INDIAN JOURNAL OF LEGAL REVIEW [IJLR – IF SCORE – 7.58]

VOLUME 6 AND ISSUE 4 OF 2026

APIS – 3920 - 0001 *(and)* ISSN - 2583-2344

Published by

Institute of Legal Education

https://iledu.in

BEYOND SECTION 25: TRADEMARK ENCROACHMENT, GENERICIDE, AND THE EFFICACY OF THE INDIAN GI ACT

AUTHOR - PRACHI SENGRIYA* & DR. KAVYA CHANDEL**

* STUDENT AT AMITY LAW SCHOOL LUCKNOW, AMITY UNIVERSITY UTTAR PRADESH LUCKNOW CAMPUS

** ASSISTANT PROFESSOR OF LAW AT AMITY LAW SCHOOL LUCKNOW, AMITY UNIVERSITY UTTAR PRADESH LUCKNOW CAMPUS

BEST CITATION – PRACHI SENGRIYA & DR. KAVYA CHANDEL, BEYOND SECTION 25: TRADEMARK ENCROACHMENT, GENERICIDE, AND THE EFFICACY OF THE INDIAN GI ACT, *INDIAN JOURNAL OF LEGAL REVIEW* (IJLR), 6 (4) OF 2026, PG. 348-360, APIS – 3920 – 0001 & ISSN - 2583-2344.

ABSTRACT

This paper examines the complex intersection and inherent doctrinal conflicts between trademark law and geographical indications (GIs), two intellectual property regimes that both serve as source identifiers but possess fundamentally opposing philosophical underpinnings. While trademarks function as private, highly alienable rights indicating a product's commercial origin, GIs represent collective, inalienable public rights inherently tethered to a specific geographic region and its unique terroir. The research explores primary conflict scenarios, such as the clash between prior registered trademarks and subsequent GIs, contrasting the strict "first in time, first in right" (FITFIR) principle with the equitable doctrine of coexistence adopted by jurisdictions like India and the European Union. Additionally, it analyzes the statutory mechanisms designed to protect established GIs from bad-faith trademark encroachment and the superseding power of internationally well-known trademarks.

Furthermore, the study highlights the critical global threats of genericness ("genericide") and biopiracy, illustrating how the misappropriation of traditional knowledge and structural asymmetries in international IP law uniquely threaten developing nations, using prominent disputes over Basmati rice, Darjeeling tea, and Feta cheese as case studies. Finally, the paper concludes with a critical analysis of Section 25 of the Indian GI Act, arguing that while it establishes a foundational defensive shield against the corporatization of public geographical assets, its socio-economic effectiveness is severely undermined by deeply flawed statutory definitions of genericide, an absence of mandatory post-registration quality governance, and a severely eroded adjudicatory infrastructure following the abolition of the Intellectual Property Appellate Board (IPAB).

Keywords: Geographical Indications, Trademark Law, Genericide, Biopiracy, Indian GI Act.

1.1 Nature and Causes of Conflict

The intersection of trademark law and the jurisprudence governing geographical indications (GIs) represents one of the most fiercely contested and doctrinally complex domains within contemporary intellectual property (IP) rights. Historically, the relationship between these two regimes has been described as tempestuous, with both operating as "quibbling siblings" under the broader umbrella of unfair competition law.[731] Both legal instruments fundamentally serve as source identifiers, designed to regulate the communication of product information to the market, reduce consumer search costs, and

[731] Dev Gangjee, "Quibbling Siblings: Conflicts between Trademarks and Geographical Indications" 82 *Chi.-Kent L. Rev.* 1253 (2007).

prevent information asymmetry. However, despite their shared epistemological origins in consumer protection and market regulation, the intrinsic nature of the rights they confer creates a fertile ground for inevitable conflict.

The primary cause of this conflict is the opposing philosophical underpinnings of the two systems regarding ownership, alienability, and origin. Trademarks denote the commercial origin of a product or service, functioning as a private, exclusive, and alienable proprietary right vested in a specific individual or corporate entity. A trademark guarantees that a product emanates from a specific commercial enterprise, emphasizing brand reputation independent of where the goods are physically manufactured. Conversely, a geographical indication identifies the geographic origin of a good and represents a collective, inalienable public right inherently tethered to a specific locale, region, or *terroir*. A GI guarantees that the product's quality, reputation, or other characteristics are essentially attributable to its geographical origin, including natural and human factors unique to that region.

Conflict inevitably crystallizes when a trademark proprietor and a GI collective lay claim to the identical or deceptively similar alphanumeric sign within a single jurisdiction. This overlap typically manifests in dual scenarios: either a private commercial entity attempts to register a term possessing geographical and cultural significance as a private trademark, or a regional collective seeks to register a geographical indication that incorporates an existing, legally valid trademark.

The friction is further exacerbated by the divergent international approaches to managing these rights. The World Trade Organization's (WTO) Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) attempted to harmonize these regimes but ultimately left significant interpretative voids. Certain jurisdictions, notably the United States, integrate GIs primarily into their trademark systems via certification and collective marks, fiercely defending private trademark exclusivity and the principle of priority.[732] In contrast, the European Union and India have adopted *sui generis* (standalone) GI regimes that treat GIs as public goods or collective rights. These *sui generis* systems frequently elevate the protection of geographical indications over private trademarks to prevent the misappropriation of regional heritage, creating a continuous structural tension between private commercial monopolies and collective regional identities.

Doctrinal Feature	**Trademark Regime**	**Geographical Indication (GI) Regime**
Nature of Right	Private, exclusive proprietary right.	Public, collective right shared by authorized regional producers.
Origin Indicated	Commercial origin (the specific enterprise or manufacturer).	Geographical origin (the specific territory, region, or locality).
Transferability	Highly alienable; can be assigned, licensed, or sold globally.	Inalienable; tethered to the land and cannot be assigned or licensed outside the region.
Basis of Quality	Attributable to corporate standards, recipes, or manufacturing protocols.	Attributable to *terroir*, inherent natural factors (soil, climate), and traditional

[732] Section 4 of the Lanham (Trademark) Act of 1946 (USA).

		human skills.
Creation of Right	Acquired through arbitrary selection, distinctiveness, and commercial use.	Acquired through historical reputation and established geographic nexus.

1.2 Prior Trademark vs Subsequently Registered GI

1.2.1 Legal Position

The legal position regarding a prior registered trademark that conflicts with a subsequently applied-for geographical indication requires a delicate statutory balancing act, largely mandated by international obligations designed to protect pre-existing commercial investments. Article 24.5 of the TRIPS Agreement explicitly provides a "safe harbor" or grandfather clause for prior trademarks.[733] This multilateral provision stipulates that where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through continuous use in good faith before the geographical indication is protected in its country of origin, the implementation of GI protections shall not prejudice the eligibility, validity, or the right to use that trademark.

In India, this international obligation is meticulously codified under Section 26 of the Geographical Indications of Goods (Registration and Protection) Act, 1999.[734] Section 26 operates as a vital statutory exception to the general prohibition against registering GIs as trademarks. It protects trademarks that contain or consist of a geographical indication if they were applied for, registered, or used in good faith before the commencement of the GI Act (September 2003), or before the date of filing the application for the specific GI registration. The underlying legislative intent is to prevent the unjust expropriation of brand equity and goodwill that a corporate entity has legitimately built over the years, merely because the state subsequently recognizes the term's geographical significance.

Furthermore, Section 26(4) of the Indian GI Act establishes a strict limitation period that significantly affects the legal position of the parties in conflict. It explicitly mandates that no legal action in connection with the use or registration of a trademark shall be taken after the expiry of five years from the date on which such infringing use or registration became known to the registered proprietor or authorized user of the GI. This limitation applies subject to the condition that the trademark has been published under the Trade Marks Act and that the trademark was not used or registered in bad faith. This definitive legislative framework seeks to uphold legal certainty, ensuring that historical, good-faith trademarks are not perpetually vulnerable to invalidation by newly minted geographical indications.

1.2.2 Who Prevails and Why

The determination of who prevails in a conflict between a prior trademark and a subsequent GI is one of the most vigorously debated issues in IP law, hinging entirely on the ongoing clash between two legal doctrines: the "first in time, first in right" (FITFIR) principle and the doctrine of coexistence.[735]

Under the FITFIR principle, which is deeply entrenched in conventional trademark jurisprudence and championed by jurisdictions like the United States, the first intellectual property sign to be protected takes absolute precedence. This principle allows the prior trademark owner to categorically exclude the subsequent GI from the market to prevent any likelihood of consumer confusion. Proponents of FITFIR argue that Article 16.1 of the TRIPS Agreement grants trademark owners an unqualified, exclusive right to prevent the use of

[733] The Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994, art. 24.5.
[734] The Geographical Indications of Goods (Registration and Protection) Act, 1999 (Act 48 of 1999), s. 26.
[735] *Id.*, s. 26(4).

confusingly similar signs, arguing that there is no implied limitation in TRIPS that subjugates this right to geographical indications. This absolute exclusivity was fiercely debated in WTO dispute settlement panels, particularly in disputes DS174 and DS290, where the US and Australia challenged the European Union's GI regulations.

However, the prevailing global compromise, particularly influenced by the regulatory frameworks of the European Union and India, is the principle of coexistence. Coexistence posits that a prior trademark registered in good faith shall not be invalidated merely because of the subsequent registration of a GI. Instead, the law permits both the trademark and the GI to operate in the market simultaneously, provided there is no explicit public confusion about the true origin of the goods and the trademark does not inherently deceive consumers. The rationale behind coexistence is fundamentally equitable. It recognizes that dismantling a legitimately acquired prior trademark would constitute a draconian expropriation of private property. Conversely, granting an absolute monopoly to a prior trademark to completely block a legitimate GI would deny an entire region the fundamental right to identify its traditional cultural and agricultural heritage in the global marketplace.

In the Indian legal landscape, the prior trademark generally prevails within its specific sphere of use, shielded by the statutory defenses under Section 26 of the GI Act. Provided the "good faith" requirement is indisputably satisfied and the five-year limitation period has lapsed, the prior trademark proprietor is immunized against GI infringement suits. The burden of proof rests heavily on the GI claimant to establish *mala fide* intent or severe deceptive practices to overcome the established, vested rights of the prior trademark proprietor. Therefore, under Indian law, priority, coupled with good faith, guarantees the survival and continued use of the trademark, effectively forcing legal coexistence.

1.3 Prior GI vs Subsequently Registered Trademark

1.3.1 Protection of Established GIs from Trademark Encroachment

When a geographical indication has successfully established its historical reputation or achieved formal statutory registration, subsequent attempts by private commercial entities to register identical or evocative trademarks are met with stringent legal prohibitions. The foundational objective of the Indian GI Act is to prevent the monopolization of collective public property by private corporate interests, ensuring that geographical descriptors remain in the public domain for use by all legitimate producers within that region.

To enforce this, Section 25 of the GI Act explicitly prohibits the registration of a geographical indication as a trademark.[736] The legislation mandates the Registrar of Trade Marks, acting either *suo motu* (on their own motion) or upon a request from an interested party, to categorically refuse or invalidate the registration of a trademark that contains or consists of a GI. This prohibition is activated if the use of such a mark would confuse or mislead the public regarding the true place of origin of the goods. This *sui generis* firewall is seamlessly reinforced by the general trademark regime; Section 9(1)(b) of the Trade Marks Act, 1999, provides absolute grounds for refusal for any trademark that consists exclusively of marks or indications designating the geographical origin of the goods or services.[737]

This protection mechanism extends far beyond identical marks to encompass evocative or imitative marks that subtly attempt to circumvent literal similarity. International trademark registries actively police this boundary. For example, the French National Institute of Industrial Property (INPI) has consistently rejected subsequent trademarks incorporating elements that evoke a protected

[736] The Geographical Indications of Goods (Registration and Protection) Act, 1999 (Act 48 of 1999), s. 25.
[737] The Trade Marks Act, 1999 (Act 47 of 1999), s. 9(1)(b).

GI.[738] In notable administrative decisions, the trademark "COGNAPEA" for spirits was refused for illegally evoking the GI "COGNAC," and the mark "SAINT EMILLIARD" was invalidated for inappropriately evoking "SAINT-EMILLION". Similarly, Indian jurisprudence ensures that established GIs cannot be diluted, trivialized, or free-riding upon by subsequent commercial branding. This robust prohibition safeguards the collective economic fabric of the artisan or farming communities, ensuring that unauthorized domestic or foreign corporations do not siphon off the premium price commanded by authentic, region-specific goods.

1.3.2 Bad Faith Registration of GI Names as Trademarks

The doctrinal conflict frequently escalates to aggressive litigation when private entities attempt to register established GI names as trademarks in bad faith. Bad faith registration occurs when a trademark applicant, fully cognizant of the regional significance, cultural heritage, and commercial reputation of a geographic term, deliberately seeks to trademark it to monopolize the market, capitalize on the GI's pre-existing goodwill, or intentionally deceive consumers as to the product's true origin.

Under both international IP frameworks and domestic Indian law, the absence of "good faith" is a fatal determining factor that immediately strips a trademark of any statutory safe harbors, including the protections ordinarily granted under TRIPS Article 24.5 or Section 26 of the Indian GI Act. If a trademark is demonstrably adopted with the illicit intent to ride on the reputation of a specific geographical region, it constitutes an egregious act of unfair competition and deliberate misrepresentation. In these instances, the temporal priority of the trademark application becomes entirely irrelevant; fraud vitiates priority.

Indian courts and the Intellectual Property Office have consistently struck down subsequent trademarks that attempt to appropriate established GIs with *mala fide* intent. The adjudicatory machinery requires a meticulous examination of the circumstances surrounding the trademark's adoption. If a commercial enterprise incorporates a widely known GI into its brand name without any actual geographical nexus to the indicated region and deals in similar or identical goods, the registry may legally presume a high likelihood of confusion and bad faith. This uncompromising legal posture is essential to prevent the "genericide" of the GI and to ensure that the economic benefits, brand equity, and market exclusivity of the geographical indication remain firmly vested in the legitimate, traditional producers of the region.

1.4 Generic Names Trademark, GI, or Neither?

1.4.1 The Problem of Genericness

The concept of "genericide" or "genericness" represents the single most controversial, intractable, and fatal threat to both trademarks and geographical indications globally.[739] A geographic name is deemed generic when, over a prolonged period and through widespread, unregulated commercial use, it loses its specific geographic significance. Instead of indicating a product's regional origin, the term is understood by the consuming public merely as a designation of a product's type, kind, recipe, or style. Once a geographic term crosses the threshold into genericness, it is relegated entirely to the public domain. It can no longer function as a valid trademark due to a complete lack of distinctiveness, nor can it be protected as a GI because it no longer exclusively identifies a specific geographic source.

The TRIPS Agreement formally acknowledges this phenomenon in Article 24.6, which explicitly exempts WTO Member States from the obligation to protect a geographical indication

[738] *INAO/BNIC* v. *COGNAPEA*, INPI Opposition Decision OP 22-0433 (2022); *Conseil des Vins de Saint-Emillion* v. *D.A.*, INPI Nullity Decision NL 23-0090.

[739] Dev Gangjee, "Say Cheese! A Sharper Image of Generic Use Through the Lens of Feta" *LSE Research Online* (2007).

if the term is customary in the common language as the "common name" for such goods or services within their territory. This specific provision lies at the epicenter of a profound geopolitical schism. The United States frequently invokes genericness, arguing forcefully that historical terms brought over by European immigrants, such as Parmesan, Feta, Gorgonzola, and Bologna, have evolved into standard, unprotected product descriptions in the American market. The US views European attempts to enforce global GI protection over these terms as sheer trade protectionism, designed to illegally monopolize common food names and severely restrict American agricultural exports. Conversely, the European Union argues that allowing these historical terms to be treated as generic usurps the immense value created by traditional producers, severs the vital link between quality and *terroir*, and systematically misleads consumers regarding the authenticity of the products.

In India, the problem of genericness is legally addressed under Section 9(f) of the GI Act, which expressly prohibits the registration of geographical indications that are determined to be generic names or indications. However, the Indian statute has been heavily critiqued by legal scholars for adopting excessively broad and potentially harmful criteria for determining genericide. Specifically, the Indian legal framework requires an examination of the generic status of a term not just within the country of origin but also within the "areas of consumption". By legally entertaining the possibility that a traditional Indian product name might be deemed generic simply because a foreign export market widely misuses it, the legislature inadvertently weakened the absolute protection of indigenous goods. This "area of consumption" clause leaves traditional Indian GIs highly vulnerable to the exact type of exploitation and biopiracy perpetrated by multinational corporations in the Global North.

1.4.2 Case Illustrations

The profound legal complexities of genericness and the fierce international struggle to reclaim or defend geographical terms are best illustrated through high-profile, cross-border judicial battles.

The Feta Cheese Dispute (EU)

The protracted legal battle over "Feta" cheese epitomizes the global tension surrounding generic terms. Nations such as Denmark and Germany, which had been producing white cheese in brine from cow's milk for decades, aggressively argued before European courts that "Feta" had become a purely generic term indicating a style of cheese. However, Greece sought exclusive GI protection (Protected Designation of Origin, or PDO) for Feta, arguing it was intrinsically linked to ancient Greek heritage and required specific sheep's and goat's milk from designated Greek regions. The European Court of Justice (ECJ) ultimately ruled in favor of Greece. The ECJ observed that despite its massive production in other Member States, the term had not lost its geographical connotation for the majority of European consumers. Crucially, the court noted that non-Greek producers frequently marketed their feta using highly evocative labels featuring Greek cultural traditions (such as windmills and Greek lettering), thereby implicitly acknowledging and free-riding on the term's true geographical origin.

Parmesan and Gruyère (US vs. EU): In the United States, relentless attempts by European consortia to enforce GIs have repeatedly struck an impenetrable wall of genericness. The US judicial system and the Trademark Trial and Appeal Board (TTAB) have consistently held that traditional European terms like "Gruyere" and "Parmesan" are unequivocally generic.[740] In a recent, highly publicized dispute over Gruyère, a US District Court ruled that contemporary American consumers understand Gruyère purely as a type of cheese characterized by its

[740] T. S. Ellis, *Interprofession du Gruyère* v. *United States Dairy Export Council*, US District Court for the Eastern District of Virginia (2021).

distinctive hole structure and nutty taste, regardless of whether it originates from Switzerland, France, or Wisconsin.[741] Consequently, Parmesan and Gruyere are denied all GI protections in the US. They are used freely by American dairy conglomerates, resulting in a direct, unresolvable conflict with the EU's strict PDO enforcement regimes.

Indian Context: Rasogolla and Kolhapuri Chappal India has faced its own highly nuanced domestic and international battles regarding genericness and cultural appropriation. The bitter inter-state conflict between West Bengal and Odisha over the "Rasogolla" is a prime example of how to manage widespread generic use through homonymous GIs.[742] Recognizing that the sweet possessed deep historical roots in both regions but exhibited markedly different physical and organoleptic characteristics, the GI Registry skillfully avoided complete genericization by granting separate, distinct tags for "Banglar Rasogolla" and "Odisha Rasagola". By prefixing the specific regional identifiers, the registry prevented the base term from falling entirely into the generic public domain while simultaneously preventing a monopolistic chokehold by a single state.

Internationally, the "Kolhapuri Chappal" faced a unique threat bordering on genericization and severe cultural appropriation.[743] When the global luxury fashion brand Prada showcased a premium summer collection heavily inspired by the traditional, handcrafted toe-loop design of the GI-tagged Kolhapuri Chappal, it raised profound concerns among IP scholars about the dilution of the GI into a generic, unprotected fashion style. While this did not constitute a direct trademark infringement because Prada did not explicitly use the protected name "Kolhapuri" in its branding, the unauthorized, uncompensated adaptation of the traditional design by a global powerhouse illustrated a critical vulnerability. It demonstrated how unprotected traditional cultural expressions and intricate regional designs risk being forcefully assimilated into the generic global public domain, effectively bypassing the protections intended by the GI Act.

Dispute / Subject Matter	Jurisdictional Forum	Legal Outcome Regarding Genericness	Broader Implication
Feta (Denmark/Germany v. Greece)	European Court of Justice (ECJ)	Declared **Non-Generic**. Granted exclusive PDO status to Greece.	Established that foreign marketing that evokes the country of origin defeats claims of genericness.
Gruyere / Parmesan (EU Consortia v. US Dairy)	US District Courts / TTAB	Declared **Generic** in the US. No GI protection granted.	Consumer perception in the target market overrides historical European *terroir* claims.
Rasogolla / Rasagola (Bengal v. Odisha)	Indian GI Registry	Homonymous GIs are granted with regional prefixes.	Prevents complete genericization while avoiding interstate commercial

[741] *Ibid.*
[742] *Odisha Rasagola* v. *Banglar Rasogolla*, W.P.(C)-IPD 17/2021 (Del).
[743] Sajid Nissar Mir and Shaik Ishrath Sadiqua, "Kolhapuri Chappals on the Global Runway: Cultural Appropriation and Gaps of Intellectual Property Protection" *ACIPR Blog* (2025).

INDIAN JOURNAL OF LEGAL REVIEW [IJLR – IF SCORE – 7.58]

VOLUME 6 AND ISSUE 4 OF 2026

APIS – 3920 - 0001 *(and)* ISSN - 2583-2344

Published by

Institute of Legal Education

https://iledu.in

			monopolies.
Kolhapuri Chappal (Cultural Appropriation)	Extralegal / Public Discourse	Risk of design dilution into generic fashion trends.	Highlights gaps in the GI law regarding the protection of traditional design separate from the nomenclature.

1.5 Well-Known Trademarks and Their Conflict with GIs

Well-known trademarks represent a formidable, overarching exception to the standard limiting principles of trademark law, specifically the principles of strict territoriality and the rule of specialty (which usually limits trademark protection only to the specific class of goods registered). Regulated internationally under Article 16.3 of the TRIPS Agreement and Article 6bis of the Paris Convention, and domesticated under Section 11(6) of the Indian Trade Marks Act, 1999, a well-known mark is granted enhanced, cross-class protection owing to its massive, widespread reputation, goodwill, and instant recognition among the relevant public.

A significant and highly complex conflict arises when a newly proposed geographical indication conflicts with a pre-existing, internationally recognized, well-known trademark. Because well-known marks transcend traditional geographical boundaries and easily jump across classes of goods, their corporate proprietors frequently argue that the state registration of a new GI containing the well-known mark, even for an entirely different category of goods or agricultural produce, would inevitably dilute the brand's unique distinctiveness or unfairly free-ride on its heavily capitalized reputation.

The prevailing international legal consensus holds that a well-known trademark has the legal capacity to successfully block the registration of a subsequent geographical indication. TRIPS negotiations and subsequent WTO dispute settlement mechanisms have shown that the exclusivity rights of a well-known mark often prevail in such asymmetrical disputes. The statutory rationale dictates that if a geographical term is already intrinsically and overwhelmingly associated with a well-known corporate brand in the minds of the consuming public, granting a GI to a local community could severely deceive consumers about the product's commercial origin. In such scenarios, the prior right of the well-known mark, established through extensive duration, broad geographic use, and substantial, sustained advertising expenditure, overrides the collective regional claim. This stringent application of trademark superiority effectively stunts the emergence of new, legitimate GIs if their regional names accidentally overlap with global mega-brands, prioritizing corporate commercial investments over regional heritage.

1.6 Passing Off Actions at the Intersection of Trademark and GI

While statutory infringement under Section 22 of the Indian GI Act provides robust, codified remedies for registered GIs, the legislation explicitly acknowledges that registration is not the sole avenue for legal protection. Section 20(2) of the GI Act expressly preserves the common-law right to initiate an action for "passing off". Passing off is a deeply rooted tort grounded in equity, designed to prevent one trader from misrepresenting their goods or services as being those of another, thereby misappropriating established goodwill and deceiving the public.

To succeed in a passing off claim involving a geographical indication, the plaintiff must satisfy the requirements of the "classic trinity" of passing off jurisprudence: (1) establish that the geographical indication possesses substantial reputation and goodwill in the relevant market;

(2) demonstrate a clear misrepresentation by the defendant (whether intentional or unintentional) that deceives the public into believing their goods originate from the genuine, protected GI region; and (3) prove actual or probable commercial damage to the collective goodwill of the legitimate regional producers. The passing off remedy is particularly critical in the IP ecosystem because it extends vital protection to unregistered GIs that have acquired a strong market reputation, and it supplements statutory rights in complex, borderline cases where the rigid parameters of infringement may not be met.

The Scotch Whisky Precedent Decades before the formal enactment of the Indian GI Act, the Bombay High Court's definitive ruling in *Scotch Whisky Association* v. *Pravara Sahakari Shakar Karkhana Ltd.* (1991) established the robust foundation for GI passing off in India.[744] The defendant, a domestic Indian distillery, was aggressively marketing its local whisky using deceptive labels such as "Blended with Scotch" alongside evocative imagery of a Scottish drummer in a kilt. The court granted a sweeping injunction, ruling that the defendant was deliberately and colorably imitating the goodwill of "Scotch Whisky" to gain unequal commercial benefits, thereby deceiving the average consumer of imperfect recollection. This landmark judgment firmly established that Indian courts possessed the inherent equitable jurisdiction to uphold passing off claims to protect geographical origin claims and international heritage, effectively safeguarding foreign GIs long before *sui generis* statutory regimes were institutionalized.

The Darjeeling Lounge Case. The structural limits and boundaries of passing off in the context of GIs were thoroughly tested in the landmark case of *Tea Board, India* v. *ITC Limited*, the first major litigation involving the infringement of a registered GI in India.[745] The Tea Board, the statutory proprietors of the "Darjeeling" GI and associated certification trademarks for tea, sued the massive ITC conglomerate for operating an exclusive executive hotel refreshment area named the "Darjeeling Lounge".

The Calcutta High Court decisively dismissed the Tea Board's suit. In its sophisticated legal reasoning, the court emphasized that the GI Act's protection is strictly confined to "goods" and cannot be stretched to cover commercial "services" such as hospitality. Regarding the passing off claim, the court held that there was no competitive "nexus" or commercial overlap between a high-end luxury hotel lounge and the agricultural tea industry. Furthermore, the court noted that the term "Darjeeling" had been widely used across various unrelated commercial sectors for decades before the GI registration. Therefore, ITC's use of the name for a lounge did not constitute a misrepresentation likely to cause consumer confusion, nor did it unfairly exploit or dilute the Tea Board's specific goodwill in tea cultivation.

This ruling delineated a crucial jurisprudential boundary: while passing off is a powerful tool for protecting the geographical authenticity of goods, a GI proprietor cannot weaponize it to claim an absolute, cross-category monopoly over a geographical name in entirely unrelated service sectors.

1.7 Biopiracy and Misappropriation of Indian GI Names Abroad

1.7.1 Concept of Biopiracy

Biopiracy refers to the unethical, predatory, and often highly legalized appropriation of traditional knowledge, indigenous biodiversity, and regional agricultural heritage by foreign corporate entities, typically carried out through mechanisms of the global intellectual property system.[746] Developing nations, which are deeply endowed with natural resources and millennia of traditional manufacturing and agricultural practices, are particularly vulnerable to this

[744] *Scotch Whisky Association* v. *Pravara Sahakar Shakar Karkhana Ltd.*, AIR 1992 Bom 294.
[745] *Tea Board, India* v. *ITC Limited*, 2011 (48) PTC 169 (Cal).
[746] Action Group on Erosion, Technology and Concentration (ETC Group) definition of Biopiracy.

phenomenon. Multinational corporations located in the Global North routinely exploit structural asymmetries in international IP law, specifically by leveraging loopholes in Western patent and trademark systems, to claim exclusive proprietary rights over plants, seeds, medicinal practices, and regional names that have been freely cultivated and utilized by indigenous communities for centuries.

In the specific context of geographical indications, biopiracy effectively manifests as cultural "identity theft." It occurs when foreign commercial entities register well-known geographic appellations as private trademarks in their home countries or patent naturally occurring biological resources that are intricately tied to those appellations. This systemic misappropriation forces traditional farmers and rural artisans to compete unfairly against heavily subsidized, synthetically developed corporate imitations in the international market. Consequently, this dilutes the region's authentic brand equity, misleads global consumers, and effectively bars legitimate indigenous producers from exporting their heritage products to Western markets under their rightful names.

1.7.2 Notable International Instances Involving India

India's exceptionally rich repository of traditional agricultural products has frequently been the target of high-profile biopiracy and international misappropriation, forcing the nation into expensive, reactive legal battles in foreign jurisdictions to reclaim its geographical indications.

The Basmati Rice Dispute (RiceTec): The most egregious and globally publicized instance of biopiracy involving Indian agricultural heritage. Basmati is a slender, aromatic, long-grain rice historically cultivated under specific agro-climatic conditions in the Indo-Gangetic plains at the foothills of the Himalayas in India and Pakistan. In 1997, a Texas-based corporation, RiceTec Inc., was controversially granted Patent No. 5,663,484 by the US Patent and Trademark Office (USPTO) for "basmati rice lines and grains".[747] RiceTec audaciously claimed to have "invented" a novel rice variety by crossbreeding traditional Basmati germplasm with American long-grain rice, intending to monopolize the market under proprietary names such as "Kasmati" and "Texmati" while simultaneously asserting rights to the generic term "basmati".

The patent claims were excessively broad, attempting to legally monopolize physical and aromatic characteristics that were inherently natural to traditional South Asian Basmati. Recognizing the catastrophic threat to millions of farmers, the Indian government, alongside prominent civil society organizations and scientists, launched a vigorous legal challenge at the USPTO. India presented extensive scientific evidence, sophisticated DNA analysis, and historical documentation proving that the traits claimed by RiceTec as novel inventions were, in fact, identical to the traditional varieties cultivated by Indian farmers for generations (prior art). Faced with incontrovertible scientific prior art, RiceTec was ultimately forced to withdraw the vast majority of its claims, specifically those concerning the broad characteristics of the rice, retaining only a highly narrow patent on its specific, newly developed hybrid strains.

While the revocation was celebrated as a victory against biopiracy, the dispute exposed severe national vulnerabilities. Because India lacked a robust domestic GI legislative framework at the time, it struggled immensely to assert absolute international rights under TRIPS. The US Federal Trade Commission subsequently exacerbated the issue by ruling that "Basmati" was merely a generic term for aromatic rice in the US, highlighting the devastating economic consequences of delayed domestic IP legislation.

Darjeeling Tea Misappropriation

"Darjeeling Tea," officially India's premier and first registered GI, has faced relentless global

[747] RiceTec Inc., US Patent No. 5,663,484.

trademark misappropriation and brand dilution. Foreign corporations in diverse jurisdictions such as France, Japan, and the United States have repeatedly attempted to register "Darjeeling" as a private trademark for entirely unrelated goods, including perfumes, clothing, and lingerie, or to sell counterfeit tea blends. For example, the Tea Board of India had to actively intervene and successfully oppose a trademark application by the French company *Comptoir des Parfums*, forcing the company to amend its application to ensure that the goods actually contained authentic Darjeeling tea or had its genuine scent.

Furthermore, in protracted disputes like the one against *Delta Lingerie* in the European Union (Case T-624/13), the Tea Board fought intensely against the registration of the word "Darjeeling" for apparel and telecommunication services, aiming to prevent the dilution, trivialization, and vulgarization of the GI's elite global reputation.[748] These frequent international skirmishes underscore the need for perpetual vigilance, robust legal strategies, and immense financial resources for state bodies to enforce GI rights against bad-faith trademark registrations abroad.

1.8 Critical Analysis of Section 25 of the GI Act: Prohibition of Registration of GI as Trademark

The Geographical Indications of Goods (Registration and Protection) Act, 1999, was enacted primarily to fulfill India's mandatory multilateral obligations under the TRIPS Agreement and to establish a proactive, defensive legal architecture to shield its regional heritage from relentless international biopiracy. The absolute cornerstone of this defensive framework is Section 25, which explicitly prohibits the registration of a geographical indication as a trademark. The underlying legislative intent of this provision is unequivocal: to categorically prevent the unilateral appropriation of collective, public property by private corporate entities. By doing so, the statute aims to avert market confusion, preserve regional cultural identity, and protect the vital socio-economic interests of traditional artisan and farming communities.

Despite its inherently noble objectives and its success in establishing a baseline of legal protection, a critical scholarly analysis of Section 25 and the broader operational mechanics of the GI Act reveals significant systemic failures. These failures create a pronounced gap between the law's theoretical promise and its practical socio-economic performance.

First, the effectiveness of Section 25 is heavily compromised by the statute's highly ambiguous conceptualization of genericide. Section 9, which must be read in direct conjunction with the prohibitions in Section 25, forbids the registration of generic names but relies on excessively broad and potentially harmful criteria. Unlike strict European legal interpretations that focus almost exclusively on consumer perception in the country of origin, the Indian framework controversially requires assessing a term's generic status based on its usage in export markets or "areas of consumption". By legally entertaining the possibility that a traditional Indian product name might be deemed generic simply because a foreign market heavily misuses it, the Indian legislature inadvertently weakened the absolute protection of indigenous goods. This self-inflicted "area of consumption" clause leaves traditional Indian GIs perpetually vulnerable to the exact type of systematic exploitation and biopiracy perpetrated by multinational corporations during the Basmati crisis.

Second, the structural enforcement mechanism surrounding the Section 25 prohibition is deeply flawed and disconnected from ground realities. The prohibition operates essentially as a negative right; it effectively prevents the usurpation of the name through trademark registration. Still, it does not inherently guarantee positive economic uplift for the

[748] *The Tea Board* v. *OHIM — Delta Lingerie (Darjeeling)*, Case T-624/13 (General Court of the European Union, 2015).

actual producers. The Act allows "registered proprietors" (which are frequently state agencies, government boards, or well-meaning non-governmental organizations) to legally secure the GI. However, the standard of proof required by the registry to demonstrate that these bodies adequately represent the intricate interests of the actual artisans is exceedingly low. Consequently, the true beneficiaries, the rural artisans and farmers, are frequently alienated from the administration, commercialization, and enforcement of the GI.

Furthermore, there is a glaring absence of robust, decentralized post-registration quality-control mechanisms in the Act. Without mandated statutory liabilities for inspection bodies or strict supply-chain integrity protocols, merely prohibiting trademark registration under Section 25 results in a hollow victory. In the absence of stringent quality assurance, the domestic market quickly becomes flooded with sub-standard goods bearing the legitimate GI tag, which actively dilutes consumer trust and collapses the premium pricing model the Act was meant to foster.

Finally, the institutional adjudicatory framework required to resolve the highly complex conflicts arising under Section 25 has been severely undermined by recent legislative actions. The abolition of the Intellectual Property Appellate Board (IPAB) under the Tribunal Reforms Act, 2021, has thrust a highly specialized category of GI trademark disputes back into the general dockets of overburdened High Courts and Commercial Courts.[749] The resulting massive judicial backlog effectively deprives financially constrained producer communities of swift, cost-effective, and specialized legal redress, rendering the robust statutory prohibitions of Section 25 practically inaccessible for the rural artisans the Act was specifically designed to protect.

In the final synthesis, while Section 25 of the GI Act provides a vital, foundational statutory shield against the corporatization of public geographical assets, it is functionally incomplete. The glaring lack of mandatory quality governance, the fundamentally flawed statutory definition of genericide, and an eroded, inaccessible adjudicatory infrastructure severely restrict the Indian GI regime. Until these structural deficiencies are rectified, the Act will struggle to transcend its current status as a mere defensive legal tool and fulfill its ultimate mandate of functioning as a true engine for rural socio-economic empowerment and traditional heritage preservation.

BIBLIOGRAPHY

Statutes and Legislations

- **The Geographical Indications of Goods (Registration and Protection) Act, 1999** (India).
- **The Trade Marks Act, 1999** (India).
- **The Tribunal Reforms Act, 2021** (India).

International Agreements and Conventions

- **Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement)**, World Trade Organization.
- **Paris Convention for the Protection of Industrial Property**.

Table of Cases and Administrative Disputes

- *Scotch Whisky Association v. Pravara Sahakari Shakar Karkhana Ltd.* (1991), Bombay High Court.
- *Tea Board, India v. ITC Limited* (The Darjeeling Lounge Case), Calcutta High Court.
- *Feta Cheese Dispute (Denmark/Germany v. Greece)*, European Court of Justice (ECJ).
- *Gruyère and Parmesan Disputes (EU Consortia v. US Dairy)*, US District Courts / Trademark Trial and Appeal Board (TTAB).
- *Basmati Rice Dispute (India v. RiceTec Inc.)*, United States Patent and Trademark Office (USPTO).

[749] The Tribunal Reforms Act, 2021 (Act 33 of 2021).

- *Tea Board of India v. Delta Lingerie* (Case T624/13), European Union.
- *Tea Board of India v. Comptoir des Parfums*, France.
- *Rasogolla / Rasagola Dispute (West Bengal v. Odisha)*, Indian GI Registry.

Other Referenced Intellectual Property Disputes

- *Cognac v. Cognapea*, French National Institute of Industrial Property (INPI).
- *Saint-Emilion v. Saint Emilliard*, French National Institute of Industrial Property (INPI).
- *Prada's unauthorized use of the Kolhapuri Chappal design.*