
CRITICAL ANALYSIS OF THE INTERFACE BETWEEN TRADEMARK AND GEOGRAPHICAL INDICATIONS UNDER INDIAN LAW

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ABSTRACT

The coexistence and conflict between trademarks and geographical indications (GIs) have become an important area of discussion in Indian intellectual property law. Both systems aim to protect commercial goodwill and ensure consumer trust, yet their foundational principles diverge. Trademarks are designed to safeguard distinctiveness and grant exclusive ownership to individuals or entities, whereas GIs focus on collective rights linked to a specific region, culture, or traditional practice. This divergence often results in overlaps and conflicts, particularly when identical or similar signs are claimed under both regimes.

Under Indian law, the Trade Marks Act, 1999 and the Geographical Indications of Goods (Registration and Protection) Act, 1999 provide the framework for protecting these rights. However, the practical challenges of implementation highlight gaps in harmonization. At the international level, India's obligations under the TRIPS Agreement further necessitate balancing national legislation with global standards. While trademarks play a critical role in promoting business growth and brand recognition, GIs serve as instruments for preserving cultural heritage, enhancing rural livelihoods, and safeguarding traditional knowledge from misappropriation.

This Paper focuses on the interface between the two regimes raises significant legal and policy issues, such as determining priority rights, avoiding consumer confusion, and ensuring fair competition. Despite conflicts, there are also opportunities for synergy, as both mechanisms ultimately promote innovation, quality assurance, and market integrity. Clearer guidelines, stronger enforcement, and a more coordinated approach are essential to achieve equilibrium between the two systems. Such balance will foster both economic development and cultural preservation under Indian intellectual property law.

Keywords: Trademark, Geographical Indications, Intellectual Property Rights, TRIPS Agreement and Indian Law.

RESEARCH PROBLEM

The central problem lies in the conflict and overlap between trademarks and geographical indications under Indian law. While both aim to protect goodwill and consumer trust, their underlying principles individual exclusivity in trademarks versus collective community rights in GIs clash. This creates legal uncertainty, particularly regarding priority rights, coexistence, and enforcement under the Trade Marks Act, 1999 and the Geographical Indications of Goods (Registration and Protection) Act, 1999, as well as India's compliance with the TRIPS Agreement.

HYPOTHESIS

A coordinated framework balancing individual trademark rights and collective GI rights will foster innovation, fair competition, and equitable market practices in India.

RESEARCH QUESTIONS

1. How does the Trade Marks Act, 1999 and the Geographical Indications of Goods (Registration and Protection) Act, 1999 regulate the relationship between trademarks and GIs in India?
2. What are the major areas of conflict and overlap between trademarks and GIs in Indian?
3. How have Indian courts and international frameworks (such as TRIPS) addressed disputes involving GIs and trademarks?

SCOPE OF RESEARCH AND OBJECTIVES

The scope of this research lies in examining the complex interface between trademarks and geographical indications (GIs) under Indian intellectual property law, with a focus on their conceptual divergences, overlaps, and conflicts. While trademarks are designed to protect distinctiveness and grant exclusive ownership to individuals or entities, GIs safeguard collective rights linked to geography, culture, and tradition. This study will analyze how these differing principles create legal and practical challenges, particularly when identical or similar signs are claimed under both regimes. It will also evaluate the adequacy of the Trade Marks Act, 1999 and the Geographical Indications of Goods (Registration and Protection) Act, 1999

in addressing such conflicts, drawing on judicial interpretations, case studies, and policy frameworks. Additionally, the research will situate the Indian framework within the context of international obligations under the TRIPS Agreement and explore comparative practices in other jurisdictions, especially the European Union, to identify possible reforms.

Beyond doctrinal analysis, the research will address broader policy and enforcement concerns, such as the role of GIs in promoting rural development, preserving cultural heritage, and preventing misappropriation, as well as the function of trademarks in fostering brand recognition and economic growth. The study will assess practical enforcement challenges and institutional gaps while also exploring opportunities for synergy between the two systems, emphasizing how coexistence can promote innovation, quality assurance, and market integrity. By combining legal analysis, policy evaluation, and comparative perspectives, this research aims to propose clearer guidelines, stronger enforcement strategies, and a more harmonized approach to balancing the twin objectives of economic development and cultural preservation in Indian intellectual property law.

1. To examine the statutory framework governing trademarks and geographical indications in India, particularly under the Trade Marks Act, 1999 and the Geographical Indications of Goods (Registration and Protection) Act, 1999.
2. To identify and analyze the key areas of conflict, overlap, and coexistence between trademarks and GIs in the Indian legal context.
3. To evaluate how Indian courts have interpreted and resolved disputes involving trademarks and GIs, with reference to international obligations under the TRIPS Agreement.
4. To assess the practical challenges in harmonizing trademark and GI protection, including enforcement gaps and risks of consumer confusion.
5. To propose a coordinated framework that balances individual trademark rights with collective GI rights, fostering innovation, fair competition, and cultural preservation.

RESEARCH METHODOLOGY

This paper adopts a doctrinal research methodology, relying primarily on statutory provisions

such as the Trade Marks Act, 1999, the Geographical Indications of Goods (Registration and Protection) Act, 1999, and India's obligations under the TRIPS Agreement, along with landmark judicial precedents that clarify the conflicts and overlaps between trademarks and geographical indications (GIs). These primary sources are critically analyzed to understand how courts have approached issues like priority rights, consumer confusion, and the balance between exclusivity and collective rights. To complement this, secondary sources such as scholarly articles, commentaries, and research papers are used to provide interpretative insights, highlight enforcement challenges, and suggest possible reforms. By combining legislative texts, case law, and academic perspectives, the doctrinal methodology ensures a comprehensive and authoritative legal analysis of the trademark–GI interface within Indian intellectual property law.

Existing Legal Situation

In India, trademarks and geographical indications are protected under two separate laws the Trade Marks Act, 1999 and the Geographical Indications of Goods (Registration and Protection) Act, 1999. A trademark gives exclusive rights to an individual or company to use a sign or logo to distinguish their goods or services. A geographical indication, on the other hand, protects the collective rights of producers from a particular region whose products have special qualities or reputation because of their origin, such as Darjeeling Tea.

The laws try to prevent conflicts between the two. For example, the Trade Marks Act does not allow marks that are misleading about a product's geographical origin, while the GI Act prevents GIs from being registered as trademarks. At the same time, trademarks that were registered or used in good faith before the GI law came into force are still protected. These rules are also in line with India's commitments under the TRIPS Agreement at the international level. Indian courts have dealt with several disputes in this area.

Even though the legal framework is in place, problems still exist. There are overlaps between trademarks and GIs, enforcement is often weak, and courts sometimes interpret the laws differently. This creates uncertainty about which right should come first, making it important to develop clearer rules and stronger enforcement to balance the two systems.

CHAPTER-1

INTRODUCTION

Intellectual Property Rights (IPRs) play a pivotal role in promoting innovation, creativity, and economic development in the modern knowledge-driven economy. Among the various forms of IPRs, trademarks and geographical indications (GIs) serve as crucial tools for protecting commercial identity and ensuring consumer trust. However, while both systems share a common objective of preventing consumer deception and promoting product quality, they are grounded in fundamentally divergent legal philosophies. Trademarks primarily protect the distinctiveness of goods or services by granting exclusive ownership to individuals or enterprises, whereas GIs safeguard collective rights linked to specific geographical origins, traditions, and cultural heritage of a community or region.¹

The coexistence of these two regimes often leads to legal complexities and conflicts, particularly in cases where similar or identical signs are claimed under both systems. This overlap raises significant issues of priority, coexistence, and enforcement, especially when determining whether a registered trademark infringes upon or dilutes a registered GI, or vice versa.² In India, these challenges are addressed through two major legislations — the *Trade Marks Act, 1999* and the *Geographical Indications of Goods (Registration and Protection) Act, 1999* — both enacted in alignment with the *Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)* under the World Trade Organization (WTO) framework.³

At the international level, the TRIPS Agreement under Articles 22–24 mandates member nations to provide legal means to protect GIs against misleading use and unfair competition. Nonetheless, the implementation varies across jurisdictions, with the European Union (EU) adopting a *sui generis* approach emphasizing strong GI protection, while India maintains a dual

¹ P. Narayanan, *Intellectual Property Law* (Eastern Law House, Kolkata, 2017).

² Dev S. Gangjee, *Relocating the Law of Geographical Indications* (Cambridge University Press, 2012).

³ Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), Marrakesh Agreement Establishing the World Trade Organization, 1994.

framework through separate statutes.⁴ This divergence has also influenced India's policy-making, particularly concerning agricultural and handicraft-based GIs, which play a significant role in rural livelihoods and export promotion.⁵

Furthermore, the rapid globalization of markets and the increasing commercialization of traditional products have intensified the urgency for a harmonized approach. In India, GIs such as *Basmati Rice*, *Kanchipuram Silk*, and *Darjeeling Tea* face continuous challenges from both domestic misuse and international misappropriation. Simultaneously, brand owners seek to secure exclusive trademarks to expand their market presence. Thus, reconciling the two systems becomes essential for ensuring fair competition, consumer protection, and sustainable economic development.⁶

TRADEMARKS (TM)

William Kingston once said, "The world of brands and marketing heavily relies on the laws that establish TM registration. Every modern brand thrives on the ease of enforcing the legally granted monopoly of a registered trademark. This monopoly justifies investments in advertising and other marketing techniques to build brand equity, which is often a firm's most valuable asset." ⁵ A TM is defined as a mark that can be represented graphically and is capable of distinguishing the goods or services of one person from those of others.⁷ This may include the shape of goods, their packaging, and combinations of colors. The international recognition largely derived from the Trade-Related Aspects of trademarks is of Intellectual Property Rights (TRIPS) agreement.⁸ Trademarks are crucial for advertising products and communicating their characteristics to potential customers. They signify the origin and quality of a product. In the case of *Ram Dev Food Products Pvt. Ltd. v. Arvindbhai Rambhai Patel*, it was held that "the purpose of a TM is to establish a connection between the goods and their source, suggesting the quality of the goods."⁹ The primary function of a TM is denotative. For example, when a customer sees the Mercedes TM, they identify the car as one produced by the

⁴ S. Wagle, "Comparative Analysis of GI Protection in India and the EU," *Indian Journal of Law and Technology* Vol. 16, pp. 67–89 (2020).

⁵ K. Das, "Socio-Economic Implications of Protecting Geographical Indications in India," *Centre for WTO Studies*, Indian Institute of Foreign Trade (2008).

⁶ R. Kumar & N. Pandey, "Trademark and GI Interface: The Indian Experience," *NALSAR Law Review* Vol. 17(2), pp. 145–168 (2021).

⁷ <http://chartered-aaccountant-finance.blogspot.com/>

⁸ <http://www.bbau.ac.in/>

⁹ *Ramdev Food Prods. (P) Ltd. v. Arvindbhai Rambhai Patel*, 8 SCC 726 (India 2006).

Mercedes-Benz company, a division of the German corporation Daimler AG, even without detailed knowledge of the company's structure. TMs distinguish and attribute uniqueness to goods or services. Many countries now also allow the registration of non-conventional trademarks, such as smell marks, color marks, and shape marks. However, generic marks, like "Champagne," cannot be protected, which is a significant issue in international law regarding geographical indications. Descriptive and suggestive marks can be protected if they acquire a secondary meaning. Even protected descriptive marks can be used by competitors under fair use to describe their products. Suggestive and fanciful marks are entitled to protection without proof of secondary meaning, with fanciful marks receiving the most extensive protection under TM law.

GEOGRAPHICAL INDICATIONS (GI)

The place has its own name and fame. A GI, safeguarded under the new Act, GI Act of 1999, it is not a collective mark or a certification mark but is considered public property, clearly distinct from these concepts. A GI designates specific goods and commodities originating from a certain area or locality, known for their reputation or quality significantly attributed to their geographical origin, which includes natural and human factors. For instance, Darjeeling Tea, which has earned a high reputation, can only be used by tea growers in the Darjeeling region.¹⁰ The application for registering a GI can only be made by an association of producers, an organization, or an authority established by law representing the interests of the producers. The criteria and conditions for the registrability of a GI are different from those for collective or certification marks under the Trade Marks Act, 1999. GIs are similar to trademarks in that they serve as source indicators. They protect both producers and consumers from false advertising. A GI for goods recognizes such goods as agricultural, natural, or manufactured goods originating in a specific territory, region, or locality where a given quality, reputation, or characteristic is essentially due to its geographic location.

Difference Between TMs and GIs

When comparing intellectual property devices, it is useful to consider:

¹⁰ <http://blog.ipleaders.in/>

1. Nature of the Owner: Trademarks are proprietary in nature, granting the user exclusive rights to the mark. In contrast, a GI represents the common heritage of a community of producers in a geographical region or locality, whose products share the same qualities and characteristics.

2. Term of Protection: The protection term can differ between trademarks and GIs.

3. Nature of the Object: Trademarks are individual rights that can be sold and delocalized, whereas GIs cannot be sold or delocalized. Any producer within the region can use a GI.

4. Nature of the Right: Trademarks provide exclusive individual rights, whereas GIs are collective rights shared by all qualifying producers in the designated area.

Relationship between trademarks and GIs in India

The relationship between trademarks and geographical indications (GIs) in India is carefully balanced through the combined framework of the *Trade Marks Act, 1999* and the *Geographical Indications of Goods (Registration and Protection) Act, 1999*, both enacted to harmonize with India's obligations under the TRIPS Agreement.¹¹ While trademarks primarily serve to distinguish goods or services of one enterprise from those of another, GIs identify goods as originating from a specific territory where a particular quality, reputation, or characteristic is essentially attributable to its geographical origin.¹² The *Trade Marks Act, 1999* prohibits the registration of deceptive marks that could mislead the public about the geographical origin of goods,¹³ and specifically bars the registration of trademarks that contain or consist of GIs with respect to goods not originating in the indicated region if such use is likely to cause confusion.¹⁴ Conversely, the *Geographical Indications Act, 1999* provides exclusive rights and protection to producers of registered GIs, preventing unauthorized use that may misrepresent the true origin of goods.¹⁵ Section 25 of the *GI Act* explicitly addresses the interface between trademarks and GIs by stipulating that a trademark which contains or consists of a GI indicating goods not originating in that region shall be refused or invalidated.¹⁶

¹¹ Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), 1994, Arts. 22–24

¹² Geographical Indications of Goods (Registration and Protection) Act, 1999, §2(1)(e).

¹³ Trade Marks Act, 1999, §9(1)(b).

¹⁴ Trade Marks Act, 1999, §9(1)(c).

¹⁵ Geographical Indications Act, §21.

¹⁶ Geographical Indications Act, §25.

Additionally, Section 26 provides transitional protection for trademarks registered in good faith before the commencement of the Act or before the filing of the GI application, thereby ensuring a fair balance between prior trademark rights and new GI registrations.¹⁷ The Registrar of Trademarks and the Registrar of GIs are also expected to maintain mutual consultation to prevent overlap and ensure consistency in registration decisions.¹⁸ Judicial interpretation has further clarified this relationship or instance, in *Tea Board, India v. ITC Limited*,¹⁹ the Calcutta High Court held that the use of the term “Darjeeling Lounge” by a hotel did not constitute GI infringement since it was not being used in connection with tea, emphasizing the contextual nature of such conflicts.

The coexistence of both regimes demonstrates India’s commitment to protecting commercial identity and consumer interests without undermining traditional and regional heritage.²⁰ While GIs are collective rights rooted in regional reputation, trademarks are private rights reflecting individual enterprise goodwill, and the legislative framework ensures that neither operates to the unjust detriment of the other.²¹ Hence, the Acts together create a complementary mechanism preserving the distinctiveness of origin-based goods through GIs while upholding brand distinctiveness through trademarks.²² The Indian model thereby aligns with international standards, safeguarding both economic interests and cultural heritage within the intellectual property regime.²³

Major Areas of Conflict And Overlap Between Trademarks and Gis In India

CONFLICT BETWEEN TRADEMARK AND GIs

- For the past twenty-eight years, the conflict between trademarks has been a prevalent topic in intellectual property debates, international and regional conferences, legislative programs, and workshops. This controversy coincided with the development of the framework for protecting geographical indications (GIs). Conflicts over the exclusive use of a distinguishing sign typically arise when multiple parties claim the same right. When both a TM and a GI protect

¹⁷ Geographical Indications Act, §26(1)–(2).

¹⁸ Trade Marks Rules, 2017, r.33; Geographical Indications Rules, 2002, r.32.

¹⁹ *Tea Board, India v. ITC Limited*, (2011) 45 PTC 61 (Cal).

²⁰ *Scotch Whisky Association v. Pravara Sahakar Shakkar Karkhana Ltd.*, (1992) IPLR 91 (Bom).

²¹ Watal, Jayashree, *Intellectual Property Rights in the WTO and Developing Countries*, Oxford University Press, 2001.

²² Basheer, Shamnad, “Protection of GI and its interface with trademarks in India,” *Journal of World Intellectual Property*, Vol. 8, 2005.

²³ WTO, *Review of Legislation on Geographical Indications: India’s Submission*, IP/C/W/253 (2001).

the same subject matter, disputes emerge over the exclusive use of the product. Local IP legislation permits qualifying applicants to register and exclusively use trademarks and GIs for the same product, necessitating clarity on the relationship between the rights of TM and GI holders. While TM rules are clear in most countries, the legislation on GIs is often ambiguous, complicating the determination of their applicability.²⁴

- The general assumption that both trademarks and GIs act as source identifiers without considering their functions and the generalized language of international instruments contribute to conflicts. Arguments related to cultural heritage, traditional knowledge, economic perspective, trade, and agricultural benefits further fuel these disputes. Proponents of GI protection view any priority given to a trademark for a sign already registered or used as a GI in another region as an attack on cultural heritage and traditional knowledge. Conversely, TM advocates see any expropriation or denial of exclusivity due to an identical GI as a violation of private property rights.²⁵
- Conflicts often arise when a sign indicating geographical origin is also protected under trademark law. For example, "CAPRI," an island in Italy, was also a trademark for a Ford car. Similarly, "Sapporo," a city in Japan, is both a company's name and a TM for a well-known brewery. Businessmen frequently use geographical names for their brands, which can lead to conflicts.²⁶ Emigration can also contribute to this issue when emigrants use the same names for their products in new locations. Identical names for items can also occur by chance, involving human names, brands, and locations.
- The primary points of contention include the scope of GI protection against trademarks and whether GI rights should prevent the registration of similar interpretation trademarks in member nations. Article 24(5) of TRIPS raises issues regarding the concept of "good faith" and the determination of authority to assess the good faith use of trademarks or GIs.²⁷ The question of protection for unregistered GIs or trademarks also arises, along with the need to prove that

²⁴ Trade Marks Act, 1999, No. 47 of 1999, §§ 9, 11, 18, 25, 28 (India).

²⁵ D. Gangjee, *Relocating the Law of Geographical Indications* (Cambridge University Press, 2012), pp. 118–146.

²⁶ WIPO, *Geographical Indications: An Introduction*, Publication No. 952E (World Intellectual Property Organization, 2017).

²⁷ Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), Art. 24(5)

a trademark was registered and used in good faith before the GI. Member countries may need to agree on protecting trademarks that conflict with GIs.²⁸

AREAS OF OVERLAP

- Overlap often occurs when the same sign is used as both a GI and a TM by different parties for the same product. This raises the question of who is entitled to the rights and whether one should take precedence or if both can coexist. Another conflict arises when different parties use the same sign for different goods, one as a TM and the other as a GI, and one of them is a well-known mark. As long as they are used in their respective spheres, there are no issues. However, TM laws and GI laws do recognize the potential overlap. Trademark laws stipulate that TMs must not be descriptive or deceptive, while GIs are often descriptive.²⁹ This ensures that TMs incorporating a GI cannot be protected if they are misleading about the product's origin.

- TM laws also prohibit the use of names of territories, nations, or geographical places on products that could imply the origin of the goods. Registration is excluded if the public perceives the geographical term used as a TM to indicate the origin of the goods and the TM. However, the use of a geographical term as a TM is possible if it becomes arbitrary and does not relate to the origin of the products.³⁰ Additionally, a GI can be used as a TM if it initially was descriptive but has gained secondary meaning or distinctiveness through use.

- When the protection of a GI is based on unfair competition or passing off laws, and the opponent claims TM rights in that indication, whether the use of the GI is misleading is decisive. If it is found to be deceptive about the product's origin, it would be considered unfair competition, and such use would be prohibited.³¹ However, if the use is not misleading, the action under unfair competition and passing off might fail, allowing the TM to continue being used. In cases where the GI has goodwill in a small area while the conflicting TM is well-

²⁸ Geographical Indications of Goods (Registration and Protection) Act, 1999, No. 48 of 1999, §§ 25–26 (India).

²⁹ Imperial Tobacco Co. v. Registrar of Trade Marks, AIR 1977 Cal 413.

³⁰ Scotch Whisky Association v. Golden Bottling Ltd., 2006 (32) PTC 656 (Del).

³¹ Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories, AIR 1965 SC 980.

known in a larger territory, both should be allowed to coexist with specific conditions on the use and scope of the rights.³²

- When geographical terms are used as collective or certification marks, they are protected and regulated under the country's TM law. Conflicts regarding such rights are resolved by applying the principle of priority. TM law prioritizes the rights registered or used earlier and, under certain situations, the mark that has become well-known before other claims. The use of GI as certification and collective trademarks ensures protection, and their conflict resolution with individual trademarks generally poses no problems.³³

INTERNATIONAL FRAMEWORKS (SUCH AS TRIPS) ADDRESSED DISPUTES INVOLVING GIS AND TRADEMARKS

Resolving Conflicts Between TMs And GIs

The traditional methods for resolving conflicts between TMs and GIs, when similar or identical signs are used for the same product, are based on principles of priority, territoriality, and exclusivity.³⁴ Different countries have adopted various approaches to address these conflicts. For instance, the European Union holds that TMs containing words identical to geographical names for wine should be abolished. WIPO suggests that GIs are best protected under trademark and unfair competition law.³⁵ If a trademark has been acquired in good faith, it should be protected against conflicting GIs. The International Association for the Protection of IP has examined these conflicts and proposed actions such as refusing trademark registration ex officio, allowing third parties to oppose registration, initiating proceedings to cancel TMs, and prohibiting their use.³⁶ It recommends that national and regional legislations consider existing bilateral and multilateral agreements, and allow affected parties to intervene directly in proceedings. Competent courts or authorities should decide on the validity of TM registrations. In the UK, TM consisting exclusively of signs indicating geographical origin should not be registered, though geographical names can be registered as certification and collective marks. In India, the legislation for trademarks and GIs aligns with the TRIPS. The

³² Tea Board of India v. ITC Ltd., 2011 (45) PTC 673 (Cal).

³³ IP India, Manual of Geographical Indications Practice and Procedure (Controller General of Patents, Designs & Trade Marks, Government of India, 2020).

³⁴ TRIPS Agreement, Articles 22–24, WTO (1994).

³⁵ WIPO, “Protection of Geographical Indications,” SCT/3/2, SCT/5/3.

³⁶ AIPPI Resolution, “Conflict Between Trademarks and Geographical Indications,” 37th Congress, Rio (1998).

TM Act, 1999, and the GI Act, 1999, provide guidelines for resolving conflicts. Indian trademark law prohibits registration of marks that designate characteristics such as geographical origin unless they have become well-known or acquired distinctiveness.³⁷

- If a TM was registered or gained distinctiveness in good faith before the current act, its validity cannot be questioned on the grounds of similarity to a GI. The GI Act prevents the registration of GIs as trademarks in India, but if a trademark includes a GI registered or applied for in good faith before the act, its validity is protected.³⁸ The act does not apply to goods and classes that have become common names. Individuals can use their names or their predecessors' names in business, provided it does not cause confusion or mislead the public.

- Countries have adopted various conflict resolution methods influenced by existing practices, historical reasons, or international frameworks. The aim is to balance the rights and interests of trademark and GI holders effectively.

HARMONIZING THE RELATIONSHIP BETWEEN G.I. AND TM

- Resolving the interference between trademarks and geographical indications (GIs) has been a topic of extensive deliberation. One proposed solution is coexistence, where a GI and TM can be used simultaneously to some extent, even if this would typically infringe on the rights granted by the other. This approach is considered the most equitable and practical. Both the TRIPS and WTO panels support this method. In the notable Budweiser case, the WTO panel endorsed coexistence, recognizing it in national and regional legal frameworks initially as a "geographical descriptive use" defense in TM law.³⁹

- Coexistence is crucial in managing the dynamic relationship between TM and GIs, a contentious issue in intellectual property discussions. The TRIPS agreement outlines methods for resolving conflicts by considering the date of TRIPS implementation for member states, the start of GI protection in their origin territory, and the date of acquiring bona fide TM rights in similar signs used on GI-protected goods. This agreement aims to balance TRIPS and GI law rights.

³⁷ Trade Marks Act, 1999 (India) — Sections 9, 11, 12.

³⁸ Geographical Indications of Goods (Registration and Protection) Act, 1999 — Sections 25 & 26.

³⁹ WTO Panel Report, EC — Protection of Trademarks and GIs, WT/DS174/R; WT/DS290/R (2005).

- At its 37th congress in Rio, the AIPPI favoured coexistence, suggesting that while the FITFIR principle (First In Time, First In Right) is useful, coexistence should apply unless the TM has prior reputation. This rule applies to misrepresentation and misappropriation, with considerations for mitigating circumstances like usage extent and bona fides.
- EU members, keen on protecting GIs, advocate for either GI primacy or coexistence, while TM law proponents favour the FITFIR rule for its clarity and predictability. The territoriality of GIs, restricted to specific regions, sometimes necessitates alternative conflict resolution methods as FITFIR applies only within certain territories.
- The WTO promoted coexistence in a dispute over EC Regulation 2081/92, permitting coexistence due to GIs' fair use of geographically descriptive terms, despite potential TRIPS Article 16 violations. The regulation included a "legitimate interest" proviso under Article 17. The panel aimed to define the exception's scope, considering a slight reduction in trademark rights, without entirely negating them, adhering to a limited derogation standard.

INCEPTION OF CONFLICT

Conflict arises when one party asserts geographical indication (GI) rights and another asserts trademark rights over the same term or sign within the same jurisdiction. This issue stems from Articles 24(5) and 16 of the TRIPS Agreement. Therefore, it is essential to examine these provisions closely.

Article 24(5) of TRIPS states that protecting GIs should not affect the eligibility or validity of a TM registration • • or the right to use a trademark identical or similar to a GI if it has been used in good faith either: 1. Before the relevant TRIPS provision's application date in that member state, or 2. Before the GI is protected in its country of origin. To set TM protection under Article 24(5), the following conditions must be met:

The TM must be identical or similar to the GI.

The TM been used in good faith.

Must have been used either before the relevant TRIPS provision's application or before the GI was protected in its country of origin.

Article 16 of the TRIPS Agreement outlines the protection scope for a TM. It grants the registered TM owner exclusive rights identical or similar signs for goods to prevent or third parties from using services that could cause confusion. This protection does not prejudice existing prior rights and does not affect the possibility of members granting rights based on use. There is a conflict between Articles 24(5) and 16, as Article 24(5) provides an exception, while Article 16 confers absolute rights. Different geographical regions can share the same name for similar products, leading to issues if trademarks containing GIs are misleading about the products' true origin. However, a geographical term can be used as a TM if it acquires distinctiveness through use.

PRINCIPLE FOR RESOLUTION OF CONFLICT INDIAN TM AND GI LAWS: PROVISIONS AND CONFLICT RESOLUTION TRIPS

Indian laws governing trademarks and Geographical Indications (GIs), aligned with the Agreement, include unique provisions for resolving these two concepts. Under trademark law, marks conflicts between or indications that serve to designate aspects like geographical origin, kind, quality, quantity, or other characteristics of eligible for registration. However, a trademark intended purpose, values, goods or services are generally will not be not denied registration if, before the application date, recognized it has acquired a as a well-known TM. The Registrar, in determining distinctive character through use or is whether a trademark is well-known, will consider:

1. Public recognition or knowledge of t through promotion.
2. Duration, extent, and he TM, including information obtained geographical area in India of use.
3. Duration and extent of promotion, including advertising and publicity.
4. Registration and publication details reflecting the trademark's use or recognition.
5. Records of successful enforcement of r recognition as a well-known ights in that trademark, particularly its mark by courts or the registrar. If a trademark has been registered in good faith, disclosing all relevant information, and has been used in good faith before the enactment of the current law, the validity of that TM's registration or right to use will not be prejudiced, even if it is identical or similar to a well-known trademark. The Geographical Indications of Goods

(Registration and Protection) Act, 1999, includes specific provisions regarding trademarks and prior users. Section 25 3 registration prohibits the trademarks that contain or comprise a GI and were faith under of GIs as trademarks. However, Section 26 protects applied for or registered trademark law, or used in good faith before in good the GI Act's enactment or the filing of t 15 he GI registration application. This to goods 2 or classes of act does not apply to GIs related goods that had become common names in India by January 1, 1995. It also protects individuals' right to use their name or their predecessors' name in business, except where public. No action regarding the use years from when the such use is likely to or registration cause confusion or mislead 3 of a trademark will be use or Taken registration infringing any GI registered the after five under this act became known to the registered proprietor or authorized user.

RESOLUTION OF CONFLICT

- Conflict resolution in these cases often hinges on value judgments. One common approach is the 'first in time, first in right' principle, where the symbol registered earlier is entitled to protection. Section 25 of the GI Act aligns with Article 22.3 of TRIPS, which mandates national legislation to allow the refusal or invalidation of trademarks that mislead the public about goods.
- The Registrar of Trade the true origin of the Marks must examine applications in light of Section 25(a) and (b) of the GI Act. The matter can also be addressed in rectification proceedings to invalidate a misleading trademark registration. 19 This requires evidence showing that the public recognizes the indications only 3 as a geographical indication for the relevant goods.
- Section 26 of the Act, an exception to Section 25, protects trademarks containing a GI applied for or registered before the in good faith under trademark law GI Act or the GI registration application date. Subsection (2) exempts GIs related to goods that became common names in India by January 1, 1995. Subsection (3) allows the use of a person's name or their predecessor's name in business unless it causes confusion or misleads the public. • V. 21 Different countries have adopted various methods for resolving these conflicts, influenced by existing practices, historical reasons, or international frameworks, aiming to balance the rights and interests of GIs and trademarks effectively.

JUDICIAL INTERPRETATIONS

- ❖ Tea Board v. ITC Limited (2019): allowing them to use 2 The Calcutta High Court ruled in favor of ITC Limited, the name "Darjeeling" for their hotel lounge. The Tea Board, which held

registrations for "Darjeeling" as a GI and certification mark for tea, argued of "Darjeeling Lounge" infringed on their rights. The court found that the that the use GI Act's scope was limited to goods, not services, and dismissed the suit.⁴⁰

❖ Scotch Whisky (C-44/17): The European Court of Justice ruled that the Whisky" as a trademark use of "Scotch for non-whisky products was misleading and could not be registered. This case emphasized the protection of GIs against misuse in unrelated products.⁴¹

❖ Champagner Sorbet (C-393/16): The European Court of Justice held "Champagner" for a sorbet was misleading and could not be registered that the use of as a This case reinforced the principle that GIs should be protected from misuse in dissimilar goods and services. trademark.⁴²

Could a Geographical Name with No Importance to Trade Be Registered as a Trademark?

This issue was raised in the case of Trademarks. In this of Imperial Tobacco Co. of India vs. Registrar case,⁴³ the Imperial Tobacco Company of India the Registrar applied to of TMs to register a TM for a cigarette package wrapper featuring a device showing snow-clad hills with "Simla" prominently displayed in various panels, along with a small inscription indicating the product came from the company. The Registrar rejected the application for registration, prompting the company to appeal to the Calcutta High Court. The Calcutta High Court, while dismissing the appeal, established the following principles: The term "Simla" is a geographical name, and the snow-clad hills depicted in the stamp suggest its use in a natural or geographical context. As such, the term is neither a fanciful nor an invented word, nor does it have a secondary meaning. The principles for resolving conflicts between a trademark and an identical or similar sign used to designate identical or similar 3 goods or services on three widely accepted and straightforward principles: priority, exclusivity, and territoriality. When a conflict arises, the earlier right prevails.

CONCLUSION AND SUGGESTIONS

⁴⁰ Tea Board of India v. ITC Ltd., (2019) 78 PTC 123 (Cal).

⁴¹ Scotch Whisky Association v. Klotz, Case C-44/17 (ECJ, 2018).

⁴² Champagner Sorbet Case, Case C-393/16 (ECJ, 2017).

⁴³ Imperial Tobacco Co. of India Ltd. v. Registrar of Trade Marks, AIR 1968 Cal 582

The interface between trademarks and geographical indications (GIs) under Indian law reveals a complex yet evolving relationship shaped by statutory interpretation, judicial reasoning, and international obligations under the TRIPS Agreement. While trademarks are rooted in the principles of individual exclusivity, commercial goodwill, and market distinctiveness, GIs emphasize collective heritage, regional identity, and community-driven reputation. This fundamental divergence naturally gives rise to conflicts, particularly in cases involving identical or similar signs used for the same class of goods.

However, the Indian legal framework through the Trade Marks Act, 1999 and the Geographical Indications of Goods (Registration and Protection) Act, 1999 attempts to harmonize these competing rights by providing mechanisms such as refusal of deceptive marks, invalidation of misleading registrations, transitional protection for good-faith trademarks, and mutual consultation between registrars. Judicial precedents like *Tea Board v. ITC Limited* further clarify the contextual application of these laws, emphasizing the need to balance private commercial rights with cultural and regional heritage. International approaches, especially those of the EU and WTO panels, also support coexistence and balanced protection instead of absolute priority.

A coordinated framework balancing individual trademark rights and collective GI rights will foster innovation, fair competition, and equitable market practices in India.

The analysis demonstrates that when trademarks and GIs are treated as complementary rather than competing rights with coexistence, prior-use safeguards, and clear rules on consumer confusion both systems function more efficiently. This balanced approach strengthens economic opportunity, protects cultural heritage, and reduces legal uncertainty, thereby based on the findings of this research, ***the hypothesis stands proved.***

The analysis clearly shows that when trademarks and GIs are treated not as competing claims but as complementary identifiers serving different purposes, both systems can coexist effectively. Coexistence, prior-use protection, and clarity on consumer confusion lessen litigation and create certainty for brand owners and producers. Such a balanced approach does not merely protect rights—it enhances economic opportunities, strengthens international competitiveness, preserves cultural heritage, and fosters consumer trust. Therefore, a coordinated framework indeed promotes innovation, fair competition, and equitable market practices, validating the research hypothesis.

- Strengthen coordination between the Trademark Registry and GI Registry to prevent conflicting registrations and ensure consistent decisions.
- Introduce clearer statutory guidelines on coexistence, priority, and interpretation of geographical terms to reduce ambiguity.
- Encourage alternative dispute resolution (ADR) mechanisms such as mediation for TM–GI conflicts to reduce litigation burden.
- Strengthen border control measures and customs training to prevent import/export of counterfeit GI goods.
- Develop a unified digital platform for trademark and GI search to help avoid inadvertent conflicts during registration.
- Promote collaborations between industry and GI producer groups to ensure fair commercial practices and innovation-driven product development.