



**Università
degli Studi
di Ferrara**

DOCTORAL COURSE IN
"DIRITTO DELL'UNIONE EUROPEA
E ORDINAMENTI NAZIONALI"

CYCLE XXXI

DIRECTOR
Prof. Giovanni De Cristofaro

THE PROTECTION OF GEOGRAPHICAL INDICATIONS IN
THE GLOBAL TRADE: EU AND US PERSPECTIVES AND
THE ENVISAGED HARMONIZATION

Candidate
Dott. Tallia Camilla

(signature)

Supervisor
Prof. Russo Luigi

(signature)

Years 2015/2018

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SCOPE OF WORK: HOW MUCH DO YOU VALUE THE FOOD YOU EAT AND ITS PROVENANCE?

How much do you value the food you eat? When you are doing your groceries, do you usually pay attention to the provenance of the products you choose and any other attached certification (such as the geographical indications)? Do you know that special properties and tastes of food can depend on its origin? Have you ever realized that maybe your day-to-day choices may affect deeply the producers and their well-being, in addition to the general rural development?

These are just some reflections. And maybe the answer cannot be straight. Still, it is clear that many issues can arise just from these few simple questions and their solution can affect (and it is actually affecting) not just the national economies, but the global trade.

It has been a while since I have started wondering on these matters and I have felt that the environment around me was quite sensitive to the topic as well. Local and national newspapers often offer essays on food economies and regulations; most of the EU external action on trade discusses about food protection and food safety. If this is the big picture, I have started to become more and more interested on geographical indications and the value of the products they protect in terms of taste, culture, quality and production process. I have also tried to imagine how all this value can be protected at best and shared to the maximum benefit of both producers and consumers around the world. By collecting a significant number of relevant materials, studying different regulations and their rationale, comparing divergent models, I have come out with a proposal.

Given all these premises, this dissertation aims at being a study on the protection of geographical indications for food products in a comparative perspective between EU and US. The guidelines of the project are to safeguard the EU market values and quality products in the international trade. According to my personal perspective, being sensitive to the issue of promoting the Italian (and European) food companies around the world, this is deemed a particularly interesting topic. A mutual recognition of geographical signs will grant added value to EU products – meaning greater incomes for owners and higher wages for workers – together with a

privileged spot in the market (that can be deemed appealing also in light of corporate expansion through deals and investments).

In this context, it shall be preliminary recalled that the geographical indications are, generally (and improperly) speaking, those name of territories or regions used to describe certain food products, originating in the same areas and having, as an effect of their provenance, peculiar qualities which make the products recognizable. They are of greatest consideration when it comes to international trade, since there is no uniformity between the different states.

On one side, the EU model is a *sui generis* structure based on a sort of communal property, addressed at rural development, fair competition, protection of traditional goodwill and providing a level of protection to the highest possible extent. In a nutshell, it means that the geographical name is displayed in a public register, associated with the product itself and the relevant geographical region and is available to any local producer who is compliant with quality level required and production method. Accordingly, the holders are granted with an extensive power to prohibit all practices that take unjustified advantage of the geographical name's reputation, including simple evocation practices.

On the other side, the US system has grown in an environment traditionally less interested in protecting quality and origin of food products. It is far more composite and complicated than the European one, being made of various layers and based on a private property model typical of the intellectual property rights. As of now, there is no restrictions in marketing within the United States borders products bearing the same (or similar) EU geographical names, although they do not come from the same territory. It is a matter of free riding of geographical indications and of different domestic approaches and it prevents the exportations by the EU producers.

It is thus clear that the two systems seem to contrast one another and a balance between the two appears difficult to achieve. Nevertheless, the meaning of this dissertation is to demonstrate that, apart from first sights discrepancies, if put under the right spotlight, the overall scenario can be encouraging for the EU producers and stakeholders. There is a material chance to go beyond the traditional opposition and disagreement of the two systems.

At this respect, the thesis suggests the enhancement of a multilateral, but “EU sounding” model of protection that is, firstly, compatible with the US system of law and, ultimately, profitable from both the consumers and the businesses of both sides of the Atlantic Ocean and that for various reasons.

First of all, the negotiating environment might be more relaxed. The US system is currently facing a development in the food culture. The general social perception of geographical names has been subject of continuous change and improvement, being US consumers more sensitive to food quality issues, more sophisticated and having the US themselves invested in the protection of unique American food products (e.g. certification of Vidalia onions, Florida oranges, Idaho potatoes and others).

In addition, it is possible to infer that legal background is not as distant from the EU model as usually claimed. The US system in fact is already adequate to grant an extensive protection of geographical names and offers some incentives that can build up a bridge between the two sides of the Atlantic Ocean. Therefore, it cannot be excluded that the two countries would agree on international extensive mutual recognition of geographic names, with no need for the US to amend their system and, as such, avoiding costs of implementation.

In general terms, the US system adopts a “private” approach, based on Lanham Act, where geographical indications are protected by mainly two categories of trademarks, namely certification and collective marks. These can be recognized to the extent that they, respectively, certify certain qualities (including the geographic provenance) or are used by members of a specific group, who meet minimum requirements for being part of the relevant association. Regardless their “formal” private nature, in practice, differences with EU geographical indications blurry. With regard, in particular, to certification marks, they are generally owned and managed by public entities, they shall be mandatorily licensed to all who meet the standard and, in case a transfer occurs, the transfer shall not affect the basic requirements which shall not vary. Their recognition is open also to foreign products.

The recognition should be easy considering that the only barrier might be genericness of the name. US parties, in fact, usually uphold that EU geographical terms (and/or their translation) are generic descriptive term of a kind of product for US consumers. Genericness thought shall be evaluated in a precise time and space and in light of the public perception. Therefore, it cannot be excluded that EU geographic

terms usually deemed generic from the US perspective can turn into distinctive, in light of new and growing sophistication of consumers. Once a geographic name is recognized, the free ride of the name (or of similar name) by competitors is prevented by measures against unfair competition under the Lanham Act. Measures that are currently empowered also by the new possibility to enforce Federal rules specifically preventing mislabeling of food products (generally managed solely by public Authorities). The *POM Wonderful v. Coca-Cola* case in fact has opened the way for the intersection between two Federal Laws, allowing private action under the Lanham Act alleging unfair competition from false or misleading food label regulated by the Food, Drug and Cosmetics Act, increasing companies chance to obtain relief when injured by misleading claims of competitors. Of course, being a litigation matter, the outcome of eventual suits is not fully predictable. Still, it represents a chance already available within the US system: a chance that can be exploited as a kind of protection against “evocative” use (similar to what expressly provided under EU Regulation).

All these elements combined together demonstrate that there may be room for real discussion between EU and US about the enhancement of a system of mutual recognition of geographical indications (i.e. a model which, in the first place, provides the protection of Article 23 of the TRIPs to all food products. And, then, it is matched with a list of specific names that, being strategically important for some sectors and if not safeguarded can turn into deal breakers, can continue to be used in a descriptive way, provided that the place of real origin is clearly displayed, and they are likely to be misleading). Moreover, if such a mutual system of recognition of geographical signs is effectively implemented, consumers will be provided with a wider choice of products made available in the market, together with precise information on what they are going to buy. Contemporarily, US domestic producers will be induced to create original and renewed products, satisfying for the public’s tastes and adapt at creating new market niches.

In order to justify and argue on this proposal, the dissertation is structured as follows: the first chapter describes the scenario of international laws regulating geographical indications (i.e. WIPO conventions on intellectual property rights and the TRIPs agreement). The second and the third chapter analyses the “state of play” of

respectively the EU and US models of protection of geographical indications, pointing out the respective main features. Then, the fourth and last chapter displays the proposal concerning a multilateral system of protection of geographical indications by overcoming the current critics and pointing out a suggested and grounded perspective. In order to do so, this chapter is split into two parts: one that recalls all the institutional basis of the topic and the other one which describes in details the author's thesis on the multilateral model of protection of geographical signs and its supporting materials.

The conclusive remarks are not limited to this chapter, but closes the whole dissertation, pointing out a "hoping working agenda" for the future of international negotiations of geographical indications.

CHAPTER I:

THE INTERNATIONAL SYSTEM OF PROTECTION OF GEOGRAPHICAL INDICATIONS

SUMMARY: 1. Introduction – 2. The international framework in the protection of geographical indications – 2.1. The Paris Convention for the Protection of Industrial Property – 2.2. The Madrid Agreement for the Repression of False or Deceptive Indications of Source in Goods – 2.3. The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration – 2.4. The Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications – 2.5. The Agreement on Trade-Related Aspects of Intellectual Property Rights – 2.5.1. Article 22: Protection of Geographical Indications – 2.5.2. Article 23: Additional Protection for Geographical Indications for Wines and Spirits – 2.5.3. Article 24: International Negotiations; Exceptions – 2.5.4. Enforcement and dispute settlement – 3. Conclusive remarks.

1. INTRODUCTION

As already mentioned in the introductory scope of work, this dissertation deals with the protection of geographical indications. Nonetheless, since the regulatory part of this topic has already been analyzed and deepened by a considerable number of remarkable scholars (especially in the European academia), the author seeks to carry out a study on a single aspect of this topic.

In particular, the dissertation is intended to become – on ultimate level – a handbook for food producers, politicians, and lawyers whenever they are demanded to deal with a specific (debated and divergently regulated) interest, that of protecting in the international trade the added value of food products¹ depending on their particular geographical origin.

This interest, its different global perception and discipline have historical roots, included in a broader framework. The reference is to the circumstance that food has always been in the center of communities' life and, as such, in the spotlight of different regulations.

It seems to be a crystal-clear truth, maybe too often disregarded, the fact that food is not only inseparable from the entire history of the human race, but basic to it. It might

¹ At this respect, please note that the scope of this dissertation is limited to geographical indications for foodstuff. It does not extend to beverages (i.e. wine and spirits). It may happen that throughout the dissertation some references are made to wine and spirits, but they are regulated by special rules. Thus, it remains understood that the effect of these mentions should not overcome the purpose of the reference.

not be a perspective taken for granted, but, still, it can be upheld that without food there would be no human race and, as a consequence, no history.

As expressly reported by Reay Tannahill: *“for 50,000 years and more, humanity’s quest for food has helped to shape the development of society. Food has played a part in religion, helping to define the separateness of one creed from another by means of dietary taboos; in science, where the prehistoric coo’s observations laid the foundations of early chemistry; in technology, where the water wheel first used for milling grain became a tool of the industrial revolution; in medicine, which was based largely on dietary principles until well into the eighteenth century and is becoming so again today; in war, where battles were postponed until the harvest was gathered in, and well-fed armies usually defeated hungry-ones; in class distinctions, where a man’s quality and status were judged by the food on his table; and even in relations between people, where for 12,000 years there has been a steady undercurrent of antagonism between vegetarians and meat-eaters”*².

Paraphrasing Tannahill’s words, it means that food has been the driving preoccupation of humans since the dawn of evolution and the key factor in the development of societies.

Making a step further, the result is that food issues are strictly connected to each society and are a matter of concerns for legal specialists and politicians. Better, as expressly stated by, among others, Luigi Costato and Barton Hutt, agricultural and food law and policy encompasses social, cultural, and personal beliefs and biases that cannot be ignored³.

To have a clearer idea of spider web’s role played by food within societies, it is worth mentioning some of the examples collected by both Luigi Costato and Barton Hutt

² Please refer to R. TANNAHILL, *Food in History*, 1995.

³ Further on this matter, please refer to L. COSTATO, *Dai prodotti agricoli primari ai consumatori: I percorsi della storia*, in *Rivista di Diritto Alimentare*, volume 3, 2013; P. BARTON HUTT, *Food Law and Policy: an essay*, in *J. Food L. & Pol’y*, 2005.

Again, on the importance of regulating food issues towards the development and well being of communities, please take into account, among others, Michelle Obama’s recent speech the Grocery Manufacturers Association: *“We need you not just to tweak around the edges, but to entirely rethink the products that you’re offering, the information that you provide about these products, and how you market those products to our children”*. According to Mrs. Obama, it is to reject the conventional argument that the food industry is merely giving people the sugary, fatty, and salty foods that consumers demand, contending that the industry *“doesn’t just respond to people’s natural inclinations— it also actually helps to shape them, through the ways it creates products and markets them”*.

Ms. Obama’s speech can be read at <http://www.whitehouse.gov/the-press-office/remarks-first-lady-a-grocery-manufacturers-association-conference>.

who underlined that there are many issues in food law and policy that have not changed throughout recorded history. By way of example, one of the earliest clay tablets in ancient Samaria made it a crime for an innkeeper to provide a false measure of ale. A fundamental right established in the Magna Carta of 1215 was the guarantee of a uniform standard for weights and measures throughout England. Laws throughout the world, maintain that tradition today.

In medieval London, each baker was required to write his name on each of his bread products so that a consumer could have recourse in the event of an adulterated product. Today, all food products in most of the world (at least in all developed or Western countries), are required to bear the name and address of the manufacturer or distributor, for precisely the same reason⁴.

Laws prohibiting the adulteration and misbranding of food can be found in every civilized country from ancient Greece and Rome to the present.

International trade barriers and trade wars have similarly existed throughout history. For instance, during the rise of the Roman Empire trade of food was florid and regulated in order to grant food security to the Roman population. After the fall of the Empire, trade decreased, and communities started to become self-sufficient.

Again, in the 1800s and 1900s, European countries and the United States passed a plethora of protectionist laws against importation of cattle and other livestock. In Italy the road and rail system were improved in order to grant the transportation of food throughout the peninsula.

In light of all the above, then, it seems easy to conclude that the roots of disparities among nations in all aspects of food law and policy has to be identified in history, costumes and habits. Therefore, it should not be surprising that various different approaches towards food regulations (depending on the different interests and backgrounds) have been adopted throughout the world.

And that is particularly true when it comes to geographical indications. By way of

⁴ Please refer, for instance, to Article 9 of Regulation (EU) No 1169/2011 of the European Parliament and of the Council of 25 October 2011 on the provision of food information to consumers, amending Regulations (EC) No 1924/2006 and (EC) No 1925/2006 of the European Parliament and of the Council, and repealing Commission Directive 87/250/EEC, Council Directive 90/496/EEC, Commission Directive 1999/10/EC, Directive 2000/13/EC of the European Parliament and of the Council, Commission Directives 2002/67/EC and 2008/5/EC and Commission Regulation (EC) No 608/2004 Text with EEA relevance (hereinafter, the "**Food Information Regulation**"). It states that the label of foodstuff shall mandatorily displays, among others, "*the name or business name and address of the food business operator*".

introduction, it is worth recalling that the so-called geographical indications, are, generally (and improperly) speaking, those name of territories or regions used to describe certain food products, originating in the same areas and having, as an effect of their provenance, peculiar qualities which make the products recognizable. Therefore, it is natural that different regions imply different interests and the main issues in connection thereto are a consequence of globalized trade.

Before globalization, in fact, people ate, drank, and used local goods primarily because that was what was available to them geographically⁵. With the development of more expansive trade, consumers started to be in touch with a wider range of food varieties and prefer certain goods coming from certain local areas. The latter resulted being highly desirable products, because of their superior quality, due to various factors, such as the climate and geology, local recipes, processing techniques and manufacturing skills⁶.

This consumers' preference led merchants to apply to the products themselves geographical signs – consisting in the indication of the place of origin of the products – in order to safeguard consumers' informed choices, provide a guarantee of the quality of these goods and protect the producers from freeriders. In addition, local authorities started to provide protection for the commercial reputation of these products by passing laws aimed to prevent their adulteration⁷.

⁵ Please refer to J. HUGHES, *Champagne, Feta, and Bourbon: the spirited debate about Geographical Indications*, in 58 *Hastings L. J.*, 2006.

⁶ Please refer to M. BLAKENEY, *Proposal for the International Regulation of Geographical Indications*, in 4 *J. World Intell. Prop.*, 2001.

Some famous examples include: "Parmigiano Reggiano" for cheese (Italy), "Champagne" for sparkling wine (France), "Antigua" for coffee (Guatemala), "Roquefort" for blue cheese (France), "Prosciutto di Parma" for ham (Italy), "Kobe" for meat (Japan) and many others.

⁷ In a world where the economy has been increasingly globalized, a trend of "localization" is rising strongly. A "local" culture has been laying down against the globalization in order to preserve traditional qualities and grant to typical products a protection which is not limited to the internal market, but it is widespread on the whole economy. On this point, please refer to F. ALBISINNI, *L'origine dei prodotti agro-alimentari e la qualità territoriale*, in *Rivista di Diritto Agrario*, 2000; C. GALLI, *Globalizzazione dell'economia e tutela delle denominazioni di origine dei prodotti agro-alimentari*, in *Rivista di Diritto Industriale*, volume 2, part 1, 2004. On the same matter other folks underline that – in the new shape of markets, characterized by a strong competition and new consumers needs – agriculture systems should be built following not conformed products, but, rather, specialty regimes. The author includes this reasoning in a broader scenario whereby such actions are also addressed at preserving and developing rural communities and, for what concerns the EU, it is possible also if common policies are implemented. Please refer to I. TRAPÈ, *Qualità e sviluppo delle aree rurali*, in *Dalla riforma del 2003 alla PAC dopo Lisbona. I riflessi sul diritto agrario, alimentare e ambientale*, P. Borghi, L. Costato, L. Russo, S. Manservigi, 2011.

Therefore, if there is no doubt that whether to protect geographical indications is an issue, if considering the different methods of production, the development of the markets, and the underlying economic, historical and social background in the "old world" versus the "new world"⁸, different approaches towards these indications are likely. In other words, although geographical signs are recognized as competitive tools, there may be different ways of regulating them, in addition to various systems and levels of protection⁹.

As mentioned, the dissertation is intended to provide guidelines to stakeholders, politicians and advisors. Therefore, it attempts to analyze the various approaches towards geographical indications in order to strike a balance among them in the greatest interest of those food companies seeking to open their markets, without giving up to their qualities and distinctive assets. According to the author's view, who is personally sensitive to the issue of promoting the Italian (and European) food companies around the world, this is deemed to be a particularly sensitive topic. The

A material example, worth of being entirely reported, useful to deeply understand natural process of the developing need to protect geographical indications was invented by D. DUDDING, *Note: the Lisbon Agreement: why the United States should stop fighting the Geneva Act*, in 18 Vand. J. Ent. & Tech. L., 2015, who claimed: "Imagine for a moment that you are a novice cheesemaker. You have just completed all of your studies, graduated from a prestigious cheesemaking program, and have recently purchased a small plot of land in an area known as "Niceland" and a special breed of livestock to cultivate and create your product. Additionally, you have been experimenting with new so as to make your cheese a standout among the other products on the market. In a perfect scenario, the combination of your plot of land, which contains certain unique minerals and nutrients for your livestock, and your new techniques have made your cheese both exceptional and quite nouveau. Your product becomes known as "nicela," honoring the area in which it was created. Nicela explodes onto the market, and you go through the typical trademark requirements to ensure adequate protection for your highly acclaimed cheese, which has now become associated with the area in which you are creating it. Unfortunately, your newfound fame has attracted the attention of several other cheesemakers who want to capitalize on your success by claiming to be from Niceland and selling nicela cheese. What sort of protections are available to you and your cheese? Contrary to what you might think, if your product's country of origin is the United States, your rights may vary greatly compared to someone similarly situated in another part of the world".

⁸ The differences between "old" and "new" world will be better outlined when comparing the systems of protection of geographical indications.

Nevertheless, it is worth noticing, from the very beginning, that the debate over the protection of geographical signs does not follow the usual "north" versus "south" challenge, meaning developed countries against developing countries. The dispute, on the contrary, determines a conflict between "emigrant" nations – such as European Union, Eastern countries and a bunch of other developing countries – and "immigrant" nations, like Australia, New Zealand and United States.

⁹ As highlighted by some scholars, Intellectual Property rights are the frame in which the geographical signs find their legal protection. They have been elected as the suitable field in order to introduce distinctive signs that identify the link between quality and origin. Within this frame different approaches may be adopted. On this point, please refer to M. FERRARI, *La dimensione proprietaria delle indicazioni geografiche: uno studio di diritto comparato*, 2015.

final goal is to outline a multilateral system of protection and mutual recognition which would grant added value to food products – meaning greater incomes for owner and higher wages for workers – together with a privileged spot in the market (that can be deemed appealing also in light of corporate expansion through deals and investments).

Bearing this in mind, the dissertation is structured as follows.

The first chapter draws the current international framework of protection of geographical indications. In particular, the several attempts to institute an international protection of geographical indications are recalled. It describes, on one side, the basic concepts developed by most significant international treaties that have occurred in the past centuries, from the Paris Convention for the Protection of Industrial Property, to the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration and the relevant recent Geneva Act. On the other, it defines the terms of the agreement which represents the greatest international breakthrough, since it has been given the widest effect. We make reference to the World Trade Organization's Agreement on Trade Related Aspects of Intellectual Property Rights (better known as TRIPs).

Thereafter, the thesis goes on by analyzing the two most representative systems of law with regard to the regulation of geographical signs for foodstuff, those of EU and US.

On one side, in order not to overlap the great attention that scholars, academics and researchers have paid to the topic, only the main pillars of the EU system will be recalled, those which distinguish it from the other systems based on trademark law (i.e. the historical development and *ratio*, the notion of geographical indications, the registration procedure and the level of protection, including the controls system). In other words, the chapter focuses exclusively on those peculiar elements which better describe the *sui generis* structure based on a sort of communal property, addressed at rural development, fair competition and protection of traditional goodwill, rather than related to intellectual property. In a nutshell, it means that the geographical name is displayed in a public register, associated with the product itself and the relevant geographical region and is available to any local producer who is compliant with quality level required and production method. Accordingly, the holders are

granted with an extensive power to prohibit all practices that take unjustified advantage of the geographical name's reputation, including simple evocation practices¹⁰.

On the other side, greater attention is given to the description of the US system, in order to proceed to the relevant comparison. The US system has been chosen as a significant comparison, in the first place, considering that, from the European producers' perspective, US are the first competitor and client in terms of economic values¹¹. Back then, the US adopted a system of protection of geographical indications that is "opposite" (at least on a first sight) to the EU's. In fact, a trademark system, based on private rights has been preferred as the legal means to recognize, protect and enforce geographical indications. In brief, the US are primarily driven by two key objectives: i) to protect trademarks' holders against misappropriations (which reflects the economic philosophy of intellectual property rights intended to give inventors an incentive to create by providing financial rewards deriving from exclusive use) and ii) to avoid consumers' confusion by ensuring that they are not made to believe that unrelated products come from the same producer. Nevertheless, throughout the thesis, it will be displayed how this private system has faced significant influences from the public model.

Under a methodological perspective, the comparison is carried out on the basis of the

¹⁰ Leaving the deep analysis of the EU system of protection of Geographical Indications to the following chapter, it is in any case interesting reporting the words of a remarkable scholar who underlines the *sui generis* nature of these signs distinguished from the regular private proprietary system. She focuses, in particular, on the status granted to producers, highlighting that they are granted with an exclusive rights of impeding any false, unfair and misleading act, but only as long as they comply with the requirements setting forth by the competent public agency and supervised in connection thereto. The author argues; "*la situazione giuridica soggettiva dell'imprenditore non è posizione assoluta, ma è posizione giuridica attiva condizionata, perché deriva da un provvedimento amministrativo che delimita il contenuto del diritto di uso, prevedendo obblighi e modalità di fruizione, legando il potere dispositivo del produttore alla permanenza del collegamento tra prodotto e zona segnalata dall'indicazione geografica*". Please refer to S. CARMIGNANI, *La tutela delle indicazioni geografiche nell'Accordo TRIPS: localizzazione geografica del prodotto e mercato globale*, in *Diritto e Giurisprudenza Agraria e dell'Ambiente*, volume 2, part 1, 2002.

¹¹ When carrying out a comparative analysis, it is worth taking into account systems that may affect and/or interfere the most with the domestic one. At this respect, the European Union and the United States of America are by far the world's largest economies by Gross Domestic Product (GDP). Consider that trade between the EU and US determined total revenue equal to €616 billion in 2015, of which agriculture accounted for €31 billion and that, thanks to exports of EU high-value added products, the EU had a total surplus of €123 billion with the US for trade in goods and a surplus of over €7 billion in agricultural goods. Data acquired from EUROPEAN COMMISSION, *Agriculture and Geographical Indications (GIs) in TTIP, A guide to EU's proposal*, 21 March 2016.

legal sources collected during the author's six-month visiting period at UCLA School of Law, using the UCLA's database (both paper and online) and taking advantage of the general knowledge of US Food Law system acquired by sitting in some classes, participating at seminars, round tables and advisory boards of dedicated foundations¹².

2. THE INTERNATIONAL FRAMEWORK IN THE PROTECTION OF GEOGRAPHICAL INDICATIONS

As already made clear throughout the introductory part, when it comes to food, geography matters and become a valuable commercial asset¹³. Indeed, whenever the place of origin or geographical location is itself an essential characteristic of the product, there is the need to display it to the consumers and protect it towards unfair practices, such as counterfeiting, forgery, and misappropriation and from becoming a generic term.

¹² At this respect, please refer to:

1. ADVISORY BOARD OF RESNICK FOUNDATION OF FOOD LAW & POLICY: The Resnick Program is a think tank at UCLA that engages in scholarship, teaching, and service to facilitate a more transparent, equitable, and sustainable food system that yields improved health outcomes for all. The Advisory Board was held in order to summarize and review the activities carried out in the academic year 2016/2017, in addition to promote new initiatives and discuss innovative strategies.

2. SEMINARS, SYMPOSIUM AND ROUND TABLES, organized by UCLA School of Law or other partners and dealing with various topics of US Food Law, from sugar consumption, rural development, geographical indications etc.

3. UCLA School of Law. Sitting at: i) MODES OF LEGAL INQUIRY, HISTORICAL REFLECTIONS: THE ROLE OF LAW IN THE PURSUIT OF A MORAL FOOD SYSTEM. This class dealt with the history of food law, surveyed and compared the moral and cultural bases used for historical and modern regulation of food. By way of example, particular attention was given to the development of sumptuary laws during Medieval and Renaissance Europe aimed to preserve social hierarchies and morals and the modern moral problems associated with food inequity. It traced the development of Jewish dietary laws that focused in large part on purity. The complicated role of religious food rules was examined further in the rise and expansion of Christianity and Islam as expressed in the modern regulation of kosher and halal food labeling. Back then, the course also looked at the development of recent food law that has adapted in part to a food movement setting out to foster new cultural norms for civil society, including a demand for natural and pure food and a return to agrarian values. ii) INSTITUTION OF FOOD LAW AND POLICY. The courses started clarifying the definition of Food Law, then moved to the forms of enhancement, analyzing case law and Administrative Law. It shifted to the problems of adulteration, considering marketing, advertising and labeling. In the end, the course dealt with various themes connected with food safety, health claims and nutrition.

¹³ At this respect, please refer to the esoteric concept of "*terroir*," a French term which expresses the idea that foods and wine express the soil, climate, culture and tradition of a region. J. BLACK, *The Geography of Flavor, Bringing a European Idea Down to Earth: Producers, Farmers Pin Hopes on the Appeal of 'Terroir'*, in Washington Post, Wednesday, August 22, 2007, available at http://www.washingtonpost.com/wp-dyn/content/article/2007/08/21/AR2007082100362_pf.html.

As the global marketplace continues to expand due to the increased availability of Internet access and improvements in transportation, protection of geographical indications – both nationally and internationally – is no longer attached to few “traditional” countries but is becoming more and more important to many countries and their producers of local products.

Over the years, a movement has emerged to protect these products. First, on the national level, through legislation or jurisprudence; afterwards, also at the international level through bilateral agreements, multilateral treaties, or other agreements¹⁴.

This first chapter explores the current state of geographical indications in international law and the special protections afforded to wines and spirits, by analyzing the historical evolution of international intellectual-property agreements and the protection of geographical indications within each agreement¹⁵.

¹⁴ At this respect, please take into account that until the end of the 19th century, intellectual property, including geographical indications, was largely governed at a country-specific level, with each country's laws governing within its borders. As technological advances made international commerce easier, the international patchwork of intellectual-property protections became popular, and by the early 1900s, several European countries signed copyright and patent agreements. S. K. SELL, *Private power, Public Law: the globalization of Intellectual Property Rights*, 2003.

¹⁵ For a general overview on the protection of geographical indications on the international level through multilateral treaties, please refer, among others, to WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO), *Introduction to Intellectual Property, theory and practice*, 1997; F. ABBOTT, T. COTTIER, F. GURRY, *The International Intellectual Property system: commentary and materials*, 1999; G. GREGORY LETTERMAN, *Basics of Intellectual Property Law*, 2001; G.B. DINWOODIE AT AL., *International Intellectual Property Law and Policy*, 2001; P. GOLDSTEIN, *International Intellectual Property Law, cases and materials*, 2008. Other relevant sources dealing with the international system of protection of geographical signs are, among others, A. G. MICARA, *La tutela internazionale delle indicazioni geografiche relative ai prodotti alimentari nella prospettiva della tutela della qualità*, in *La tutela multilivello del diritto alla sicurezza e alla qualità degli alimenti*, 2012; A. VANZETTI E V. DI CATALDO, *Manuale di diritto industriale*, 2012; G. ANGELICCHIO, *Indicazioni Geografiche e Denominazioni di Origine*, in *Diritto Industriale Italiano*, 2014.

2.1. The Paris Convention for the Protection of Industrial Property¹⁶

The Paris Convention for Protection of Industrial Property (hereinafter, the “Paris Convention”) is the first international agreement that specifically addresses the topic of geographical signs.

First of all, it is important to underline that the Paris Convention does not expressly contain the notion of “geographical indication”. Rather, Article 1(2) lists “indications of source” and “appellations of origin” as objects of “industrial property.”

Although the Paris Convention failed to define these two notions, the distinction between them can be identified with the level of connection with the territory. “Indication of source” is a sign which simply indicates that a certain product originates in a specific area and that is it. While “appellation of origin” can be attached to those products which have characteristic qualities due to the relevant geographical environment, including human or natural factors. In other words, appellations of origin may be understood as a special kind of indication of source.

This distinction is not limited to a terminological level. In fact, Article 10(1) - which represents the basic provision on the geographical signs - expressly provides protection “*in cases of direct or indirect use of a false indication of the source of the goods*”, but there are no special provisions for the protection of the appellations of origin. Anyway, this is a “false friend”: the rules regulating indications of source can be extended to appellations of origin, since the latter constitutes, by definition, an indication of source.

Once clarified the apparent terminological issue, it is worth giving some hints about the content of Article 10(1) and related provisions.

Article 10(1) states that sanctions provided for in Article 9 in respect of goods unlawfully bearing a trademark (i.e. basically seizure on importation) apply to any direct or indirect false indication of sources, that is one that refers to an area from

¹⁶ The Paris Convention for the Protection of Industrial Property was concluded in 1883 and revised at Brussels in 1900, at Washington in 1911, at The Hague in 1925, at London in 1934, at Lisbon in 1958 and at Stockholm in 1967, and was amended in 1979 [text available at: http://www.wipo.int/treaties/en/text.jsp?file_id=288514].

For a brief institutional summary of the agreement, please refer to Summary of Paris Convention for the Protection of Industrial Property available at: http://www.wipo.int/treaties/en/ip/paris/summary_paris.html.

For a comment, please refer to G.H.C. BODENHAUSEN, *Guide to the application of the Paris Convention for the Protection of Industrial Property*, 1968.

which the products do not originate.

At a first sight this provision seems to be incomplete, since it does not provide any kind of protection to misleading indications which are not technically false¹⁷. Hence, in order to fill this vacuum, Article 10*bis*¹⁸ intended to assure effective protection against unfair competition was later added, providing a basis for the protection against confusing and misleading practices.

Article 10*ter* imposes to the signatories to define and enforce appropriate legal remedies effectively to repress all the acts referred to in Articles 9, 10, and 10*bis*.

On the overall, the Paris Convention may sound like an agreement providing for strong protection of geographical indications. In reality, as highlighted by some authors, the work seems to be undone.

On one side, the Paris Convention provides no material recourse for producers who encountered the improper usage of geographical indications since it only applies if the internal current laws allow for the seizure of imported goods bearing false representations of origin. In other words, only countries with effective system of protection of intellectual property rights may have a good recourse under the Paris Convention¹⁹.

On the other side, the Paris Convention does not deal with a question that later we will focus on, as being the center of the debate between EU and US in enhancing a shared system of protection of geographical indications. We make reference to the question of how to treat indications which, in countries other than the country of origin, are generic names of a product. It seems that signatories of the Paris Convention can consider themselves to be entirely free at this respect²⁰.

Still, compared to the other international agreement that we will discuss further

¹⁷ When analyzing the Paris Convention, some authors have underlined that, in its original version, the main concern of the negotiating countries was basically to ensure that consumers are not misled about true origin of the goods. As a consequence they laid down a system intended to contrast false information. On this point, please refer to A. VANZETTI, V. DI CATALDO, *Manuale di diritto industriale*, 2012, cit.

¹⁸ Article 10*bis* was added during the 1958 Lisbon Revision Conference.

¹⁹ Please refer to E.C. CREDITT, *Terroir vs. Trademark: the debate over Geographical Indications and expansions to the TRIPs agreement*, in 11 Vand. J. Ent. & Tech. L., 2009.

²⁰ Please refer to WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO), *Introduction to Intellectual Property, theory and practice*, 1997, cit.

about, the Paris Convention registered the greatest number of signatories²¹.

As conclusive remarks, regardless the issue of incompleteness underlined by various scholars, as a matter of fact, it may be said that the soft boundaries prescribed by the Paris Convention persuaded a great number of countries to join the agreement.

2.2. The Madrid Agreement for Repression of False and Deceptive Indications of Source on Goods²²

Only eight years after the negotiations of the Paris Convention, the Agreement for Repression of False and Deceptive Indications of Source on Goods (hereinafter, the “Madrid Agreement”) extends the framework of the Paris Union. The Madrid Agreement, in fact, aims at filling the gaps of the Paris Convention, by expressly providing for the repression not only of false, but also of deceptive indications of source²³.

According to the Madrid Agreement, all goods bearing a false or deceptive indication of source, by which one of the contracting states, or a place situated therein, is directly or indirectly²⁴ indicated as being the country or place of origin, shall be seized on importation, or such importation must be prohibited, or other actions and sanctions must be applied in connection with such importation.

The Madrid Agreement has a peculiarity: it includes, for the first time, a specific distinct approach in the protection of food products and wine and alcoholic beverages. Article 4 in fact reads, as a general rule, that the courts of each country should decide what appellations, on account of their generic character, do not fall within the protection granted of the Madrid Agreement. And, as exception, regional

²¹ As of the date of the submission of this thesis, the Paris Convention includes 177 contracting parties. The full list, always up to date, is available at: http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=2.

²² The Madrid Agreement for Repression of False and Deceptive Indications of Source on Goods, was concluded in 1891 and revised at Washington in 1911, at The Hague in 1925, at London in 1934, at Lisbon in 1958 and at Stockholm in 1967 [text available at: http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=286776].

For a brief institutional summary of the agreement, please refer to Summary of Madrid Agreement for Repression of False and Deceptive Indications of Source on Goods available at: http://www.wipo.int/treaties/en/ip/madrid/summary_madrid_source.html.

²³ Please refer to Article 1 of the Madrid Agreement.

²⁴ The protection is pretty wide: Article 3bis, in fact, expressly clarifies that it must be prohibited the use of “*all indications in the nature of publicity capable of deceiving the public as to the source of the goods, and appearing on signs, advertisements, invoices, wine lists, business letters or papers, or any other commercial communication*”.

indications concerning the provenance of wine are excluded from this reservation.

This provision was deeply criticized by scholars²⁵. From their perspective, the reservation limits the scope and power of the Madrid Agreement, allowing signatories to be free to develop different approaches – with the result that, in most cases, countries have provided limited protection to foreign geographical terms – and also demonstrating the international tendency to afford more protection to wine and spirits (as will be shown when analyzing the outcomes of TRIPs).

Apart from that, the impact of the Madrid Agreement has been minimal due to the weak support received. It has few signatories, and, notably, United States are not part of it²⁶.

2.3. The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration²⁷

After a period of massive international regulation with regard to Intellectual Property Rights and geographical indications (i.e. in less than 8 years two international treaties were adopted), there were seventy years of slowing down on the matter²⁸.

²⁵ Please refer to WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO), *Introduction to Intellectual Property, theory and practice*, 1997, cit.; E.C. CREDIT, *Terroir vs. Trademark: the debate over Geographical Indications and expansions to the TRIPs agreement*, in 11 Vand. J. Ent. & Tech. L., 2009, cit.; J.M. WAGGONER, *Andrew P. Vance memorial writing competition winner: Acquiring a European taste for Geographical Indications*, in 33 Brooklyn J. int'l L., 2008.

²⁶ As of the date of the submission of this thesis, the Madrid Agreement includes 36 contracting parties. The full list, always up to date, is available at: http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=3.

²⁷ The Lisbon Agreement concluded in 1958, was revised at Stockholm in 1967, and amended in 1979 [text available at: http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=285838].

The Diplomatic Conference for the Adoption of a New Act of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration which took place from May 11 to 21, 2015, adopted the Geneva Act of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration.

For a brief institutional summary of the agreement, please refer to Summary of Lisbon Agreement for the Protection of Appellations of Origin and their International Registration available at: http://www.wipo.int/treaties/en/registration/lisbon/summary_lisbon.html.

²⁸ The reasons of this slowing down may be searched in the history of the Old World. European countries have historically been the driving force acting behind the scene for the protection of Geographical Indications. Thus, there was little progress on the matter while the continent faced two World Wars and related economic depression. It was only when Europe recovered from World War II, the protection of geographical indications reemerged as a priority and faced another round of innovative negotiations. On this matter, please refer to A. QUINTANA ANTONIO, *Legal mercantile evolution from the twentieth century to the dawning of the twenty-first century*, in 42 Tex. Int'l L.J., 2007.

Nevertheless, when countries started again to discuss about geographical indications, the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (hereinafter, the “Lisbon Agreement”) was adopted with the declared goal of extending the protection of geographical signs.

The object of the Lisbon Agreement is the protection of appellations of origin, meaning the “*geographical name of a country, region or locality which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors*”²⁹.

The most innovative impact of the Lisbon Agreement may be identified in the level of protection granted to the appellations of origins and provided for in Article 1(2). Signatories undertake to recognize and protect in their territories the appellations of origin of products of the other signatories which are, first, recognized and protected as such in their country of origin³⁰ and, second, registered at the International Bureau of Intellectual Property (i.e. an agency of WIPO)³¹.

In particular, the registration process is activated at the request of the competent authorities of the interested countries. Indeed, these offices do not act on their own,

²⁹ Please refer to Article 2(1).

³⁰ The expression “*protected as such in the country of origin*” included in Article 1(2) has arisen various concerns among interpreters. According to the majority, this terminology means that it is not enough for the interested country to protect its appellation in a general way. It is necessary a distinct and express protection (i.e. deriving from a specific act, such as a legislative or administrative provision, a judicial order or a registration). Hence, the protection by means of law of unfair competition or advertising is not recognized. At this respect, please refer to WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO), *Introduction to Intellectual Property, theory and practice*, 1997, cit.; A. CONRAD, *The protection of Geographical Indications in the TRIPs agreement*, in 86 Trademark Rep., 1996.

On the contrary, other authors have adopted a less strict perspective. They claimed that the expression means that the country of origin shall apply the definition provided in the Lisbon Agreement, but not necessarily use the term “appellation of origin”. In other words, the “as such” argument does not seem to impede to countries not using the term “appellation of origin” to join the Lisbon Agreement, provided that they recognize in their systems and comply with the relevant definition. To this regard, please refer to WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO), *Actes de la conference reunie a Lisbon du 6 au 31 octobre 1958*, 1963; D.J. GERVAIS, *Reinventing Lisbon: the case for a Protocol to the Lisbon Agreement (Geographical Indications)*, in 11 Chi. J. int’l L., 2010.

Moving forward on this topic and adopting another point of view, the provision under the spotlight has been interpreted as an improvement with respect to the previous agreements in terms of effectiveness of the protection. In fact, it grants to each member state the flexibility to identify the need to protect the geographical signs and the relevant internal legal tools. To this extent, please refer to D. SARTI, *La tutela delle indicazioni geografiche nel sistema comunitario*, in *Le indicazioni di qualità degli alimenti*, Diritto Internazionale ed Europeo, 2009.

³¹ The registration process is expressly regulated at Article 5.

but in the name and on behalf of any natural persons or legal entities, public or private, having, according to their national legislation, the right to use such appellations.

At this point, the International Bureau keeps the International Register of Appellations of Origin and formally notifies the other contracting states of the registrations. Each contracting state may declare, within one year of receiving the notice of registration, that it cannot ensure the protection of a registered appellation within its territory, provided that such a declaration is founded on reliable grounds for the refusal³². In all countries not having made a declaration of refusal, the registered appellation enjoys protection.

Once completed the registration, signatories have to ensure that any usurpation or imitation of the appellations is prohibited under their laws and that even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as “kind,” “type,” “make,” “imitation”, or the like³³. Furthermore, the registered appellations – as long as their protected in the country of origin – cannot become generic in none of the territories of signatories³⁴.

Similarly to the Madrid Agreement, Lisbon Agreement did not have the envisaged success, gaining a few number of signatories³⁵. Two main critical points may be identified. First, the Lisbon Agreement is effective only to the extent appellation of origin are protected in their country of origin: many national legislatures were

³² With reference to the grounds of refusal, it is worth mentioning that there are no express limitations in the possible grounds. The negotiating history registers “genericness” as the most common ground for refusal. The grounds however are heterogeneous. Either way, the effect is that each country holds a discretionary power to protect or refuse to protect a registered appellation of origin, demonstrating that the negotiations did not seek for any kind of international supervisory or oversight authority. On this topic, please refer to WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO), *Introduction to Intellectual Property, theory and practice*, 1997, cit.; D.J. GERVAIS, *Reinventing Lisbon: the case for a Protocol to the Lisbon Agreement (Geographical Indications)*, in 11 Chi. J. int'l L., 2010, cit.

³³ Please refer to Article 3.

³⁴ Please refer to Article 6.

³⁵ As of the date of the submission of this thesis, the Lisbon Agreement includes 28 contracting parties. The full list, always up to date, is available at: http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=10.

Commenting the number of signatories, some authors have highlighted that the greatest interest has been raised among those Old World countries (such as Italy and France) which desired to defend their traditions and qualities. On the contrary, outside Europe, most of the countries (such as Australia and United States) did not join the Lisbon Agreement because they were substantially more interested in limiting the protection of geographical signs and preserving their freeriding. At this respect, please refer to L. SORDELLI, *L'identificazione dei prodotti agricoli sul mercato*, in *Rivista di Diritto Industriale*, volume 1, 1994.

unwilling to enact specific protection. Second, similarly to what already argued with regard to the Paris Convention, it is not clear the treatment reserved to names already generic in some signatories before the registration³⁶.

The United States did not join the Lisbon Agreement either, confirming once again their tendency to be lenient with regard to the protection of geographical indications.

2.4. The Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications³⁷

Few years ago (precisely May 2015), within the WIPO context, a diplomatic conference has been convened in order to discuss on the development of the Lisbon system. The result of this international meeting is the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (hereinafter, the “Geneva Act”).

The aim of this meeting was to revise the Lisbon Agreement and adapt it to the needs and concerns of the countries which were not part of the previous treaties. In other words, the conference was asked to render the Lisbon framework more attractive for states and users, while preserving its principles and objectives³⁸.

³⁶ Please refer to WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO), *Introduction to Intellectual Property, theory and practice*, 1997, cit.; A. CONRAD, *The protection of Geographical Indications in the TRIPs agreement*, in 86 Trademark Rep., 1996, cit.; J.M. WAGGONER, *Andrew P. Vance memorial writing competition winner: Acquiring a European taste for Geographical Indications*, in 33 Brooklyn J. int’l L., 2008, cit.

³⁷ The complete text of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications is available at http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=370115.

For a deeper analysis of the Geneva Act, please refer to D. GERVAIS, *Irreconcilable differences? The Geneva Act of the Lisbon Agreement and the common law*, in Hous. L. Rev., 2015; AA. VV., *Revised WIPO Lisbon Agreement to Cover Geographical Indications*, in Bridges Weekly Trade News Digest, 2015; M. GEUZE, *Protecting geographical-origin-brands abroad: the Geneva Act of the Lisbon Agreement*, in The importance of place: Geographical Indications ad a tool for local and regional development, 2017; D.J. GERVAIS, M. SLIDER, *The Geneva Act of the Lisbon Agreement: controversial negotiations and controversial results*, in The importance of place: Geographical Indications ad a tool for local and regional development, 2017.

³⁸ With regard to the primary objective of the Geneva Act, please consider the meaningful words of WIPO General Director, Mr. Francis Gurry who stated that the final goal was to “*produce a Lisbon system that is attractive to the full membership of the Organization, by providing a basis for the expression of the Lisbon system beyond the historically rather low level of participation amongst the members states of the WIPO*”. The entire statement can be reached at <http://www.wipo.int/webcasting/en/index.jsp?event=LI/DC>.

Given that, this paragraph records the most significant provisions of the Geneva Act. The provisions described herein has been chosen in light of their proximity with the core discussion carried out in the conclusive remarks of this thesis, regarding the possibility to (and advantage of) reconcile the “old” world with the “new” world or at least to create a bridge between the two.

First of all, with regard to the definitions, the Geneva Act applies to, respectively, appellations of origin and geographical indications³⁹. Both of them are denominations consisting of or containing the name of a geographical area, or another denomination known as referring to such area, which serves to designate a good as originating in that area. The difference is that, in the case of appellations, the quality or characteristics of the good are due exclusively or essentially to the environment (including natural and human factors, and which has given the good its reputation). While, in the case of geographical indications, the product’s properties are essentially attributable to its geographical origin.

Actually, this distinction does not have in fact material consequence. The Geneva Act does not require member countries and intergovernmental organizations to use the same terminology. Despite the definitions, for the purpose of the Geneva Act, the substance matters: geographical-origin-brands may be protected in their country of origin in the form of an appellation of origin, a geographical indication, a certification mark, a collective mark or whatever other title may exist under national or regional law⁴⁰.

The first step of protection of geographical brands is the completion of the

In addition, please note that various authors have highlighted that, among the primary objectives of WIPO, there is the enhancement of a shared/balanced, global and effective system of protection of intellectual property rights (including geographical indications). WIPO acts as the primary multilateral forum for discussion of Intellectual Property issues, fighting against the threat of fragmentation through the rising number of bilateral and regional agreements. At this respect, please refer to C. DEERE BIRKBECK, *Inside views: strengthening WIPO’s governance for the next 50 years: a time for action*, in Intellectual Property Watch, September 26, 2014.

³⁹ Please refer to Article 2.

⁴⁰ Please refer to Article 9. It remains understood that the notion of geographical indication is broader than that of appellation of origin. Hence, each member state is free to protect the geographic signs on the basis on only one of the two definitions. If the selected definition corresponds to that of geographical indications, the interested states have to deal with the denominations with the properties of the appellations of origin as if they were geographical indications. At this respect, please refer to M. GEUZE, *Protecting geographical-origin-brands abroad: the Geneva Act of the Lisbon Agreement*, in *The importance of place: Geographical Indications as a tool for local and regional development*, 2017, cit.

registration procedure⁴¹. The application can be filed by either by i) the national competent authority in the name of the beneficiaries or whoever is entitled to exercise control over the use of the geographical-origin-brand or to enforce rights in it; or ii) the beneficiaries themselves if the legislation of the country of origin so permits.

The application shall be accompanied by a list of information, including, by way of example, the geographical-origin-brand itself, the good(s) to which the brand applies, as well as the applicant(s) and the beneficiaries or the natural person⁴².

The whole registration procedure is costly. The registration of each appellation of origin and geographical indication is subject to payment of a fee⁴³, although the amount has not been established yet⁴⁴.

Once satisfactorily registered, the indication is granted with international recognition and protection. Under a practical point view, it means that each contracting State is requested to protect the registered name within its own legal system and practice but in accordance with the substantive terms of the Geneva Act. In particular, the Geneva Act is pretty detailed⁴⁵. First of all, in case of false or deceptive practices, it makes a distinction between the use of geographical-origin-brands in respect of goods of the same kind as those to which the geographical sing applies and the use with regards to goods that are not of the same kind or services.

In the first scenario, protection has to be available for rightful holders against any use of the brand in respect to goods not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin or the geographical indication.

In the second scenario, protection has to be available against any use that would suggest a connection between those goods or services and the beneficiaries of the internationally registered origin brand – being likely to damage their interests – and be able to impair or dilute in an unfair manner, or take unfair advantage of, the brand's reputation.

⁴¹ Please refer to Articles 5 and 6.

⁴² Please refer to joint Articles 5(6) and 6(3).

⁴³ Please refer to Article 7.

⁴⁴ At this respect, please note that the determination of the fee's amount is left to the Assembly of the members of the Lisbon System, which it is supposed to make a decision on this topic prior to the entry into force of the Geneva Act. In any event, by way of comparison, please take into account that the fixed fee, under the current Lisbon Agreement, is equal to 1000 Swiss francs.

⁴⁵ Please refer to Article 11.

In addition, the registered geographical signs shall be protected against not only the use of origin brand in exactly the same form, but also the practices which amount to imitation of the brand. The Geneva Act makes reference, in particular, to the use of the brand with slight differences, use in translation, use in combination with a delocalizing term, or in combination with terms such as “style”, “kind”, “type”, “make”, “imitation”, “method”, “as produced in”, “like”, “similar” or the like⁴⁶.

Furthermore, as a collateral effect, all registered appellations of origin and registered geographical indications cannot be considered to have become generic in the territories of the other contracting parties⁴⁷.

Whereas these mentioned rules provide for a specific level of protection, nothing in the Geneva Act prevents member countries or intergovernmental organizations to ensure a more extensive protection than that stipulated and does not derogate nor prejudice any other protection that members may accord under a bilateral,

⁴⁶ As reported in the official text of the Geneva Act, please note that a footnote (i.e. whose technical name is “Agreed Statement”) has been added to this provision. In particular, in case of composed geographical names, it is understood that where only certain elements of the denomination have a generic character in the country, the latest level of protection shall not be required in the other contracting parties. In other words, it is allowed to describe a product through the generic name and expressions such as “like”, “type” etc.

For sake of clarity – and as will be better described in the chapter relating to the EU system – the name “Edam Holland” is a Protected Geographical Indication under the EU Law. Nevertheless, the act by virtue of which protection is granted explicitly mentions that only the composed name “Edam Holland” is relevant for the purpose of the Geographical Indications *sui generis* system. While “Edam” remains free for use as a generic term for a particular kind of cheese.

⁴⁷ Please refer to Article 12.

For sake of completeness, please note that this provision has been the center of debates during the assembly. In the definitive version, the Geneva Act – like the Lisbon Agreement – allows contracting parties to refuse a registration if the geographic name is generic in their territory. That has been made clear by the approved Added Statement which recites as follows: *“For the purposes of this Act, it is understood that Article 12 is without prejudice to the application of the provisions of this Act concerning prior use, as, prior to international registration, the denomination or indication constituting the appellation of origin or geographical indication may already, in whole or in part, be generic in a Contracting Party other than the Contracting Party of Origin, for example, because the denomination or indication, or part of it, is identical with a term customary in common language as the common name of a good or service in such Contracting Party, or is identical with the customary name of a grape variety in such Contracting Party”*.

However, it is not clear if any kind of remedy may be implemented in the event a registered name becomes generic in a contracting country because of, for instance, inaction or even acquiescing by the holder of geographical brand.

That is why some countries proposed to include another Added Statement – never enforced – granting the contracting parties the right to refuse protection to those geographical names which – as demonstrated after due process – lost their ability to designate a good as originating in the relevant geographical area.

plurilateral or multilateral agreement⁴⁸.

In so far, we have analyzed the best scenario, meaning the case where the international registration is completed, and the other contracting parties ensure protection within their territory pursuant to prescriptions of the Geneva Act.

Nevertheless, the Geneva Act has imagined a bitter scenario, as already mentioned when recording the Lisbon Agreement. The commitment of members to protect geographical-origin-brands is subject to any refusal, renunciation, invalidation or cancellation that may become effective with respect to their territory.

The refusal shall be submitted by the competent authorities within a year from the receipt of the notification of a new international registration and can be based – as seen with reference to the Lisbon Agreement – on any ground⁴⁹.

The latest relevant provisions are those related to the safeguards mechanisms, meaning the relationship with other indications⁵⁰. The Geneva Act expresses that, in principle, its rules shall not prejudice prior trademark rights acquired in accordance with the laws of the member country. However, where a member country or intergovernmental organization, which allows for coexistence, provides a limited exception to the rights conferred by a trademark, protection of the geographical-origin-brand shall not limit the rights conferred by that trademark in any other way.

By way of explanation this is quite a flexible safeguard provision. It is basically meant to ensure that it is up to each member decide to protect geographical brands on the basis of the principle of first-in-time first-in-right or on the basis of coexistence.

Leaving further and reasoned considerations to the conclusive remarks of this thesis (after a deep analysis of the two opposed systems of law), it is however possible to conclude that the Geneva Act seems to have succeed in providing a broader, but at the same time more flexible protection to geographical names. On one side, it significantly expanded the scope of the Lisbon Agreement by extending the category of appellations of origin – which, as shown, represented a narrower subset of geographical signs in which products are exclusively or essentially linked to a geographical environment – to the broader category of geographical indications.

On the other, the Geneva Act was intended to set a standard of protection and leave each contracting party to implement it in the most feasible way. Under the Geneva

⁴⁸ Please refer to Article 10(2) and (3).

⁴⁹ Please refer to Article 15.

⁵⁰ Please refer to Article 13.

Act, signatories are expressly free to keep their existing national systems for geographical signs protection (i.e., for instance, in the form of trademark and/or as certification marks) and regulate the relationship with prior indications.

In light of this elasticity, the registration and protection system provided for by the Geneva Act is likely to be attractive on an international level. It might be a good starting point for enhancing a multilateral and satisfactory way to grant to the rightful holders of geographical brands the possibility to defend their rights in the jurisdictions of both actual and potential export markets.

By reading the brief analysis carried out so far, it is clear that a number of attempts to set up an international system of protection of geographical indications have been made. Yet a breakthrough is still awaited from many producers and other stakeholders. To sum up the elements discussed so far, the Paris Convention – which has the greatest number of signatories and so, in theory, the highest grade of effectiveness – does not contain any substantial provision with reference to the geographical indications. The Madrid Agreement is a little more complete, but in practice unsuccessful. The Lisbon system (made by both the Lisbon Agreement and the Geneva Act) may embody an effective level protection, but the former has few participants and the latter is not in force yet⁵¹ – although, in the author’s opinion, some provisions are attractive.

In any event, as anticipated, before giving up any hope for an effective multilateral protection, it is worth recalling that the international panorama is filled with another agreement dealing with the protection of geographical indications. We make reference to the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter, “TRIPs”).

The latest part of this chapter is devoted to the analysis of the most significant provisions of the TRIPs with regards to the geographical denominations.

The outcome is the basis on which carrying out the conclusive remarks on how the system can be improved, adjusted or extended (we will see hereinafter that the choice of the verb matters; the analysis of the various proposals shows how different the

⁵¹ Pursuant to Article 29(2), the Geneva Act shall enter into force three months after five contracting parties have deposited their instruments of ratification or accession. As of now, none of the eligible countries have activated any ratification/accession procedure (updates on this status are available at: http://www.wipo.int/treaties/en/ActResults.jsp?act_id=50).

approaches can occur, considering the various historical and economic backgrounds). This is in order to effectively protect the quality food products in the era of globalized trade, avoid freeriding and increasing the overall success and incomes of producers.

2.5. The Agreement on Trade-Related Aspects of Intellectual Property Rights⁵²

As mentioned, it is worth concluding the analysis of the international framework of protection of geographical indications by dealing with the TRIPs.

It deserves a separate analysis primarily because it introduced the first comprehensive system of protection of intellectual property rights. Secondly, because it is as of now the most complete system in the international panorama⁵³. Therefore it can be deemed a benchmark to be adjusted to the debated and emerging needs and used as a basis to extend multilateral system of guarantee of geographical signs.

The TRIPs – in addition to the protection provided for a variety of intellectual property rights, including copyrights and related rights, trademarks, industrial designs, patents, and layout-designs – dedicates a whole section to geographical indications, with the express objective of introducing order and predictability with regards to the geographical signs, uniform the level of protection and move forward

⁵² The TRIPs is Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization (hereinafter, “WTO”). It was signed at the Marrakesh ministerial meeting in April 1994, as one of the result of the 1986–94 Uruguay Round negotiations.

The official text is available at: https://www.wto.org/english/docs_e/legal_e/27-trips.pdf.

For an official overview of the TRIPs and the provisions on Geographical Indications, please refer to the WORLD TRADE ORGANIZATION, *Overview: TRIPS Agreement*, available at: https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm#geographical.

For a further analysis of the TRIPs, please refer, among others, to A. CONRAD, *The protection of Geographical Indications in the TRIPs agreement*, in 86 Trademark Rep., 1996, cit.; J. AUDIER, *TRIPs agreement: geographical indications*, 2000; M. CORREA, A.A. YUSUF, *Intellectual Property and International Trade: the TRIPs Agreement*, 2008; WORLD TRADE ORGANIZATION, *A handbook on the WTO TRIPs*, 2012; J. MALBON, C. LAWSON, M. DAVISON, *The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights: a commentary*, 2014.

Other relevant sources dealing with the TRIPs are, among others, A. GERMANÒ, *Le indicazioni Geografiche nell'Accordo TRIPs*, in *Rivista di Diritto Agrario*, volume 3, part 1, 2000; S. CARMIGNANI, *La tutela delle Indicazioni Geografiche nell'Accordo TRIPs: localizzazione geografica del prodotto e mercato globale*, in *Diritto e giurisprudenza agraria e dell'ambiente*, volume 2, part 1, 2002, cit.; C. DORDI, *La protezione delle indicazioni geografiche nell'accordo TRIPs*, in *Le nuove sfide per l'OMC a dieci anni dalla sua istituzione*, 2005.

⁵³ The wider effect of the TRIPs compared to others international agreements depends from the fact that, being the TRIPs an attachment of the incorporation deed of WTO, all WTO members are members of TRIPs as well. At this respect, as of the last update of accession (i.e. 29 July 2016), the WTO counts 164 members (reference at: https://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm).

from the previous interventions⁵⁴.

By way of introduction, please bear in mind that the most important feature of the TRIPs is that it provides different standards of protection to, on one side, wine and spirit (i.e. higher) and, on the other, all other foodstuff.

2.5.1. Article 22: Protection of Geographical Indications

Article 22 provides for a general standard of protection to all geographical indications.

Geographical indications are defined, for the purposes of the TRIPs, as “*indications*⁵⁵ which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation⁵⁶ or other characteristic of the good

⁵⁴ At this respect, please refer to F. ABBOTT, T. COTTIER, F. GURRY, *The International Intellectual Property system: commentary and materials*, 1999, cit.; WORLD TRADE ORGANIZATION, *A handbook on the WTO TRIPs*, 2012, cit.

⁵⁵ As mentioned before, both the Lisbon Agreement and the Geneva Act describe the geographical signs exclusively as “names”.

The use of the broader term “indications” suggests that the definition is not limited to the names of areas, but, in turns, it is open (as it usually happens with regards to trademarks) to any term, symbol or design that may identify a particular good as originating in the relevant, territory or locality. This may be related to the fact that TRIPs’ soul is the protection of the Intellectual Property rights. Indeed, the intention seems to be to give the owners of the geographical signs the flexibility to adopt creative indications that stretches beyond the simple name. On this topic, please refer, among others, to M.A. ECHOLS, *Geographical Indications for food products: International legal and regulatory perspectives*, 2008; J. MALBON, C. LAWSON, M. DAVISON, *The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights: a commentary*, 2014, cit.

⁵⁶ The definition of reputation has been at the center of various debates. The scholars’ concerns regard its interpretation. As a general rule, geographical indications are connected with history and traditions: their existence is based on traditional practices in force for many years and on characteristics traditionally accepted as specific to the relevant area. In a globalized trading world with advanced technological means, there is the risk that reputation can be established really quickly. Please refer to UNCTAD-ICTSD, *Resource book on TRIPs and development*, 2005. Other scholars have taken the issue into account, but concluded that this is nonsense. There is no reason why reputation needs to be developed over a significant period of time. At this respect, please refer to J. MALBON, C. LAWSON, M. DAVISON, *The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights: a commentary*, 2014, cit.

In the same direction, it can be recalled that the European Union, which has provided for the highest standard of protection of geographical indications, as better outlined throughout this thesis, has built up a specific category of signs only to protect traditional methods and processes (so called, Traditional Specialties Guaranteed).

Some other scholars have analyzed other issues concerning the “reputation”. Please take into account the translation of the expression in the languages of the member countries. For instance, the term “reputation” is translated in Italian with the name “notorietà” that is, literally, more generic. Hence, there may be the risk of an unjustified expansion of geographical signs. It has been argued that this is

*is essentially*⁵⁷ *attributable to its geographical origin*⁵⁸.

Once clarified the notion of geographical indication, it is time to shift to the analysis of the protection granted to the mentioned signs.

First of all, the provisions regulating geographical indications – as all the other categories – are subject to the general principle of “minimum standards”⁵⁹.

Therefore, under the TRIPs, signatory countries are not ordered to implement a certain system, but rather requested to provide the interested parties with the legal means⁶⁰ necessary to prevent:

- i) the designation of a good that misleads the public as to the geographical origin⁶¹;
- ii) the use of a geographical sign in a way that constitutes an act of unfair competition pursuant to the Paris Convention⁶²;
- iii) the application of a geographical name that, although literally true with

not an issue: regardless of the translation, what matters in terms of protection is the distinctiveness of a name and its ability of identifying a specific product bearing special qualities derived from its area of provenance. On this point, please refer to A. GERMANÒ, *Le indicazioni Geografiche nell'Accordo TRIPs*, in *Rivista di Diritto Agrario*, volume 3, part 1, 2000, cit.

⁵⁷ It is worth noticing that – choosing the term “essentially” – the TRIPs has extended the area of application of geographical signs compared to the Lisbon Agreement, which referred also to qualities “exclusively” due to certain provenance. The same term “essentially” has been selected in the definition of geographical indications provided for by the Geneva Act.

⁵⁸ The TRIPs does not specify that the geographical origin may include “natural and human factors”, as the Lisbon Agreement did. Some scholars interpreted that omission relevant. Please refer, on this theme, to A. CONRAD, *The protection of Geographical Indications in the TRIPs agreement*, in 86 *Trademark Rep.*, 1996, cit.

Other scholars, on the contrary, have overcome this critic. They argued that the relevance of “natural and human factors” is naturally connected with the definition of geographical indications. In fact, whether it is necessary that the products derive their properties from the relevant geographical area, it is automatic that the origin involves also natural factors, climate together with processing methods and production’s means. On this topic, please refer to A. GERMANÒ, *Le indicazioni Geografiche nell'Accordo TRIPs*, in *Rivista di Diritto Agrario*, volume 3, part 1, 2000, cit.

Either way, as already mentioned, when defining the geographical indications, also the Geneva Act does not include any further specification.

⁵⁹ Please refer to Article 1 of the TRIPs.

It basically means that the signatories shall give effect to the obligations set forth in the Agreement, but are not obliged to implement in their domestic legislation more extensive protection than that required by the agreement itself. In other words, in protecting domestic and foreign geographical signs, the TRIPs is a floor which can be exceeded, but not diminished.

⁶⁰ The expression “legal means” is compliant with the above-mentioned principle of “minimum standard”. It can cover a broad range of legal tools or combinations of the same.

⁶¹ Please refer to Article 22(2)(a).

⁶² Please refer to Article 22(2)(b). On this point, as already referred to herein, Article 10bis of the Paris Convention describes “unfair competition” any act which is contrary to honest practices in industrial or commercial matters.

regard to the origin, falsely represents to the public that the products comes from another territory⁶³.

In addition, the signatories shall, if their legal system so permits, refuse or invalidate the registration of a trademark containing a geographical sign likely to be misleading as to the true place of origin⁶⁴.

To sum up, Article 22 shall be reminded because it is the current benchmark for the international protection of geographical indications relating to any kind of product. It sets a standard level of protection against deceptive and misleading acts, entrusting each signatory country to determine the precise nature of the implementation.

It also provides a first guideline to dissolve potential conflicts between geographical signs and analogous trademarks, although, for deeper comprehension, it should be read together with the “grandfather” clause provided for in Article 24 (hereinafter analyzed).

2.5.2. Article 23: Additional Protection for Geographical Indications for Wines and Spirits

If Article 22 provides a standard level of protection for all geographical indications, Article 23 is intended to ensure a comprehensive guarantee for geographical names relating to wines and spirits⁶⁵, by implementing a system effective in preventing

⁶³ Please refer to Article 22(4). This provision is intended to regulate the cases of so called homonymous geographical signs. These are geographical names which are spelled and pronounced alike (most of time because the relevant territories have been name during the colonist era), but refer to an entirely different geographical location.

To better understand the case, please refer to a meaningful example provided by scholars: “a couturier from Paris, Texas, may not be able to see the mark PARIS on its clothes – notwithstanding geographical truth – if consumers would believe that those clothes come from Paris, France”. G.B. DINWOODIE AT AL., *International Intellectual Property Law and Policy*, 2001, cit.

⁶⁴ Please refer to Article 22(3). For sake of completeness, with regard to this provision some scholars have noted how curious is the formula of this provision. It seems to be applicable only when the geographic name is reproduced in its entirety and precise form. As a consequence, trademark registered with small variations to the geographic name would not contravene a literal interpretation of the provision. On this matter, please refer to J. MALBON, C. LAWSON, M. DAVISON, *The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights: a commentary*, 2014, cit.

⁶⁵ For sake of completeness, please take into account the difference between wine and spirit. “Wine” includes products deriving from the fermentation of fruits. “Spirits” come from distillation and consequently have a significantly higher alcohol content.

names from becoming “generic terms”⁶⁶.

In particular, member countries shall enact all the proper legal means to impede the use of false geographical indications for wine and spirits. And that is valid in absolute terms, meaning even where there is no risk of consumers being misled as to the true origin of the good. In other words, the use of geographical signs is to abide also where the true origin is indicated or used in translation⁶⁷ or accompanied by expressions such as “kind”, “type”, “style” and others⁶⁸.

Signatories shall refuse or invalidate registration of trademark which contains or consists in a protected geographical indication⁶⁹. This provision is once again intended to determine the relationship between trademarks and geographical indications. It is similar to what already provided for in Article 22, although there is no need that the use of the trademark would mislead the public. In any event, for deeper comprehension, this provision should be read together with the “grandfather” clause provided for in Article 24 (hereinafter analyzed).

Furthermore, in the event of homonymous geographical indications, protection shall be granted to each of them provide that they are not deceptive nor misleading. This is the case when there are two identical geographical indications, both legitimate, and so each country shall determine the relevant practical conditions to be used to differentiate them⁷⁰.

⁶⁶ The additional protection negotiated for wine and spirit represents the greatest achievement for European countries, which succeeded in imposing to many countries whose legal tradition was not familiar with the protection of Geographical Indications an extra protection for a particularly sensitive sector. As noted by some authors, in contrast with other Intellectual Property issues, the question of increased protection for wine and spirits remains one of the principal obstacles to the execution of the agreement. On this point, please refer to A. CONRAD, *The protection of Geographical Indications in the TRIPs agreement*, in 86 Trademark Rep., 1996, cit.

In addition, it is worth noticing that the importance of the wine sector has historical roots. As mentioned herein, the Madrid Agreement already dealt with this topic. It included a specific provision for wine, establishing that regional indications concerning the wine the provenance of wine cannot become generic.

⁶⁷ The inclusion of the prohibition of the use of geographical signs in translation is new with regards to the other international agreements and with no doubt represents a considerably strengthened of the level of protection.

⁶⁸ Please refer to Article 23(1).

⁶⁹ Please refer to Article 23(2).

⁷⁰ Please refer to Article 23(3). This provision addresses the issue of winegrowing regions in different countries that have the same name or same sounding name. As noted by the authors, this is quite possible considering the tendency of migrants to produce product and adopt names from their previous homelands. A famous example is Rioja, which is a region specialized in the wine production

Lastly, with the aim to provide the greatest protection to geographical names relating to wine, as a negotiation tool, TRIPs countries held a built-in agenda, entrusting the parties to enter into future discussions in order to establish a multilateral notification and registration system for geographical indications of wine⁷¹.

For our purposes, this is a particularly meaningful provision because it paves the way for a kind of “super” protection of geographical indications and constitutes a legal basis on which founding international obligations. In the conclusive remarks of this dissertation, when analyzing the ongoing debates on the protection of geographical indications, it will be discussed how a multilateral register for wine and the extension of this omni-comprehensive system to all goods (combining also some elements of the Geneva Act) might be feasible in the global scenario and beneficial for trade of geographical quality products.

2.5.3. Article 24: International Negotiations; Exceptions

Article 24 is the closing provision of the section dedicated to geographical indications. It contains some miscellaneous prescriptions together with exception clauses to the basic protection as set forth in previous Article 22 and 23.

Starting from the general instructions, by entering into the TRIPs, members literally undertake to enter into negotiations aimed at increasing the protection of individuals geographical indications under Article 23⁷². Furthermore, the Council for TRIPs shall constantly keep under review the application of the entire set of rules relating to geographical indications⁷³. Lastly, apart from complying with the TRIPs rules, each member shall not diminish the level of protection existing in the country itself immediately prior to the entry into force of the agreement⁷⁴.

both in Spain and Argentina. Refer to M. CORREA, A.A. YUSUF, *Intellectual Property and International Trade: the TRIPs Agreement*, 2008, cit.

⁷¹ Please refer to Article 23(4).

⁷² Please refer to Article 24(1). The author decides to mention here this provision and suggests to the reader to keep it in mind. As we will see hereinafter it can be argued that, already at the time of the adoption of the agreement, this provision was included in order to guarantee the legal ground for extending the additional level of protection to all kinds of products.

⁷³ Please refer to Article 24(2). Similarly as what stated above, the author decides to mention here this provision and suggest to the reader to keep it in mind. As we will see hereinafter in fact some authors have identified in this provision an incentive to improve (extend) the system.

⁷⁴ Please refer to Article 24(3).

The remaining paragraphs of Article 24 are dedicated to the said mentioned exceptions to the conventional system.

First of all, each contracting party has the right to grant to its nationals or domiciliaries the right to continue to use a geographical indication for wines or spirits of another party, provided that the sign has been continuously used for at least 10 (ten) years or in good faith prior to the signature of the TRIPs⁷⁵.

If this exception is limited to names of wines and spirits, TRIPs regulated also the event when the continued use of geographical indications in a country other than that origin relates to any kind of products. It is allowed the use those geographical signs, provided that, in the country of application, these indications have become the common⁷⁶ name for that particular product. And the scope of protection is not restricted to nationals or residents.⁷⁷

Moreover, as already mentioned, Article 24 sets forth special rules governing the relationship between geographical indication and trademarks indicating a geographical provenance. To this extent, TRIPs allows the existence and validity of those trademark that were either applied for or registered or acquired through use in good faith before the date of application of the TRIPs in the relevant country or before the geographical sign is protected in the country of origin⁷⁸.

⁷⁵ Please refer to Article 24(4). This provision is significant because it is designed to allow, under certain circumstances, the status quo that existed before the enhancement of the agreement. At this respect, please refer to J. MALBON, C. LAWSON, M. DAVISON, *The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights: a commentary*, 2014, cit.

With reference to the requirements to the application of Article 24(4), the two main features are (i) the continuous use of the signs, meaning a use never substantially interrupted and (ii) the restriction of the personal scope of application of the right, which is granted in favor of only nationals or resident in the country of protection. That means that the right cannot be exercised with reference of third countries. On this point, please refer to R. KNAAK, *The protection of Geographical Indications according to the TRIPs Agreement*, in F. BEIER, G. SCHRICKER, *From GATT to TRIPs – The Agreement on Trade-Related Aspects of Intellectual Property Rights*, 1996.

⁷⁶ Please note the terminological choice of the term “common” rather than “generic”. This is possible because the latter has a connotation typical of trademark law, while the former has a broader meaning. At this respect, please refer to J. MALBON, C. LAWSON, M. DAVISON, *The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights: a commentary*, 2014, cit.

In any event, for what matters at our purpose, such a finding shall rely on the actual use of the term by both consumers and the industries.

⁷⁷ Please refer to Article 24(6).

⁷⁸ Please refer to Article 24(5). Some authors have highlighted some weaknesses of this provision. First of all, the major concerns relate to the definition of “good faith”. Considering that a geographical name – for its nature – its rarely used without knowing its origin, the most reasonable solution would be to interpret “good faith” as meaning without deceptive or misleading intent during the use over time. Secondly, if it is stated that the validity of the trademark is subject to the condition that its registration

At first glance it is possible to notice a huge limitation with respect to the rights provided for by Article 22 and 23. In fact, if the latter would *tout court* prevent the use of a prior registered trademark in favor of a later geographical indication, the former is to negate this effect to trademarks having certain properties. Therefore, this provision is designed in order to move forward to the current situation and protect from future misappropriations⁷⁹.

Lastly, Article 24 explicitly states that no country shall protect any geographic sign if they are not protected or have fallen in disuse in the country of origin.

To sum up, Article 24 serves to both leave the door open to further discussions on the extension of protection and set forth some limits to the sensitive issue of how to deal with previous generic/common geographical names. At this respect, as we will demonstrate further herein, it provides a half-way reconciliation between divergent interests that can be useful when trying to implement a multilateral system of protection of geographical signs.

Before getting to the conclusive remarks of this chapter, it is worth sketching some hints on those provisions of TRIPs that distinguish it from the other international agreements (that dealt exclusively with substantial issues) and make it practically more effective. We make reference to enforcement and dispute settlement.

2.5.4. Enforcement and dispute settlement

Without any analytic purpose (it overcomes the focus of this dissertation), only some

occurred prior to the protection of the Geographical Indication in the country of origin, the “domino” effect is to favor states which already have a strong system of protection of geographical signs at the time of the TRIPs to the detriment of those which acted more recently. Please refer to A. CONRAD, *The protection of Geographical Indications in the TRIPs agreement*, in 86 Trademark Rep., 1996, cit.

Regardless of all these critics, this provision shall be deemed an effective tool for the future. In fact, once in force and once adopted the TRIPs, it would be difficult for relatively new trademarks identifying geographical areas to claim good faith and be established.

For sake of completeness (even though this will be object of specific analysis throughout the comparative chapter of this thesis), under the EU perspective it cannot be denied that the circumstance that the protection is substantially valid for the future causes an indirect acceptance of freeriding of certain hugely famous names. At this respect, please refer, among others to A. GERMANÒ, *Le indicazioni Geografiche nell'Accordo TRIPs*, in Rivista di Diritto Agrario, volume 3, part 1, 2000, cit.

⁷⁹ At this respect, please refer to KNAAK, *The protection of Geographical Indications according to the TRIPs Agreement*, in F. BEIER, G. SCHRICKER, From GATT to TRIPs – The Agreement on Trade-Related Aspects of Intellectual Property Rights, 1996, cit.; M. CORREA, A.A. YUSUF, *Intellectual Property and International Trade: the TRIPs Agreement*, 2008, cit.

major features of the enforcement part of the TRIPs⁸⁰ are recorded.

On a surface level it can be easily argued that having international protection for intellectual property rights is not enough without proper enforcement. Hence, the TRIPs lays down general obligations that all enforcement procedures must meet, together with some specific rules regarding civil and administrative procedures and remedies, provisional measures, special requirements related to border measures and criminal procedures.

All these provisions have in common two basic objectives: i) firstly, to ensure that effective means of enforcement are available to right holders; ii) to grant that enforcement procedures are applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

By way of example, the TRIPs provides expressly that procedures shall be fair and equitable, not unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays. In addition, the decisions shall preferably be in writing and reasoned, and they shall be made available at least to the parties to the proceeding without undue delay. Furthermore, in order to facilitate member states' compliance, TRIPs does not set forth any obligation to put in place a judicial system for the enforcement of intellectual property rights distinct from that for the enforcement of law in general, nor did it affect the capacity of Members to enforce their law in general.

In addition to the enforcement system, TRIPs expressly provides that disputes between members regarding respect any of their obligations under the agreement itself are subject to the WTO's dispute settlement procedures⁸¹. Without objective of completeness⁸², it can be stated that settling disputes is the responsibility of the so called Dispute Settlement Body which consists of all WTO members. The Dispute Settlement Body has the sole authority to establish "panels" of experts to consider the case, and to accept or reject the panels' findings or the results of an appeal. The discussion of the case is carried out basically as ordinary trials, with evidence and hearings.

A system of revision has been provided: the decisions of the Dispute Settlement Body

⁸⁰ Please refer to TRIPs, Part III – Enforcement of Intellectual Property Rights, Articles from 41 to 61.

⁸¹ Please refer to TRIPs, Part V — Dispute Prevention and Settlement, Articles 63 and 64.

⁸² For a complete description of the Dispute Settlement procedures under the WTO, please refer to WORLD TRADE ORGANIZATION, *Dispute Settlement gateway*. available at: https://www.wto.org/english/tratop_e/dispu_e/dispu_e.htm.

may generally be appealed before the Appellate Body⁸³.

Once the case is decided, the infringing country should correct its fault. And if it continues to break an agreement, it should offer compensation or face a suitable response, the ultimate goal being in any case for the country to comply with the ruling.

3. CONCLUSIVE REMARKS

This chapter introduces the topic of geographical indications.

It recalls their nature, strictly connected to history, culture and social habits of countries. It highlights, in this context, the crucial role played in the communities and in their economic development and, as last resort, their relevance in the international trade.

Taking the first steps from the need of protection as an economic tool and advantage, various attempts have arisen, firstly, at national level and then on the international scenario.

This first chapter starts from describing the international scenario which reflects the current state of play.

It describes the first agreements and then the TRIPs.

In light of the analysis, it seems clear that, compared to the other agreements, TRIPs represent a watershed in the international trade system. In fact, it provides for an adequate and effective protection against false or misleading acts, it prevents the registration of identical geographic trademarks, save for specific cases, and avoid risk of dilution of geographical signs into generic terms.

Nevertheless, according to the author's view (intended to protect all producers interested in preserving the value of the provenance of their products), the TRIPs is not complete, being influenced by the negotiating muscles of those countries (such as USA) seeking to limit geographical indications protection rather than extending it.

Hence, some further efforts should be undertaken. And they may be the enhancement of multilateral register of geographical indications for wines and spirits, followed by

⁸³ For sake of completeness please note that the each appeal is heard by three members of a permanent seven-member Appellate Body. The latter is set up by the Dispute Settlement Body and broadly representing the range of WTO membership. Members of the Appellate Body have four-year terms. They have to be individuals with recognized standing in the field of law and international trade, not affiliated with any government.

the extension of this level of protection to all products. Together with the inclusion of some attractive hints (or concessions), especially in terms of flexibility in the implementation process and interests for the other countries⁸⁴.

Indeed, TRIPs shall be deemed a good legal basis, considering that all the substantial provisions are accompanied by a comprehensive system of enforcement and dispute settlement (lacking in the other international agreement).

In order to get to this conclusion, the dissertation focuses, first separately, on the two systems most representative of the different approaches to geographical indications. It starts by recalling the European Union system, underlining the effectiveness and adequateness of this system which shall be considered a benchmark for protecting the interest of all those producers and countries relying on the qualities and characteristics of the area of origin. In particular, it provides for the definition of geographical indications, their properties, their “public” ownership, the protection connected thereto (highlighting that it is granted to the maximum extent possible, also against evocative behaviors) and the automatic and widespread control system.

Then, it shifts to the other side of the Atlantic Ocean, describing the US system of protection focusing on the “private” approach, describing the conditions under which geographical names can be protected as trademarks, their private ownership and the protection primarily entrusted to individual actions.

Lastly, it compares the two systems highlighting the underlying conflicting interests together, likely to be reconciled and balanced in light of the compatibility of their features. At the very end, it displays the mentioned conclusion (i.e. enhancement of the international renewed system) and support its feasibility in light of all the previous considerations and underlining also the role of regional trade agreements,

⁸⁴ Suggesting the adoption of a multilateral extended system of protection of geographical indications accompanied with some concessions from the EU side in order to get to a consensus, crucial for the future, is the core of this dissertation. Differentiated and well-explained analysis and focus will get the reader to deeply understand this position.

In any event, among the numerous opinions and copious research activity carried out in order to build up the guidelines of this dissertation and get to the proposal analyzed herein, the author believes it may be interesting to mention one remark, special to her. Please refer to A. JANNARELLI, *La proprietà intellettuale e la catena alimentare*, in *La tutela dell’origine dei prodotti alimentari in Italia, nell’Unione Europea e nel commercio internazionale*, Atti del Convegno, Alessandria, 21/22 maggio 2015.

Professor Jannarelli highlights in a bright manner how much intellectual property rights matter in the agri-food sector and, more than in other sectors, economic and social environments affect them. As a consequence, none of the statements and proposals relating to the intellectual property rights for foodstuff can ignore to take into account social, political and economic forces and carefully balance them.

geographical indications in developing countries, which have been showing an increasing demand for the implementation of an omni-comprehensive system of protection, in addition to the consumers driving force and the general (spread) economic value of geographical indications.

CHAPTER II:
PROTECTING THE ORIGIN OF FOODSTUFFS IN THE EUROPEAN UNION INDICATIONS
OF ORIGIN REGULATION

SUMMARY: 1. Introduction – 2. The comprehensive system of protected designations of origin and protected geographical indications: Regulation UE No. 1151/2012 – 2.1. Material and territorial scope of Regulation UE No. 1151/2012 – 2.2. The notions of protected designation of origin and protected geographical indication – 2.3. The notion of “geographical area” – 2.3.1. The “Feta” case – 2.3.2. The “Altenburger Ziegenkäse” case – 2.4. The relevance of processing and packaging of food products with regard to the protection of geographical indications – 2.4.1. The “Rioja” case – 2.4.2. The “Prosciutto di Parma” case – 2.5. The quality symbols – 2.6. The “generic” nature of geographical terms – 2.6.1. The “Grana Biraghi” case – 2.6.2. The “Feta” case – 2.6.3. The “Bayerisches Bier” case – 2.6.4. The “Parmesan” case – 2.6.5. The “Gouda” case – 2.7. The procedure of registration of geographical names – 2.7.1. The national scrutiny – 2.7.2. The scrutiny by the European Commission – 2.8. The level of protection granted to registered geographical indications – 2.8.1. The “Cambozola” case – 2.8.2. The “Verlados” case – 2.8.3. The “Toscoro” case – 2.9. The system of controls under Regulation 1151/2012 – 3. Conclusive remarks.

1. INTRODUCTION

The first chapter of this dissertation introduced the international framework of protection of geographical indications, outlining the borders where the single domestic models have to live. As mentioned, the international rules provide for a basic (or better, minimum) level of protection of geographical signs for foodstuff against misleading and unfair behaviors, leaving it to each country to enhance its internal system of protection. In this context, EU chooses to apply to geographical names for foodstuff the highest-level possible of guarantee, as such adopting a mainly “public” approach¹.

As briefly mentioned in the first chapter, the final goal of this dissertation is to offer to politicians, stakeholders and researchers a multilateral system providing for an extensive protection of geographical indications for food products. Indeed, being

¹ For sake of clarity, it is worth mentioning that, within the academia, there are some isolated voices running against the extensive system of protection of geographical indications for foodstuff provided for by the EU law. According to these folks, the whole system should be reformed in a more competitive-oriented perspective. In particular, initiatives to prevent freeriding or usurpation should be left to private stakeholders and parties, while the public authorities should supervise over food frauds and unfair behaviors. Please refer to M. LIBERTINI, *I segni geografici protetti: pubblico e privato, protezionismi e concorrenza*, in AIDA, 2015.

acknowledged of the material traits of the EU system of protection of geographical signs (to be complemented with the analysis of the “rival” US system) seems to be extremely useful in order to fully understand the author’s proposal. The EU system, being a *sui generis* one and tailored made upon the values connected with geographical provenance, shows numerous elements that – although with certain compromise necessary to gather all the (partially) different global needs – can be used as a template.

In light of this, this second chapter focuses precisely on the EU rules governing the geographical signs connected to the quality of foodstuff.

We have already taken note that the link between tradition – and so certain qualities – and geography has always been appreciated and of greatest importance within the food sector. Geographical indications, generally speaking, have historically represented a key instrument of protection of cultural heritage, traditional methods of production and natural resources². Each country has adopted its personal view on the topic.

EU followed the path of historically considering geographical indications as signs of quality. For instance, in ancient Egypt brick makers indicated the resistance bricks and stones with which pyramids were made with origin related signs. As well in ancient Greece geographical signs were valuable. Thasian wine (from the island of Thasos, Macedonia region, Greece) yielded a price premium of 20 drachmas for 20 liters. Other geographical indications nowadays widespread, such as Parmigiano or Comté, dates back to early 13th century.

In light of this, it is at first sight clear – from the EU’s eyes – that geographical indications represent the legal tool which defines the identity of a place and of the groups operating there, ensuring certain qualities and properties to the relevant products³.

² Please refer to EUROPEAN COMMISSION, MEMO/03/160, *Why do Geographical Indications matter to us?*, Brussels, 30 July 2003.

³ For the sake of completeness, it is worth noticing that many authors have expressly underlined the importance of geographical indications in the process of association of the products with qualities, characteristics and traditional knowledge of a designated place.

At this respect, please refer to J. ANDERSON, *Law, Knowledge, Culture: the production of indigenous knowledge in Intellectual Property Law*, Cheltenham: Edward Elgar, 2009; D. GANGJEE, *Relocating the law of geographical indications*, Cambridge University Press, 2012; J. GIBSON, *Community Resources: Intellectual Property, International Trade and Protection of Traditional Knowledge*, Farnham: Ashgate, 2009; T. VOON, *Cultural products and the World Trade Organisation*, Cambridge University Press, 2007.

From a further point of view, geographical indications, representing – as stated – an origin link that implies tradition and quality (emphasizes the relationship between human efforts, culture, land, resources and environment), constitutes also a preferential path to place products in the relevant market and obtain a production prize, while maintaining a local specialty.

Under the consumerist perspective, geographical indications can serve as a significant means in light of consumers assigning increasing value to tradition and characteristics underlying food. In fact, it has been studied that consumers associate certain qualities to food produced in specific territories/areas and are willing to pay a premium for traditional products from that source⁴.

At this respect, among the other possible examples, it is worth considering that, nowadays, in a supermarket, when doing their groceries, consumers have the choice between many types and varieties of products. Besides the price, another important factor that may influence the consumers' decision to pick one product over another is the quality reputation related to the geographical origin of the product concerned. In particular, Millennials⁵ want *'to know where their food is from. [They] want to know how it is made, who raised it, who grew it, nurtured it. [They] want to know how [the]*

Thereafter, it can be stated that a cultural heritage perspective has been adopted. According to this view, geographical indications are essential in affirming the identity and defining the creativity which a certain community has succeeded in developing over time. Geographical indications, in fact, identify local goods produced following traditional techniques and exploiting specific local properties, embodying, as such, a portion of territorial knowledge and promoting cultural background of the related community. It means that, under a substantive perspective, geographical indications may be deemed a constitutive element of a territory, part of the intangible cultural heritage of the country they belong to.

More precisely on the cultural heritage perspective, please refer to I. CALBOLI, *In territorio veritas: bringing geographical coherence in the definition of geographical indications of origin under TRIPs*, in WIPO Journal. 6, (1). Research Collection School Of Law, 2014; B. UBERTAZZI, *EU Geographical Indications and Intangible Cultural Heritage*, in International Review of Intellectual Property and Competition Law, August 2017, Volume 48, Issue 5.

As conclusive remarks on the matter, it may be added that some authors have pointed out that the extrinsic nature of geographical indications (meaning their role as pillars in building a community's environment) is not static. Geographical indications in fact are filled with a transformative power that allows them to affect and intervene on values, traditions and practices constituting a designated identity.

On this point, please refer to M. FERRARI, *The narratives of geographical indications*, in International Journal of Law in Context, 2014, 10, 2.

⁴ For further analysis on the consumers interest towards geographical indications and the relevant will of paying premium prices for geographic base products, please refer to chapter 4, part II, paragraph 1.1 of this dissertation.

⁵ Generation of people who came of age in the beginning of the third Millennium; birth dates beginning 1980-1992 and ending 1995- 2004.

*ingredients came to be, the details of their origins*⁶. In other words, the territory, referring not only to the geographical area, but also a mix of cultural, environmental and historical element, represents a relevant driver for consumers.

In light of all the above, since 1992 the EU institutions has underlined the relevance of adopting/implementing/shaping an harmonized system of protection of geographic signs, enabling the promotion and identification of food products having specific qualities, attributes and reputation related to the provenance and, as a consequence, preventing unfair use from competitors⁷.

At this respect, for sake of completeness, it is worth recalling that, within the EU system, geographical indications are still not alone in the protection of the value connected to origin of foodstuff (and the related qualities)⁸. In fact, it is not excluded the chance to display the origin through collective European trademarks⁹.

⁶ E. TUROW, *A Taste of Generation Yum*, 2015.

⁷ Please note that the estimated worldwide sales value of products sold under geographical indications registered in the European Union was equal to Euro 54.3 billion in 2010 and had increased of 12% between 2005 and 2010. Over that period wines accounted for 56% of the total sales (Euro 30.4 billion), agricultural products and foodstuff for 29% (Euro 15.8 billion), spirit drinks for 15% (8.1 billion) and aromatized wines for 0.1%.

Data certified by EUROPEAN COMMISSION, *Value of production of agricultural products and foodstuffs, wines, aromatised wines and spirits protected by a geographical indication (GI)*, Final report October 2012. On this point, please note that there seem to be no other updated data, officially made available/released by the EU institutions.

⁸ At this respect, though it does not constitute the core of this dissertation, it seems relevant to recall a bright analysis on the quality signs for food products released within the Italian academia. Some authors notice that the EU panorama is quite a “jungle” of legal tools and signs linked to food quality (i.e. individual and collective trademarks, geographical indications and national signs). Therefore, it cannot be excluded that this background may result in “entropy” at the (possible?) detriment of consumers. Please refer to P. BORGHI, *Sovrapposizioni tra ordinamenti e “fantasia” del legislatore in tema di segni di qualità dei prodotti alimentari: entropia e story telling*, in *Rivista di Diritto Alimentare*, no. 4, October-December 2015.

⁹ Please refer to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version). Pursuant to Article 66, paragraph 2 of the Regulation No 207/2009, it is allowed to register collective trademarks consisting in a sign or denomination that serves to designate the geographical origin of the products. The collective trademarks distinguish from the private trademarks because they identify the goods or services of the members of the association which is the proprietor of the mark from those of other comparable undertakings. Furthermore, it can be stated in advance, the possibility to register “geographical trademarks” represents a derogation from the general rule of distinctiveness, according to which marks cannot be merely descriptive of the origin of the products.

Without being complete, but with the sole objective of providing the readers with all the preliminary information they may need to properly follow the analysis of this dissertation, it seems interesting to give some hints concerning the relationship between collective trademarks and geographical indications.

However, this second chapter leaves in the background the purely intellectual property studies and, instead, analyzes deeper the framework and main elements of the comprehensive system of protected designations of origin and protected geographical indications, set forth by Regulation UE No. 1151/2012 (hereinafter, the Regulation 1151/2012)¹⁰. To be honest (but this is compliant with the premises and purposes of this dissertation) the chapter does not study the Regulation 1151/2012 in all its details. On the contrary, it puts under the spotlight only those elements, which may be relevant in order to understand how the EU model places itself in the international panorama and confronts with the rivals (especially with the US).

To this extent, the chapter is structured as follows. First of all, it introduces the Regulation 1151/2012, explaining that this rule represents a comprehensive landing zone of all the previous legislations and describing its exhaustive nature with regard to the domestic legislations protecting geographical names.

Thereafter, the chapter provides the notion of “geographical indication”, focusing on the related concept of “geographical area”, the rules applicable to eventual processing

In particular, it can be anticipated that – as general rule – when conflicts arise between a trademark (that includes a geographical name) and a geographical indication a priority principle in favor of the geographical indications shall apply.

The simplest case occurs in case of application for a conflicting trademark relating to the same type of product submitted after the date of application for protection of the geographical name. In such an event, the geographical name has the priority, therefore the registration of the trademark shall be refused and, if not, the trademark invalidated.

A second hypothesis provides for coexistence in specific cases, reflected in the permitted use of the geographical signs as well as use of the relevant trademarks. In particular, the use of a conflicting trademark shall not be prevented, first, if it has been applied for, registered, or established by use, in good faith, within the territory of the EU, before the date the date of submission to the European Commission of the application for registration of the geographical indication. Second, if there are no grounds for invalidity or revocation of the trademark under applicable EU legislation. Even though the registration of a conflicting trademark in principle does not prevent registration of a geographical indication pursuant to the said provision, the EU rules on geographical signs provide for a single exception. The registration of a geographical name shall be prevented when it would be liable to mislead the consumer as to the true identity of the product in light of the trademark’s reputation and renown and the length of time it has been used.

With reference to a punctual comparison between geographical indications and collective trademarks, please refer to, among others, Y. VAN COUTER, F. D’ATH, *Protecting the origin of foodstuff in the European Union*, in *European Food and Feed Law Review*, Volume 11, Issue 4, 2016.

In any event, it is worth noticing that the described provisions show a generalized preference towards geographical indications. In fact, whether the registration of a later conflicting trademark is to be refused *tout court*, the registration of later geographical indications is prevented only when there is a material risk of misleading consumers.

¹⁰ Please refer to Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs.

activities of the raw product associated with the geographical name and the exclusion, from the notion, of generic names. At this respect, the chapter studies the circumstances under which geographical names cannot be protected since they are simply terms to identify certain foodstuff.

Given that, it briefly recalls of the procedural steps for the registration (and thus recognition) of geographical names. Such description seems to be significant in order to understand how the procedural machine concealed behind the protection of geographical names is composed and run by a public assessment.

The chapter ends by describing the material level of protection granted to registered geographical indications, listing all the behaviors prevented and highlighting the related organization of controls and enforcement, which purely represents the core of the EU extended and “public” protection and distinguishes it from the other global players.

Both these latter features precisely identify the EU system within the international panorama, where also private-based and less extended schemes operate. As a consequence, these features can contribute to explain why, often, opponents of a multilateral extensive system of protection contest high costs of implementation.

2. THE COMPREHENSIVE SYSTEM OF PROTECTED DESIGNATIONS OF ORIGIN AND PROTECTED GEOGRAPHICAL INDICATIONS: REGULATION UE No. 1151/2012¹¹

The Regulation 1151/2012 is the latest comprehensive legislative measure in the

¹¹ Generally, on the legal system of protection of geographical indications, please refer among others to B. O'CONNOR, *The law of geographical indications*, Cameron May, 2007; WIPO, *Geographical Indications, an introduction*, available at the following internet address: http://www.wipo.int/edocs/pubdocs/en/geographical/952/wipo_pub_952.pdf; M. A. ECHOLS, *Geographical Indications for food products, international legal and regulatory perspective*, Wolters Kluwer, 2008; M. BLAKENEY, *The protection of geographical indications, law and practice*, Elgar Intellectual Property Law and Practice, 2014; S. MASINI, *PDO, PGI and TSG*, in L. Costato, F. Albisinni, *European and Global Food Law*, CEDAM, 2016; M. FERRARI, *The narratives of geographical indications*, *International Journal of Law in Context*, 2014, volume 10, issue 2; M. BENELLI, L. CIANFONI, *La politica di qualità dei prodotti agricoli e alimentari dell'Unione europea*, Istituzioni del Federalismo; F. CAPELLI, *Il Regolamento (UE) n. 1151/2012 sui regimi di qualità dei prodotti agro-alimentari: luci ed ombre*, *Rivista di diritto alimentare*, volume 1, January – March 2014; W. VAN CAENEGEM, S. CLEARY, *The importance of place: geographical indications as a tool for local and regional development*, Springer, 2017; G. COSCIA, *The international framework of geographical indications and designations of origin protection and the European approach*, in *Studi sull'Integrazione Europea*, 2009, volume 3; V. MANTROV, *EU Law on Indications of Geographical Origin*, Springer, 2014.

field of quality of food products. It fully replaces – and partially amends¹² – the previous legal framework, namely Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs and Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs¹³.

¹² The main features of the Regulation 1151/2012 are better detailed hereinafter. However, for a specific list of exclusively the modifications and integrations provided for by the Regulation 1151/2012, please refer, among other, G. STRAMBI, *Le novità introdotte dal Reg. UE n. 1151/2012 con riguardo alle denominazioni di origine protette, alle indicazioni geografiche protette, alle specialità tradizionali garantite e alle indicazioni facoltative di qualità*, in *Il nuovo diritto agrario dell'Unione Europea*, A. Germanò, G. Strambi (a cura di), 2014. The author recalls each of the amendments (or better, as defined in the article, developments and updates, since the Regulation 1151/2012 does not change the basic pillars of the system), mentioning, among the other, the comprehensive nature of the Regulation 1151/2012, the even out of the rules applicable to PDO, PGI and TSG (i.e. the different quality signs), the introduction of *ex officio* controls, better described in the last paragraph of this chapter.

¹³ With the sole purpose of giving an idea of the development of the EU rules on geographical indications, please note that, compared to 1992 rules, Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs introduces an innovative regime of controls and supervisions, in addition to new rules for registering geographical names of third countries, evening out the relevant procedure to that referred to EU products.

As for what concerns this latter topic, according to the 1992 regulation, the EU would register within its territories foreign geographical names provided that the relevant third country either has an adequate system of protection of geographical indications (i.e. a model equivalent to the EU's with regard to product specification and controls) and grants protection to corresponding EU products. Such provisions governing the registration of third countries geographical names were challenged by the US and Australia on the basis of discriminatory charges (in particular, charging the violation of the “national treatment” and “most favoured nation” principles), since there was a discrepancy in treating/evaluating EU and third countries geographical names, making the access to the EU market more difficult for foreign products. Further to these disputes, the WTO dispute settlement body issued some recommendations (please refer to reports WT/DS/174/R and WT/DS/290/R), demanding the EU to revise its internal rules. Although technically there is no legal obligation to directly implement WTO rules and recommendations, but in order to avoid eventual trade sanctions or pay backs, the EU introduced new rules to adequate its model to the outcome of such double disputes charged by US and Australia. After the amendments, analog procedure steps and requirements apply also to third countries. At this respect, please refer to EUROPEAN COMMISSION, *Proposal for a Council Regulation on the protection of geographical indications and designations of origin for agricultural products and foodstuffs /COM/2005/0698 final*, stating (in paragraph 5 of the explanatory memorandum) that “*following the lodging of complaints WT/DS174 and WT/DS290 with the World Trade Organisation (WTO) by the United States and Australia respectively, the WTO Dispute Settlement Body (DSB) adopted on 20 April 2005 the Panel Reports on the European Communities - Protection of trademarks and geographical indications for agricultural products and foodstuffs. Those Reports conclude that Regulation (EEC) No 2081/92 is incompatible with Article 3:1 of the TRIPS Agreement and with Article III: 4 of GATT 1947. It is necessary to bring that Regulation into line with the TRIPS Agreement and GATT 1994 by the deadlines agreed with the other parties concerned*”.

The amendments of EU rules after the WTO disputes are analyzed in the academia.

Regulation 1151/2012 is included a broader political plan¹⁴ addressed at promoting quality agriculture to replace merely quantitative reasoning. In light of this, the Regulation 1151/2012 regulates not only simple geographical signs, but rather, more broadly, the quality schemes for agricultural products useful to defend and support both farmers/producers and consumers. Regulation 1151/2012 expressly makes clear such objectives.

It opens by underlining that the quality and diversity of the European Union's agricultural, fisheries and aquaculture production gives a competitive advantage to the European Union's producers and makes a major contribution to their living cultural and gastronomic heritage¹⁵.

In fact, quality and diversity of the European Union's agri-food production are increasingly demanded by citizens and consumers, with the effect of generating a demand for agricultural products or foodstuffs with identifiable specific characteristics, in particular those linked to their geographical origin¹⁶.

As a consequence, those producers who endorse skills and determination to keep

Some authors describe in detail the content of the amendments and reflect on the effect of the WTO rules into the EU. Though – according to the constant opinion of the ECJ – WTO rules have no direct effect in the EU law system, EU decided to adequate its discipline to the Panel's findings and conclusions, in order to avoid countermeasures (known as “retaliation”). Such decision may not be without consequences. The author suggests to reflect on the possible competitive and economic outcomes of such an harmonization. The EU risks to open its market to products that pass the registration test, but may not be produced according to the high EU standards, but following less strict requirements. Please refer also to S. VISSER, *La protezione delle indicazioni geografiche e delle denominazioni d'origine dei prodotti agroalimentari a seguito del rapporto del “Panel” dell'Organizzazione mondiale del commercio*, in *Agricoltura istituzioni e mercati*, volume 1, 2007.

¹⁴ Regulation 1151/2012 is included in the broader EU policy on quality of food products. Such placement is not random. Instead, it reflects a precise purpose of the EU legislator and is line with some remarks developed during the years within the academia. For instance, Professor Albisinni, when reflecting on the value of origin in the agricultural markets, provides some interesting hints on the matter.

Firstly, he notices how origin (serving as a declaration of the link between product and relevant territory) represents a general and essential means of promotion and evaluation of the whole agricultural production. Origin enables to satisfy consumers' needs concerning foodstuff and, in particular, the intimate relationship with the products they choose to eat. As a consequence, it is necessary to implement harmonized rules for regulating – from a quality and safety perspective – the whole market, in order to provide consumers with complete information under all perspectives. And geographical indications constitute a piece of such broader puzzle. In other words, rules on origin lies at the heart of the agri-food markets, being a means to safeguard consumers' interests and fair competition among producers. Please refer to F. ALBISINNI, *L'origine dei prodotti alimentari*, in *Il diritto alimentare tra sicurezza dei prodotti e comunicazione*, A. Germanò, E. Rook Basile (a cura di), 2009.

¹⁵ Please refer to Whereas 1 of Regulation 1151/2012.

¹⁶ Please refer to Whereas 2 of Regulation 1151/2012.

traditions alive balancing them with the developments of new production methods and material shall be rewarded fairly for their effort. And the reward may come if they are provided with quality schemes and enabled to communicate to buyers and consumers the characteristics of their products under conditions of fair competition and to correctly identify their products on the marketplace¹⁷.

Furthermore, another important result for the general agricultural policy of operating quality schemes is the benefit for rural economy, particularly in less favored areas, in mountain areas and in the most remote regions, where the farming sector accounts for a significant part of the economy and production costs are high. The existence of quality schemes – and the added value connected thereto – provides producers with a tool to sustain their production, at the same time contributing to and complementing rural development¹⁸.

To sum up, the European Union has tailored/established a specific system for protected designations of origin and protected geographical indications adequate to essentially (i) secure fair returns to producers for the qualities of their products; (ii) ensure uniform protection in the European Union territories – as intellectual property rights – to the geographical signs and (iii) grant consumers to make more informed purchasing choices by providing clear information on the value adding attributes of the products¹⁹.

2.1. Material and territorial scope of Regulation UE No. 1151/2012

Regulation 1151/2012 applies to agricultural products and foodstuffs intended for human consumption without extending its effects to wine, spirit drinks, aromatized wines or grapevine products that, on the contrary, are regulated by more specific vertical regulations and that benefit from an even broader scope of protection²⁰.

¹⁷ Please refer to Whereas 3 of Regulation 1151/2012.

¹⁸ Please refer to Whereas 4 of Regulation 1151/2012.

¹⁹ Please refer to Article 4 (Objective) of Regulation 1151/2012.

²⁰ As already made clear in Chapter 1, the scope of this dissertation is limited to food products and does not extend to wines and spirits. However, in order to provide the readers with a complete regulatory picture in the field of geographical indications, it is worth noticing that, with regard to wines, please refer to Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organization of the markets in agricultural products. While, with reference to spirit drinks, please refer to Regulation (EC) No 110/2008 of the European Parliament

More precisely, Regulation 1151/2012 applies to the both agricultural products listed in Annex I to Treaty on the Functioning of the European Union and foodstuff and other products detailed in Annex I to the Regulation 1151/2012²¹. Annex I of the Treaty on the Functioning of the European Union includes basic foods intended for human consumption, listing products of the soil, of stock farming and of fisheries, as well as products of first stage processing. While Annex I to Regulation 1151/2012 has a broader application, including new categories of food products, such as chocolate, bread, pastry, biscuits, pasta, salt products and other “non-agricultural” such as natural gums and resins, hay, essential oils, cork, flowers and ornamental plants, cotton, wool, wicker, scutched flax, leather, fur and feather.

For the sake of completeness, it is important to highlight also the territorial scope of Regulation 1151/2012. In fact, both products manufactured in one of the Member States and products manufactured in third countries may benefit from the European schemes of protection of geographical indications. It means that the producers not established in the EU – but meeting the qualifying terms to request a registration – have the right to apply for a geographical indication in order to protect the geographical origin of their foreign products in the European Union territory.²²

In order to close the section related to the nature of Regulation 1151/2012, it is worth giving some hints with regard to its relationship with the internal legislations of member States. In fact, as of now, the EU legislator has not specified whether the system of protection of geographical indications has an exclusive nature (thus precluding the chance that member States can introduce specific domestic rule able to create a parallel protection system) or it is, vice versa, a matter of shared competence between the EU institutions and the national legislators (as such, leaving room for cumulative domestic protection for those names of products not registered between the EU system).

and of the Council of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks.

²¹ Please refer to Article 2, paragraph 1 of Regulation 1151/2012. At this respect, it is interesting to notice that, although agricultural and food products are ontologically distinct, they are subject to the same rules when it comes to geographical indications. For such a remark, please refer to F. ALBISINNI, *L'origine dei prodotti alimentari*, in *Il diritto alimentare tra sicurezza dei prodotti e comunicazione*, A. Germanò, E. Rook Basile (a cura di), 2009, cit.

²² Please refer to footnote 13 above and take into account that, so far, rather few applicants based outside the European Union have applied for geographical indications. Nevertheless, there are some examples, such as baklava from Turkey (Antep Baklavasi, PGI), Longjing tea from China (Longjing cha PDO), coffee from Colombia (Café de Colombia, PGI) and Darjeeling black tea from India (PGI).

As it usually happens in the event of legislative gaps, the EU Court of Justice has ruled on the matter several times²³. This is because the matter is particularly relevant considering the practical consequences. Indeed, acknowledging whether the EU rules on geographical indications are exhaustive or not means to question the legislative competence of member States concerning geographical indications. And that is especially true when – as it often occurs – there is the need to protect, with internal legal instruments, those names with that show a specific provenance but that are not registered as EU geographical indications.

In light of such preliminary hints, it is not surprising that the topic is broad and complex and is subject to a heated debate in doctrine²⁴. However, the analysis of this debate would overcome the scope of this dissertation, which is focused on another level (i.e. attempting to justify and explain the possibility to enhance a multilateral system of protection of geographical indications). Therefore, for what matters at our purposes, it is enough to acknowledge that conflicts of competence – that may affect

²³ At this respect, please refer to, *inter alia*, “Pistre”, joined cases C-321/94 and C-324/94; “Warsteiner”, case C- 312/98; “Bud I” and “Bud II”, respectively case C-216/01 and C-478/07 and, lastly, “Salame Felino”, case C-35/13.

²⁴ At this respect, it is worth noticing that, generally speaking, the Italian academia lines up against the exhaustive nature of Regulation 1151/2012.

Some uphold the fictitiousness of the distinction between qualified and non-qualified geographical indications (i.e. the differences may be blurry in practice, especially when reputation is the qualifying element), which lays at the basis of the EU judges reasoning. Please refer to G. COSCIA, *Considerazioni sulla portata esauriente del Regolamento n. 510/2006*, in Dalla riforma del 2003 alla PAC dopo Lisbona. I riflessi sul diritto agrario alimentare e ambientale, P. Borghi, L. Costato, L. Russo, S. Manservigi (a cura di), 2011.

Others believe that the reasoning of the EU judges are too brief and contradictory and do not properly take into account the role and the *ratio* of domestic laws protecting intellectual property rights (especially when it comes to food products that do not always have European dimension, but may be marketed only within national borders). Please refer to F. CAPELLI, *La Corte di giustizia, in via interpretativa, attribuisce all'Unione europea una competenza esclusiva in materia di riconoscimento delle denominazioni di origine e delle indicazioni geografiche protette, riferite ai prodotti agroalimentari, mediante la sentenza BUD II motivata in modo affrettato, contraddittorio e per nulla convincente*, in Diritto comunitario e degli scambi internazionali, no. 3, 2010.

Others think that there are some products circulating only at local level and not interested in the EU or transnational trade. Such products are not interested by EU intellectual property rights and, for them, domestic systems of protection are more appropriate. According to the author, should this be true for intellectual property rights, it should be valid also for geographical indications. Hence, national laws protecting geographical indications (both qualified and non-qualified) cannot be deemed to be *per se* in contrast with EU law. Please refer to V. DI CATALDO, *Denominazioni e indicazioni geografiche tra registrazione e protezione nazionale. Made in, IGP e DOP*, in AIDA, 2016.

For a general collection of different points of view on the matter, please refer to N. COPPOLA, *Lo studio della questione della competenza degli Stati membri in materia di IG agroalimentari da parte dei membri AIDA: lezioni e sviluppi*, in Rivista di Diritto Alimentare, volume 1, January-March 2015.

also the international level²⁵ – are unlikely to arise or become relevant, since the case law of the EU Court of Justice (although it has developed and adapted over the years) is oriented in the direction of recognizing the exclusive nature of EU legislation (being member States able to protect non registered geographical signs exclusively under certain circumstances, and, in pills, this is the protection of non-qualified denominations against unfair practices and misleading acts)²⁶.

Given the above premises upon the *ratio*, nature and objective of the regulation governing quality schemes to protect the properties and diversity of food products within the European Union, it is likely to focus the analysis on the “technical” profiles

²⁵ With such statement, the author refers to the event a geographical name, not registered pursuant to EU rules, but attesting a certain geographical provenance demands – on the international panorama – for the same level of protection granted to geographical indications (even the extensive one, should the proposal set forth in this dissertation should be adopted).

²⁶ In particular, the guidelines of the EU positions upon the relationship between the Regulation 1151/2012 and the internal legislations on geographical signs are clearly set forth in a famous (and recent) and omni-comprehensive EU judgment.

We make reference to the so-called “**Salame Felino**”, Judgment of the Court (Ninth Chamber) of 8 May 2014. Agriculture — Agricultural products and foodstuffs — Regulation (EEC) No 2081/92 — Article 2 — Protection of geographical indications and designations of origin — Material scope — Protection on national territory — Absence of Community registration — Consequences — Protection of designations relating to products for which there is no specific link between their characteristics and their geographical origin — Conditions. Case C- 35/13.

According to the EU judges, the EU rules on quality schemes provide for a uniform and exhaustive system of protection.

Nevertheless, they do not preclude the application of rules governing the protection of geographical designations, which fall outside their scope. It means that domestic legislation can still deal with those designations aimed at not showing a particular link between the territory and the products’ qualities or characteristics, but simply highlighting the geographical origin of a product. They are the “non-qualified” indications of origin.

Either way, in order to comply with the EU system, a national legislation governing non-qualified indications of origin should be addressed exclusively at displaying the geographical provenance of the product and be suitable for securing the attainment of such objective without going beyond what is necessary at this respect. In other words, non-qualified geographical signs can still be protected against misleading and unfair behaviors pursuant to national laws.

For further analysis of the contents of the Salame Felino case law, please refer, inter alia, to L. SALVI, *Indicazioni geografiche non oggetto di registrazione a livello europeo e loro utilizzo all'interno dell'Unione*, in *AlimentarEuropeo*, 2014; F. PRETE, *La protezione nazionale delle indicazioni geografiche semplici. La saga del Salame Felino: ultimo atto*, in *Rivista di Diritto Alimentare*, volume 2, April – June 2014. Other folks commented the judgment under exam highlighting the practical difficulties in identifying domestic rules that are, at the same time, compliant with the principles stated in the ruling (i.e. the exhaustive nature of Regulation 1151/2012) and effective in protecting non-qualified geographical names. Please refer to L. BRUGIONI, *La tutela delle denominazioni di origine e delle indicazioni geografiche agroalimentari non registrate ai sensi del Regolamento UE n. 1151/2012. Una riflessione sul caso Salame Felino*, in *Rivista di Diritto Industriale*, volume 6, 2015.

of the protection system. Starting from the notion of geographical signs²⁷ and their distinctive features. At this respect, attention is given also to the interpretation of “geographical area” and the concept of genericness, which prevents geographical names from being protected.

2.2. The notions of protected designation of origin and protected geographical indication

Generally speaking, PDO and PGI mostly consist of the name of a city, a region or even a country, that identifies products owing specific characters and qualities, attributable to the place of provenance itself.

More precisely, under Regulation 1151/2012, PDO *“is a name which identifies a product: (a) originating in a specific place, region or, in exceptional cases, a country; (b) whose quality or characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors; and (c) the production steps of which all take place in the defined geographical area”*²⁸.

While PGI *“is a name which identifies a product: (a) originating in a specific place, region or country; (b) whose given quality, reputation²⁹ or other characteristic is*

²⁷ On this point, please note that Regulation 1151/2012 lists three quality signs for food products: (i) the Protected Geographical Indication (PGI); (ii) the Protected Designation of origin (PDO); and (iii) the Traditional Specialities Guaranteed (TSG). Our study is limited to the analysis of PDO and PGI. Therefore, it does not take into the TSG quality scheme. The latter distinguishes from PDO and PGI since it does not refer to the origin, while it relates to the traditional methods of production and recipes of some products, regardless of the origin of their ingredients or the place where they are manufactured. What matters for the TSG is the value-adding attributes of traditional recipes rather than the link between the quality and place of provenance. As of now, the TSG system has gained a light success in the European Union. There are few examples. The most famous are Italian and are those of “Mozzarella” (please refer to Commission Regulation (EC) No 2527/98 of 25 November 1998 supplementing the Annex to Regulation (EC) No 2301/97 on the entry of certain names in the 'Register of certificates of specific character' provided for in Council Regulation (EEC) No 2082/92 on certificates of specific character for agricultural products and foodstuffs) and “Pizza Napoletana” (please refer to Commission Regulation (EU) No 97/2010 of 4 February 2010 entering a name in the register of traditional specialities guaranteed [Pizza Napoletana (TSG)]).

²⁸ Please refer to Article 5, paragraph 1 of Regulation 1151/2012.

²⁹ The notion of “reputation” is worth being analyzed separately since it relates exclusively to PGI and, to some extent, harmonizes the EU rules with the general definition of “geographical indication” provided for by Article 22 of the TRIPs agreement (at this respect, please refer to chapter 1, paragraph 2.5.1 of this dissertation). In order to have a practical explanation of how the “reputation” can link a product to a certain territory granting to the former the protection under geographical indications system, it seems interesting to pick the example of the “Piadina Romagnola/Piada Romagnola”. Please

*essentially attributable to its geographical origin; and (c) at least one of the production steps of which take place in the defined geographical area*³⁰.

By reading the definitions provided for Regulation 1151/2012, it is clear that the main difference between PDO and PGI lies on the level of connection between the qualities and the territory. On one side, the PDO requires that the product is entirely

refer to Judgment of the General Court (Second Chamber) of 23 April 2018, CRM Srl v European Commission. Case T-43/15.

This case has its roots basically in, first, the proposal of registration and, then, the official registration in the EU database of the geographical name “Piadina Romagnola/Piada Romagnola” PGI. In particular, pursuant to the Commission implementing Regulation (EU) No 1174/2014 of 24 October 2014, the name “Piadina Romagnola/Piada Romagnola (PGI)” enters in the register of protected designations of origin and protected geographical indications.

With regard to this name, various attempts of opposition and invalidation have been undertaken within the Italian territory. In this context, the regional administrative court of Lazio region (judgment no. 5148/2014) upholds that only the “piadine” produced artisanally can be covered by the protected geographical name, as such excluding all the industrial productions. The Italian supreme administrative court (judgment no. 2405/2015) reversed this statement reflecting on the concept of reputation, which constitutes the ground for the registration of the geographical name under exam. In particular, the supreme administrative court underlines that the name “Piadina Romagnola/Piada Romagnola” can be attributed to all the piadine produced following the traditional methods and ingredients, regardless whether this process is artisanal or industrial. In fact, on the basis of reputation, the name is commonly associated with the region of Romagna because of the long history of the region in the production of such foodstuff. But the reputation is independent from the “corporate structure” of the producers. In any event, the judges suspended the process and submit a preliminary ruling before the EU court.

Many commented these rulings within the Italian academia. For further details on both the judgments, please refer to V. PAGANIZZA, *Dalla padella alla brace: la piadina romagnola IGP, dal “pasto” al Consiglio di Stato*, in Rivista di Diritto Alimentare, no. 3, July–September 2014.

Others welcome the outcome upholding that it is compliant with the general objective of PGIs showing a particular link between reputation and geographic origin. Actually, a piadina is a renowned product as long as it is produced in its birth region (i.e. Romagna), pursuant to certain methods and using specific ingredients, as such acquiring particular features. And none of these changes if either the product is artisanally manufactured or industrially produced. Furthermore, should this be not the case, the practical result would be absurd, since none of the industrial producers could call its products Piadina Romagnola, even if the methods, recipes and ingredients are the traditional ones. Please refer to A. CORINI, *La piadina legittimata a fregiarsi dell’IGP è quella fatta in Romagna, non importa se in modo artigianale o industriale*, in Diritto Comunitario e degli Scambi Internazionali, volume 3-4, 2015.

If this is the background of the questions brought before the EU court, it is interesting to underline that the EU judges substantially shared the position of the Italian supreme administrative court. In fact, they confirm that, in order to have this name, Piadina Romagnola PGI shall be produced only in the territory of Romagna, both for industrial and artisan production. The EU Court stresses that the link between the name and the products exists on the basis of human factors building the reputation. In fact, following the production techniques of piadina transmitted from generation to generation in Romagna, originally for immediate consumption and then for deferred consumption, and thanks to the social and cultural events organized by the population of Romagna, the consumer associates the image of Piadina Romagnola to the Romagna region in general, regardless of the methods of craftsmanship or industry.

³⁰ Please refer to Article 5, paragraph 2 of Regulation 1151/2012.

manufactured within a specific geographical area and its qualities are “*exclusively due*” to the area, assuming relevance the inherent natural and human factors (including, by way of example, the weather conditions, the shape of the landscape, the composition of the soil, the feed of the animals with the eventual addition, under certain circumstances, of the human skills with which the product is manufactured, stored, packaged or even sliced). While, to access to the PGI protection it is sufficient that the qualities (or just the reputation, meaning the spread perception of the buyers) of the product are generally “*attributable*” to the place of origin and, furthermore, the product does not have to originate entirely from the defined area, a single production step carried out in the relevant area could be enough. The result is that the two signs requires for a different link between the product and the territory: stronger for PDO and lighter for PGI.

2.3. The notion of “geographical area”

For sake of completeness, it is worth focusing on the notion of “*geographical area*” or, better, on how to interpret this expression with the consequence of setting forth requirements/listing indexes useful to identify, correctly, the place to which a product shall be connected in order to have to the right of being identified with a geographical indication. The definition of the geographical area (and the chance to eventually include nearby territories, though having a different denominations) is quite an essential matter considering its practical consequences/impacts. In fact, the exact limitation of the geographical area may exclude producers from the protection of a PDO or PGI.

2.3.1. The “Feta” case

The European Court of Justice have ruled upon this issue several times. By way of example, a relevant case is *Germany v Commission (Agriculture)*, better known as “Feta” judgment³¹. According to this ruling, the terms “region” and “place” shall be

³¹ Judgment of the Court (Grand Chamber) of 25 October 2005. Federal Republic of Germany (C-465/02) and Kingdom of Denmark (C-466/02) v Commission of the European Communities. Agriculture - Geographical indications and designations of origin for agricultural products and

interpreted not only from a merely territorial perspective, but better from a geomorphological and non-administrative viewpoint, in so far as the natural and human factors inherent in a given product are likely to transcend administrative borders. In other words, in order to identify a “region” or “place” relevant for the protection of a PDO or PGO it is not necessary to refer to administrative districts and borders. It is more likely to take into account a general geographical environment, bearing peculiar natural and human factors capable of granting an agricultural product or foodstuff its specific characteristics. Therefore, it is clear that a geographic “area” or “place” for the purposes of the protection of geographical indications shall present homogenous natural features which distinguish it from the other areas adjoining it.

To make it clearer and give a practical explanation, in the case of the name “Feta”, the defined geographical area covers only the territory of mainland Greece and the department of Lesbos, while all other islands and archipelagos are excluded because the necessary natural and/or human factors do not apply there. In particular, the milk used to produce “Feta” cheese must come from ewes and goats of local breeds reared traditionally, whose feed must be based on the flora present in the pastures of the said eligible regions³².

The European judges went further, by explaining the natural, human and traditional factors – inherent to the defined geographic area – which influence the characteristics of the “Feta” cheese and whose interplay grants it its unique and remarkable taste, shape and international reputation. In particular, the European Court explained that *“extensive grazing and transhumance, central to the method of keeping the ewes and goats used to provide the raw material for making “Feta” cheese, are the result of an ancestral tradition allowing adaptation to climate changes and their impact on the available vegetation. This has led to the development of small native breeds of sheep and goats which are extremely tough and resistant, fitted for survival in an environment that offers little food in quantitative terms but, in terms of quality, is endowed with an extremely diversified flora, thus giving the finished product its own specific aroma and flavor”*³³.

foodstuffs - The name "feta" - Regulation (EC) No 1829/2002 - Validity. Joined cases C-465/02 and C-466/02.

³² Joined cases C-465/02 and C-466/02, paragraph 22 (35).

³³ Joined cases C-465/02 and C-466/02, paragraph 22 (36).

2.3.2. The “Altenburger Ziegenkäse” case

Another interested element when considering the interpretation of the “geographical area” is its extension. According to the European Union case law, the size of a geographical area is immaterial. The issue was raised in the first place within the *Molkerei Großbraunschweig and Bene Nahrungsmittel v Commission* case³⁴ relating to the geographical indication “Altenburger Ziegenkäse”³⁵. This sign covers a geographical area that extends beyond the boundaries of the district of Altenburger Land (Altenburg and Schmöln) in Thuringia and includes districts in Saxony and Saxony-Anhalt, such as the district of Würzen. The Court has been asked to judge upon whether or not the geographical indication scope may be reduced (to the sole area corresponding to the name of the product, to the district of Altenburger Land) considering that the defined geographic area was extremely wide.

The European judges concluded that, in order to identify a geographic area, relevant for the purposes of protection of geographical indications, it is necessary to take into account the particular features of production and marketing in the region connected to the products’ qualities, regardless of the size of the area³⁶.

In fact, according to the Court, it is possible that the definition of a too extensive geographical area may in theory cause a reduction in the real value of a designation of origin. Nevertheless, in this case, it would be necessary to prove that a wider size of the area affects the remarkable features of the protected products, qualities that could be granted if the geographical indication refers only to a smaller geographical area. The European judges underlined that the applicants failed in producing specific evidence that that might be the case with respect to them³⁷.

The lesson learned is that the identification of the geographical area, relevant for using a geographical indication, is basically a matter of fact. It means that the exact

³⁴ Order of the Court of First Instance (Second Chamber) of 15 September 1998. *Molkerei Großbraunschweig GmbH and Bene Nahrungsmittel GmbH v Commission of the European Communities*. Community protection of designations of origin - Registration by a Commission regulation of a designation for a geographical area considered by the applicants to be too large - Action for annulment - Inadmissibility. Case T-109/97.

³⁵ The geographical indication identifies a goat cheese made in the Altenburg region, which must contain a minimum percentage of goat’s milk.

³⁶ Case T-109/97, paragraph 65.

³⁷ Case T-109/97, point 71.

extension of a certain environment (together with its inherent natural and human factors) – in the case of PDO – and the geographical origin – in the case of PGI – shall be evaluated on a case by case basis taking into account the properties and characteristics described in the product specification³⁸ due to/connected with the territory itself³⁹.

2.4. The relevance of processing and packaging of food products with regard to the protection of geographical indications

Once clarified the notions of geographical indications and established the limits of designated geographical area, it is worth highlighting that, in some case, a product can be provided with the protection connected to a registered geographical indication not only if the production of the food stuff is carried out in the designated geographical area, but also if the processing and packaging activities take place in the relevant territory as well.

There might be special circumstances when, in order to safeguard quality and authenticity of the product and, as a consequence, granting the geographical indication, the relevant packaging shall take place in the defined geographical area⁴⁰.

³⁸ In a nutshell, the product specification is a charter document representing a “certification” of the geographical indications (i.e. it precisely lists all the requirements to be satisfied in order to access to the geographical names. For a detailed explanation of the product specification, please refer to paragraph 2.7.1 here below.

³⁹ The issue relating to the identification of the exact extension of the geographical area relevant to the purposes of a geographical indication is object of studies in the academia. Some folks (while dealing with concrete domestic disputes) recognize the practical difficulties of identifying the borders of the relevant geographical area and thus suggest using – as evaluation tool – the prescribed non-deceptive feature of the geographical names. Following this reasoning, the area should be drawn in such a way that would confuse neither consumers nor producers (eventually interested in accessing to the geographical name) on the real provenance of the product. Please refer to M. FERRARI, *Il territorio nelle denominazioni geografiche: spunti comparatistici*, in *Foro Italiano*, volume 6, 2015.

⁴⁰ Please refer to Article 7, paragraph 1 (e) of Regulation 1151/2012, according to which: “A *protected designation of origin or a protected geographical indication shall comply with a specification which shall include at least: [...] e) a description of the method of obtaining the product and, where appropriate, the authentic and unvarying local methods as well as information concerning **packaging**, if the applicant group so determines and gives sufficient product-specific justification as to why the packaging must take place in the defined geographical area to safeguard quality, to ensure the origin or to ensure control, taking into account Union law, in particular that on the free movement of goods and the free provision of services*”.

On this provision, it is worth recalling a remark arisen within the Italian academia. In dealing with the information which can be included in the product specification, Regulation 1151/2012 refers expressly

The European Court of Justice has expressly ruled at this respect in several judgments. Two of them, the “Rioja” and the “Prosciutto di Parma” cases, may be regarded as particularly significant.

2.4.1. The “Rioja” case

The “Rioja” case is a leading case in the field of geographical indications and it is composed of a double phase.

In the *Delhaize* part⁴¹, the Court was asked to decide on the compatibility with the European internal market of national rules according to which wines may be sold bearing the “*denominacion de origen calificada Rioja*” exclusively if they are bottled in authorized cellars using bottles of a certain glass and capacity.

The Court essentially found, firstly, that national rules as such – by limiting the quantity of wine that might be exported in bulk – constituted measures having equivalent effect to a quantitative restriction on exports (prohibited under general European Union Law)⁴² and procure a special advantage for bottling undertakings

to indications on how to carry out packaging activities. If literally applied, this provision would exclude all the other processing activities (i.e. grating or slicing) that are, equally, aimed at making the raw product “ready to sale”. The issue here is that there is a divergence among the various translations in the EU official languages. Similar to the English one, the Italian version refers to “confezionamento” and the Spanish one to “envasado”. On the contrary, the French text deals with “conditionement” and the German one with “aufmachung”. At this respect, it is possible to infer that such divergence is due to a gross translator mistake. In any event, it remains understand that, if interpreted literally, this provision may cause relevant economic impacts and discrepancies. Please refer to P. BORGHI, *L’insostenibile leggerezza delle versioni linguistiche: condizionamento e confezionamento dei prodotti DOP e IGP nel recente Regolamento UE n. 1151/2012*, in *Rivista di Diritto Alimentare*, volume 3, July-September 2013.

⁴¹ Judgment of the Court of 9 June 1992. *Établissements Delhaize frères and Compagnie Le Lion SA v Promalvin SA and AGE Bodegas Unidas SA*. Reference for a preliminary ruling: Tribunal de commerce de Bruxelles - Belgium. Exportation of wine in bulk - Prohibition - Wine of designated origin - Articles 34 and 36 of the Treaty. Case C-47/90.

⁴² This chapter is aimed at providing an introductory framework of the signs of quality for food products under EU Law. Therefore, it will not recall all the copious work of scholars and professors on the establishment and functioning of the European Union internal single market.

At this respect, please refer to, among others, G. TESAURO, *Diritto dell’Unione Europea*, Cedam 2012; A. LA MATTINA, *La libera circolazione delle merci*, in *Atti Notarili di Diritto Comunitario ed Internazionale*, volume 3, 2011; L. DANIELE, *Diritto del Mercato Unico Europeo*, Giuffrè, 2016; L. MARINI, *La libera circolazione delle merci*, in *Il diritto privato dell’Unione Europea*, Volume I, 2006; EUROPEAN COMMISSION, *Free movement of goods, Guide to the application of Treaty provisions governing the free movement of goods*, Ref. Ares(2013)3759436 - 18/12/2013; D. DINAN, *Ever closer Union: an introduction to European integration*, The European Union series, 2010; P. OLIVER E M. JARVIS, *Free Movement of Goods in the*

situated in the region of production⁴³.

Given that, the Court recognized (what is most interesting for the purposes of this analysis) that, since the specific function of a registered designation of origin was to guarantee that the product bearing it comes from a specified geographical area and displays certain particular characteristics, the bottling (i.e. the processing of the product) in the region of production may be essential to fulfill this task. And, namely, when this activity endowed the wine originating in that region with particular characteristics, of such a kind as to give it individual character, or is essential in order

European Community, 2003; C. BARNARD, *The substantive law of the EU- Four freedom*, 2016; DASHWOOD A., DOUGAN M., RODGER B., SPAVENT E. E WYATT D., *Wyatt and Dashwood's European Union Law*, 2011.

Nevertheless, for the better understanding of the reader, it summarizes some basic notions relating to the definition of unjustified restrictions on intra-EU exports.

In light of this, it can be recalled that the free movement of goods represents one of the founding pillars of the entire European Union. In fact, it has been the basis on which to build the internal market from which European citizens and businesses are now benefiting and which is at the heart of EU policies.

Nowadays, thanks to the almost fully completed single market, consumers are provided with a wide choice of products and allowed to shop around looking for the best available offer.

At the same time European businesses have a strong platform in an open, diverse and competitive environment.

The single market was achieved by affirming and successfully adopting specific legislative measures. Among the other relevant ones, the Treaty on the Functioning of the European Union expressly prohibits any unjustified restrictions on the internal movement of goods.

In this context, Article 35 of the Treaty on the Functioning of the European Union relates precisely to exports from one member State to another and prevents any quantitative restriction in addition to any measure having equivalent effect. This provision – which looks quite extensive at first sight – has been completely interpreted by the European operators and, in particular, by the European Court of Justice.

First of all and for the sake of clarity, the term “exports” refers only to trade between Member States and, as a consequence, it does not apply to exports to a country outside the European Union territories. Then, in the pioneering case *Groenveld* (Judgment of the Court (Second Chamber) of 8 November 1979. P.B. Groenveld BV v Produktschap voor Vee en Vlees. Reference for a preliminary ruling: College van Beroep voor het Bedrijfsleven - Netherlands. Horsemeat. Case 15/79) the European Court clarified which behaviors and measures may be deemed obstacles to exports. In particular, the Court stated that Article 35 of the Treaty on the Functioning of the European Union “concerns national measures which have as their specific object or effect the restriction of patterns of exports and thereby the establishment of a difference between the domestic trade of a Member State and its export trade in such a way as to provide a particular advantage for national production or for the domestic market of the state in question at the expense of the production or of the trade of other Member States”.

In other words, the prohibition of Article 35 of the Treaty on the Functioning of the European Union applies to those measures applicable to the production of local goods, as such drawing a distinction depending on whether such goods are intended for the national market or for export.

In fact, in this case, the natural consequence is the benefits for the domestic market against the opposite competitive disadvantages for businesses established in other member States due to additional costs that may occur or the difficulties of procuring certain products, which are necessary in order to enter into competition with the domestic market.

⁴³ Case C-47/90, paragraphs from 12 to 14.

to preserve essential characteristics acquired by that wine⁴⁴.

Nevertheless, the Court concluded that the applicant failed in establishing that, in the specific case, the confinement of bottling to a specified area was, in itself, capable of affecting the quality of the wine⁴⁵.

In any event, the dispute did not come to an end and moved further until the definitive judgment in *Belgium v Spain*⁴⁶.

This ruling is extremely useful because it provides clear guidelines on the theme of processing and packaging of food products with regard to the protection of geographical indications.

In fact, in the Court's final opinion, it is undisputed that certain processing and packaging activities represent important operations which, if not carried out in accordance with strict requirements, may seriously impair the quality of the product. In the case of bottling, the Court recognized that this does not involve merely filling empty containers but normally entails, before filling, a series of complex oenological operations (filtering, clarifying, cooling, and so on) which, if not carried out in accordance with prescribed rules, may adversely affect the quality and alter the characteristics of the wine. The bulk transport – if not undertaken under optimum conditions – may seriously impair wine quality as well by exposing it to oxidation reduction. And, contrary to what happened in the *Delhaize* case, the applicant succeeded in proving it⁴⁷.

As a consequence, it can be inferred, as general rule, that the protection granted by a geographical indication shall be extended also to the processing activities when it is proved that there is a material risk of non-safeguarding a product's qualities and reputation when the activities are not carried out in the designated geographical area or under certain defined conditions.

⁴⁴ Case C-47/90, paragraphs 17 and 18.

⁴⁵ Case C-47/90, paragraphs 22 and 23.

⁴⁶ Judgment of the Court of 16 May 2000. Kingdom of Belgium v Kingdom of Spain. Article 34 of the EC Treaty (now, after amendment, Article 29 EC) - Regulation (EEC) No 823/87 - Quality wines produced in a specified region - Designations of origin - Obligation to bottle in the region of production - Justification - Consequences of an earlier judgment giving a preliminary ruling - Article 5 of the EC Treaty (now Article 10 EC). Case C-388/95.

⁴⁷ Case C-388/95, paragraphs from 61 to 64.

2.4.2. The “Prosciutto di Parma” case

The “Prosciutto di Parma” case⁴⁸ represents a sort of confirmation of the basic principles expressed in the “Rioja” case.

The case brought before the European Court of Justice dealt with the admissibility – in terms of compliance with the internal market – of a PDO’s specification expressly requiring that operations such as slicing and packaging take place in the designated geographical area. Such a specification in fact determines effects equivalent to those of quantitative restrictions on exports⁴⁹.

Under the Court’s point of view, despite its restrictive effects on trade, a condition such as at issue must be regarded as compliant with European freedom of movement of goods if it is shown that it is necessary and proportionate and capable of ensuring the quality and authenticity of the product, meaning, in the specific case, upholding the reputation of the PDO “Prosciutto di Parma”. In support, the Court underlined that Parma ham is consumed mainly in slices and the operations leading to that presentation are all designed to obtain in particular a specific flavor, color and texture which will be appreciated by consumers⁵⁰.

It seems particularly relevant bearing in mind the mentioned rulings, since they add an important piece to the geographical indications framework. Given the EU legislators concerns over setting forth an extensive system of protection of quality of foodstuff, it is significant that the same applicable rules can cover not only the production of the relevant foodstuff, but also the activities address at making it “ready to sale” and available to consumers. In fact, as shown, it is allowed that the product specification governs also the processing activities as long as – if carried out elsewhere or without following strict requirements – they may seriously impair the quality of the product.

Moreover – and this is an author’s personal opinion – the choice of including

⁴⁸ Judgment of the Court of 20 May 2003. Consorzio del Prosciutto di Parma and Salumificio S. Rita SpA v Asda Stores Ltd and Hygrade Foods Ltd. Reference for a preliminary ruling: House of Lords - United Kingdom. Protected designations of origin - Regulation (EEC) No 2081/92 - Regulation (EC) No 1107/96 - Prosciutto di Parma - Specification - Requirement for ham to be sliced and packaged in the region of production - Articles 29 EC and 30 EC - Justification - Whether requirement may be relied on against third parties - Legal certainty - Publicity. Case C-108/01.

⁴⁹ Please refer to footnote 42 above.

⁵⁰ Case C-108/01, paragraphs from 61 to 67.

processing activities in the product specification reflects the EU will of enhancing an extensive system of protection of geographical signs, where any kind of freeriding on recognized names is discouraged.

2.5. The quality symbols

Once clarified what are the substantive requirements for a product to access to a geographical indication, it is worth mentioning the practical means provided for by Regulation 1151/2012 which allow consumers to easily and immediately recognize protected products and distinguish them from the non-registered ones.

These practical means are represented by quality symbols. A specific quality symbol corresponds to each of the quality schemes described⁵¹. The use of these symbols on the packaging or labeling of food products bearing a protected name is compulsory in the case of products originating in the European Union⁵². By contrast, in the case of products originating in third countries marketed under a name entered in the European register, the symbols associated with the protected geographical signs may appear on the labeling. Therefore, whether to use or not the symbol is discretionary choice of the single producers.

In other words, the obligation concerning the use of symbols relates exclusively to products originating in the European Union and therefore does not affect the products originating in third countries and protected under a geographical indication, such as those already mentioned arriving from India, China, Turkey or Colombia. As a consequence and by way of example, the PDO symbol shall mandatorily appear on the packaging of Parma Ham, originating in the area of Parma (i.e. a geographic provenance from Italy, a European member State). On the contrary, it is not compulsory to show the PGI symbol on the packaging of Darjeeling tea, which originates in India, an extra European Union country.

⁵¹ Please note that quality symbols referring to protected geographical indications are shown in and can be downloaded from the following address: https://ec.europa.eu/agriculture/quality/schemes_it.

⁵² Please refer to Article 12, paragraph 3 of Regulation 1151/2012. At this respect, please note that, according to Article 59 of Regulation 1151/2012, the obligation to mandatorily use the geographical indication symbols for European products protected under Regulation 1151/2012 became effective as of January 4, 2016. Of course this obligation is applicable without prejudice to products already placed on the market before that date.

2.6. The “generic” nature of geographical terms

Besides the specific (positive) conditions laid down in Regulation 1151/2012 for a name to be registered as a PGI/PDO, some signs and terms are prevented from being protected under a geographical indication⁵³. Among the excluded cases, fall the *ab origine* “generic terms”⁵⁴.

The rationale of this kind provision lies upon a simple social and economic evaluation/reasoning. Namely, the circumstance that common names are not worth being granted with a superior level of protection, since they do not identify products which distinguish themselves in the market for their specific and peculiar features. In addition, this kind of exclusion is addressed at preventing, on one side, an improper use of a name by third parties seeking to profit from the reputation which it has acquired and, on the other, the disappearance of that reputation as a result of popularization through general use detached from a specific quality, reputation or other characteristic which is attributable to that origin and justifies registration.

Given that, in order to apply the said prevention, it shall be anonymously/generally clear when a name is rightfully deemed generic.

In theory, generic name refers to the names of products which, although relating to the place, region or country where the product was originally produced or marketed, have become the common name of a product in the Union⁵⁵.

⁵³ Please refer to Article 6 of Regulation 1151/2012. “2. A name may not be registered as a designation of origin or geographical indication where it conflicts with a name of a plant variety or an animal breed and is likely to mislead the consumer as to the true origin of the product.

3. A name proposed for registration that is wholly or partially homonymous with a name already entered in the register established under Article 11 may not be registered unless there is sufficient distinction in practice between the conditions of local and traditional usage and presentation of the homonym registered subsequently and the name already entered in the register, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.

A homonymous name which misleads the consumer into believing that products come from another territory shall not be registered even if the name is accurate as far as the actual territory, region or place of origin of the products in question is concerned.

4. A name proposed for registration as a designation of origin or geographical indication shall not be registered where, in the light of a trade mark’s reputation and renown and the length of time it has been used, registration of the name proposed as the designation of origin or geographical indication would be liable to mislead the consumer as to the true identity of the product”.

⁵⁴ Please refer to Article 6, paragraph 1 of Regulation 1151/2012.

⁵⁵ Please refer to Article 3 (6) of Regulation 1151/2012

In practice, some case law of the European Court of Justice identified basic principles useful to evaluate the generic nature of geographical terms. At this respect, some interesting cases are selected and reported here below.

2.6.1. The “Grana Biraghi” case

A pillar at this respect is *Consorzio per la tutela del formaggio Grana Padano v Commission* case⁵⁶. It dealt with an application filed by the Italian company Biraghi S.p.A. at the OHIM (Office for Harmonization in the Internal Market) for the registration of the name “Grana Biraghi” as an European trademark for cheese. The Italian Consorzio per la tutela del formaggio Grana Padano opposed to this filing, claiming that the trademark “Grana Biraghi” is invalid as contrary to the protection of the PDO “Grana Padano”. The issue was then referred – as preliminary ruling – to the European Court of Justice. In this context the European Court expressly stated⁵⁷ that, in order to evaluate the generic nature of a term, it is necessary to carry out a detailed analysis of all the relevant factors which could establish the generic character of the name.

In that regard, the Court made a step further, by providing a list of the relevant legal, economic, technical, historical, cultural and social factors. In particular, the Court mentioned:

- a) the relevant national and Community legislation, including its historical development, the perception which the average consumer has of the allegedly generic name, including the fact that the reputation of the name remains linked to the traditional good produced in a rural area as a result of the fact that it is not commonly used in other areas of the Member State or of the European Union;

⁵⁶ Judgment of the Court of First Instance (Fourth Chamber) of 12 September 2007. *Consorzio per la tutela del formaggio Grana Padano v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*. Community trade mark - Invalidity proceedings - Community word mark GRANA BIRAGHI - Protection of the designation of origin ‘grana padano’ - Lack of generic nature - Article 142 of Regulation (EC) No 40/94 - Regulation (EEC) No 2081/92. Case T-291/03.

For a general overview upon the arguments of this judgment, please refer, among others, to S. VENTURA, *Quando una DOP composta protegge anche i singoli elementi che la compongono: il caso del nome “grana”*, in *Diritto Comunitario e degli Scambi Internazionali*, 2008.

⁵⁷ Case T-291/03, paragraphs from 65 to 67.

- b) the fact that a product has been legally marketed under the name in question in certain Member States;
- c) the fact that a product has been legally produced under the name in question in the country where the name originated even though the traditional methods for the production thereof have not been complied with;
- d) the fact that such processes have endured over time, the quantity of goods which bear the name in question and are produced using non-traditional methods as against the quantity of goods produced using traditional methods, the market share held by goods bearing the name in question which were produced using non-traditional methods as against the market share held by goods produced using traditional methods;
- e) the fact that the goods produced using non-traditional methods are presented in such a way as to refer to the places of production of goods produced using traditional methods, the protection of the name in question under international agreements and the number of Member States which may rely on the allegedly generic nature of the name in question.

By considering all these indexes, it can be inferred that an indication is generic when it can no longer be used as a distinctive sign towards the general consumer perception, with the consequence that any producer can freely refer to it in order to designate a type of product rather than a product with a distinct geographical origin and specific geographical qualities or characteristics.

For the sake of completeness, please note that, in this specific case, the Court concluded that one of the arguments submitted by Biraghi S.p.A. made possible to call into question any of relevant factors which could establish the generic character of the name⁵⁸. In particular, the Court underlined that, from the analysis of the Italian

⁵⁸ Case T-291/03, paragraphs 79 et seq.

Please note that the conclusions of the Court in the Grana Biraghi case has been challenged by some authors. According to these complaints, the Court lacks of clearness in its reasoning. In fact, it only provides for a list of criteria to be considered when assessing the generic nature of a name, but it fails in setting forth a general and precise rule on how to carry out the balance of the various indexes (on how to balance the different evidences). However, it seems that the EU Court gives preference to a “quantitative” criteria and picks, as determining item, the spread of the product in the relevant markets (i.e. in theory the national and the EU, but in practice foreign markets are hardly more significant, under quantitative terms, in comparison to the country of origin). The result is that the

judicial and legislative practice and under the consumerist perspective (on so, from the cumulative evaluation of the described criteria), it seems that none of the applicant's claims prevailed on the others and allowed to affirm the vulgarization and widespread of the name "grana".

From this leading case on, the case law of the European Court of Justice has always been harmonized at this respect and adopted the same point of view.

Nevertheless, it may be interesting to highlight some other significant judgments in order to better underline the meaning of the "generic nature" of geographical terms.

2.6.2. The "Feta" case

First of all, we can refer to the already mentioned *Feta* judgment⁵⁹. In particular, the Court reflected upon the generic nature of the term "Feta" by carrying out an analysis following the above listed criteria, focusing, in particular, on the circumstance that a product has been lawfully marketed under a name in some Member States may constitute a factor which must be taken into account in the assessment of whether that name has become generic. In this regard⁶⁰, the Court took into account some studies and data collected by the European Commission. According to these studies, the cheese feta is produced in Member States other than the Hellenic Republic, namely the Kingdom of Denmark, the Federal Republic of Germany and the French Republic⁶¹, although it is not questioned that the greatest production of feta has remained concentrated in Greece.

generic nature of a term is difficult to uphold and, from a practical perspective, this may conceal protectionist purposes in contrast with a fair competitive market.

On this point, please refer to V. RUBINO, *La tutela delle denominazioni di origine complesse nella sentenza "Grana Biraghi"*, in *Alimenta*, volume 3, 2008.

⁵⁹ Please refer to paragraph 2.3.1 above.

As general comment of the judgment, please refer to, among others, S. VENTURA, *La tormentata vicenda della denominazione Feta*, in *Diritto Comunitario e degli Scambi Internazionali*, 2006; J. REED, *Feta: a cheese or a fudge?*, in *European Intellectual Property Review*, 2006.

⁶⁰ Joined cases C-465/02 and C-466/02 paragraphs from 75 to 88.

⁶¹ In particular, the Hellenic Republic produces approximately 115 000 tonnes annually. In 1998, almost 27 640 tonnes were produced in Denmark. From 1988 to 1998, production in France varied between 7 960 tonnes and 19 964 tonnes. Production in Germany has varied between 19 757 and 39 201 tonnes since 1985.

And this latter factor is particularly relevant, given that the circumstance that a particular product is lawfully produced in Member States other than the reserved geographic area is only one factor of several which must be taken into account. As stated, the others are, for instance, the general perception of consumers, the circumstance that non-local products are marketed in such a way as to reference to the traditional country of origin⁶² or using different production methods⁶³.

As regards the name “Feta”, the European judges observed that evidence has been adduced *“to show that, in Member States other than Greece, feta is commonly marketed with labels referring to Greek cultural traditions and civilization. It is legitimate to infer therefrom that consumers in those Member States perceive feta as a cheese associated with the Hellenic Republic, even if in reality it has been produced in another Member State”*⁶⁴. On this basis, the Court concluded that from several various factors relating to the consumption of feta in the Member States it is likely to infer that the name “Feta” is not generic in nature.

⁶² For instance, it shall be taken into account whether the labeling, the marketing and advertising use to recall – both directly and indirectly – the territory or origin (as it happens with Greece when it comes to Feta).

⁶³ At this respect, it is worth noticing that Feta produced and legally sold in the above mentioned countries is made following different methods and using different raw materials than those adopted in Greece.

In fact, the production of Feta in Greece and other Balkans area dates back to centuries ago and is characterized by the use of sheep milk or a mixture of sheep and goat milk processed through the traditional and artisan method of natural dripping of milk without any pressure.

On the contrary, the Feta produced in the other countries is made using cow milk and following an industrial processing method, called ultrafiltration.

These elements determine naturally substantive differences in terms of colour and taste in the final product. On one side, the sheep milk provides the cheese with a pure white color, while the cow milk determines a yellow/white color that can only be processed using chemicals.

Moreover, the feta produced with sheep milk is fat, salty, slightly acid and has a very strong aroma. While the feta produced with cow milk is lighter and has a sweeter taste.

In the end, when using cow milk, the product reports fewer holes than cheese obtained from sheep milk as the brine affects the two cheeses in different ways.

On this point, please refer to C. BENATTI, *Il revirement della Corte di Giustizia sul caso Feta*, in *Rivista di diritto agrario*, Volume 2, 2006.

⁶⁴ Joined cases C-465/02 and C-466/02, paragraph 87.

2.6.3. The “Bayerisches Bier” case

Another worth mentioning case, is the *Bavaria and Bavaria Italia* case⁶⁵, dealing with the alleged generic nature of the name “Bayerisches Bier”.

Within this context, the Court repeated once again that “*a name becomes generic only if the direct link between, on the one hand, the geographical origin of the product and, on the other hand, a specific quality of that product, its reputation or another characteristic of the product, attributable to that origin, has disappeared, and that the name does no more than describe a style or type of product*”⁶⁶.

Bearing that in mind, the Court observed that the most effective tool to assess whether a name can describe a style or type of product is taking into account various factors, such as the places of production of the product concerned both inside and outside the Member State which obtained the registration of the name at issue, the consumption of that product and how it is perceived by consumers inside and outside that Member State, the existence of national legislation specifically relating to that product. In the specific case, the European judges found that the name “Bayerisches Bier” cannot be deemed generic, because it describes and identifies a product which clearly distinguishes itself from the presence on the market of similar trade marks and labels of commercial companies including the term “Bayerisches” or translations of it. Furthermore, they noted that there were five different bilateral agreements relating to the protection of the name “Bayerisches Bier” as geographical name, proving as well that this name had no generic nature⁶⁷.

2.6.4. The “Parmesan” case

In addition, it is worth mentioning the famous⁶⁸ *European Communities v Federal Republic of Germany* case, better known as the “Parmesan” case⁶⁹. The case concerned

⁶⁵ Judgment of the Court (Fourth Chamber) of 2 July 2009. *Bavaria NV and Bavaria Italia Srl v Bayerischer Brauerbund eV*. Reference for a preliminary ruling: Corte d'appello di Torino - Italy. Reference for a preliminary ruling - Assessment of validity - Admissibility - Regulations (EEC) No 2081/92 and (EC) No 1347/2001 - Validity - Generic name - Coexistence of a trade mark and a protected geographical indication. Case C-343/07.

⁶⁶ Case C- 343/07 paragraph 107.

⁶⁷ Case C- 343/07 paragraphs 108 and 109.

⁶⁸ The Parmesan case has become extremely notorious because of the popularity of the Italian relevant cheese. The parmesan reputation is conferred by its natural properties, distinctive taste and traditional

the alleged fraudulent selling by some German producers of a dried, grated pasteurized cheese in powder form – not conforming to the specification of the PDO “Parmigiano Reggiano” – as “Parmesan”. The defendant claimed that no violation of the PDO “Parmigiano Reggiano” occurred, since the name “Parmesan” is generic in nature and, as such, can be used to describe any kind of dried, hard granular cheese.

While discussing about the generic character of the name, the Court stated that this is the case when, over time and through use, a geographical name become generic name since the greatest portion of consumers ceases to regard it as an indication of the geographical origin of the product and comes to regard it only as a general indication of a certain kind of product⁷⁰.

The Court added that, when assessing the generic character of a geographical name, it is necessary to carry out a concrete analysis of the relevant above mentioned factors

production process. Italian dairy farmers located in the area of Parma made the cheese without using any preservative or additive, by following in person a precise fully natural and long maturation process. All these features distinguish the parmesan from the other similar products and made that cheese a symbol of the Italian culture and cuisine.

For further information on the Parmesan cheese, please refer to M. CORRADO, *Italian perspective on the importance of geographical indications and protected designation of origin status for Parmigiano Reggiano cheese*, in Chicago-Kent Journal of Intellectual Property, volume 16, issue 2, 2017.

⁶⁹ Judgment of the Court (Grand Chamber) of 26 February 2008. Commission of the European Communities v Federal Republic of Germany. Failure of a Member State to fulfil obligations - Regulation (EEC) No 2081/92 - Protection of geographical indications and designations of origin for agricultural products and foodstuffs - ‘Parmigiano Reggiano’ cheese - Use of the name ‘Parmesan’ - Obligation on a Member State to proceed on its own initiative against the abuse of a protected designation of origin. Case C-132/05.

The “Parmesan” case is a broad one (and a milestone of EU case law in the food sector), since it involves various topics relating to the protection of geographical indications. In fact, the EU Court rules upon the evocation of the PDO “Parmigiano Reggiano”, the generic nature of the term “Parmesan” and the States’ competences in controlling the use of geographical indications. On this latter point, please refer to footnote 100 of this chapter, which mentions this judgment as a turning point (or better, source of inspiration) in the development of controlling systems.

Whereas the existence of such features, in this section, we would limit the scope of the analysis to the arguments on genericness of the name “Parmesan”.

For further analysis on the various elements of the judgment, please refer to I. CANFORA, *Il caso “Parmigiano Reggiano”: denominazioni di origine composte e strumenti di tutela tra competenze nazionali e diritto comunitario*, in Rivista di diritto agrario, Volume 1, part II, 2008, which focuses on the relationship between genericness and evocation of composed geographical indications. S. VENTURA, *Il caso Parmesan visto dalla Corte di Giustizia*, in Diritto Comunitario e degli Scambi Internazionali, 2008 and C. HEATH, *Parmigiano Reggiano by Another Name - The ECJ’s Parmesan Decision*, in International Review of Intellectual Property and Competition Law, no. 8, 2008, both for a general overview of the case.

⁷⁰ Case C-132/05 paragraph 36. In order to support its thesis about the shifting in meaning (i.e. from distinctive sign to generic one), the Court provided some examples, recalling that this phenomenon occurred in the cases of other European food products, such as “Camembert” and “Brie”.

(i.e. it shall be taken into account the places of production of the product concerned both inside and outside the Member State which obtained the registration of the name at issue, the consumption of that product and how it is perceived by consumers inside and outside that Member State, the existence of national legislation specifically relating to that product)⁷¹.

In the present case, the Court concluded that the applicant referred only to the existing literature on the topic and failed in providing information on the factors relating to the amount of production, perception and consumption of that cheese as indicators of the generic character of the name “Parmesan”, making impossible for the European judges to rule on the matter and adopt a specific position⁷². As a natural consequence, since genericness of the term was not demonstrated, the Court claimed that the use of the word “Parmesan” for cheese which does not comply with the specification for the PDO “Parmigiano Reggiano” must be regarded as infringement the protection granted to the mentioned PDO (i.e. evocation of the protected geographical name)⁷³.

2.6.5. The “Gouda” case

At last, with reference to the generic nature of geographical terms, it is worth

⁷¹ Case C-132/05 paragraph 53.

⁷² This conclusion of the Court has been challenged by various authors over time and deemed inadequate. What is at stake in the authors’ opinion is that the Court did not expressly deny the generic nature of the name “Parmesan” (or better, the Court did not expressly affirm the not generic nature of the term). In doing so, the Court made a step backwards with regard to the conclusion adopted in the Feta case, where – as shown – the EU Court expressly upheld the non-generic nature of the term within the EU territories. And, at the same time, it left a door open for different (and eventually opposite) interpretations by national judges, with all the connected risks in terms of harmonization among legislations.

On this point, please refer to, among others, F. GENCARELLI, *Il caso “Parmesan”: la responsabilità degli Stati nella tutela delle DOP e IGP tra interventi legislativi e giurisprudenziali*, in *Il Diritto dell’Unione Europea*, Volume 4, 2008.

⁷³ Case C-132/05 paragraphs 56 and 57. Such conclusive remarks leave many doors open. In fact, the EU Court did not exclude that the name “Parmesan” can continue to be used for non-Italian cheese and, should this use be challenged, another judgment can be brought before the EU judges. Thus, it is possible that the statement concerning the evolvement of the designation Parmesan into a generic name can be sustained by convincing evidence. Please refer to C. HAUER, *Using the Designation “Parmesan” for Hard Cheese (Grated Cheese) of Non-Italian Origin. Judgment of the ECJ of 26 February 2008 in case C-132/05 (Commission of the European Communities vs. Federal Republic of Germany)*, in *European Food and Feed Law Review*, Volume 3, issue 6, 2008.

mentioning another interesting case dealing with the “Gouda”⁷⁴ cheese. The perspective adopted in this case was quite opposite in respect of the ones described so far, being focused on the relationship between generic geographical names and protected geographical indications including that generic name, the so-called “compound (or composite) geographical indications”. The issue here is evaluating whether a geographical indication can be protected regardless the circumstance that part of its name is deemed generic.

As a matter of fact, the statement of objection in the “Gouda” case was dealt with the circumstance that the registration of the name PGI “Gouda Holland”,⁷⁵ without any express clarification, would compromise the use of the renowned generic name “Gouda”⁷⁶ and, as such, give a competitive advantage to some producers.

In the specific case, as expressly provided for by the European Commission, the name “Gouda” may continue to be used within the European Union territory notwithstanding the registration of the composite geographical indication⁷⁷.

In light of this, the Court firstly recalled that – in general terms – whenever a registered geographic name contains the name of an agricultural product or foodstuff which is considered generic, the use of that generic name on the appropriate agricultural product or foodstuff shall not be considered *per se* invalid.

⁷⁴ Order of the Court (Seventh Chamber) of 6 October 2015 *Schutzgemeinschaft Milch und Milcherzeugnisse e.V. v European Commission*. Appeal — Article 181 of the Rules of Procedure of the Court of Justice — Agriculture — Regulation (EC) No 510/2006 — Register of protected designations of origin and protected geographical indications — Registration of the designation ‘Gouda Holland’ — Producers using the name ‘Gouda’ — Absence of a legal interest in bringing proceedings. Case C-519/14 P.

With regard to a reasoned comment of the case, please refer to, among others, V. MANTROV, *The cases of Edam Holland and Gouda Holland: continuing road back home as protected indications of geographical origin*, in *European Journal of Risk Regulation*, Volume 7, Issue 2, June 2016. By way of introduction please note that the author refers not only to the Gouda case, but also to the Edam one (focused on the Edam Holland cheese). Nevertheless, the two are overlapping one with the other.

The author confirms that the case is particularly significant since the registration of the compound PGI “Gouda Holland” includes a generic name, extensively used in practice and occupying a considerable market share. In any event, the author notices that – in light of the EU Court’s ruling and the relevant PGI registration – the name “Gouda” can continue to be used. Thus, any concern by private parties is unfounded because the value of the generic names is recognized and preserved, regardless of the registration of the composed geographical name. For sake of completeness, please note that the author focuses the second part of the article on the *locus standing* matter (outside our interest).

⁷⁵ Please refer to Commission Regulation (EU) No 1122/2010 of 2 December 2010 entering a designation in the register of protected designations of origin and protected geographical indications [Gouda Holland (PGI)].

⁷⁶ The name “Gouda” in fact is extensively widespread and occupies a considerable market share.

⁷⁷ Please refer to Article 1, paragraph 2 of the Commission Regulation (EU) No 1122/2010.

Thereafter, in rejecting the appellant's claim, the Court underlined that the contested Regulation is intended not to abolish the applicant's rights (as it is still entitled to use the generic name "Gouda"), while, on the contrary, to grant a new right to all operators that comply with the requirements of the compound geographical indication. At this respect, in fact, the Court reminded that the purpose of the system of protection of geographical indications is, *inter alia*, to ensure a "fair competition" among all the producers entitled to use a PGI⁷⁸.

In conclusion, should the Court have annulled the contested Regulation, on one side it would have not be of any advantage in favor of the applicant, on the other it would have prevented producers entitled to bear the composite geographical indication to benefit from the relevant legal and economic advantages.

In the case under exam, the Court noted that the applicant lacked any interest or standing to bring proceedings and the relevant action was therefore rejected as inadmissible.

In light of all the above, it is possible to conclude that genericness is usually associated with non-distinctiveness of the name, meaning the inability of the name to identify, to the consumers eyes, products having specific characteristics, rather being just the common term for certain foodstuff.

As a general rule, several elements deriving from social, cultural, historical, commercial and political environment should be balanced to assess if the name under exam – in the consumers perception – is no longer linked to a specific product coming from a designated place and having certain properties. Such evaluation basically results in a matter of fact, which – as highlighted throughout this section – may give birth to different (and even diverging) outcomes.

In any event, evaluating whether a name is generic or not is crucial within the comprehensive EU system of protection of geographical indications. In case of negative outcome, the name can be registered and protected against any attempt of freeriding or even descriptive use of the name itself. It is clear the relevance in the producers' strategies and activities.

Moreover, it is interesting to focus on the selected EU case law upon the "generic" nature of geographical names, since it shows the EU perspective on certain sensitive

⁷⁸ Case C-519/14 P, paragraphs 38 and seq.

designations, which are usually deemed to be generic outside the EU and are placed at the center of the conflicts between EU and US (also in light of the connected economic and trade value). Furthermore, many of the names studied by the mentioned case law (i.e. Parmesan or Feta) may also be object of the concession that – throughout this dissertation – the author suggests to the EU to evaluate in order to get consensus on a generalized multilateral extensive system of protection of geographical indications.

2.7. The procedure of registration of geographical names⁷⁹

Once clarified the features generally requested for a geographical name to be worth being protected, it seems interesting to focus on the procedural steps which lead to the mentioned protection and, as an effect, highlight their public connotation, given that the assessment upon the requirements necessary to the extent of Regulation 1151/2012 is basically left to administrative bodies.

The right to use a geographical indication, PDO or PGI as described above, is subject to the positive outcome of the registration procedure.

First of all, under a subjective perspective, it should be pointed out that the procedure may be activated only by a group of producers, where the term “group” means any association, regardless of its legal form, mainly composed of producers or processors working with the same product⁸⁰.

Once the group exercises its right, the registration procedure is carried out and is composed of a double-phase. The first one is brought before the competent authorities of the Member State the group belongs to and, in case of success in the first step, the second one before the European Commission.

⁷⁹ Please refer to CHAPTER IV “Application and registration processes for designations of origin, geographical indications, and traditional specialties guaranteed” of Regulation 1151/2012.

⁸⁰ Please refer to Article 3, paragraph 1(2) of Regulation 1151/2012.

As general exception, please note that under certain circumstances also natural person can activate a procedure for the registration of a geographical indications.

In particular, according to Article 49, paragraph 1 of Regulation 1151/2012 “*a single natural or legal person may be treated as a group where it is shown that both the following conditions are fulfilled: (i) the person concerned is the only producer willing to submit an application and (ii) with regard to protected designations of origin and protected geographical indications, the defined geographical area possesses characteristics which differ appreciably from those of neighbouring areas or the characteristics of the product are different from those produced in neighbouring areas*”.

Given that, it might be interesting to outline, more in details, the single steps to be fulfilled in order to reach the registration of a geographical indication.

2.7.1. The national scrutiny

First of all, the applicant addresses the official registration request to the competent authorities of that Member State⁸¹.

This official registration request shall include at least:

- a) the name and address of the applicant group;
- b) the product specification⁸²;

⁸¹ In this context, it is worth recalling – as a general principle – that the registration as geographical indications can apply also to names referring to products originating in third countries, provided that they comply with the requirements laid down by Regulation 1151/2012.

Therefore, according to Article 51 of Regulation of 1151/2012, paragraph 5, when the registration request relates to a geographical area in a third country or is prepared by a group established in a foreign state, the first phase of the national scrutiny is somehow skipped. In fact, the application shall be lodged with the EU Commission, either directly or via the authorities of the third country concerned. It remains understood that the application shall be submitted to the EU Commission in one of the official languages of EU.

For further analysis on the legislative developments of EU rules with regard to the registration of third countries geographical indications, please refer to footnote 42 above.

⁸² According to Article 7 of Regulation 1151/2012, the product specification shall be composed of the following:

“(a) the name to be protected as a designation of origin or geographical indication, as it is used, whether in trade or in common language, and only in the languages which are or were historically used to describe the specific product in the defined geographical area;

(b) a description of the product, including the raw materials, if appropriate, as well as the principal physical, chemical, microbiological or organoleptic characteristics of the product;

(c) the definition of the geographical area delimited with regard to the link referred to in point (f)(i) or (ii) of this paragraph, and, where appropriate, details indicating compliance with the requirements of Article 5(3);

(d) evidence that the product originates in the defined geographical area referred to in Article 5(1) or (2);

(e) a description of the method of obtaining the product and, where appropriate, the authentic and unvarying local methods as well as information concerning packaging, if the applicant group so determines and gives sufficient product-specific justification as to why the packaging must take place in the defined geographical area to safeguard quality, to ensure the origin or to ensure control, taking into account Union law, in particular that on the free movement of goods and the free provision of services;

(f) details establishing the following: (i) the link between the quality or characteristics of the product and the geographical environment referred to in Article 5(1); or (ii) where appropriate, the link between a given quality, the reputation or other characteristic of the product and the geographical origin referred to in Article 5(2);

(g) the name and address of the authorities or, if available, the name and address of bodies verifying compliance with the provisions of the product specification pursuant to Article 37 and their specific tasks;

(h) any specific labelling rule for the product in question”.

- c) a single document setting out the following: i) summary of the main points of the product specification; ii) a further description of the link between the product and the geographical environment or geographical origin, including, where appropriate, the specific elements of the product description or production method justifying the link.

The Member State shall scrutinize the application by appropriate means in order to check that it is justified and meets the conditions set forth by Regulation 1151/2012 with regard to each reference scheme. Once received the application, the Member State shall ensure adequate publicity of the application and grant a reasonable period within which any natural or legal person having a legitimate interest and established or resident on its territory may lodge an opposition to the application.

If, after assessment of any opposition received or in the event no opposition was made, the Member State considers that the requirements of Regulation 1151/2012 are met, it may take a favorable decision and refer an application dossier before the EU Commission⁸³.

Nevertheless, in order to grant the greatest level of protection to all interested parties, the Member State shall ensure that its favorable decision is made public, by providing, for instance, electronic access to the product specification, and that any natural or legal person having a legitimate interest has an opportunity to appeal.

For sake of completeness, it is worth highlighting the centrality of the product specification system within the EU geographical indications scheme.

First of all, it represents the “guarantee” of the product, precisely listing the “must have” features if it bears a geographical indication. Furthermore, it reflects another piece of the puzzle of the public nature of the EU system of protection of geographical names. Indeed, it is drafted and submitted by private parties, but goes through the assessment of public (national and EU) authorities. At this respect, product specifications can be amended only with the consent of the competent authorities (i.e. the amendment procedure is regulated by the same rules governing registration). Please refer to M. FERRARI, *La dimensione proprietaria delle indicazioni geografiche. Uno studio di diritto comparato*, 2015. On the same matter, other researchers point out the – through the product specifications – private parties voluntary regulate their quality products under the umbrella of public framework. Please refer to A. MARESCOTTI, *Il ruolo del disciplinare di produzione nella costruzione dei legami tra prodotti DOP e IGP e sviluppo rurale*, in *Agriregionieuropa*, no. 20, 2010.

⁸³ While the application is under the EU Commission’s scrutiny, the concerned member State can provide for transitional protection to the relevant name and it lasts until the EU Commission issues its final decision on the geographical designation. It remains understood that the transitional protection should produce effects at national level only, and has no effect on intra-EU or international trade. Please refer to Article 9 of Regulation 1151/2012.

2.7.2. The scrutiny by the European Commission

The Commission shall scrutinize by appropriate means any application that it receives from the Member States, in order to check – in a definitive way – whether the registration request is justified and meets the conditions of the relevant quality scheme. For a proper functioning of the whole protection system, it is established that the said scrutiny does not exceed a period of six months, save in the event of grounded reasons – promptly notified in writing to the applicant – justifying the delay.

Further to the said scrutiny, there might occur two possible scenarios.

On the one hand, in the event the European Commission considers that the conditions for registration are not fulfilled, it shall adopt implementing acts rejecting the application.

On the other, on the contrary, whether the European Commission considers that the conditions laid down in Regulation 1151/2012 are fulfilled, it shall publish in the Official Journal of the European Union the single document and the reference to the publication of the product specification.

In this latter case, within three months from the date of publication in the Official Journal of the European Union, any interest party (i.e. being the authorities of a Member State or of a third country, or even a legitimate natural or legal person) may lodge a notice of opposition with the Commission, claiming that the application infringes the conditions laid down in Regulation 1151/2012.

If no notice of opposition or no admissible reasoned statement of opposition is brought before the European Commission, it shall adopt implementing acts in order to register the name.

On the contrary, whether an objection is received and indeed is deemed reasoned, the Commission shall invite the interested parties to engage in appropriate consultations that shall start without undue delay and shall be addressed at providing each party with the relevant information to assess whether the application for registration complies with the conditions of Regulation 1151/2012.

At this stage, following the appropriate consultations and taking into account the results thereof, the European Commission shall either: (i) register the name if an

agreement has been reached; or (ii) adopt a final decision, if no agreement has been reached.

In any case, acts of registration and decisions on rejection shall be published in the Official Journal of the European Union.

Although in pills, this section analyzes the relevant steps in order to register a geographical name pursuant to Regulation 1151/2012 and provides further steps on the public connotation of the system. Also in light of the further discussions concerning the implementation of multilateral system of protection of geographical indications (and in order to understand the divergent negotiating positions of the parties), it is essential to understand what is the level of protection granted to the geographical name once the registration is obtained. In other words, for the relevant purposes of the present analysis, it is crucial to highlight what are the behaviors that are prevented once the quality scheme are implemented.

2.8. The level of protection granted to registered geographical indications

According to Article 13, paragraph 1 of Regulation 1151/2012, “*registered names shall be protected against:*

(a) any direct or indirect commercial use of a registered name in respect of products not covered by the registration where those products are comparable to the products registered under that name or where using the name exploits the reputation of the protected name, including when those products are used as an ingredient;

(b) any misuse, imitation or evocation, even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’ or similar, including when those products are used as an ingredient;

(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product that is used on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;

(d) any other practice liable to mislead the consumer as to the true origin of the product”.

By a simple interpretation of the rules provided for by Regulation 1151/2012 in terms of protection granted further to the registration, it is quite clear that the level of protection is extremely extended, covering a large number of behaviors.

The registration in fact allow the producers who comply with the conditions set forth in the product specification to contrast any wrongful or misleading use and attempt of unfair exploitation of the protected indication by third parties.

At this respect, in order to shape the material framework of protection, it would be useful to analyze some significant judgments of the European Court of Justice dealing with this topic and, namely, with the interpretation of the cases of “imitation or evocation”⁸⁴.

2.8.1. The “Cambozola” case

As leading case it is worth mentioning the “Cambozola” case⁸⁵. The questions brought before the Court dealt with an order – requested by the Italian Consorzio per la Tutela del Formaggio Gorgonzola – addressed at prohibiting the marketing in Austria of a

⁸⁴ Apart from the analysis of the European Court of Justice case law upon the interpretation of “evocation”, it might be useful to refer to B. CALABRESE, *La protezione dei nomi geografici nei regimi di qualità dei prodotti agricoli e alimentari: criteri oggettivi e soggettivi della tutela per evocazione*, in *Diritto Comunitario e degli Scambi Internazionali*, volume 2/3, 2016.

Preliminarily, although better analyzed in this section, the notion of “evocation” prohibited according to Regulation 1151/2012 is pretty broad, including any circumstance where the use of a name triggers in the consumers mind the image of product covered by a protected geographical indication.

If this is the general interpretation, for sake of completeness, it worth reminding that the notion of “evocation” can include also the transliteration acts, meaning the conversion of characters following the phonetics of the original language of the relevant geographical indication (even if the transliteration itself means nothing). And this is a sensitive matter, especially any time the geographical indication originates from a country with a non-latin alphabet. To better understand the extension of the scope of protection yield in the “evocation”, please take into account a recent analysis dealing also with the transliteration of EU geographical names in Chinese terms. While reflecting on how transliteration of EU geographical indications can affect the relevant sales in the concerned markets, they point out that EU producers usually register transliterated names within the Chinese trademark system in order to protect their products. Please refer to S. VACCARI, F. GUALTIERI, B. CATIZZONE, *La protezione delle indicazioni geografiche: la nozione di evocazione*, in *Rivista di Diritto Alimentare*, volume 2, 2017.

Moreover, it is worth bearing in mind also the solutions adopted by the EU in trade agreement with third non-latin countries. At this respect, please refer to chapter 4, footnote 14 of this dissertation.

⁸⁵ Judgment of the Court (Fifth Chamber) of 4 March 1999. *Consorzio per la tutela del formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH*. Reference for a preliminary ruling: *Handelsgericht Wien - Austria*. Articles 30 and 36 of the EC Treaty - Regulation (EEC) No 2081/92 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs. Case C-87/97.

soft blue cheese under the designation “Cambozola” and requiring the cancellation of the “Cambozola” trade mark. The Italian Consorzio per la Tutela del Formaggio Gorgonzola believed that the said trademark was clearly evocative and misleading with reference to the registered PDO “Gorgonzola”. And that also when the packaging of the cheese bore a visible indication of the real country of manufacture.

In order to rule on the described issues, the Court focused on the concept of “evocation”, by expressly stating that it occurs, for instance, when there is the phonetic similarity between terms used to designate similar products. It happens when the name incorporates part of a protected designation, with the effect that, in the consumers’ mind, the image triggered is that of the product whose designation is protected.

Apart from the described phonetic similarity, another index that shall be taken into account in order to evaluate the existence of “evocation” is the visual similarity between the relevant terms. According to the Court’s point of view, it would seem reasonable, if not obvious, to conclude that a registered name is indeed evocative where the term used to designate a similar product ends in the same two syllables and contains the same number of syllables.

Furthermore, the Court claimed that the risk of “evocation” is material even if there is no likelihood of confusion between the products concerned⁸⁶.

Given such premises and further to the analysis of relevant indexes, the Court concluded that use of the name “Cambozola” may therefore be deemed evocative with respect to the registered PDO “Gorgonzola”, irrespective of the fact that the packaging indicates the product's true origin. Nevertheless, it does not fall under the Court’s competence – being up to national court to decide – to state whether to allow the use of an earlier trade mark notwithstanding the registration of the PDO “Gorgonzola”.

2.8.2. The “Verlados” case

More recently, the European Court of Justice ruled upon the “evocation” theme and, namely, in the “Verlados” case⁸⁷. The matter there concerned a cider spirit

⁸⁶ Case C-87/97, paragraphs from 25 to 27.

⁸⁷ Judgment of the Court (Second Chamber) of 21 January 2016. Viiniverla Oy v Sosiaali- ja terveystieteiden tutkimuskeskus. Request for a preliminary ruling from the Markkinaoikeus. Reference for a preliminary ruling — Protection of geographical indications of spirit drinks — Regulation (EC) No

manufactured in the village of Verla (Finland) and commonly marketed under the name “Verlados”.

The use of this name was object of a specific complaint relating to the alleged misuse of the French geographic indication “Calvados”, referring to a similar spirit drink.

The Court adopted the same view of the “Cambozola” case and recalled the same basic principles.

First of all, it stated that, in order to check the existence of an evocative behavior, it shall be verified if part of a protected name is included in the term used to designate the product at issue and, if yes, whether the image triggered in the consumer’s mind – when confronted with the name of the product – is that of the product whose designation is protected. In other words, it is essential to evaluate whether the consumers – by simply reading and/or hearing the name at issue – are likely to establish a link between that term and the protected name.

In this specific field, the Court expressed that the benchmark is not simply a reasonably well informed, observant consumer, but it is the European consumer. It means that the assessment of an evocation shall be carried out on an European reference of consumers. In fact, the evocation shall not be limited to the Member State in which the protected good is manufactured, but shall take into account the European territory, considering that the products are generally sold in other countries as part of the single internal market⁸⁸.

The Court added that another crucial indexes in terms of “evocation” occur when, concerning products which are similar in appearance, the sales names are phonetically and visually identical. As regards the specific visual and phonetic relationship between the names “Verlados” and “Calvados”, the Court highlighted that they both contain eight letters, the last four of which are identical, and the same

110/2008 — Article 16(b) — Evocation — Cider spirits produced in Finland and placed on the market as ‘Verlados’ — Protected geographical indication ‘Calvados’. Case C-75/15.

⁸⁸ Case C-75/15, paragraphs 27 and 28. This EU Court’s reasoning has been studied in the academia. Some folks notice that – in the EU case law – the notion of “average consumer” is widely used. Still, it has never been expressly clarified in the sector of geographical indications. Thus, this particular case is significant, since it clearly states that the “average consumer” covers EU consumers and not merely the consumers of the member State where evocation is challenged. The relevant *ratio* lies in the circumstance that geographical indications are Union-wide and therefor uniformity should be ensured. Please refer to, among others, A. VOLPATO, *On Consumer, Evocation and Cider Spirit*, in *European Food & Feed Law Review*, Vol. 11 Issue 2, 2016

number of syllables, and that they share the suffix “dos”, which confers on them a certain visual and phonetic similarity.⁸⁹

What is interesting, in the “Verlados” judgment, is that the Court focused on another principle – which is essential for the competent authorities to evaluate with regard to the specific circumstances of each case. The Court referred to the existence of possible information and circumstances indicating that the visual and phonetic relationship between the two names is not fortuitous⁹⁰.

Finally, the Court concluded that, in any event, the use of a name classified as an “evocation” shall not be authorized, even in the absence of any likelihood of confusion⁹¹.

In conclusion, it is clear that in the present case, the Court recalled the concept of “evocation” as established in the previous case law. Therefore, what is of most interest in this case is the “novelty” of definition of the reference consumer.

2.8.3. The “Toscoro” case

The last judgment that might be taken into account to complete the analysis on the concept of evocation is the “Toscoro” case⁹². The case dealt with the trademark “Toscoro” registered for a variety of products such as olive oils and salad dressing⁹³

⁸⁹ Case C-75/15, paragraphs 22 and from 30 to 38.

⁹⁰ Case C-75/15, paragraph 39. In that regard, in the case at issue, the Court suggested that it might be taken into account that the product “Verlados” was originally named “Verla” and the suffix “dos” was added only later (i.e. from 2001 on), following a significant growth in exports of the French “Calvados” to Finland. Moreover, it can be noted that the syllable “dos” has no particular meaning in the Finnish language. In light of all these information, there might be enough evidence to conclude that the similarity between the protected name “Calvados” and the name at issue “Verlados” is not fortuitous.

⁹¹ Case C/75-15, paragraph 45.

⁹² Judgment of the General Court (Seventh Chamber) of 2 February 2017. Roberto Mengozzi v European Union Intellectual Property Office. EU trade mark — Invalidity proceedings — EU word mark TOSCORO — Earlier protected geographical indication ‘Toscano’ — Absolute ground for refusal — Article 142 of Regulation (EC) No 40/94 — Articles 13 and 14 of Regulation (EEC) No 2081/92 — Declaration of partial invalidity. Case T-510/15.

⁹³ For the sake of completeness, please note that the name “Toscoro” was registered for products falling under classes 29 and 30 of the Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended, corresponding to the following description:

- Class 29: ‘Edible oils fats; edible vegetable oils, notably olive oils; creams for food and in particular nut creams, artichoke creams in truffle sauce, green and black olive creams; mushrooms in sauce and dried mushrooms’;

which was annulled as deemed conflicting – in terms of “imitation” and “evocation” – with the registered PGI “Toscano” granted to the product olive oil.

In considering the matter under its consideration, the Court summarized the relevant principles to evaluate the existence of “evocation”. In particular, the Court noted the concept of “evocation” firstly covers a situation where the term used to designate a product incorporates part of a protected designation, with the effect that, when confronted with the name of the product, the consumers bear in their mind the image of the product protected under the registered geographical indication. Furthermore, the Court of Justice referred to the evaluation of the phonetic and visual similarity which might exist between the names at issue. Finally, the Court of Justice held that there could be evocation of a protected designation even in the absence of any likelihood of confusion between the goods concerned, since what matters is, in particular, that an association of ideas regarding the origin of the products is not created in the mind of the public⁹⁴. Moreover, this case is interesting since the EU judges, when assessing the “evocative” nature of the mark “Toscoro”, provide for a wide interpretation of the condition relating to the identity between the products identified by the names under exam. Generally speaking, in order for association between products (and consequent possible confusion) occurs, they are supposed to be of the “same type”. However, pursuant to this recent interpretation, a mark can evoke a PGI even when products are not fully identical, but still share common features. And this is the case of “Toscoro” and “Toscano PGI”. “Toscoro” is applied not only to olive oil, but also olive creams. Indeed, it is clear that these products share the fact of being foodstuff derived from olives (or better, whose main ingredient is identical)⁹⁵.

-
- Class 30: ‘Coffee, coffee extracts and coffee-based preparations; coffee substitutes and extracts of coffee substitutes; tea, tea extracts and tea-based preparations; cocoa and preparations having a base of cocoa, chocolate, chocolate products, confectionery, sweets; sugar; natural sweeteners; bakery products, bread, yeast, pastries; biscuits; cakes, desserts, puddings; ices, products for making ices; honey and honey substitutes; breakfast cereals, rice, pastas, food products based on rice, flour or cereals, also in the form of pre-cooked dishes; products for flavoring or seasoning foodstuffs, salad dressing, vinegar, mayonnaise, pizza, sauces and in particular tomato sauces and vegetable sauces’.

⁹⁴ Case T-510/15, paragraph 31.

⁹⁵ Case T-510/15, paragraph 45. For a further comment on this case (highlighting also this novel interpretation), please refer to C. CODUTI, *Indicazioni geografiche e marchi. Note a margine del caso Toscoro*, in *Rivista di Diritto Alimentare*, volume 4, September-December 2017.

Given all these premises, the Court claimed that there was no mistake in the analysis of the similarity of the signs at issue, as such confirming the annulment decision. The Court in fact rejected any alleged plea by underlining that, as a matter of fact, in the present case, there is visual and phonetic similarity between the signs at issue. The Court noted that both the beginning (i.e. the element “*tosc*”)⁹⁶ and the final letters (i.e. the letter “*o*”) of the two signs are identical. Thus, the signs at issue, each of which is composed of seven letters and three syllables, have in common five letters with identical positioning⁹⁷.

In light of the abovementioned case law, it is quite clear that the notion of “evocation” turns out being very broad, including the use of any names which – considering the visual and phonetic similarity or, indeed, including a portion of a protected designation – is able to trigger into the consumers’ minds the image of a product covered by a registered geographical indication (and this is true even if the consumers are not materially confused)⁹⁸.

⁹⁶ At this respect, another European case law principle is highlighted. Namely, that a consumer usually pays more attention to the beginning of a sign than to its end.

⁹⁷ Case T-510/15, paragraphs from 33 to 39.

⁹⁸ For sake of completeness, when analyzing the notion of “evocation” in connection to geographical indications, please refer to the very recent “Glen Whisky” case. Judgment of the Court (Fifth Chamber) of 7 June 2018. *Scotch Whisky Association v Michael Klotz*. Request for a preliminary ruling from the Landgericht Hamburg. Reference for a preliminary ruling — Protection of geographical indications of spirit drinks — Regulation (EC) No 110/2008 — Article 16(a) to (c) — Annex III -- Registered geographical indication ‘Scotch Whisky’ — Whisky produced in Germany and marketed under the designation ‘Glen Buchenbach’. Case C-44/17.

It deals with alcoholic beverages, thus a subject which is outside the scope of this dissertation. However, considering that the case is really close to the completion of this dissertation, it is worth being taken into account so as to highlight that the EU position on “evocation” seems to be stable and agreed.

The case under exam takes its first steps from the alleged “evocation” of the protected name “Scotch Whisky” by a German producer, selling alcoholic beverages with the denomination “Glen Buchencach”. In fact, “glen” is the gaelic word for “valley” and thus can mislead the public to think that the product in question is scotch whisky. In its ruling, the EU Court repeats that – in order to determine whether “evocation” of a protected geographical indication occurs, it is necessary to assess if the average EU consumer (being reasonably well informed, observant and circumspect) is confronted with the disputed geographical name and the image triggered in his mind is that of the product linked to the registered name. Moreover, the Court specifies, in order to carry out this evaluation – in the absence of both a phonetic or visual similarity between the two names and the incorporation (even if partial) of the protected geographical indication in the disputed name – the judges should refer also to the conceptual proximity of the names. This ruling looks in line with the previous one, with the sole specification that also the conceptual proximity can be used as a benchmark in the analysis. It remains understood that there is no evidence yet on how this principle is applied by national judges (and thus no proof on the role materially attributed to conceptual proximity).

A system that excludes *tout court* such behaviors and – contemporarily – prevents any false, misleading or unfair act results extremely comprehensive.

In addition, Regulation 1151/2012 provides for the means to make such statements real and effective, avoiding for them to lie as empty provisions. At this respect, the last section of this paragraph analyzes the control system established by the EU legislators, highlighting the relevant applicable rules and the main features, which show another feature of the “public” connotation of the EU model of protection of geographical indications and make it – at least in theory – particularly effective (or intrusive?), in contrast with the global trend of the other systems of law.

2.9. The system of controls under Regulation 1151/2012

Regulation 1151/2012 dedicates a whole section to the control system⁹⁹.

By way of introduction, it is possible to underline that the official control system outlined by the EU rules is, generally speaking, an *ex officio* one¹⁰⁰ (i.e. automatically applicable even in the absence of private actions), whereby various actors – at various levels – upon the State’s authorities instructions, are required to carry out controls on the registered geographical names. In this context, with the aim of making the system complete to the maximum extent possible, Regulation 1151/2012 imagines also the chance (although not compulsorily) for groups of producers and other private parties to cooperate to the supervisory activities.

In particular, the core provisions on this topic (shaping the *ex officio* scheme of surveillance) are Articles 13 and 36 of Regulation 1151/2012. Pursuant to Article 13, paragraph 3, it is up to each member State to take all the administrative and judicial steps appropriate to prevent or stop the unlawful use of geographical names

⁹⁹ Please refer to Title V, Chapter I, Official controls of protected designations of origin, protected geographical indications and traditional specialties guaranteed, Articles from 35 to 40 of Regulation 1151/2012.

¹⁰⁰ At this respect, please note that such complete system has been ultimately reached with the adoption of Regulation 1151/2012, which implements all innovative solutions reasonable and long overdue. It overcomes the scope of the analysis to study the development and critics relating to the control system. The dissertation indeed focuses on the system as is, taking into account that the current shape distinguishes the EU experience from almost all the others system of law and represent the highest level of protection of quality products and the added value connected thereto.

produced and marketed within its territories¹⁰¹ and, to this extent, designate the authorities¹⁰² that are responsible for taking the mentioned steps in accordance with the relevant internal procedures. In particular, pursuant to Article 36 of Regulation 1151/2012, the competent authorities are designated in accordance with Regulation (EC) No 882/2004 on official quality controls (hereinafter, “Regulation 882/2004”)¹⁰³ and would carried out controls pursuant to the rules set forth thereto. In other words, it is settled that procedures and requirements of Regulation 882/2004 shall apply *mutatis mutandis* to official controls carried out to verify compliance with the legal requirement related to geographical indications¹⁰⁴.

Such compliance relates to, first, the exact correspondence between the product and the relevant product specification and then the fair and compliant use of the names in the market.

If, as shown, member States are entrusted to carry out generalized control with the sole support of adequate and independent bodies (necessary in order to make the control effective in a capillary way), Article 45 of Regulation completes the relevant

¹⁰¹ Without going into deep on the matter, but just to provide the readers with a complete and clear picture, please note that the extension of the *ex officio* controls is introduced by Regulation 1151/2012 on purpose, in order to fill in the gaps of the previous Regulations. Please refer to F. CAPELLI, *Il Regolamento (UE) n. 1151/2012 sui regimi di qualità dei prodotti agro-alimentari: luci ed ombre*, Rivista di diritto alimentare, volume 1, January – March 2014, pointing out this novelty.

The author also recalls that, in fact, in the “Parmesan” case (already analyzed in this chapter, at paragraph 2.6.4, with regard to the generic nature of names), Germany upholds – and it is confirmed by the EU Court – that its national control authorities cannot carry out any repressive action against the German “illegal” producers of “Parmesan” because it lacks in the EU rules a specific provision regarding to duty of public authorities of a country to activate for the violation of geographical names referring to the territories of another member State.

¹⁰² Pursuant to Article 36, paragraph 2 of Regulation 1151/2012, the mentioned authorities “*shall offer adequate guarantees of objectivity and impartiality, and shall have at their disposal the qualified staff and resources necessary to carry out their functions*”.

¹⁰³ Please refer to Regulation (EC) No 882/2004 of the European Parliament and of the Council of 29 April 2004 on official controls performed to ensure the verification of compliance with feed and food law, animal health and animal welfare rules.

Regulation 882/2004 reorganizes official controls so that they are integrated at all production stages and in all sectors of agriculture and food. It sets out the responsibilities of both national and EU inspectors. It aims at preventing, eliminating or reducing to acceptable levels the risks to humans and animals, to guarantee fair practices in food and feed trade and to protect the public.

¹⁰⁴ At this respect, it is worth taking notes of some remarks upon the express refer to Regulation 882/2004 made by Regulation 1151/2012. This provision, in fact, expresses the intention to simplify and harmonize relevant controls in the entire agri-food sector, with the purpose of granting the greatest quality and outcome. Please refer, among others, to E. CRISTIANI, G. STRAMBI, *Public and private standards official controls*, in *European Food Law*, L. Costato, F. Albisinni (a cura di), 2012.

framework involving also private parties (in particular groups of producers)¹⁰⁵ in the supervisory scheme, entrusting them to basically inform the public institutions of alleged violations and adopting, in their day-by-day activities, measures adapt at ensuring compliance of a product with its specification and enhancing the value of their products and, where necessary, preventing or countering any measures which are, or risk being, detrimental to the image of those products¹⁰⁶.

From the brief explanation, it is clear that the control system, as ultimately imagined by the EU legislators, has a strong “public” connotation and is intended to become the template for a omni-comprehensive and effective system of promotion and exploitation of quality foodstuff (in other words a means to realize the quality objectives of the EU agri-food policy)¹⁰⁷ and makes the EU model of protection of geographical indications even more a *sui generis* one.

As mentioned, it is not the purpose of this dissertation to inquiry deeper on how controls are materially carried out in each member country. Actually, it is important

¹⁰⁵ It seems useful to remind what we mean with “groups of producers”. In particular, Article 45 of Regulation 1151/2012 makes explicit reference to the definition provided by Article 3, point 2, according to which group means “any association, irrespective of its legal form, mainly composed of producers or processors working with the same product”.

To clarify what this means in practical terms, please take into account that, under the Italian legislation, the so called “Consorti di Tutela” are groups pursuant to Regulation 1151/2012.

¹⁰⁶ For the complete list of tasks entrusted to groups of producers with regard to quality schemes, please refer to Article 45 of Regulation 1151/2012, stating that:

“A group is entitled to:

(a) contribute to ensuring that the quality, reputation and authenticity of their products are guaranteed on the market by monitoring the use of the name in trade and, if necessary, by informing competent authorities as referred to in Article 36, or any other competent authority within the framework of Article 13(3);

(b) take action to ensure adequate legal protection of the protected designation of origin or protected geographical indication and of the intellectual property rights that are directly connected with them;

(c) develop information and promotion activities aiming at communicating the value-adding attributes of the product to consumers;

(d) develop activities related to ensuring compliance of a product with its specification;

(e) take action to improve the performance of the scheme, including developing economic expertise, carrying out economic analyses, disseminating economic information on the scheme and providing advice to producers;

(f) take measures to enhance the value of products and, where necessary, take steps to prevent or counter any measures which are, or risk being, detrimental to the image of those products”.

¹⁰⁷ For a precise analysis of the control systems as set forth by Regulation 1151/2012 and their role in enhancing the quality purposes of the EU institutions, please refer to G. CASTELLI, *La protezione ex officio delle DOP e IGP dei prodotti agricoli e alimentari*, in *Rivista di Diritto Agrario*, volume 1, 2013; S. A. CERRATO, *I controlli sulla qualità del cibo: forme, disciplina e meccanismi di enforcement*, in *AIDA*, 2015. To be honest, besides describing the control mechanisms and pointing out their ratio, the author questions the overall beneficial effects of the geographical indications model due to the costs of access and implementation of the system itself.

for the reader just to be aware how the registered geographical indications are protected within the EU borders in order to have a clear idea of what are the benefits and implications of a multilateral extensive system of protection similar to the one proposed by the author. In fact, should such system be multilaterally agreed, an ancillary system of controls is likely to follow or, at least, be discussed (and the EU model might influence the other countries domestic legislations).

3. CONCLUSIVE REMARKS

This is right the end of the first chapter of this thesis. With the support of the case law, it outlines the EU approach towards the protection of geographical indications. It seems quite clear that the EU model consists in the protection of geographical names as a distinct form of intellectual property, following a *sui generis* system of registration and protection independent from the trademark system and with a strong “public” connotation.

At this respect, this chapter describes the main features of Regulation 1151/2012. In particular, it analyses the relevant *ratio*, involving heterogeneous interests (i.e. ranging from information to consumers, preserving traditions, promoting rural development and granting fair competition among producers).

Its exhaustive nature with regard to the internal legislation of the single EU member States (as such showing a centralized interest in providing a uniform benchmark for all food products to export in the international negotiations) and the contents of geographical signs.

The procedure of registration which grants the access to the system (involving a basically whole public assessment towards the existence of requirements necessary to ground the recognition of the geographical name) and the protection granted thereafter, being an *ex officio* one, where the initiative is entrusted to public bodies and not left to private stakeholders.

The author approaches this analysis of these topics in such a way as not to overlap the copious works of the EU academia. As a consequence, should the principles be studied in an analytic manner, the reasoning are built with the precise aim of highlighting the features of the EU model necessary to carry out a reasoned and grounded comparative analysis with other system of law and, to this extent, equip the

readers with all the relevant tools necessary to understand the further discussions. Indeed, the dissertation immediately travels on the other side of the Atlantic Ocean and focuses upon the opposite approach adopted by third countries such as the US. The US in fact might be deemed the “*ying and yang*” of the EU in the field of quality schemes for food products. They do not set up a separate system of protection of geographical indications. The relevant legislation does not explicitly refer to “geographical indications”. Therefore, under the US common system, geographical indications are granted protection as a sub-set of the trademark system, in the form, less frequently, of collective marks and, generally, of certification marks and, as such, their management is left exclusively to private actions.

Still, the next chapter points out that, despite the first sight feeling, there is more than one point of contact between the two systems and, following the consumers trends and the global needs, it is not unlikely to find a compromise between the two blocks.

As already mentioned, the final goal of the dissertation is to point out a sort of “meeting point” between the conflicting perspectives in the protection of geographical indications, that might lead to satisfactory and complete trade partnership between the two countries. And such outcome – as better detailed in the last chapter of this dissertation – is reached by suggesting the enhancement of multilateral system of protection of geographical signs that makes the extended level of protection set forth by Article 23 of the TRIPs exclusively in favor of wine and spirits available to all food products.

Of course the author is well aware of the economic obstacles emerging in some sensitive sectors (especially the dairy and meat ones) where a widespread use of EU geographical names such as some of the mentioned herein (i.e. Parmesan or Feta) is made on the basis of their generic nature. Therefore, with the purpose of getting consensus on the proposal (which can, ultimately, be profitable for all international stakeholders in the long period), the author suggests also to evaluate the possibility to provide some exceptions to the general extended level of protection. These exceptions basically consist in drafting a list of specific names (of course the list should be globally shared) that, on one side, cannot be deemed *tout court* generic, but, on the other side, are strategically important for some sectors, and thus can be used by interested parties in a descriptive way, provided that the place of real origin is

clearly displayed and they are not misleading (by way of example, "*Parmesan kind – product of California*").

CHAPTER III:
THE PROTECTION OF GEOGRAPHICAL INDICATIONS UNDER CURRENT LAWS
OF UNITED STATES OF AMERICA

SUMMARY: 1. Introduction – 2. The protection of geographical terms under the Lanham Act – 2.1. Individual trademarks for geographic terms – 2.1.1. Inherently distinctive geographic terms – 2.1.2. Primarily geographically descriptive and deceptive terms – 2.1.3. Primarily geographically deceptively misdescriptive and deceptive terms – 2.2. Certification and collective marks – 2.2.1. Certification marks – 2.2.2. Collective marks – 2.3. Genericness applied to geographic terms – 2.4. “Fair use” defense – 3. US States’ initiatives – 4. US Federal Law on false and misleading practices and the impact on geographical names – 4.1. Unfair competition under the Lanham Act – 4.2. Misbranding under Section 403 of FDCA – 4.3. Misadvertising under Sections 5 and 12 of FTCA – 4.4. The intersection between Lanham Act and FDC. POM Wonderful v. Coca-Cola – 5. Conclusive remarks.

1. INTRODUCTION

The previous chapter described the EU Regulation on the protection of Geographical Indications. The outcome is a *sui generis* system of registration and protection independent from the trademark law, characterized by a public proprietary model and a protection extended to all forms of misleading use of and unfair competition towards geographical names (even with respect to evocative behaviors).

As already mentioned, the purpose of this dissertation is to provide scholars, negotiators and stakeholders with a new perspective on the trans-Atlantic *querelle* over Geographical Indications, so that a uniform system can be adopted. The envisaged model is one from which reciprocal trade of quality products would benefit.

As mentioned, before getting to the conclusion, it is of greatest interest – especially for a European public and in order to understand how to reach a multilateral shared consensus – to describe the broad legislative picture in which the debate is currently taking place. To this extent, following the analysis of both the International and the European *status quo* on the topic, the present chapter is dedicated to the study of the current system of protection of geographical terms under US Law.

In order to fully understand what is coming forward, the reader necessarily needs to reset his mind, granting a welcome to a background, at first sight, deeply different to the European one.

Most of grocery stores in the United States split the same category of products into different sectors. A significant example is that of cheese: a first cheese section is usually associated with the dairy products; a second one is often named “specialty cheese case” and is located in the traditional and/or special products department. As it is, shoppers may be requested to look at two different places to buy, either way, cheese. The reason of this separation can be found in the existence of several differences between the products. The most noticeable one is probably the price: cheeses in the specialty case are generally much more expensive. A second difference can be found in the packaging: many cheeses in the dairy aisle are usually processed (i.e. pre-grated, pre-shredded, or pre-sliced and individually wrapped, or pre-cut). On the contrary, it is likely that most cheeses in the specialty section are sold in wedges or blocks. What matters the most is the origin. Almost all cheeses found in the dairy aisle are produced in the United States, and that is true also for cheeses labeled “Swiss”, “Parmesan”, “Gorgonzola”, or “Feta” (each of them protected by a specific Geographical Indication within the European territory). The traditional/special products department, on the other hand, is where most imported cheeses are kept. Here is where a shopper is more likely to find Parmigiano and Gorgonzola cheeses materially produced in Italy or Feta cheese from Greece¹.

It is thus clear that, as of now, there is no restrictions in marketing within the United States borders products bearing the same (or similar) EU geographical names, although they do not come from the same territory. It is a matter of free riding of Geographical Indications and of different domestic approaches.

The roots of such *status quo* are basically historical: the concept of “*terroir*”² and the value of geographical terms as distinctive signs for products is something “imported” in the New World.

Very early in their history (around the beginning of 1800), the United States faced a

¹ On the status quo of grocery stores in the United States of America, please refer to I. DOSTER, *A cheese by any other name: a palatable compromise to the conflict over Geographical Indications*, in *Vanderbilt Law Review*, 2006.

² “*Terroir*” is a French term (which has no specific translation in English) identifying a product’s environment and connotation. When the product itself tastes of somewhere or makes the public think about a specific place on earth the product is expressing its “*terroir*” of provenance.

A precise definition of “*terroir*” in relation to wine can be found in M. ALLEN, *Sniff, swirl & slurp: how to get more pleasure out of every glass of wine*, 2002.

In general on the role of “*terroir*” in the trade relationships between EU and USA, please refer to J. JOSLING, *The war on “terroir”: Geographical Indications as a Transatlantic trade conflict*, in *Journal of Agricultural Economics*, volume 57, no. 3, 2006.

significant immigration of European people, bringing with them their products together with the relevant methods and styles of manufacture, some of which were unique to specific region and territories. Back then, a new relationship to food has begun to rise in the New World, with daily food consumption integrating not only “locally made” food, but more transplanted products and recipes, bearing specific properties and flavors³. Thus, such an expansion of food alternatives in the United States has been going through a non-stop growth as a consequence of mainly: i) drop in the transportation costs and improvement of their functionality which made easy the supply of all kinds of products; ii) increase in the sophistication of the average consumers, demanding for niche food products, both domestic and foreign.

Geography started to become a valuable asset among the public and similarly to what usually happens with all the assets, there has been a rising need of implementing legal tools (in the form of branding signals) to better identify food quality and reputation, especially those related to the origin⁴.

Still, unlike the European Union, the United States did not set forth a system specifically designed to protect geographical indications. Rather, they relied on existing legal means compliant with the scope of their own culture and legislation⁵. They referred to the Trademark system, naturally devoted and adapt at identifying

³ On the background of protection of geographical terms within the United States, please refer to, among others, R. PIROG, T. VAN PELT, K. ENSHAYAN, E. COOK, *Food, fuel and freeways: and Iowa perspective on how far food travels, fuel usage and greenhouse gas emissions*, in Leopold Center for Sustainable Agriculture, volume 6, 2001 (the main purpose of the paper is discussing the environmental implications of today’s food system. Nevertheless, it offers useful hints to understand how highly complex is today’s global food system, where much of the food production and processing occurs far away from where people live and buy groceries and the production, processing, storage, and transportation of the food is highly sophisticated); K. RAUSTALIA, S. R. MUNZER, *The global struggle over Geographical Indications*, in EJIL, volume 18, no. 2, 2007, D. GIOVANNUCCI, E. BARHAM, R. PIROG, *Defining and marketing “local” foods: geographical indications for US products*, in The Journal of World Intellectual Property, volume 10, no. 2, 2010.

⁴ In addition to all what is analyzed herein, as a general comment, please note that the awareness related to the ability of geographical signs to describe qualities and properties of all kinds of products (not only food ones) originating in certain regions is reflected in several initiatives from states and cities to brand their locations, which have become more and more popular. At this respect, please refer to B. EBENKAMP, *Greetings from a state of mind: from authentic colonial furnishings to Madame Twisto Totes, today’s destination licensing means posher products and savvy souvenirs. Best of all, “tourists” don’t have to leave home to see the sights*, in Brandweek, June 12, 2006.

⁵ As noted by some authors while studying the role of geographical terms within the US system: “the business world of the US is oriented towards liberal economic theory which is based on individual ownership”. Please refer to E. BARHAM, *Localisation within Globalisation: better protecting Geographical Indications to favour sustainable development*, Comments offered for the 2004 Annual WTO Public Symposium ORIGIN, Round Table on Geographical Indications 27 May 2004 – Geneva.

products in the market, by protecting source's identifiers and attesting qualities connected with the relevant source.

Following this path, generally speaking, protection against infringement and misuse may be granted to those geographical terms and signs that have been adopted or commercialized as a source identifier and acquired a certain level of distinctiveness among the public.

Whereas a first sight incompatibility exists between the EU and the US, this analysis aims at arguing a "substantial" uniformity in the EU and US approaches towards the protection of geographical indications, deriving if adopting a functional point of view. This is possible if looking at the two systems not as opponents, but as partners basically serving the same double-faced function (i.e. protection of, on one side, consumers from misleading information and, on the other, producers from unfair competition)⁶.

Adopting this perspective, the analysis of the US system demonstrated – as final achievement – that there is no legal basis to deny the enhancement of an international extended level of protection of geographical indications. As better detailed hereinafter, the US system is composed of different layers (both of private and public nature), whose combination already provides an adequate (even if complex) system of recognition and protection of geographical indications. To be clearer, following the envisaged interpretation of the issue, it is possible to imagine – under the current system – that Consorzio di Tutela del Parmigiano Reggiano could eventually begin a suit against US "parmesan" producers alleging the existence of a commercial tort for misuse of and/or unfair competition related to the geographical term "Parmigiano Reggiano" – even in translation. Such a suit may be grounded on the fact that, despite the circumstance – likely to be argued by the US defense – that an actual association between the geographic region and the product does not exist⁷,

⁶ On the adoption of a "functional" perspective as comparative tool, please refer to, among others, K. ZWEIGERT, H. KOTZ, *An introduction to comparative law*, 1996; M. FERRARI, *La dimensione proprietaria delle Indicazioni Geografiche: uno studio di diritto comparato*, 2015.

⁷ This scenario is not unusual. An average US consumer may be aware that "parmesan" has something to do with Italy, but it is highly unlikely that he would be able to place on a map the region where "parmesan" is produced. At this respect, it shall be taken into account verified data showing that the knowledge of global geography is pretty low in the US. Between December 17, 2005 and January 20, 2006, the National Geographic carried out a "general knowledge survey", involving 510 interviews with a representative sample of 18- to 24-year-olds in the continental United States. It showed, among others, that 7 in 10 cannot find North Korea on a map of Asia; 9 in 10 cannot find Afghanistan on a map of Asia; many do not know Sudan and Rwanda are in Africa (20% think Sudan is in Asia, 10% put it in

names of a foreign region may still evoke in the consumers' minds mental images of qualities and properties able to drive their purchasing choices, causing commercial damages. A hypothesis of deception/confusion can occur⁸.

Therefore, the implementation of an extensive level of protection of geographical indications will exclusively serve the function of uniform the systems and make it applicable also to third party signatories.

In addition, the analysis focuses on the reciprocal advantages of such a mutual system, taking into account not only EU producers' interests, but also those of the US businesses and consumers. In a nutshell, the analysis provides some hints for the US side to look beyond the traditional contested "protectionist" purposes and focus instead on the mutual benefits. Only to mention few of them, an extensive recognition of geographical and local signs will respond to the increasing demand of US public, everyday more and more interested in the food sector. It may give a feedback to the fast changes in the food culture and habits⁹. In fact, consumers will be provided with a wider choice of products made available in the market, precise information on what they are going to buy. And, contemporarily, it will induce domestic producers to create original and renewed products, satisfying for the public's tastes and adapt at creating new market niches.

Of course this is a long-term analysis that would apply to the future, by granting fully protection to more recent geographical names or the less widespread. With reference to most debated and widespread one, it would in any case require the EU to adopt a certain level of flexibility in the negotiations (e.g. considering the widespread circulation of most of the products included in the famous "clawback" list, the EU maybe should consider the chance to authorize descriptive uses of some of these names that clearly show the origin and the differences between the products, such as "imitation", "product of California" etc.).

In order to provide the reader with the necessary means to fully understand the

Europe). The survey's outcomes are public at available at: <https://media.nationalgeographic.org/assets/file/Roper-Poll-2006-Highlights.pdf>.

⁸ Please note that this is just an example – made by the author's fantasy – with the unique purpose of clarify, using simple concepts, the final outcome of the analysis. Nothing contained herein constitutes or shall be interpreted as advice for eventual interested parties to take legal actions.

⁹ At this respect, please note that a complete analysis of the increasing interest in food of the US society (through initiatives such as, among others, the "Food movement") is carried out precisely throughout the last chapter of this thesis, when arguing in favor of an extended level of protection of geographical indications.

briefly mentioned arguments, the first step is to describe the various layers of protection of geographical names under the current US system¹⁰.

Thus, the present chapter is structured as follows. The first section describes the forms of protection of geographical names under the trademark perspective. In particular it focuses, firstly, on geographical individual trademarks and, then, on certification and collective marks. It moreover puts under the spotlight some basic principles of US trademark law that intersect with the debate over the protection of geographical terms. Reference is made to the concepts of “genericness” of names and “fair use defense” of marks¹¹.

¹⁰ Without aiming at being in any way complete, but simply in order to let the reader fully understand the role of the layers described here below within the general US system, how they intersect one another and what is the effect of judgments (throughout the chapter several cases are described in order to outline some general principles governing the protection of geographic terms), it may be of greatest advantage to outline with a brief introduction on the basic principle of US constitutional law. First of all, the US legal system is based upon four different sources of law: i) the Constitution; ii) Statutory Law; iii) Common Law; and iv) Equity.

The Constitution is the supreme law, which all the other sources of law shall comply with. For what matters at our purposes, “Federalism” is one the basic constitutional principles. As a consequence, all federal, states and local governments are allowed to exist and have their own power. In general, state laws shall deal only with matters relating to their territories, comply with the Constitution and be as stringent as federal laws.

Statutory Law comprises all kinds of written regulations: Congress’ statutes (Federal level), states’ regulations (State Level), Agencies’ regulations (Administrative bodies) and local governments’ acts.

Common Law is the collection of case law (at every level). It is a binding source of law according to which judges – when assessing and deciding a case – would refer to previous case ruling. In case Common Law is in conflict with Statutory Law, the latter is upheld.

With reference to the judicial system within the US territory, it is composed as follows: a) the Supreme Court which is the highest court in the Federal system and its decisions cannot be overturned; b) Courts of Appeals, known also as “district court” endorsed to review the cases ruled by the several district courts. The Courts of Appeals for the Federal Circuit has a nationwide jurisdiction, since it deals with appeals in specialized sectors. There are twelve circuits at all in all the Federal territories; c) the districts courts, which are the local courts spread throughout the US.

For further analysis of US Constitutional Law, please refer to, inter alia, C. HERMAN PRITCHETT, *The American Constitutional System*, 1976; J. A. BARRON, C. T. DIENES, *Constitutional Law in a Nutshell*, 2009; R. FELLON, *The dynamic Constitution: an introduction to American Constitutional Law and practice*, 2013.

¹¹ In particular, the Trademark Law on geographical signs is regulated by both Federal Statutory and Common Law. The relevant statute is the Trademark Act of 1946, as Amended (Public Law 79-489, Chapter 540, Approved July 5, 1946; 60 Stat.427).

With regard to the practical issues relating to trademarks, please note that a specific Federal Agency – the United States Patent and Trademark Office (hereinafter, “USPTO”) – is devoted at the protection and governance of trademarks.

In addition to the USPTO, the Trademark Trial and Appeal Board (hereinafter, “TTAB”) is an administrative board, which is devoted at, mainly, hearing and decides adversary proceedings relating to trademarks’ oppositions (party opposes a mark after publication in the Official Gazette) and cancellations (party seeks to cancel an existing registration). The TTAB also handles the appeals on final refusals of registration issued by USPTO.

The second section highlights various US initiatives of state certifications marks (such as Idaho potatoes, Vidalia Onions, Florida Oranges), each of them showing that it is at the greatest benefit of also US enterprises to promote origin of products, since it translates into significant sales growth both internally and overseas.

The last part is devoted, firstly, to the analysis of protection granted against both infringement and unfair use of marks under the Lanham Act. Then, it focuses on the description of ancillary provisions, not related to the Trademark sector, but concerning the Federal Regulations protecting the consumers from misbranding and false advertising of food products, cared by respectively Food and Drug Administration (hereinafter, "FDA")¹² and Fair Trade Commission (hereinafter "FTC")¹³.

For sake of clarity, in order not to overcome the scope of the analysis, this last section takes into account only those provisions applicable in the broader debate over the protection of geographical indications. In particular, it exclusively recalls the relevant bars of unfair practices and describes a recent judgment, which allows competitors in the food sector to suit under Trademark direct actions practices prohibited by Federal rules against misleading practices in the market. It represents the basis to demonstrate that free ride of geographical indications in the US territory can already find relief under, directly, the Federal statutes governing trademark infringement and unfair competition (the Lanham Act), and, indirectly, measures prohibiting misbranding and deception of food products.

¹² FDA is an administrative body attached to one of the US Federal Executive Departments, namely the Department of Health and Human Services. It is in charge of enforcing rules, regulations and standards intended at protecting public's health in the food sector. For what matters at our purposes, FDA has the authority to compel with the labeling of food products in order to prevent all kinds of misbranding able of putting public's health in danger. In the context of measures against misbranding, as better detailed throughout this chapter, FDA takes care of preventing any false or misleading claim.

¹³ FTC is a Federal Agency responsible of ensuring the efficiency and fair competition in the markets, in order to avoid harm to consumers. The main object of FTC is to enforce Federal consumers protection Laws preventing fraud, deception and unfair business practices. For better pursuing the said objectives, FTC is subdivided into five specialized commissions. To our extent, it is worth of attention the Division of Advertising Practices, entrusted of dealing with truth-in advertising, in general, and, in particular, of preventing food fraud in advertising and other deceptive practices.

2. THE PROTECTION OF GEOGRAPHICAL TERMS UNDER THE LANHAM ACT¹⁴

As mentioned in the introduction, the primary function of a trademark is to identify goods and services coming from a single business source¹⁵.

Geographical names are, usually, “descriptive” terms. They correspond to a noun or adjective which simply designates the geographic location of origin of potentially all goods and services coming from the area named in the term¹⁶. The natural consequence of such a concept is that – in principle – no one can obtain an exclusive right to use a geographic name so as to preclude other businesses, operating in the same territory, to present to their public that their goods or services originate in the

¹⁴ The Lanham Act is the colloquial name to refer to the Trademark Act of 1946, as Amended (Public Law 79-489, Chapter 540, Approved July 5, 1946; 60 Stat.427), cit.

For general comments on the protection of geographical terms under the Lanham Act, please refer to J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 14 – Geographic term Marks, 2017; L. BENCH NIEUWVELD, *Is this really about what we call our food or something else? The WTO food name case over the protection of Geographical Indications*, in 41 Int'l Law, 2007; S. H. NAEVE, *Chief Judge Rader's material contribution to geographic indicator analysis*, in 7 Wash. J. L. Tech. & Arts, 2012; L. BENDEKGEY, C. H. MEAD, *International protection of Appellations of Origin or other Geographic Indications*, in 82 Trademark Rep., 1992.

The present section describes the US system of protection of geographical signs as set forth in the Lanham Act. For sake of clarity, it is crucial to bear in mind that the rights granted to registered trademarks are to the same extent provided also to “common law” marks.

In particular, in the United States parties are not required to register their marks to obtain protectable rights. It is possible to establish “common law” rights based solely on use of the mark in commerce, even without a registration.

However, owning a federal trademark registration provides a number of advantages over common law rights alone. First of all, it gives strength to a claim of exclusive use against all third parties, existing a legal presumption of ownership, validity, non genericness of the term and right to use. In addition, a registered mark is recorded on a public registry and easily accessible by all interested parties, as such, likely to be prevented to use it or similar terms. It allows to take advantage of the US registration as a basis to ask for registration in foreign countries.

Generally, on the “common law” protection of trademarks, please refer to U.S. PATENT & TRADEMARK OFFICE, U.S. DEPARTMENT OF COMMERCE, *Protecting your trademark: enhancing your rights through federal registration*, 2016, available at <https://www.uspto.gov/sites/default/files/documents/BasicFacts.pdf>.

¹⁵ Pursuant to Lanham Act, § 45 (15 U.S.C. § 1127), “*In the construction of this chapter, unless the contrary is plainly apparent from the context [...]*

Trademark. The term “trademark” includes any word, name, symbol, or device, or any combination thereof – (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown”.

¹⁶ As highlighted by some scholars – on the basis of the relevant case law – mere geographical names can be regarded as a kind of “common property”. If using the ancient Latin, they are “common juris”. On this respect, please J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 14 – Geographic term Marks, 2017, cit.

same place¹⁷.

Nevertheless, the US Law sets forth some exceptions to this general principle and allows the use of geographical names as trademarks under certain circumstances. In particular, according to the Lanham Act, recognition as trademarks is allowed when geographical terms are used in an inherently distinctive sense or – even if originally used in a descriptive manner – they have acquired a secondary meaning¹⁸.

On the contrary, recognition shall be refused to the names that are primarily geographically deceptively misdescriptive or otherwise deceptive¹⁹.

Each of the mentioned hypotheses is here below analyzed in detail.

2.1. Individual trademarks for geographic terms

2.1.1. Inherently distinctive geographic terms

As mentioned, geographical terms used in an inherently distinctive way can be recognized as trademarks. It is the case when geography does not matter, because the products do not come from the named place and the term does not describe any territorial provenance. On the contrary, it is reasonably certain that most consumers

¹⁷ Please refer to **190 U.S.P.Q. 238 (TTAB), In Re Charles S. Loeb Pipes Inc. (1975)**.

As noted by some authors, such a dislike represents a point of contact with the EU system of protection of Geographical Indications, which is hostile to a private appropriation of geographical terms. Nevertheless, some differences can still be found. In the EU, the use of a geographical name is subject to compliance with strict requirements. In the US, with the exception of what herein highlighted with reference to certification and collective marks and the application of the “fair use” defense, the provisions are lighter. The use of geographical terms should, in general terms, be granted to all those who produce in the named area or used it in a “fair” manner. At this respect, please refer to M. FERRARI, *Il nesso fra origine geografica e qualità dei prodotti agroalimentari: i diversi modelli di tutela europei e nordamericani*, in *Rivista di Diritto Agrario*, volume n. 2, 2014.

¹⁸ Pursuant to Lanham Act, § 2 (15 U.S.C. § 1052), “no trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it [...] (e) consists of a mark which, [...] (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them”. Still, pursuant to § 2 (15 U.S.C. § 1052), lett. (f) “nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce”.

¹⁹ Pursuant to Lanham Act, § 2 (15 U.S.C. § 1052), “no trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it [...] (e) consists of a mark which, [...] (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them”. In general, Pursuant to § 2 (15 U.S.C. § 1052), “no trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it (a) consists of or comprises immoral, deceptive, or scandalous matter”.

would not connect the name with any precise location and certainly would not believe that the good actually come from that place. The inquiry on such a distinctiveness of the term in the public's mind shall be carried out on a case-by-case basis²⁰.

Despite the peculiarity of each case, some guidelines may be useful when verifying the nature of the geographical term. For instance, whether the commercial activity of the applicant is widely inclusive or otherwise heterogeneous, it is unlikely that the consumers attach the products to any specific place²¹. The same applies when the significance of the term is commonly unknown or, alternatively, subordinate to other meanings²².

Whereas the geographic term has no connection with a place and rather identifies a business, the risks of consumers being misled on the provenance of the goods is

²⁰ Copious case law deals with the distinctive nature of geographical names, granting protection as individual trademarks. In this rich context, please take into account the following cases, selected as particularly meaningful since they involve the use of geographical names in connection to food products.

158 U.S.P.Q.U. 64 (TTAB), In Re Circus Ices Inc. (1966). The plaintiff appeals the refusal of registration of the name "Hawaiian Ices" in connection to flavored-iced products. The name is deemed both primarily geographically descriptive and deceptively misdescriptive of the applicant's goods. The Appeal Board first recalls the general principle in terms of distinctiveness of geographic names. It repeats that – in determining whether or not a geographical term is primarily geographic descriptive – the main step is to assess whether the public associates the products with the relevant geographic area.

In the specific case, it has not been made to appear that either the name "Hawaii" or "Hawaiian Ices" were used by anyone to denote the geographical origin of such products. Therefore, the refusal of registration is reversed.

157 F. 2nd 115, La Touraine Coffee Co. Inc. v. Lorraine Coffee Co. Inc., 1946. The plaintiff contests the defendant's unfair use of the name "Touraine" in connection to the sale of coffee products. The Court clearly states – as a basic principle governing the protection of geographical names – that when a geographic term is used in an arbitrary or fictitious sense it may be object of a valid trademark.

In the specific case, the word "Touraine" showed no geographic meaning. In fact, the term neither has nor professed to have any relation with source of the coffee, the place of manufacture or the place of sale. Instead, it seemed to be an entirely arbitrary name. Accordingly, the Court grants the plaintiff protection against unfair practices made available to trademarks.

²¹ The describe one together with other guidelines relating to the distinctiveness of geographic terms are provided for in a "Restatement View on Unfair Competition", expressly referred in J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 14 – Geographic term Marks, 2017, cit.

²² For instance, it is unlikely that the public would think that "North Pole" refrigerators are actually assembled at the North Pole. Just the same, they would not believe that "Amazon" store is located in the Brazilian jungle. For other examples on the lack of connection between geographic terms and territories, please refer to J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 14 – Geographic term Marks, 2017, cit.

extremely low. Hence, registration of such name shall not be prevented²³.

2.1.2. Primarily geographically descriptive terms

When the geographic term is not arbitrary, but descriptive, it still can be treated like non-geographic merely descriptive if an additional requirement is satisfied. Reference is made to the so-called “secondary meaning”, applicable if – as a result of continuous and substantially exclusive of a geographic name – the consumers have come to understand the geographic descriptive word in a renewed and secondary sense which identifies only one source and quality of goods and services²⁴.

²³ On the connection between registration of geographical names inherently distinctive and the risks for consumers, please refer to S. H. NAEVE, *Chief Judge Rader’s material contribution to geographic indicator analysis*, in 7 Wash. J. L. Tech. & Arts, 2012, cit.

²⁴ For a general overview over the “secondary meaning” principle, please refer to L. ALTMAN, M. POLLACK, § 20:14, *When use is not enough to create rights – the doctrine of secondary meaning*, in Collmann of Unfair Competition, trademarks, and Monopolies, 4th Ed., 2017.

The “secondary meaning” principle has been object of various judgments which made it firmly accepted in the common law and defined the relevant limits and features. At this respect, the following cases were selected to describe some traits of the “secondary meaning” principle, useful for the purposes of our analysis.

43 L.R.A. 826, Supreme Judicial Court of Massachusetts, American Waltham Watch Co. V. United States Watch Co. (1899). It represents the leading case on the topic of “secondary meaning”. It deals with the defendant’s alleged misuse of the name “Waltham” in connection to the sale of watches. The Court expressly finds that the plaintiff has acquired great reputation in the watch sector. Even though it originally used the term “Waltham” in a mere geographical sense, such a name has, by long use, come to be a designation of specific watches that the public had been accustomed to associate with the plaintiff.

Accordingly, the Court issues an injunction preventing the defendant to use the name “Waltham” upon the plates of its watches. However, the Court specifies that the restriction applies unless the defendant used a specific disclaimer or anything able to distinguish its products from those of the plaintiff. It is advisable that the reader takes carefully into account the disclaimer granted by the Court. It is important in shaping the contours of the scope of “secondary meaning”.

264 F. 2nd 88, Anheuser - Busch Inc. V. Bavaria Brewing Co. (1959). The plaintiff sues the defendant for an alleged unfair use of the name “Bavaria” in connection to its beers. The plaintiff showed enough evidence that it has developed a “secondary meaning” for the term “Bavaria” – at least in the territories of three States (i.e. Southern Ohio, Northern Kentucky and Southeastern Indiana). The Court, thus, issues an order of injunction restraining the use of Bavaria’s name by the defendant, limited to the cited area.

The case is significant in terms of application of the “secondary meaning”. It is possible to infer that the “secondary meaning” has a geographical scope, being able to exist either locally or on national scale.

774 F. 2nd 1451, California Cooler Inc. V. Loretto Winery Ltd. (1985). The defendant is charged for the misuse of the term “California Special Cooler” to sell in the relevant market wine coolers similar to those of the plaintiff.

The Court concludes that the plaintiff has demonstrated that the composite mark “California Cooler” had acquired secondary meaning. To this extent, it showed, among others, that 75% of the relevant

In other words, even when a name is originally a geographic descriptor, trademark significance may be attached if the use is so extensive and exclusive that the public understands the term “secondarily” as a business identifier.

To make it simple, secondary meaning exists when, in the mind of consumers, the significance of the geographic term is not the place of origin of the product but the producer himself.

So far, the analysis dealt with admissible registrations of geographical names as trademarks, because either they depart from their descriptive significance becoming sources’ identifiers or they are arbitrary because the products do not come from the territory and they simply designate the relevant business.

Nevertheless, a further inquiry is required when non-distinctive terms are used in inaccurate way, meaning in connection with goods not coming from the place named in the mark. Such inquiry aims at verifying whether any deceptively misdescriptive or simply deceptive practice occurs.

2.1.3. Primarily geographically deceptively misdescriptive and deceptive terms

As stated, registration shall be refused towards those geographical terms that are used in deceptively misdescriptive or otherwise deceptive manners²⁵. The only exception occurs when a primarily geographically deceptively misdescriptive term became distinctive of the applicant’s goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act

public volunteered “California Cooler” as a brand of wine and winery products. Accordingly, the Court provides the plaintiff with a preliminary injunction against the defendant.

168 Cal. 289, Modesto Creamery v. Stanislaus Creamery Co., 1914. The plaintiff claims that the defendant marketed and labeled its butter in such a way to deceive the public that the butter rather came from the plaintiff.

The Court finds that the word “Modesto” (city in California) used by the plaintiff in both the label and the wrap of its butter acquired a secondary meaning. Apart from the origin, the term signified the source, the manufacture and the specific qualities connected to exclusively the plaintiff’s business.

²⁵ For sake of clarity, primarily geographically deceptively misdescriptive and deceptive terms can be paired together after the amendments of the Lanham Act further to the execution of North American Free Trade Agreement. Before the amendments, primarily geographically deceptively misdescriptive could be registered in case of secondary meaning. While, after the amendments, the same marks are regulated in a precise and separate section (i.e. Lanham Act, § 2 (15 U.S.C. § 1052), lett. (e)(3)) and expressly prevented from registration, even in case of secondary meaning. They are, in practice, treated as deceptive marks.

(hereinafter, “NAFTA”)²⁶, namely December 8, 1993²⁷.

The categorization of a geographical name as, alternatively, deceptively misdescriptive or otherwise deceptive is quite a sensitive matter and with no already-made solution, because it requires a deep insight into the consumers’ perception of the name itself. To translate the cited “deep insight” into practice, over the years, a step-based test has been developed²⁸.

Precisely, a geographical name cannot – under any circumstance – be recognized as a trademark if:

- i) its primary significance is a generally known geographic location;
- ii) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place; and
- iii) the misrepresentation is a material factor in the consumer's decision.

In conclusion, material deception in consumers’ minds with regards to the geographical origin of a product prevents the recognition of the name as a trademark. Some significant examples of names deemed primarily geographically deceptively misdescriptive are “Havana Club” used for Cigars not from Cuba, “Manhattan”

²⁶ NAFTA is a multilateral agreement entered into by and between USA, Canada and Mexico. With the execution of NAFTA, tariffs were eliminated progressively together with all duties and quantitative. NAFTA also includes chapters covering rules of origin, customs procedures, agriculture and sanitary and phytosanitary measures, government procurement, investment, trade in services, protection of intellectual property rights, and dispute settlement procedures.

²⁷ Please refer to Lanham Act, § 2 (15 U.S.C. § 1052), lett. (f).

²⁸ These requirements have been set up by US case law on geographic deceptiveness. For what matters to our purposes, it is important to underline that relevant case law has expressly extended the deceptive test also to primarily geographically deceptively misdescriptive terms. For instance, in **329 F.3d 1334, US Court of Appeals, Federal Circuit, in Re California Innovations Inc., 2003**, the Court reasons that, since primarily geographically deceptively misdescriptive terms have been separated by the other geographically distinctive names, they should be somehow treated differently. It also explains that, also with regard to primarily geographically deceptively misdescriptive terms, it shall be necessary to apply the more difficult showing of public deception, referred to deceptive terms, because both these categories are subject to permanent denial of registration.

Some authors noted that the application of the “materiality” requirement also to primarily geographically deceptively misdescriptive marks raises the evidence bar, making more difficult to deny registration. At this respect, please refer to J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 14 – Geographic term Marks, 2017, cit.

Some authors contested the application of such requirement upholding that the amendments to the Lanham Act (i.e. the split of geographically deceptively misdescriptive term from the other descriptive names) were intended to make it easier – not more difficult – to reject the registration of primarily geographically deceptively misdescriptive marks. At this respect, please refer to S. H. NAEVE, *Chief Judge Rader’s material contribution to geographic indicator analysis*, in 7 Wash. J. I. Tech. & Arts 467, 2012.

referred to cookies from Michigan, “Neapolitan” for sausages not from Naples²⁹.

2.2. Certification and collective marks

So far, the present chapter analyzed the circumstances under which geographic names can be protected as individual trademarks. In brief, geographic terms can be recognized to the extent of trademark law as long as they achieve “distinctiveness”, by either inherent assumption or secondary meaning. In other words, geographic signs can be recognized if they lose their primary geographical meaning and can never be protected if they are likely to mislead consumers about the provenance.

Nevertheless, this general analysis on geographic terms under US system is not the only chance for geographical indications: when it comes to protection of geography, the US system gets multifaceted.

The Lanham Act, in fact, defines two categories of trademarks that can serve expressly the function of geographic identifiers (not individual source connectors), even regardless of distinctiveness. Certification and collective marks can be recognized to the extent that they, respectively, certify certain qualities (including the geographic provenance) or are used by members of a specific group, who meet minimum requirements for being part of the relevant association.

These kinds of marks are particularly relevant for the analysis, since scholars, faculties and lawyers generally state that geographical indications are protected under the US certification and collective mark doctrine³⁰.

2.2.1. Certification marks

The Lanham Act expressly defines “certification mark” as “*any word, name, symbol, or device, or any combination thereof – (1) used by a person other than its owner, or (2) which its owner has a bona fide intention to permit a person other than the owner to*

²⁹ For a list of examples, please refer to J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 14 – Geographic term Marks, 2017, cit.

³⁰ At this respect, please refer to D. SNYDER, *Enhanced protection for Geographical Indications under TRIPs: potential conflicts under US Constitutional and Statutory Regime*, in 18 *Fordham Intell. Prop. Media & Ent. L. J.* 1297, 2008; I. SHALEVICH, *Protection of trademarks and Geographical Indications*, in 6 *Buff. Intell. Prop. L.J.* 67, 2008/2009; J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 19 – Federal Registration, 2017.

*use in commerce and files an application to register on the principal register, to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization"*³¹.

As showed by the Federal definition, certification marks – unlike individual trademarks – do not identify a specific business source. They are rather used to certify to consumers one or more characteristics of the products. In practice, they indicate to the public that the authorized manufactures meet the standards set forth with reference to a product. As a consequence, the public is made aware that the product has been examined, tested, inspected or otherwise reviewed by the mark's owner³².

Because of their nature – although they may go unnoticed for a slice of consumers – it cannot be denied that they can often determine whether the consumers would buy the product, at all³³.

In practical terms, the certification function is carried out in the following terms.

First of all, certification marks can be registered without proof of secondary meaning or distinctiveness. They thus can be descriptive³⁴.

The owner of a certification mark shall not be the user (i.e. "anti-use by the owner" rule³⁵). It means that the owner is in charge of registering the name, by clearly indicating to what geographic region the name refers and with respect to which

³¹ Please refer to Lanham Act, § 45 (15 U.S.C. § 1127).

³² For a specific description of this kind of function served by certification marks, please refer to I. SHALEVICH, *Protection of trademarks and Geographical Indications*, in 6 Buff. Intell. Prop. L.J. 67, 2008/2009, cit.

³³ It is worth mentioning, from the very beginning, that the certification function is one the main point of contact between EU and US system of protection of geographic names. As argued in Chapter II of this thesis, one of the rationale of the sui generis Geographical Indications Regulations lies in the value of qualities connected to geographic origin as a driving force in consumers' purchasing choices. This role of geographic terms is not unknown also from the US perspective. Among the several examples, it may be interesting highlighting that of "Kosher" searched by many health-conscious and religious consumers, such as Jews, Muslims, and Seventh Day Adventists before purchasing the product. At this respect, please refer to M. B. CHESAL, *Deciphering certification marks*, in 47 Broward Dailybus A7, 2006.

³⁴ Pursuant to Lanham Act, § 2 (15 U.S.C. § 1052), "*no trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it [...] (e) consists of a mark which, [...] (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title (i.e. certification and collective marks)*".

³⁵ This definition is provided by J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 19 – Federal Registration, 2017, cit.

protection is required, together with relevant standards³⁶.

In addition, the owner is in charge of managing the name, by monitoring the relevant use. The owner shall, in the first place, ensure that all products sold by the authorized users meet the certification requirements³⁷. Then, it shall prevent the dilution of the name, avoiding use by unauthorized parties so wide that the term becomes generic³⁸.

In light of the described tasks, it is possible to state that owner is exclusively the

³⁶ This can be considered another point of contact with the EU geographical indications regulatory framework. Through the certification, in fact, the owner sets forth specific standards for geography, quality, safety, purity and other desirable features.

As noted by some scholars, even if it is not mandatory, the system allows to include – within the certification elements – the existence of a special link between the characteristics of the products and its geographical origin. At this respect, please refer to G. E. EVANS, *The protection of Geographical Indications in the European Union and the United States under sui generis and trademark systems: signs of harmonization?*, in I.P.Q., 1, 2013.

This possibility is taken into account also by some relevant case law.

101 U.S.P.Q. 2nd 1731 (TTAB), Swiss Watch International Inc. v. Federation of the Swiss Watch Industry. The case involves the certification mark “Swiss” or “Swiss Made” for watches. The petitioner claims that the respondent has permitted the use of its certification marks for purposes other to certify. What is of greatest interest at our purposes is the following principle, set forth by the Appeal Board in the judgment (and showing some common features with the Geographical Indications under EU Law and, in particular, with the link between origin and qualities): *“the terms “Swiss” or “Swiss Made” for watches can certify the quality or characteristics that the watches are time pieces of great precision, without affecting their status as certification marks”*.

³⁷ The rationale of entrusting the mark’s owner with “controlling” powers over the use of the certification is based on the need to protect the public from being misled over the qualities and properties certified. And it seems clear that such a risk becomes of greater and greater consideration in the case of certification marks which, as mentioned, can affect purchasing choices.

Some case law has been released on the “monitoring” tasks of certification marks’ owner. Among the different judgments, the following is deemed of particular interest.

906 F. 2nd 1568, United States Court of Appeals, Federal Circuit, Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc. The case deals with a request of cancellation of a certification marks as a consequence of the registrant’s inability to control the use of the mark.

Regardless of the final outcome of the judgment (i.e. the appellant failed to prove basis for cancellation), what matters is the explanation of the grounds of certification marks’ owners duties. The Court expressly clarifies that the purpose of requiring the registrant to control over the use of the mark is to avoid the public to be misled. And this is particularly sensitive task in the case of certification marks, because they set forth specific representations and warranties about the manufacture and characteristics of the good to which the mark is applied.

³⁸ Please refer to *infra* paragraph 2.3. Genericness applied to geographic terms. As better explained herein, but already mentioned in the introduction of this section, it is a basic principle of Trademark Law that generic names cannot be protected since they are unable to distinguish a precise business source. Therefore, if registered, they shall be subject to cancellation.

This principle applies also to certification marks, provided that the features of the specific kind of mark are considered. It means that registration of a certification mark shall be refused (or if already granted, cancelled) if the designation does not have (or loses) all significance as identifier of precise and strict standards. And this is the case when the mark has come primarily to signify a type of goods, without regard to the geographical origin and the producing standards connected. This situation can be the result of failure to control of the owner.

standard setter and manager of the certification mark and never the users³⁹.

In carrying out its office as manager of the certification mark, the owner shall not discriminately refuse to certify or continue to certify the goods or services of any person who keeps the certification standards.

A kind of “compulsory licensing”⁴⁰ arises from this peculiar obligation. Once it has established the standards, the owner shall grant the license to use the name fairly and across the board to all whose goods do satisfy the requirements.⁴¹ Such a license, in turn, grants both owners and licensees alike the right to injunctive and monetary relief, in case of infringement of the name⁴².

In light of the above, there is no doubt that the reliability of certifications marks is largely left up to mark owners. Being a complex and sensitive task, although it is not prohibited, it is unlikely that private parties engage in the managing of certification marks. In fact, they are not usually in the best position to carry out the described activities, which are basically pursuing public policy goals (i.e. consumers’ information and fair competition). On the contrary, it is more likely that public oriented bodies are entrusted to manage the certification registration, use and licensing⁴³.

³⁹ The fear is that, should a certifier be allowed to compete in the market place of the goods and services it is supposed to certify, it would no longer be able to certify objectively. On this point, please refer to, among others, J. C. FROMERS, *The unregulated certification mark(et)*, 69 Stan. L. Rev. 121,130, 2017.

⁴⁰ Similarly to what mentioned on the “anti use by the owner” rule, this definition is provided by J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 19 – Federal Registration, 2017, cit.

⁴¹ This feature of certification marks is at first sight a further point of contact with the EU system of protection of Geographical Indications. As recalled in Chapter II of this thesis, within the EU territories, once a geographical name is registered as either PDO or PGI, each producer who complies with the standards can impress the relevant quality symbol on its products’ labels.

To uphold the importance of this principle, it can be stated that – as noted by some scholars in the US – the combination of the “anti use by the owner” rule and the “compulsory licensing” seems to be designed to promote free competition in the market of certified products, since it removes incentives for mark holders to engage in anticompetitive conducts. The same outcome has been adopted also by some recent case law, such as **425 F.3rd, 708, 717, 9th Circuit, Idaho Potato Commission V. G&T Terminal Packaging Inc., 2005.**

Again, in the system designed by the EU, Geographical Indication are intended to promote fair competition, by providing buyers with a useful economic tool for selling their products and consumers with clear information on the characteristics of products.

⁴² Precisely on the topic of rights granted to licensees, please refer to D. SNYDER, *Enhanced protection for Geographical Indications under TRIPs: potential conflicts under US Constitutional and Statutory Regime*, in 18 Fordham Intell. Prop. Media & Ent. L. J. 1297, 2008, cit.

⁴³ On the role of public bodies in the certification mark field, please refer to US DEPARTMENT OF COMMERCE – PATENT AND TRADEMARK OFFICE, *Trademark Manual of Examining Procedure*, as revised

In order to allow the reader to have a clearer idea of what is at stake, famous examples of certification marks⁴⁴ – protected under both statutory and common law – are “Florida” (with design) for citrus fruit and juices from Florida⁴⁵, “Stilton” for cheese from central England⁴⁶, “Parmigiano Reggiano” for long cured cheese coming from Parma region in Italy⁴⁷, “Parma” (combined with a crown design) for ham from the Parma region in Italy⁴⁸, “Vidalia” for onions grown in Georgia⁴⁹, “Darjeeling” for tea from India⁵⁰, “Cognac” for alcoholic beverages coming from France⁵¹.

through October 1, 1989. Referring expressly to certification mark, it states that “*the Government of a region would be the logical authority to control the use of the name of the region. The Government, either directly or through a body to which it has given authority, would have power to preserve the right of all persons and to prevent abuse or illegal use of the mark*”.

That is logic also considering that the costs of managing a certification are high and time consuming. And, in turn, the certification is not profitable itself, since the owner cannot use the mark to sell or promote its products. Thus, many private parties are prevented to invest in certification. At this respect, please refer to S. J. LOVENWORTH, M. SHINER, *Protecting geographically unique products: news: some think the US system needs fixing*, in *New York Law Journal*, 2008.

Some scholars have also noted that the public oriented structure of certification marks makes the line of demarcation between EU and US in the field of geographical terms more and more unclear. Such a structure, in fact, provides a good sample of how US institutions intervene in the protection of geographical terms more often than generally assumed. At this respect, please refer to C. LE GOFFIC, A. ZAPPALAGLIO, *The role played by the US Government in protecting Geographical Indications*, in *World Development*, Volume 98, 2017.

In addition, it is worth mentioning that these are not just suggestions, but facts, considering the circumstance that several US States intervene directly (and often invest) in the protection of Geographical Indications. Further analysis on the States’ initiatives follows herein and constitutes a strong argument towards a path of reconcile between EU and US in the field of food and geography.

⁴⁴ As general comment, it is interesting that most of the certification marks registered in the US relate to foreign products. First, this is significant in terms of existing protection and recognition of EU Geographical Indications, as better explained in the analysis. Second, it shows the substantial opening of the US system. As noted by some scholars, “*the Law of United States of America is non-discriminatory and an excellent model for other countries to follow*”. At this respect, please refer to M. G. COERPER, *The protection of Geographical Indications in the United States of America, with particular reference to certification marks*, in WIPO/GEO/WI/91/4 Rev.

⁴⁵ US Reg. No. 1200770, certifying that the citrus fruit was grown in the State of Florida under specified standards or are processed or manufactured wholly from such citrus fruit.

⁴⁶ US Reg. No. 1959589, certifying blue mould or white cheese produced within the county boundaries of Leicestershire, Derbyshire and Nottinghamshire, England, with no applied pressure, forming its own crust or coat and made in cylindrical form from full cream milk produced by English dairy berds.

⁴⁷ US Reg. No. 1896683, certifying that the goods originate in the Parma-Reggio region of Italy, specifically the zone comprising the territory of the provinces of Parma, Reggio Emilia, Modena and Mantua on the right bank of the river Po and Bologna on the left Bank of the river Reno.

⁴⁸ US Reg. No. 2014627, certifying that ham is made, processed and packaged in Parma, Italy.

⁴⁹ US Reg. 1709019, certifying yellow granex type of onion grown by authorized growers within the Vidalia region in Georgia as defined in the Georgia Vidalia Act of 1986.

⁵⁰ US Reg. 2685923, certifying a blend of tea containing at least 60% tea originating in the Darjeeling region of India.

Apart from being an example of certification, “Cognac” is worth being analyzed because it is a sample of “common law” certification mark⁵². It is a statement that protection of geographical names can be granted when public understands that the goods bearing the mark as produced in the region named therein and having certain qualities.

Such a reasoning is of great importance for this analysis. It paves the way to the chance that EU producers gain common law protection of their geographical indications through use within the US territory, as long as the names are recognized

⁵¹ **1998 WL 2851518 (TTAB), The Institute National des Appellation d’Origine and the Bureau National Interprofessionnel du Cognac v. Brown-Former Corp., 1998**. This case deals with the opposition against the defendant’s sought to register the mark “Canadian mist and Cognac” for alcoholic beverages consisting primarily of a mixture of Canadian whiskey and Cognac. The plaintiff/opposer claims that the name “Cognac” is a well-known, distinctive appellation of origin, designating a popular alcoholic beverage, produced following prescribed standards of quality and content and limited to the region of Cognac (France).

In its reasoning, the Board expressly recognizes the term “Cognac” as a common law regional certification mark, accepting the opposer’s motion. In addition, the Board emphasizes that, in order to grant protection to a geographical name, it is necessary to assess whether the public understands the goods bearing the particular mark come only from the region named therein, have certain qualities and are not produced elsewhere.

Should “Cognac” have been recognized as a mark, case law denied recognition to other geographical names. For the purposes of our analysis, it is worth mentioning “Fontina” and “Chablis”.

The term “Fontina” merely describes or is the generic name for a type of soft cheese, regardless of the geographical origin (ref. **230 U.S.P.Q. 131, TTAB, In Re Cooperativa Produttori Latte e Fontina Valle d’Aosta, 1986**).

Similarly, the word “Chablis” is used in the United States in the public domain. It is a generic name for a type of wine having characteristics similar to the French Chablis, despite that the grapes originate or not in France. (rif. **598 F. 2nd 1574, US Courts of Appeals, Federal Circuit, Institut National des Appellations d’Origine v. Vintners International Company Inc., 1992**).

⁵² For sake of completeness, it is worth mentioning that the common law recognition of certification marks is at stake. The relevant case law and doctrine recognize their admissibility. On this topic, please refer to M. G. COERPER, *The protection of Geographical Indications in the United States of America, with particular reference to certification marks*, in WIPO/GEO/WI/91/4 Rev., cit.; S. A. BOWERS, *Location, location, location: the case against extending geographical indication protection under TRIPs Agreement*, in 31 AIPLA Q. J. 129, 2003; L. BERESFORD, *Geographical Indications: the current landscape*, in 17 Fordham Intell. Prop. Media & Ent. L. J. 979, 2007.

330 F. Supp. 428, US District Court, M. D., Florida, Orlando division, State of Florida v. Real Juice Inc., 1971. The case relates to the alleged infringement of the name “Sunshine Tree” not registered, but commonly used by the plaintiff to identify citrus products originating in Florida. The Court holds the existence of a valid certification mark in the case, contemporarily stating that there is no substantive distinction between certification marks and trademarks that would render the case law pertaining the creation of common law trademarks non-applicable to certification marks.

Nevertheless, some folks affirm that certification marks should not be subject to common law recognition so that to avoid anticompetitive standards and inaccessibility of certification standards and revisions. At this respect, please refer to M. B. SMITH, *(Un)common law protection of certification marks*, in 93 Notre Dame L. Rev. 419, 2017.

as certifiers of geographical provenance and standards⁵³.

In conclusion, if certification marks – as shown – share several similarities with the geographical indications protected under EU system⁵⁴, they are not the only means available to ensure provenance of goods and the qualities connected.

The US system in fact sets forth an additional of geography and properties connected to geography, through the category of collective marks.

2.2.2. Collective marks

The Lanham Act reserves a precise definition also to collective marks. Namely, “*the term “collective mark” means a trademark or service mark – (1) used by the members of a cooperative, an association, or other collective group or organization, or (2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, and includes marks indicating membership in a union, an association, or other organization*”⁵⁵.

By simply reading the definition, it is easy to infer that there are basically two codified types of collective marks:

- i) first, those which identify the user as a member of a union, association or other organization;
- ii) second, those which are used by members of a specific group to identify their goods and services.

⁵³ At this respect, please refer to J. HUGHES, *Champagne, Feta, and Bourbon: the spirited debate about geographical indications*, in 58 Hastings L. J. 299, 2006.

Of course, the recognition is subject to the non genericness of the name. An envisaged motion, then, should pass the case-by-case test of non genericness, as better described herein at paragraph 2.3. Genericness applied to geographic terms.

⁵⁴ Some authors have underlined that certification marks are, in any event, private tools. Hence, being subject to the same discipline of individual trademarks, they are likely to be transferred or otherwise circulated. If this is true, the exception can be overcome easily. In fact, should a certification mark be transferred, the certification shall still be reliable for consumers. Otherwise, the validity itself of the mark would be compromised. Therefore, the mark is likely to be transferred to an owner who can carry out the certification tasks and ensure that use is compliant with the standards (of both geography and qualities). At this respect, please refer to M. FERRARI, *Il nesso fra origine geografica e qualità dei prodotti agroalimentari: i diversi modelli di tutela europei e nordamericani*, in *Rivista di Diritto Agrario*, volume n. 2, 2014.

⁵⁵ Please refer to Lanham Act, § 45 (15 U.S.C. § 1127).

The difference between the two categories lies in the mark's function. In the first case, the mark does not serve an "origin" function. It only signifies the membership status of an individual. In the second scenario, on the contrary, the mark serves as an identifier. It indicates that the products are sold by members of an organization or a collective group and meet the standards for admission⁵⁶.

In this latter case, the group holds the ownership of the mark in favor of all the members, entrusted to use it to distinguish their products from those of non-members.⁵⁷ Regardless acting generally as holder, the owner is not, in principle, prevented to use the mark itself⁵⁸.

At first sight, whenever collective marks are used by members of a group (admitted to the group on the basis of specific requirements) to distinguish their products, the distinction with the certification marks – certifying that all the user comply with certain standards – becomes a little blurry⁵⁹. Basically, the choice of one type of mark over the other lies in the expectations of the owners. If the owner is a private party who seeks to continue producing and selling goods, then he can just set up a group and apply for a collective mark. As such, he would set specific standards, but at the same time avoid the restraints and burdens connected to the management of a certification⁶⁰.

Regardless of any argument on the convenience of the different types of mark, for what matters at our purposes, it is worth noticing that collective marks may be used to identify that goods are sold by businesses being part of a group identified by the provenance from a named region.

⁵⁶ For a deeper explanation of the mentioned difference between the two codified types of collective marks, please refer to J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 19 – Federal Registration, 2017, cit.

⁵⁷ On this point, please refer to I. SHALEVICH, *Protection of trademarks and Geographical Indications*, in 6 *Buff. Intell. Prop. L.J.* 67, 2008/2009, cit.

⁵⁸ The collective organization usually advertises and promotes goods and services provided by its member under the mark. Nevertheless, as noted by some scholars "unlike certification mark owners, collective mark owners are not barred from using the trademark themselves". Please refer to, among others, to T. L. STATEN, *Geographical Indications Protection under the TRIPS Agreement: Uniformity Not Extension*, in 87 *J. Pat. & Trademark Off. Soc.* 221, 2005.

⁵⁹ In light of these shades, some authors have questioned over the need of two distinct categories. At this respect, please refer to F. BREITENFELD, *Collective marks: should they be abolished?*, in 47 *Trademark Rep.* 1, 1957.

⁶⁰ At this respect, please refer to T. L. STATEN, *Geographical Indications Protection under the TRIPS Agreement: Uniformity Not Extension*, in 87 *J. Pat. & Trademark Off. Soc'y* 221, 2005, cit. and J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 19 – Federal Registration, 2017, cit.

Although this is a chance, in practice, there are actually few number of collective marks connected to geography. Significant examples are “Florida Orange Growers – Mark of Purity”⁶¹ and “Frankfurter Apfelwein” for apple wine from the city of Frankfurt in Germany⁶².

So far, the chapter focuses on the layers composing the framework of protection of geographical terms under US Law.

In order to understand deeply the system (and to be provided with the tools useful to carry out the comparison with the EU system and outline a balanced solution of the conflicts), it is important to analyze some other basic principles relating to the functioning of trademarks.

First of all, “genericness” is explained. As already mentioned, generic terms (i.e. non-business identifiers) can be neither registered nor recognized. The genericness of geographical names is one of the main arguments uphold by American firms during international negotiations. The analysis shows what are the requirements to be satisfied for a name to be deemed generic, pointing out that it is basically a matter of case-by-case test. The practical nature of the test, based on evidence, is important since it can be used as a bridge towards the acceptance of a uniform system of protection of geographical signs. On one side, since the test is carried out in a precise moment, it cannot be excluded that EU geographic terms usually deemed generic from the US perspective can turn into distinctive, in light of new and growing sophistication of consumers. And so, even in the absence of a mutual system of recognition of terms, EU geographic terms may indeed deserve protection.

On the other side, a uniform system of protection can be valuable for the future, in order to set up a certain background and avoid dilution of “new generation” geographic names.

Then, the analysis moves forwards and describes the main features of the “fair use” defense, which grants to all the producers coming from the same place the right to use the geographical names to the extent that the use is merely descriptive and in good faith. Considering that, in practice, geographical names inherently include specific qualities of the products, it is interesting to assess whether the “fair use” defense can be extended also to these cases.

⁶¹ US Reg. 73323851.

⁶² US Reg. 1097779.

Bearing this factual background in mind, the section deals mainly with the evaluation of the likelihood of confusion of consumers as discerning item.

In fact, with the purpose of enhancing an extended level of protection, it is worth noticing that, in the US territory, it is currently not easy to use protected geographical terms, not even on the ground of a “fair use” defense.

The analysis closes by reflecting on the actions against false labeling and advertising under the Lanham Act and made available to all market stakeholders, regardless whether a mark exists or not. This section is particularly meaningful since it aims at demonstrating that – to date – the US system of protection of geographical names is much more complete than expected and misuse of geographical names (also the European non-generic ones) can already find relief, at least in damage reimbursement terms. Furthermore, the description of the actions against unfair competition practices is the basis to understand how the specific measures against misbranding and misadvertising of food products can be privately enforced and not only on a public level.

2.3. Genericness applied to geographical terms

It should be now clear that generic names, of any kind, including geographic ones, cannot be protected under Trademark Law, either statutory or common law.

This is the case when geographic terms have been so widely used that they do no longer identify a specific origin (including, if applicable, the qualities and properties connected). Instead, they have become the common name of a category of products, regardless of the geographic provenance.

Examples of geographic names generally used as generic terms are “French” for fried potatoes, “Peking” for ducks, “Brussels” for sprouts, “Swedish” for meat balls and many others⁶³.

The point of talking about genericness at our purposes is that, under US law, it is not an absolute principle, but rather a matter of facts as long stated by case law. The evaluation whether a geographic term is generic or not shall be the result of a case-by-case test. A test which examines the material understanding of the name by the

⁶³ For a list of examples, please refer to J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 14 – Geographic term Marks, 2017, cit.

relevant public⁶⁴.

To summarize, the generic character of a name is not an easy statement. It shall be verified on a case-by-case basis, taking into account the specific “time and space” circumstances. Such a test can be of essence when it comes to recognition of geographical terms, especially European or otherwise foreign names. The test shall examine the material perception of consumers, under precise circumstances. As a consequence, the result is likely to depend on when and where the analysis is carried out. Therefore, it cannot be excluded that the growing awareness, interest and sophistication of the average US consumer towards quality, local and foreign products (as shown herein) can affect also the outcome of the test.

In light of the principles described and the arguments expressed so far, in the field of geographical terms, the admissibility of protection is a matter of careful analysis and, most of all, of combination of different items. It is the result of the balance between the need, on one side, to protect the value and goodwill related to geographical branding and, on the other, to let consumers know where the products come from (and which qualities present) in a fair and competitive market.

In such a scenario, the solution deemed most feasible is that of protecting those geographical names that are either distinctive or expression of certified standards. However, without prejudice to this kind of protection, the Lanham Act includes a sort of “safe harbor” for the free and extensive use of geographical terms by competitors. This is the case of the “fair use” defense.

A brief analysis of this doctrine follows. As a disclaimer, this thesis does not intend to

⁶⁴ On the “genericness” test, please take into the account the following judgment, usually deemed the leading case on the topic.

272 F. 505, District Court, S. D. New York, Bayer Co. Inc. v. United Drug Co., 1921. It is a suit for the alleged infringement by the defendant of the plaintiff’s common law mark “Aspirin” for the sale of “acetyl salicylic acid” drugs. The Court addresses the issue of whether the term “Aspirin” fell into the public domain and became the generic name of a drug, therefore a merely descriptive name. It holds that the term “Aspirin” is indeed generic. Despite the ruling, what is at stake here is that the Court outlines the guidelines to follow in assessing whether a name is generic or not.

In particular, the test shall be based on the inquiry about what buyers understand by the contended word. In practice, it shall be examined what the relevant public thinks the word connotes: if it just a generic name of a kind of product or other source of that product.

The ruling of this case has been so massive that the principle has been codified in the Lanham Act. Please refer to § 14 (15 U.S.C. § 1064), expressly stating that “*the primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used*”.

look deeply at the various debates on the “fair use” defense, currently on going among US scholars. It takes into account the “fair use” defense doctrine only to the extent that it can interact with the protection of geographical names. In other words, it points out that “fair use” shall be limited by the risk of consumers’ confusion. It is possible to imagine that, as long as EU geographic names (even in translation) are not generic in the public perception, the use of analogous or similar name may not fall under the “fair use” defense, if the likelihood of confusion is material. And this represents another point of contact between EU and US that can drive to a possible uniformity of regulation.

2.4. “Fair use” defense

Generally speaking, exclusively rights granted to trademarks’ owners can be subject to the “fair use” of the terms by competitors. The scope of trademark protection is not unlimited. The owners cannot monopolize words or phrases in the event competitors rely on the same or similar terms to “fairly” designate their products⁶⁵.

In the application of this principle to geographic names, doubts may arise when geographical names describe not only the provenance, but rather some features of the products themselves⁶⁶ and are used by competitors in light of this inherent “descriptive” feature.

Especially with reference to these cases (even if not limited to), it is necessary to establish how much of the geographic name can be left to competitors’ free use. Boundaries shall be defined in order to balance the interests of consumers of

⁶⁵ An omni comprehensive definition of “fair use” under Trademark Law has been drafted by some relevant case law.

For instance, please consider **617 F2nd 1178, US Court of Appeals – Fifth Circuit, Soweco Inc. v. Shell Oil Company Co., 1980**. The Court has to define whether the term “Larvacide” has been used by the defendant as a trademark or, instead, fallen under the umbrella of “fair use” defense as a name to describe the nature of products. The Court affirms that the use of the name “Larvacide” by the defendant has accurately conveyed essence of its product and so constituted a fair use.

To reach this conclusion, the Court expressly states that “fair use” defense is available whenever a name is used fairly and in good faith to the exclusive extent of describing goods or services or their origin. Accordingly, such defense prevents trademarks’ owners to appropriate fully of a descriptive term, not allowing others to fairly describe their goods.

⁶⁶ As noted by some scholars, besides to regional certification marks, it is not unusual that geographic names become brands, meaning signs that display a particular provenance and forms a precise impression in the consumers’ minds. On the content of “brands”, please refer to, among others, R. CLIFTON, *Brands and branding*, 2003.

knowing what they are buying (and eventually a clear idea may come from a geographical descriptor) and of producers of safeguarding their identification.

To this extent, guidelines have been provided by Supreme Court case law⁶⁷. In particular, the Court acknowledges that the “fair use” of a name is compatible with a certain level of consumers’ confusion (and the defendant is not required to prove the lack of likelihood of confusion). Nevertheless, this does not mean – the Court specified – that the likelihood of confusion is irrelevant in determining whether “fair use” exists in the first place. It shall result from the circumstances. To this extent, important factors to take into account are the strength of the mark, the parties market position or the relevant commercial justifications.

To summarize, any time a defense of “fair use” is upheld, in order to ascertain whether the challenged use of the mark is “fair”, it is necessary to evaluate the bigger picture. All the circumstances of the case shall be examined, and evidences of confusion balanced with other factors. At the end of the day, the side that, from the overall weighing of the element, results strongest shall prevail⁶⁸.

The “fair use” defense principle – and the relevant test based on likelihood of confusion – is thus of essence to the extent of this analysis. It shows that the current

⁶⁷ **125 S. Ct. 542, US Supreme Court, KP Permanent Make-up Inc. v. Lasting Impression Inc., 2004.** The dispute arises because both parties use the term “micro color” in marketing permanent cosmetic makeup. Lasting Impression is the owner of a registered trademark including the terms “micro color” and brings an infringement suit against KP Permanent for using the same expression. KP Permanent asserts a “fair use” defense for using the terms in good faith and exclusively to describe the qualities of its products.

The Ninth Circuit firstly affirms that an alleged infringer cannot rely on a fair use defense if the use causes confusion between the marks. The Supreme Court adopts another perspective believing that a certain level of confusion is acceptable under a fair use defense.

⁶⁸ Some scholars have commented this test and explained that references to “some degree” of confusion mean that a likelihood of confusion does not necessarily lead to a “yes-no” determination of whether fair use exists or not. The evidence is a matter of check and balance.

At this respect, please refer to J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 11 – Distinctiveness of Marks, 2017, cit.

For sake of completeness, it can be underlined that such doctrine has been criticized by various scholars, claiming that the major issue is the lack of clarity in the application, detrimental for both the public and the market.

Some suggested that courts should define better the application limits in a way so that both producers and competitors can understand them. For instance, they could elaborate on the precise amount of confusion that would overcome a fair use defense. At this respect, please refer to J. C. DANIELS, *The branding of America: the rise of geographic trademarks and the need for a strong fair use defense*, in 94 Iowa L. Rev. 1703, 2009.

Others proposed to avoid time consuming evaluations and, rather, immunize particular categories of expressive uses, thereby reducing uncertainty and allowing for quick application. At this respect, please refer to W. MCGEVERAN, *Rethinking trademark fair use*, in 94 Iowa L. Rev. 49, 2008.

US system, if supported by material evidence, is willing to protect geographic names against “evocative” use of analogous or similar terms by competitors. And that can be available also with regard to EU non-generic terms.

3. US STATES’ INITIATIVES

Before moving forward with the analysis, it seems interesting to close the section regarding the protected geographical trademarks under US law by listing some example of US publicity owned certification marks. Some of them have already been mentioned. Still, this list adds another strategic piece to purpose of enhancing a mutual recognition of geographical sings. In fact, it demonstrates that the US culture in the food sector is going beyond the relatively few foods bearing regional associations. Rather, it is filled with a growing consideration with respect to geographical terms, considering that, in recent years, the number of American food and drink being uniquely American has increased significantly. It is no longer uncommon the idea that protecting geographical names and the connected qualities could actually protect savvy consumers, generations of investment and reputation of the producers, together with promoting progress and encouraging experiment and improvement in the products⁶⁹ and, not least, increasing sales, both domestic and abroad⁷⁰.

Moreover, the circumstance that most of these terms are protected by regional certification marks, managed by public authorities, reinforces the existence of a point of contact with the EU system, since it represents a kind of contamination of public within a mainly private based approach.

Among these initiatives, it is worth recalling “Idaho”⁷¹ for potatoes grown in Idaho and compliant with other specific requirement; “Vidalia”⁷² for onions from a specific product region in Georgia; “Seal of Quality Vermont”⁷³ for milk, dairy products,

⁶⁹ At this respect, please refer to J. BONAR-BRIDGES, *The proof is on the label? Protecting Kentucky Bourbon in the global era*, in 8 Ky. J. Equine, Agri. & Nat. Resources L. 491, 2015-2016.

⁷⁰ At this respect, please refer to M. RUBINO, E. M. WILIAMS, *Food, geography and the law*, in 54 La. B. J. 12, 2006.

⁷¹ US Reg. 2914308, filed in 2004 by the State of Idaho, Potato Commission State Agency.

⁷² US Reg. 1709019, filed in 1990 by the Georgia Department of Agriculture and certifying yellow granex type of onion grown by authorized growers within the Vidalia region in Georgia as defined in the Georgia Vidalia Act of 1986.

⁷³ US Ser. 73565826, filed in 1987 by Vermont Department of Agriculture.

apples, honey, potatoes and other agricultural products; “Texas Department of Agriculture Organically Produced”⁷⁴ for food or fiber products grown organically within the territory of Texas; “Certified Authentic Louisiana Wild Seafood”⁷⁵ for seafood landed, processed and packaged in the State of Louisiana; all types of coffee (i.e. “Kona”, “Oahu”, “Molokai”, “Maui”, “Kauai” and “Hawaii”) grown in the Hawaii Islands.

4. US FEDERAL LAW ON FALSE AND MISLEADING PRACTICES AND THE IMPACT ON GEOGRAPHICAL NAMES

So far, the chapter analyzed when and how geographical names are recognized under the US system, describing individual geographic trademarks and certification and collective marks. It also added, to such “institutional” overview, some practical reflections over basic doctrines of trademark law, highlighting possible points of contact with the EU regulation, valuable in the negotiations regarding the enhancement of a multilateral system of protection of geographical terms. In order to strengthen the feasibility of a new extended international scenario, significant US States’ “personal” initiative of regional marks for food products have been recalled, with the aim of showing a growing interest and a slight change of perspectives.

In light of all the above, in the author’s opinion, a significant contribute to the present dissertation is given by referring to both the right of private actions against unfair competition under the Lanham Act and the Federal Laws governing certain issues related to food marketing, such as the bans of misbranding and misadvertising set forth by, respectively, the Food, Drug and Cosmetic Act and the Federal Trade Commission Act.

The section first highlights the main features of each statutory provision, pointing out the content of the various regulations and the distinct areas of competence (i.e. private enforcement under the Lanham Act and public monitoring under the Federal regulations on food marketing). Nevertheless, following some recent case law in the *POM Wonderful v. Coca-Cola*, an interaction between the two fields cannot be excluded. In particular, this ruling expressly allows for the enforcement of Federal provisions preventing misbranding through private actions under the Lanham Act, in

⁷⁴ US Ser. 76092644, filed in 2000 by Texas Department of Agriculture.

⁷⁵ US Ser. 85516899, filed in 2012 by Louisiana Department of Wildlife and Fisheries.

light of the complementary nature of the Federal regulations. The effect of this judgment is to make easier for competitors to file food-misleading claims against those businesses, which cause in any way harm to the food producer's brand and reputation.

Such new generation rights may be of vital importance in the debate relating to extending the protection of geographical indications. If the risk of litigation increases, the US side would be more likely to reconcile its positions towards the EU geographical names.

A brief explanation of all the mentioned remedies (i.e. private, public and the interaction between the two) follows.

4.1. Unfair competition under Section §43(a) of the Lanham Act

Section §43(a) of the Lanham Act is intended to protect enterprises engaged in commerce against deceptive and misleading use of marks, which represents a business tort likely to determine unfair competition. In general terms, "unfair competition" is a broad definition, including any kind of business conduct, which is contrary to honest practice in industrial or commercial matters⁷⁶.

In particular, Section §43(a)⁷⁷ allows claims based on either infringement of a name or false statements.

With regard to the infringement, cause of action under the Lanham Act is granted to

⁷⁶ A number of rulings have stated on unfair practices under the Lanham Act, setting forth the main features of these banned practices. At this respect, it is generally considered "unfair competition" any form of commercial immorality, aimed at taking the skill, expenditures and labors of a competitor and misappropriating of its commercial advantage (ref. **683 F.2d 704, US Court of Appeals, Second Circuit, Standard & Poor's Corporation Inc. v. Commodity Exchange Inc., 1982**).

⁷⁷ Literally, according to Lanham Act, Section §43(a), "*any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which – (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act*".

For a general comment on this Federal provision, please refer to J. T. McCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 27 – False Advertising, 2017, cit.; AMERICAN BAR ASSOCIATION, *Business torts and unfair competition handbook*, 2014.

both registered and unregistered marks, as long as they are distinctive⁷⁸ and the challenged use is likely to cause confusion in the public⁷⁹.

Following the second prong of Section §43(a), business operators can contrast any false or misleading statement made by competitors in the forms of, alternatively, literally false claims, or literally true, but ambiguous claims which implicitly convey a false impression or are otherwise confusing⁸⁰.

In conclusion, it is worth listing some practical hints related to the functioning of this provision. Firstly, as mentioned, this action is available to both registered and unregistered marks. Then, in case of successful suit, remedies may include injunctions, destruction orders, recovery of defendant's profits and reimbursement of damages suffered⁸¹.

In light of all the above, Lanham Act, Section §43(a) is of interest since it goes beyond the ordinary trademark protection, providing businesses with additional remedies against broad unfair practices.

Such right can play a significant role also in the panorama of trans-Atlantic protection of geographical terms. It adds a layer to the current US system, highlighting a further point of contact with the EU system or, at least, being an incentive to the implementation of an extensive level of protection. Indeed, regardless of the registration of a EU geographical term as a mark, as long as it is distinctive (and the evaluation over distinctiveness lies on specific time and space circumstances, that can change with the development of relevant public), EU producers can already find relief against evocative practices or misappropriation by US businesses.

⁷⁸ Please refer to *supra* Section 2 – The protection of geographical names under the Lanham Act. The present chapter has deeply analyzed the requirements under which names and signs (of geographical nature in particular) can be protected as trademarks.

⁷⁹ Please refer to *supra* paragraph 2.4 – “Fair use” defense. As mentioned, likelihood of confusion shall be evaluated on the basis of various factors, ranging from the so called “market factors” (i.e. degree of similarity between the marks, market positions of the parties, characteristics of the public), defendant's intent and evidence of actual confusion.

⁸⁰ For sake of completeness it is worth recalling that when the advertisement is literally false, violations may be established without evidence of consumers' deception. On the contrary, should the challenged practice be misleading, the misrepresentation shall be both deceptive and material, meaning likely to influence purchasing decisions. At this respect, please refer to AMERICAN BAR ASSOCIATION, *Business torts and unfair competition handbook*, 2014, cit.

⁸¹ On this point, please refer to AMERICAN BAR ASSOCIATION, *Business torts and unfair competition handbook*, 2014, cit. In addition, with regard to proof of damages, in order to recover them, the plaintiff shall demonstrate injury causally linked to the alleged violation and actual damages.

If general remedies against unfair practices are granted under the Federal Trademark Law, when it comes to food products, false and misleading practices are expressly regulated.

Considering that consumers find themselves in a complicate world of food marketing, great attention has been given – at the Federal level – to labeling, which represents the main tool to convey information about the product itself and facilitate consumers' choices⁸². In particular, the Federal Regulatory system sets forth both affirmative standards of information to be displayed on the label and prohibitive requirements, banning false, deceptive and misleading labeling and advertising⁸³.

Under the US Food Law system these tasks are accomplished by various Federal Agencies. For what matters at out purposes, the analysis focuses only on misbranding provisions under Section 403 of the Food, Drug, and Cosmetics Act (hereinafter, "FDCA")⁸⁴ managed by the FDA⁸⁵ and misadvertising bans under Sections 5 and 12 of the Federal Trade Commission Act (hereinafter, "FTCA")⁸⁶, managed by the FTC⁸⁷.

4.2. Misbranding under Section 403 of FDCA

In general terms, FDCA prohibits a series of practices that can cause "misbranding" of food products and entrusts the FDA to deal with the matter⁸⁸. Therefore, the term

⁸² A deep analysis over the essence of food labeling would overcome the scope of the section. For any further argument on the matter, please refer to E. GOLAN, *Economics of Food Labeling*, 2001.

⁸³ As clarified by the US Food Law academia, the affirmative requirements serve the purpose of providing consumer with adequate information in order to make informed choices about the food they buy. While, the ban of unfair practices aims at avoiding that people draw false conclusions on products. On the basic structure of food labeling, please refer, among others to, M. T. ROBERTS, *Food Law in the United States*, 2016; N. D. FORTIN, *Food Regulation: Law, Science, Policy and Practice*, 2017.

⁸⁴ For sake of completeness, please note that the laws of the United States are organized by subject into the United States Code. The FDCA and subsequent amending statutes are codified into Title 21, Chapter 9 of the United States Code.

⁸⁵ For a general overview on FDA please refer to *supra* footnote no. 12.

⁸⁶ The FTCA and subsequent amending statutes are codified into Title 15, Chapter 2.

⁸⁷ For a general overview on FTC please refer to *supra* footnote n. 13.

⁸⁸ In order to give the reader a complete framework of the FDA's powers in managing misbranding actions, it can be recalled – in general terms – that FDA's practical functioning is pretty structured. A full analysis of FDA's procedures overcomes the scope of the analysis. Nevertheless, they can be summarized as follows. Misbranding charges may arise from, alternatively, inspections or complaints by competing firms. At this point, FDA has the discretion not to take action. Otherwise, it can seizure action in Court, refer to the FTC for action, if applicable, or leave the issue up to regulatory level. For a precise analysis of FDA's functioning in case of misbranding, please refer to K. A. VAN TASSEL, *Chapter*

“misbranding” is a legal term of art that encompasses a series of independent statutory prohibitions, all of them listed in Section 403 of the FDCA.

Among other provisions, Section 403 of FDCA states that a food product shall be deemed misbranded if its labeling is “*false or misleading in any particular*”, if the product is sold “*under the name of another food product*” or, even, if it is “*an imitation of another food*” and the imitation is not clearly disclosed.

It means that FDA has the authority to contrast various form of unfair trade practices, resulting in false or misleading information for consumers. At this respect, a label is false if it is “untruthful”. A label may be misleading even if the representations are technically true, but otherwise confusing for the public. In other words, the analysis of whether a label is misleading or not relates to consumers’ expectations⁸⁹. The reasonable consumer should be preferred as a benchmark⁹⁰.

If the above described is the applicable regulation in case of misleading practices in the labeling, it cannot be ignored that, in the current global scenario, food are usually marketed through commercials, brochures, internet and other forms of advertising. Therefore, misleading practices can occur in the advertising of food. When this is the

10. *Food Regulation: Marketing, Nutrition, and Dietary Supplements*, in Food and Drug Administration, Fourth Edition, November 2017.

⁸⁹ On the interpretation of the term “misleading”, there is mainly uniform US case law. The idea is that that, regardless of the truthfulness and nature of the claim, a label may be misleading when confuses consumers’ perception.

At this respect, it may be interesting to consider the recent ruling **849 F.3d 849, United States Court of Appeals, Ninth Circuit, Compassion Over Killing v. US Food and Drug Administration, 2017**. The case is broad and involves all the US competent agencies in the food sector. The plaintiff alleges that the agencies acted arbitrarily and capriciously in dismissing its petition requesting to promulgate regulations that would require all egg cartons to identify the conditions in which the egg-laying hens were kept during production. To what matters at our extent, while dealing with the FDA’s tasks and regulations, the Court reaffirms that “*food labeling may be misleading through affirmative representations or through an omission of a material fact*”.

⁹⁰ At this respect, please refer to FDA, *Guidance for industry: qualified health claims in the labeling of conventional foods and dietary supplements*, 2002.

For sake of completeness, it can be recalled that before the adoption of the guidelines, the consumers’ standard has been changing over time. Two different standards have been followed: that of “ignorant, unthinking and credulous consumer” and that of “reasonable” consumer. As noted by some scholars, in picking the “reasonable” consumer as a benchmark, the FDA aligns with the standards adopted by FTC in evaluating misadvertising (as described further herein). At this respect, please refer to M. T. ROBERTS, *Food Law in the United States*, 2016, cit.

case, the issue is no longer managed by the FDA, but falls under the scope of FTC⁹¹. Sections 5 and 12 of FTCA, in fact, broadly prohibit unfair or deceptive practices and precisely misadvertising of foods, drugs or cosmetics.

4.3. Misadvertising under Sections 5 and 12 of FTCA

Generally speaking, FTC is entrusted of contrasting any unfair or deceptive advertising act or practice affecting commerce. In this context, FTC has issued a policy statement⁹² articulating the basic elements of the deceptive analysis to be considered when assessing a false or misleading advertising case.

In setting up a comprehensive test for deception, FTC first acknowledges that deception – similarly to what has been underlined in terms of misleading – can take a several numbers of forms, ranging from false intentional claims to true advertisers creating a false or misleading impression. FTC, therefore, elaborates a principle that can be applied to the greatest extent possible in order to contrast the largest number of unfair practices.

According to the mentioned policy, FTC shall take action⁹³ against “*any misrepresentation, omission or other practice that is likely to mislead the consumer acting reasonably in the circumstances, to the consumer’s detriment*”.

In other words, deception occurs in case of:

- i) misrepresentation, omission or practice likely to mislead the consumer⁹⁴;

⁹¹ For sake of clarity, it shall be noted that, in practice, it is not always easy to distinguish clearly what constitutes labels and what is advertising. On the blurring line between FDA and FTC respective action fields, please refer to N. D. FORTIN, *Food Regulation: Law, Science, Policy and Practice*, 2017, cit. Should, in general terms, labels be the package label and everything typed or printed therein and advertising any kind of television or newspaper communications, there may exist some grey zones between the two. In order to solve the issue of potential overlapping in actions, the two agencies adopted a memorandum to coordinate their joint jurisdiction. At this respect, please refer to MEMORANDUM OF UNDERSTANDING OF THE FEDERAL TRADE COMMISSION AND THE FOOD AND DRUG ADMINISTRATION, 1971.

⁹² Please refer to FTC DECEPTION POLICY STATEMENT, Appended to Cliffdale Associates, Inc., 103 F.T.C. 110, 174 (1984).

⁹³ In practical terms, the FTC is entrusted with a broad range of powers to contrast misadvertising. FTC may promulgate binding trade regulation rules. In addition, FTC can files suits to either seek injunction relief or remedy violations of any of the relevant laws. At this respect, please refer to J. T. MCCARTHY, *McCarthy on Trademarks and unfair competition*, Chapter 27 – False Advertising, 2017, cit.

⁹⁴ FTC takes into account any relevant practice in a broad manner, without distinction. It means that the entire advertisement, transaction or course of dealing shall be considered. At this respect, please

- ii) misleading is considered from the perspective of the reasonable consumer⁹⁵;
- iii) there is “materiality”, meaning that the consumers’ choices have been affected in a detrimental way⁹⁶.

To sum up all briefly described in the present sections, unfair competition is broadly contrasted under US Law, through both Federal agencies actions and private enforcement. In other words, businesses dealing with unfair practices – depending on the alleged violation – can decide to file a private suit or rely on FDA or FTC course of action in the enforcement of laws against misleading labeling or advertising.

And this context is of essence in the current US system, where food companies are more concerned of protecting their brands from unfair practices, considering that US consumers are more and more interest in the food they eat⁹⁷ and so willing to rely on the information provided on the labels. Should the enforcement by the Federal

refer to FTC DECEPTION POLICY STATEMENT, Appended to Cliffdale Associates, Inc., 103 F.T.C. 110, 174 (1984), cit.

The same broad view has been adopted also by US case law. The following case is particularly significant on the matter.

695 F.2d 681, United States Court of Appeals, Third Circuit, American Home Products Corporation v. Fair Trade Commission, 1982. The case arises from a petition seeking review of an FTC’ order which required that manufacturer to cease and desist various deceptive advertisements with reference to its drug products. To what matters at our purpose, the Court affirms that, in assessing tendency of advertising to deceive, it shall be judged the advertising as a whole, not emphasizing isolated words or phrases apart from their context. The desideratum is the impression created by the advertising, not its literal truth or falsity.

⁹⁵ With reference to the “reasonable” standard, FTC states that an interpretation is not a member of quantity, but of substance. Something may be reasonable even though it is not shared by a majority of consumers in the relevant class, or by particularly sophisticated consumers. A material practice that misleads a significant minority of reasonable consumers may still be deceptive. At this respect, please refer to FTC DECEPTION POLICY STATEMENT, Appended to Cliffdale Associates, Inc., 103 F.T.C. 110, 174 (1984), cit.

⁹⁶ In a nutshell, it is material any information which is important to consumers as to affect their choices. Or better, should a reasonable person regard an information as important in deciding how to act or one, then it is material, even if it does not necessarily affect the finances of a transaction. For such a precise definition of “materiality”, please refer to AMERICAN LAW INSTITUTE, *Restatement, Second, Torts* (full text 1956-2017), available at <https://home.heinonline.org/titles/American-Law-Institute-Library/Restatement-Second-Torts/>.

In any event, it shall be noted that the materiality test makes the burden of proof under FTC higher than under FDA’s provisions on misleading labeling. As explained in the previous paragraph, claims for misbranding under FDCA shall be grounded only on a finding of false or misleading labeling, regardless of the impact on the consumers’ behaviors. At this respect, please refer to N. D. Fortin, *Food Regulation: Law, Science, Policy and Practice*, 2017, cit.

⁹⁷ At this respect, please refer to *supra* footnote no. 9.

agencies be inadequate and slow, business usually try to find relief through litigation, claiming damages due to a misbranded or misleading label. To this extent, it is worth studying a recent ruling which opens the way for the intersection between two Federal Laws, allowing private action under the Lanham Act alleging unfair competition from false or misleading food label regulated by the FDCA. In fact it increases companies chance to obtain relief when injured by misleading claims of competitors.

4.4. The intersection between Lanham Act and FDCA. *POM Wonderful v. Coca-Cola*⁹⁸

This case represents a turning point in the US case law on misleading food labeling. The Supreme Court in fact reversed a number of lower courts rulings holding that Lanham Act §43(a) is not valid vehicle to indirectly enforce provisions of FDCA.

To get to this conclusion, the Supreme Court analyses deeply the backgrounds of the two Federal rules and affirms the possibility of interaction between the two.

On one side, the Lanham Act adopts a “private” approach and aims at regulating commerce by making actionable by competitors any false or misleading use of marks or trade names in the relevant market. The FDCA regime, on the other side, is based on a “public” perspective and designed primarily to protect health and safety of the public. When it comes to food labels, enforcement of the FDCA and the detailed prescriptions of its implementing regulations is largely committed to the FDA. The FDA, however, does not have the same perspective or expertise in assessing market dynamics that day-to-day competitors possess. Competitors who manufacture or distribute products have detailed knowledge regarding how consumers rely upon certain sales and marketing strategies. Their awareness of unfair competition practices may be far more immediate and accurate than that of agency rule makers and regulators. Lanham Act suits draw upon this market expertise by empowering

⁹⁸ **134 S.Ct. 2228, Supreme Court of the United States, POM Wonderful LLC v. the COCA-COLA Company, 2014.** As a factual background, a distributor of pomegranate-blueberry juice blend files a suit under Lanham Act, alleging deceptive labeling of the defendant’s product. The defendant in fact labels its beverages as “pomegranate blueberry” juice, when they contain only 0.3% pomegranate juice and 0.2% blueberry juice. According to the petitioner, such practice misleads consumers into believing that the product consists mainly of pomegranate and blueberry juice when in fact it is made predominantly with less expensive juices. Such practice confuses the public and causes damages in the petitioner’s sales.

private parties to sue competitors to protect their interests on a case-by-case basis. According to the Supreme Court's view, the two Federal regulations complement each other in major respects and none of them forbids or limits, in express terms, Lanham Act claims referred to labels regulated by FDCA.

As such, a holding that the FDCA precludes Lanham Act claims challenging food and beverage labels would not only ignore the distinct functional aspects of the FDCA and the Lanham Act but also would lead to a result that Congress likely did not intend.

Because the FDA acknowledges that it does not necessarily pursue enforcement measures regarding all objectionable labels, if Lanham Act claims were to be precluded then commercial interests – and indirectly the public at large – could be left with less effective protection in the food and beverage labeling field than in many other, less regulated industries.

In light of all the above, it is clear that food companies may bring suit against their competitors under Lanham Act challenging labels deemed misleading pursuant to FDCA.

The impact of such a ruling is massive. It basically makes sure that commercial parties injured by misleading food labels are provided with an additional adequate remedy⁹⁹.

For what matters at our purposes, this case is significant because it completes the picture of geographical names drawn so far. It adds a layer to the US relevant system. In fact, it gives EU companies holding a geographical indication the chance to seek

⁹⁹ This ruling has been object of deep comment and analysis by scholars. They all recognized the general impact, but made some assumptions of the envisaged developments, which are worth being mentioned.

Some folks underline that the case has made easy for competitors in food commerce to expand brand recognition and market position through misleading labeling claims. As such, litigation in the food sector would become a growth industry for lawyers. At this respect, please refer to P. D. SWANSON, *The challenges of regulating food safety and litigating food mislabeling and false advertising claims*, in 2014 WL 6629544.

Others highlight that the ruling provides competitors with adequate remedy against unfair competition. In addition, litigation can improve label clarity and accuracy, since Lanham Act suit would be able to fill the regulatory gaps left by inadequate/incomplete Federal Regulation. At this respect, please refer to J. THURSWELL RADIS, *The Lanham Act's Wonderful complement to the FDCA: POM Wonderful v. Coca-Cola enhances protection against misleading labeling through integrated regulation*, in 47 Loy. U. Chi. L.J., 369, 2015.

Others point out the problematic issues of litigation as remedy. In fact, litigation is generally time consuming and costly and sometimes produces different results for the same issue. In light of this, they suggest that current litigation efforts shall be combined with the introduction of new and precise rules for food labeling. At this respect, please refer to J. L. POMERANZ, *Litigation to address misleading food label claims and the role of the State Attorneys General*, in 26 Regent U. L. Rev. 421, 2014.

protection against any free ride attempt on their name by US producers, claiming of suffering damages for the confusion created by the use of analogous, similar or translated names.

Of course, being a litigation matter, the outcome of eventual suits filed by EU producers is not fully predictable. Still, this is a chance already available within the US system.

And if this is true, the outcome of the *POM Wonderful v. Coca-Cola* case can become – combined with other factors, such as growing interests of consumers in quality of food and transparency, new investment in local food carried out by US enterprises, new food culture – an effective/persuasive tool for the US stakeholders to proceed with the negotiations and agree on an extensive level of protection of geographical indications.

5. CONCLUSIVE REMARKS

The present chapter has precisely described the relevant laws and regulations protecting Geographical Indications under the US Law. As explained, such analysis has been carried out only in light of the final goal, which is finding a balance between EU and US in the field of geographical indications, able to support the enhancement of international system of mutual recognition and extensive protection.

The outcome is for sure the recognition that the US system is far more composite and complicated than the European one, being made of various layers.

Still, apart from first sights discrepancies, if put under the right spotlight, the overall scenario can be encouraging for the EU producers and stakeholders. There is a material chance to go beyond the traditional opposition and disagreement of the two systems.

First of all, the negotiating environment might be more relaxed. The US system is currently facing a development in the food culture. The general social perception of geographical names has been subject of continuous change and improvement, being US consumers more sensitive to food quality issues, more sophisticated and having the States themselves invested in the protection of unique American food products.

In addition, it is possible to infer that legal background is not as distant from the EU model as usually claimed. The US system in fact is already adequate to grant an

extensive protection of geographical names and offers some incentives that can build up a bridge between the two sides of the Atlantic Ocean. Therefore, it is not excluded that they can agree on international extensive mutual recognition of geographic names, with no need for the US to amend their system and, as such, avoiding costs of implementation.

These arguments are grounded on various reasons, most of them already highlighted throughout the dissertation.

In general terms, the US system adopts a “private” approach, based on Lanham Act, where geographical indications are protected by mainly two categories of trademarks, certification and collective marks. These can be recognized to the extent that they, respectively, certify certain qualities (including the geographic provenance) or are used by members of a specific group, who meet minimum requirements for being part of the relevant association.

The analysis has shown that, regardless their “formal” private nature, in practice, differences with EU geographical indications blurry. With regard, in particular, to certification marks, they are generally owned and managed by public entities, they shall be mandatorily licensed to all who meet the standard and, in case a transfer occurs, the transfer shall not affect the basic requirements which shall not vary. Their recognition is open also to foreign products. All of this means that EU organizations entrusted of taking care of protecting the market value of their EU products can already rely on these kinds of mark within the US territory.

Moreover, what is of greatest interest – especially for EU producers seeking to sell their products in the US market – is that geographic marks do not need to be registered: they can be recognized simply in force of continuous use and exploitation by commercial entities. The analysis has also pointed out that recognition should be easy considering that the only barrier might be genericness of the name. US parties, in fact, usually uphold that EU geographical terms (and/or their translation) are generic descriptive term of a kind of product for US consumers. Genericness thought shall be evaluated in a precise time and space and in light of the public perception. Therefore, it cannot be excluded that EU geographic terms usually deemed generic from the US perspective can turn into distinctive, in light of new and growing sophistication of consumers.

Once a geographic name is recognized (even if not registered), the free ride of the

name (or of similar name) by competitors is prevented by measures against unfair competition under the Lanham Act. Measures that are currently empowered also by the new possibility to enforce Federal rules specifically preventing mislabeling of food products (generally managed solely by public Authorities).

The *POM Wonderful v. Coca-Cola* case in fact has opened the way for the intersection between two Federal Laws, allowing private action under the Lanham Act alleging unfair competition from false or misleading food label regulated by the FDCA, increasing companies chance to obtain relief when injured by misleading claims of competitors.

Of course, being a litigation matter, the outcome of eventual suits is not fully predictable. Still, it represents a chance already available within the US system: a chance that can be exploited as a kind of protection against “evocative” use (similar to what expressly provided under EU Regulation). To this extent, it can also be recalled that, once the geographical name is recognized, the “fair use” defense is not unlimited. It cannot be granted when the likelihood of consumers’ confusion is material.

All these elements combined together demonstrate that there may be room for real discussion between EU and US about the enhancement of a system of mutual recognition of geographical indications.

The following (and last) chapter describes in detail such possibility. As mentioned, the most feasible solution seems to be the extension of the provisions of Article 23 of the TRIPS (currently limited to wine) to all food products.

At this respect, the chapter first recalls that an international system of protection is preferable over a bilateral one, because it allows to have a uniform background that can be enforced by all signatories. In other words, it is not limited to EU and US but can be extended to all the interested parties, having individual interests involved.

Then, it described the existing proposals advanced by the parties in order to deeply understand the main discrepancies so far arisen between EU and US negotiators.

On the basis of the tools provided with reference to the US system, it is possible to demonstrate that the negotiating strong conflicts are mainly political and/or economical.

Instead, a uniform and extended system is feasible because the parties share the same values, may reciprocally benefit and do not have to afford costs of modifications. Each of these arguments is further discussed. At this respect, the last chapter highlights the

new food movements continuously growing and spreading within the US borders and the material economic incentives for US producers.

In any event, in the author's opinion, EU should acknowledge that the extension of protection is a long-term analysis that would apply to the future, by granting fully protection to more recent geographical names or the less widespread. With reference to most debated and widespread ones, it would in any case be likely that the EU adopts a certain level of flexibility in the negotiations. Considering the widespread circulation of most of the products included in the famous "clawback" list, the EU maybe should consider the chance to authorize uses of these names that clearly show the origin and the differences between the products, such as "imitation", "product of California" etc.

CHAPTER IV:
**THE BRAND NEW (PROPOSED) PROTECTION OF GEOGRAPHICAL INDICATIONS IN THE GLOBAL
MARKET UNDER THE TRIPS AGREEMENT: DREAM OR REALITY?**

SUMMARY: 1. Introduction

PART I – 1. *Why are regional agreements currently deemed to be more effective than multilateral ones? Is it possible to overcome this common sense opinion and turn again to multilateral partnership?* – 2. *Once clarified the preferred role of multilateral agreements when dealing with matters of global interest, such as the geographical indications, why are multilateral negotiations on the extension of protection at a standstill point? Would it be possible to move forward and take the topic back to the international agenda?* – 3. *The Doha Development Agenda with regard to geographical indications* – 3.1. *Multilateral register of protected geographical indications for wine and spirits* – 3.1.1. *The joint proposal* – 3.1.2. *The Hong Kong, China proposal* – 3.1.3. *The EU proposal* – 3.2. *Extension of higher levels of protection (i.e. Article 23 of the TRIPs) to all food products.*

PART II – 1. *The brand new (proposed) protection of geographical indications in the global market under the TRIPs agreement* – 1.1. *Consumers' interest* – 1.2. *The economic value of geographical indications* – 1.3. *The adequateness of the US legal system in the system of geographical indications.*

2. *Conclusive remarks.*

1. INTRODUCTION

The appreciation of the previous three chapters led the reader to the closing credits of this dissertation. Indeed, the other chapters aimed at shaping the puzzle of the overall meaning of geographical indications, by clarifying the legal tools (rules and regulations) currently in force and applicable to geographical signs at all levels (i.e. international and national, focusing, in the latter case, on the EU and US systems).

When describing each model, the dissertation carefully highlights the underlying values and objectives of each single system.

There is no point in repeating what has already been analyzed, but for mere sake of clarity, it is worth recalling that, should the international forum be the framework, various attempts of harmonization were undertaken. The latest outcome, at least as of today, is the 1994 draft of the TRIPs agreement. As already mentioned, the TRIPs leaves it to the signatories to determine the legal form for the protection of

geographical names. In practice, it results in the use of various and different means, including laws on business practices (e.g. on unfair competition and consumer protection), trademark law (including through certification or collective marks), in addition to *sui generis* systems specifically set up.

Such a heterogeneous picture is possible in light of the literal provisions of TRIPs. At first, Article 22 of TRIPs defines a standard level of protection for all products; as integration, Article 23 provides for an enhanced level of protection for geographical indications for wines and spirits; at last, Article 24 provides for the exceptions to the protection, for instance, in relation to terms that have become generic and priority trademark rights¹.

Given such minimum level of protection established internationally, the global “battle” over geographical indications rotates around two different approaches, which are well represented by EU, on one side, and US on the other, based, respectively, on the adoption of a *sui generis* system of protection and the plain inclusion of geographical signs in trademark law. It is a crystal clear statement that, in the case of EU, geographical names do not belong to individual producers who are only allowed to use the denominations for their businesses as long as they comply with the intrinsic and distinctive qualities associated with the geographical names themselves. Geographical indications are widely perceived as an expression of the soil, the history and the culture of specific locations. The effect of such a system is that geographical indications are managed according to charter documents and cannot be sold to competitors neither moved elsewhere. In case any infringement/breach of the mentioned general principles occurs, it is up to the national governments (even though improperly, the owners – or better the guardians – of the indication) to take the legal initiative to defend the name of origin.

This approach shows a significant “public” background which seems to oppose to the very nature of business in other countries, such as the US, that consider brands and marks as intellectual property rights protected by trade names. By definition, trademarks are “private” tools, belonging to individuals or companies, which, naturally, can be bought, sold and licensed in the same way as any other business

¹ Among all the exceptions provided for by Article 24, in this introductory section, the author decided to pick only the two mentioned considering that they represent the greatest “legal” obstacles generally upheld by opponents to a multilateral and extensive system of protection of geographical indications.

asset. Any kind of violation, infringement or freeriding is to be handled by the natural or legal persons who own the asset².

The dissertation took its preliminary steps assuming that, at first sight, these two jurisdictions seem to be very distant one another.

If we want to use a metaphor the EU and US systems of protection of GIs can be deemed traditional rivals, playing a *clasico* match in a soccer field. In other words, we are so used to imagine the EU and the US in the field of food law in general and geographical signs in particular as opponents and we are not keen to even imagine any kind of constructing and/or effective dialogue.

Well – as already spotted throughout the dissertation – the good news is that there are ways (even though they might be long term ones) able to reconcile the diverging perspectives. I mean that, apart from the conflicting negotiating surface, the basic principles of protection of geographical indications (such as the economic benefits and the consumers requests and desiderata) are recognized and shared by both systems. Hence, it is not unreal to imagine – for the next future – a global bunch of rules entrusted to protect to the maximum extent possible geographical names in the international market.

The objective of this last chapter is to collect most of the hints already analyzed throughout the dissertation and put them together in an analytical manner. As such, the dissertation shows that distances between the EU and the US fronts are thinner than those we are used to, hence it is likely to promote a multilateral system of protection by extending of the scope of the geographical indications section under the TRIPs agreement.

The effect is that the dissertation proposes a solution where a globally agreed, efficient and accepted scheme of protection is ensured, in a way that cannot be objected to be acceptable for all parties, and thus sustainable.

² The specific and clear description provided herein with regard to the antagonism between EU and US in the protection of geographical indications is construed following some hints of F. PARESECOLI, *Geographical indications, intellectual property and the global market*, in *Geographical indications as cultural property*, Gottingen studies in cultural property, volume 10, 2017.

As already deeply highlighted in the previous chapters, these different attitudes towards to geographical signs reflect different roots. In comparison to the EU model, the US one represents a food system that experienced a much longer and more intense industrialization process compared to its European counterparts, allowing for many local traditions to disappear or become insignificant, also from an economic point of view. For further analysis of the divergences between Old and New World countries reflected in the protection provided to geographical indications, please refer to chapter 1 of this dissertation.

Under a methodological perspective the chapter is organized as follows.

The first part is “academic” and “institutional”. It is intended to describe the assumptions, which are the valid basis for all further discussions. In particular, given that the suggested system is a multilateral one while the current global framework is filled with regional/bilateral agreements and/or trade partnerships, it analyzes the relationship between multilateral and regional trade agreements. At this respect, this chapter answers to two basic bunch of questions:

Why are regional agreements currently deemed to be more effective than multilateral ones? Is it possible to overcome this common sense opinion and turn again to multilateral partnership? With regard to the first question, the issue here is that regional agreements are easy to negotiate considering the few interests involved and, as a consequence, can be more detailed and focus on the parties individual interests. In a nutshell, this is the key of their success. Nevertheless, there can be a shift towards the multilateral partnership. Indeed, that is the envisaged way ahead, especially with regard to topic such as the protection of geographical indications, which are of global interest and cannot be properly discussed bilaterally. As multilateral solution, the dissertation puts the TRIPs under the spotlight of the analysis, assuming that it is to be preferred over the WIPO related agreements. Without prejudice to the general benefits shared by all multilateral agreements and better detailed in the following paragraphs, the main reasons for such preference lays in the same arguments already highlighted in the first chapter of this dissertation. Compared to the WIPO related agreements, the TRIPs is executed by a significantly higher number of signatories’ parties and is provided with a structured system of dispute settlement.

Once clarified the preferred role of multilateral agreements when dealing with matters of global interest, such as the geographical indications, why are multilateral negotiations on the extension of protection at a standstill point? Would it be possible to move forward and take the topic back to the international agenda?

The answer should first take into account the contribution offered by regional trade agreements. Reference is made to the circumstance that countries engaging in regional commitments are usually willing to – sooner or later – extend to multilateral setting. Thereafter, it should evaluate the crucial role played by developing countries, which, despite the practical issues that may arise with regard to the protection of geographical indications (and better, even if briefly, described hereinafter), are

undeniably more and more interested in protecting their traditional productions, sharing the EU's view of *terroir* (connection between territory and qualities) and identifying in geographical signs the most suitable tool to reach the goal.

Once clarified all the above, the dissertation should explain what, in practical terms, the "extension" mentioned and promoted so far is. At this respect, it refers to the TRIPs developments, going through all the steps of the Doha Development Agenda with regard to geographical indications (in particular, the proposals related to the implementation of a multilateral register of protected geographical indications and the amendment of Article 23 of the TRIPs to make it applicable to all food products) and analyzing the relevant positions expressed.

The first part closes with the institutional definition of "extensive protection for geographical indications" and gives the floor to the argumentative part, where the author partially reworks the definition of "extensive protection" in a compromising perspective, as such proposing a path to define the international long term and unsolved debate over geographical names and overcome the stall essentially established between the EU and US fronts. In order to provide the reader with an idea of what the author means with "compromise", it may be interesting to reveal in advance her proposal. Actually, the author suggests to evaluate the possibility to provide some exceptions to the general extended level of protection. These exceptions basically consist in drafting a list of specific names (of course the list should be globally shared) that, on one side, cannot be deemed *tout court* generic, but, on the other side, are strategically important for some sectors, and thus can be used by interested parties in a descriptive way, provided that the place of real origin is clearly displayed and they are not misleading (by way of example, "*Parmesan kind – product of California*").

By reaching to this conclusion, the author provides some hints of reflections to three main points that can still be deemed the open ones, meaning the most debated.

Reference is made to:

- (i) a new food culture is growing in the US which thus means deeper attention to the quality of food, becoming integral part of desiderata list of the average consumers;

- (ii) the effective economic value of geographical indications cannot be underestimated and can be shared worldwide (it is not limited to EU territories). Indeed, also in light of the growing/developing new requests from consumers/significant slices of market, the chance for US producers to diversify their lines of production, invest in niche markets and promote their growing traditional products addressed also at exports in third countries;
- (iii) last but not least, further to the deep analysis carried out in chapter three of the dissertation, the author recalls the existence in the US system of a proper legal basis to grant adequate protection to geographical indications and prevent forces denying extensive protection.

The overall effect of the global enhancement of an extensive level of protection of geographical signs is likely to be the driving force the following goals/objectives.

First, a brand new system would ratify the current international framework: actually, it would expunge information asymmetries, letting every country and its relevant consumers to know exactly where the products come from (together with the relevant qualities and properties) and, as such, granting the producers that the product itself is recognized and associated with an added/premium value.

The proposed extension represents a strategic medium/long term policy. It is addressed at healing a current situation without imposing additional burdens to the *status quo* (from a political perspective, it would make easier for the traditional opposing countries to accept the extensive protection, if their legal systems are either willing to embrace the geographical names – like what usually happens in developing countries – or ready – like, as demonstrated, the US, regardless of the specific characteristics depending on the common law basis), but, at the same time, promoting future exportations, spread of quality products, preventing behaviors adapt at providing genericness/dilution of geographical names³.

³ For sake of clarity, at this stage of the dissertation, the notion of genericness with regard to geographical names is given for granted, since it has been deeply analyzed in the previous chapters and it is substantially a matter of fact and the evaluation whether a name is generic or not depends on time and space circumstances to be analyzed on a case by case basis.

PART I

1. WHY ARE REGIONAL AGREEMENTS CURRENTLY DEEMED TO BE MORE EFFECTIVE THAN MULTILATERAL ONES? IS IT POSSIBLE TO OVERCOME THIS COMMON SENSE OPINION AND TURN AGAIN TO MULTILATERAL PARTNERSHIP?

In pills, the answer is that regional agreements are usually more detailed and easy to negotiate and this is natural considering the few interests involved. Therefore, at the international level, state players have recently preferred to pursue their political and economic interests through bilateral or regional trade agreements rather than investing in multilateral negotiations. In this context, in the author's opinion, multilateral agreements should prevail over bilateral negotiations in order to frame a comprehensive and ambitious coverage of geographical indications values. As already mentioned, the scope of this analysis is limited to the WTO forum and does not include the WIPO related agreements.

In fact, it is quite natural to get to the conclusion that bilateral partnerships may not be the most suitable regulatory means when the interest at stake is the protection of geographical names. Generally speaking, nowadays, regardless of their link with the territory and area of origin, the value of geographical indications is not a matter of simple regional concern. On the contrary, they are of global interest and that is particularly true if considering, among others, the current trends and consumers preferences⁴.

Apart from that, the underlying *ratio* of the global value of geographical names is essentially that in today's increasingly competitive and transnational trading environment, products from all over the world are sold in domestic and foreign markets. It is the greatest interests of producers and sellers that products are distinguished from one another in order to provide consumers with information about their origin, quality and taste. As already analyzed throughout the dissertation, for the purpose of distinguishing products from each other, various ways and methods with legal implications have been developed.

⁴ At this respect, please refer to the following Part II, paragraph 1.1.

Historically, trademarks became the chief way for producers to individualize themselves, distinguish their products from those of others, and secure economic revenue from exclusivity. However, as competition grew increasingly fierce and international, protection for trademarks turned out not to be enough; goods needed to be further distinguishable.

This was where indications of geographical origin demonstrated their importance. Geographical indications are place names used to identify the origin and quality, reputation or other characteristics of products. In addition to communicate geographical origin, a geographical sign is also a legally protected instrument for creating value for the producers through the peculiarity of the good in question⁵.

Given all the above, the preliminary assumption is that the global relevance of geographical indications seems to be hardly disputable⁶.

Nevertheless such assumption seems to be ignored in favor of individual negotiations. The empirical records show a significant increase of regional trade agreements in the recent years: a trend that has increased rapidly and continues to do so⁷. The reasons are mainly individualistic and relating to personal economic and

⁵ For a further description of the global relevance of geographical indications please refer to, *inter alia*, J. FLODGREN, *Geographical Indications and Trademarks: Synergies and Conflicts in the International Market*, 2009, position paper included in the OriGIn publications, available at the following link: https://www.origin-gi.com/images/stories/PDFs/English/OriGIn_publications/News/johan_flodgren_essay.pdf.

⁶ At this respect, it is worth recalling that in the contemporary world there is a strict link (an indissoluble one) between local and global. Global cannot exist without local, since global is made of several local and *viceversa*. It means that local needs to find relief in global regulation in order to be preserved, especially in the cases of trade and exportations. Please refer to E.C. RAFFIOTTA, *La protezione multilivello delle tipicità agroalimentari tra diritto globale e legislazione nazionale*, in *Federalismi.it*, December 2016.

⁷ Professor Luigi Costato has recently taken a position on the topic of the dispute between regional and multilateral trade agreements, with, for what matters at our purposes, a special focus on geographical indications. The author expresses some general remarks over the faith of geographical indications (and agricultural products) in the international trade in light of the contemporary protectionist trends (i.e. refer, for instance, to Brexit or President Donald Trump's external policies). Although the effects of protectionism can be negative on the overall international market, there are some attempts to promote international free trade, even between large economies/developing countries. This is the case of EU and Canada and EU and Japan (please note that both the agreements are mentioned here below as template of extensive protection of geographical indications in the global picture which give hope with regard to the enhancement of the proposal of this dissertation. Further to this analysis, the author suggests that proper actions should be taken by the States so that they can handle the globalization, by adopting acts of modernization in the most relevant sectors (agri-food among others) without landing in protectionist traps. Please refer to L. COSTATO, *Editoriale, Barriere commerciali e margini di libertà: prodotti alimentari tra protezionismo e aperture dei mercati*, in *Rivista di Diritto Alimentare*, no. 2, April – June 2017.

political concerns. The main motivations that lead to a preference for regionalisms can be, *inter alia*, the will to address special security threats, the intention of locking-up domestic reforms and make them applicable to an entire region, allowing to speak with one voice and, as such, increasing the bargaining power in the international scenario⁸. Should the said interests be predominant, it is not unlikely that the regional trade agreements can become political stumbling to multilateral liberalization in the long term⁹. In any case, bilateral agreements offer undeniable practical benefits. Discussions are faster and easier. It is natural that, in the context of multilateral negotiations, it can be awkward and slow to negotiate separately with over hundred small countries and representative¹⁰. In fact, an organization such as the WTO that is currently composed by more than one hundred and fifty countries¹¹, most of them very disparate one another; it is not hardly surprising that an institution increasingly inclusive is increasingly unwieldy as well¹².

Regardless of the said individual benefits, even in light of the conclusive remarks of this dissertation, meaning the envisaged implementation of an extensive multilateral protection of geographical indications for all food products under TRIPs, regional and bilateral trade agreements show some peculiar advantages from a multilateral perspective.

⁸ On the specific topic of bargaining power in the international framework, this is usually the case of developing countries which may be willing to increase their negotiating leverage within international organizations and, to this extent, use to pool their diplomatic resources with other members of a regional economic agreement. At this respect, some authors note that, by gathering their diplomatic forces, less developed countries are sometimes able to achieve greater prominence in international relations and negotiate agreements that would not be available, if they have acted individually. On this topic, please refer to WORLD BANK POLICY RESEARCH REPORT, *Trade Blocs*, 2000.

⁹ At this respect, please refer to C. DAMRO, *The political economy of Regional Trade Agreements*, in Regional trade agreements and the WTO legal system by L. Bartels and F. Ortino, 2006.

¹⁰ For a detailed collection of the potential material benefits of regional trade agreements and the underlying reasons, please refer to, among others, C. DAMRO, *The political economy of Regional Trade Agreements*, in Regional trade agreements and the WTO legal system by L. Bartels and F. Ortino, 2006, cit. and T. COTTIER, M. FOLTEA, Constitutional function of the WTO and Regional Trade Agreements, in Regional trade agreements and the WTO legal system by L. Bartels and F. Ortino, 2006.

¹¹ The last update of July 29, 2016 records a total number of 164 contracting parties of the WTO. For precise information, please visit the WTO website, "Members and observers", at the following link: https://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm.

¹² For another perspective on the practical difficulties connected to the WTO forum, please refer also to V.D. DO, W. WATSON, *Economic analysis of Regional Trade Agreements*, in Regional trade agreements and the WTO legal system by L. Bartels and F. Ortino, 2006. At this respect, the author underlines, specifically, that the slow moving of negotiations may be an issue and can inevitably cause freelancing of contracting parties interested in obtaining immediate and material results.

In fact, they can be deemed a support, an ancillary mean, building blocks to complement multilateral negotiations. To make it simple, it means that the adoption of certain principles in regional trade agreements could help to consolidate and build upon the benefits of preferential trade agreements and promote a more effective multilateral system¹³. For what matters to this dissertation, the importance of bilateral agreement is crystal clear, should they serve as laboratories for change and innovation and provide guidance for the adoption of new trade discipline at multilateral level. And this is so true if we take into account the numerous initiatives carried out by the EU in protecting geographical indications in the trade relations with its major partners¹⁴. In fact, without mentioning all of them, but simply recalling

¹³ The ability of bilateral trade agreements to become the basis for future multilateral agreements is usually recognized in the global context and in the academia. At this respect, please refer to, *inter alia*, J.A. CRAWFORD, R.V. FIORENTINO, *The changing landscape of Regional Trade Agreement*, World Trade Organization Discussion Paper no. 8, 2005. In additions, please take into account T. COTTIER, *The Common Law of International Trade and the Future of the World Trade Organization*, in *Journal of International Economic Law*, volume 18, 2015. The author first takes note of the crucial role played by regional trade agreement, and their role of expressing political positions and individual economic interests. In any event, he overcomes this circumstance and focuses on the advantages for all global players. Actually, he claims “*all these agreements, forming the global trading system, thus stimulate each other and induce progress by borrowing from each other*”.

¹⁴ On the role of the international attempts undertaken by the EU on the protection of geographical indications (in particular, with the objective to shape TRIPs plus provisions), which can be seen as a basis for future multilateral consensus, please take into account what expressly stated by the EU Commission, DG Agri: “*as long as TRIPs does not offer a satisfactory level of protection for EU geographical indications, it is crucial to achieve a good outcome on geographical indications in bilateral free trade agreements*”. DG AGRI WORKING DOCUMENT ON “*International protection of geographical indications: objectives, outcomes and challenges*”, June 25, 2012.

On the same matter, it is worth recalling an article analyzing the bilateral negotiations between EU and US within the TTIP in the agriculture and food sectors. Although the TTIP (which is the object of the article) cannot be used as a benchmark since it is not complete (neither seek to be completed in the short term) some relevant arguments expressed therein can generally apply to the role of bilateral agreements in the protection of geographical indications. In fact, the author underlines that the EU usually requests for strong protection of geographical signs and it has never been followed in the TRIPs Council. However, EU finds other ways to promote its agenda and is successful in its bilateral trade agreements. All of these can represent a significant help to overcome the existing stumbling blocs at the multilateral level. Please refer to T. JOSLING, *A transatlantic free trade deal: implications for food and agricultural policy*, in the *Estey Centre Journal of International Law and Trade Policy*, volume 15, no. 2, 2014.

Other papers explore the EU policy upon the international protection of geographical indications. Please refer to A. LUPONE, *Il dibattito sulle indicazioni geografiche nel sistema multilaterale degli scambi: dal Doha Round dell'Organizzazione Mondiale del Commercio alla protezione TRIPs plus*, in B. Ubertazzi, E. Muniz Espada (a cura di), *Le indicazioni di qualità degli alimenti. Diritto internazionale ed europeo*, 2009.

Others highlight that the success of EU in bilateral trade negotiations is due to the pragmatic approach usually adopted. For instance, as better explained hereinafter, in the CETA agreement, EU obtains a

the inspiring ratio, the EU has activated a chain of trade agreements seeking satisfactory protection for geographical indications, by establishing sort of TRIPs plus system granting extensive protection¹⁵.

strong protection for a certain number of geographical names (namely the most relevant for the EU international trade) by accepting some concessions (i.e. the exclusion from the protection of a short list of names), which result non detrimental for the EU, but, at the same time, advantageous for the counterparty, making the latter willing to enter into the agreement. Please refer to H.V.J. MOIR, *Understanding EU trade policy on geographical indications*, in *Journal of World Trade*, volume 51, no. 6, 2017.

In any event, to be honest, it is worth underlining that, even if EU is progressing well in its geographical indications agenda and key processing elements are included in the most important bilateral trade agreements, since they are mostly recent, how this picture works in practice remains to be seen.

¹⁵ For a deeper analysis of the specific provisions protecting geographical indications in the EU bilateral trade agreements, please refer to B. O'CONNOR, L. RICHARDSON, *The legal protection of Geographical Indications in the EU's Bilateral Trade Agreements: moving beyond TRIPS*, in *Rivista di Diritto Alimentare*, no. 4, October – December 2012.

In any event, for sake of completeness and considering the relevance in economic terms of the partners, it is worth mentioning the provisions obtained by the EU in the bilateral trade agreement completed with, respectively, Canada and Japan.

CETA is a comprehensive trade agreement entered into by and between EU and Canada. It is intended to open up Canada's goods, services and public procurement markets, help protecting labor rights and environment and enable even smaller EU producers to export significantly to Canada.

It was signed on October 30, 2016 and, starting from September 21, 2017, it is provisionally in force. It means that most of its provisions are already applicable in the territories of signatories, but it would fully enter into force once all the EU national parliaments (or the other competent authorities pursuant to their respective constitutional requirements) ratify the agreement.

As for what matters at our purposes, CETA has a great impact on the food and agriculture sectors. In particular, it reflects the EU position according to which promoting and protecting EU's flagship food and drink products is a top priority (as it is for any EU bilateral agreement). From this perspective, CETA provides in the Canadian territories to 143 EU product bearing a geographical indication a level of protection similar to that attached to the EU *sui generis* system. The same does not apply in the EU territories with reference to Canadian geographical names, since none of them is included in the relevant list.

In particular, *Chapter 20 (Intellectual Property Rights), Subsection C (Geographical Indications)* states that each party shall provide the legal means to protect in its country the geographical names included in the list attached to the agreement. In particular, the latter are guaranteed against any false, misleading or unfair use. In addition, each party undertakes to protect the relevant names against any evocative or descriptive behavior (i.e. use of the geographical name accompanied by expressions such as "kind", "type", "style", "imitation" or the like, even when the true origin is displayed). All of this is without prejudice to any further protection granted by the single jurisdiction. The protection, however, is not extended to translations and some exceptions are provided for certain sensitive names (i.e. Asiago, Feta, Gorgonzola), which can continue to be used within the Canadian territories under certain circumstances.

On the basis of this brief analysis, it seems clear that CETA offers an extensive level of protection only in favor of a selected (though large) list of geographical names, leaving out the others. It is not a complete system; still it represents a step forward against the stumbling blocks of protectionism and shows that common law jurisdictions are ready (and have the means) to welcome extensive protection of geographical names. More important, they can agree upon it, if economic interests converge.

The lesson learned is that bilateral negotiations can pave the way for finding common traits among the global players and overcoming individual political fragmentation in the name of intellectual coherence and identification sense¹⁶. Such a relevance is also

For further analysis of the CETA agreement and its critical appraisal, please refer, among others, to B. O'CONNOR, *Geographical indications in CETA, the Comprehensive Economic and Trade Agreement between Canada and the EU*, in *Rivista di Diritto Alimentare*, no. 2, April – June 2015, B. AWAD, M. CADOGAN, *CETA and the future of Geographical indications protection in Canada*, in Policy File, volume 5, 2017.

EU-JAPAN FREE TRADE AGREEMENT. On July 17, 2018, the EU and Japan entered into a trade agreement which removes trade barriers and helps EU to shape global trade rules in line with its high standard and shared values. The agreement is now awaiting ratification from the EU Parliament and Japanese Diet following which it could enter into force in 2019.

To the extent of this dissertation, this bilateral agreement intervenes deeply into the agriculture field. It scraps Japanese duties on many cheeses (such as Gouda or Cheddar) and wine exports and ensures the protection in Japan of more than 200 EU geographical indications and the mutual protection within the EU territories of a selection of Japanese geographical names.

In particular, *Article 14 (Intellectual Property Rights), Subsection 3 (Geographical Indications)* is addressed at creating an ad hoc system of protection of geographical indications applicable in the region extended between EU and Japan.

First of all, each party undertakes to establish or maintain (if this the case) a system of registration and protection of geographical names in its territories, whereby the system includes at least the following minimum requirements: (i) the list of registered geographical names is available to public; (ii) procedures for opposition to the registration and cancellation of the name; (iii) administrative authorities for controlling and supervising over the fair and correct application of the geographical indication and the maintenance of the requirements.

In addition, with reference to the geographical indications listed in the relevant exhibit to the agreement (referred to both EU and Japanese geographical names), each party undertakes to prevent in its territories any act of unfair competition, false or misleading use, any use of the geographical name for “like goods” in translation or transliteration or accompanied with expressions such as “kind”, “type”, “style”, “imitation” or the like.

This agreement turns out to be very interesting at our purposes since it represents a development of the CETA and the landing point of all the other bilateral trade agreements entered into by the EU as of now. First it imposes the enhancement of a specific system of protection of geographical indications in both countries and provides an extensive protection applicable to a large number of geographical indications. Furthermore, it includes a provision which reflects some of the recent concerns on the development of the notion of “evocative” use (already briefly mentioned in the chapter 2, paragraph 2.8 of this dissertation). It provides that protection should be extended also to the use of geographical names in transliteration, whereby transliteration covers the conversion of characters following the phonetics of the original language or languages of the relevant geographical indication.

¹⁶ To be honest, the possibility of rebirth of multilateral agreement is not unanimously shared within the academia. Some folks, indeed, critically analyze the multilateral system of trade agreements underlying their inherent utopia.

The objective of WTO is to establish a normative framework agreed by all members and subject to steady improvement following new demands and innovations. Nevertheless, such utopia dramatically crushes against reality: should decisions be adopted by all parties, it is almost genetic that individual political positions can prevent the implementation of rules and regulations. Therefore, alternative fora (i.e. bilateral trade agreements) involving only two parties seem to be more satisfactory, in addition to being easier and quicker to implement. If this is the general rule and the harsh true, the author would

better explained any time international players need to face issues – like, as said, the protection of geographical indications – that are inherently multilateral/of global relevance and therefore cannot be effectively dealt with in the context of individual relationships.

Moreover, and this adds an important piece to the puzzle in terms of “turning into practice the theoretic dissertation”, multilateral agreements like the TRIPs provide for dispute settlement mechanisms and authorized enforcement¹⁷.

Ultimately, despite the recent shift towards regional trade agreements, multilateral level of protection in the field of geographical indications is to be preferred. Such a system is not unlikely to be reached if we consider as a common basis, among the other factors better analyzed hereinafter, the global relevance of geographical indications and the contribution of already completed regional trade agreements including extensive guarantee for geographical signs. The TRIPs is to be identified as the most suitable tool, considering the section already addressed at geographical indications, the related dispute settlement system and the widespread acknowledgement by international players and ongoing and open (even if suspended) negotiating tables.

2. ONCE CLARIFIED THE PREFERRED ROLE OF MULTILATERAL AGREEMENTS WHEN DEALING WITH MATTERS OF GLOBAL INTEREST, SUCH AS THE GEOGRAPHICAL INDICATIONS, WHY ARE MULTILATERAL NEGOTIATIONS ON THE EXTENSION OF PROTECTION AT A STANDSTILL POINT? WOULD IT BE POSSIBLE TO MOVE FORWARD AND TAKE THE TOPIC BACK TO THE INTERNATIONAL AGENDA?

Whether multilateral agreements (and especially the WTO and TRIPs forum) represent the main goal in the international trade when it comes to geographical indications, the reality looks quite distant. As mentioned, the EU undertook numerous initiatives in protecting geographical indications in the trade relations with its major partners. And it is still a fact that more than two decades after the adoption of TRIPs,

welcome with appreciation any effort towards the salvation of multilateral system. At this respect, please refer to P. BORGHI, *Il declino dell'utopia multilaterale?*, in Eurojus.it, May 20, 2015.

¹⁷ On the enforcement related to multilateral trade agreements and especially to TRIPs please refer to chapter 1 of this dissertation.

the negotiations have stalled and the EU is trying to leverage on the signed agreement to influence other signatories to join its position.

In the author's opinion, nothing is lost yet. On the contrary, there are various and heterogeneous glimmers which keep the fire alive and lead towards a multilateral extensive protection of geographical signs. To the basis of existing bilateral agreement regulating geographical indications, it possible to add the driving forces promoted by a number of developing countries.

The purpose of this paragraph is to highlight the negotiating capacity of developing countries with regard to the protection of geographical indications in the WTO forum, by exposing the possible relevant risks and benefits.

It seems, from recent debates, that developing countries are becoming more and more aware of the role that geographical indications can have in the extension of their economies¹⁸.

In any event, some concerns are still on the table. In particular, we make reference to the envisaged check and balance between two divergent topics.

On one side, being geographical indications, among others, a collectively governed, locally based mechanism devoted at protecting the traditional heritage, farmer knowledge, and environmental resources associated with certain products, they represent useful legislative means for producers and practitioners in developing countries¹⁹. Actually, many developing countries may be interested in exploiting the reputation of some of their exotic products in which they have a particular commercial, traditional or national interest, with the aim of consolidating their position in the global market²⁰. The enhancement of a multilateral system of protection of geographical indications would impose the mutual recognition of the names, preventing the misleading identification of the relevant products and, if this is the case, allowing *ex officio* actions to contrast the negative effects, as such ensuring

¹⁸ For a deeper analysis of the consequences of an extensive level of protection of geographical indications in developing countries, please refer to J. OTIENO-ODEK, *The way ahead – What future for geographical indications?*, paper presented at the Worldwide Symposium on Geographical Indications jointly organized by the Italian Ministry of Productive Activities and WIPO in Rome, June 27/29, 2005.

¹⁹ At this respect, please refer to S. BOWEN, *Development from Within? The Potential for Geographical Indications in the Global South*, in the *Journal of World Intellectual Property*, volume 13, no. 2, 2010.

²⁰ Please note that examples of geographical names often used to wrongly identify or identify without any guarantee of origin in the relevant developing countries are “Persian” for carpet, “Basmati” for rice, “Colombian” for coffee or “Chuaao” for chocolate from a region in Venezuela.

higher incomes from the sale of the specialties and the further increase of the overall production²¹.

It remains an open question, however, whether and to what extent proliferation of geographical labeling would achieve the outcomes sought by policy makers and producers in developing countries of supporting domestic production and exports. On the contrary, it should be evaluated whether such a system of protection would impose additional costs with no significant reward. In other words, it is essential to assess whether benefits of enhancing a system of protection of geographical indications are real and not only potential. And this is naturally a matter of concern, which is in the front line developing countries negotiating strategy.

First, it is true that geographical labeling provides information on a product's origin and quality. But, at the same time, it is true that such information would be an added value exclusively (or, at least, mainly) to those products that carry a portfolio of certified and recognized quality attributes, including food safety and consistent store availability²². Considering the overall background of developing countries, it may happen that many or most of their food products do not have the cachet and certified

²¹ On the advantages of multilateral extensive system of protection of geographical indications, please refer to, *inter alia*, D. VIVAS-EUGUI, *Negotiations on Geographical Indications in the TRIPs Council and their effect on the WTO agricultural negotiations. Implications for developing countries and the case of Venezuela*, in *Journal of World Intellectual Property*, volume 4, no. 5, 2001. Furthermore, please note that other folks share the view, expressly stating that “*geographical indications are an opportunity for emerging economies to use intellectual property rules to improve their living standards by generating wealth for their communities, preserving their cultural heritage and landscape*”. Please refer to M. AGDOMAR, *Removing the greek from Feta and adding Korbel to champagne: the paradox of geographical indications in international law*, in 18 *Fordham Intell. Prop. Media & Ent. L.J.*, 2008. On the same page other arguments on the positive relationship between geographical indications and developing economies can be recalled. The author starts from the assumption that geographical indications are economic assets. On one side, producers can monetize in the form of premium prices for products covered by the geographical sign. On the other, such premium prices can help to channel resources in the area where goods are produced, incentivizing quality preservation and innovation in authentic products. In light of this, she promotes the rule-making on geographical indications to the greatest benefit of developing countries. To this extent and to realize better the legal and economic potential of geographical indications, the author suggests to take the experience of other WTO countries as example. Please refer to T. YANGUAS ACOSTA, *Geographical Indications in the accession landscape*, in *Trade Multilateralism in the Twenty-First Century: Building the Upper Floors of the Trading System through WTO Accessions*, 2017.

²² At this respect, please refer to D. VIVAS-EUGUI, *Negotiations on Geographical Indications in the TRIPs Council and their effect on the WTO agricultural negotiations. Implications for developing countries and the case of Venezuela*, in *Journal of World Intellectual Property*, volume 4, no. 5, 2001, *cit.*, highlighting that food produced in developing countries may not fully comply with the sanitary standards of developed countries and, in addition, the amount of production is often undersized to guarantee immediate global market access and supply.

supply chain systems, which EU geographical indications can usually bank on²³. If we wish to turn these arguments into concrete suggestions, it is worth considering that, in order to receive monetary benefits from products identified by geographical signs, products should first build their reputation on the international market and, then, they can become truly competitive and thus a source of revenues.

Furthermore, as mentioned, geographical indications are matched with a structured enforcement system. If this is the assumption, it is not uncommon that, in developing countries, most geographical names simply exist, but are not covered by specific protection. They are neither registered as protected indications nor subject to quality nor supervisory controls. Since the policy makers in developing countries are often inexperienced, a broader protection of geographical indications may impose to developing countries to invest resources in establishing national adapt legislative frameworks, including quality assurance schemes, record keeping, supervisory activities²⁴. From a practical perspective, all the above shows that chasing the dream of price premium for protected and origin-labeled products may result to be costly for developing countries.

In light of all the above, it is clear that there is no one way answer with regard to the overall effect of the expansion of geographical labeling on developing countries, since any evaluation depends on a complex mix of market opportunities that may be yield

²³ On the issues related to the market access of food products of developing countries even if protected by geographical indications, please refer to S. ANDERS, J.A. CASWELL, *The benefits and costs of proliferation of geographical labeling for developing countries*, in *The Estey Center Journal of International Law and Trade Policy*, Volume 10, no. 1, 2009. On the same topic, other folks recognize that the possibility to access extra local markets with quality / geographically marked products represents an important chance for producers in developing countries, since it can bring economic resources into marginalized rural areas. However, the beneficial effects may not be automatic neither immediate. Although some products, like tequila or coffee, are fairly easy to transport, making market expansion logistically feasible, for others (e.g. local cheeses), this may prove to be difficult. Please refer to S. BOWEN, *Development from Within? The Potential for Geographical Indications in the Global South*, in the *Journal of World Intellectual Property*, volume 13, no. 2, 2010, cit.

²⁴ At this respect, please refer to D. VIVAS-EUGUI, *Negotiations on Geographical Indications in the TRIPs Council and their effect on the WTO agricultural negotiations. Implications for developing countries and the case of Venezuela*, in *Journal of World Intellectual Property*, volume 4, no. 5, 2001, cit. To the same extent, other authors express their concerns towards the costs connected to the enhancement of an extensive system of protection of geographical indications, especially in countries for the political background are quite rudimental. Please refer to S. ANDERS, J.A. CASWELL, *The benefits and costs of proliferation of geographical labeling for developing countries*, in *The Estey Center Journal of International Law and Trade Policy*, Volume 10, no. 1, 2009, cit. and S. BOWEN, *Development from Within? The Potential for Geographical Indications in the Global South*, in the *Journal of World Intellectual Property*, volume 13, no. 2, 2010, cit.

both substantial benefits and costs of implementing. Therefore, when evaluating its negotiating strategies in the international forum, each country should take into account its individual situation and analyze the opportunity of extending geographical indications protection with regard to the material production portfolios held, the market channels and the existing legislative framework²⁵.

Despite of all the above, for what matters at our purposes, it is worth noticing that it can be registered a growing interest of developing countries in discussing in the international forum their need to promote their traditional products using a legislative tool, such as the geographical indications, which is omni-comprehensive and extended. And this growing interest can serve as further leverage on WTO delegations to move forward on the discussion upon the protection of geographical indications and solve the remaining open questions.

Throughout the dissertation, we have paved the way to get to a multilateral extensive system of protection of geographical indications. To this extent, we have analyzed the current international framework, which represents the grounds on which building the author's proposal, together with the two main "national" systems of law (i.e. the EU and US ones) highlighting the main characteristics and relevant meeting points, in order to clear any doubts on the possibility of reconciling the "apparent" differences through the adoption of the suggested extended system.

In the first part of this chapter we have also explained why a multilateral system of protection is the envisaged solution with regard to the protection of geographical signs and how, thanks to basis provided by numerous regional trade agreements and the push from developing countries, the stalled negotiations can effectively start again and lead to the proposed solution.

At this point, before explaining better the suggested system and expressing the underlying *ratio* which makes it suitable and compliant with both backgrounds of the major parties, we believe it is worth clarifying, to the reader's benefit, what "extensive" materially means, what are the guarantees made available to products bearing a geographical signs if the protection is "extensive".

²⁵ In other words, as better expressed by other authors, the case of developing countries and geographical indications should be located within the larger framework of international legislation, considering that higher standards are necessary and should be achieved through more context-specific approaches. Please refer to S. BOWEN, *Development from Within? The Potential for Geographical Indications in the Global South*, in the *Journal of World Intellectual Property*, volume 13, no. 2, 2010, cit.

Given that the “extensive” solution as means to protect geographical indications worldwide is not in itself a brand new discovery, in order to explain her position, arguments and the basis on which drawing up the conclusive outcome, the author deems useful to pick some principles from the proposals already expressed by the negotiating states within the WTO forum. The following section, therefore, summarizes the mentioned steps undertaken in the negotiations post TRIPs.

3. THE DOHA DEVELOPMENT AGENDA WITH REGARD TO GEOGRAPHICAL INDICATIONS²⁶

We have already mentioned that the TRIPs provisions on geographical indications represent a “temporary” and “compromise” solution reflecting a very sensitive debate among WTO members²⁷.

The creation of a complete system for international protection of geographical indications is a work in progress, there being a series of outstanding issues. WTO negotiators on the Uruguay Round were conscious of these deficiencies and thus, in the approved text, expressly mandated further negotiations²⁸ in order to keep alive the commitment towards improving intellectual property rights entailed in geographical names.

In particular, the 1994 Uruguay Round Agreement on Agriculture includes a commitment to start new negotiations on agriculture by the end of 1999. The 1999 Ministerial Meeting to launch this Round ends in failure in Seattle. Despite this failure, in November 2001, the negotiations officially enter a new phase with the Doha Ministerial Declaration²⁹ suggesting a new dynamism to the continuing negotiations in various sectors and, for what matters to this dissertation, in agriculture and

²⁶ For a deeper analysis of the WTO negotiations over WTO provisions on agriculture and TRIPs provisions on geographical indications, please refer, respectively to G. ANANIA, J.C. BUREAU, *The negotiations on agriculture in the Doha Development Agenda Round: current status and future prospects*, in *European Review of Agricultural Economics*, volume 32, no. 4, 2005 and M. GEUZE, *The provisions on geographical indications in the TRIPs agreement*, in *The Estey Journal of International Law and Trade Policy*, volume 10, no. 1, 2009.

²⁷ For a complete analysis of the birth of the TRIPs please refer to chapter 1, paragraph 2.5 of this dissertation.

²⁸ Such a negotiating mandate in the field of geographical indications has been defined (and it is currently renown) as the “built-in agenda”.

²⁹ Please refer to WT/MIN(01)/DEC/1, November 20, 2001.

The complete official text is available on the WTO website at the following link: https://www.wto.org/english/thewto_e/minist_e/min01_e/mindecl_e.htm.

geographical indications. The deadline to reach an agreement is originally set for the Fifth Session of the Ministerial Conference³⁰, where the participants fail to reach an agreement over geographical indications issues and so the negotiations takes place within the overall time for the round.

Two years later, during the Hong Kong Ministerial Conference, apart from taking notes of the progresses made (or at least attempted), members are not able yet to get to any landing zone on the vexing issues of geographical indications.

From that moment on, multilateral negotiations on geographical indications are deadlocked in the WTO forum³¹. However, as better explained in the latest paragraphs of this chapter, the overall scenario has changed and developed. Hence, it is not unrealistic to believe that there is room for discussion, especially if an extensive solution (even with a certain degree of concession) is put on the table³². Before

³⁰ Please refer to Cancun Ministerial Meeting of 2003.

³¹ On the stalling of WTO negotiations upon geographical indications, please note that even though negotiating positions have not changed, as from the Hong Kong Conference, further meetings, summaries and reports have been released by interested parties.

Also in a 2011 report, the Director-General of WTO confirmed again that the parties positions keep on diverging sharply and no already made solution seems to be in sight. Please refer to Report by the Director-General, WT/GC/W/633, TN/C/W/61, April 21, 2011, paragraph 17: "*Delegations continued to voice the divergent views that have characterized this debate, with no convergence evident on the specific question of extension of Article 23 coverage: some Members continued to argue for extension of Article 23 protection to all products; others maintained that this was undesirable and created unreasonable burdens*".

The timeline of the complete path of the WTO negotiations starting from the Doha Round are available online on the WTO website at the following link: https://www.wto.org/english/tratop_e/dda_e/dda_e.htm.

³² In addition to all the reasoning carried out and grounded in the following paragraphs of this chapter, it is worth mentioning a study which – being not so recent – shows how symptoms towards a multilateral consensus upon geographical indications date back to 2009.

The study under exam sets out a list of countries protecting geographical indications, together with an estimation of total number of recognized names (and a note upon the nascent geographical names). The study involves both countries adopting *sui generis* and trademark systems of protection of geographical names. The outcome is quite encouraging: the examination of almost 160 countries shows a total number of 8,900 registered geographical names and almost 1,000 nascent ones.

Pursuant to the author's view, this seems to have a significant impact on ongoing WTO negotiations on the topic. In particular, the author upholds that: (i) many countries which, in the early stages of the WTO rounds opposed to geographical indications, are developing *sui generis* systems of protection; (ii) EU accounts for only half of the geographical indications recognized worldwide (and not for the majority of them, as usually contested) proving that the topic is of global interest; (iii) EU is not alone, but more and more international stakeholders would take its stand. Please refer to B. O'CONNOR, *Geographical indications. An examination of how different countries protect GIs and an attempt to identify how many known GIs there are*, in *Diritto e giurisprudenza agraria, alimentare e dell'ambiente*, no. 5, 2009.

getting to the conclusion, it is worth mentioning the steps and attempts already undertaken at the WTO that serve as basis for the proposed outcome.

In particular, the Doha Ministerial Declaration states: *“with a view to completing the work stated in the Council for Trade-Related Aspects of Intellectual Property Rights (Council for TRIPs) on the implementation of Article 23.4, we agree to negotiate the establishment of a multilateral system of notification and registration of geographical indications for wines and spirits by the Fifth Session of the Ministerial Conference. We note that issues of related to the extension of the protection of geographical indications provided for in Article 23 to products other than wines and spirits will be addressed in the Council for TRIPs pursuant to paragraph 12 of this declaration”*³³.

And paragraph 12 expressly claims that *“we agree that negotiations on outstanding implementation issues shall be an integral part of the Work Program we are establishing. In this regard, we shall proceed as follows: (a) where we provide a specific negotiating mandate in this declaration, the relevant implementation issues shall be addressed under that mandate; (b) the other outstanding implementation issues shall be addressed as a matter of priority by the relevant WTO bodies, which shall report to the Trade Negotiations Committee”*.

As usually happens when it comes to WTO negotiating matters, the application of the principles set forth above was not undisputed³⁴. In fact, should the discussion on the enhancement of a multilateral register of protected geographical indications for wine and spirits be expressly mandated, discussions upon the extension of Article 23 of TRIPs to all food products may result in a discretionary initiative of certain signatories, depending on the interpretation chosen for paragraph 12 of the Doha Ministerial Declaration and the mentioned *“outstanding issues”*.

EU and many developing countries on one side believe that the unresolved and outstanding implementation issues are clearly part of the agenda and are included in the scope of negotiations. On the other side, US and US oriented parties responds that the Trade Negotiation Committee has not included other outstanding implementation issues in the agenda and countries, alone, are not authorized to discuss lacking a mandate. In any case, it would overcome the scope of this dissertation questioning

³³ Please refer to Doha Ministerial Declaration, paragraph 18.

³⁴ On the concerns over the interpretation of paragraph 12 of the Doha Ministerial Declaration, please refer to, inter alia, M. ECHOLS, *Geographical indications for food products*, 2008, cit.

whether a mandate to negotiate extension of Article 23 of the TRIPs exists or not, since discussions have been undertaken either way. At our purposes, it is worth summarizing the various steps of the discussions and the relevant content in order to have a clear picture of how the author's proposal to reconcile the worldwide debate upon geographical indications is shaped.

Given that, let us just recall that two main topics are currently on the negotiating table³⁵:

- (a) the establishment of a multilateral system of notification and registration of geographical indications for wines and spirits;
- (b) the extension of the protection of geographical indications provided for in Article 23 to products other than wines and spirits.

For sake of completeness, the author dedicates a brief paragraph to the proposals relating to the multilateral register of protection of geographical indications. Still, greater attention will be given to the proposals relating to the application of the protection granted to wines and spirits to all food products. As a matter of fact, the analysis of this topic represents the basis to draw up the conclusions of the dissertation, which promote the adoption of a complete level of protection applicable to all food products (even though including some concessions, proposed by the author for feasibility reasons/as consensus strategies).

³⁵ Please note that, within the context of the agriculture negotiations, EU submit also the "claw back" proposal. It concerns a list of names that, in the EU, are protected as geographical indications, but are used as generic terms to identify food products in some third countries. The aim of the proposal is to reclaim the listed names so that their use is reserved exclusively to eligible producers in the EU. On the "claw-back" proposal, please note only that geographical names included in the list were chosen among those names usually, in the EU's perspective, usurped and imitated the most, in particular in those countries which are the most relevant export partners. Please refer to EUROPEAN COMMISSION, *WTO talks: EU steps up bid for better protection of regional quality products*, August 28, 2003.

The author does not focus on this proposal, but believes it is worth mentioning because she borrows the idea of clawing back geographical names, but reverses the application. As better explained in the description of the author's proposal, the extension of the protection of geographical indications should be applicable to all geographical indications protected in each signatory country (pursuant to the mutual recognition principle) and matched with a list of geographical names that – considering their sensitive value – can continue to be used in a descriptive way in third countries, as long as their origin is clearly revealed and they are not misleading.

3.1. Multilateral register of protected geographical indications for wine and spirits

With regard to the register for protected geographical indications, two main approaches are currently feeding the debate. Reference is made to the minimalist approach claimed by the US block and based on merely informative nature and voluntary participation and the maximalist approach supported by the EU block, promoting a register applicable and, at least in its original version, binding for all signatories.

3.1.1. The joint proposal³⁶

It refers to a purely voluntary system, where no WTO member party shall be required to participate³⁷. Those member countries who wish to participate to the register would notify a list of geographical indications to be recorded on a database administered by the WTO Secretariat³⁸. The most relevant element of this proposal

³⁶ Please refer to Submission by Argentina, Australia, Canada, Chile, Dominican Republic, Ecuador, El Salvador, Honduras, Mexico, New Zealand, Chinese Taipei and the United State, TP/IP/W/10 first presented on April 1, 2005 and then revised several times.

³⁷ Please refer to Submission by Argentina, Australia, Canada, Chile, Dominican Republic, Ecuador, El Salvador, Honduras, Mexico, New Zealand, Chinese Taipei and the United State, TP/IP/W/10 first presented on April 1, 2005, Article 2.1.

According to the main commentaries, such structure of the proposal reflects the principle that geographical indications are territorial rights and, therefore, the conditions for granting and exercising them shall be established in national legislations of WTO members. At this respect, please refer to J.M. CORTÉS MARTIN, *The World Trade Organization and the negotiations to establish a multilateral register for geographical indications*, in *La tutela dell'origine dei prodotti alimentari in Italia, nell'Unione Europea e nel commercio internazionale*, Atti del Convegno, Alessandria 21/22 maggio 2015.

As a general comment on the nature of this proposal, it is worth mentioning some arguments stated in the academia. The weakness of this proposal lies in the circumstance that Article 23, paragraph 4 of the TRIPs expressly mandates the establishment of a multilateral register and the word "register" is supposed to imply much more than simple transparency and informative nature. Indeed, registers are usually created to provide legal bounds, as opposed to databases which are normally created for transparency reasons and record keeping. Please refer to D. VIVAS-EUGUI, *Negotiations on Geographical Indications in the TRIPs Council and their effect on the WTO agricultural negotiations. Implications for developing countries and the case of Venezuela*, in *Journal of World Intellectual Property*, volume 4, no. 5, 2001, cit.

³⁸ Please refer to Submission by Argentina, Australia, Canada, Chile, Dominican Republic, Ecuador, El Salvador, Honduras, Mexico, New Zealand, Chinese Taipei and the United State, TP/IP/W/10 first presented on April 1, 2005, Articles 3 (Notification) and 4 (Registration on the Database).

In order to fully understand the scope of the proposal, please take into account that the database is imagined to be free, researchable online and accessible to all WTO members and the public. Please

lies in the effects attributed to the register. On one side, participating members would commit to ensure that their internal procedures for evaluating geographical signs for wine and spirits (and, in particular, their registration and protection pursuant to domestic law) include the consultation of the database. On the other side, non-participating members would be encouraged, but would not be obliged to consult the database³⁹. In practical terms, registration in the multilateral system would not give rise to any presumption regarding eligibility for protection, provided that it remains regulated by the national relevant rules and the exceptions included in Article 24 of the TRIPs⁴⁰ still apply.

3.1.2. The Hong Kong, China proposal⁴¹

It aims at being a half way proposal between the other two proposals, building a bridge between the extremist positions of the US and EU blocks. Similar to the Joint Proposal, Hong Kong, China proposal suggests the participation to the register should be voluntary. Members wishing to participate in the system would notify the administrative body of any geographical indication for wine or spirits protected in their territories. At this point the indication goes through a formal examination process carried out by the administrative body. More precisely, the applicant submits some basic information (i.e. details of the geographical name, ownership, basis of protection in the home country, payment of the requisite fee) and the authority verifies that they are in order⁴². If this is the case, the geographical sign is recorded in the register⁴³.

refer to Submission by Argentina, Australia, Canada, Chile, Dominican Republic, Ecuador, El Salvador, Honduras, Mexico, New Zealand, Chinese Taipei and the United State, TP/IP/W/10 first presented on April 1, 2005, Article 4.3.

³⁹ Please refer to Submission by Argentina, Australia, Canada, Chile, Dominican Republic, Ecuador, El Salvador, Honduras, Mexico, New Zealand, Chinese Taipei and the United State, TP/IP/W/10 first presented on April 1, 2005, respectively Article 5 (Procedures to be followed by Participating Members) and 6 (Access for other Members).

⁴⁰ For a complete analysis of the exceptions provided for by Article 24 of TRIPs please refer to chapter 1, paragraph 2.5.3 of this dissertation.

⁴¹ Please refer to Communication from Hong Kong, China, TN/IP/W/8 of April 23, 2003.

⁴² At this respect, please refer to [Annex A](#) to the Communication from Hong Kong, China, TN/IP/W/8 of April 23, 2003, letter A), (Notification) and letter B), (Registration), paragraph 1).

⁴³ In order to fully understand the scope of the proposal, please take into account that the database is imagined to be free, researchable online and accessible to all WTO members and the public. At this

With regard to the legal effects of registration, this proposal entails a system whereby a registered geographical indication would determine in participating members a “prima facie” evidence with regard to (i) the ownership of the geographical indication, (ii) compliance with the definition provided for by Article 22 paragraph 1 of the TRIPs⁴⁴ and (iii) protection in the country of origin⁴⁵. It means that the mentioned three issues are deemed to be proved unless evidence to the contrary is produced by the other party⁴⁶.

3.1.3. The EU proposal⁴⁷

In its first version dating back to 2005, the EU position implies a system that would be applicable to all WTO members⁴⁸.

respect, please refer to Annex A to the Communication from Hong Kong, China, TN/IP/W/8 of April 23, 2003, letter B), (Registration), paragraph 6).

⁴⁴ For a complete analysis of the provisions of Article 22 of the TRIPs please refer to chapter 1, paragraph 2.5.1 of this dissertation.

⁴⁵ At this respect, please refer to Annex A to the Communication from Hong Kong, China, TN/IP/W/8 of April 23, 2003, letter D), (Effect of registration), paragraph 2).

⁴⁶ As a general remark on this element of the proposal (i.e. the effect of registration), it has been noted that, compared to the Joint Proposal, it affects the burden of proof of applicants to the register. It supports the geographical indication’s owner, by allowing him to discharge some relevant issues and forcing the counterparty to produce the evidence. Please refer to K. DAS, *The protracted WTO battle over a multilateral GI register: what lies beneath?*, in *Journal of World Trade*, volume 49, no. 6, 2015.

⁴⁷ Please note that the EU position has been declined in various proposals: a first maximalist statement is followed by a lighter perspective aimed at embracing some contrasting requests and finding consensus among the WTO negotiators.

The first proposal is the Communication from the European Communities, TN/IP/W/11 of June 14, 2005.

The second proposal, commonly known as the “new thinking”, is included in a broader text dealing with other matters: Communication from Albania, Brazil, China, Colombia, Ecuador, the European Communities, Iceland, India, Indonesia, the Kyrgyz Republic, Liechtenstein, the Former Yugoslav Republic of Macedonia, Pakistan, Peru, Sri Lanka, Switzerland, Thailand, Turkey, the ACP Group and the African Group, TN/IP/W/52 of July 19, 2008.

Some authors comment the EU position with regard to the multilateral register, stating that whether the EU proposal follows the negotiating mandates, its success is shaky since it lacks of political support from other members. Please refer to D. VIVAS-EUGUI, *Negotiations on Geographical Indications in the TRIPs Council and their effect on the WTO agricultural negotiations. Implications for developing countries and the case of Venezuela*, in *Journal of World Intellectual Property*, volume 4, no. 5, 2001, cit.

⁴⁸ Please take into account that, as expressly provided for in the whereas of the Communication itself, the proposal maintains the level of ambition of the EU with regards the multilateral register of geographical indications, as contained in particular in the proposals in documents IP/C/W/107/Rev.1, June 22, 2000.

Under a terminological perspective, please note that “participating Member” means each WTO members which notifies geographical indications into the multilateral system. While “non-

The initial step is the same of the other mentioned proposals: members wishing to participate would notify geographical names to the competent authority and let it assess the existence of requisites of registration⁴⁹. Upon submission of the request and for the following 18 months, the other members have the right to examine the submission and, eventually, challenge the geographical indication on three specific grounds of opposition, namely (i) the geographical indication does not meet the definition pursuant to Article 22, paragraph 1 of the TRIPs⁵⁰; (ii) the notified use of the geographical indication is misleading pursuant to Article 22, paragraph 4 of the TRIPs; (iii) the geographical indication is deemed the common name for a type of wine or spirit in the territory of the challenging member⁵¹. Should a reservation be submitted, the involved parties shall enter into negotiations aimed at resolving the disagreement⁵². To the extent that a reservation lodged has not been neither solved nor withdrawn, the registration shall be accompanied by an annotation referring to the reservation. Should there be no challenges or the challenges are withdrawn at the expiry of 18-month period, then the geographical indication can be recorded in the register. The most debated element of this proposal is the effect attribute to the registration⁵³. Actually, once included in the register, the geographical indication would produce an irrebuttable (i.e. no longer challengeable) presumption with regard to the three mentioned grounds of opposition. In other words, the members who have not challenged the registration or have withdrawn the challenges cannot deny protection to the relevant geographical indication on none of the three grounds. The same principle applies to non-participating members that have not lodged reservations or have withdrawn the challenges within the prescribed 18 months.

participating Members” refers to those members that do not notify geographical indications into the system.

⁴⁹ Please refer to Communication from the European Communities, TN/IP/W/11 of June 14, 2005, Annex, Articles 2 (Notification) and 3 (Registration).

⁵⁰ For a complete analysis of the provisions of Article 22 of the TRIPs please refer to chapter 1, paragraph 2.5.1 of this dissertation.

⁵¹ Please refer to Communication from the European Communities, TN/IP/W/11 of June 14, 2005, Annex, Article 3.2.

⁵² Please refer to Communication from the European Communities, TN/IP/W/11 of June 14, 2005, Annex, Article 3.4.

⁵³ At this respect, please refer to Communication from the European Communities, TN/IP/W/11 of June 14, 2005, Annex, Articles 4 (Legal effects in participating Members) and 5 (Legal effects in non-participating Members).

As mentioned the irrebuttable presumption applies only to the prescribed grounds of opposition, therefore it is not unlimited. Indeed, if the internal legislation so permits, participating members can challenge at any time the geographical indications on the grounds provided for by Article 24 of the TRIPs, such as prior good faith use or prior good faith trademarks or grandfathered uses.

The examined first proposal was not really welcomed by the other members of WTO. With the purpose of reaching a landing zone among the various critics and oppositions, during 2008, the EU submitted a slightly amended proposal (the so called “new thinking”), through which the EU basically relaxed its positions concerning the boundaries of the register and the legal effects of registration.

Given that, the EU first proposes that the register would not be an automatic protection system. Actually, it is left to domestic authorities to act within the framework of their domestic systems and pursuant to the internal applicable laws, provided only that they commit to take into account the register when making the decision.

Second, the registration would be deemed “prima facie” evidence that the registered geographical indication meets the definition laid down in Article 22, paragraph 1 of the TRIPs.

In the framework of these procedures, domestic authorities shall consider assertions on the genericness exception laid down in Article 24, paragraph 6 of the TRIPs only if these are substantiated⁵⁴.

Regardless the efforts endured by the EU to reach a shared consensus on the multilateral register of protected geographical indications for wine and spirits, all its proposals collapsed against the opposition of US oriented countries and no compromise was reached on the matter. The situation thus is stalled⁵⁵. It overcomes

⁵⁴ Some authors comment the efforts made by the EU in order to offer a hand to opponents and reach consensus. Although this new proposal does not entail any automatic protection of registered geographical names, it is true that occasional freeriding can be prevented. Those who attempt to free ride on a notified geographical indication shall bear the burden of proof (in particular that the name is a generic term to identify products) and incur in the relevant litigation costs. Furthermore, it is not unlikely that usurpation would diminish. Please refer to J.M. CORTÉS MARTIN, *The World Trade Organization and the negotiations to establish a multilateral register for geographical indications*, in *La tutela dell'origine dei prodotti alimentari in Italia, nell'Unione Europea e nel commercio internazionale*, Atti del Convegno, Alessandria 21/22 maggio 2015, cit.

⁵⁵ For sake of completeness, please note that recently the matter has been brought once again under the spotlight. In fact, on February 23, 2015, the TRIPs Special session held an informal information session in which the Secretariat provided a detailed factual overview of past work in the TRIPs Special

the scope of this dissertation to inquiry further on the underlying *ratio* of this proposals and the reasons of the debates. In any event, for what matters at our purpose, it is worth having a general idea of the proposed role a potential register of protected geographical indications. Should the extensive system of protection as suggested throughout this dissertation be adopted, the enhancement of a multilateral register will follow and will be regulated by the same terms and conditions of the extended protection.

Once completed the brief summary of the proposals for the establishment of a multilateral register for protected geographical indications of wine and spirits, the analysis focuses on the proposals as of now submitted in order to apply the protection currently granted only to wines and spirits under Article 23 of the TRIPs to all food products. As a matter of fact, this is the central point of this dissertation's arguments and the lighthouse of the proposed multilateral system (which include this extension only with some concessions, proposed by the author for feasibility reasons/as consensus strategies).

3.2. Extension of higher levels of protection (i.e. Article 23 of the TRIPs) to all food products

Generally speaking and regardless all the mentioned discussions upon the existence of a negotiating mandate, the debate on the extension of the rules under Article 23 of the TRIPs to products other than wine and spirits turns around the objectives, scope and content of the extension and the cost implications on producers, consumers and government authorities. The debate is one the hottest issues within the WTO forum and has put the Old and New World countries one against the other. In pills, the EU claims that protection, as set forth in Article 22 of the TRIPs, is inadequate. In fact, it allows free riding by producers outside the country of origin and, as an effect, determines confusion in the consumers and dilution of the names' value, lower revenues for producers, ultimately less interest in investing in quality products. On the opposing front, US oriented players state that the mentioned critics are not

Session, tracing the negotiations of a register for wine and spirit geographical indications from 1997 to 2011.

The chairman of the Special Session of the TRIPs Council, Dacio Castillo of Honduras, circulated his report (ref. TN/IP/23) to the Trade Negotiations Committee on December 3, 2015.

material, but, on the contrary, moved by protectionist interests. In addition, charges on usurpation of the name are not grounded in light of the generic nature of most of the reclaimed names. Lastly, but not less important, the extension would imply the relabeling of various products, the implementation of specific registration procedures and control systems. Therefore, connected administrative costs may become significant⁵⁶.

Under a systematic point of view, the analysis of this matter is carried out following a fluent exposition. Therefore, the positions of the conflicting blocks are analyzed jointly, as a single voice, highlighting the main characteristics⁵⁷. Furthermore, this paragraph is of the greatest importance to the extent of this dissertation since it expressly deals with the definition of “extensive” protection of geographical names.

The object of the debate is the proposal to amend Article 23 of the TRIPs to require each member to provide the legal means for interested parties to prevent use of geographical indications identifying "*goods for such goods not originating in the place indicated by the geographical indication in question*"⁵⁸.

The supporters of this amendment uphold that the existing provisions of Article 22 of the TRIPs did not prevent free-riding on the reputation of a product which displays unique features and a specific quality due to its geographical origin by other products bearing the same or similar geographical indication but produced in other regions and not possessing the same qualities. As already mentioned, opponents reply to this charge offering a double fold statement. On one side, most of the reclaimed names are generic terms used in the contested territories to identify certain food products. On the other side, the same geographical names are used to identify the same products for historical reasons. Citizens of the of the Old World who emigrated to the New

⁵⁶ For an omni-comprehensive and institutional point of view with regard to the extension of Article 23 to products other wine and spirits, please refer to D. RANGNEKAR, *Geographical indications: a review of proposals at the TRIPs Council: extending Article 23 to products other than wine and spirits*, in ICTSD-UNCTAD, Issue paper no. 4, 2003.

⁵⁷ At this respect, please note that WTO Secretariat issued a note with the purpose of presenting a factual compilation of the issues raised and views expressed on the extension of the protection of geographical indications provided for in Article 23 of the TRIPs to products other than wines and spirits. Note WT/GC/W/546 and TN/C/W/25, May 18, 2005.

⁵⁸ For a complete analysis of the provisions of Article 23 of the TRIPs please refer to chapter 1, paragraph 2.5.2 of this dissertation.

World brought with them their food culture and it is natural that they continued to make the same products and use the same names to identify those products.

According to the proponents view, such freeriding brings at least two negative effects. The first is that goods produced outside the home region – being inevitably of lower quality – could threaten the reputation of both the product itself and the region which it is associated with (having the further consequence of reducing the price consumers are available to pay and the incentives for the producers to invest in the quality of products)⁵⁹.

The second is the risk of dilution of the name, with all the connected losses in revenue for producers due to the consumers' deception. On the opposite front, folks uphold that generalization of names is linked to the producers' negligence or inactivity. It is not a matter of inadequate protection⁶⁰.

At last, Article 22 of the TRIPs sets forth protection for geographical terms only when they are threaten by misleading or unfair behaviors. EU folks criticize this minimum level of protection on two basic grounds. The misleading test leads legal uncertainty as to enforcement of protection at the international level, because it leaves the judgment to the courts' discretion (as such, judges may reach different conclusions on whether the public is misled or not).

Moreover, on the basis of the actual provisions of Article 22 of the TRIPs, defense for geographical indications is made harsh. It is up to the plaintiff to prove to judicial

⁵⁹ For further analysis of the divergent positions on the extension of Article 23 of the TRIPs to products others than wine and spirits, explaining, among the others, the EU position concerning the effects of freeriding of geographical names which can be healed through an extensive system of protection, please refer to B. GRAHAM, *TRIPs: ten years later: compromise or conflict over geographical indications*, in Syracuse Sci. & Tech. L. Rep. 4, 2005.

⁶⁰ At this respect, opponents drafted a special example involving the name "parmesan" (which is among the most debated, sensitive and reclaimed by EU producers). Please refer to Note WT/GC/W/546 and TN/C/W/25, May 18, 2005, paragraph 41. They state: "*the term "parmesan" had been used worldwide for many decades as the generic term for hard white cheese. In fact, the term was so generic that the Members of the Codex Alimentarius wished to establish product-identity standards so that anyone worldwide could produce parmesan to internationally established standards. If "parmesan" was really such an important geographical indication, the purported owners could have tried to protect it in the United States as a certification mark, as had the owners of "Roquefort"* Such example triggered an immediate reaction, claiming that, while certification mark protection had been obtained for "Parmigiano Reggiano", this had not helped in providing protection for "Parmesan" since such protection would have conflicted with several pre-existing local trademarks consisting of stylistic versions of the term "Parmesan", even if that term was not itself protected. This is without prejudice to the example mentioned in chapter 3, paragraph 1 relating to the chance to challenge the unfair use within the US territories of the name "Parmesan", in light of the brand new time and space circumstances.

and/or administrative authorities that the public is misled or that an act of unfair competition occurs.

Opponents reply that should it be demonstrated that protection granted by Article 22 of the TRIPs to geographical names is insufficient, the financial and administrative costs (i.e. relabeling expenses and litigation costs) of implementing an extensive system of protection outweighs the benefits⁶¹.

The described conflicts prevented WTO negotiations to move forward and led to their failure creating a dead locked situation.

Regardless of this harsh truth, in light of all the arguments deeply analyzed as of now, the author's objective is to reinterpret the positions expressed within the WTO forum in order to find a "compromise" solution able to gather unanimous consensus.

⁶¹ On the analysis of the divergent concerns upon the completeness of Article 22 of the TRIPs with regard to the protection of geographical terms, please refer to T.L. STATEN, *Geographical indications protection under the TRIPs agreement: uniformity not extension*, in 87 J. Pat. & Trademark Off. Soc'y 221, 2005.

PART II**1. THE BRAND NEW (PROPOSED) PROTECTION OF GEOGRAPHICAL INDICATIONS IN THE GLOBAL MARKET UNDER THE TRIPS AGREEMENT**

The TRIPs geographical indications section should be amended in order to create a single extended discipline applicable to all food products. To make it clearer: Article 22 of the TRIPs should remain valid whereby it defines geographical signs, but the misleading test should be replaced by the strong level of protection currently provided by Article 23 of the TRIPs only in favor of wine and spirits. And these provisions should apply to all geographical names, compliant with the relevant definition and, to some extent, protected (or recognized) in their respective countries or origin. Moreover, each country, according to its domestic law, should undertake to implement the adequate legislative means to give effect to such provisions.

The author truly believes that the global forces are rowing all in the same direction, being the consumers' interests convergent instead of diverging. As here below explained, such a framework would make this proposed solution more than feasible. Nevertheless, since there are some sectors that are particularly sensitive (the dairy first but also the meat one), the author suggests to evaluate the possibility to provide some exceptions to the general extended level of protection. The exception consists in drafting a list of specific names (of course the list should be globally and carefully shared) that, on one side, cannot be deemed *tout court* generic, but, on the other side, can be used in a descriptive way, provided that the place of real origin is clearly displayed and they are not misleading (by way of example, "*Parmesan kind – product of California*").

This is the proposed solution and the author is confident that a genuine global commitment towards an extensive protection of geographical indications exists. Should someone be not yet convinced, neither in light of what already explained (i.e. the global significance of geographical terms, the strong basis already provided for by existing regional trade agreements, the recent acknowledgment and push by developing countries), there are further open points that can support this outcome and can reconcile the traditional conflicts between Old and New World countries.

1.1. Consumers' interest

The consumers and their acknowledgement are the lighthouse to reach a consensus on the extensive multilateral protection of geographical indications. Consumers all around the world show an increasing interest in the quality of food. They drive a “quality turn” in the economy. It starts to become common practice that even the average consumers expect high dietary, health and hygiene standards from the products they buy. In addition, they increasingly look for certified provenance, taste, environmental friendliness, animal welfare aspects and other individual product characteristics, often attributed to specific origin or production methods⁶².

It is not unlikely to claim that what is at stake now is the interests of the whole international community.

Given the above, a question naturally comes up to the reader's mind: if this is the global trend, why are there still divergences between EU and US? Why does the global consensus over geographical indications seem to be a prohibitive climb?

Someone can imagine an ordinary US family eating a dinner complete with side salad and white wine. The dad may ask his daughter to “pass the Chardonnay”, the mother may add “can I have some more parmesan on my spaghetti?” and the daughter may ask to complete her salad with some feta. From the traditional US perspective, it seems that – should the EU have its way on the field of geographical indications –

⁶² On the existence of this consumers trend towards quality food products, please refer to A. HAJDUKIEWICZ, *European agri-food quality schemes for the protection and promotion of geographical indications and traditional specialties: an economic perspective*, in *Folia Hort.*, volume 26, no. 1, 2014. The author further confirms that there is a connected growing interest of producers in using geographical indications as a tool to create competitive advantages.

The same matter is studied in the academia. Other folks argue that in the modern market consumers have become increasingly demanding. As a consequence, being able to build consumers confidence through accurate information about the origin of the product is economically valuable. Please refer to S. FUSCO, *Geographical indications: a discussion on the TRIPs regulation after the Ministerial Conference of Hong Kong*, in *12 Marq. Intell. Prop. L. Rev.*, 2008.

Also some Italian academia deals with this matter. Although this paper is mainly focused on the EU jurisdiction and aimed at showing the general importance of providing consumers with fair, clear and precise information on food products (as such, arguing the need to always improve proper legislation), some hints can be picked. While analyzing the regulations on geographical indications, the author underlines that globalization and standardization of productive methods causes a general and widespread shift towards “local” products, as synonymous of peculiar properties. The author also adds that, by displaying the link between the origin and the qualities of the product, geographical indications play a crucial role in responding to the consumers needs. Please refer to M. DI PIETRO, *La tutela del consumatore e gli obblighi di informazione nel diritto alimentare europeo*, in *Cultura e Diritti*, 2017.

such conversations could not take place, unless this family does some very particular shopping⁶³.

Still, such an example seems to be out of date and contrary to the current trends, even for US style. A new food culture is growing in the US implying an higher attention to quality and tasting properties, becoming every day more and more an integral part of a greater number of consumers⁶⁴.

Back to 2010, Professor Pollan⁶⁵ recorded the birth and growth of the “food movement” in the US. He acknowledges that in the modern era the circumstance that food security problems have been largely solved and people do not have to worry

⁶³ For such a clear example, the author thanks F.G. ZACHER, *Pass the parmesan: geographic indications in the United States and the European Union – can there be compromise?*, in 19 Emory Int'l Rev. 427, 2005. For sake of clarity, please note other authors note that, even if it is true that many consumers in the US are unaware of the full significance of geographical indications – particularly on products coming from a different country – but this conclusion cannot be generalized. At this respect, please refer to S. FUSCO, *Geographical indications: a discussion on the TRIPs regulation after the Ministerial Conference of Hong Kong*, in 12 Marq. Intell. Prop. L. Rev., 2008, cit.

⁶⁴ Please refer also to D. GIOVANNUCCI, E. BARHAM, R. PIROG, *Defining and marketing “local” foods: geographical indications for US products*, in the Journal of World Intellectual Property, volume 13, no. 2, 2010. The authors state that the seeds of interest in local food begin as soon as US people become nationally acquainted of their own regional foods and localized traditions. The paper focuses specifically on local foods, but this is a broad concept which incorporates various consumers needs: desire for freshness, support for the local economy and traditions, reduce transportation and processing affecting climate change, relationship with farmers, food safety, improved nutrition, better flavor, backlash against feelings of alienation and disconnection from the land.

The interesting topics in light of our dissertation are the authors’ arguments with regard to the means to secure local foods, whereas the “local” (with its broad meaning) represents the new consumers desire. The authors state that for “local” to work in the US, it is necessary to adopt modern models to secure the intellectual property contents of origin claims. Also learning from other jurisdictions experiences (i.e. *sui generis* system of protections), geographical indications can be conducive for “local” foods, since they are not owned, but attributed instead, as such granting even to small producers access to their marketing potentials.

⁶⁵ Please refer to M. POLLAN, *The Food Movement rising*, in New York Review of Books, May 20, 2010. Given all that, please note that someone in the academia underlines that although it is true that differences between EU and US in the food culture are continuously becoming thinner and thinner, in the field of *terroir* (which is the most relevant at our purposes) US folks are still uncertain about its meaning, which they do not fully share/understand. In any event, it cannot be denied that they are moving in that direction and the journey can become faster considering the role of and pushes from researchers and academics. Please refer to F. BRUNO, *Il diritto alimentare nel contesto globale: USA e UE a confronto*, 2018.

For sake of completeness, it is important to underline that the “Food Movement” is currently in force, despite the Trump Era and the nationalist/protectionists forces. Food Movement representatives state that they are still trying to join forces to actively resist the dragging to the past trends. Moreover, they keep on following the bright line between the interests of the rapidly declining sector of agribusinesses and the broader interests of the US (including the majority of its farmers, workers and eaters). Please refer to M. BITTMAN, M. POLLAN, O. DE SCHUTTER, R. SALVADOR, *Food and movement: expanding the movement for the Trump Era*, in Civileats, January 16, 2017.

about the access to food and – indeed – can easily have it is counted as a blessing. Although cheap food has been deemed good politics, it turns there are some significant costs (to the environment, public health, public purse, even culture) that cannot be ignored. Following the recognition of such issue (i.e. the industrial and massive food production is in need of reform), many voices are gathering together in the US as a coherent movement.

To sum up, Professor Pollan expressly claims that “*the food movement is identity, pleasure and, most notably, about carving out a new social and economic space removed from the influence of big corporations on one side and government on the other*”.

As overall effect of this movement, among others, the traditional role of consumers acquires important aspirations. Consumers start to carefully evaluate their buying decisions, being led by information and ethics, qualities and peculiar qualities, getting more satisfaction from what they eat.

Putting under the spotlight the new trend of consumers is crucial to our analysis. On the assumption that geographical indications represent the most suitable legal means to comply with (and satisfy) the consumers request being a guarantee of provenance, qualities and properties⁶⁶, it cannot be excluded that the stalled position of the US in the WTO negotiations upon the extension of protection granted to geographical indication for products other than wine and spirits can be overcome⁶⁷.

⁶⁶ Various folks study the topic of the link between geographical signs and information to consumers. When analyzing the overall contribution of geographical indications, they expressly state that the information conveyed by geographical indications make it possible to meet the new consumers criteria, by allowing the identification of products with added value and specific qualities with their provenance. As a consequence (as better explained in the next paragraph of this dissertation), geographical indications give consumers confidence in the origin of the product, synonymous with quality and special properties. Either way, something which they are ready to pay more for. Please refer to F. ADDOR, A. GRAZIOLI, *Geographical indications beyond wines and spirits – A roadmap for a better protection for geographical indications in the WTO TRIPS Agreement*, in the Journal of World Intellectual Property, volume 5, no. 6, 2002.

⁶⁷ Please note that pushes towards this direction come also from the US academia. Some folks underline that, in many ways, the US position in the WTO negotiations seems to contradict the encouragement US producers are getting from the US food agencies and governmental authorities to move away from production of homogeneous commodities and towards the production of value-added and region branded products that can increase revenues. They claims that geographical indications are just the support needed by producers who are willing to move away form commodity production and invest in a profitable niche market. Please refer to B.A. BABCOCK and R. CLEMENS, *Geographical indications and property rights: protecting value added agricultural products*, in Midwest Agribusiness Trade Research and Information Center, briefing paper, May 2004. In order to fill in with practical relevance such arguments, please note that many concrete examples of US bets on niche food products.

In fact, further to the brand new global consumers perspective, it seems acceptable that also systems like the US one can benefit from an extensive level of protection of geographical indications⁶⁸. Actually, a multilateral normative framework upon geographical signs would allow US producers to capitalize on the consumers trend to purchase lower volume, niche or specialty products in lieu of common place, mass produced items⁶⁹. In fact, either the geographical indications would protecting the existing US quality products protection, allowing them to become more and more

In addition to the names already mentioned throughout chapter 3 of this dissertation, Copper River Salmon from Alaska, Wisconsin Real Cheese, Taste of Iowa, Get Real Get Maine, Fresh from Florida and Maryland Seafood are just some examples.

To be honest, despite this promoted happy ever ending outcome, there are still some doubts in the academia with regard to the feasibility of an extensive level of protection of geographical indications for all food products. Some claims that extension of TRIPs provisions would never be realized. Please refer to B. GRAHAM, *TRIPs: ten years later: compromise or conflict over geographical indications*, in Syracuse Sci. & Tech. L. Rep. 4, 2005, cit.

Others believe that extending Article 23 of the TRIPs would not resolve the dispute between Old and New World countries. On the contrary countries should reach an agreement upon the proprietary nature of geographical indications and, then, adopt an uniform system reflecting this agreement. Please refer to T.L. STATEN, *Geographical indications protection under the TRIPs agreement: uniformity not extension*, in 87 J. Pat. & Trademark Off. Soc'y 221, 2005, cit.

Some others claim that the WTO is at the mercy of US for its success and the US are not likely to agree on any move in the area of geographical indications that may harm its economic interests without the promise of substantial gains in the future. Please refer to F.G. ZACHER, *Pass the parmesan: geographic indications in the United States and the European Union – can there be compromise?*, in 19 Emory Int'l Rev. 427, 2005, cit.

Moreover, although not dealing precisely with the extension of Article 23 of the TRIPs agreement to all food products, other authors believe that conflicting positions between EU and US in the field of geographical indications are incompatible. The regulatory approaches (respectively, *sui generis* system of protection and trademark law) are not likely to be reconciled. An interesting paper closes with a question: “*what was one of the key products causing such consternation?*”. The answer is the Feta cheese. Such conclusive remarks, in the author's personal opinion, leaves the door open to enhancement of a multilateral extensive system of protection of geographical indications, should, as it is in the proposed model, the descriptive use of the most sensitive names (the one related to products of the dairy and meat sectors) be to some extent preserved. Please refer to B. FARRAND, *Two continents, divided by deep philosophical waters? What geographical indications pose a challenge on the completion of the TTIP*, in European Journal of Risk Regulation, volume 7, no. 2, 2016.

⁶⁸ In order to fully understand the importance of granting multilateral protection to geographical signs, which turns out to be reciprocal and not to the univocal benefit of EU, in addition to what just described with regard to the US internal circumstances, it is worth noticing that a portion of EU consumers begins to recognize American and Australian wine, among other products, and to identify them by their origin and quality. Please refer to S. FUSCO, *Geographical indications: a discussion on the TRIPs regulation after the Ministerial Conference of Hong Kong*, in 12 Marq. Intell. Prop. L. Rev., 2008, cit.

⁶⁹ At this respect, please refer to J.M. WAGGONER, *Acquiring a European taste for geographical indications*, in 33 Brooklyn Int'l L. 569, 2008.

recognizable by sophisticated consumers also abroad and supporting the producers willing to keep and create a sense of place. Various economic benefits emerge.

It is a matter of fact that the whole world is moving forward to the recognition of the intellectual property rights entailed by geographical indications. Therefore, US negotiators should catch the long-term benefits (i.e. *inter alia*, development of niche products, investment in quality and healthy productions) that a multilateral protection of geographical names can bring rather than being tied to eventual immediate commercial/economic losses.

1.2. The economic value of geographical indications

The previous paragraph ends by claiming that a multilateral and extensive system of protection of geographical indications for food products is not only compliant with but also desirable to satisfy the global consumers' needs, on the assumption that geographical indications themselves are the most suitable legal means to communicate to consumers the information they seek.

At the same time, such a system approaches producers' interests: it provides them with significant economic benefits, allowing them to leverage on the information provided to consumers. Geographical indications are the most direct means to capture (and monetize) the value that consumers – at the local, national and international level – place on a product because of its provenance and related properties. In light of the messages conveyed through this dissertation related to the extension of TRIPs provisions on the protection of geographical indications, we have taken this role of geographical indications for granted, thus it is worth explaining it and its economic value⁷⁰.

⁷⁰ For a general analysis of the economic value of geographical indications and the trade relevance connected thereto, please refer to F. ADDOR, A. GRAZIOLI, *Geographical indications beyond wines and spirits – A roadmap for a better protection for geographical indications in the WTO TRIPS Agreement*, in the *Journal of World Intellectual Property*, volume 5, no. 6, 2002, cit.; S. CALBOLI, *Of markets, culture and terroir: the unique economic and culture-related benefits of geographical indications of origin*, in *International Intellectual Property, a handbook of contemporary research* (edited by D.J. Gervais), 2015; S. CALBOLI, *Time to say local cheese and smile at geographical indications of origin? International trade and local development in the United States*, in 53 *Hous. L. Rev.* 373, 2015-2016.

For sake of completeness, please note that, within the academia, some concerns are expressed towards the *tout court* economic value of geographical indications. Some folks appreciate the benefits connected to the use of geographical indications (i.e. information to consumers, premium prices and possibility for producers to reinvest the premium incomes in quality methods and processes).

The beneficial patch created by geographical indications is composite. First, they can even out information asymmetries, by making consumers able to distinguish between authentic products and imitations produced outside the relevant geographic area. If truly and precisely informed, consumers would demand for authentic geographic denominated products and be willing to spend premium prices on them⁷¹.

In connection, the enhancement of a system of extensive protection of geographical indications would transit into the producers' interests, since they become able to control and prevent the use of terms that are identical or similar to the geographical names applied to their products. Indeed, geographical names are less exposed to the risk of turning into generic names of products. Lastly, producers of geographic denominated products would be incentivized to invest in high quality products, preserving and also establishing specific niche markets⁷², all this by reinvesting the premium incomes obtained⁷³.

However, they believe that geographical indications are not by themselves decisive and can be truly effective only when they are part of a broader successful action. In other words, the usefulness of geographical indications rules largely depends on the strength of the reputation of the name, whether the name has been promoted (or it is going to be), the qualifications of the organization that manages the name, the amount of resources that can be addressed to the geographical indications. Please refer to A. ZAPPALAGLIO, *The protection of geographic indications: ambitions and concrete limitations*, in 2 Edinburgh Student L. Rev. 89, 2015.

⁷¹ A study committed by the EU Commission and carried out on a variety of case studies (although not on the entire universe of EU geographical indications considering the high number) finds out that – among the other economic benefits – in most cases (even if taking into account different marketing channels and practices used) products marked with geographical indications achieve price premium over the corresponding standard products. Please refer to ARETE RESEARCH AND CONSULTING IN ECONOMICS, *Study on assessing the added value of PDO/PGI products*, 2013.

⁷² On the function of geographical indications as preserving and creating niche markets, by capturing the unique value of the names, please refer to R. BELMIN, F. CASABIANCA, J.M. MEYNARD, *Contribution of transition theory to the study of geographical indications*, in Environmental Innovation and Societal Transitions, volume 27, 2018.

According to the authors, such effect is made possible if adopting a broad definition of the *terroir* conveyed in the geographical indications. *Terroir* is not a static space, wrapped in a cotton wool and incapable of change. On the contrary, it is a dynamic, evolving space where organized actors can innovate, by making use of the specific features of the environment and local resources. All these actions can drive an innovative process and lead to product characteristics and practices that stand apart from the agro-industrial sector.

⁷³ If this is the framework of the economic value attached to geographical indications, as presented by legal specialists, the same statements are confirmed under an economic/scientific perspective. Following some theories developed by OECD (Organization for Economic Cooperation and Development) and the Shapiro model on consumers information and market efficiency, some folks uphold a specific thesis. It starts from the assumption that geographical indications are distinctive signs that can be used to institutionalize reputation of products. It is through this function of signaling certain quality standards (for the purposes of this dissertation connected to the geographical origin) that consumers are induced to return on and purchase at higher prices the region-identified products.

All the arguments expressed so far address the relevance and effectiveness of geographical indications from various perspectives⁷⁴. It is clear that it can be taken the most out of these arguments only if a proper coordination of legislations and policies is implemented. As of now, such an outcome turns out to be closer to utopia, in light of the systematic interpretation of the patch at stake, it seems to approach the next future reality.

On one side, as shown, the advantages are globally shared and are not exclusively related to the EU products. Therefore, should a compromise solution is adopted in the WTO forum with regard to the protection of geographical indications and, in particular, a solution that grants extended protection to all food products, at the same time allowing the descriptive use of certain selected geographical names (operating in the most relevant sectors), the matter of facts can be beneficial for all the involved players.

The US would not be negatively affected by this system since they would preserve the use of some spread names (such as Parmesan or Feta), but at the same time are incentivized to invest in complementary niche markets and in the promotion of their domestic products which are everyday more appreciated and requested mainly nationally (with the aim of becoming the same on the global level)⁷⁵.

The added value so derived may lead to a differentiation based on products “qualities” and consequently to the establishment of niche markets. Please refer to C. BRAMLEY, J.F. KIRSTEN, *Exploring the economic rationale for protecting geographical indications in agriculture*, in *Agrekon*, volume 46, no. 1, 2007.

⁷⁴ In addition to anything explained so far, please consider that some studies seek to demonstrate the heterogeneous effectiveness of geographical indications. Besides being undoubtedly a source of revenues for producers, geographical indications can contribute as means of protection of cultural heritage of a geographical area and the relevant environment. This function is not fully accomplished yet, but data shown that it is on its way. Please refer to R. PALMA, *Agro-ecologia e indicazioni geografiche tra mafia e razionalità nel diritto dell’UE e dell’OMC: “reinventare” le designazioni di origine per preservare l’economia rurale, il patrimonio culturale e l’ambiente*, in *Rivista di Diritto Industriale*, no. 6, 2017.

Without being exhaustive, but just for sake of completeness, please note that many other folks put under the spotlight the matter related to geographical indications as a means to support rural communities and/or traditional knowledge of areas and their inhabitants and fostering sustainable development and environment preservation. Among the other, please refer to S. CALBOLI, *Of markets, culture and terroir: the unique economic and culture-related benefits of geographical indications of origin*, in *International Intellectual Property, a handbook of contemporary research* (edited by D.J. Gervais), 2015, cit. For further analysis on the specific role of geographical indications in the safeguarding of traditional knowledge, please refer also chapter 2, footnote 3 of this dissertation.

⁷⁵ On this point, it is worth mentioning a paper of the Italian academia. It is an analysis of the international protection of geographical indications in light of preserving quality products. The author takes into account the developments of multilateral negotiations and the role of bilateral agreements

The EU producers would be reassured that – besides the names included in the list allowing for a descriptive use – the risks of dilution of the value attributed to geographical names and their generalization are reduced.

Furthermore, and this arguments builds the bridge to the very last paragraph of this chapter, US should not worry about the costs of implementation of such a system (in terms of registration procedures, recording data, controls and protection) since the system is already filled with an adequate level of protection.

1.3. The adequateness of the US legal system in the field of geographical indications

We have already deeply analyzed the US system of protection of geographical indications. Thus, there is no point in repeating everything that has already been said⁷⁶. Nevertheless, in order to close the analysis of the reasons why a multilateral and extensive system of protection of geographical indications (although with some minor concessions from the EU side) may comply with the current global trend and be reconciled with the existing US legislation, it is possible to infer that legal background is not as distant from the EU model as usually claimed.

It is true that, if analyzed from the surface, the US system seems divergent from the EU one, since, instead of *sui generis* rules, it adopts a “private” approach, based on Lanham Act, where Geographical Indications are protected by mainly two categories of trademarks, certification and collective marks. These can be recognized to the extent that they, respectively, certify certain qualities (including the geographic provenance) or are used by members of a specific group, who meet minimum requirements for being part of the relevant association.

The analysis has shown that, regardless their “formal” private nature, in practice,

in enhancing TRIPs plus provisions, even if arguing that such agreements mostly pursue economic interests linked to specific geographical names rather than quality of food products in general. However, what looks interesting at our purposes is that the author – following the path of other researchers – admits that the multilateral scenario can face improvements (meaning that it can accept a strong protection of geographical indications), since more and more US producers and stakeholders prove to be interested in investing in quality food products. Please refer to A.G. MICARA, *La tutela internazionale delle indicazioni geografiche relative a prodotti alimentari nella prospettiva della tutela della qualità*, in *La tutela multilivello del diritto alla sicurezza e qualità degli alimenti*, 2012, cit..

⁷⁶ In addition to any of the arguments repeated herein, please refer to Chapter III of this dissertation for further analysis on the US system of protection of geographical indications and the points of contacts with the EU system.

differences with EU geographical indications blurry. With regard, in particular, to certification marks, they are generally owned and managed by public entities, they shall be mandatorily licensed to all who meet the standard and, in case a transfer occurs, the transfer shall not affect the basic requirements which shall not vary. Their recognition is open also to foreign products. All of this means that EU organizations entrusted of taking care of protecting the market value of their EU products⁷⁷ can already rely on these kinds of mark within the US territory.

Moreover, what is of greatest interest – and that is a direct consequence of being the US a common law based jurisdiction – is that geographic marks do not need to be registered: they can be recognized simply in force of continuous use and exploitation by commercial entities. The only barrier to recognition might be genericness of the name. Genericness thought shall be evaluated in a precise time and space and in light of the public perception. Therefore, even if US parties, usually uphold that EU geographical terms (and/or their translation) are generic descriptive term of a kind of product for US consumers, it cannot be excluded that EU geographic terms usually deemed generic from the US perspective can turn into distinctive, in light of new and growing sophistication of consumers.

Once a geographic name is recognized (even if not registered), the free ride of the name (or of similar name) by competitors is prevented by measures against unfair competition under the Lanham Act. Measures that are currently empowered also by the new possibility to enforce Federal rules specifically preventing mislabeling of

⁷⁷ Such a statement is quite sensitive since it involves some issues relating to the proprietary nature of geographical indications. Any trademark, in principle, has its owner. It would overcome the scope of this dissertation to inquiry upon this matter: the statement used in this paragraph is limited to share the message (crucial to the extent of this dissertation) that geographical names can be protected in the US system within the cover of the trademark (and certification marks in particular) system and be provided with a level of protection similar to the offered by the EU rules.

For sake of completeness, please note that the matter of defense of EU geographical names outside the EU borders has been recently discussed in the Italian academia. Some folks recognize that geographical indications do not have owners but, rather, are available to all who comply with the basic requirements. Nevertheless, when it comes to defend the names outside the EU borders, each member State turns out to be the central point. Since article 13, paragraph 3 of the EU Regulation no. 1151/2012 member countries “*shall take appropriate administrative and judicial steps to prevent or stop the unlawful use of protected designations of origin and protected geographical indications*”, the same principle can be extended to the protection even outside the EU borders. In other words, member States (and the designated authorities) should be entrusted of defending the geographical indications connected to their territories against misappropriation and take all the necessary measures (including the registration of trademark if so requested) to avoid breach and violations. Please refer to A. GERMANÒ, *Sulla titolarità dei segni DOP e IGP*, in *Diritto Agroalimentare*, volume 2, 2017.

food products (generally managed solely by public Authorities).

The *POM Wonderful v. Coca-Cola* case in fact has opened the way for the intersection between two Federal Laws, allowing private action under the Lanham Act alleging unfair competition from false or misleading food label regulated by the FDCA, increasing companies chance to obtain relief when injured by misleading claims of competitors.

Of course, being a litigation matter, the outcome of eventual suits is not fully predictable. Still, it represents a chance already available within the US system: a chance that can be exploited as a kind of protection against “evocative” use (similar to what expressly provided under EU Regulation).

All these elements combined together demonstrate that there may be room for real discussion between EU and US about the enhancement of a system of mutual recognition of geographical indications.

2. CONCLUSIVE REMARKS

All the claims carried out throughout the dissertation lead to the conclusion that a multilateral “extensive protection of geographical indications” could become reality. This would be possible in a compromising perspective, whether a general extended level of protection similar to the one provided for by Article 23 of the TRIPs is granted to all food products. And that is complemented with a list of specific names that, on one side, cannot be deemed *tout court* generic, but, on the other side, are strategically important for some sectors, and can be used in a descriptive way, provided that the place of real origin is clearly displayed and they are not misleading (by way of example, “*Parmesan kind – product of California*”).

The reason why I do believe this outcome can turn into reality is that, regardless of the “traditional” opposing grounds, it is a matter of fact (and I hope that the message is loud and clear) that the whole world is moving towards an extensive level of protection of geographical.

Yet it is shown by the various bilateral trade agreements entered into by the EU with large economies (also from the New World) providing for specific systems of protection of geographical indications accepted when the economic benefits converge.

The statements from developing countries which are everyday more willing of accessing new market with their traditional and cultural heritage products and seek for a proper legal mean to grant the access and, at the same time, capitalize on their value.

The analysis upon the US system of law which it has been demonstrated is not so distant from the EU as it seems from the surface, showing that the value of geographical indications is recognized as is also in that jurisdiction and its extensive application is only a matter of economic and political diverging interests.

The new food movement raised and alive (not yet expunged by the Trump era) within the US borders which suggests to go “local” and the related interest of producers to shift towards a quality agriculture and promote their domestic products. Thus, even small producers affectionate to their sense of territory can invest in quality products and establishing niche markets, being able to rely on the guarantee of extensive protection also outside the US borders. In additions, the economic interests (often

concealed behind claims of genericness of geographical names and protectionist interest of EU producers who are the only one provided with large number of geographical names) of large US food companies, able to drive the lobby on the political forces, can be overturned. By carefully drafting the mentioned list of geographical names that can still be used in a descriptive manner, provided that the true origin is clearly displayed, large food companies would not be affected in their respective core business. Find an agreement upon the name worth being included in the list is likely to be a problematic issue, but this is a different story.

I realize that there are lots of open questions and maybe exceptions to each of the arguments expressed herein and all of this might look as a bite difficult to swallow. Still, it is possible to open constructive discussions which are not limited to the fronting exceptions or concerns but, rather, take into account future global benefits and consumers trends. I truly believe some of the reflections carried out in this dissertation may serve as a basis to move forward within the WTO upon the completion of a multilateral and extensive system of protection of geographical indications. It remains understood that, since geographical indication affects various sectors and involves various interests ranging from legal, to political, social and economic, further studies from academia, researchers and stakeholders would be crucial in contributing to enrich the arguments with data and theories and making the negotiating machine restart being provided with all the necessary informative materials and demonstrations.

REFERENCES

SUMMARY: 1. Introduction – 2. Part I: laws and regulations – 2.1. International – 2.2. European Union – 2.3. Unites States – 3. Part II: doctrine – 4. Part III: case law – 4.1. EU case law – 4.2. US case law – 5. Part IV: web links.

1. INTRODUCTION

This section includes all the references quoted/mentioned throughout the text of the dissertation. For sake of clarity, please note that it is basically structured as follows: the first part recalls the rules and regulations applicable to the subject matter, the second part gathers together all the relevant doctrine, the third one lists the case law which supported the analysis and the last one takes note of the web links collected so far.

In particular, the first part is devoted to the list of laws and regulations applicable to geographical indications at all level (i.e. international agreements and national rules and acts), together with the other related laws mentioned throughout the analysis since they are to some extent connected to the matter.

With regard to the “doctrine” part, it is quite heterogeneous, since it includes text books on a single topic, reports and positions issued by administrative bodies and institutions, papers and essays derived, mainly, from the EU and US academia and simple statements published in official journals.

The case law part is divided into two sections: one devoted to EU judgments (including also those released by domestic courts) and the US jurisprudence, both federal and state.

The web links part is basically a list of links to the web pages of administrative and public bodies (i.e. WTO or EU Commission or US Patent Office) providing open access to position papers and other information.

2. PART I: LAWS AND REGULATIONS

2.1. International

- The Paris Convention for the Protection of Industrial Property was concluded in 1883 and revised at Brussels in 1900, at Washington in 1911, at The Hague in 1925, at London in 1934, at Lisbon in 1958 and at Stockholm in 1967, and was

amended in 1979;

- The Madrid Agreement for Repression of False and Deceptive Indications of Source on Goods, was concluded in 1891 and revised at Washington in 1911, at The Hague in 1925, at London in 1934, at Lisbon in 1958 and at Stockholm in 1967;
- Lisbon Agreement for the Protection of Appellations of Origin and their International Registration concluded in 1958, was revised at Stockholm in 1967, and amended in 1979 (the Diplomatic Conference for the Adoption of a New Act of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration which took place from May 11 to 21, 2015, adopted the Geneva Act of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration);
- The Agreement on Trade-Related Aspects of Intellectual Property Rights: Annex 1C of the Marrakesh Agreement Establishing the World Trade Organization (hereinafter, “WTO”). It was signed at the Marrakesh ministerial meeting in April 1994, as one of the result of the 1986–94 Uruguay Round negotiations;
- North American Free Trade Agreement Implementation Act of December 8, 1993, being a multilateral agreement entered into by and between USA, Canada and Mexico;
- EU-Japan Free Trade Agreement of July 17, 2018;
- CETA, comprehensive trade agreement entered into by and between EU and Canada, of October 30, 2016;
- Doha Ministerial Declaration, WT/MIN(01)/DEC/1, November 20, 2001;
- Report by Director-General of WTO, WT/GC/W/633, TN/C/W/61, April 21, 2011;
- Submission by Argentina, Australia, Canada, Chile, Dominican Republic, Ecuador, El Salvador, Honduras, Mexico, New Zealand, Chinese Taipei and the United State, TP/IP/W/10 first presented on April 1, 2005 and then revised several times;
- Communication from Hong Kong, China, TN/IP/W/8 of April 23, 2003;
- Communication from the European Communities, TN/IP/W/11 of June 14, 2005;
- Communication from Albania, Brazil, China, Colombia, Ecuador, the European Communities, Iceland, India, Indonesia, the Kyrgyz Republic, Liechtenstein, the Former Yugoslav Republic of Macedonia, Pakistan, Peru, Sri Lanka, Switzerland, Thailand, Turkey, the ACP Group and the African Group, TN/IP/W/52 of July 19, 2008;
- Report by the chairman of the Special Session of the TRIPS Council, Dacio Castillo of Honduras (ref. TN/IP/23) to the Trade Negotiations Committee of December 3, 2015;
- Note of the WTO Secretariat WT/GC/W/546 and TN/C/W/25 of May 18, 2005.

2.2. European Union

- Regulation (EU) No 1169/2011 of the European Parliament and of the Council of 25 October 2011 on the provision of food information to consumers, amending Regulations (EC) No 1924/2006 and (EC) No 1925/2006 of the European Parliament and of the Council, and repealing Commission Directive 87/250/EEC, Council Directive 90/496/EEC, Commission Directive 1999/10/EC, Directive 2000/13/EC of the European Parliament and of the Council, Commission Directives 2002/67/EC and 2008/5/EC and Commission Regulation (EC) No 608/2004 Text with EEA relevance (hereinafter, the “Food Information Regulation”);
- Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark;
- Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs;
- Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs;
- Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs;
- Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organization of the markets in agricultural products;
- Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008 on the definition, description, presentation, labelling and the protection of geographical indications of spirit drinks;
- Commission Regulation (EC) No 2527/98 of 25 November 1998 supplementing the Annex to Regulation (EC) No 2301/97 on the entry of certain names in the 'Register of certificates of specific character' provided for in Council Regulation (EEC) No 2082/92 on certificates of specific character for agricultural products and foodstuffs [Mozzarella (TSG)];
- Commission Regulation (EU) No 97/2010 of 4 February 2010 entering a name in the register of traditional specialities guaranteed [Pizza Napoletana (TSG)];
- Commission implementing Regulation (EU) No 1174/2014 of 24 October 2014, entering the name Piadina Romagnola/Piada Romagnola (PGI) in the register of protected designations of origin and protected geographical indications;
- Commission Regulation (EU) No 1122/2010 of 2 December 2010 entering a designation in the register of protected designations of origin and protected geographical indications [Gouda Holland (PGI)];

- Regulation (EC) No 882/2004 of the European Parliament and of the Council of 29 April 2004 on official controls performed to ensure the verification of compliance with feed and food law, animal health and animal welfare rules;

2.3. United States

- Trademark Act of 1946, as Amended (Public Law 79-489, Chapter 540, Approved July 5, 1946; 60 Stat.427 (hereinafter, the “Lanham Act”);
- US Reg. No. 1200770, certifying that the citrus fruit was grown in the State of Florida under specified standards or are processed or manufactured wholly from such citrus fruit;
- US Reg. No. 1959589, certifying blue mould or white cheese produced within the county boundaries of Leicestershire, Derbyshire and Nottinghamshire, England, with no applied pressure, forming its own crust or coat and made in cylindrical form from full cream milk produced by English dairy herds,
- US Reg. No. 1896683, certifying that the goods originate in the Parma-Reggio region of Italy, specifically the zone comprising the territory of the provinces of Parma, Reggio Emilia, Modena and Mantua on the right bank of the river Po and Bologna on the left Bank of the river Reno,
- US Reg. No. 2014627, certifying that ham is made, processed and packaged in Parma, Italy,
- US Reg. 1709019, certifying yellow granex type of onion grown by authorized growers within the Vidalia region in Georgia as defined in the Georgia Vidalia Act of 1986;
- US Reg. 2685923, certifying a blend of tea containing at least 60% tea originating in the Darjeeling region of India;
- US Reg. 1097779 collective mark for “Frankfurter Apfelwein”, apple wine from the city of Frankfurt in Germany;
- US Reg. 73323851, collective mark for “Florida Orange Growers – Mark of Purity”;
- US Reg. 2914308, filed in 2004 by the State of Idaho, Potato Commission State Agency;
- US Reg. 1709019, filed in 1990 by the Georgia Department of Agriculture and certifying yellow granex type of onion grown by authorized growers within the Vidalia region in Georgia as defined in the Georgia Vidalia Act of 1986;
- US Ser. 73565826, filed in 1987 by Vermont Department of Agriculture;
- US Ser. 76092644, filed in 2000 by Texas Department of Agriculture;
- US Ser. 85516899, filed in 2012 by Louisiana Department of Wildlife and Fisheries.

- Food, Drug, and Cosmetics Act (hereinafter, “FDCA”) and subsequent amending statutes, codified into Title 21, Chapter 9 of the United States Code;
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4. PART III: CASE LAW

4.1. EU case law

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PART IV: WEB LINKS

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