

The background of the journal cover features a top-down view of a desk. On the left, a pair of black leather brogue shoes is partially visible. In the center, an open notebook with lined pages and a silver pen lies on a light-colored wooden surface. To the right, a black leather bag with a zipper is partially shown, and a black leather watch with a silver dial is placed on the desk. A large, semi-transparent white rectangular box is centered over the image, containing the journal's title and ISSN information.

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GEOGRAPHICAL INDICATIONS IN **INTERNATIONAL TRADE: LEGAL FRAMEWORK** **AND MARKET EXCLUSIVITY**

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1.1 Concept and Evolution of Geographical Indications

There is something instinctively appealing about the notion that a product is a product of a place. That a bottle of wine is not just wine, but is indistinguishably Champagne, its taste and character forged by the chalk soil of the Marne valley, the northerly climate, the mist that clings to the vineyards in October, and the collective experience of generations of winemaking that no hillside in California or outback in Australia can match. That a cup of tea carrying the name Darjeeling makes a promise to the drinker about altitude, terroir, and muscatel that no Assam or Kenyan leaf can honestly make. This intuition that place confers quality in ways that are neither accidental nor transferable is the foundational idea behind the legal concept of the geographical indication.¹ A geographical is a sign used on products that have a specific geographical origin and possess qualities, reputation or characteristics that are essentially attribute to that origin. The definition is deceptively simple, but it contains three distinct elements that courts and registries have spent considerable effort unpacking. First, there must be a geographical connection, i.e., a product must come from a particular geographical area, region, or territory. Secondly, there must be a qualitative or reputational connection, i.e., the product's qualitative characteristics must be fundamentally associated with that geographical origin, either because of natural factors such as soil composition, climate, altitude, rainfall, etc., or human factors such as traditional production techniques, artisanal expertise, reputation, etc. Finally, there has to be a mechanism to enforce this connection against anyone who would seek to use the geographical name improperly.²

¹ *Paris Convention for the Protection of Industrial Property* (adopted 20 March 1883); *Loi du 6 mai 1919 relative à la protection des appellations d'origine* (France) (law on the protection of appellations of origin).

² TRIPS Agreement, art 22(1); *Geographical Indications of Goods (Registration and Protection) Act 1999* s 2(1)(e).

The idea of protection of place-based product names, however, has much deeper historical roots than might be expected given its relatively late inclusion in modern IP law. The first formal schemes of GI protection emerged in Europe, and France, with its tradition of terroir in wine, was the first country to formally adopt the appellation d'origine contrôlée (AOC) system in 1919, driven by the need to protect Champagne and other wine regions from being exploited by local and foreign producers wanting to benefit from the well-known names of the regions, without being prepared to adhere to the quality and production standards that the name had come to represent.³ This system was later generalised and extended to other products. Portugal adopted protection schemes for Port wine and Madeira wines. Italy developed its denominazione di origine controllata system. Spain developed its denominación de origen system.

At the international level, protection of geographical indications was first afforded through the Paris Convention for the Protection of Industrial Property, 1883, which protected indications of source and appellations of origin as part of industrial property, and required member states to seize goods bearing false indications of source. Other obligations were added with the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, signed in 1891. The Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration, signed in 1958, established a more developed framework for the specific regime of appellation of origin, with an international register maintained by WIPO. Nevertheless, the Lisbon Agreement had few member states, with geographic coverage limited to Europe.⁴

The turning point for the internationalization of GI law was the conclusion of the TRIPS agreement in 1994. For the first time, geographical indications have been included in a universal and enforceable multilateral system, binding all 164 WTO member states. The inclusion of GI protection in the TRIPS agreement was a reflection of the underlying principle that particular geographic locations are responsible for product qualities that cannot be duplicated elsewhere, and since the

³ For the historical development of European GI systems, see Dwijen Rangnekar, *Geographical Indications: A Review of Proposals at the TRIPS Council* (UNCTAD-ICTSD 2003) 5–12.

⁴ *Paris Convention for the Protection of Industrial Property* (adopted 20 March 1883) arts 1(2), 10; *Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods* (adopted 14 April 1891); *Lisbon Agreement for the Protection of Appellations of Origin and their International Registration* (adopted 31 October 1958).

place is an important part of the product, those outside a particular region cannot be allowed to use the place name for promotional and product labeling purposes. The TRIPS provisions on geographical indications are a compromise between the European approach to strong, sui generis protection of geographical indications, on the one hand, and the Anglo-American approach of relying on trademark law and protection of consumer law in the case of misleading use of geographical indications, on the other, which has remained controversial to the present day.

It is also important to note that geographical indications must be distinguished from trademarks, with which they are most often, but wrongly, equated. A trademark is the private property of an individual or an enterprise. It is an exclusive right to use the name of the goods or services of a specific trader. A trademark is alienable, assignable, and licensable just like any other property. On the other hand, the rights to GI are based on public law. These rights are collective rights rather than individual rights. These rights are legitimate because of the relationship that exists between the product and the natural and human-made environment of a specific region. These rights are non-assignable and non-licensable, thus differentiating them from trademarks. Such community nature, however, is not merely a technical difference, but a reflection of a fundamentally different philosophy underlying ownership in IP, whereby certain types of knowledge and reputation are considered to belong to a region and its producers collectively, rather than to any individual owner thereof.

1.2 International Legal Framework: TRIPS, WIPO and WTO

The provisions relating to geographical indications under the TRIPS Agreement are contained in Articles 22 to 24 under Section 3 of Part II. These provisions have given rise to a two-tier system, which has been surrounded by much controversy since 1995, when the Agreement came into force.

Article 22.1 states:

“Geographical indications are defined as indications which identify a good as originating in the territory of a member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin. This definition is notable for its breadth: it requires only that a quality, reputation or other characteristic not the totality of the product's characteristics be essentially attributable to geographical origin. Reputation alone, even in the absence of demonstrable natural factors, is sufficient to ground a GI claim.⁵

The obligation, therefore, that is imposed on the members of the WTO through Article 22.2 is to ensure that legal means are established to prevent any use of any designation or presentation of a good that indicates or suggests a geographical origin other than the true place of origin in a manner that is liable to mislead the public, and to prevent any use that is an act of unfair competition within the meaning of Article 10bis of the Paris Convention. Moreover, Article 22.3 also obligates the members to refuse or invalidate the registration of a trademark that contains or consists of a geographical indication for goods that are not originating in the territory indicated, where such use is liable to mislead the public as to the true place of origin.⁶

The enhanced level of protection is found in Article 23, but this is only available for geographical indications for wines and spirits. Under Article 23.1, members are required to "provide the legal means to prevent the use of a GI identifying wines for wines not originating in the place indicated on the GI, or identifying spirits for spirits not originating in the place indicated on the GI, even where the true origin of the goods is indicated on the product, or where the geographical indication is used in translation or accompanied by words such as 'kind,' 'type,' 'style,' 'imitation,' or the like." The distinguishing factor for the level of protection afforded under Article 22 and 23 is that, while protection under Article 22 is only available if proof is shown that the public is misled, protection afforded under Article 23 is absolute protection, regardless of proof of consumer confusion.⁷

The reason why this higher level of protection is only given to wines and spirits has much more to do with historical interests and compromise than with any relevant matters of fact, and since the TRIPS Agreement came into force, there has been debate about the alignment of the level of protection. The issue is not, as one might expect, between developing and developed countries, but rather between the "Old World" wine-producing countries, led by the European Union, and the "New World" wine producers, including the United States, Australia, Canada, New Zealand, Argentina, and Chile,

⁵ *Agreement on Trade-Related Aspects of Intellectual Property Rights* (adopted 15 April 1994) Annex 1C, *Marrakesh Agreement Establishing the World Trade Organization* 1869 UNTS 299, art 22(1); World Trade Organization,

Overview of the TRIPS Agreement (WTO Secretariat, Geneva 2020).

⁶ *Agreement on Trade-Related Aspects of Intellectual Property Rights* (adopted 15 April 1994) Annex 1C, *Marrakesh Agreement Establishing the World Trade Organization* 1869 UNTS 299, arts 22(2), 22(3); *Paris Convention for the*

Protection of Industrial Property (adopted 20 March 1883) art 10bis.

⁷ TRIPS Agreement, art 23(1).

which use generic geographical indications that migrant communities took with them when they left Europe.⁸

Article 24 specifies a number of exceptions to the protection of GI's. Most importantly, Article 24.6 states that members are not required to protect a GI which has become generic, i.e., which has become the common name in the member's territory for the type of product to which the GI applies. The classic example of genericide is the use of the name "Cheddar" to refer to a type of cheese rather than specifically to cheese produced in Cheddar in Somerset. Article 24.5 protects existing trademark rights acquired in good faith. Article 24.4 protects the use of a GI by nationals who have continuously used the GI for at least ten years before 15 April 1994, or who used the GI in good faith before that date.⁹

The major controversy that is still pending resolution at the WTO regarding GIs revolves around two Doha Round negotiation issues. The first issue is the establishment of a multilateral register for wines and spirits under Article 23.4, and the second issue is the extension of the high level of protection provided for under Article 23 to products other than wines and spirits, and these two issues are as contentious as any other issue on the Doha Round negotiation agenda. The positions taken by the WTO, India, the European Union, Switzerland, and a coalition of developing countries are that extension is necessary, and this is because the two-tier system discriminates against GI products from developing countries, such as agricultural products, handicrafts, and textiles, that are produced in developing countries. The opposing positions, taken by the US, Australia, Canada, and New Zealand, are that the extension would deny the use of terms that have become generic to these countries and would, therefore, constitute a subsidy for European and developing country producers.¹⁰

1.3 GI Protection under Indian Law: The GI Act, 1999

India's decision to enact its Geographical Indications of Goods (Registration and Protection) Act, 1999, which came into force on 15 September 2003, was a direct response to its TRIPS obligations—but it was also a response to a practical and urgent

⁸ <https://digitalcommons.law.ggu.edu/cgi/viewcontent.cgi?article=1196&context=annlsurvey>

⁹ World Trade Organization, *Geographical Indications — Background and Current Situation* (WTO Secretariat 2011); Council for Trade-Related Aspects of Intellectual Property Rights, *Composite Text* WTO Doc TN/IP/W/12 (2011).

¹⁰ *Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications* (adopted 20 May 2015, entered into force 26 February 2020).

problem. Indeed, India is one of the most GI-rich countries in the world. Its agricultural diversity, its centuries-old traditions of artisanal production, its regional culinary identities, and its textile and handicraft heritage combine to represent an extraordinary portfolio of products linked to their geographic origin, which, in the absence of dedicated protection, was at risk of being misappropriated by domestic and foreign actors. India's rich cultural and agricultural diversity is reflected in its wide range of products protected under GI, such as Darjeeling Tea, Kashmiri Pashmina, Nagpur Orange, Mysore Silk, Basmati Rice, Banarasi Sari, etc. The GI system is intended not only to enhance the value of these products but also to protect them from misuse and counterfeiting, so that only authentic producers can use the name.

The GI Act follows a system of "sui generis" protection, which means a specially designed legal framework for geographical indications, without reference to trademark laws or consumer protection laws. The structure of the GI Act points to its communal nature. Section 2(1)(e) states, "Geographical Indication" means an indication which identifies a product as originating from, or manufactured in, the territory of a country, or a region or locality in that territory, where a quality, reputation, or other characteristic of the product is essentially due to its geographical environment, including natural and human factors."

The reference to natural and human factors points to a recognition that traditional skills and knowledge are just as important a part of geographical indications as natural environmental conditions.¹¹

Such a collective monopoly is created by the Act to prevent misuse or misappropriation of the GI by entities operating outside the region of legitimate use. The GI registry located at Chennai maintains the register of GI and provides exclusive rights to the registered proprietor and authorised users to use the GI in commerce. This is achieved by: making an application by an association of producers or any organisation representing the interest of producers; technical examination and publication of the application; and issuance of a certificate of registration.¹²

Another important element of the Act is the distinction between the registered proprietor and the authorised users. While the registered proprietor is a producers' association, a statutory body,

¹¹ *Geographical Indications of Goods (Registration and Protection) Act 1999* s 2(1)(e); *Geographical Indications of Goods (Registration and Protection) Rules 2002*.

¹² <https://www.taxtmi.com/article/detailed?id=15547>

or a government agency responsible for maintaining the integrity of the registration and protecting it against infringement by others, the authorised users are the actual producers who are entitled to use the registered GI in commerce. The Act has granted the exclusive right to use the registered GI in association with the specified goods to the authorised users, and various provisions are made for the redressal of the situation in the event of infringement of the rights of the registered proprietor.

However, a GI registered under the Act shall be valid for a period of ten years and shall be renewable indefinitely as long as the product continues to satisfy the registered specifications and the territorial indicator is maintained. Section 8 of the Act prohibits the registration of a GI which is generic, contrary to public order, or scandalous. Section 9 of the Act provides absolute grounds for refusal of a GI, which would likely to deceive or cause confusion, would comprise of scandalous matter, or would be contrary to any law. Section 22 of the Act prohibits infringement of a registered GI, and Section 25 of the Act specifically provides for the passing off of goods by a GI which misrepresents the geographical origin of the goods.¹³

The Act, since its coming into force, has overseen the growth of the portfolio of registered GI products in India. Currently, India boasts over 658 registered GI products, each representing the states and types, and hence the richness and craftsmanship of the country. The Legal School The Government of India has set an ambitious target of registering 10,000 GIs by 2030, indicating its strategic commitment to leveraging GI protection as an instrument of cultural preservation and export promotion.¹⁴

1.4 Market Exclusivity through GI Protection

The economic rationale behind the protection of GI is based on the ability of the registered GI to create a kind of market exclusivity, but not in the sense of granting a monopoly to one economic actor, but rather in the sense of granting an exclusive right to all economic actors in the region, which forbids other economic actors from outside the region from using the name. This kind of exclusivity has several economic effects.

¹³ *Geographical Indications of Goods (Registration and Protection) Act 1999* ss 8, 9, 22, 25.

¹⁴ Department for Promotion of Industry and Internal Trade, *Promotion of Geographical Indications in India* (Ministry of Commerce and Industry, Government of India 2023); Geographical Indications Registry, *Annual Statistics 2024–25* (Chennai 2025).

This is so because a product with a legally protected geographical name can command a certain level of trust and reliance on the part of the consumer. This eliminates the problem of information asymmetry between the consumer and the producer of differentiated quality products. Consumers who are willing to pay a premium for "Darjeeling Tea" on the assumption that the product is genuinely produced in the high-altitude region of Darjeeling are willing to pay a premium for the product. This premium is then available to the genuine producers of Darjeeling tea. Without the GI protection, the genuine producers of Darjeeling tea would see the premium being undermined by the free-riding of imitations of Darjeeling tea of lower quality being sold at the same price as the genuine article. This undermining of the premium is not just a matter of the producers losing out on the premium price of the product but is a problem of incentives that destroys the reputation of the product unless addressed.¹⁵

The second function is that of rural economic empowerment. The majority of the registered GI products in India are from the rural and economically disadvantaged sections, and they are the ones who would be affected most if the product they have been making and selling over the years becomes economically unviable. The function is presented as being related to rural development, premium pricing, counterfeiting, the preservation of traditional knowledge, and the preservation of heritage, and the enforcement is done through the courts and customs officials.

The GI tag helps the rural producers to gain premium pricing in the market, distinguishing their product from the cheaper and more easily produced counterfeit product.

Third, GI protection has a cultural preservation dimension. Many of India's most famous GI products, such as Banarasi saris, Kashmiri Pashmina, Kancheepuram silk, and Madhubani paintings, are directly associated with a tradition and a skill set, and these are threatened by the availability of cheaper machine-made alternatives. Thus, GI protection adds to the strategic importance of intellectual property protection in terms of economic development, rural empowerment, and cultural preservation, and helps communities to claim ownership of their heritage even while competing in a globalized world. The GI system, in a sense, provides a market-based solution to the problem of ensuring that the next generation of artisans does not abandon a tradition for more economically reliable alternatives.

¹⁵ P Narayanan, *Intellectual Property Law* (3rd edn, Eastern Law House 2001) ch 'Geographical Indications'.

Fourth, with respect to international trade, GI protection is a non-tariff trade tool. Products that bear a GI can be differentiated from other products, and this would allow the producers to enter markets that would otherwise be closed to them. Products such as India's Darjeeling Teas, Basmati Rices, Alphonso Mangoes, and coffees produced in Darjeeling and Nilgiri are high-value products that are sold at premium prices to major export markets such as Germany, Japan, the US, and the Gulf region because these products are associated with a quality standard that is embodied in the GI.¹⁶

However, the effectiveness of market exclusivity depends on the strength of the enforcing body behind the GI protection. In the case of the tea from the region, the Tea Board of India is the registered owner of the GI, but the lack of effective enforcement due to limitations in monitoring the global market acts against the interests of the community, as well as the GI Act, 1999. India's existing GI regime suffers from a structural gap, which is common to all developing countries' GI regimes. While it is correct to have a right under law, it is equally important to have an institutional infrastructure in place to make this right economically viable. In other words, it is not just having a right under law, but having an infrastructure of quality control, branding, export promotion, monitoring, and funding for litigation in place.¹⁷

1.5 Challenges in International Enforcement

Of all the aspects of GI law, the practical implementation of GI protection across borders is perhaps the most challenging, and in this arena, the limitations of the current TRIPS system are most acutely felt. Three areas of difficulty need to be highlighted: the genericide problem, the two-tier asymmetry in the TRIPS system, and the inherent limitations in the enforcement capacity of developing countries.

The genericization of a geographical name happens when a geographical name, after widespread and generally unopposed use for a significant time, becomes a generic name for a product rather than a product produced in a particular place. "Cheddar," for example, does not refer to a cheese produced in the town of Cheddar, England, but rather to a style of cheese produced everywhere in the world. "Champagne," though protected in the European Union, is

¹⁶ India Brand Equity Foundation, *Promotion of Geographical Indications in India* (IBEF Report 2023).

¹⁷ <https://www.suolaw.com/geographical-indication-gi-laws-in-india-and-its-implementation/>

also used to refer to a type of wine produced everywhere outside the EU. "Parmesan," though protected as a GI for the cheese known as Parmigiano-Reggiano, is also used to refer to a cheese that is produced everywhere in the world. GI tags help to prevent regional names from becoming generic terms that lack legal protection, such as "Cheddar" cheese, originally produced in the town of Cheddar, England, where this style of cheese was originally produced¹⁸. In the case of India, the threat of genericide is very real, as the case of "Basmati" is an example of the efforts being made to appropriate the product in the international market, and the case of the Basmati dispute with the United States involving RiceTec is the most vivid example in this regard.

The two-tier asymmetry in the TRIPS regime, which provides absolute protection to wines and spirits under Article 23, while only providing the lesser protection of Article 22 to other agricultural products, handicrafts, and foodstuffs, is an inherent unfairness in the TRIPS regime, which has a disproportionate negative effect on developing countries whose GI products are overwhelmingly in the latter category. In the case of a product like Darjeeling Tea, which must enjoy the same level of protection as Champagne in the international arena, in order to secure protection in other countries, the WTO member must show that the use of the "Darjeeling" name actually misleads the consumer, which is both legally and practically challenging, especially in countries in which the word has become genericized to connote high-quality tea rather than specifically tea from the Darjeeling region of West Bengal, India.

India, in conjunction with a coalition of developing countries, has been pressing in the Doha Round negotiations of the WTO the extension of the protection offered under Article 23 to products other than wines and spirits.¹⁹ Despite repeated rounds of negotiation, this extension has not been realized, and this is a reflection of the power imbalance in the WTO, with Old World countries that are exporters of GI products and New World countries, who do not want any extension of protection for GI, standing on opposite sides.

Infringement on foreign territory is the third issue that needs to be addressed. The territorial nature of GI rights is such that registration of a GI in India will give protection to the GI only on Indian territory. If the producers in India are to enforce the GI rights in foreign jurisdictions, they will have to either depend on the domestic laws of the foreign jurisdiction, which may or

¹⁸ <https://www.britannica.com/topic/geographical-indication>

¹⁹ <https://academic.oup.com/ejil/article/18/2/337/361981?login=false>

may not provide adequate protection to the GI, or use the provisions of the bilateral trade agreements that exist between the two countries and provide for clauses on GI rights, or go through the long and expensive process of registration in foreign jurisdictions. The experience of the Tea Board in Japan, where the Japanese had registered the name "Darjeeling" as a trademark, and the Tea Board had to institute proceedings for cancellation and invalidation of the registration at the Japan Patent Office, is an example of the problems and high cost of enforcing GI rights on foreign territory.²⁰

Another factor that is adding to the complexity of the enforcement problem is the emergence of electronic commerce and e-commerce websites. The sale of counterfeit GI labelled goods through electronic platforms is now an important problem, as the global nature of these platforms enables the seller to sell goods such as imitation Kashmiri Pashmina, counterfeit Banarasi Silk, or mislabelled Darjeeling Tea to consumers all over the world, without the GI holder being able to intervene in the sale before the goods are sold. It is extremely important to strengthen the enforcement of Section 25 of the GI Act, 1999, especially at international borders and electronic platforms, in order to avoid infringement, passing off, and the procurement of counterfeit GI labelled goods. In the context of the increased importance of electronic platforms, the control over electronic platforms must be increased in order to ensure that they are consistent with the standards set by GI and the goods are genuine.

1.6 Case Studies

1.6.1 Darjeeling Tea: India's First GI and Its Enforcement Journey

The Darjeeling Tea has a unique place in the history of GI law in India, as it was the first product to be registered under the Geographical Indications of Goods (Registration and Protection) Act, 1999, and obtained its GI status in 2004-05 and has registration numbers 1 and 2 in the Geographical Indications Registry. The Darjeeling tea is grown in the hill areas of West Bengal, Darjeeling District. The unique taste and flavor are due to geographical features such as altitude, rainfall, sunshine, and mist. The soil has minerals, and the hill slopes act as a drain, providing a unique quality to the tea grown in Darjeeling, making it one of the most demanded teas in the world. Darjeeling tea is grown in 86 tea gardens, spreading over 19,000 hectares, and produces 10,000 tonnes per annum, out of which 70 percent is exported.²¹

²⁰ World Intellectual Property Organization, *Protecting the Geographical Indication for Darjeeling Tea — Case Study in Managing the Challenges of WTO Participation* (WIPO, Geneva 2004).

The primary export markets for premium first and second flush Darjeeling tea are Germany, Japan, the United States, and the United Kingdom.

The history of legal and commercial protection of Darjeeling Tea is much older than the GI Act. The Tea Board of India, a statutory organization constituted under the Tea Act, 1953, had already registered the 'Darjeeling' word mark and logo as certification trademarks under the Trade and Merchandise Marks Act, 1958, and obtained registration in class 30 in 1986, and thereafter, the marks have been registered in many countries, including the United Kingdom, United States, Canada, Japan, and various countries in Europe, under the Madrid Agreement. The Tea Board had already employed the services of Compumark, a worldwide watch agency, to watch and report all unauthorized use and attempted registration of 'Darjeeling' marks around the world.²²

The most important GI litigation in India involving Darjeeling Tea is the case of Tea Board, India v. ITC Limited. This case produced significant jurisprudence on the extent of GI rights in India and is the first decision of an Indian court on the infringement of a GI. The Tea Board of India instituted a lawsuit against ITC Limited, a premier Indian conglomerate with luxury hotels around the world, for referring to a part of its hotel in Kolkata, the ITC Sonar Hotel, as the 'Darjeeling Lounge' and serving food and drinks including, but not limited to, Darjeeling tea.

The Division Bench of the Calcutta High Court, in its judgment dated 24 August 2011, confirmed the decision of the Single Judge, who refused to grant an interlocutory injunction. The plaintiff, who was the registered proprietor of certification trademarks and geographical indications for "DARJEELING" tea, was held not to have a right to prevent the defendant from using "DARJEELING LOUNGE" in its hotel business. The plaintiff was held not to have made out a prima facie case of infringement of its trademark or passing off. The judgment reiterates the limited rights conferred by certification trademarks and geographical indications, especially outside the certified goods category.²³

²¹ <https://csriprnusr1.wordpress.com/2021/09/05/geographical-indications-and-legal-framework-in-india-a-case-study-of-darjeeling-tea/>

²² Tea Act, 1953 (India), Section 4; Trade Marks Act, 1999 (India), Chapter VIII (Certification Trade Marks), Sections 69–78.

²³ <https://www.casemine.com/judgement/in/56e1005f607dba389660c7ef>

The last word in this case came in the judgment pronounced by Justice Sahidullah Munshi of the Calcutta High Court on 4th February 2019, when the suit filed by the Tea Board was dismissed in its entirety, with costs awarded to the plaintiff to the tune of Rs. 1,00,000, when the court observed: "The whole object of the GI Act is to add to the economic prosperity of producers of goods and promote goods bearing Indian Geographical Origin for export" and held that the use of "Darjeeling" to name a luxury hotel lounge, without any representation whatsoever regarding geographical origin, was entirely outside the scope of protection provided under the Act²⁴

The case has several implications, first and foremost being that GI rights in India only apply to goods, and there is no extension of rights in this regard to services, which could be a lacuna that needs to be addressed legislatively, especially in a more service-driven economy and where the reputation of GI names extends into areas other than goods. Secondly, there was a clear distinction made between rights under a certification trademark and rights under a regular trademark, making it clear that a holder of a certification trademark would not be able to plead infringement under Sections 28 and 29 of the Trade Marks Act, 1999. Finally, there was a clear indication that the court would be reluctant to broaden rights under GI, giving a monopoly to GI holders in the use of geographical names, which aligns with the philosophy behind GI rights. At the international level, the experience of the Tea Board in enforcing GIs in Japan, where Japanese companies had registered "Darjeeling" as a trademark before the Indian application for GI registration, is an example of the problems that can arise because of the lack of a multilateral system for the registration of GIs other than wines and spirits. The Board was forced to file separate actions for cancellation and non-use before the Japan Patent Office, with a measure of success, including a non-use cancellation action and a failure to invalidate a trademark for public order grounds.²⁵

1.6.2 Basmati Rice and the RiceTec Dispute

The Basmati dispute is arguably the most well-known case of India's GI enforcement globally and is arguably an apt example of how traditional Indian agricultural products can be subject to foreign business interests without adequate global protection.

²⁴ *Tea Board, India v ITC Limited* CS No 250 of 2010 (Calcutta High Court, 4 February 2019); *Tea Board, India v ITC Limited* (2011) 5 CHN 1 (Calcutta High Court, 24 August 2011).

²⁵ World Intellectual Property Organization, *Protecting the Geographical Indication for Darjeeling Tea*.

Basmati rice is known for its exceptional length, slender grain, fragrance, and taste. It has been cultivated for centuries in the Indo-Gangetic plains of northwestern India and the adjacent areas of Pakistan. Its exceptional characteristics can be attributed to its soil, climate, altitude, and traditional method of cultivation, which cannot be replicated anywhere else in the world. India and Pakistan have been cultivating Basmati rice in particular areas of Indian states like Haryana, Punjab, and Uttar Pradesh, and in the Punjab province of Pakistan.

The dispute began in the late 1990s, when the agricultural company RiceTec Inc., based in the state of Texas, USA, submitted patent applications to the United States Patent and Trademark Office (USPTO) asserting its rights over the varieties of rice with characteristics close to the traditional variety of Basmati, and sought to use the name "Basmati" to market them. The counter-response by the Indian side, through the Agricultural and Processed Food Products Export Development Authority (APEDA) and the Ministry of Commerce, consisted of challenging the patent applications before the USPTO, supported by the evidence that the distinct characteristics of the Basmati variety could not be separated from its geographical origin, and hence the name was a geographical indication.²⁶

In the end, the US courts ruled that the term "Basmati" could not be owned by RiceTec, as they realized the importance of the term "Basmati" to the Indian subcontinent. In 2016, the EU gave the GI status to Basmati rice, stating that only the rice produced in the Indian subcontinent, namely India and Pakistan, could be called "Basmati." While the efforts to give the GI status to Basmati rice are ultimately successful, they take considerable time and institutional efforts, which not all developing countries are in a position to undertake. The case of Basmati is an important example of the need for GI protection and the difficulties in its enforcement.

This was, in the end, a beneficial process, but it was a lengthy one, taking several years to complete, and one that demanded an institutional process and engagement with international law that not all developing countries' GI holders have the capacity for. In this sense, the Basmati case can be seen to highlight the significance of GI protection, but also the problems of enforcing it at an international level.

²⁶ *Geographical Indications of Goods (Registration and Protection) Act 1999*; Agricultural and Processed Food Products Export Development Authority, *Basmati GI Application*; H V Chandola, 'Basmati Rice: Geographical Indication or Mis-Indication' (2006) 9(2) *Journal of World Intellectual Property* 166.

1.6.3 Scotch Whisky: A Foreign GI before Indian Courts

The protection of foreign geographical indications under Indian law was directly tested in *Scotch Whisky Association v. Golden Bottling Limited*, (2006) 32 PTC 656, a decision of the Delhi High Court. The defendant was engaged in producing and selling whisky under the name "Red Scot." The defendant's whisky name was held to be misleading in its phonetic similarity to "Scotch," a registered geographical indication for whisky manufactured in Scotland, adhering to particular methods, matured for a minimum of three years in oak casks, and having a minimum alcoholic strength of 40 per cent when bottled.

The Delhi High Court passed a permanent injunction, and its ruling was that even phonetic similarity to a "recognized geographical indication" was sufficient to constitute "misleading use" under Section 22 of the GI Act and Section 9 of the Trade Marks Act, 1999. The rationale for this ruling was consistent with the established principle that GI protection in India was not limited to a literal reproduction of the protected name, and that phonetic or structural similarity to a GI, if sufficient to cause confusion among consumers regarding the geographical origin of the product, was also actionable. The case is significant as a precedent for the protection of well-known foreign GIs within Indian territory and is an example of India's commitment to comply with its TRIPS obligations regarding geographical indications for wines and spirits, as provided for in Article 23.²⁷

1.6.4 Banglar Rasogolla v. Odisha Rasagola: GI and Cultural Contestation

The dispute between West Bengal and Odisha regarding the famous Indian dessert, referred to as "rosogolla" in West Bengal and "rasagola" in Odisha, thus posed a different kind of problem for the GI Registry and ultimately for the public, in that it was not a case of an individual's or company's misuse of a GI, but rather a dispute between two Indian states over which of them was home to the original geographical indication of a beloved cultural icon. West Bengal's application for the GI registration of "Banglar Rasogolla" was approved in November 2017 by the GI Registry. Odisha's application for the GI registration of "Odisha Rasagola" was approved in 2019.

²⁷ *Scotch Whisky Association v Golden Bottling Ltd* (2006) 32 PTC 656 (Delhi High Court); *Agreement on Trade-Related Aspects of Intellectual Property Rights* (adopted 15 April 1994) Annex 1C, *Marrakesh Agreement Establishing the World Trade Organization* 1869 UNTS 299, art 23; *Trade Marks Act 1999* s 9.

The fact that two different registrations for what is essentially the same product have been granted raises interesting questions about the efficacy of the GI system in settling issues of cultural origin, and what is required to establish a geographical link for the purposes of GI registration.²⁸



²⁸ Geographical Indications Registry, *Registration of “Banglar Rasogolla”* (November 2017) and *“Odisha Rasagola”* (2019); *Geographical Indications of Goods (Registration and Protection) Act 1999*.