

Case C-341/24

Summary of the request for a preliminary ruling pursuant to Article 98(1) of the Rules of Procedure of the Court of Justice

Date lodged:

8 May 2024

Referring court:

Corte suprema di cassazione (Italy)

Date of the decision to refer:

8 May 2024

Appellant:

Duca di Salaparuta SpA

Respondents:

Ministero dell'Agricoltura, della Sovranità Alimentare e delle Foreste

Consorzio volontario di tutela dei vini DOC Salaparuta

Baglio Gibellina Srl

Cantina Giacco Soc.coop. agricola

Madonna del Piraino Soc. coop. agricola

Subject matter of the main proceedings

The main proceedings concern an application for a declaration of invalidity of the registration of a PDO [(protected designation of origin)] in the wine sector and of the recognition of the relevant Italian DOC [(Denominazione di origine controllata (controlled designation of origin))] at national level. In support of the application, it is contended that such designations are deceptive and/or applied for in bad faith and, in any case, interfere with the trade marks of others.

Subject matter and legal basis of the request

The request for a preliminary ruling concerns the interpretation of Regulations (EC) Nos 1493/1999 and 1234/2007 and Regulation (EU) No 1308/2013 and seeks to determine the regime applicable for verifying the validity of the registration, effected in 2009, of a PDO for wines where the name was already recognised before the entry into force of Regulation (EC) No 1234/2007. That name interferes with an earlier trade mark with a reputation and is, therefore, liable to mislead consumers as to the identity of the wine.

By its first question, the referring court asks whether, in such a case, the provisions of paragraph 2(b) of Section F of Annex VII to Regulation (EC) No 1493/1999 should apply and, consequently, whether such a registration is permitted, or whether the provisions of Article 118(k) of Regulation (EC) No 1234/2007, Article 43(2) of Regulation (EC) No 479/2008 and Article 101(2) of Regulation (EU) No 1308/2013 should apply, and consequently such a registration is not permitted.

The second question concerns only the possible situation where the Court of Justice holds that the provisions of Section F of [Annex VII to] Regulation (EC) No 1493/1999 apply for verifying the validity of the registration of the PDO in question. The referring court asks whether, in that case, there are rules other than those latter provisions that result in the invalidity of a PDO or exclude its protection where that PDO interferes with an earlier trade mark with a reputation and is therefore liable to mislead consumers as to the identity of the wine.

Questions referred for a preliminary ruling

‘1. ... Are PDO/PGI registrations, in the wine sector, of designations that existed prior to Regulation (EC) No 1234/2007 – subsequently replaced by Regulation (EC) No 1308/2013 – such as, in particular, the PDO ‘Salaparuta’ PDO-IT-A0795 of 8 August 2009, subject – in terms of the impediment to registration based on an earlier trade mark that, because of its reputation and renown, is liable to render the PDO/PGI in question misleading (‘protection is liable to mislead the consumer as to the true identity of the wine’) – to Article 43 [paragraph 2] of Regulation (EC) No 479/2008, *recte* [Article] 118k of Regulation (EC) No 1234/2007 (then Article 101, [paragraph 2,] of Regulation (EU) No [1308]/2013), which excludes protection of the PDO or PGI where the name in question is liable to mislead the consumer, ‘in the light of a trade mark’s reputation and renown’, or is that rule inapplicable to names already enjoying national protection prior to unitary European registration being granted, in application of the principle of legal certainty (Court of Justice, judgment of 22 December 2010, Case C-120/2008, [*Bayerischer Brauerbund*]), according to which a factual situation must, as a general rule, unless otherwise expressly provided, be assessed in the light of the legal rules in force at the time when the situation obtained, with the consequent application of the earlier regulatory

situation as laid down in Regulation (EC) No 1493/1999, and with the conflict between the designation of origin and the earlier trade mark to be resolved on the basis of the provisions of that legislation, laid down in Section F [paragraph] 2(b) of Annex VII to that regulation?

2. If the answer to the first question affirms the necessary application of Regulation (EC) No 1493/1999 to the factual situation at issue in the present case, ... do the rules laid down in Section F [of Annex VII] to Regulation (EC) No 1493/1999, which are intended to regulate the conflict between a trade mark registered for a wine or a grape must that is identical to protected designations of origin or geographical indications for a wine, exhaust all possible circumstances of coexistence between the different signs and all possible mechanisms providing protection for the wine names, or does there still exist a possible situation where later PDOs or PGIs might be invalid or not subject to protection, in cases where the geographical indication is liable to mislead the public as to the true identity of the wine because of the reputation of an earlier trade mark, by virtue of the general principle of non-deceptiveness of distinctive signs?

Provisions of European Union law relied on

Charter of Fundamental Rights of the European Union, and in particular Article 17; Regulation (EEC) No 2081/92, and in particular Articles 14 and 17; Regulation (EC) No 1493/1999, and in particular Articles 48, 52, 54 and Annex VII; Directive 2000/13/EC, and in particular Article 2; Regulation (EC) No 753 /2002, and in particular Article 28; Regulation (EC) No 510/2006, and in particular Articles 3 and 14; Regulation (EC) No 1234/2007, and in particular Articles 118b, 118i, 118k, 118l, 118s and 118u; Regulation (EC) No 479/2008, and in particular Articles 43, 44, 51 and 54; Regulation (EU) No 1151/2012; and Regulation (EU) No 1308/2013, and in particular Articles 101 and 107.

Provisions of national law relied on

The referring court refers to various Italian legislative texts on the subject, but without listing them in full, namely: legge 10 febbraio 1992, n.164 – Nuova disciplina delle denominazioni d’origine dei vini (Law No 164 of 10 February 1992 – New rules on designations of origin for wines), and in particular Article 1; decreto del Presidente della Repubblica 20 aprile 1994, n. 348 – Regolamento recante disciplina del procedimento di riconoscimento di denominazione d’origine dei vini (Presidential Decree No 348 of 20 April 1994 – Regulations governing the procedure for the recognition of designations of origin for wines); decreto legislativo 10 febbraio 2005, n. 30 – Codice della proprietà industriale (Legislative Decree No 30 of 10 February 2005 – Industrial Property Code), pursuant to Article 15 of legge 12 dicembre 2002, n. 273 (Law No 273 of 12 December 2002), and in particular Articles 14 and 29; decreto legislativo 23 giugno 2003, n. 181 – Attuazione della direttiva 2000/13/CE concernente l’etichettatura e la presentazione dei prodotti alimentari, nonché la relativa

pubblicità (Legislative Decree No 181 of 23 June 2003 – Implementation of Directive 2000/13/EC [on the approximation of the laws of the Member States] relating to the labelling, presentation and advertising of foodstuffs), and in particular Article 2; decreto legislativo 8 aprile 2010, n. 61 – Tutela delle denominazioni di origine e delle indicazioni geografiche dei vini (Legislative Decree No 61 of 8 April 2010 – Protection of designations of origin and geographical indications of wines), implementing Article 15 of legge 7 luglio 2009, n. 88 (Law No 88 of 7 July 2009); and decreto legislativo 12 dicembre 2016, n. 238 – Disciplina organica della coltivazione della vite e della produzione e del commercio del vino (Legislative Decree No 238 of 12 December 2016 – Organic regulation of the cultivation of vines and the production and marketing of wine).

Succinct presentation of the facts and procedure in the main proceedings

- 1 It emerges from the request for a preliminary ruling that the appellant in the main proceedings is a wine-producing undertaking that is the owner of certain trade marks distinguishing the wines it produces. In 2016, it brought legal action, inter alia, against the respondents in the main proceedings before the Tribunale di Milano (District Court, Milan) requesting, specifically, that the registration of a PDO granted in 2009 and the recognition of an Italian DOC granted in 2006 be declared null and void: it argued that those designations are misleading and/or applied for in bad faith and, in any event, interfere with the appellant's trade marks, which were registered in 1989 and enjoy a reputation. In fact, both these names and trade marks contain the expression 'Salaparuta'. That court dismissed the appellant's application, and the appellant then appealed that judgment before the Corte di appello di Milano (Court of Appeal, Milan). The appellate court confirmed the judgment at first instance. The appellant appealed the latter judgment before the Corte di cassazione (Supreme Court of Cassation), the referring court.

The essential arguments of the parties in the main proceedings

- 2 In its appeal before the Supreme Court of Cassation, the appellant argues five grounds of appeal, with the first three being relevant to the questions referred for a preliminary ruling.
- 3 By its first ground, the appellant alleges an infringement of Article 118k(2) of Regulation (EC) No 1234/2007, the wording of which is reproduced in Article 43(2) of Regulation (EC) No 479/2008 and Article 107 of Regulation (EU) No 1308/2013. [It asserts that] the Court of Appeal, Milan, erred in holding that, for the purposes of verifying the validity of the PDO at issue, it is necessary to apply the transitional rule laid down in Article 51 of Regulation (EC) No 479/2008, which in essence reproduces the provisions of Article 118s of Regulation (EC) No 1234/2007 and establishes the automatic protection of

designations – such as the one in question – which were already protected under the previous legislation laid down in Regulation (EC) No 1493/1999.

- 4 By contrast, the appellant submits that, for the purposes of verifying the validity of the PDO at issue, it is necessary to apply Article 118k(2) of Regulation (EC) No 1234/2007, which excludes the protection of a designation of origin where, in the light of a trade mark's reputation and renown, consumers could be misled as to the true identity of the wine.
- 5 According to the appellant, first, national recognition of the DOC containing the expression 'Salaparuta' was granted when Regulation (EC) No 1493/1999 was in force, and second, the registration of the PDO containing the expression 'Salaparuta' was granted later, namely on 8 August 2009, when Regulations (EC) Nos 1234/2007 and 479/2008 were in force. Regulation (EC) No 1493/1999 merely accepted national recognitions by requiring that they be notified to the Commission, without laying down conditions for the recognition or refusal of such recognitions. Regulation (EC) No 1234/2007, as amended by Regulation (EC) No 491/2009, repealed Regulation (EC) No 1493/1999, with effect from 1 August 2009. From that date onwards, in the registration procedure for a PDO, registration is subject to a final decision by the Commission, while the Member States are entrusted simply with carrying out a preliminary evaluation procedure.
- 6 The appellant submits that the transitional rules in Article 51 of Regulation (EC) No 479/2008 and Article 118s of Regulation (EC) No 1234/2007, which were incorporated into Article 107 of Regulation (EU) No 1308/2013, established that names protected by previous national recognition and protected under Regulation (EC) No 1493/1999 were to be registered under and for the purposes of the new legislation, unless such registration was refused administratively by the Commission by 31 December 2014.
- 7 That being so, the appellant contends that the transitional rules referred to in the previous paragraph should be understood as meaning that, for names protected under Regulation (EC) No 1493/1999, national recognition of the Italian DOC was merely a prerequisite. This was necessary but not sufficient for registration of the PDO at EU level. The PDO, therefore, replaces the previous national recognition, and thus, in accordance with the abovementioned provisions of Regulations (EC) Nos 479/2008 and 1234/2007, the protection granted to pre-existing wine names is given exclusively by the legislation in force at the time when the PDO for those wines was registered.
- 8 It follows that – as the appellant asserts – new registrations of PDOs relating to names already recognised nationally under Regulation (EC) No 1493/1999, according to the transitional rule in Article 51 of Regulation (EC) No 479/2008 and Article 118s of Regulation (EC) No 1234/2007, do not fall within the scope of Regulation (EC) No 1493/1999, but rather constitute new registrations under EU law. New registrations exist only from the date on which they are granted and are

protected under the EU law in force on that date, namely under Regulation (EC) No 1234/2007 and, currently, Regulation (EU) No 1308/2013.

- 9 Under those circumstances, the appellant challenges the judgment under appeal in so far as that judgment holds that Article 43(2) of Regulation (EC) No 479/2008 is not applicable for verifying the validity of the registration of the PDO in question, on the ground that the national recognition of the Italian DOC containing the expression ‘Salaparuta’ was granted in 2006 and that that recognition had then benefited from the protection provided for in Article 51 of Regulation (EC) No 479/2008.
- 10 According to the appellant, first, the national DOC recognitions that existed before 2009, including the recognition of the DOC containing the expression ‘Salaparuta’, were repealed and ceased to apply as of 1 August 2009. Second, the registration of the PDO at issue did not merely presuppose the conclusion of the recognition procedure for that Italian DOC, but also entailed the performance of a separate administrative procedure. That administrative procedure for registration of the PDO, which falls exclusively within the scope of Union law, commenced with the registration of the PDO in question, on 8 August 2009, and ended on 1 January 2015, as the Commission did not request the cancellation of that registration by 31 December 2014, in accordance with the provisions of Article 51 of Regulation (EC) No 479/2008 and Article 118s of Regulation (EC) No 1234/2007.
- 11 The appellant argues that the rules laid down in Article 118k of Regulation (EC) No 1234/2007 and Article 43(2) of Regulation (EC) No 479/2008, which exclude the protection of a name where it is liable to mislead the consumer ‘in the light of a trademark’s reputation and renown’, must also be applied to the examination of the validity of the registration of the PDO at issue, since those rules were in force both on the date on which the procedure resulting in the registration of the PDO in question was initiated (8 August 2009) and on the date on which it was concluded (1 January 2015).
- 12 According to the appellant, Annex VII to Regulation (EC) No 1493/1999 did not contain a provision similar to Article 118k(2) of Regulation (EC) No 1234/2007, which expressly excludes the recognition of a designation of origin where the consumer might confuse that designation with a different trade mark with a reputation. Furthermore, Article 118l of Regulation (EC) No 1234/2007 provides for the possibility of coexistence of a designation of origin with a trade mark in cases other than that referred to in Article 118k(2). The appellant argues that the PDO in question is also subject to the provisions of the abovementioned Article 118k(2).
- 13 By its second ground of appeal, the appellant submits, in the alternative (in the event that the rules laid down in Article 43(2) of Regulation (EC) No 479/2008 and Article 118k(2) of Regulation (EC) No 1234/2007 are held not to be applicable to the present case), that even under the earlier legislation, namely

Regulation (EC) No 1493/1999, registration of wine names that could mislead the consumer because of the reputation of an earlier trade mark is not permitted.

- 14 The appellant contests the judgment under appeal in so far as it holds that a name which, as in the present case, interferes with an earlier well-known trade mark, and is liable to mislead the public as to the true identity of the wine and is therefore deceptive, must necessarily be recognised as valid under Regulation (EC) No 1493/1999 since that regulation does not expressly establish that such a name is invalid.
- 15 According to the appellant, in the light of a systematic interpretation of Regulation (EC) No 1493/1999 in relation to other rules of European Union law, on the one hand, protection of a misleading geographical designation must be excluded. On the other hand, there is no justification for the interpretation of the legislation adopted, in the judgment under appeal, according to which, as regards wines, misleading names are not invalid merely because they were recognised nationally before the introduction of the rules laid down in Regulations (EC) Nos 479/2008 and 1234/2007.
- 16 By its third ground of appeal, argued in the further alternative, the appellant considers whether Annex VII to Regulation (EC) No 1493/1999 should be interpreted as meaning that it also provides for the protection of PDOs that, given the reputation of an earlier trade mark, are liable to mislead consumers as to the true identity of the wine. In such a case, in accordance with Section F 2 of Annex VII to Regulation (EC) No 1493/1999, that earlier trade mark, where it is identical – as in the present case – to a PDO subsequently registered, could no longer even be used, with the result that, according to the appellant, that trade mark would be expropriated, in the absence of reasons of public interest and without compensation.
- 17 On that point, the appellant alleges an unreasonable difference in treatment in relation to the identical situation concerning the relationship between an earlier mark with a significant reputation and a PDO subsequently registered under Regulation (EEC) No 2081/1992, which concerns designations of origin for agricultural products or foodstuffs other than wines. Article 14(3) of this latter regulation states as follows: ‘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 is liable to mislead the consumer as to the true identity of the product’.

Succinct presentation of the reasoning in the request for a preliminary ruling

- 18 It is clear from the order referring the questions for a preliminary ruling that the first question referred concerns the system of protections applicable in situations, such as the present case, relating to the period between 2006 and 2009, in which there was a pre-existing designation of origin, namely an Italian DOC, issued in the Member State in 2006, to which protection at EU level – namely a PDO – was

added or by which it was replaced. On that point, the referring court questions whether the first – national – recognition remains effective and receives protection under Regulation (EC) No 1439/1999 or whether that recognition should be regarded as having been replaced by the PDO, with the result that that name is governed by the legislation in force during the PDO registration procedure.

- 19 With regard to the EU regulatory context, the order referring the questions notes that Regulation (EC) No 1493/1999 provided for an initial redefinition of the rules governing the wine market by introducing a classification of wines. Regulation (EC) No 479/2008 established a new classification in the wine sector, which provides for PDO and PGI ([protected geographical indications]) for wines characterised by a specific link with the territory of origin.
- 20 According to the referring court, the application of PDOs and PGIs in the wine sector has, as a rule, led to the exclusion of national systems of protection, and the regulations relating to that sector have therefore introduced transitional rules to take account of the fact that, in the European Union, some national frameworks have already introduced rules governing designations of origin. Italy, taking advantage of an option permitted under Regulation (EU) No 1308/2013, chose to retain national designations, which can therefore continue to stand alongside the European ones. A controlled designation of origin ‘DOC’ therefore continues to have value at national level.
- 21 The order referring the questions also states that the PDO registration procedure is made up of three steps. In the first step, wine producers submit applications for PDO registration to the Member State in which the wine production area is located. In the second step, after the Member State has carried out the necessary verification to ensure that the requirements have been met and after any objections have been resolved, that Member State forwards the application to the Commission. In the third step, the Commission carries out a further verification and takes the final decision on the registration of the PDO.
- 22 The referring court then refers to the judgment of the Court of Justice in Case C-120/2008, [*Bayerischer Brauerbund*], concerning the interpretation of Regulation (EEC) No 2081/1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs. It would appear from this judgment, first, that the principle of legal certainty precludes a European Union measure from taking effect from a point in time before its publication, but it may exceptionally be otherwise where the purpose to be achieved so demands and where the legitimate expectations of those concerned are duly respected. Second, the Court stated in that judgment that the principle of legal certainty itself requires that any factual situation should normally, in the absence of any contrary provision, be examined in the light of the legal rules existing at the time when the situation obtained. Furthermore, if the new law is valid only for the future, it would also apply, save for derogation, to the future effects of situations which came about during the period of validity of previous laws.

- 23 The referring court observes that, according to the judgment under appeal, Article 51 of Regulation (EC) No 479/2008 applies in the present case, and therefore designations of origin already protected under Article 54 of Regulation (EC) No 1493/1999 enjoy automatic protection through registration under Article 46 of Regulation (EC) No 479/2008, subject to the possibility for the Commission to order cancellation of protection before 31 December 2014.
- 24 On the other hand, according to the appellant, the provisions of Article 51 of Regulation (EC) No 479/2008 and Article 118s of Regulation (EC) No 1234/2007 apply only to the procedure for registration of the PDO at issue, whereas the provisions of Article 43(2) of Regulation (EC) No 479/2008 apply for verifying the validity of the registration of that PDO, because the PDO in question, registered on 8 August 2009, constitutes a new element that cannot fall within the scope of Regulation (EC) No 1493/1999, since this latter regulation was repealed with effect from 1 August 2009.
- 25 The second question referred concerns the possible situation in which it is held that Regulation (EC) No 1493/1999 applies to the case referred to in the first question. The order referring the questions for a preliminary ruling notes that that regulation does not contain a specific provision that could resolve the conflict between, on the one hand, an earlier trade mark with a reputation and, on the other hand, a later designation of origin that interferes with that trade mark and is liable to mislead consumers. In that context, the referring court asks whether it is possible to derive a general principle, from the systematic interpretation of the legislation on trade mark protection, that protects trade marks, including designations of origin, against subsequent misleading signs, having regard to Article 14 of Regulation (EEC) No 2081/1992, even though that text is not applicable to the wine sector.
- 26 As noted by the referring court, Regulation (EEC) No 2081/1992, unlike Regulation (EC) No 1493/1999, was intended to regulate the matter of designations of origin in a complete and exclusive manner. In particular, Article 14(3) of Regulation (EEC) No 2081/1992 contained the rule stating that a designation of origin may 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 is liable to mislead the consumer as to the true identity of the product. This rule was only introduced for wines with Regulation (EC) No 497/2008.
- 27 On this point, the referring court observes that several provisions prohibit any distinctive or descriptive sign, trade mark or designation of origin, that is liable to mislead the public, such as, in particular, Article 10*bis* of the Paris Convention of 20 March 1883 for the Protection of Industrial Property, Article 3*bis* of the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods of 14 April 1891, subsequently revised in Washington, The Hague, London and Lisbon, and Article 2 of Directive 2000/13.

- 28 The referring court notes that, according to the respondents, in the conflict between trade marks and indications of quality, a rule other than the fundamental rule on distinctive signs is often applied, according to which earlier rights prevail over later rights. On this point, a legislative choice in favour of quality indications emerges from EU law, which would imply a prevalence of the latter over other distinctive signs.
- 29 According to the referring court, the relationship between protected designations and trade marks in the wine sector has been regulated in a manner essentially coinciding with other agri-food products only by Regulation (EC) No 479/2008, which introduced a new system for Community-wide registration of PDOs and PGIs for wines, which entered into force on 1 August 2009, replacing the system established by Regulation (EC) No 1493/1999. This system was based on the national registration designations, which were then automatically recognised at Community level.