal challenges brought in by the tobacco industries against the implementation of the Plain tobacco packaging regulations and its impact on The Constitution of India, 1950; The Trademark Act, 1999 and The Legal Metrology Act, 2009.

**6. Conclusion & Suggestions**

Lastly, the dissertation concludes with essential verdicts, applicable recommendations and remarks of the researcher.

**Bibliography**

## CHAPTER 2- PLAIN PACKAGING OF TOBACCO PRODUCTS: THE HISTORICAL AND SOCIAL CONTEXT

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### 2.1 EARLY ADVOCACY FOR PLAIN PACKS

The tobacco Industries have always been spending huge sums on advertisement and promotion of their products to attract the people of all ages towards their product. The tobacco industry has been widely criticized in 1963 when the reports revealed that every teenager viewed at least 100 cigarette advertisements a month and a child viewed approximately 70 a month due to broadcasting of advertisements during the peak hours of television being watched by youths.<sup>8</sup> Therefore, over the years, by observing the actions of tobacco industries it has been observed that they have not stopped airing these advertisements and promotions of tobacco products until a some kind of social or legal pressure was made upon them.<sup>9</sup> To combat the issue the governments of different jurisdictions have been enacting various measures to regulate and ban advertisement and promotion of tobacco products. One such instance was dealt by the US Court in 1971 in the case of *Capital Broadcasting Company v. Mitchell*<sup>10</sup>, “...Six corporations that operated radio stations challenged the constitutionality of a tobacco control law that banned cigarette advertising on all federally regulated electronic communications media. Although the corporations argued that the ability to disseminate information is integral to the right to freedom of speech, the court held that the advertising ban did not implicate the corporations right to speak but affected only their monetary interests. The Court further held that the Congress retains broad power to deal with the evils of cigarette advertising, it can force the removal of deceptive claims and require manufacturers to couple their advertisements with a clear statement of the hazardous nature of their product. Therefore, the ban did not violate due process because rational bases existed for regulating advertising in broadcast media and in print media differently.”

In the ongoing debate on controlling tobacco consumption, one of the measures to combat with the problem is the implementation of a regulation for plain packaging of tobacco products. This idea of selling all tobacco products in standardised, plain and generic packs devoid of all characteristic features that might subsidize to their attractiveness or appeal to consumers, can be outlined back to Canada. **Dr Gerry Karr** appears to be the first person to have formally

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<sup>8</sup>Richard Pollay, *The Major Minor Issue: Children, Cigarettes and Advertising Self-Regulation in the Sixties* In Thorson, Esther, editor. , ed. *Proceedings of the American Academy of Advertising* . Columbia: University of Missouri, 1993. 2-11.

<sup>9</sup>Lynch BS, ‘Growing up Tobacco Free: Preventing Nicotine Addiction in Children and Youths’ (*Institute of Medicine of United States* 1994) <<https://www.ncbi.nlm.nih.gov/books/NBK236761/>> accessed 20 May 2019.

<sup>10</sup>*Capital Broadcasting Company v. Mitchell* (1971) 333 F.Supp. 582.

proposed the idea of plain packaging of tobacco products in a motion presented at a Canadian Medical Association annual general meeting in June 1986.<sup>11</sup> Over the next decade the proposal received some attention from researchers and advocates in Australia, New Zealand and a considerable amount in Canada.<sup>12</sup> Thereafter, in 1990 the conference resolutions of the Seventh World Conference on Tobacco or Health held in Perth embraced the concept of mandatory generic packaging of all tobacco products, and urged all countries to include generic packaging in their tobacco control legislation.<sup>13</sup> A similar resolution was embraced by the world conference in Buenos Aires in 1994.

In response to the mounting interest of governments for implementing a plain packaging legislation the tobacco industry instigated campaigns to fight against generic packaging contending that it would be in contravention to their intellectual property protections. Following the industry's response many countries had dropped the idea of implementing a legislation for the same.

Then, on 21<sup>st</sup> May, 2003 The World Health Assembly adopted by consensus The WHO Framework Convention on Tobacco Control (WHO FCTC).

## **2.2 THE WHO FRAMEWORK CONVENTION ON TOBACCO CONTROL (WHO FCTC)**

### **2.2.1 BACKGROUND**

The FCTC is the first international treaty negotiated under the auspices of WHO and entered into force on 27<sup>th</sup> February, 2005.<sup>14</sup> It is a first of its kind legal instrument bringing the imperatives of public health in the international legal domain and therefore is one of most widely embraced treaties in UN History.

By the 1990s the then prevailing tobacco epidemic had been described as 'a public health problem of epic proportions' and '*one of the major public health disasters of the past century*'.<sup>15</sup> These views are not surprising, given the sobering facts of the 1990s: tobacco use was a leading cause

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<sup>11</sup>Tobacco Documentation Centre, 'Plain Packs History' (*British American Tobacco Records* 1994) <<https://www.industrydocuments.ucsf.edu/tobacco/docs/#id=jlxn0198>> accessed 21 May 2019.

<sup>12</sup>Carr-Gregg MR, Gray AJ, 'Generic packaging-a possible solution to the marketing of tobacco to young people' 1990 153(11-12) *Medical Journal of Australia* <<https://www.ncbi.nlm.nih.gov/pubmed/2246993>> accessed 20 May 2019.

<sup>13</sup>David Reubi, Virginia Berridge, 'The Internationalisation of Tobacco Control: 1950-2010' (2016) 60(4) *Cambridge Journal of Medical History* <<https://www.ncbi.nlm.nih.gov/pmc/articles/PMC5058405/>> accessed 21 May 2019.

<sup>14</sup>World Health Organisation, 'About the WHO Framework Convention on Tobacco Control' (*WHO FCTC Overview* 2019) <<https://www.who.int/fctc/about/en/>> accessed 21 May 2019.

<sup>15</sup>Ruth Roemer, Allyn Taylor and Jean Larivière, 'Origins of the WHO Framework Convention on Tobacco Control' (2005) 95 *American Journal of Public Health* <<https://www.ncbi.nlm.nih.gov/pmc/articles/PMC1449287/>> accessed 20 June 2019.

of premature death; it resulted in at least 3.5 million deaths in 1998 alone, and was expected to cause 10 million deaths per year by 2030 if the epidemic continued unchecked – with 70 per cent of these deaths expected to occur in developing countries.<sup>16</sup> The tobacco epidemic had accelerated from the developed parts of the world to the developing because of the expanding tobacco industry at global levels. The underlying issue was that even after the rampant effect of tobacco was evident and identified by the nations, all the traditional efforts to curb the problem and stop the industry were unsuccessful.

The odds of successfully controlling this enormous threat to public health seemed insurmountable, until a group of tobacco control pioneers persuaded the public health community to ‘change the rules of the game’.<sup>17</sup>

### 2.2.2 HISTORY

The idea of using the WHO’s treaty-making power first appeared in 1979 in a report prepared by the WHO Expert Committee on Smoking Control.<sup>18</sup> This report included a tobacco control programme and also suggested that if, within a justifiable period of time, this programme does not help in yielding the desired result then the WHA should, by using its treaty making power, establish an “International Regulatory Mechanism for Tobacco Control”.

Finally, in 1993, the idea of having the global tobacco control community began to take root and to gain broad support<sup>19</sup> and in May 1996 at its 49<sup>th</sup> Session, the WHA adopted a resolution calling for the creation of an international framework convention on tobacco control.<sup>20</sup> In three years WHA established an Intergovernmental Negotiating Body (INB) for drafting and negotiating the FCTC and all the protocols related to it. Thus, after numerous regional meetings and intersessional discussions, the final text of the convention was adopted and thereafter enforced.

The pressing public health concerns which incited the nations to draft and negotiate this convention can be located by delving in the Preamble of the FCTC. The preliminary paragraph of the preamble lays emphasis on the determination of the parties and prioritizes their right to

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<sup>16</sup> Ibid, 14.

<sup>17</sup>Dr Haik Nikogosian, ‘History of the WHO Framework Convention on Tobacco Control’ (*World Health Organization*2009)<[https://apps.who.int/iris/bitstream/handle/10665/44244/9789241563925\\_eng.pdf?sequence=1](https://apps.who.int/iris/bitstream/handle/10665/44244/9789241563925_eng.pdf?sequence=1)> accessed 21 June 2019.

<sup>18</sup>Institutional Repository for Information Sharing, *Controlling the Smoking Epidemic: Report of the WHO Expert Committee on Smoking Control* (World Health Organization 1978)<<https://apps.who.int/iris/handle/10665/41351>>accessed 18 June 2019.

<sup>19</sup>V S Mihajlov, ‘International Health Law: Current Status and Future Prospects’ (1989) 40(9) *International Digest of Health Legislation*.

<sup>20</sup>World Health Assembly (6<sup>th</sup> Plenary Meeting) Resolution : 49.17 : Resolution Concerning Tobacco Free Initiative (25 May 1996).

protect public health.<sup>21</sup>This formal declaration is also implanted in later part of the Preamble, wherein reference is also made to the Constitution of the WHO that ‘...[t]he enjoyment of the highest attainable standard of health is one of the fundamental rights of every human being without distinction of race, religion, political belief, economic or social condition’<sup>22</sup>.

Moreover, the public health imperatives of three core human rights treaties are also specifically referred to in the Preamble, which are as follows:-

1. **The International Covenant on Economic, Social and Cultural Rights, 1966** ensures that everyone has the right to enjoy the highest attainable standard of physical and mental health<sup>23</sup>;
2. **Convention on the Elimination of All Forms of Discrimination against Women, 1981** provides that States shall ensure that women have equal rights with men to access to health care services, including reproductive health services<sup>24</sup>;
3. **Convention on the Rights of the Child, 1989** ensures that children shall have the right to such protection and care as is necessary for their well-being and those they may express their views freely<sup>25</sup>.

The further paragraphs of the preamble not only enshrine the foundation principles on the basis of which the WHO FCTC was compiled but also set one’s sight on the primary rationale for which the parties agree to endorse the convention. It recognizes tobacco epidemic as a global problem with consequential impact on public health and therefore demands widest international cooperation of all countries.<sup>26</sup> The most significant amongst all is that the preamble acknowledges that there is clear scientific evidence that prenatal exposure to tobacco smoke causes adverse health and developmental conditions for children.<sup>27</sup>

### **2.2.3 THE WHO FCTC: THE INTERNATIONAL CONTEXT FOR PLAIN PACKAGING**

The purpose of drafting FCTC was to strengthen national and international coordination and bring harmonization in the battle against harmful effects of tobacco. FCTC, through its dynamic and progressive approach, provides a framework to strengthen relations among nations by

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<sup>21</sup>Framework Convention on Tobacco Control (WHO) (adopted 21 May 2003 and adopted 27 February 2005)

<sup>22</sup>Constitution of the World Health Organization, Article 19

<sup>23</sup>International Covenant for Civil and Political Rights (adopted 16 December 1966 and entry into force 23 March 1976) Article 12

<sup>24</sup>Convention on Elimination of All Forms of Discrimination Against Women (adopted 18 December 1979 and entry into force 3 September 1981) Article 12

<sup>25</sup>The Convention of Rights of Child(adopted 20 November 1989 and entry into force 2 September 1989) Article 12

<sup>26</sup> Framework Convention on Tobacco Control (WHO) (adopted 21 May 2003 and adopted 27 February 2005), Preamble

<sup>27</sup> Ibid

requiring their broad international participation and cooperation for an appropriate, effective and comprehensive response to the convention. The pre-requisites and obligations incorporated in the FCTC are supplemented by the additional protocols and guidelines for their proper implementation.

Importantly, and as is commonly the case in international legal instruments, the obligations and other measures contained in the WHO FCTC are not intended to be the high water mark for measures taken by Parties.<sup>28</sup> Instead, Parties are specifically encouraged to implement measures beyond those required by the WHO FCTC and its protocols, and to impose stricter requirements than those set out in the Convention and its protocols.<sup>29</sup> Turning to the guidelines for implementation, which also form an important part of the framework convention, Article 7 of the WHO FCTC requires the Conference of the Parties to propose appropriate guidelines for the implementation of Articles 8 to 13.<sup>30</sup> Therefore, the parties are under an obligation to propose guidelines for the implementation of the provisions of FCTC. In order to fulfil this requirement, the Conference of the Parties has established an intergovernmental process for the development of guidelines for the implementation of the various provisions of the Convention.<sup>31</sup>

The binding obligations accommodated under Article 11, Article 13 read with Article 1 (c) along with the guidelines for the implementation of the above mentioned provisions are particularly relevant to the issues of plain packaging.

Article 11 of the FCTC provide for exhaustive and *in toto* measures for packaging and labelling of tobacco products and also places a binding obligation on the parties to the convention to adopt those measures. It requires, to that end, packaging and labelling of a tobacco product must be in a way that it should not promote the product by any means that are *“false, misleading, deceptive or likely to create an erroneous impression about its characteristics, health effects, hazards or emissions, including any term, descriptor, trademark, figurative or any other sign that directly or indirectly creates the false impression that a particular tobacco product is less harmful than other tobacco products; for instance using terms such as low tar, light, ultra-light, or mild”*.<sup>32</sup>

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<sup>28</sup>Edward Elgar, *Public Health and Plain Packaging of Cigarettes: Legal Issues*(Edward Elgar Publishing House 2012)

<sup>29</sup>Framework Convention on Tobacco Control (WHO) (adopted 21 May 2003 and adopted 27 February 2005) Article 2.1

<sup>30</sup>Framework Convention on Tobacco Control (WHO) (adopted 21 May 2003 and adopted 27 February 2005) Article 7

<sup>31</sup> ‘Elaboration of Guidelines for the Implementation of the Convention, FCTC/COP1/15 (17 February 2006)

<sup>32</sup>Framework Convention on Tobacco Control (WHO) (adopted 21 May 2003 and adopted 27 February 2005) art 11(1)(a)

In furtherance, it is required under Article 11 (1) (b) that “each package of tobacco products and any outside packaging and labelling of such products shall also carry health warnings describing the harmful effects of tobacco use”. Also, that these warnings and messages:

- (i) *shall be approved by the competent national authority;*
- (ii) *shall be rotating;*
- (iii) *shall be large, clear, visible and legible;*
- (iv) *should be 50% or more of the principal display areas but shall be no less than 30% of the principal display areas;*
- (v) *May be in the form of or include pictures or pictograms.*<sup>33</sup>

It would be pertinent to note that all the above stated requirements have to be endorsed and implemented by the parties within 3 years of the coming into force of WHO FCTC for that party. As aforementioned, vis-à-vis Article 7 it is the obligation of the Conference of Parties to develop guidelines for the implementation of the obligations under Article 11 and 13 of FCTC, thus, all guidelines have been brought to effect by them through a consensus decision. As noted in the Article 11 guidelines, their purpose is *‘to assist Parties in meeting their obligations under Article 11 of the Convention, and to propose measures that Parties can use to increase the effectiveness of their packaging and labelling measures’*.<sup>34</sup>

Article 13 of the WHO FCTC provides for a framework to *undertake “a comprehensive ban on tobacco advertising, promotion and sponsorship”*.<sup>35</sup> For apt recapitulation, it must be read with Article 1(c) of the FCTC which defines *“tobacco advertising and promotion” to mean “any form of commercial communication, recommendation or action with the aim, effect or likely effect of promoting a tobacco product or tobacco use either directly or indirectly.”*<sup>36</sup>

The underlying objective as stated in the Guidelines for implementation of Article 13 *“is to assist Parties in meeting their obligations under Article 13 of the WHO FCTC. They draw on the best available evidence and the experience of Parties that have successfully implemented effective measures against tobacco advertising, promotion and sponsorship”*.<sup>37</sup>

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<sup>33</sup> Framework Convention on Tobacco Control (WHO) (adopted 21 May 2003 and adopted 27 February 2005) art 11(1)(b)

<sup>34</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on Tobacco Control, Decision of COP3, FCTC/COP3(10) (22 November 2008) (hereinafter referred to as Guidelines for Article 11)

<sup>35</sup> Framework Convention on Tobacco Control (WHO) (adopted 21 May 2003 and adopted 27 February 2005) art 13

<sup>36</sup> Framework Convention on Tobacco Control (WHO) (adopted 21 May 2003 and adopted 27 February 2005) art 1(c)

<sup>37</sup> ‘Guidelines for Implementation of Article 13 of the WHO Framework Convention on Tobacco Control’, Decision of COP3, FCTC/COP3(12) (22 November 2008)



As a corollary, the guidelines for implementation of Article 13 concede the packaging and labelling of a tobacco product as one of the very essential constituent element used by the tobacco industry to advertise and promote their product. The guidelines explain how the strategy behind fancy, attractive packaging to attract consumers from all ages and establish a brand identity. Moreover, the guidelines explain how plain packaging can effectively provide a key element for a truly comprehensive ban on tobacco advertising and promotion, and urge Parties to adopt plain packaging requirements.<sup>38</sup>

### **2.3 GUIDELINES FOR IMPLEMENTATION OF ARTICLE 11 OF THE WHO FRAMEWORK CONVENTION ON TOBACCO CONTROL (PACKAGING AND LABELLING OF TOBACCO PRODUCTS)**

The underlying objective behind enforcing separate guidelines for implementing the plain packaging provision is to provide assistance to the parties to effectively convention to meet their obligations under the convention and to propose measures that parties can use to increase the effectiveness of their packaging and labelling measures.<sup>39</sup> The guidelines state that most of the people are not aware of the risks for morbidity and premature mortality due to consumption and exposure to tobacco, sometimes they even misunderstand the risks involved.<sup>40</sup> Therefore, well-designed health warnings are cost-effective methods and one of the key components of a comprehensive integrated approach to tobacco control and to increase the level of awareness amongst public of the health effects of tobacco use.<sup>41</sup> The guidelines also provide for the requirements of developing effective packaging and labelling requirements, which are as follows:

- larger text warnings with pictures should be adopted as they are more likely to be notices, communicate health risks in a much better way, provoke a greater emotional response and increase the motivation of tobacco users to quit and to decrease their tobacco consumption.<sup>42</sup> Other elements that enhance effectiveness include locating health warnings and messages on principal display areas and at the top of these principal display areas; the use

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<sup>38</sup> Ibid

<sup>39</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on 'Tobacco Control', Decision of COP3, FCTC/COP3(10) (22 November 2008) Paragraph 1

<sup>40</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on 'Tobacco Control', Decision of COP3, FCTC/COP3(10) (22 November 2008) Paragraph 3

<sup>41</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on 'Tobacco Control', Decision of COP3, FCTC/COP3(10) (22 November 2008) Paragraph 3

<sup>42</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on 'Tobacco Control', Decision of COP3, FCTC/COP3(10) (22 November 2008) Paragraph 7

of colour rather than just black and white; requiring that multiple health warnings and messages appear concurrently; and periodic revision of health warnings and messages.<sup>43</sup>

- The location of the health warnings should be such to ensure maximum visibility, therefore, they should be on the top and :
  - i. on both the front and back of each unit packet and package, rather than just one side;
  - ii. on principal display areas and, in particular, at the top of the principal display areas rather than at the bottom to increase visibility; and
  - iii. in such a way that normal opening of the package does not permanently damage or conceal the text or image of the health warning.<sup>44</sup>
- Parties should ensure that in addition to the requirements of Paragraph 8, the health warnings should also be on all sides of package, as well as on inserts and onserts and the warnings should not be obstructed by other required packaging and labelling markings or by commercial inserts and onserts.<sup>45</sup>
- When creating pictures for use on tobacco product packaging, Parties should obtain, where possible, ownership or full copyright of images, instead of allowing graphic designers or other sources to retain copyright as it will provide maximum flexibility to use the images for other tobacco control interventions, including mass media campaigns and on the Internet.<sup>46</sup>
- The health warnings and messages shall be rotating as the novelty effect of new health warnings and messages is important and the new warnings should maintain saliency and enhance impact of warnings.<sup>47</sup>
- It is also important that health warnings and messages should address different issues related to tobacco use, in addition to harmful health effects and the impact of exposure to tobacco smoke, such as:
  - i. advice on cessation;
  - ii. the addictive nature of tobacco;

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<sup>43</sup> Ibid

<sup>44</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on 'Tobacco Control', Decision of COP3, FCTC/COP3(10) (22 November 2008) Paragraph 8

<sup>45</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on 'Tobacco Control', Decision of COP3, FCTC/COP3(10) (22 November 2008) Paragraph 9 & 10

<sup>46</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on 'Tobacco Control', Decision of COP3, FCTC/COP3(10) (22 November 2008) Paragraph 17

<sup>47</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on 'Tobacco Control', Decision of COP3, FCTC/COP3(10) (22 November 2008) Paragraph 20

- iii. adverse economic and social outcomes (for example, annual cost of purchasing tobacco products); and
  - iv. the impact of tobacco use on significant others (premature illness of one’s father due to smoking, for example, or death of a loved one due to exposure to tobacco smoke).<sup>48</sup>
- Packages should also contain information on relevant constituents and emissions of tobacco products, Examples of such statements include “smoke from these cigarettes contains benzene, a known cancer-causing substance” and “smoking exposes you to more than 60 cancer-causing chemicals” and this information should be shown on the display area not occupied by health warnings.<sup>49</sup>
  - Target sub groups should be identified, such as youth, middle aged, etc. and Parties should consider pre-marketing testing to assess the effectiveness of the health warnings and messages on the intended target population. <sup>50</sup>Pre-marketing testing can permit identification of unintended effects, such as inadvertently increasing the craving to smoke, and assessment of their cultural appropriateness. <sup>51</sup>
  - The people should be informed of proposals to introduce new health warnings and messages as public support will assist Parties in introducing the new health warnings and messages.<sup>52</sup>

## **2.4 INTERNATIONAL DEVELOPMENTS AND INITIATIVES PERTAINING TO TOBACCO CONTROL AND ESPECIALLY PLAIN PACKAGING MEASURES**

The plain packaging initiative by WHO has already been adopted and implemented in 8 major jurisdictions like Australia (2012), France (2016), The United Kingdom (2016), Norway (2017), and Ireland (2017), will be implemented in New Zealand (2018), Hungary (2018), and Slovenia (2020), and is under formal consideration in Canada, Uruguay, Thailand, Singapore, Belgium, Romania, Chile, Turkey, Taiwan, Jersey, Guernsey, Georgia, Sri Lanka, Nepal, Finland, and

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<sup>48</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on Tobacco Control’, Decision of COP3, FCTC/COP3(10) (22 November 2008) Paragraph 23

<sup>49</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on Tobacco Control’, Decision of COP3, FCTC/COP3(10) (22 November 2008) Paragraph 32

<sup>50</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on Tobacco Control’, Decision of COP3, FCTC/COP3(10) (22 November 2008) Paragraph 38

<sup>51</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on Tobacco Control’, Decision of COP3, FCTC/COP3(10) (22 November 2008) Paragraph 39

<sup>52</sup> Guidelines for Implementation of Article 11 of the WHO Framework Convention on Tobacco Control’, Decision of COP3, FCTC/COP3(10) (22 November 2008) Paragraph 41

South Africa. Expressions of support for implementation of plain packaging have also been made by the governments of Mauritius, Kenya, Gambia, Botswana, and Burkina Faso.<sup>53</sup>

- **AUSTRALIA**-It is the first country to adopt legislation for plain packaging as on December 1, 2011. The two legislations- *The Tobacco Plain Packaging Act, 2011* and *The Tobacco Plain Packaging Regulation, 2011* were fully implemented with effect from December 1, 2012. Although, the legislations were challenged by the big tobacco companies to be unconstitutional, but the challenge was dismissed by the High Court of Australia on August 15, 2012. Thereafter, a similar appeal was made to the WTO, who also dismissed the challenge.
- **UNITED KINGDOM**- The journey of plain packaging in UK began in November 2010, when the UK government declared in connection therewith to introduce plain packaging for cigarettes and other tobacco products. Following the two public consultations, the UK government drafted regulations and notified the EU of its intent to introduce such legislation.<sup>54</sup> The UK produced a detailed and comprehensive impact assessment study in March 2015 and on March 11, 2015, the members of parliament voted in favour of plain packaging which came into force on May 20, 2016.<sup>55</sup> It applies to England, Wales, Northern Ireland and Scotland. The legislation was also challenged by the tobacco industry but the appeal was dismissed by the UK Supreme Court on April 12, 2017.<sup>56</sup>
- **FRANCE** -A national plan for reduction in consumption of tobacco was introduced by the French government in September, 2014. In that plan it explained various measures and actions that could be adopted to fight against the battle of harmful effects of tobacco. In furtherance, in addition to their strategy for reduction in consumption of tobacco the French Government amended its law by adding an article on "*Modernization of the French Health system pertaining to plain packaging of tobacco product*" similar to Irish and British legislations. They adopted the legislation on December 17, 2015 and it came into force on May 20, 2016. Thereafter, the legislation was held to be constitutional by France's Constitutional Court on January 21, 2016.<sup>57</sup> Moreover, from these considerations, France even hosted a 10-Country Ministerial meeting on plain packaging.

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<sup>53</sup> Canadian Cancer Society, *Plain packaging- International Overview* ( February 7, 2018)

<sup>54</sup> Ibid

<sup>55</sup> Children and Families Act 2014, s 94

<sup>56</sup> *BAT v. UK Department of Health*[2016] EWHC 1169

<sup>57</sup> *National Committee for Tobacco Control v. Altadis Distribution France*, No. 55175, Court of First Instance -Paris (2008)

- **NEW ZEALAND** –The legislation for Plain packaging was adopted on September 14, 2016 and regulations approved June 6, 2017, came into force on March 18, 2018 at the manufacturer level.<sup>58</sup>
- **CANADA** – The new Canadian government which was elected on October 19, 2015 had in its election manifesto promised its citizens to implement legislation for plain packaging. Thus, after winning the elections, the then Health Minister, Jane Philpott launched a public consultation and a government bill, Bill S-5, to elaborate on regulatory authority for plain packaging was approved by the Senate on June 1, 2017, received first reading in the House of Commons on June 15, 2017 and second reading on Jan. 30, 2018.<sup>59</sup>

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<sup>58</sup> Smoke-free Environments (Tobacco Standardised Packaging) Amendment Act, 2016

<sup>59</sup>The Tobacco Act and the Non-smokers' Health Act 2018, s 5

## CHAPTER 3- THE LEGITIMACY OF PLAIN PACKAGING UNDER INTERNATIONAL INTELLECTUAL PROPERTY LAWS

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Once upon a time, a packet of cigarettes came with a glitzy logo, rich foil sleeves, and romantic language describing the pleasures within appealing a large number of people specially the youth and adolescents to consume it.<sup>60</sup> The rate of consumption of tobacco was increasing with every passing day, as a result, increasing number of diseases were being reported due to consumption of tobacco. Therefore, 'plain packaging of tobacco products' is being adopted as a tobacco control policy by various legislators around the world to curb marketing and promotion of tobacco products on the ground of public health. Plain packaging, in its framework, prohibits the use of fancy logos, colour schemes, designs, and graphics on the packets of tobacco products. Given this circumstance, the plain packaging policy also controls and provides for a mechanism of using the trademarks on the packs of tobacco products. Consequently the tobacco industry is constantly trying to erode its foundation by challenging the international validity and constitutionality of the various legislations implemented in this context and also by claiming that the plain packaging is in contravention of the international legal requirements concerning the protection of trademarks. The primary contention made by the tobacco advocates challenging the validity of legislations for plain packaging of tobacco products was that these legislations fails to comply with the obligations under international legal instruments concerning the protection of trademarks, which are:

1. The Paris Convention for the Protection of Industrial Property (hereinafter referred to as the Paris Convention), especially Article 6 *quinquies* in combination with Article 7.<sup>61</sup>
2. Article 2, 8, 16 and 20 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to TRIPS).<sup>62</sup>

The above stated issues abridge to two simple parameters. Firstly, if the legislation for plain packaging of tobacco products is required to be implemented within the meaning of Article 8 of the TRIPS, then no question of its validity arises under the two international spheres. On the contrary, if the legislation is not an imperative under Article 8 of TRIPS, then the only possibility

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<sup>60</sup> Sarah A. Hinchliffe, Comparing Apples and Oranges in Trademark Law: Challenging the International and Constitutional Validity of Plain Packaging of Tobacco Products (2013) 13(4)J. Marshall Rev. Intell. Prop. Law

<sup>61</sup> Paris Convention for the Protection of Industrial Property (WIPO)(adopted 20 March 1883 and enforced 07 July 1884)

<sup>62</sup> Marrakesh Agreement Establishing the World Trade Organization 1867 UNTS 3 (adopted 15 April 1994 and entered into force 1 January 1995)

of the plain packaging legislation being in contravention of TRIPS or Paris Convention falls under Article 20 of the TRIPS agreement.

It has been contended by the tobacco manufacturers that the Paris Convention and the TRIPS agreement endorse an implied right and support the use of trademark thereby sub-consciously invalidating any legislation restricting the use of mark. These claims have ranged from assertions that these other provisions, by themselves, invalidate plain packaging legislation by creating an implied right to use a trademark to more subtle claims that these other provisions provide support for an interpretation of Article 20 that results in plain packaging legislation being more likely to contravene that Article.<sup>63</sup> For which they are not correct. Hence, in connexion of the debate surrounding the framework for plain packaging, this chapter reflects on the relevant provisions of The Paris convention and The TRIPs Agreement and explains why no right of use of trademark exists under the two international regimes.

### **3.1 THE PARIS CONVENTION- OVERSTATEMENT OF THE RIGHT TO REGISTRATION AND DEFINING THE RIGHT TO USE A TRADEMARK**

#### **RIGHT TO REGISTRATION**

As a starting point, Article 2.1 of the TRIPS Agreement obliges all the members of the WTO and parties to the Paris Convention to act in accordance with the Paris Convention with respect to other parties to Paris Convention as a matter of international law.<sup>64</sup> Article 2.1 states that "*in respect of Parts II, III and IV of the TRIPS Agreement, WTO Members shall comply with Articles 1 through 12, and Article 19, of the Paris Convention.*" In furtherance, TRIPS Article 2.2 also states that "*nothing in Parts I to IV of the TRIPS Agreement shall derogate from existing obligations that Members may have to each other under the Paris Convention or certain other treaties.*" It would be pertinent to note that neither of the two instruments i.e. The Paris Convention or The TRIPS Agreement directly confers on the owners of the trademarks the right to use their trademarks. Instead, the right may be described as "implied," particularly due to:

1. the absence of an express right to use a trademark in the Paris Convention;
2. the presence of strict obligations to register some trademarks in some circumstances;
3. the alleged futility of requiring registration without also requiring use.<sup>65</sup>

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<sup>63</sup>Mark Davison, "The legitimacy of plain packaging under international intellectual property law : Why there is no right to use a Trademark under either the Paris convention or the Trips agreement"(SSRN, 2012)<[https://papers.ssrn.com/sol3/papers.cfm?Abstract\\_id=2009115](https://papers.ssrn.com/sol3/papers.cfm?Abstract_id=2009115).> accessed 20 June 2019

<sup>64</sup> Agreement on Trade Related Aspects of Intellectual Property Rights(1 January 1995) art 8

<sup>65</sup>Lalive, "Why Plain Packaging Is In Violation Of WTO Members' International Obligations Under Trips And The Paris Convention

The Paris Convention evidently imposes a responsibility on its Member nations to allow the registration of those trademarks which have been registered in the country of its origin. This obligation flows from its Article 6 *quinquies* (A), which states that every trademark which has been registered in the country of its origin shall also be accepted for undergoing the process of registration and granted protection in other member nations of the Union if it is in consonance with other provision of the convention.<sup>66</sup> Within this framework, *Article 6 quinquies* (B) of the Paris Convention which is also incorporated into the TRIPS Agreement pursuant to TRIPS Article 2.1, provides:

“Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases:

- (i) *when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;*
- (ii) *when they are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;*
- (iii) *when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public”.*<sup>67</sup>

In the present context, inter alia, a trademark registered in respect of tobacco products would fall under the third category of Article 6 *quinquies* (B).

The objective behind grant of protection to trademark is to protect the mark from being misused and to give better protection to goods and services. The tobacco industry argued that plain packaging restricts them from using their trademark which is in itself a contravention of the rights under Trademark law and the basic purpose behind granting registration to trademarks is also being violated. Furthermore, Article 7 of the Paris Convention which states that the nature of the goods in respect of which trademark protection is being requested for should never be an

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2009< [https://www.aph.gov.au/Parliamentary\\_Business/Committees/House\\_of\\_Representatives\\_Committees?url=haa./billtobaccopackage/subs/sub30.pdf](https://www.aph.gov.au/Parliamentary_Business/Committees/House_of_Representatives_Committees?url=haa./billtobaccopackage/subs/sub30.pdf)> accessed 1 June 2019

<sup>66</sup> The Paris Convention for the Protection of Industrial Property (adopted on 20 March 1883 and amended as on 28 September 1979) art 6 *quinquies*

<sup>67</sup> The Paris Convention for the Protection of Industrial Property (adopted on 20 March 1883 and amended as on 28 September 1979) art 6 *quinquies*



obstacle while registering a trademark and the plain packaging legislation somewhat makes tobacco products an hindrance thereby restricting them from basic protection under the law.<sup>68</sup>

Against this background, what the tobacco industry has failed to mention is Article 6 of the Paris Convention, which provides:

- (1) The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation;
- (2) A mark duly registered in a country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.<sup>69</sup>

It would be pertinent to note here that what Article 6 *quinquies* (B) requires for registration of a trademark is not binding, but it has to be read with Article 6 of the Convention. Furthermore, this consequential conflict between Article 6 and Article 6 *quinquies* of the Paris Convention, wherein the former endorses the requirements for registration of trademarks to be in consonance with the domestic legislations of each country and the latter embraces a system for granting protection to in certain exceptional situations and circumstances, has been a subject matter of consideration at the WTO.

In USA, a dispute arose under Section 211 Appropriations Act,<sup>70</sup> which effectively denied registration to applicants claiming registration of trademarks representing business which were prohibited and restricted by the Cuban government. In pursuit of the legislation, the USPTO denied registration of the trademark “The Havana Club” claimed by a European business because the applicant’s title to the trademark was based on transfers from entities that had acquired the trademark as a consequence of the revolution.<sup>71</sup> In the dispute, the European Communities failed in an attempt to argue that the exceptions listed in Article 6 *quinquies* of Paris are the sole grounds upon which registration of a trademark may be refused.<sup>72</sup> In the matter, even though the refusal to register the mark by USPTO did not fall in the purview of exceptions enumerated under Article 6 *quinquies*, the WTO panel held that the legislation was justified by Article 6 and that WTO Members are free to legislate to refuse registration on grounds other

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<sup>68</sup> The Paris Convention for the Protection of Industrial Property (adopted on 20 March 1883 and amended as on 28 September 1979) art 7

<sup>69</sup> The Paris Convention for the Protection of Industrial Property (adopted on 20 March 1883 and amended as on 28 September 1979) art 6

<sup>70</sup> Report of the Appellate Body United States – Section 211 Omnibus Appropriations Act of 1998 WTO Doc WT/DS176/AB/R at [139-140]

<sup>71</sup> Mark Davison, “The legitimacy of plain packaging under international intellectual property law : Why there is no right to use a Trademark under either the Paris convention or the Trips agreement?”(SSRN, 2012) <[https://papers.ssrn.com/sol3/papers.cfm?Abstract\\_id=2009115](https://papers.ssrn.com/sol3/papers.cfm?Abstract_id=2009115).> accessed 20 June 2019

<sup>72</sup> Report of the Appellate Body United States – Section 211 Omnibus Appropriations Act of 1998 WTO Doc WT/DS176/AB/R at [139-140]

than those relating to the form of the trademark in question.<sup>73</sup> Therefore, it can be concluded that any legislation which deals with the determination of the rightful owner of a trademark is impervious to the requirements under Article 6 *quinquies*.

In the foregoing discussion, two strong justifications can be established sabotaging the arguments of the tobacco industry that plain packaging legislations are contrary to the provisions of the Paris Convention. They are:

1. Firstly, the claims by the tobacco industry vis-à-vis registration of trademark that if registration of a trademark is mandatory, then consequentially, the use of trademark after it has been registered is also a pre requisite and that intention to use or actual use of trademark is required to be proved before pursuing registration, diminish the extent to which the Paris Convention requires the registration of trademarks. It is contended by the tobacco advocates that one of the most important pre requisite for seeking registration under the Paris convention is that since to register a trademark, the applicant's impugned trademark should be either in use or there should be an intention to use that mark, therefore, the prohibition on the use of mark by the plain packaging legislation is invalid and the use of mark for tobacco products should be allowed. In other words, there is a right to use in order to obtain registration as well as a right to use as a consequence of registration.<sup>74</sup> In contrast, the procedure enumerated under the Paris Convention is far more indulgent than the picture depicted by the tobacco advocates. It directs exclusively at the issue of registration and not use. Consequently, the oblique but constant references to either a right to use that flows from registration or a right to use in order to obtain registration lose much of their force because the obligation to register is much more limited than has been portrayed.<sup>75</sup> For instance, in Australia Section 28 of the Tobacco Plain Packaging Act, 2011 specifically provides that "the absence of an intention on the part of a trademark applicant to use the trademark because of the legislation does not disqualify that applicant from obtaining registration". It is noteworthy that the legislation does not prohibit or prevent registration of trademarks representing tobacco products. Thus, it can be said that the separation of use of trademark and its registration falls within the ambit of the convention. Moreover, the registration procedure and requirements under the Paris Convention are much more flexible than advocated by the tobacco industry.

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<sup>73</sup> Ibid

<sup>74</sup> Mark Davison, 'The legitimacy of plain packaging under international intellectual property law : Why there is no right to use a Trademark under either the Paris convention or the TRIPS agreement'(SSRN, 2012)<[https://papers.ssrn.com/sol3/papers.cfm?Abstract\\_id=2009115](https://papers.ssrn.com/sol3/papers.cfm?Abstract_id=2009115).> accessed 20 June 2019

<sup>75</sup> Ibid

2. The second implication of the looser approach to registration under the Paris Convention is that the argument of tobacco advocates can be easily reversed and their argument is, in part, that the strict requirements to allow registration are mirrored by a corresponding requirement to permit use.<sup>76</sup> In any event, the spirit of the Paris Convention is quite clearly to be very deferential to Member Nations in relation to the grounds upon which they may refuse registration and is therefore necessarily even more deferential to the right of Member Nations to prevent the use of trademarks, whether registered or not.<sup>77</sup>

## **RIGHT TO USE**

Even after being a signatory to common international binding instruments, the domestic legislations of nations might differ in their approach. This is because; the goal of national legislations is to communicate the law clearly to the people who are affected by it, the officials who administer it and the judges who interpret it. Thus, every domestic legislation is drafted keeping in consideration the need, requirements, nature of the community of that nation. In the present context, the difference between the right to use a trademark as incorporated under the domestic laws of different countries and as implied into an international treaty is that the domestic legislation can be amended, changed, reshaped, redesigned and reconstructed at the will of the legislature of that state pertaining to the conditions prevailing in that state.

In the framework convention for plain packaging of tobacco products and all the legislations structured pursuant to the FCTC have imposed a prohibition on the use of fancy trademarks, logos representing the product. As a result, a legitimate question is being raised by the tobacco industry that what is the rationale of registering a mark when the use of mark is not allowed?

On numerous occasions, the courts of various jurisdictions have dealt with the question. It has been concluded that there have been innumerable instances where registration of a trademark without a right of use had been held to be valid. For example, where a pharmaceutical product is awaiting regulatory approval before it is sold in the country of registration.<sup>78</sup> What is required to be appreciated in the central controversy is that there is an unambiguous and a well-defined difference between the types of prohibition imposed- one on the use of a trademark, while other on the sale of the product associated with that trademark.

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<sup>76</sup>Daniel Gervais, *Analysis of the Compatibility of Certain Tobacco Product Packaging Rules with The TRIPS Agreement and The Paris Convention* (World Trade Organisation 30 November 2010)  
<<https://www.jti.com/sites/default/files/key-regulatory-submissions-documents/submissions/eu/12gervais.pdf>>  
accessed 20 May 2019

<sup>77</sup> Ibid

<sup>78</sup> Ibid

To appreciate the central controversy, it would be pertinent to refer to Article 5 of the Paris Convention for apt recapitulation. Article 5 compliments the situation as it deals with the non-use provisions, it states that “Non-use may be a ground for removal of a trademark” and in the present case the legislation restricts the use of trademark on the packs of tobacco products but it allows the use of trademark on bills and other similar modes of business transactions. The restriction of non-use on packs is for the interest of the public. It is high time to realise that public health should be treated as a matter of utmost importance as compared to other policy objectives, for instance, determining the right to use the trademark and how to limit that right or how to create exceptions to it.

### **3.2 THE TRIPS AGREEMENT AND THE PLAIN PACKAGING IN CONTEXT**

Plain packaging legislations impose strict restrictions on the use of word marks and figurative marks. Consequently, there have been numerous legitimate questions raised by the tobacco advocates against this background challenging the validity of the entire concept of plain packaging, not being in consonance with the instruments of WTO’s specifically TRIPS. It is the obligation of the members of WTO to take effective measures to protect and promote health and well-being of people, but in the process, it is essential that they should comply with the requirements of various instruments of WTO.

On the issue of plain packaging when observed from an international intellectual property perspective, the main contention is to see if the plain packaging laws are in violation of the trademark or any other provision of TRIPS Agreement. The key issues relevant to the plain packaging, which require interpretation of the TRIPS Agreement, can be summarized as follows:

1. Whether plain packaging of tobacco products imposes unjustified encumbrances under Article 20 of The TRIPS Agreement;
2. The relevancy of Article 15, 16, 17, and 19 to the interpret Article 20 and to establish the context of Article 20 with respect to plain packaging;
3. The object and purpose of the TRIPS Agreement and the trademark provisions therein;
4. Whether the restrictions imposed by the plain packaging measures are justified because they are for enhancing public health;
5. Relevancy of Article 8 of the TRIPS Agreement to the interpretation of Article 20 in context of plain packaging.<sup>79</sup>

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<sup>79</sup>W. Kip Viscusi, The New Cigarette Paternalism, 25 REGULATION 58 (2002–2003)

It is the duty of members of WTO to initiate measures to protect and promote public health and for this they should comply with the agreements associated with it. This kind of compliance is necessary for a stable and predictable world trading system and to achieve this it is important that the rules of WTO should be properly interpreted with the help of The Vienna Convention on the Law of Treaties (VCLT) should be resorted to. VCLT holds a great value as there are many instances when it has been applied to WTO disputes as a set of interpretive rules.

It is pertinent to note that in the ongoing debate it is quintessential to interpret the TRIPS Agreement in the light of plain packaging as any case filed against the subject matter is likely to impact future involving cases concerning not only the TRIPS Agreement but also the *modus operandi* being used to interpret it.<sup>80</sup> Therefore, the decision made in these situations have to be very solicitous bearing in mind that these involve issues related to public health as one decision affects the subsequent ones.

### **THE RULES OF INTERPRETATION OF TREATY**

Article 31 of the VCLT, is the cardinal rule of interpretation of TRIPS which requires that, “interpretation of a treaty must be done in good faith in the light of the objectives and purpose highlighted in the treaty.”<sup>81</sup> It would be pertinent to note that the treaty begins with the words “in good faith” which requires that the interpretation of Article should be made in a way to avoid absurd or unreasonable results.<sup>82</sup> What amounts to such a result will of course be specific to the facts and treaty at issue.<sup>83</sup> So, from this perspective, “in the context of trademarks and the TRIPS Agreement, a good faith interpretation must at least require that the trademark provisions are interpreted in light of their context and of the TRIPS Agreement’s object and purpose”.

All facets of Article 31.1 have to be borne in mind when it comes to interpretation of language of a treaty. As has already been stated above that to identify the ordinary meaning of any provision in a treaty, it should be interpreted in accordance with its object and purpose as well as the surrounding words use in the article in question.<sup>84</sup> Some specific statements of preamble or other supporting provisions which are relevant to the subject matter should also be looked into.<sup>85</sup> For instance, Article 8 of the TRIPS Agreement articulates principles for the agreement and puts an obligation on the members of WTO by stating in the Article that members may

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<sup>80</sup>Ian Sinclair, *The Vienna Convention on The Law Of Treaties* (2d ed. Manchester University Press 1984)

<sup>81</sup>Malcolm N. Shaw, *International Law* (5th ed. Cambridge Publishers 2003)

<sup>82</sup> Ian Sinclair, *The Vienna Convention on The Law Of Treaties* (2d ed. Manchester University Press 1984)

<sup>83</sup>Mary E. Hiscock *The Keeper Of The Flame: Good Faith And Fair Dealing In International Trade* (1996) 29 LOY. L.A. L. REV

<sup>84</sup> Ian Sinclair, *The Vienna Convention on The Law Of Treaties* (2d ed. Manchester University Press 1984)

<sup>85</sup>Mark E. Villiger, *Commentary On The 1969 Vienna Convention On The Law Of Treaties* 415–49 (2009)

adopt certain measures or policies which are necessary to enhance public health and nutrition while drafting or amending their domestic laws and regulations and should also focus on promoting public interest in areas which are very crucial to their technological and socio-economic progress.<sup>86</sup>

There have been a many instances when a very formal and rigid interpretation has been given to the TRIPS Agreement by various WTO Panels and appellate bodies.<sup>87</sup>It has been argued by many scholars and researchers that in many existing dispute settlement reports, WTO has not used VCLT in a way to give specific importance or to explain the crucial role played by Article 7 and 8 of The TRIPS Agreement.<sup>88</sup>Although, *The Doha Declaration on the TRIPS Agreement and Public Health* expressly states that Articles 7 and 8 are relevant to interpretation of the TRIPS Agreement.<sup>89</sup>

The VCLT embraces rules and explains the purpose of using sources that can be used to establish that purpose. Article 31.1 depicts the fact that objectives and purpose of any treaty should be interpreted in a way that the ordinary, original meaning and subject matter of the treaty remains unaltered. The object and purpose are rather tools through which the subject matter is discerned and applied.

## **POWER OF A GOVERNMENT AT INTERNATIONAL LAW TO RESTRICT THE PRIVILEGE OF USE OF TRADEMARKS**

One of the critical issues in the interpretation of TRIPS is the extent to which governments may restrict the privilege of using trademarks even though they may still acknowledge the right to exclude and a right to registration.<sup>90</sup> The starting point from an international legal perspective is that, absent international agreements to the contrary, a sovereign government enjoys untrammelled power to make a determination via its own internal processes that its legitimate interests justify it asserting a claim right to the non-use of a trademark owner's intellectual property.<sup>91</sup>

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<sup>86</sup> Agreement on Trade Related Aspects of Intellectual Property Rights(1995) art 8

<sup>87</sup>Graeme B. Dinwoodie& Rochelle Dreyfuss, TRIPS and the Dynamics of Intellectual Property Lawmaking, (2004) 36 CASE W. RES. J. INT'L L

<sup>88</sup> Peter K. Yu, The Objectives and Principles of the TRIPS Agreement, (2009) 46 HOUS. L. REV

<sup>89</sup> James T. Gathii, The Legal Status of the Doha Declaration on TRIPS and Public Health Under the Vienna Convention on the Law of Treaties, (2002) 15 HARV. J.L. & TECH

<sup>90</sup>Davison, Mark, Patrick Emerton, 'Rights, Privileges, Legitimate Interests, and Justifiability of Article 20 of TRIPS and Plain Packaging of Tobacco' (2014) American University International Law Review 29 No. 3, 505-580

<sup>91</sup>National preventive Health taskforce, 'Taking Preventative Action – A Response to Australia: The Healthiest Country by 2020' (2010) paras 65–67

A government may thereby impose a duty upon the trademark owner not to use intellectual property, correlative with the asserted right and as a government has an untrammelled power to confer such a right upon itself, the privilege holder is liable to the exercise of that power.<sup>92</sup>Hence, the duty that correlates with the right can be and is imposed.<sup>93</sup> A shorthand way of expressing this proposition is that a government has the power to impose a duty on its corporate and personal citizens, in this case a duty not to use the intellectual property in question.<sup>94</sup>

In the ongoing debate over whether legislations for plain packaging of tobacco products are in consonance with the TRIPS Agreement, the solution to the focal issues revolves around the scope and minimum standards which the member nations provide in the national trademark legislations.

Provisions relating to the trademark law can be traced in the Paris Convention and those provisions, as discussed above, are also incorporated into the TRIPS Agreement. Part II namely “Standards concerning the availability, scope and use of Intellectual Property Rights”, from Article 15-21 of the TRIPS Agreement provide for minimum standards and substantive provisions for Trademarks, wherein Article 21 is primary to the central issue. Therefore, analysis of Article 20 in light of VCLT is essential to appreciate the issue at hand.

## **THE NATURE & ESSENCE OF OBLIGATION UNDER ARTICLE 20**

Article 20 of The TRIPS Agreement states that any ‘*unjust encumbrances*’, like using trademarks with other similar marks, using it in a way which is damaging its ability to differentiate the goods or services it represents from other goods and services of similar nature, should not be imposed on the use of trademark in the course of trade.<sup>95</sup>

Article 20 uses the term “encumbrances”, the dictionary meaning of which is to “hamper, impede, or burden.”<sup>96</sup> Interpreting Article 20 according to the rules of interpretation explained under The VCLT , if any measure or standards prevent or restrict the use of trademark or hampers the ability of the trademark to differentiate between the goods and service it is registered for from other similar goods and service then the reason behind such encumbrance has to be looked into.<sup>97</sup> Article 20, intrinsically does not does not prohibits every measure

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<sup>92</sup>Wesley Newcomb Hohfeld, ‘*Fundamental Legal Conceptions As Applied In Judicial Reasoning*’ (David Campbell & Philip Thomas eds., 2001)

<sup>93</sup>Davison, Mark, Patrick Emerton, ‘Rights, Privileges, Legitimate Interests, and Justifiability of Article 20 of TRIPS and Plain Packaging of Tobacco’ (2014) *American University International Law Review* 29 No. 3, 505-580

<sup>94</sup> Ibid

<sup>95</sup> Agreement on Trade Related Aspects of Intellectual Property Rights(1995) art 20

<sup>96</sup>Benn Mcgrady, ‘TRIPS And Trademarks: The Case Of Tobacco’ (2004) *WORLD TRADE REV.* 53, 62–63

<sup>97</sup> Ibid.

imposing restriction upon the use of trademark, instead, it prohibits only those measures and policies which “*Unjustifiably encumber*” the use of mark in the course of trade.<sup>98</sup>

One of the most important and relevant principle of interpretation as incorporated in the VCLT is that when there are two or more interpretations of a statute or any provision then preference should be given to the one which appreciates and connects to the object and purpose of the treaty or statute it is a part of. This helps in making that treaty or statute more effective and proves that it is made in good faith. The following principle can be preferred to better comprehend the interpretation of Article 20 in the present context.

The term “*special requirements*” used in Article 20 was interpreted in relation to TRIPS Article 13 in the WTO Panel Report as “having an individual or limited application or purpose”; “containing details; precise, specific”; “exceptional in quality or degree; unusual; out of the ordinary”; or “distinctive in some way.”<sup>99</sup>

In Cuba, the Panel for Tobacco Plain Packaging while considering the scope of “special requirements” used under Article 20 stated that a simple and plain meaning of the term ‘requirement’ does not imply that a certain action or behaviour will be permitted by excluding some other legitimate actions.<sup>100</sup> In furtherance, the panel continued to explain that the phrase “special requirements” address to a situation that must be adhered to, in accordance with the purpose the trademark is destined to serve in the course of trade. The special requirements have a limited scope and application. It has to be noted that the term “special” is required to be interpreted with the surrounding words and circumstances and it may also include requirements much beyond the scope of trademark. Thus, in any circumstance, a requirement restricting the use of trademark will fall within the reasonable definition of ‘special’.<sup>101</sup>

## **LEGITIMATE INTEREST OF GOVERNMENT: ARTICLE 20**

One of the prime features of Article 20 is that it acknowledges the legitimate interest of the government by simultaneously focusing on the “privilege of use” rather than a “right to use”. Article 20 gives the right to third parties i.e. The Government to restrict or prevent the right to exercise the “privilege of use”. The only possible interpretation of the term “unjustifiably” in context of Article 20 is that it determines the legitimate interest of government to prevent others

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<sup>98</sup> Ibid.

<sup>99</sup> Panel Report, *United States—Section 110(5) of the US Copyright Act* WT/DS160/R para 6.109

<sup>100</sup> Panel Report, *Australia – Tobacco Plain Packaging (Cuba)*, para. 7.2222.

<sup>101</sup> Ibid.



from using their right. Some of the interests of the government in preventing the use of the right enshrined under the TRIPS agreement are:

### **1. Prohibition on Use of Signs for Promotion**

It is deemed to be one of the duties of the government to work on betterment of public health and for the benefits of its people; therefore, the governments of various nations hold legitimate interest in preventing the promotion of consumption of tobacco. For exercising this interest they have the right to impose certain restrictions on its people, like, restricting and preventing the use of any logos, signs, and symbols etc. which promote the consumption of tobacco products by making them more appealing and attractive. The proposition that promotion of tobacco occurs via the use of packaging is difficult to refute. British American Tobacco Australasia Ltd has expressly admitted in litigation that it uses its packaging to promote its products as well as to differentiate them from others.<sup>102</sup> At least one Australian High Court justice has agreed with that proposition.<sup>103</sup> Since times immemorial it has been very evident from the actions of the tobacco companies that packaging of their products is one of the key feature of the product to attract more consumers.

The legislations for plain packaging regulate the use of trademarks or any other fancy logos and aims to make the products look less attractive. Tobacco packaging is used to promote tobacco and it is used to mislead consumers about the characteristics of the product and one of the reasons we know this is that over 170 nations have signed or acceded to a treaty that says so.<sup>104</sup> In the light of above stated, it can be concluded that there are no evidences to prove that the FCTC seeks to override or conflict with the TRIPS Agreement.

### **2. Promotion Outside the Course of Trade**

The FCTC aims at making the tobacco products packs plain and bland in a way that they do not contribute towards promotion of consumption of tobacco but time and again with all the legal suits instituted at various courts of various jurisdictions proves the desperation of the tobacco industry to achieve and earn the rights of fancy packaging of their products.

### **3. Misleading Uses of Signs**

Before 2003, the tobacco industry used fancy logos and symbols on the packaging of tobacco products which delivered a wrong message about the characteristics of the products to the

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<sup>102</sup>*British American Tobacco Australasia Limited v Commonwealth* [2011] S389 (Austl.)

<sup>103</sup>*JT Int'l SA v Commonwealth* [2012] HCA 43, 286 (Austl.)

<sup>104</sup>Parties to the WHO Framework Convention on Tobacco Control, WHO, <[http://www.who.int/fctc/signatories\\_parties/en](http://www.who.int/fctc/signatories_parties/en)>assessed May. 28, 2019

people that they were safe to consume. The following issue is dealt under Article 11 of the WHO FCTC (as has already been explained in Chapter 2. Thus, the governments who are signatory to the convention can impose restrictions on the use of trademarks and logos in this case so as not to mislead the people.

#### **4. Public Health as a Legitimate Interest**

The debate about the relevance of health as a general principle by which justification of encumbrances may be demonstrated has occurred in other publications.<sup>105</sup> The essence of the debate is whether health measures must be necessary under Article 8(1) to constitute a justification for the purposes of Article 20, or whether the reference to justification encompasses the basic principle that protecting public health is highly relevant to considering whether plain packaging is permissible under TRIPS.<sup>106</sup>

The WTO has expressly made a confirmed obligation through “Doha Declaration on TRIPS and Public Health” by using the terms “Right to protect public health” that it is the obligation of the member nations to protect and work for the enhancement of public health. Therefore, it can be said that the governments have a legitimate right to restrict the use of trademarks in anticipation of protecting public health.

In furtherance, paragraph five of the Doha Declaration also provides that when the rules of customary international law have to be applied, every provision of TRIPS Agreement has to be read with the objects and purpose of the agreement as provided under Article 7 and 8 of the agreement. Moreover, WHO in its preamble states that, “*The enjoyment of the highest attainable standard of health is one of the fundamental rights of every human being without distinction of race, religion, political belief, economic or social condition*”. It further states that “The health of all peoples is fundamental to the attainment of peace and security and is dependent on the fullest co-operation of individuals and States. The achievement of any State in the promotion and protection of health is of value to all.” Furthermore, Article 1 of the Constitution of WHO, which, enumerates the objectives of WHO states that, “The objective of the WHO shall be the attainment by all peoples of the highest possible level of health.” Therefore, interpreting Article 20 in this context will not make it contrary to the essence of the TRIPS Agreement.

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<sup>105</sup> Daniel Gervais, Plain Packaging and the TRIPS Agreement: A Response to Professors Davison, Mitchell and Voon, 23 AUSTL. INTELL. PROP. J. 96 (2013)

<sup>106</sup>Mark Davison, “The legitimacy of plain packaging under international intellectual property law : Why there is no right to use a Trademark under either the Paris convention or the Trips agreement”(SSRN, 2012)<[https://papers.ssrn.com/sol3/papers.cfm?Abstract\\_id=2009115](https://papers.ssrn.com/sol3/papers.cfm?Abstract_id=2009115).> accessed 20 June 2019

Thus, to conclude the ongoing debate it can be said that protection and enhancement of public health is one of the primary legitimate obligation of the governments. To ensure the attainment of their goal certain valid restrictions imposed on the use of trademark will not hinder the purpose and objective of the TRIPS Agreement, rather it will help in attaining one of the most important goal of WHO.

## CHAPTER 4 – AUSTRALIAN EXPERIENCE WITH PLAIN PACKAGING AND ITS IMPLICATION

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### 4.1 BACKGROUND

It was in 1973 when for the first time Australia witnessed its cigarette packs with a faint and an unobtrusive health warning glancing at the bottom corner of the packs. Though, Australia was not the first country which was trying to make people aware of the harmful effects of use of tobacco, even USA had started putting health warnings on cigarette packs by then. Thereafter, in the mid-1970s USA, UK and Australia had implemented guidelines regarding ban of cigarette advertisement on televisions and also imposed a complete restriction on smoking in Cinema and public halls and even on public conveyances like trains and buses. By September 1976, all kinds of advertisement and promotion of tobacco products was banned on radios and televisions but it took another 16 years to ban all other remaining forms of advertisement which were then prohibited by the *Tobacco Advertising Prohibition Act, 1995*.

In addition, in 1983 Australia introduced and established in each state “QUIT CAMPAIGNS” which focused on making people aware of the dangerous impact of tobacco consumption and the hazardous effect of smoking on human health. Australian Government had started allocating separate funds for spreading the “*Quit*” message to the public at large by:-

1. Funding the advertisement companies to play those advertisements which deliver the “Quit” message during the peak prime hours rather than late nights;
2. Governments encourage media coverage of the campaign by using celebrities to promote the programme and broadcasted it on a high-rating television and radio programmes which popularised the ‘Quit’ message;

The massive support by the public towards the ‘*Quit*’ initiative encouraged the government to place serious concerns on enacting the law.<sup>107</sup> Furthermore, because of the recommendations enforced by various international health departments to put a ban on all types of promotion and advertisement of tobacco products and to increase the rate of taxes imposed on tobacco products with the objective of making tobacco products expensive and to collect more funds for public awareness campaigns.<sup>108</sup>

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<sup>107</sup>Borland R, Winstanley M, Reading D. Legislation to institutionalize resources for tobacco control: the 1987 Victorian Tobacco Act. *Addiction* 2009;104:1623–9

<sup>108</sup> Ibid

The entire process of regulating consumption of tobacco and making people aware of its harmful effects has been very sluggish and inactive due to the response of the tobacco industry regarding the same and the nonchalant attitude of the government in working towards lowering the consumption of tobacco. Moreover, the deliberate attempts of those working in tobacco control were being constantly threatened by the constant lobbying by the tobacco industries. As it has already been discussed in Chapter 2, since 1980 the tobacco industry had been advocating against plain packs i.e. putting health warnings on cigarette packs, despite all the hurdles Australia is one country which has worked on its “tobacco control agenda” very vigorously and with full determination. The effect of all the important achievements and activities on these front was seen during late 1980s when people started putting restrictions on smoking not only at public places and places of hospitality but also their private workplaces, which had also helped in outgrowing an “anti-smoking sentiment” among the people of Australia.

One of the primary achievements of Australia in this regard is that it is one of the first forty countries to sign and ratify the WHO FCTC on the date of enforcement of the convention i.e. February 27, 2005. Since the mid-1970s with a very comprehensive approach, Australian Government is very famous for launching mass media campaigns, raising consumer awareness, re-thinking their tobacco taxation policy and providing advisory support, medication and therapies to the smokers.<sup>109</sup> In Figure 1 the most important achievements and campaigns undertaken in this regard have been stated in brief.

The efforts of Australian government over past four decades have been very fruitful as there had been significant decline in tobacco consumption rate “*from 3500 gms of tobacco per person in 1961 to 875 gms per capita in recent years*”.<sup>110</sup> Thus, it can be seen that Australian Government has been consistently putting efforts on reducing the rate of consumption of tobacco and therefore by adopting a comprehensive approach it had launched different programmes via SMS, telephones, internet and smart phone applications which motivates, supports and encourage smokers in their “Quit Attempts”.

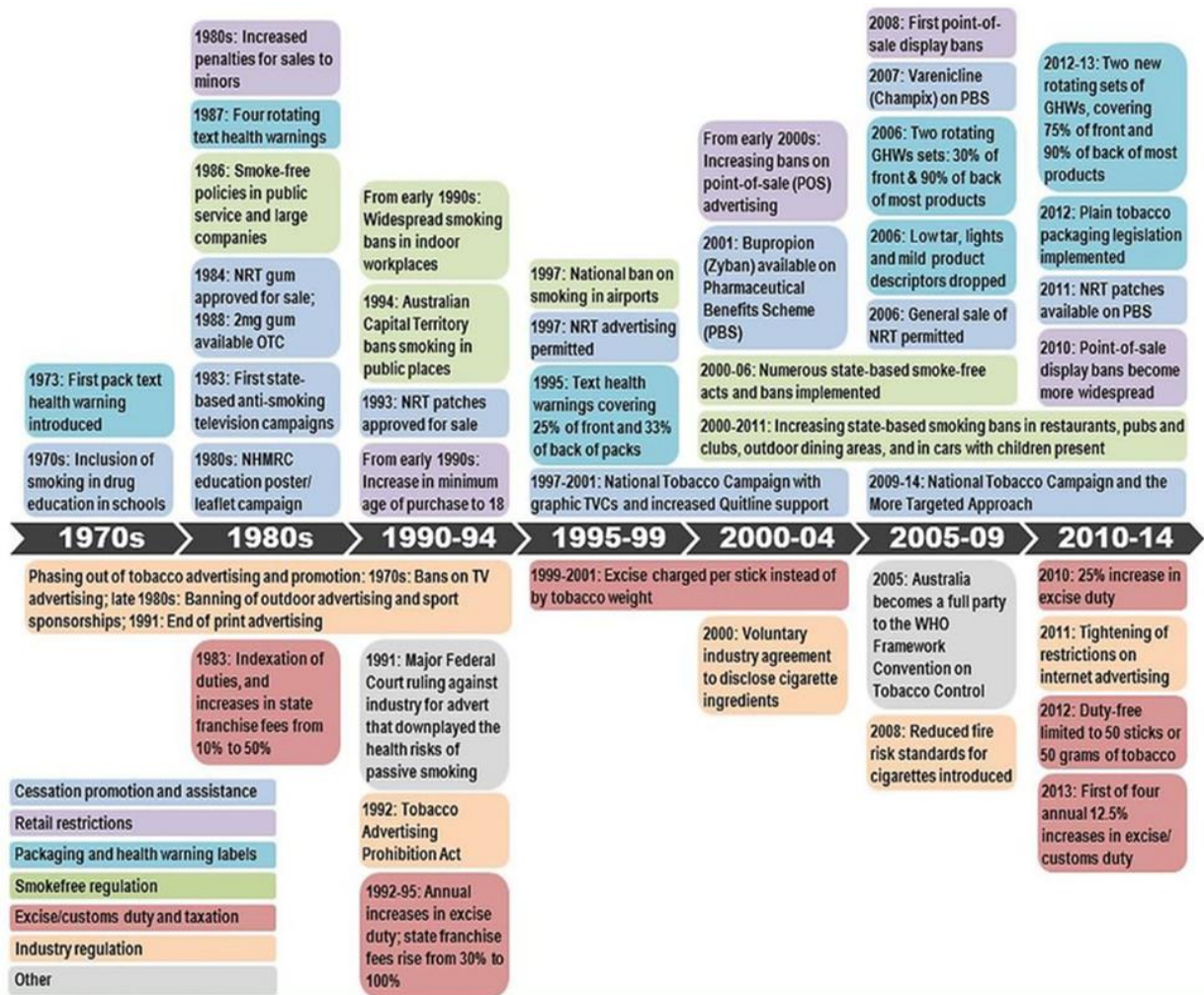
Due to continuous rigorous efforts of Australian government against the tobacco epidemic, the tobacco industry describes Australia as the “*World’s Darkest Market*”. In Australia, tobacco advertisements and promotion was banned from very type of virtual media including TVs, radios by the end of 1970s, and no promotion was allowed through posters, billboards, newspapers,

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<sup>109</sup> Scollo M, Winstanley M, ‘Tobacco in Australia: facts and issues’ 2012 <<http://www.tobaccoinaustralia.org.au>> accessed 21 June 2019

<sup>110</sup>Michelle Scollo, Megan Bayly, Melanie Wakefield, ‘Plain packaging: a logical progression for tobacco control in one of the world’ s ‘darkest markets’ (2015) <[https://tobaccocontrol.bmj.com/content/tobaccocontrol/24/Suppl\\_2/ii3.full.pdf](https://tobaccocontrol.bmj.com/content/tobaccocontrol/24/Suppl_2/ii3.full.pdf)> accessed 20 June 2019

magazines or sports sponsorships by the end of 1990s and during early 2000s the retail display of products was also banned completely.<sup>111</sup> Australia had during early 2000s already banned use of trademarks, logos, business names, or any other form of fancy designs on the tobacco packs, but, the tobacco industry was constantly challenging the same claiming that the policy is violating their constitutional and trademark right, but, by enacting the first ever legislation for plain packaging standardising the packaging of tobacco products, Australia had given a major throw-back to the tobacco industry's market strategies and policies as the legislation focused on reduction of misleading advertising and promotion of tobacco products by the tobacco industry.<sup>112</sup>



**Figure 1:** Journey of tobacco control policies in Australia from 1970 to 2014.

**Source:** Scollo M and Winstanley M, eds. *Tobacco in Australia: Facts and Issues*, 2012.<sup>113</sup>

<sup>111</sup> Scollo M, Winstanley M., 'Tobacco in Australia: facts and issues' 2012 <<http://www.tobaccoaustralia.org.au>> accessed 21 June 2019

<sup>112</sup> Preventative Health Taskforce, *Australia National Preventative Health Strategy* (1-74186-920-X 2009) ch 6

<sup>113</sup> Scollo, MM and Winstanley MH., 'Tobacco in Australia: Facts and issues' (Cancer Council Victoria 2012)

## 4.2 JOURNEY OF PLAIN PACKAGING IN AUSTRALIA

YEAR	MILESTONE
2008	<ul style="list-style-type: none"> <li>• A National Preventative Health Taskforce was announced to be established by Nicola Roxon, the then Health Minister of Australia.</li> <li>• The National Preventative Health Taskforce released the draft report for consultation by strongly recommending implementation of plain packaging.</li> <li>• On the report the parties to the WHO FCTC adopted “<i>Guidelines on advertising and package labelling</i>” which also recommended the use of plain packaging.</li> </ul>
2009	<ul style="list-style-type: none"> <li>• The National Preventative Health Taskforce released a final report to Australian Government.</li> <li>• The report was released by the Minister which included recommendations on implementation of plain packaging.</li> </ul>
2010	<ul style="list-style-type: none"> <li>• Kevin Rudd, the 26<sup>th</sup> Prime Minister of Australia along with Nicola Roxon announced a 25% increase in tax on tobacco products and the introduction of plain packaging.</li> </ul>
2011	<ul style="list-style-type: none"> <li>• Australia communicated to WTO its intention to implement plain packaging.</li> <li>• The British American Tobacco Australia Limited launched an advertising campaign in Australia opposing plain packaging.</li> <li>• Australia was appreciated by WHO for initiating implementation of plain packaging.</li> <li>• On 21<sup>st</sup> November the House of Representatives passed the amended bill.</li> <li>• On the same day i.e. Phillip Morris Limited challenged the bill for plain packaging by serving a notice of arbitration against the Australian Government.</li> </ul>
2012	<ul style="list-style-type: none"> <li>• The case by Phillip Morris commenced before The High Court of Australia.</li> <li>• The court decided in favour of plain packaging and held that it will be illegal to manufacture or import branded cigarette packs.</li> </ul>

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| <ul style="list-style-type: none"><li>• On December 1, the legislation for plain packaging was fully implemented in Australia.</li></ul> |
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### 4.3 SUMMARY OF THE TOBACCO PLAIN PACKAGING ACT, 2011

*The Tobacco Plain Packaging Act, 2011* in its Preamble expresses the purpose of the Act and states that it is “*An Act to discourage the use of tobacco products, and for related purposes*”. The Act contains 6 Chapters with 109 Sections.

#### • OBJECTIVE OF THE ACT

Section 3 of the Act explains the objectives of the Act which states that it is duty of the state to improve health and living conditions of the people by make people more aware of the harmful effects of smoking to discourage them to consume tobacco products or smoking cigarettes; by encouraging more and more people that it is possible for them to be a part of Quit campaign and stop consuming tobacco products or to give up on their smoking habits and by providing them with proper medication and therapies to avoid getting back or relapsing to their old habits.<sup>114</sup>It should also be ensured that there should be minimum exposure of tobacco products to stop the people from smoking them.<sup>115</sup> In furtherance, Section 3(2) of the Act also provides that it is the duty of the parliament to standardise and regulate the packaging and appearance of tobacco products by planning strategies for reducing the appeal of tobacco products, by enhancing the health warnings and by restricting the tobacco industry from providing false and misleading information about tobacco products to the consumers.<sup>116</sup>

#### • REQUIREMENTS FOR PLAIN PACKAGING AND APPEARANCE OF TOBACCO PRODUCTS

Chapter 2 of the Act under Part 2 from Section 18 to Section 25 provide for “*Requirements for retail packaging and appearance of tobacco products*”. The chapter explains in detail the requirements for the physical appearance and characteristic features such as the colour, finish, and the use of marks, trademarks etc. on tobacco packaging. The salient requirements for plain packaging are as follows:-

1. Unless otherwise provided by the Act, the tobacco pack from its outer and inner surface must be kept devoid of artistic ridges, carvings, moulds, stamps or any other asymmetric

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<sup>114</sup> The Tobacco Plain Packaging Act 2011, s 3 (1)

<sup>115</sup> *Ibid.*

<sup>116</sup> The Tobacco Plain Packaging Act 2011, Section 3(2)



shape or texture or any other kind of ornamentation which beautifies a tobacco pack, even the adhesive substances used in producing the packs must be transparent and not tinted.<sup>117</sup> Also the entire packet of tobacco product should not be glossy but with a matt finish and must be in dab dark brown colour.<sup>118</sup>

2. A pack of cigarette must be rigid and only made of cardboard and all the edges of the package must not be curvy, rounded or in any other shape, but they should be straight.<sup>119</sup>
3. Section 20 of the Act imposes a clear restriction on the use of marks, trademarks or any other similar logo other than name of the company, business or trade name or any form of variant of tobacco products anywhere on the package of tobacco products.<sup>120</sup>
4. Furthermore, Section 21 is in continuation and has to be read with Section 20 of the Act. It imposes a restriction on the use of brand imagery, name of the company, business or any such other variants and states that these should not be used more than once on the package or carton and should be placed on following locations:
  - (i) The front, top and bottom of the outer surfaces of the cigarette pack;
  - (ii) The front, top and bottom of the front outer surfaces of the cigarette carton.<sup>121</sup>
5. Tobacco companies are not allowed to use any inserts or onserts on the package<sup>122</sup> and the packaging should not make any kind of noise while opening or closing it and should not be scented in way leading to advertising and promotion of tobacco.<sup>123</sup>
6. The use of inks which get activated by heat, inks or any ornamentation which are so architected that they gradually pop up over the time, any kind of ink which change their colour when they come in contact with light source, or the fold-out panels and the panels which are so designed that when they are scratched they reveal any design, image or text are not allowed to be used.<sup>124</sup>
7. Section 26 imposes restriction on the use of trademarks or any other associated marks on the packaging of a tobacco product, which is further supported by Section 28 which provide detailed guidelines for as to the impact of Section 26 on Australia's Trade Marks Act 1995.

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<sup>117</sup> The Tobacco Plain Packaging Act 2011, s 18(1)

<sup>118</sup>The Tobacco Plain Packaging Act2011, s 19(2)

<sup>119</sup> The Tobacco Plain Packaging Act 2011, s 18(2)

<sup>120</sup> The Tobacco Plain Packaging Act 2011, s 20

<sup>121</sup> The Tobacco Plain Packaging Act2011, s 21

<sup>122</sup>The Tobacco Plain Packaging Act 2011, s 23

<sup>123</sup>The Tobacco Plain Packaging Act 2011, s 24

<sup>124</sup>The Tobacco Plain Packaging Act 2011, s 25

The Explanatory memoranda<sup>125</sup> to The Tobacco Plain Packaging Act, 2011 issued by the Government of Australia provide with an explanation to Section 28 and states that even though the bill restricts the trademark rights of tobacco manufacturers, Section 28 facilitates them by preserving their right to protect get their trademark registered and protect their trademark.<sup>126</sup> Section 28 in fact provides with a method in which the provisions of Trade Marks Act, 1995 and The Trade Marks Regulations, 1995 will function in consonance with the plain packaging legislation.<sup>127</sup> The memoranda explains the same situation with an example, that, In Australia, whenever any trademark will be registered in respect of a tobacco product it will be deemed as if the owner of the trademark will use it on the operation of the Bill for the products and not on the packaging of the product or the product itself.<sup>128</sup> And if someone infringes the trademark or makes an application for removal of trademark on the grounds of *non-use*, then the argument in favour of the owner of the original trademark will be that he was using it for the operation of the Bill.<sup>129</sup>

For apt recapitulation it would be pertinent to refer to the case of *Moorgate Tobacco Co. Limited v. Phillip Morris Limited and Another*,<sup>130</sup> wherein it was held by Hon'ble Deane J. that, "... [i]t is not necessary to have an actual dealing in goods bearing the trademark before there can be a local use of the mark as a trade mark, therefore, in cases where there had been a small yet sufficient amount of use of mark, it is possible to identify an actual trade or offer to trade in the goods bearing the mark". Bearing the above stated judgment in mind, it can be interpreted that due to the implementation of a regulation for plain packaging the trade mark protection will not be extended on the ground of non-use but on the ground of 'small yet sufficient use'.

Moreover, Section 231 A of The Trade Marks Act, 1995<sup>131</sup> was inserted to it by The Trade Marks Amendment (Tobacco Plain Packaging) Act, 2011. The central purpose of the amendment was

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<sup>125</sup> Minister for Health and Ageing *Explanatory Memoranda to The Plain Packaging Bill, 2011* <<https://www.legislation.gov.au/Details/C2011B00128/Explanatory%20Memorandum/Text>> accessed 24 June 2019

<sup>126</sup> Ibid

<sup>127</sup> Ibid

<sup>128</sup> Ibid

<sup>129</sup> Ibid

<sup>130</sup> *Moorgate Tobacco Co. Limited v. Phillip Morris Limited and Another* (1984) 156 CLR 414

<sup>131</sup> The Trade Marks Act 1995, Section 231A of - Regulations may make provision in relation to the Tobacco Plain Packaging Act 2011

(1) The regulations may make provision in relation to the effect of the operation of the Tobacco Plain Packaging Act, 2011, and any regulations made under that Act, on:

- (a) a provision of this Act; or
- (b) a regulation made under this Act, including:
  - (i) a regulation that applies a provision of this Act; or
  - (ii) a regulation that applies a provision of this Act in modified form.

to prevent the use of a trade mark on the packaging of a tobacco product so that it does not make the product look attractive. The central theme of plain packaging is to make the graphical health warning clear and more prominent, therefore, use of trade marks or any other form of mark is prohibited to prevent it from being used as a design feature which will promote the product by making the product more attractive and will lure more consumers towards it, thereby, diminishing the impact of health warnings. Section 28 of The Plain Packaging Act ensures that the implementation of the Act will not infringe the rights of the trade mark owners to protect and use their marks, instead it allows them to use the mark in a manner that the use is not contrary to The Tobacco Advertising Prohibition Act, 1992 or any other law in this matter.

Therefore, to achieve the above stated purpose, Section 231 A was added to The Trade Marks Act, 1995, which permits formulation of regulations under the Act to give effect to the provisions of The Plain Packaging Act.

8. The Act further operates by imposing obligations on its citizens by providing that a person must neither buy or sell those tobacco products which are not in compliance with the conditions and requirements of the Act nor Participate in the business of packaging of tobacco products if those labels and packets are not in consonance with the requirements of the Act.<sup>132</sup> Section 31 further provides that if any person is found to be involved in any of the acts stated above may:

Said to have been committed a “ <i>fault-based offence</i> ” which means an the kind of offence where fault elements apply to	commit a “ <i>strict liability offence</i> ” which means an offence where no fault elements apply to the	may also said to have contravened a civil penalty provision, for which penalty will be 2000 units (\$2,20,000)
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Note: Section 28 of the Tobacco Plain Packaging Act 2011 also sets out the effect of the operation of that Act on certain provisions of, and regulations made under, this Act.

(2) Without limiting subsection (1), regulations made for the purposes of that subsection may clarify or state the effect of the operation of the Tobacco Plain Packaging Act 2011, and any regulations made under that Act, on a provision of this Act or a regulation made under this Act, including by taking or deeming:

- (a) something to have (or not to have) happened; or
  - (b) something to be (or not to be) the case; or
  - (c) something to have (or not to have) a particular effect.
- (3) Regulations made for the purposes of subsection (1):
- (a) may be inconsistent with this Act; and
  - (b) prevail over this Act (including any other regulations or other instruments made under this Act), to the extent of any inconsistency.

<sup>132</sup> The Tobacco Plain Packaging Act 2011, Section 31 (1)

the physical elements of the offence and will be punished with a penalty which will be 2000 units (currently \$ 2,20,000) for individuals and 10,000 penalty units (\$1.1 million) for corporate bodies. <sup>133</sup>	physical elements of the offence and for this a penalty will of 60 units (\$6600) for individuals and 300 penalty units (\$3,3000) for corporate bodies will be charged. <sup>134</sup>	for individuals and 10,000 penalty units (\$1.1 million) for corporate bodies. <sup>135</sup>
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#### 4.4 EFFECT OF TOBACCO PLAIN PACKAGING MEASURE ON SMOKING PREVALENCE

It is perhaps not surprising that Australia, long an international leader in tobacco control, is the first jurisdiction in the world to implement plain packaging.<sup>136</sup> Since mid-1970s Australian government have been constantly monitoring smoking and has launched many campaigns and programmes to make its people aware of its harmful effects. It is one of the first nation who drew attention of the world to treat consumption of tobacco as a massive health issue which it felt was one of the primary matter of concern in context of protecting human health. Thus, Australian State Government were the first jurisdictions in the world to run well-funded sustained mass media led public education campaigns which resulted in increased awareness of the health effects of smoking and quite dramatic declines in tobacco use.<sup>137</sup>

Australia, with the implementation of plain packaging, has proved that it is a logical next step in this decades long process of regulating tobacco and the tobacco industry and that it will surely help in eliminating the last possible frontiers the tobacco industries were equipped with for advertising and promoting their product.<sup>138</sup>

In order to evaluate the impact of tobacco plain packaging measure on public health, industry and the government it is essential to first evaluate whether the legislation is able to effectively address the objects it imbibes i.e. making the health warnings more effective, diminish the ability of tobacco packs to mislead consumers, reducing the appeal of tobacco packs. The objectives are

<sup>133</sup>The Tobacco Plain Packaging Act 2011, Section 31 (2)

<sup>134</sup>The Tobacco Plain Packaging Act 2011, Section 31 (3)

<sup>135</sup>The Tobacco Plain Packaging Act 2011, Section 31 (4)

<sup>136</sup>Simon Chapman, Public Health Advocacy and Tobacco Control: Making Smoking History (Blackwell,2007)

<sup>137</sup>J Pierce, A Macaskill and D Hill, Long Term Effectiveness of Mass media Led Anti-Smoking Campaigns in Australia, (1990) 80 American Journal of Public Health 565

<sup>138</sup>Minister for Health and Ageing *Explanatory Memoranda to The Plain Packaging Bill, 2011* <<https://www.legislation.gov.au/Details/C2011B00128/Explanatory%20Memorandum/Text>> accessed 14 June 2019

the “early-indicators” to assess the feasibility and success of any legislation and the factors stated above are also bound to perform the same function.

Since the implementation of the legislation for plain tobacco packaging in Australia, a number of studies have been conducted already to analyse the impact of the legislation by focusing on success rate of the policy and assessing the behavioural changes of smokers.<sup>139</sup> Some of the observations from those studies are as follows:

- In one of the surveys the researchers aimed at investigating the impact of tobacco plain packaging legislation on the appeal of tobacco products and asked the existing smokers to rate the extent to which they liked the new plain tobacco packs and were also asked to rate the quality of the tobacco products, the level of satisfaction felt on consuming and on looking at the packet and to rate if according to them brand played any role in the quality, taste and prestige of the product.<sup>140</sup> It was concluded in the study that it was because of the plain standardised packs, there had been a significant reduction in the appeal of a tobacco product. Even the adolescents had felt a major reduction in appeal of a tobacco product after the implementation of plain packaging legislation.
- In the same study as discussed above, it was also concluded therein with respect to impact of the graphical health warning that it was more pronounced and clear. In fact, after a year of implementation there had been constant demands by the smokers requesting to change the health warnings graphics as they had to conceal their packs because of those blatant images depicting the harmful effects of tobacco.
- Further, it was also revealed during the experimentation that there was an increase in the number of smokers who believed that brands of tobacco products did not play any role in the controlling the harmful effects of tobacco, therefore the purpose behind restricting the use of marks, logos, trademarks, business names was also successfully achieved.<sup>141</sup>
- The study concluded that among the three main objectives of the legislation, the first two objectives i.e. reduction of appeal of tobacco products and enhanced effectiveness of the graphical health warning, were successfully achieved and the third objective of making people aware of the harmful effects of tobacco was partially achieved.<sup>142</sup>

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<sup>139</sup>S. Dunlop, D. Perez, A. Dessaix, and D. Currow, ‘Australia’s plain tobacco packs: Anticipated and actual responses among adolescents and young adults 2010–2013’ (2016) <<http://tobaccocontrol.bmj.com/content/early/2016/11/15/tobaccocontrol-2016-053166.abstract?papetoc>> accessed 27 May 2019

<sup>140</sup>M. Wakefield, K. Coomber, M. Zacher, S. Durkin, E. Brennan and M. Scollo, ‘Australian Adult Smokers’ Responses to Plain Packaging with Larger Graphic Health Warnings 1 Year After Implementation: Results from a National Cross-sectional Tracking Survey’ (2015) 24(2) Tobacco Control p. ii17-ii25

<sup>141</sup> Ibid

<sup>142</sup> Ibid

- One of the studies also focused on assessing the short term changes in the behaviour of the smokers in relation their attitude towards quitting it.<sup>143</sup> It was proved that packs with graphical health warnings resulted in smokers avoiding the packs and resisting from smoking making attempts to quit.<sup>144</sup>

To conclude, the studies which are being conducting in Australia in pursuance of plain packaging measure substantially corroborate that the legislation is helping to a great extent in bringing a positive impact on people vis-à-vis their smoking behaviours and it is slowly successfully heading towards achieving the objects enshrined in the Act.

#### **4.5 TOBACCO INDUSTRY’S RESPONSE TO THE TOBACCO PLAIN PACKAGING ACT, 2011**

The tobacco industry’s response to the tobacco plain packaging regulation had been very aggressive and was well funded by the big tobacco companies<sup>145</sup>, thereby bringing in a range of legal actions against the legislation at local as well as international levels.

- ***J.T. International SA v. Commonwealth of Australia & British American Tobacco Australasia Limited v. The Commonwealth***<sup>146</sup>

The legal fights began in April 2012 before The Hon’ble High Court of Australia where the big tobacco companies (BAT, Imperial Tobacco Australia Ltd., JT International SA, Nelle Tabak Nederland BV and Phillip Morris) unsuccessfully argued that the legislation for tobacco plain packaging leads to acquisition of property requiring compensation under Section 51(xxxi) of the Constitution of Australia.<sup>147</sup>

The main contention made by the tobacco industry before the Hon’ble court was regarding the impact it had on the use of their property, primarily Intellectual Property. It was argued before the court that the tobacco plain packaging regulation which put a restriction on the use of

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<sup>143</sup> S. Durkin, E. Brennan, K. Coomber, M. Zacher, M. Scollo and M. Wakefield, ‘Short-term changes in quitting-related cognitions and behaviours after the implementation of plain packaging with larger health warnings: Findings from a national cohort study with Australian adult smokers’ (2015) 24 Tobacco Control pp. ii26-ii32

<sup>144</sup> Ibid

<sup>145</sup> Jonathan Liberman, Michelle Scollo, Becky Freeman and Simon Chapman, *Plain Tobacco Packaging in Australia: The Historical and Social Context*’ (ElgarOnline 2012)

<sup>146</sup> *J.T. International SA v. Commonwealth of Australia & British American Tobacco Australasia Limited v. The Commonwealth* [2012] HCA 43

<sup>147</sup> Professor Tania Voon, ‘Big Tobacco v. Australia’s Plain Packaging’ (Pursuit, 11 march 2019)

<<https://pursuit.unimelb.edu.au/articles/big-tobacco-vs-australia-s-plain-packaging>> accessed 9 June 2019

trademark and logos on the packs constituted to an acquisition of their property under Section 51 (xxxix) of the Constitution of Australia<sup>148</sup>.

The Hon'ble court by 6:1 majority held that the act of parliament of putting restrictions on the use of trademarks or any other similar form of mark was valid and in no way it is leading to acquisition of property under the relevant provision of Constitution of Australia. It was held by the majority of Court that to establish acquisition of property under S. 51 (xxxix) the acquisition must involve some kind of proprietary benefit or interest earned by the person who has acquired the property, but, in the present matter, the situation is completely different, even though the act restricts and regulates the use of Intellectual property specifically Trade Marks, the act does not confers any kind of proprietary benefit or interest on the government of Australia or any other person in this regard. Therefore, a case under S 51 (xxxix) cannot be established in the matter at hand.

To put it simply, under S. 51 (xxxix) of the Constitution of Australia, *"for establishing acquisition of property requiring just terms, it is necessary that the commonwealth must have earned benefits or held any interest in the property acquired"*. But, in the present matter, it is very clear that through the restrictions imposed by the Act, the commonwealth is neither acquiring any property nor it is acquiring any kind of benefit out of the restricted property.

In furtherance, to the arguments raised by the tobacco industry relating to the violation of their proprietary rights as the act was controlling their right to use the pack space, it was observed the Hon'ble Court, that the act does not imposes any different condition or requirement, like any other legislation which is made in interest of the public, it also requires warning labels to be printed on packs expressing the heinous nature of the product or telling the reader what steps to initiate in case there is mishandling or misuse of a product.<sup>149</sup> If the legislation requires imposition of warning labels on the packs and even if the warnings are as substantial as those required by the tobacco plain packaging legislation then also it does not results in acquisition of property.<sup>150</sup>

Moreover, since 1996 the world is witnessing that governments of many jurisdictions have been seizing some parts of intellectual property owned by tobacco companies. A very significant instance in this context is USA, which is the first nation of the world to put a health warning on

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<sup>148</sup> Constitution of Australia, Section 51(xxxix), 'Legislative powers of the Parliament - the acquisition of property on just terms from any State or person for any purpose in respect of which the Parliament has power to make laws;'

<sup>149</sup>J.T. *International SA v. Commonwealth of Australia & British American Tobacco Australasia Limited v. The Commonwealth* [2012] HCA 43

<sup>150</sup>Ibid

cigarette packs, same was then followed by many other nations. Gradually, there has been a significant shift and the warnings on the packs became more exhaustive “*embracing language like addiction, cause and kill that saw protracted national and global lobbying against every new step that was taken.*” All of these dynamic changes have been constantly legally challenged by the tobacco companies, but, it has never happened that any tobacco company had received any compensation in this regard. Therefore, the demand of \$3 billion of compensation by the tobacco companies for the restriction imposed stood no chance here as well.

Furthermore, in response to the tobacco advocates pleading against the extinguishment of their basic right of promoting and advertising their product through their trade mark and brand imagery, it was observed by one of the judges that in the ongoing debate the extinction or reduction of rights is not a matter of concern as neither the government or any other person is not acquiring any property as a consequence of the legislation nor is the legislation authorising anyone even the government to use the trademarks.<sup>151</sup> Thus, the contention that restriction on the use of property constitutes acquisition of property does not stand valid as was also held by the High Court in 2009, in that case it was decided that the government had the right to extinguish rights.<sup>152</sup>

In the light of all that is stated above, by consolidating the two cases, the Hon’ble High Court of Australia, upheld the constitutionality of The Tobacco Plain packaging Act, 2011 by a majority of 6:1.

- ***Australia - Tobacco Plain Packaging [Australia] [June 28, 2018]***

The HC of Australia had upheld the constitutionality of The Tobacco Plain Packaging Act and in response to that the tobacco industry challenged the legislation before WTO. Since the tobacco industry had no direct standing of bringing claims before WTO, therefore, they supported and assisted the WTO members to challenge the validity of the plain packaging legislation. As a result, five jurisdictions, namely, Cuba, Indonesia, Honduras, Ukraine and Dominican Republic had initiated a complaint before the WTO’s Dispute settlement body on the ground that the tobacco plain packaging Act is in violation of the provisions of TRIPS Agreement and some provisions of the Agreement on Technical Barriers to Trade and General Agreement on Tariffs and Trade 1994.<sup>153</sup> To investigate into the matter WTO constituted a single panel in 2014.

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<sup>151</sup> Davison M., “Plain packaging bill to extinguish some tobacco trademarks” (ABC The Drum, 15 Apr 2011) <<http://www.abc.net.au/unleashed/56666.html>> accessed 11 June 2019

<sup>152</sup> Ibid

<sup>153</sup> **FB Rice**, *WTO panel decision: Australia’s tobacco plain packaging legislation not in violation of TRIPS*, (LexisNexis’ Australian Intellectual Property Law Bulletin Vol 31 No 9)



The main contention of the tobacco advocates was that The Tobacco Plain Packaging Act, 2011 was inconsistent with the Trade mark provisions of the TRIPS agreement as it restricts them from using the rights of registration and their right to use a trade mark. On this, the panel observed that none of the provisions of tobacco plain packaging were inconsistent with the TRIPS Agreement or the Agreement on Technical Barriers to Trade, (TBT Agreement).<sup>154</sup>

The strongest claim by the complainants' was that the tobacco plain packaging was against Article 20 of the TRIPS Agreement which was also the primary focus of the panel's report. With the purpose of finding the answer to whether the plain packaging legislation violates Article 20, the Panel dealt with the following questions, which have already been discussed in Chapter 2 of this dissertation:

1. Whether the special requirements enshrined under the tobacco plain packaging legislation impede the use of a trademark, and if it does,
2. Whether those special requirements restrict the use of a trademark "*in the course of trade*",
3. In case the above two questions are true in nature then the next concern is to find whether the restriction and encumbrance is justifiably".<sup>155</sup>

The next questions were whether the special requirements encumber the use of a trademark 'in the course of trade' and 'unjustifiably'.<sup>156</sup> The Panel rejected Australia's arguments that 'in the course of trade' means buying or selling only up to the point of sale and that the relevant use of the trademark is solely for the purpose of distinguishing the goods of one undertaking from those of others.<sup>157</sup> Therefore, the Panel found that Australia's measures amount to special requirements that encumber the use of a trademark in the course of trade.<sup>158</sup>

The panel further stated that the plain packaging measures allow the tobacco manufacturers to use word trade marks on their products, thus the restrictions it imposes are already partially mitigated with the right to use word mark on the product. Needless to say, restriction on the use

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<sup>154</sup> William New, 'Australian Tobacco Plain Packaging Upheld in Decision at WTO' (2018) <<https://www.ip-watch.org/2018/06/28/australian-plain-packaging-upheld-decision-wto/>> accessed 1 June 2019

<sup>155</sup> Reports Of The Panel, *Australia – Certain Measures Concerning Trademarks, Geographical Indications And Other Plain Packaging Requirements Applicable To Tobacco Products And Packaging* (WT/DS435/R)

<sup>156</sup> Tania Voon, 'WTO Panel On Australia's Tobacco Plain Packaging: A Fact Dependent Analysis of TRIPS Article20' (2018) <<https://www.ip-watch.org/2018/07/03/wto-panel-australias-tobacco-plain-packaging-fact-dependent-analysis-trips-art-20/>> accessed 1 June 2019

<sup>157</sup> Reports Of The Panel, *Australia – Certain Measures Concerning Trademarks, Geographical Indications And Other Plain Packaging Requirements Applicable To Tobacco Products And Packaging* (WT/DS435/R) para 7.2264 and para 7.2286

<sup>158</sup> Reports Of The Panel, *Australia – Certain Measures Concerning Trademarks, Geographical Indications And Other Plain Packaging Requirements Applicable To Tobacco Products And Packaging* (WT/DS435/R) para 7.2292

of trade mark is one of the basic requirements to be mandatorily followed, without which it will be very difficult to achieve the objectives manifested under the tobacco plain packaging.

Therefore, Australia's argument that the plain packaging measures were introduced to support its comprehensive realm of tobacco control measures (which included restriction on advertisement and promotion of tobacco, higher taxes on tobacco products, pictorial-graphical health warnings and programmes and campaigns for raising public awareness) was strongly supported by the WTO panel.<sup>159</sup> Therefore the panel held that Australia while adopting their plain packaging policy and imposing some special restrictions on use of trademark through that policy was acting within the latitudinal extent of Article 20 of TRIPS Agreement.<sup>160</sup>

To conclude, the panel's decision will provide assistance to the jurisdictions in deciding their policies while addressing this issue of protecting public health by restricting trade mark rights of tobacco manufacturers. The test of validity of legislation depends on the extent of encumbered facts and circumstance of each case and the jurisdiction where the policy is being implemented and the kind of encumbrance it is imposing.<sup>161</sup>

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<sup>159</sup> Ibid

<sup>160</sup> Reports Of The Panel, *Australia – Certain Measures Concerning Trademarks, Geographical Indications And Other Plain Packaging Requirements Applicable To Tobacco Products And Packaging* (WT/DS435/R) para 7.2604

<sup>161</sup> [FB Rice](#), 'WTO panel decision: Australia's tobacco plain packaging legislation not in violation of TRIPS', (LexisNexis' Australian Intellectual Property Law Bulletin Vol 31 No 9)

## CHAPTER 5 – LEGALITY OF PLAIN PACKAGING SCHEMES IN INDIA WITH REFERENCE TO TRADEMARK LAW

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### 5.1 BACKGROUND

India is leading producer of tobacco in the world, providing livelihood to over 6 million farmers and over 20 million industry workers and contributes over 70 billion rupees to government earnings<sup>162</sup>. However, underpinned sad truth is that the cost of health is being sacrificed and has far outweighed the economic benefits, thereby attracting more and more people towards the industry. In 2004, in an estimated population of 1065 million, it was found that approximately 2500 Indians die every day from diseases associated with tobacco use and it is also predicted that by 2020 tobacco will account for 13% of all deaths in India.

In light of the facts stated above, it is high time that India should also adopt a “*more holistic and coercive approach*” to combat with the growing problems arising from the use of tobacco. Unlike Australia, USA and UK, India has not played a very significant role in dealing with the problems arising out of consumption of tobacco. Although the first ever legislation relating to tobacco products dates back to the recent past, needless to say, since then the policies relating to the subject matter in question have undergone radical and progressive changes.

India signed the WHO FCTC on September 10, 2003 and ratified it on February 5, 2004, as a result it enacted its first national tobacco control legislation in 2003, namely, *Cigarettes and Other Tobacco Products (Prohibition of Advertisement and Regulation of Trade and Commerce, Production, Supply and Distribution) Act, 2003 (COTPA)*. Remarkably, much before the legislation was enacted, the Indian courts have been reminding the states of their constitutional duty to ensure, protect and enhance the health of public and as a result to initiate strict measures controlling tobacco epidemic.<sup>163</sup> Needless to say, India was the amongst the forerunners who ratified the WHO FCTC. In the eleventh Five Year Plan (2007-2012) also, a separate room was reserved for publicity and awareness campaigns spreading the awareness for harmful effects of tobacco.<sup>164</sup> Moreover, the reports by media and other related agencies, based on GATS 2009-10, provided

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<sup>162</sup>Ravi Mehrotra, ‘Tobacco control legislation in India: Past and present’ (2010) *Suppl 1(Suppl. 1):75-80*

<sup>163</sup>*Ramakrishna and Anr. v. State of Kerala and Ors.*, AIR 1999 Kerala 385

<sup>164</sup>Planning Commission Government of India, Eleventh Five Year Plan (2007-2012) Social Sector (ISBN-10: 0-19-569650-6) para 3.1.25

corroborative evidences supporting the effectiveness of pictorial health warnings which even induced people to *Quit Smoking*.<sup>165</sup>

## 5.2 COTPA, 2003 AND THE MOVE TO PICTORIAL HEALTH WARNINGS ON TOBACCO PACKS

The enforcement of COTPA has been one of the most remarkable achievements of India to give effect to its obligations under the WHO FCTC. The gradual shift from text health warnings to graphical and pictorial health warnings on the tobacco packs is an outcome of COTPA. It has not only enhanced the existing warnings on the packs but also has integrated the textual and pictorial health warning which has made the enforcement of legislation all the more fruitful. The legislation can be treated as one of the most important and dynamic changes ever made in the arena of public health. One of the leading roles in this context was played by judiciary who time and again through their judgments have focused on the need to control and regulate the tobacco epidemic.

COTPA received assent of the President on May 18<sup>th</sup>, 2003 and was entered into force on December 1, 2007. The key highlights of the Act are as follows:-

- The main object of the Act is to prohibit the advertisement of, and to provide for “*the regulation of trade and commerce in, and production, supply and distribution of, cigarettes and other tobacco products.*”<sup>166</sup>
- Section 4 of the Act strictly prohibits “*smoking in any public place and also states that in a hotel having thirty rooms or a restaurant having a seating capacity of thirty persons or more and even in airports, there should be established separate smoking areas or spaces.*”<sup>167</sup> Furthermore, the act also provides that whoever contravenes the provisions of section 4 shall be punishable with fine which may extend to two hundred rupees.<sup>168</sup>
- Section 5 is another significant provision of the act which states that no person engaged in, or purported to be engaged in the production, supply or distribution of cigarettes or any other tobacco products shall advertise and no person having control over a medium shall cause to be advertised cigarettes or any other tobacco products through that medium and no person shall take part in any advertisement which directly or indirectly suggests or promotes the use or consumption of cigarettes or any other tobacco products.<sup>169</sup>

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<sup>165</sup>Ravi Mehrotra, ‘Tobacco control legislation in India: Past and present’ (2010) Suppl 1(Suppl. 1):75-80.

<sup>166</sup> COTPA 2003, Preamble

<sup>167</sup> COTPA 2003, s 4

<sup>168</sup> COTPA 2003, s (1)

<sup>169</sup> COTPA2003, s 5 (1)

- It has also been stated that no one shall for the sake of any direct or indirect monetary benefit:
  - (a) Display or authorise to display any form of advertisement promoting cigarettes or any other tobacco product; or
  - (b) Sell or authorise to sell a film or video tape containing advertisement of cigarettes or any other tobacco product; or
  - (c) Erect, exhibit, fix or retain upon or over any land, building, wall, hoarding, frame, post or structure or upon or in any vehicle or shall display in any manner whatsoever in any place any advertisement of cigarettes or any other tobacco product.<sup>170</sup>
  - (d) The act also imposes a stern prohibition on sale of a tobacco product to a person under eighteen years of age and prohibits sale of a tobacco product within a radius of one hundred yards of any educational institution.<sup>171</sup>
  - (e) Section 8 of the act deals with the manner in which specified warning on a package of cigarettes or any other tobacco products shall be made and it requires that the warnings should be:
    - (a) legible and prominent;
    - (b) conspicuous as to size and colour;
    - (c) in such style or type of lettering as to be boldly and clearly presented in distinct contrast to any other type, lettering or graphic material used on the package or its label and shall be printed, painted or inscribed on the package in a colour which contrasts conspicuously with the background of the package or its labels.<sup>172</sup>
- In furtherance, the Act requires that every package containing cigarettes or any other tobacco products shall be so packed as to ensure that the specified warning appearing thereon, or on its label, is, before the package is opened, visible to the consumer.<sup>173</sup>
- Another significant feature of COTPA is that it requires the language of the health warning should be the language of the place where the product is being sold and provides for all Indian languages as well as English. It also states that the health warning should also be specified in both English as well as the regional Indian language.<sup>174</sup>

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<sup>170</sup> COTPA2003, s 5 (2)

<sup>171</sup> COTPA 2003, s 6

<sup>172</sup> COTPA2003, s 8 (1)

<sup>173</sup> COTPA 2003, s 8 (3)

<sup>174</sup> COTPA 2003, s 9

- Also, any package of cigarettes or any other tobacco products or any advertisement material of cigarettes or any other tobacco products, in respect of which any provision of this Act has been or is being contravened, shall be liable to be confiscated.<sup>175</sup>
- Any person who produces or manufactures cigarettes or tobacco products, which do not contain, either on the package or on their label, the specified warning and the nicotine and tar contents, shall in the case of first conviction be punishable with *imprisonment for a term which may extend to two years, or with fine which may extend to five thousand rupees, or with both*, and for the second or subsequent conviction, with imprisonment for a term which may extend to five years and with fine which may extend to ten thousand rupees.<sup>176</sup> Also, Any person who sells or distributes cigarettes or tobacco products which do not contain either on the package or on their label, the specified warning and the nicotine and tar contents shall in the case of first conviction be punishable with *imprisonment for a term, which may extend to one year, or with fine which may extend to one thousand rupees, or with both*, and, for the second or subsequent conviction, with imprisonment for a term which may extend to two years and with fine which may extend to three thousand rupees.<sup>177</sup>
- In addition the Act also provides for punishment for advertisement of cigarettes and tobacco products and states that whoever advertises or authorise to advertise any tobacco product shall be imprisoned for a term which may extend to two years or with fine which may extend to one thousand rupees or with both for first conviction and in the case of second or subsequent conviction with imprisonment for a term which may extend to five years and with fine which may extend to five thousand rupees.<sup>178</sup>

Like it has been the nature of tobacco industries worldwide in India also there were numerous legal challenges made which questioned the constitutional validity of Section 7 of COTPA, 2003. As a result, the enforcement of the Act had been delayed, but, the PIL filed before the High Court of Himachal Pradesh brought the government into action. Thereafter, the government notified the rules supporting the enforcement of Section 7 of COTPA, 2003.

With the consideration of regulating tobacco epidemic in April 2016, the Government of India increased the size of pictorial health warning on the packaging of tobacco product to 85% both front and back. The percentage of users in India who thought of quitting because of such warning labels increased sharply to 62% (cigarette), 54% (bidi) and 46% (smokeless tobacco

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<sup>175</sup> COTPA2003, s 14

<sup>176</sup> COTPA2003, s 20 (1)

<sup>177</sup> COTPA 2003, s 20 (2)

<sup>178</sup> COTPA 2003, s 22

users), according to the Global Adult Tobacco Survey 2016-2017, when compared with the survey results of 2009-2010.<sup>179</sup> The corresponding figures for 2009-2010 were 38% and 29% for cigarette and bidi smokers respectively and 34% for smokeless tobacco users.<sup>180</sup> Thus, it can be concluded that by imposing higher taxes along with larger, more clear and blatant pictorial health warnings plain packaging can help in curbing the problems associated with the consumption of tobacco to a great extent.

### 5.3 THE NEED FOR PLAIN PACKAGING IN INDIA

Allahabad High Court, for the first time addressed the concern for implementing plain packaging in India, it was in this case that the court directed the centre as well as the state governments to make arrangements for implementing the policy of plain packaging and stated that, “*tobacco plain packaging measure would be a long-term investment to safeguard the health of the Indian youth.*”<sup>181</sup> It was by this time that the Australia-India Taskforce on Tobacco Control, in its reported, had already highlighted the interest and support of the public for introducing a legislation for plain packaging in India as a policy intervention in India and also strongly recommended that India can implement plain packaging by amending some provisions of COTPA, 2003.<sup>182</sup>

As a result of the recommendation made by the Court and the report of Taskforce, a private member bill was proposed in the Parliament of India, recommending that Section 3, 5 and 7 of COTPA, 2003 should be amended. It was proposed that the size of pictorial health warnings should be increased and a strict prohibition should be imposed on the advertisement and promotion of tobacco products. Thus, in this context, Section 3 of the bill proposed to include Section 7A to COTPA, 2003 which would deal with the requirements that need to be followed for every package of cigarette or any other tobacco product. It states that:

- (a) Unless otherwise provided under the COTPA, 2003 no business name, brand name, trademark or any other similar mark should be printed anywhere on the package;
- (b) In situations where the business name, trademark, brand name etc need to be printed on the package, the following conditions should be strictly adhered to:
  - i. The mark or name shall be printed on the outer surface of the package and shall not appear more than once,
  - ii. It should not cover more than one line,

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<sup>179</sup>International Institute for Population Sciences (IIPS) Mumbai and Ministry of Health and Family Welfare Government of India. *Global Adult Tobacco Survey India (GATS INDIA)*, 2009-2010.

<sup>180</sup> Ibid

<sup>181</sup>*Love Care Foundation v. Union of India and Others*, (2013) Writ Petition No.1078 (M/B) of 2013

<sup>182</sup>Arora M, Tewari A, Grills N, et al., ‘Exploring perception of Indians about plain packaging of tobacco products: A mixed method research. (2013) *Front Public Health*1, 35

- iii. The style and size of font shall be according to the rules prescribed by the COTPA, 2003 and the mark shall appear parallel to the and below the health warning,
- (c) The colour and texture of the outer and inner surface of the package should also be in accordance with the conditions as specified in the act;
- (d) Any kind of *embossing, ridges or any irregularities of shape or size, or any other embellishments* should not appear on the outer and inner surfaces of the tobacco product package;
- (e) It should also be ensured that the tobacco package shall be devoid of following characteristics:
  - i. *it shall not reveal any text or picture when scratched;*
  - ii. *it shall not be made of such ink that appears or changes colour with passage of time;*
  - iii. *it shall not be made of such ink that appear visible in certain light;*
  - iv. *it shall not have any removable or folding tabs.*<sup>183</sup>

With the consistent increase in the rate of consumption of tobacco regulation of tobacco has become a need of the hour. Henceforth, after Australia's victory in WTO plain packaging legislation is being considered as one of the most dynamic step to deal with the issue of tobacco consumption. The after effects of implementation of the legislation have proved its viability and it is now one of the most successful tobacco control policy accepted worldwide. Therefore, amending COTPA, 2003 and including plain packaging making it in consonance with the Trademark Act, 1999, it would take us very close to the idea of centrally regulating tobacco products. In these right set of circumstances, it is a good time for government to start by establishing a technical infrastructure, for instance, by developing a website or an online portan for people which will report, track and trace and monitor any case of infringement or violation of the Act.<sup>184</sup>

#### 5.4 OPERATIONAL ASPECTS OF PLAIN PACKAGING IN INDIA

As reported and observed by the Australian-Indian taskforce, a policy for plain packaging should be designed a way that it is in perfect harmony with the international laws especially laws affecting Trademark Law- The Paris Convention and the TRIPS Agreement, the domestic legislations and the socio-economic status of the nation.<sup>185</sup> Implementation of plain packaging will affect a number of other legal areas as well, like The Constitution of India, 1950, The

<sup>183</sup> Panda B, 'The cigarettes and other tobacco products (prohibition of advertisement and regulation of trade and commerce, production, supply and distribution) amendment bill' (2014) <<http://164.100.47.4/BillsTexts/LSBillTexts/Asintroduced/1432LS.pdf>> accessed 15 June 2019

<sup>184</sup> Report of the Australia-India Institute Taskforce on Tobacco Control, *Plain packaging of Tobacco Products* (2012), <<https://www.aii.unimelb.edu.au/wp-content/uploads/2019/01/Task-force-Tobacco-Control.pdf>> accessed 19 May 2019

<sup>185</sup> Ibid



Trademark Act, 1999, The Consumer Protection Act, 1986 etc., the policy needs to be drafted in way that all these issues are also addressed.<sup>186</sup> There are multifarious challenges and changes are required to be made for the sake of introducing plain packaging in India.

The very first step in this direction can be tracing the provisions of the laws that are being affected and need to be amended.<sup>187</sup> In this respect, the most feasible option to introduce plain packaging in India is to make an amendment in COTPA, 2003. India is an independent, sovereign nation and therefore, has a room for manoeuvre much beyond what is required by the minimum standards of WHO FCTC. To bring a change a lot of consultation and a complex procedure is to be followed thus also involving a lot of complexities.

- **MAIN CHALLENGES TO PLAIN PACKAGING IN INDIA**

### **1. OBSTRUCTION BY THE TOBACCO INDUSTRY**

As is evident from Australia, UK and other countries who have either implemented or are planning to implement a legislation for plain packaging have witnessed the biggest impediments by the tobacco industry, who are constantly intimidating the governments by calling for legal challenges against the legislation at domestic and international levels.

In India, the COTPA Rules, 2008 came into force on May 31, 2009 with a statutory requirement to display health warnings which would take at least 40% of the principal display area on the cigarette package.<sup>188</sup> Thereafter, the rules were amended in 2014, which was notified on October 15, 2014 and came into force on April 1, 2015, provided that the health warning should cover at least 85% of the principal display area of the package of which 60% shall cover pictorial health warning and 25% shall cover textual health warning.<sup>189</sup>

As soon as the amendment came into effect, it was challenged before the Karnataka High Court, who quashed the said rule with a reason that the amendment lacked empirical data.<sup>190</sup> Following this, a SLP was filed before the Hon'ble SC of India against the order of the Karnataka HC. The Apex Court while quashing the order of the HC said that, "...[t]hough a very structural submission has been advanced by the learned counsel for the respondent that it will affect their business, the Court remained unimpressed by the said "health of a citizen has a primacy and he or she should be aware of that which can affect

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<sup>186</sup> Ibid

<sup>187</sup> Ibid

<sup>188</sup> COTPA Rules 2008, Rule 3 (1) (b)

<sup>189</sup> COTPA Amendment Rules 2014, Rule 3 (1) (b)

<sup>190</sup> *Karnataka Beedi Industry Association et al. v. Union of India*, (2015) Writ Petition Nos. 53876-53877 / 2015, High Court of Karnataka (2015).

or deteriorate the condition of health.” The court went on to say that deterioration may be a milder word and therefore, in all possibility the expression destruction of health is apposite.”<sup>191</sup>

In India also with the implementation of plain packaging a number of legal challenges can be surely anticipated by the tobacco industry to delay or stop the legislation from being enforced. The tobacco industry will circumscribe their proprietary rights over the space of the packaging, the use of their trademark that is being effected and restricted, and also over the problem of counterfeiting product as because of lack of brand imagery it will be very challenging for the consumers/retailers to differentiate and identify the original product.<sup>192</sup> Moreover, due to cultural and regional differences, language variations the problems associated with the sale of tobacco inter-state is a matter of concern, therefore, a huge number of experts, stakeholders (including retailers involved in tobacco business, the people associated with health care, Judiciary, academicians, Lawyers, Policy makers, agriculturalists, people from commerce and trade, Health Ministers, victims & families of victims of tobacco epidemic, etc.) in the tobacco industry are required to deal with these barriers.<sup>193</sup>

## 2. OVERLAPPING LAWS IDENTIFIED AS A BARRIER AND CLAIMED BY TOBACCO INDUSTRY

AFFECTED LAW	CLAIM	COUNTER ARGUMENT
Article 19 (1) (g) of The Constitution of India, 1950	It guarantees that “every citizen have the right to practise any profession, or to carry on any occupation, trade or business” but plain packaging will infringe freedom of trade of tobacco dealers	Article 19 (6) states that “reasonable restrictions on trade can be imposed in the interest of general public and may restrict any trade and activity even to the exclusion of all impose a total prohibition on such trade”. Therefore, plain packaging is also no more than a “reasonable restriction in the interest of general public and therefore complete prohibition on

<sup>191</sup>Health for Millions Trust v. Union of India, (2017) SLP (C) (37348/2017)

<sup>192</sup>Report of the Australia-India Institute Taskforce on Tobacco Control, Plain packaging of Tobacco Products (2012), <<https://www.aii.unimelb.edu.au/wp-content/uploads/2019/01/Task-force-Tobacco-Control.pdf>> accessed 19 May 2019

<sup>193</sup> Ibid

		<i>the trade of tobacco is possible.”</i>
<b>Article 21 of The Constitution of India, 1950</b>	Article 21 deals with <i>“protection of life and personal liberty and states that no person should be deprived of his life or personal liberty”</i> . If plain packaging is implemented then it will affect the “right to livelihood” of those who are engaged in trade of tobacco.	As a matter of course there have been many surveys and studies which prove that tobacco industry exploits those who are engaged in trade specially tendu leaf collectors (mostly tribal) and bidi rollers by forcing them to live in perpetual poverty with arduous working conditions and occupational health hazards. <sup>194</sup> It can be said that all those who are involved in the trade, their occupation is the primary reason behind their poverty and ill health. It is also depriving them of a life of dignity.
<b>Article 300 (A) of The Constitution of India, 1950</b>	It states that <i>“no person shall be deprived of his property”</i> and plain packaging leads to acquisition of property as it restricts traders from using their trademarks, business names etc.	The plain packaging of tobacco products does not lead to acquisition of property. In fact, it just puts a restriction on the use of property which is reasonable, just and for the benefit of public at large.
<b>Trade Marks Act, 1999</b>	It was claimed that plain packaging would adversely affect their exclusive right to use the trademark as provided under Section 28 of	The right of trademark according to the Act, 1999 is a <i>negative right</i> which means that no one can use a trademark other than its

<sup>194</sup> Yadav A, Nazar GP, Rawal T, et al. Plain packaging of tobacco products: the logical next step for tobacco control policy in India. BMJ Glob Health 2018;3:e000873. doi:10.1136/ bmjgh-2018-000873.

	the Act, 1999. Also, restriction on the use of trademark will have a detrimental impact on the business, therefore, the legislation is discriminatory and unjustly depriving the tobacco traders of their intellectual property.	owner and it is to stop others from using the mark deceptively. Moreover the restriction being imposed is for the interest of the public, therefore the restriction is reasonable.
<b>Competition Act, 2002</b>	Plain packaging is anti-competitive as it restricts advertisement and promotion of products.	As per section 54 of the Act, the Central Government has power to exempt the application of the very Act and there is constitutional protection to take such action under Article 19(6). <sup>195</sup>
<b>Consumer Protection Act, 1986</b>	Plain packaging deprives the customers of their right to obtain information about the product they are consuming.	Essentially, the plain packaging legislation will diminish the likelihood of “Unfair Trade Practices”.
<b>Legal Metrology Act, 2009</b>	The mandatory declarations required to be made on the pre-packaged commodities will be grossly affected.	The Act, 2009 exempts bidi manufacturers through some declarations.

### 3. OTHER BARRIERS

The problem of “counterfeiting products and illicit trade” was another important issue raised by the tobacco industry. The tobacco industries, are largely labour intensive, unorganised and rich in cash.<sup>196</sup> Unlike Australia, in India the packaging of tobacco products differs in size, shapes and quantities. Therefore, only implementing plain packaging will not help, but, along with it the “the standardisation of packaging within product categories” also needs to be done. In India, most of

<sup>195</sup> Ibid

<sup>196</sup> Report of the Australia-India Institute Taskforce on Tobacco Control, *Plain packaging of Tobacco Products* (2012), <<https://www.aii.unimelb.edu.au/wp-content/uploads/2019/01/Task-force-Tobacco-Control.pdf>> accessed 15 May 2019

the cigarettes are sold loose in a way that consumers buy exactly the quantity they want. Therefore product standardisation has also become a need of the hour.

## CHAPTER 6 - CONCLUSION& SUGGESTIONS

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### 6.1 CONCLUSION

The following research has focused on identifying the arguments made by the researchers, experts and tobacco advocates to challenge and enforce the legislation for plain packaging of tobacco products. Until now most of the studies and researches made on plain packaging of tobacco products have focused on establishing a connection between what the investment treaties (between nations) guarantees and tobacco control, and the connection between tobacco control and trade, but the present research has, by analysing the success of Australia in this subject tried to establish the interaction between “public-right” and “private-property right”.

As has already been proved in Australia and on the basis of analysis made in present research it can be concluded that in India also by making the plain packs less fancy and appealing will help in encouraging the youth and the adolescents to take initiatives to quit smoking. Moreover, it has plain packaging will also make the pictorial health warning more clear and increase the visibility of the health warning. In order to amplify the effect of pictorial health warnings, an image with large, hideous and a tinted health warning with a plain background will be more influential.<sup>197</sup>

Furthermore, one of the biggest hurdles in implementation of plain packaging is the response of the tobacco industry towards it. The tobacco advocates have been consistently challenging the legislation to either delay or prevent it from being implementing on the grounds that it results in acquisition of their intellectual property, in turn, resulting in violation of their constitutional and basic human rights. One of the biggest examples is the challenge brought before the WTO by its members due to constant lobbying by the Big Tobacco companies. But, because of commitment and efforts of the Australian Government on this subject, WTO upheld the validity and constitutionality of the legislation for plain packaging and gave preference to “public right” instead of “private property right”.

Among other obstructions, the ones which are relevant to Indian scenario is that there are many different varieties of tobacco and tobacco products such as Ghutkas, Bidis, some other smokeless forms of tobacco and even some of the tobacco is also sold loose.<sup>198</sup> While drafting a legislation for plain packaging or while making an amendment in COTPA, 2003 for including

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<sup>197</sup> Report of the Australia-India Institute Taskforce on Tobacco Control, *Plain packaging of Tobacco Products* (2012), <<https://www.aii.unimelb.edu.au/wp-content/uploads/2019/01/Task-force-Tobacco-Control.pdf>> accessed 15 May 2019

<sup>198</sup> International Institute for Population Sciences (IIPS) Mumbai and Ministry of Health and Family Welfare Government of India. *Global Adult Tobacco Survey India (GATS INDLA)*, 2009-2010

plain packaging, the policy makers will have to necessarily consider these additional challenges and frame the policy in a way, that these issues are also dealt with, for instance, “by applying the plain packaging legislation on all forms of tobacco- smokeless, bidi, etc.”.

It can be concluded that plain packaging will make the regulation of tobacco a possibility in India and will also provide with the opportunity to standardize packaging of tobacco products. Through an amendment in COTPA, 2003 India has already very precisely specified the size of the health warnings on the packs of tobacco products, but the other hurdles in this context need to be addressed too.

## **6.2 SUMMATION OF CHAPTERS**

**Chapter 1** establishes the foundation of the present research as it encompasses the significance of the research, identifies the research questions and hypothesis, explains the methodology followed. It basically explains the structure of the research.

**Chapter 2** delineates the historical background and meaning of plain packaging of tobacco products. Prior to the WHO FCTC 2003, there were many restrictions on the tobacco industries, as a result, packaging of tobacco products was the only possible solution for promoting and advertising their products. Therefore, they used to spend a huge amount of money on packaging. To deal with this problem WHO introduced and enforced the FCTC which imposed restriction on the tobacco industry on the use of their trademarks, logos or business names and also provided with a mandatory health warning on the packs. The chapter while highlighting the requirements of FCTC and the efforts of different jurisdictions made in this context concludes that plain packaging of tobacco products will be one major step towards regulation of tobacco. The tobacco industries and advocates have been constantly challenging the legislation for plain packaging at domestic and international levels on the grounds that it leads to acquisition of property- their intellectual property, especially Trademarks.

**Chapter 3** establishes the legitimacy of the legislation for plain packaging by analysis Article 6 Quinquies of the Paris Convention and Article 20 of the TRIPS Agreement. It concludes that protection of health is the primary goal of every government. Keeping in mind the harmful effects of tobacco, implementation of plain packaging is very essential. It does not infringes the trademark rights of the tobacco industry as it does not leads to acquisition of their property in any sense. Instead it just restricts the use of mark for the interest of the public.

After Australia’s big win in WTO in the case brought in by WTO members challenging the validity of their plain packaging legislation, Australia is now the first country to successfully

implement The Tobacco Plain Packaging Act, 2011. Since mid-1970s, Australian government has been struggling very hard to protect its citizens from the tobacco epidemic by launching “*Quit Campaigns*”, guidelines, public awareness programmes, etc.

So, in regard to this **Chapter 4** concludes that Australia is one significant example of the success of the legislation and other jurisdictions can take inspiration from Australia to implement the same, as studies also prove that there has been a significant decline in the rate of consumption of tobacco in Australia, proving the success of plain packaging.

In addition to all that is above stated, **Chapter 5** establishes the importance and need of implementing the legislation for plain packaging in India. It analyses the existing provisions of COTPA, 2003 along with the relevant provisions of The Constitution of India, 1950; The Consumer Protection Act. 1986; The Legal Metrology Act, 2009 and the Competition Act, 2002 and states that legislation for plain packaging is perfectly in consonance with the provisions of the above stated laws. In furtherance, the chapter also focuses on the contention by the tobacco industries that the plain packaging policy is violating their trademark rights.

In this context it is stated that The Trademark Act, 1999 nowhere establishes the Right use a Trademark instead it incorporates a negative right of trademark, which means that the trademark owner has the right to stop other person from using a similar or same mark. The plain packaging legislation is not taking away the right to sue for infringement but it just imposes certain restrictions for the interest of the public.

### **6.3 RECOMMENDATIONS**

Packaging of tobacco products is one of the only probably options left with the tobacco industry to advertise and promote their product. All the studies conducted in this respect have proved that packaging plays an essential role as it establishes brand-imagery and diverts consumers from the pictorial health warnings. The primary purpose of fancy packaging is to lure new consumers, especially, the Youth, and to perpetuate the existing consumers. Consumption of tobacco has now become a national health issue. Studies and researches that are being regularly conducted in this subject show strong evidences and constant support for plain packaging and it is now being treated as an important tobacco control measure in India and other major jurisdictions. Thus, the policy makers in India should also address the issue now with the objective of fighting with the tobacco epidemic and implement such legislation.



- India should fulfil its obligation under Article 11 and 133 of WHO FCTC as it's one of the first few countries who ratified the treaty. Plain packaging can be implemented as an obligation of WHO FCTC.
- Plain packaging should be introduced as a “public issue” as its purpose is to deal with the tobacco epidemic. It should be communicated as being beneficial and instrumental for the interest of health of public. This will also help the government to avoid all the challenges being brought against it solely vested with commercial interest.
- The existing pictorial warnings should be made more clear and a stronger health warning should be selected along with the picture to impart a stronger public health message. Moreover, the health warnings should be rotated more frequently.
- Section 5 which puts a restriction on tobacco advertising, promotion and sponsorship and Section 7 which provides for the graphical health warnings on the packs of The COTPA, 2003 should be amended in order to facilitate and include plain packaging in it.
- All the loopholes in the policy should be identified and dealt with by taking consultations and help from the jurisdictions which have already implemented plain packaging (like Australia); this will also help to keep the tobacco industry away from challenging it.
- In the events where the provisions of plain packaging of tobacco industry are not in consonance with any existing law (like Trademarks) then an overriding provision in this behalf can be added in the act itself.
- The government should also provide other alternative employment opportunities to those engaged in the business of tobacco (like “tobacco farmers, “tendu leaf collectors”, etc.) to provide a better livelihood to them and their families and keep them away from the tobacco business.
- India is involved in more than 60 bilateral/multilateral investment treaties and agreements and also free trade agreements involving different kinds of investments and use of intellectual property, these agreements and treaties should also be analysed to identify the implication of these agreements on the policy for plain packaging.
- The associated ministries, like the Ministry of Health and Family Welfare, should work on collecting evidences and support for plain packaging and introduce it as an important measure to protect public health.
- Campaigns, programmes should be conducted to educate and make people aware of the harmful effects of tobacco and how plain packaging will help in curbing this problem and reduce the burden of tobacco.

India being a signatory to WHO FCTC is under an obligation to take necessary steps to deal with the tobacco epidemic. Even after COTPA, 2003 and FCTC the tobacco industry leaves no stone un-turned in promoting or advertising their product. Therefore, it is very essential for Government of India to initiate steps in this direction. Through the present research and study conducted, the researcher strongly supports plain packaging and recommends it as an effective policy complementing the tobacco control measures in India.



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