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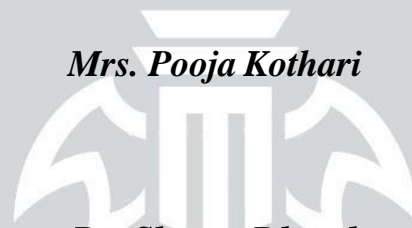
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# **CONFLICTS BETWEEN TRADEMARKS AND GEOGRAPHICAL INDICATIONS IN PRODUCTS**

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## **1. ABSTRACT:**

*The relationship between the Intellectual Property Rights is always tug-of-war proven tempestuous when we delve into the relationship between Trademarks and Geographical Indications in goods and services. This article proposes to highlight the key relationship and conflicts between Trademark and Geographical Indications in different regions and the approaches of WIPO in regards to and their possible solution for consideration, also this article limits its scope to focus on the geographical indication as well posits how far Geographical Indication uplifts the people in its real scenario.*

## **2. INTRODUCTION:**

In harmonizing globalization, countries across move transnational borders in expanding their brand from the local traditional market toward the broader international market which adds up to the quality of products globally giving more choices to their consumers at large. In order to sustain itself in the global market, the new innovations are mandated according to the trends and market needs. Where Intellectual Property Rights law plays a major role in indicating the products and property rights.

The Intellectual Property Rights are governed by the World Intellectual Property Rights and TRIPS Agreement based on the International Conventions. Trademarks and Geographical Indications a part of Intellectual Property are legal devices that regulate the communication to markets about a concerned product.

Accordance to the WIPO, the Trademark refers to the commercial origin of a good whereas Geographical Indication refers to the geographical origin of a good. While both are legally

enforceable with exclusive rights towards the use of certain words or symbols, the conflict tension arises when both overlap on the same subject matter.<sup>1</sup> Both Trademark and Geographical Indication holds valuable to providence that indicates the source and quality of a particular product<sup>2</sup>, that promotes a particular geographical region that can be eligible for the enforceability in disputes on infringement or on an unfair trade competition.

The purpose of this article proposes to analyze the relationship between the Trademarks and Geographical Indications that focus on the synergies and possible conflicts that arise in the international market in regard to their similarities and key differences.

### **3. INTERNATIONAL LEGAL FRAMEWORK FOR THE PROTECTION OF GEOGRAPHICAL INDICATIONS AND TRADEMARKS:**

The Paris Convention was the first international legal framework that was initiated towards granting the protection for Geographical indications that arise from a particular geographical origin of place or region as well afforded the protection on the appellations of origin of such geographical indicators in goods and products. Such protection doesn't guarantee the quality or characteristics of a particular Geographical Indication but fulfills the requisites for promoting and conveying to the consumers the product or good's appellation of origin.<sup>3</sup>

Similar to the Paris Convention, a concept was made in the *Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods, of 1891 (the Madrid Agreement)*<sup>4</sup> such agreement focus on the deceptive similarity in the name of two different places in two different countries while the product or good belongs to or associated to one particular state or region.

The Lisbon Agreement is a multilateral agreement addressing the quality and characteristics of a particular product or good that are associated with the appellations of origin and its geographical environment.<sup>5</sup>

Bilateral Agreements signed among various countries worldwide towards the protection of Geographical Indications add to the existing Geographical Indication and are stipulated in national legislative instruments.

National regulations are amended in reference to the needs and requisites of the particular nation in

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<sup>1</sup> 3 DEV GANGJEE, "QUIBBLING SIBLINGS: CONFLICTS BETWEEN TRADEMARKS AND GEOGRAPHICAL INDICATIONS" 82 (2007) CHI.-KENT L. REV. AT 1255.

<sup>2</sup> SRIVASTAVA, S. C. (2003). GEOGRAPHICAL INDICATIONS AND LEGAL FRAMEWORK IN INDIA. *ECONOMIC AND POLITICAL WEEKLY*, 38(38), 4022–4033. <http://www.jstor.org/stable/4414050>

<sup>3</sup> PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY of March 20, 1883 (revised on later occasions)

<sup>4</sup> 2 EC, 2007, P 3-4

<sup>5</sup> LISBON AGREEMENT Art 2(1). Examples of appellations of origin include "Bordeaux", "Tequila" and "Jaffa". See WIPO, 2000, p 6.

addition to the international regulations in their domestic legal instruments that are predominantly focused and drafted in regard to the Articles of the TRIPS Agreement. Where some countries like India, European Union, and China follow the sui generis system, and others like the USA, Canada, and Japan follow the IGOs in the form of Trademark Law.

#### **4. TRIPS AGREEMENT ON TRADEMARKS AND GEOGRAPHICAL INDICATIONS:**

Trademarks are signs that are used to distinguish their brand entity in goods and services that are protected under *The Paris Convention for the Protection of Industrial Property of 1883*, in the *Trade-Related Aspects of Intellectual Property Rights of 1994* (TRIPS Agreement)<sup>6</sup> under the article 15.1. Such distinguishment may be inherent or acquired distinguishment in regard to the case-by-case basis by the registration authorities in the protection of trademarks.<sup>7</sup> The trademarks can be acquired through registration, through use, or through well-known marks. When there exists a conflict between the rivals of a trademark claims the prior right user in time prevails.

Regarding the Geographical Indication, such are protected under the national and regional various principles protected under the indications of source and appellations based on origin, registered GI, Trademark law, and unfair competition or passing-off. The 'indication of source' refers to the geographical origin of the product, whereas the 'appellation of origin' refers to the geographical name of the place which designates the geographical environment that includes the natural and human factors. The TRIPS Agreement under Article 22.1 defines the geographical indication and appellation of origin.

Towards the difference between the Trademark and Geographical Indications, the goods distinguish in reference to the place they were made inherent to territorial geographical indications and don't refer to the manufacturing source while the Trademark is chosen arbitrarily. Since the Geographical Indication is authorized to the particular territory of the place, any unauthorized use of any famous geographical indication becomes an unfair competition and is detrimental to the reputation of such GI product at a national or international level. There are international treaties and agreements towards the protection of Geographical Indication adherence to the multilateral agreements.

Similarly, concerning the trademark, the collective marks, and the certification marks that are owned by the public entity are complying its quality standards and production indicates the particular goods on which they have used hold particular characteristics relating to the specific

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<sup>6</sup>WTO, TRIPS, Available at: <[https://www.wto.org/english/tratop\\_e/trips\\_e/trips\\_e.htm](https://www.wto.org/english/tratop_e/trips_e/trips_e.htm)>

<sup>7</sup>WIPO. 2000. STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS. [online] Available at: <[https://www.wipo.int/mdocs/sct/sct\\_5/sct\\_5\\_3/](https://www.wipo.int/mdocs/sct/sct_5/sct_5_3/)> [Accessed 18 April 2022].

geographical indications.

Once the geographical indication is associated with a collective or certification mark, in such cases any disputes can be enforced under the rules of trademark law. Unauthorized use of a protected geographical indication in regard to the appellation of origin is an offense and engages the criminal and civil proceedings on such unauthorized use of GI mark in their goods.

Geographical Indications and their protection are a challenging task as in some cases generic Geographical Indications as in cases like 'French fries', 'Bermuda Shorts', 'Danish Pastry' whereas the term 'Champagne', 'Burgundy', 'Chablis' are semi-generic while some terms like 'Feta' are still under debate for its GI protection.<sup>8</sup>

## **5. THE PROTECTION OF TRADEMARK AND GEOGRAPHICAL INDICATION IN EUROPE:**

The Geographical Indication guarantees a reputation on the quality of a product that adheres to the particular soil, climate, or traditions or any techniques or traditional knowledge of indigenous people. In European Union posits the regulations on the *Quality Schemes for Agricultural products and Foodstuffs* under Article 5.1 of European Union Regulation and Article 5.2 defines the *Geographical Indication* that signifies the quality, reputation, and other characteristics that are associated with the geographical origin and their production steps that take place only in such geographical area.<sup>9</sup> Concerns about the production of wine products such distinction between PDOs and PGIs are regulated under Article 93 of EU Regulation.<sup>10</sup>

The EU legislation holds on the *sui generis regime of protection* for each foodstuff, in their agricultural products, and in the production of wines and spirits with GI protection recognized internationally that adds to their country's economic value. The Country gives equal *sui generis* regimes that are strong and fragmented protection to Trademark as well as Geographical Indications at the community level. The Trademark is protected under the EU Trademark Law. The main objective of the grant of EU Trademark is to defend the balance occurring between the national laws and the EU Trademark System.

## **6. THE PROTECTION OF GEOGRAPHICAL INDICATION UNDER THE TRADEMARK SYSTEM IN INDONESIA:**

<sup>8</sup>MAS RAHMAH (2015) PROTECTION OF GEOGRAPHICAL INDICATION UNDER TRADEMARK SYSTEM: TO FIT THE SQUARE INTO THE TRIANGLE? MIMBAR HUKUM, 27 (3). pp. 536-552. ISSN 2443-0994

<sup>9</sup>EU REG. N. 1151/2012, available at <http://eur-lex.europa.eu/legal-content>

<sup>10</sup>Article 93, EU Reg. 1308/2013,

<https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32013R1308>

Indonesia holds many Geographical Indication unique products with high quality and holds a remarkable well-known reputation. To comply with the TRIPs Agreement, Geographical Indication is protected under Trademark Law in Indonesia to some limited extent though not in stringent capacity due to its insufficiency in Indonesia Trademark Law. To support this lacuna, the sui generis law holds in hand to protect the Geographical Indications during its 'GI theft' and infringements.<sup>11</sup> While Indonesia holds a well-known reputation for Toraja Coffee, Gayo, Java cocoa, etc. GI thefts and infringements occurred when registered in Japan by Japan's Key Coffee for *ToarcoToraja* as a trademark and for *TorayakiToraja* as a registered Trademark for seafood snacks that belong to the Geographical Indications of Indonesia.

Similarly, the GI of Indonesia – *Gayo* was registered in the Netherlands as Trademark for Holland Coffee B.V.<sup>12</sup>

Another case was when the “*JAVA*” software was created by a Java Cocoa lover who named it after his love and inspiration the Java cocoa.

Though Indonesia holds the GI's well-known reputation towards their brands could not protest against such GI thefts due to the un-registration of such names neither in Geographical Indication nor in Trademark. According to the Indonesia Trademark Law, generic names cannot be protected under the Trademark Law as it is part of the public domain.<sup>13</sup>

## 7. THE CONFLICT BETWEEN TRADEMARK AND GEOGRAPHICAL INDICATIONS IN AUSTRALIA:

To combat the overlap and the potential conflict on trademarks and the Geographical Indications in Australia, they enacted legislation under the obligations and amendments under the *Agreement between Australia and the European Community on Trade in Wine, and Protocol* ('*Trade in Wine Treaty*') as *Australian Wine and Brandy Corporation Act 1980*<sup>14</sup> which was primarily aimed to protect the European Geographical indications in Australia, it was recommended and mandated for Australia to register officially in the *Trade in Wine Treaty*.<sup>15</sup> This treaty laid down the overlap between the Trademark and the Geographical Indications and their possible conflicts.

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<sup>11</sup>MAS RAHMAH (2015) PROTECTION OF GEOGRAPHICAL INDICATION UNDER TRADEMARK SYSTEM : TO FIT THE SQUARE INTO THE TRIANGLE? MIMBAR HUKUM, 27 (3). pp. 536-552. ISSN 2443-0994

<sup>12</sup> THE JAKARTA POST, “DUTCH COMPANY CLAIMS INTERNATIONAL TRADE RIGHTS OVER GAYO COFFEE”, 11 FEBRUARY 2008.

<sup>13</sup> ARTICLE 5 ITL

<sup>14</sup>AUSTRALIAN WINE AND BRANDY CORPORATION AMENDMENT ACT 1993

<https://wipolex.wipo.int/fr/text/205095>

<sup>15</sup> STEPHEN STERN, ‘THE OVERLAP BETWEEN GEOGRAPHICAL INDICATIONS AND TRADEMARKS IN AUSTRALIA’, [https://law.unimelb.edu.au/\\_\\_data/assets/pdf\\_file/0020/1680005/Stern.pdf](https://law.unimelb.edu.au/__data/assets/pdf_file/0020/1680005/Stern.pdf)

## **8. CONFLICTS BETWEEN TRADEMARKS AND GEOGRAPHICAL INDICATIONS IN INDIA:**

While the Intellectual Property Rights adhere to the products on market, the conflicts between Trademarks and the Geographical Indications generally happen when someone especially product imitators try to register a Trademark on the geographical name which holds a significant legally entitled geographical identity associated with the product's distinctiveness by its secondary meaning.

In India, even though the infringement on the trademark and geographical indications are entertained for the enforceability but due to the absence of any specific legislation on the conflicts between Trademark and Geographical Indication in force, have applied the principles of passing off in order to protect the registered GI of India, but such protection is unavailable to unregistered GI in Indian laws.

The possible approaches to Intellectual Property are one in regard to the Geographical Indication's Sui generis protection regime and another focusing on Trademark laws of respective nations. When protected under the sui generis regime, its perception that Geographical Indications are associated with larger regional or national cultural heritage is predominantly considered to be superior when compared to the Individual private property in a trademark<sup>16</sup>.

While the Geographical Indication holds overprotection compared to the Trademark, the Trademark holds an approach of PET Principles – that are the priority, exclusivity, and territoriality. The foremost protection of Geographical Indication is that it holds the exclusive right to exclude the third parties from using and commercially exploiting it.

The three possible situations of conflict between the Trademark and Geographical Indications are when the priority date of registration or recognition occurs in the product.

The prior Geographical Indications and later Trademark based on the sui generis regime principle of priority principle, where the 'first in time' principle gives greater and strongest protection to the Geographical indications comparing the Trademark.

The second one is when the Trademark is registered Prior to the Geographical Indications, the Well-known marks play a vital role in the sui generis endorsement which might lead to non - registration of GI is governed under the TRIPS and WTO Dispute Settlement Body as witnessed in

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<sup>16</sup>GOEBEL, GROESCHL, "Learning to love my PET: the long road to resolving conflicts between trademarks and geographical indications", in Gangjee, "Research handbook on Intellectual Property and Geographical Indications", 2016

a dispute between US and Australia against the EU.<sup>17</sup>

## **9. CASES ON THE CONFLICTS BETWEEN TRADEMARK AND GEOGRAPHICAL INDICATIONS:**

### **9.1. Budweiser case:**

The classic case of Intellectual Property conflicts between Geographical Indications and Trademarks over a century-old case between American and Czech brewers of Budweiser beer who produce their own versions of 'Budweiser' beer who fought over the right to use the brand name 'Budweiser'.

The American and Bohemian brewers signed an agreement that Anheuser- Busch can market Budweiser in North -America while the Bohemian brewers can market in Europe until the dispute arose on the trademark, in Europe, it was litigation of protected Geographical Indication. The litigation over trademark and geographical indications are still ongoing since 1907 across the world in forty jurisdictions over 100 court cases.<sup>18</sup>

### **9.2. Case: Toscano vs Toscoro:<sup>19</sup>**

A landmark case of the EU General Court regarding the registration of EU Trademark Toscoro for olive-oil products to be revoked for its associated with sufficiently similar Geographical Indication Toscano olive oil that was misleading the consumers and the EU confirmed the likelihood of confusion that could occur in Trademark and Geographical Indications.

### **9.3. Torres Case:**

A trademark registered wines by Spanish firms, and acquired a noteworthy reputation worldwide, years later in Portugal a registered GI for wine that was explicitly produced in a geographical area Torres marketed 'Torres Vedras'. This exploited in two ways where the goodwill of the prior Spanish firm's wines quality was hindered by the low-priced Portuguese wines and market shares where consumers are confused with the other product to be produced by the Spanish Torres family. Here the prior well-known mark prevailed in prior registration of the trademark as the Spanish Torres family adhered to the quality of the product.

## **4. Scotch Whiskey Association Case:<sup>20</sup>**

The Scotch Whiskey Association a UK-based firm filed a case against Golden Bottling Limited

<sup>17</sup>See the Panel Report of march, 15, 2005, WT/DS174/R and of April, 20, 2005, WT/DS290/R

<sup>18</sup> Budweiser trademark dispute, [https://en.wikipedia.org/wiki/Budweiser\\_trademark\\_dispute](https://en.wikipedia.org/wiki/Budweiser_trademark_dispute)

<sup>19</sup>Mengozzi v. EUIPO, T- 510/15, available at [www.curia.eu](http://www.curia.eu).

<sup>20</sup>The Scotch Whisky Association vs Pravara Sahakar Shakar Karkhana, AIR 1992 Bom 294, 1992 (2) BomCR 219

regarding their 'Red Scot whiskey' which was misleading the consumer's impression that it was from Scotland. The court referred to the UK Scotch Whisky Act, 1988, and held that Scotch whisky is a GI in the UK, but it was unregistered in India so could not uphold GI in India.

## **10. WIPO'S STANDING COMMITTEE ON LAW OF TRADEMARKS, INDUSTRIAL DESIGNS, AND GIS:**

while dealing with the debates on conflicts between trademark and Geographical Indications observed that GIs are protected under the Trademark and unfair competition law and in regard to the registered Trademark who holds goodwill needs to be protected against the conflicting Geographical Indication.<sup>21</sup>

The protection of Geographical indication worldwide is solid business management that is associated with the competitive advantage adding more value to their product enhancing export opportunities and strengthening their GI brand.<sup>22</sup>

## **11. HOW FAR IS GEOGRAPHICAL INDICATION UPLIFTING THE PEOPLE:**

Opinions vary on the regulatory system that governs the Geographical Indications; the countries still debate whether the current protection of the Geographical Indication is efficient which was a hot debate topic in the Doha Development Round. The European Union has afforded and extended its improved sophisticated protection towards the Geographical Indication relating to the wines and spirits as well as the GI labeled goods in accordance with the TRIPS Agreement.

While the countries want to maintain the status quo, such extended protection may be made more efficient in ascertaining the protection will indirectly enhance the protection that facilitates the producers in their countries especially the developing countries to market across transnational borders.

When a debate on protection occurs on the Geographical Indication and Trademarks, it holds both the conflicts and synergies when on international trade as the Geographical Indication is collective IP mark whereas the Trademark is an individual mark though both serve a similar purpose of identification to their respective consumers their exclusivity and origin of such goods that prevents

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<sup>21</sup>WIPO. 2000. STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS, AND GEOGRAPHICAL INDICATIONS. [online] Available at: <[https://www.wipo.int/mdocs/sct/sct\\_5/sct\\_5\\_3](https://www.wipo.int/mdocs/sct/sct_5/sct_5_3)> [Accessed 18 April 2022].

<sup>22</sup> [https://www.wipo.int/geo\\_indications/en/faq\\_geographicalindications.html](https://www.wipo.int/geo_indications/en/faq_geographicalindications.html)

the unauthorized and unprivileged producers from using such unfair GI mark or trademark.<sup>23</sup>

Geographical Indications play a vital role in the international market for its dejurecondendo, where such are more transparent and reliable in the eyes of the consumers. While many countries believe the extended protection of Geographical Indications benefits as well as being more efficient evidentially it's still under debate on sustainability and on a multilateral level. Only when the Geographical Indication is accepted worldwide, more efficiency can be traced ensuring the added advantage of the protection of GI labels worldwide.<sup>24</sup>

## 12. CONCLUSION, RECOMMENDATIONS, AND SUGGESTIONS:

The protection of Geographical Indication demands a heavy structure and heavy costs with demanding communities of collective people producing a particular product maintaining its quality and characteristics that are being protected under the international regimes of Intellectual Property Rights. Such deserves extended protection when such Geographical Indication is promoted on transnational borders towards maintaining the quality standards and reputation of a particular region or country.

Since the existing Intellectual Property Laws depend on the Geographical Indication and Trademark Laws for any GI thefts and infringements. To overcome the lacunae and inadequacy towards the protection of Geographical Indication under the Trademark law regime, the sui generis may to a limited extent provide solutions perpetually. While protecting the GIs, it also requires stringent laws to prevent the Geographical Indication marks as their Trademark worldwide to prevent the misapprehension of its quality and brand amongst its legitimate consumers.

The article recommends from an Intellectual property Right that is indirectly affixed with the business and from such a business perspective, the Geographical Indications would demand mandated national legal parameters to protect the brand and the appellations of origin that are associated with their national boundaries and to satisfy their consumer perspective and expectations that are associated with their brand quality.

This article also suggests that since there is no comprehensive way of searching for all Geographical Indications that are officially registered worldwide, the Directory of IP Offices can be accessible on the WIPO website. Such a worldwide Geographical Indication Registry can be a

<sup>23</sup> LOUCKS, MELISSA A., "TRADEMARKS AND GEOGRAPHICAL INDICATIONS: CONFLICT OR COEXISTENCE?" (2012). Electronic Thesis and Dissertation Repository. 850. <https://ir.lib.uwo.ca/etd/85>,

<sup>24</sup> JOHAN FLODGRÉN, "GEOGRAPHICAL INDICATIONS AND TRADEMARKS: SYNERGIES AND CONFLICTS IN THE INTERNATIONAL MARKET", 2009, [https://www.origin-gi.com/wp-content/uploads/2010/02/johan\\_flodgren\\_essay.pdf](https://www.origin-gi.com/wp-content/uploads/2010/02/johan_flodgren_essay.pdf)

better option to avoid conflicts between the Trademarks and Geographical Indications in near future.

To conclude though, worldwide the acceptance of Geographical Indications have prevailed in branding when such are overlapped and conflict with the trademark better stringent laws might prevent the unauthorized use of the GI tagged labels and names in their trademark products which is otherwise misleading their consumer.

