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Time and Place: Key Factors to Consider When Assessing the Validity of PDOs

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In a recent dispute concerning the use of the geographical indication (GI) and Protected Designation of Origin (PDO) “Salaparuta” for Sicilian wine, the Italian Supreme Court has deferred to the Court of Justice of the European Union (CJEU) in order to determine the validity of this GI/ PDO as well as if co-existence is possible between the original users/ owners of the “Salaparuta” PDO and subsequent wineries that have used this on their labelling and packaging.

The first, and most significant, issue at play here concerns Article 43.2 of Regulation (EC) No. 479/2008 (Article 43.2), which reads as follows:

“A name shall not be protected as a designation of origin or geographical indication where, in the light of a trademark’s reputation and renown, protection is liable to mislead the consumer as to the true identity of the wine.”

Relying on this provision, Duca di Salaparuta’s complaint was, despite the fact that they own trademarks containing the word “Salaparuta”, several other wineries have not only been using this word, but featuring it prominently on the packaging of their wine, even exceeding the prominence of more pertinent details such as brand name, etc. The use of this word, in conjunction with the prominence with which it was displayed, lead Duca di Salaparuta to argue that such labels were misleading and deceptive.

Article 43.2 came into effect on 1 August 2009 and Salaparuta received EU protection as a GI/ PDO shortly after on 8 August 2009. However, both the Court of Milan and the Milan Court of Appeal held that this provision could not be used to negate the status of Salaparuta as a PDO since this provision was not in force when Salaparuta received national protection in 2006. Despite Duca Di Salaparuta having valid trademark registrations for Salaparuta dating back to 1989 and being a wine brand since the nineteenth century, no such protection was provided to trademarks under previous regulations or Italian legislation. Therefore, the fact that Salaparuta had protection as a PDO before Article 43.2 came into effect rendered Duca di Salaparuta’s arguments ineffective.

In response to this, Duca di Salaparuta relied on previous legislative provisions to argue that the current policy vis-à-vis PDOs espoused by Article 43.2 can and should be applied retroactively. In order to make this point, they relied on legislation implemented elsewhere in the agri-food sector. In this instance, it was Article 14.3 of Regulation (EEC) No 2081/9 (Article 14.3) as this established that previous trademarks with established reputation could prevent protection of

anything as a PDO/ GI. While this was not ever explicitly applied to the wine sector in the previous wine regulation (No. 1493/1999), Duca di Salaparuta argued that the principles from Article 14.3 should be applied in a uniformed and systematic fashion across all agri-food sectors.

The arguments put forward by Duca di Salaparuta subsequently prompted the Italian Supreme Court to defer this matter to the CJEU so, as of yet, there has been no definitive ruling on these issues surrounding PDOs/ GIs. Given that the CJEU will have to decide if Article 43.2 can have retroactive effect, it will be interesting to see what final decision is made as it will inevitably impact how smaller brands can market their products in order to compete with larger and more established brands. It should be noted, however, that the scale of such change is only aimed at the impact of Article 43.2 on Italian legislation, particularly in the agri-foods sector. So, should the CJEU decide in favour of Duca di Salaparuta, it will be interesting to see if this would have retroactive application to prevent PDOs competing with trade marks.

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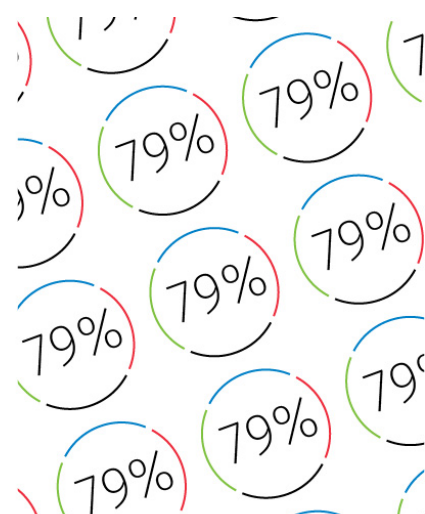
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