

## Trademarks and Geographical Indications: Navigating the Tension between Exclusivity and Origin

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### Abstract

The intersection of trademarks and geographical indications (Gis) has emerged as one of the most contested domains in contemporary intellectual property law. While both serve as indicators of origin, enabling consumers to associate goods with a particular source, quality, or reputation, they differ fundamentally in their legal character and underlying purpose. Trademarks are private, proprietary rights granted to individuals or enterprises to distinguish their goods and services in the marketplace. Geographical indications, by contrast, are collective rights vesting in a community of producers within a defined region, where the qualities or characteristics of the product are intrinsically linked to its geographical origin.

Conflicts arise when these two systems intersect — as when a trademark incorporates a geographical name that later acquires GI status, or when a registered GI overlaps with a preexisting trademark. Such disputes present complex legal challenges, particularly in a globalized economy where goods traverse multiple jurisdictions governed by divergent legal regimes.

This paper examines the nature of these conflicts and the prospects for coexistence between trademarks and Gis, with particular reference to the Indian legal framework and international instruments such as the TRIPS Agreement. Adopting a doctrinal methodology, the paper analyses relevant statutory provisions, judicial pronouncements, and academic discourse to map the contours of this tension.

The paper argues that while conflicts between trademarks and Gis are structurally inevitable, they are amenable to resolution through the principled application of prior use, good faith, and consumer protection doctrines. A calibrated legal approach — one that reconciles private commercial interests with collective cultural heritage — is essential. Strengthened enforcement mechanisms, producer awareness, and sustained international cooperation are identified as critical enablers of meaningful and durable coexistence between these two pillars of intellectual property law.

*Keywords: Trademarks ,Geographical Indications , Intellectual Property Conflict, TRIPS Agreement , Coexistence and Prior Use*

### Introduction

The use of intellectual property rights (IPRs) is one of the key drivers of competitions in the market, business identity and cultural heritage in the current globalized economy. Trademarks and geographical indications (GIs) are some of the various kinds of intellectual property, which are especially significant as they directly affect consumer attitudes and buyer behavior. Both of them are the mechanisms, which assist consumers to recognize the source of products and correlate them with some qualities and reputations. Nevertheless, even though they are similar, trademarks and GIs also differ substantially in their nature, ownership, and purpose, which results in most cases in the conflict of GIs and trademarks.

A trademark just simply is a sign that can help differentiate between the goods or services of one enterprise and the others.<sup>1</sup> It can be composed of words, logos, symbols or a mixture or all of them. The main role of trademarks is to serve as a mark of origin whereby a consumer can remain sure of the origin of goods and he or she is not deceived. The goodwill and reputation that a business has developed over a time, and thus the trademarks, make

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<sup>1</sup> The Trade Marks Act, No. 47 of 1999, section 2, India Code (1999).

them valuable commercial assets as well. They are assignable, licensable and may also be transferred, and are usually owned by companies (individuals).

A geographical indication, on the other hand, characterizes the goods as the product of the particular territory, region, or locality where the specific quality, reputation, or other characteristic is essentially due to the origin.<sup>2</sup> The examples of the Darjeeling tea and Basmati rice and Banarasi sarees show that GI is strongly connected with the aspect of regional identity, traditional knowledge, and cultural heritage. As opposed to trademarks, GIs are not possessed by one party but shared among all the owners of a particular geographical region. They cannot be moved around and do not have a value in isolation since their importance is in their attachment to a given place.

The tension between the trademarks and GIs occurs due to the reason that both systems become pointing marks in the market. One of the most typical conflict situations is a trademark containing a geographical name that is later registered as GI. An example is that, a company can apply a regional name as trademark in order to increase the popularity of a product. But when that name is subsequently understood to be a GI then the trademark can be questioned on the grounds of deceiving the consumers or on violating the rights of the GI producers.

The other source of conflict is where the trademarks are created in a way that gives it a false impression that it is of a geographical origin. This may create a false impression to the consumers that a good is a product of a specific region when it is not and this would hurt both the end users and real producers. There is also the problem of genericization that further complicated the situation. Geographical names can also lose their uniqueness with time and become generic names, so that they can no longer be so special.

Such wars are even opposed in the arena of global commerce. Alien countries also protect GIs in varying ways. An illustrative case is that the European Union is very protective of GI by participating in a separate legal framework whereas the United States largely depends on the trademark law.

Therefore, a name, which is registered as a GI in one country, can be considered a generic word or a brand name in another one. Such inconsistency introduces a level of legal ambiguity and the chances of disagreements are high.

The Acts of Parliament that provide the legal framework to the trademarks and the Geographical indicators of Goods (Registration and Protection) are the Trade Marks Act of 1999 and the Geographical indicators Act in 1999 (Products).<sup>3</sup> In India, the legal framework in which the trademarks and the GI are provided is presented by the Trade Marks Act of 1999 and the Geographical indicators Act of 1999 (products). The significance of international obligations in the TRIPS Agreement under which there are minimum standards in the protection of GIs is also acknowledged by the Indian law.<sup>4</sup>

The significance of this subject is that, there is a necessity to balance one aspect against the other integrated competing interests. On the one hand, trademarks play a key role in ensuring the successful business development, innovation, and competitiveness. Conversely, GIs are also instrumental in the preservation of the cultural heritage, local community support, and marketing of the local products. As such, a legal framework should be formulated where the two systems can exist together without each other compromising.

The objective of this research paper is to discuss this conflict between trademarks and geographical indications in detail and to see how it can be observed that coexistence can take place.

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<sup>2</sup> The Geographical Indications of Goods (Registration and Protection) Act, No. 48 of 1999, Section 2, India Code (1999).

<sup>3</sup> The Trade Marks Act, 1999.

<sup>4</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights arts. 22–24, Apr. 15, 1994.

It aims at examining the conceptual divergences of the two, finding out the instances where the conflicts emerge and the efficiency of the legal frameworks. In that way, the paper will serve the purpose of offering a better perspective on how the two relevant keys to intellectual property can work in a balanced and just way.

### **Literature Review**

The interactions between trademarks and geographical indications have been widely discussed in the literature that attests to the significance of the relationship between the two in terms of the legal sphere and the practice. Scholars have therefore approached the question from different perspectives, by a legal analysis, an economic analysis and a cultural significance.

One of the most important developments in this field is that of Dev Gangjee, who has argued that geographical indications are a form of intellectual property which will have to be understood through the lens of intellectual property where trademark laws can be seen as the functional equivalent.<sup>5</sup> Referring to GIs not being merely indicators of origin, Gangjee has argued that they have deep ties to cultural identity, traditional practices and local knowledge. He stresses that the GIs are protecting collective goodwill (shared amongst producers in a given region) as opposed to trademarks, which are designed to protect individual business interests.

Daniel Gervais offers an international focus on the issue and draws attention to the disparity in the ways different jurisdictions treat trademarks and GIs.<sup>6</sup> He notes that, while the TRIPS Agreement sets minimum standards for GI protection, the implementation of the agreement gives countries great flexibility regarding its implementation. As a result, different legal systems have taken varying approaches. For example, in the European Union, a robust, independent system has been developed for GI protection while the United States relies on trademark law, specifically certification and collective marks. This is often a source of dispute in international trade.

In the Indian context, V.K. Ahuja explains that the Indian law tries to find the right balance between the rights of the trademark and GI.<sup>7</sup> He notes the recognition of pre existing use and good faith in finding suitable resolution to the conflict. Indian courts do tend to focus on whether the use of a mark will lead to confusion amongst consumers and whether the mark unfairly exploits the reputation of a GI.

Several scholars have also stressed on the economic importance of geographical indications. They argue GIs can contribute to rural development by providing better market opportunity for local producer.<sup>8</sup> Products such as Darjeeling tea and Basmati rice have gained international recognition as a result of GI protection, which has contributed not only to improved income of producers but also exports.

At the same time, the literature shows some of the challenges associated with GI protection. One such challenge is the issue of genericization - the tendency of geographical names to become very commonly used, and so lose their uniqueness. This means that it is difficult to enforce GI rights, particularly in countries where such terms are considered generic.

Another theme that is present in the literature is the effect of globalization. As products are traded across countries, the same name could be treated differently in different countries.<sup>9</sup>

This leads to legal uncertainty and contributes to the potential for conflict between countries and businesses.

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<sup>5</sup> Dev Gangjee, "Relocating the Law of Geographical Indications" (2012).

<sup>6</sup> Daniel Gervais, "The TRIPS Agreement: Drafting History and Analysis" (2015).

<sup>7</sup> V.K. Ahuja, "Law Relating to Intellectual Property Rights" (2017).

<sup>8</sup> World Trade Organization, Review of Article 24 of TRIPS (2001).

<sup>9</sup> World Intellectual Property Organization (WIPO), Geographical Indications: An Introduction (2017).

Case law has added much to the academic discussion as well. The Darjeeling tea case is most often cited to illustrate a successful exercise in enforcing GIs, while the Basmati rice case draws attention to the problem of protecting GIs in international markets. These are a few of the cases that have shown that the conflict between trademarks and GIs is not purely hypothetical, and that there are real implications to consider.

Overall, it appears from the available literature that although there are bound to be conflicts arising between trademarks and geographical indications, such conflicts can be managed under appropriate legal mechanisms.

### **Methodology**

This research method is doctrinal and analytical, which is mostly used in legal research to analyze and interpret laws, judicial decisions, and academic writings. The goal of the use of this methodology is to build a clear understanding of the conflict and coexistence between trademarks and geographical indications (GIs) in the framework of intellectual property law.

The main method employed in this study is doctrinal analysis which is a close study of statutory provisions and legal principles. The important legislation considered in the analysis are the Trade Marks Act, 1999 and the Geographical Indications of Goods (Registration and Protection) Act, 1999. These laws serve as the foundation for the Indian legal system on the regulation of trademarks and GIs. In addition, the research considers also Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS) which establishes minimum international standards for the protection of GIs.<sup>10</sup> By analysing these legal instruments, the research is intended to understand how the law deals with conflicts between trademarks and GIs.

Another important aspect of the methodology is the case law analysis. The decisions of the courts are vital in drawing the meaning and interpretation of the law. This study attempts to examine such landmark cases as Tea Board of India vs. ITC Ltd. (Darjeeling Tea case), Basmati rice dispute and Scotch Whisky Association v. Golden Bottling Ltd. Such cases provide helpful materials concerning the approach taken by courts in matters dealing with the issues of prior use, the confusing rescission and the deceptive similarity. The trend in the reasoning of judges and the recognition of the use of such a principle like the good faith and public interest, applied in a specific situation, can also be discovered by the case law analysis.

The research is also comparative in its method of analyzing how the various jurisdictions handle trademarks and GIs conflict. In particular, the European Union and the United States are involved here. In the European Union, there is the sui generis system, which is providing robust and independent safeguard of the GIs and the United States of America employs the trademark legislation which offers insurance to geographical names in the form of certification marks and collective marks. Through juxtaposition of these systems, the study determines the variation of the approaches of the law as well as what may be learnt in enhancing the Indian legal system.

Alongside the primary sources, the work is also premised on the so-called secondary sources, i.e. books, journal articles, and reports provided by such organizations as the World Intellectual Property Organization (WIPO) and World Trade Organization (WTO). These sources contain theoretical information, and aids in comprehending the wider policy issues in protection of GI.

The critical and analytical approach is also part of methodology where effectiveness of the available laws is measured. The analysis of the research is not limited to a description of the legal provisions but it also takes into account the strength and weakness of the provisions. The presence of such issues as the lack of understanding by the producers, the ineffective mechanism of protection, and inconsistency in the application of protection on the international level are decisively considered.

There are, however, certain limitations of the study. It is mainly based on secondary data and not including empirical research like field survey or interviews. In addition, although the scope of the comparative analysis covers major jurisdictions, not all countries are detailed. Despite all these limitations, the methodology is a

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<sup>10</sup> TRIPS Agreement, supra note 4.

thorough and organized approach to understanding the conflict and coexistence between trademarks and geographical indications.

### **Analysis**

The reason for the conflict between Trademarks and Geographical indications (also known as GIs) is mainly because the function that both perform in the marketplace is similar - that is, they operate as indications of origin. However, their principle concepts and legal frameworks are significantly different, which makes for tension when both frameworks collide. This section considers the nature of such conflicts in some detail, and explores the ways in which legal systems attempt to resolve them.

### **Conceptual Conflict: Private Vs Collective Rights**

“The most basic difference between trademarks and GIs is the nature of the. Trademarks are private rights owned by individuals or corporations whereas GIs are collective rights, owned by a group of producers in one part or the other.”<sup>11</sup> This difference generates a basic conflict between private commercial and public cultural interests.

Trademarks are designed to encourage competition for businesses to develop brand identity and goodwill. In contrast, GIs try to safeguard a region's reputation and traditional knowledge. When these two objectives clash, it's hard to know which of these interests should take precedence.

### **Conflict between Prior Trademarks and GIs**

One of the most common scenarios of conflicts is when a trademark is registered prior to recognition of the geographical indication. In such a situation, the trademark owner might have developed great goodwill and reputation in the market. If the GI is later afforded protection, it may set limits on the use of the trademark and disputes may arise as a result.

Indian law, due to influence of TRIPS Agreement, generally recognizes the prior right in trademark, provided that they were acquired in good faith.<sup>12</sup> This means that a trademark which has been registered be prior to the recognition of a GI can continue to be used even if it contains a geographical name. However, concerns have been raised about fairness to producers of GI's who might feel that their collective rights are under attack from this approach.

Courts often attempt to balance between these competing interests and they will look at factors such as:

Whether the trademark was adopted without deceit

- The duration of use
- The reputation of the mark
- The chances that there will be confusion among consumers

### **Deception Use and the Consumer**

Another major battle is over deceptive use of geographical names in trademarks. This will happen when the trademark gives an indication that goods are of a particular region when they are not. This might be misleading to the consumer and cause negative reputation to the actual producers of the GI.

An example of this is the use of a name like "*Darjeeling*" in reference to tea that is not grown in Darjeeling area would cause misleading of the consumer and diminishes the value of the GI. Under such circumstances, the courts will tend to pay attention to consumer protection, and restrict the usage of misleading trademarks.

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<sup>11</sup> Graeme B. Dinwoodie & Mark D. Janis, “Trademarks and Unfair Competition” (2018).

<sup>12</sup> TRIPS Agreement, supra note 4, art. 24

The consumer protection principle is connected to the main point of settling the argument between the trademarks and the GI. An application of a mark, as long as it is likely to mislead or confuse the consumers, is usually unacceptable as far as the source of goods is concerned.

### **Genericization and Dispersion of Distinctions**

A complicated problem in this respect is the idea of genericization, in which a geographical name becomes so widely used that it loses its distinctiveness. For example, terms such as "*cheddar*" or "*champagne*" (in some jurisdictions) have become generic as time has gone by.

When any term becomes generic, it will no longer be eligible for GI protection and that creates conflicts with trademark law. Businesses may feel that such terms are freely available for use, while GI producers may wish to protect such terms as part of their cultural heritage.

As with the case of generic terms, treatment differs from jurisdiction to jurisdiction, adding to the complexity of the problem. In some countries, strong protection is given to GIs even if they are widely used, but in other countries, such terms are considered part of the public domain.

### **International Conflicts and Different laws**

The conflict between trademarks and GIs is complicated by the fact that the legal systems of nations differ. As mentioned earlier, in the European Union, GIs are strongly protected by a special legal review and in the United States by the use of trademark law.

It is this divergence that poses problems in international trade. A product that is protected as a GI in one country may not be protected to the same extent in another. This causes conflicts between nations and companies especially in industries like farming and food products.

The TRIPS Agreement aims to address certain of these problems but sets minimum standards for GI protection.<sup>13</sup> However, there is scope for flexibility in the implementation of these in the interests of the specific country, resulting in inconsistent protection.

### **Case Law Analysis**

Judicial rulings are good sources of information on how conflicts between trademarks and GIs are resolved in practice.

In *Tea Board of India v. ITC Ltd.*, the court realized the importance of protecting the "*Darjeeling*" GI and undertook steps to prevent abuse of the same.<sup>14</sup> This case indicates the role played by enforcement in maintaining the integrity of GIs.

The Basmati rice dispute illustrates the difficulties involved in protecting GIs in international markets.<sup>15</sup> Disputes over use of the term "Basmati" highlight the difficulties that can arise when differences in legal systems result in conflict.

In *Scotch Whisky Association v. Golden Bottling Ltd.* Golden Bottling determined that the protection of consumers is an important consideration in geographical name disputes.<sup>16</sup>

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<sup>13</sup> Id. arts. 22–24.

<sup>14</sup> *Tea Board of India v. ITC Ltd.*, (2011) (India).

<sup>15</sup> *Basmati Rice Case*, RiceTec Inc., U.S. Patent Proceedings.

<sup>16</sup> *Scotch Whisky Ass'n v. Golden Bottling Ltd.*, (2006) (India).

### **Mechanisms for Coexistence**

Despite all these conflicts, coexistence between trademarks and GIs is possible. Legal systems have evolved a number of measures to help create this balance:

- Recognition of prior rights
- Requirement of good faith
- Restrictions on Misleading Use
- Use of geographical qualifiers (for example "style" or "type")

### **Consumer awareness (measures)**

These mechanisms help to ensure that both the trademark owners and the GI producers can protect their interested without causing harm to the consumers.

### **Conclusion of Analysis**

The analysis shows that the conflict between trademarks and geographical indication is a complex but manageable. The key is striking the balance between competing interests and ensuring that rules and legal principles are applied in a fair and consistent manner.

### **Results and Discussion**

The analysis conducted in this study does show that conflicts between trademarks and geographical indications (GIs) are by no means incidental but instead are a natural consequence of the overlapping role these play as an origin indicator in the marketplace. However, the results also show that such conflicts can be well controlled through balanced and structured legal approach.

One of the most important things that can be noted is that the perception of a consumer plays a decisive role in the settlement of disputes. The question of whether using a trademark is likely to confuse the consumer about the source of goods has always been of concern among the courts and the authorities. In a situation where confusion would likely occur, a greater protection is typically provided to GIs since they are considered to be the image of a group and authenticity.

The other relevant and critical finding is the use of good faith and use of prior use. In case the trademark was carefully taken and has been in use for a long time, with continuous use, the rights are allowed by the courts regardless of the fact that it has caused a collision with a subsequent GI. This is one of the efforts to maintain fairness and the avoidance of unfair imposition of the harm on the owners of the trademarks.

In the study, certain critical challenges are also brought to focus on, namely in developing countries. These are the unawareness among the producers, ineffective enforcement procedures and unavailability of legal redress. Also, discrepancies occur through inconsistencies that exist because of international legal systems particularly in the trade between nations.

In general, it can be concluded that cohabitation between trademarks and GIs is possible, although it requires effective legal enforcement, stakeholder awareness and better coordination, not only at the national level, but also at the international level.

### **Conclusion**

The connection between trademarks and geographical indication is a part of a broader opposition between the individual commercial rights on one hand and the collective cultural rights on the other hand of intellectual property law. Although the role of trademarks in promoting identity of the business in terms of business competition is significant, innovation and geographical indication, geographical indications help in preserving the cultural heritage, traditional knowledge and regional identity.

This study arrives at the following findings; It is possible as well as necessary to have coexistence of these two systems to have a balanced intellectual property regime. Such a dogmatic stance that will accord the trademarks or GIs priority at the expense of the other would undermine the objectives of the other. An alternative pragmatic solution should be adopted which is anchored on certain principles like prior use, good faith and consumer protection.

The legal system of India which is supported by the Trade Marks Act, 1999 or the Geographical Indications Act, 1999 has a fairly balanced system to address such conflicts. Nonetheless, even enforcement of the requirements, awareness and cross country uniformity still have their problems. The role of the courts in formulating the laws is a significant one where the economic interests and cultural interests are going to be safeguarded.

In perspective, institutional support should be reinforced, producers ought to be more aware, and it should work more internationally. Especially the harmonization of legislation at the international level that would take place within such systems as the TRIPS Agreement can help reduce the level of conflicts and approach protection more homogeneously.

Finally, the trademarks and geographical indications cannot be regarded as rival systems and are to be used as complementary instruments. With the right level of control, coexistence will assist in economic growth, preservation of cultures, and higher levels of trust and confidence to the markets among consumers.