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The GI Prosecco Battle between Italy and Australia: Some Lessons from the History and Geography of the Most Famous Italian Wine

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Abstract

This article seeks to contribute to the debate around the legality of the Prosecco geographical indication (GI). The article's main point is to demonstrate that the term Prosecco does satisfy the conditions laid down in Article 22 TRIPS, and that its protection as a GI in both the EU and other countries does not run counter to TRIPS. Through a review of the relevant literature, the article shows that this term has been used for many centuries in the North-eastern part of the Italian peninsula to refer to a high-quality wine, including in the territory around the village of Prosecco in the Friuli Venezia Giulia region of Italy. This suggests a strong link between that area and the quality and reputation of the famous Italian sparkling wine; and strengthens the EU and Italy's claims for the protection of the term Prosecco as GI, in both the EU and other countries that sign trade agreements with the EU.

Key words: Australia; European Union; Free Trade Agreements; Geographical Indications; Grape Varieties; Prosecco; Terroir; Wines.

1. Introduction

The European Union (EU), and Italy specifically, strongly protect geographical names in connection with food and agricultural products, especially those which have qualities linked to the soil and local areas and are made according to specific methods of production. The EU's regime for the protection of geographical indications (GIs) aims at safeguarding both cultural and gastronomic heritage and economic values associated to the place of production (e.g. "Bordeaux", "Rioja", "Barolo" and "Champagne" wines). Protecting GIs via the sui generis system of Protected Designations of Origin (PDOs) or Protected Geographical Indications (PGIs) is at the heart of Europe's agricultural and food policy.

Other countries, particularly in the so-called *New World* (i.e. the former colonies of European countries), do not offer geographical names the same strong protection as the EU does.¹ United States (US), Canada and other states for example do protect geographical signs, but they do so via trademark law based on the “first come first served” rule. This however may create conflicts between European producers of wine and foodstuffs and local competitors in the new world. Chile, for instance, did not adopt a comprehensive law on geographical indications until 2005 - and several Chilean producers of wine in the past used European GIs.² One of these was Champagne.³ Chile claimed that this term had been used locally as both a generic term and component of registered trademarks, dating back to the 1930s.⁴ From a European perspective, this is perceived as an unfair behaviour which aims to free ride on the reputation of European food and agricultural products’ brands and heritage, and may end up confusing consumers as

¹ Scholarly work on the dichotomy “old world” / “new world” in the field of GIs is extensive. See Felix Addor and Alexandra Grazioli, 'Geographical indications beyond wines and spirits: A roadmap for a better protection for geographical indications in the WTO/TRIPS agreement' (2002) 5 J.World Intell.Prop. 865; José Manuel Cortès Martin. 'The WTO TRIPS agreement: the battle between the Old and the New World over the protection of geographical indications' (2004) 7(3) The Journal of World Intellectual Property 287; Anselm Kamperman Sanders. 'Future Solution for Protecting Geographical Indications Worldwide' (2005) 25 Studies in Industrial Property and Copyright Law (IIC Studies); Meir Perez Pugatch, *The intellectual property debate: Perspectives from law, economics and political economy* (Edward Elgar Publishing, 2006); Irene Calboli. 'Expanding the protection of geographical indications of origin under TRIPS: Old debate or new opportunity' (2006) 10 Marq.Intell.Prop.L.Rev. 181; Gail E. Evans and Michael Blakeney. 'The protection of geographical indications after Doha: Quo vadis?' (2006) 9(3) Journal of International Economic Law 575; Irene Calboli, 'Intellectual property protection for fame, luxury, wines and spirits: Lex specialis for a corporate “dolce vita” or a “good-quality life”?' in *Intellectual Property and General Legal Principles* (Edward Elgar Publishing, 2015a); Irene Calboli, 'Of markets, culture, and terroir: the unique economic and culture-related benefits of geographical indications of origin' in *International Intellectual Property* (Edward Elgar Publishing, 2015b); Irene Calboli. 'Time to Say Local Cheese and Smile at Geographical Indications of Origin-International Trade and Local Development in the United States' (2015c) 53 Hous.L.Rev. 373; Christopher Heath and Delphine Marie-Vivien. 'Geographical indications and the principles of trade mark law—A distinctly European perspective' (2015) 46(7) IIC-International Review of Intellectual Property and Competition Law 819; Bernard O'Connor and Giulia De Bosio, 'The global struggle between Europe and United States over geographical indications in South Korea and in the TPP economies', *The importance of place: Geographical indications as a tool for local and regional development* (Springer 2017) 47; Danny Friedmann. 'Geographical Indications in the EU, China and Australia, WTO Case Bottling Up Over Prosecco' (2018) European Integration and Global Power Shifts: What Lessons for Asia 18.

² In 2005, Chilean law No 19.039 and its implementing Regulation established a general system of protection of GIs and designations of origin (Dos), which defines and differentiates GIs from DOs and established a special registry administered by the National Institute of Industrial Property, INAPI. Previously, the protection of GIs in Chile was circumscribed to specific laws that contemplated the protection of the DO Pisco, Pajarete and Vino Asoleado DOs - recognised in Law 18.455 on Wines, Alcoholic Beverages and Vinegars – and to the reciprocal recognition of foreign GIs and DOs through the free trade agreements, which Chile has successfully negotiated since the mid-1990s, among others. See Carolina Belmar Gamboa, “Las denominaciones de origen en Chile: desarrollo y perspectivas”. RIVAR Vol. 3, N° 8, ISSN 0719-4994, IDEA-USACH, Santiago de Chile, mayo 2016, pp. 253-266.

³ Champagne is also protected in more than 120 countries of the world, following to EU-bilateral Agreement or to multilateral recognition under Lisbon System.

⁴ See Federico Mekis, Simposio sobre la Protección Internacional de las Indicaciones Geográficas – Denominaciones de Origen Posición de las vias de Chile en el concierto del nuevo mundo y relación con las negociaciones con la unión Europea OMPI/GEO/MVD/01/4, 9 Noviembre 2001, World Intellectual Property Organisation (WIPO) (noting that at that time (2001) “[t]he word ‘champagne’ is also currently incorporated in numerous trademark-labels which constitute complex marks from which cannot be deprived of such word without infringing rights enshrined in our Constitution”, and further arguing that when ‘Champagne’ is used alone, it would be considered as generic name under article 19 n. 23 of the Chilean constitution, but when used as part of a complex sign it would qualify as trademark, thus protected by proprietary rights under Chilean constitution).

to the real geographical provenance of the goods.⁵ The specific Chilean case was settled in 2002 when Chile and the EU signed a free trade agreement which provided for 12 years of coexistence after which all trademarks including the expression “champagne” would be cancelled and any generic use of the term would cease.⁶ This period ended in 2015.⁷

As we have just seen, one of the arguments put forward by countries in the *New World* is that many of these terms do not identify anything but just describe the product itself; and that therefore the attempt by the EU to claw-back names which have become common in those states constitutes a protectionist measure aimed at monopolising descriptive terms and signs to the detriment of competition and consumers. This is thus a fight between the *New World* which embraces a minimalist approach to protecting geographical names,⁸ and the *Old World*, especially Europe, which advocates for a strong protection - not only at home, but also in other states via bilateral trade or economic partnership agreements. Indeed, the EU has constantly

⁵ Disputes of this kind have also occurred in sectors other than wine. One of these occurred between producers of cured ham made in the area around the Italian town of Parma, and the Canadian company Maple Leaf Foods Ltd., which owned trademark rights in Canada for the term “Parma” (in the EU the sign “Prosciutto di Parma” is protected as a PDO, and owned by the Consorzio del Prosciutto di Parma). The trademark registration held by Maple Leaf Foods resulted in the Italian producers being banned from using signs incorporating the term Parma in Canada and being forced to resort until very recently to alternative brands such as “Le Jambon original” or “The original prosciutto”. See in this regard Viju, Crina, William A. Kerr, and Cherine Mekkaoui. Everything is on the Table: Agriculture in the Canada-EU Trade Agreement. No. 1617-2016-134595, 2010; Dr Crowne. 'Pounds of Flesh, the Merchants of Parma & Ham-Lets: a Review of The Parma Ham Litigation Across Canada and the UK' (2010) 18 Intellectual Property Journal 443.

⁶ Agreement establishing an association between the European Community and its Member States, on the one hand, and the Republic of Chile, on the other (2002), O.J. L 26 of 31.01.2003.

⁷ Vitisphere, Indicación Geográfica: el Champagne es protegido en Chile y Ecuador (May 2015), available at <https://www.vitisphere.com/news-72912-Indicacion-geografica-el-champagne-es-protégido-en-Chile-y-Ecuador.html>. One example is the trademark “Abrete al Champagne Valdivieso”, n. 744928, which was surrendered in 2015. The trademark was owned by the Chilean company “Champagne Alberto Valdivieso SA”, founded in 1879 by Mr. Alberto Valdivieso. Today, the company has been renamed “Valdivieso Group”. See Valdivieso Wines, official website, available at <http://www.valdiviesowines.com/our-company/history/?lang=en>.

The practice of appropriating European GIs was also questioned by Latin American oenologists and intellectuals in the 1960s, particularly by two emblematic figures: the Salesian oenologist and founder of the first Faculty of Oenology in Latin America, Francisco Oreglia, and the intellectual and socialist militant Benito Marianetti. The latter was particularly vocal in opposing the trend to rely on European names: “When we have bad wines, we christen them with Creole names. When the wines start to “climb up the ranks”, then we resort to French and Italian nomenclature. This is not just a complex. It is also a commercial ploy. It is thought that foreign names are better for the positioning of the goods. But this is naive. [...] and it inhibits the development of local GIs”. Oreglia even criticised the fact that Latin American wine manufacturers often try to reproduce the techniques of production used in Europe, especially in France and Italy: “It is a mistake to want to obtain wines in our environment that are identical to those of the famous wine regions, such as those of Chablis, Medoc, etc. (France), or in the north of Italy, by growing the same grape variety in similar soils, but in different climates; it is natural that as the climate becomes more similar to that of the regions taken as a reference, the wines will become more similar, let us say, in their general chemical constitution, as in the ratio of sugar and acidity at maturity, and it will then be possible, in regions or areas with a cooler climate, to subject the wine to malolactic fermentation with all its benefits and obtain excellent products, with a chemical composition similar to the great 'Crus', but they will have their own physiognomy which will distinguish them from the former - among other reasons - because the epiphytic flora is not the same - and yet they can still be of great quality.” See Burdeos de Talca y Champagne de Mendoza: Denominaciones de Origen y contaminación identitaria de vinos en Argentina y Chile Pablo Alberto Lacoste; Diego Ignacio Jiménez Cabrera; Félix Maximiano Briones Quiroz; Amalia Castro San Carlos; Bibiana Marcela Rendón Zapata; José Gabriel Jeffs Munizaga Mundo Agrario, 15 (29), agosto 2014. ISSN 1515-5994 <http://www.mundoagrario.unlp.edu.ar>.

⁸ Tim Josling. 'The war on terroir: geographical indications as a transatlantic trade conflict' (2006) 57(3) Journal of agricultural economics 337.

sought enhancing protection for its geographical names by shifting away from the WTO arena (where the two decades long discussion over reforming the TRIPS regime of GIs has been fruitless)⁹ toward a variety of bilateral accords that range from standalone agreements on GIs to sectorial accords that provide for mutual recognition and protection of names for wines or spirits.¹⁰ Specifically, the EU has in the latest years concluded comprehensive agreements with other nations that include a chapter on GIs,¹¹ including the Japan-EU Economic Partnership Agreement,¹² as well as the accords with Korea¹³ and Canada (CETA).¹⁴

This expansionist strategy has, as expected, created tensions with some countries in the *New World*. The very early negotiations between the US and the EU for concluding the Transatlantic Trade and Investment Partnership (TTIP) failed also because of the opposition of US producers of wines and food (especially cheeses) which could not accept the EU claw-back demands. Emblematic and eloquent was the letter sent by fifty-five US senators to the US Trade Representative in 2014, expressing their dislike of the EU requests: “we urge you to make clear to the EU counterparts that the US will reject any proposal in the TTIP negotiations now underway that would restrict in any way the ability of US producers to use common names (e.g. for cheeses)”.¹⁵

A GI dispute which may potentially see the EU being dragged before a WTO panel focuses on the use of the term Prosecco by Australian producers of sparkling wines. The name Prosecco

⁹ The TRIPS Agreement is one of the WTO treaties: Agreement on Trade-Related Aspects of Intellectual Property Rights 15 April 1994 33 Marrakesh.

¹⁰ For instance, the Agreement between the European Community and Australia on trade in wine (1994, renewed in 2008), 2009 O.J. (L) 28/13; the Agreement between the European Community and the United Mexican States on the mutual recognition and protection of designation for spirit drinks, 1997 O.J. (L) 152/16; the Agreement establishing an association between the European Community and its Member States, of the one part, and the Republic of Chile, of the other part, 2002 O.J. (L) 352; the Agreement between the European Community and the Republic of South Africa on trade in wine, 2002 O.J. (L) 28; and the Agreement between the European Community and the United States of America on trade in wine, 2996 O.J. (L) 87/2.

¹¹ Martijn Huysmans. 'Exporting protection: EU trade agreements, geographical indications, and gastronationalism' (2020) *Review of International Political Economy* 1.

¹² Agreement between the European Union and Japan for an Economic Partnership, OJ (L) 330 of 27.12.2018. For a full overview of the intellectual property aspects of the agreement, see: Enrico Bonadio, Luke McDonagh and Tiffany Sillanpaa. 'Intellectual property aspects of the Japan-EU economic partnership agreement' (2020) 2 *International Trade Law & Regulation*

¹³ European Union–South Korea Free Trade Agreement, OJ (L) 127 of 4.05.2011. For a full overview of the agreement, see: Bernard O'Connor and Giulia De Bosio, 'The global struggle between Europe and United States over geographical indications in South Korea and in the TPP economies', *The importance of place: Geographical indications as a tool for local and regional development* (Springer 2017) 47.

¹⁴ EU-Canada Comprehensive Economic and Trade Agreement (CETA), OJ (L) 11 of 14.1.2017. For a full overview of the agreement, see: Bernard O'Connor. 'Geographical indications in CETA, the comprehensive economic and trade agreement between Canada and the EU' (2014) NCTM Association d'avocats, http://www.origingi.com/images/stories/PDFs/English/14.11.24_GIs_in_the_CETA_English_copy.pdf

¹⁵ Filippo Arfini, Maria Cecilia Mancini and Mario Veneziani, *Intellectual Property Rights for Geographical Indications: What is at Stake in the TTIP?* (Cambridge Scholars Publishing 2016); the Senator's letter is available at: [U.S. Senator Tammy Baldwin of Wisconsin \(senate.gov\)](http://www.senate.gov).

has been formally protected since 2009 as GI in the EU,¹⁶ with protection under Italian law dating back to 1969.¹⁷ And the EU not only bans the importation of any Prosecco labelled wine in the EU - it also seeks a strong protection of this GI at international level via bilateral accords, including the trade agreement which is currently being negotiated between the EU and Australia.¹⁸ Of course, this demand is strongly opposed by Australia, which has recently experienced a hike in the sale of domestically manufactured Prosecco-branded sparkling wines. From an Italian and EU perspective, the reason for this opposition is clear: the Prosecco brand is powerful and attracts a strong customer base.

Such a row between the EU/Italy and Australia has been recently covered by some academic works.¹⁹ Specifically, it has been argued that the expression Prosecco has not traditionally been used or recognised as a term referring to a geographical location but just to a grape variety; and that the Italian Prosecco has historically been produced in the area surrounding the town of Conegliano in the Veneto region, at some 130 km from the village of Prosecco, which is situated in the neighbouring Friuli Venezia Giulia region.²⁰ Therefore – the argument goes – the Prosecco GI status would amount to a “legal fiction” which ends up shielding Italian Prosecco producers from international competition.²¹ Based on this claim, the EU and Italy would violate several provisions of the WTO TRIPS and TBT Agreements if Australian producers were prevented from labelling their products with the term Prosecco.²²

Our article seeks to contribute to this debate and offer a different perspective. Its main point is to bring into the discussion history and centuries-old practices which confirm that the term Prosecco has been used for many centuries in the North-eastern part of the Italian peninsula, including in the territory around the village of Prosecco, close to the town of Trieste. That

¹⁶ eAmbrosia, n. PDO-IT-A0516.

¹⁷ Decree of the President of the Republic n. 930/1963 ‘on the protection of the designations of origin of musts and wines’.

¹⁸ Matthew Rimmer, Prosecco wars: An aperitif for New Australia-EU Trade Talks, (July, 2018), InfoJustice. Available at: <https://infojustice.org/archives/40203> (discussing on EU-Australia negotiations on trade agreements and noting that Italy has indicated it wants a GI for Prosecco during the Australia-EU negotiation, and adding that “Understandably, Australian winemakers are irate about this.”). See also Courtney Schiessl, Inside the Great Italian- Australian Prosecco Debate, Forbes, (23 August 2018), available at <https://www.forbes.com/sites/courtneyschiessl/2018/08/23/italian-australian-prosecco/?sh=345c485cc3a3>

¹⁹ See for example Mark Davison, Caroline Henckels and Patrick Emerton. 'In Vino Veritas? The Dubious Legality of the EU's Claims to Exclusive Use of the Term 'Prosecco'' (2019) 29 Australian Intellectual Property Journal 110. See also Matthew Rimmer, *The Trans-Pacific Partnership: Intellectual Property and Trade in the Pacific Rim* (Edward Elgar Publishing 2020); Elyse Kneller. 'EU-Australia FTA: Challenges and potential points of convergence for negotiations in geographical indications' (2020) 23(3-4) The Journal of World Intellectual Property 546.

²⁰ See again Davison, Henckels, Emerson, *ibid*

²¹ *Ibidem*.

²² Article 20 TRIPS and Article 2.1. TBT.

history and those practices suggest a strong link between this area and the quality and reputation of the famous Italian sparkling wine. This – we believe – strengthens the EU and Italy’s claims for the protection of the term Prosecco as GI, in both the EU and other countries which sign trade agreements with the EU. Most issues dealt with, and points made, in this article could also be relevant in other controversies which involve the Prosecco GI, including the recent challenge brought by Italy against Croatia’s application to register the traditional expression “Prošek” as EU PDO.²³

2. A tale of agreements (and disagreement) between Australia and the EU over the use of the ‘Prosecco’ name

One of the first countries which negotiated with the EU the protection of its wine GIs was Australia. In 1994 the two partners signed an agreement to regulate the wine trade between them (EU/Australia 1994 Agreement).²⁴ This accord offered reciprocal protection of wine names, and laid down provisions on their description and presentation. A replacement agreement was signed in 2008, coming into force in 2010.²⁵ Australia had regulated until 1993 the export of its wine under the Australian Wine and Brandy Corporation Amendment of 1980²⁶ — yet this law did not provide any form of GI protection. In 1993 Australia amended its Wine and Brandy Corporation Act,²⁷ offering a minimum level of protection to geographical names for wines and other alcoholic beverages. It protected geographical names for wines if the 85% of the grape was sourced from the relevant region. The regime was mainly aimed at maximising exports, thus in line with liberal economic policies,²⁸ rather than being based on

²³ On this dispute see Enrico Bonadio – Magali Contardi, Prosecco or prošek? The EU battle between Italy and Croatia over wine branding, *The Conversation*, 27 September 2021.

²⁴ Agreement between the European Community and Australia on Trade in Wine, Eur.-Austl., opened for signature Jan. 26, 1994, 1994 O.J. (L 86) 3, 3.

²⁵ Agreement Between the European Community and Australia on Trade in Wine, Eur.-Austl., 30 Jan. 2009, O.J (L 28) 1.

²⁶ Australian Wine and Brandy Corporation Amendment of 1980, Act n. 161 of 180, 10 December 1980. Available at: <https://wipolex-res.wipo.int/edocs/lexdocs/laws/en/au/au242en.pdf>.

²⁷ Australia wine and Brandy Corporation Act 1993, Act n. 93 of 1993, 16 December 1993. Available at: <https://wipolex.wipo.int/fr/text/205095>.

²⁸ Mariusz Rybak. 'EXPLAINING THE EUROPEAN COMMUNITY–AUSTRALIA WINE TRADE AGREEMENT. IMPACT OF NATIONAL PREFERENCES ON A CHANGE OF SCENE IN TRADE POLITICS' (2012) 11(1) *Studia Humanistyczne AGH* (od 2012) 135; Peter Drahos. 'Sunshine in a bottle? Geographical indications, the Australian wine industry, and the promise of rural development' (2017) *Geographical indications at the crossroads of trade, development and culture* 259 (noting that during this time Australia was one of the leaders of the Cairns Group, the group that was leading the charge to liberalize trade in agriculture in the Uruguay Round of multilateral trade negotiations).

quality²⁹ and typicality.³⁰ The need to extend export markets for Australian wines was also the reason why Australia concluded the 1994 Agreement with the EU.³¹ Indeed, harmonization of standards³² and mutual recognition of oenological practices³³ was important to gain facilitated access to the rich EU wine market.³⁴ On the other hand, the EU-Australia 1994 Agreement allowed the EU to obtain legal protection of some of its most important GIs in Australia,³⁵ including “Prosecco di Conegliano Valdobbiadene, whether or not accompanied by the term “Superiore di Cartizze”.³⁶ It should be noted that the subsequent 2008 Agreement only refers to “Conegliano Valdobbiadene, whether or not followed by Cartizze”, the term Prosecco having been removed.

Australia and the EU have also been negotiating since 2018 a comprehensive trade agreement which should include a chapter on intellectual property rights and specifically GIs. If finally reached, it would also extend the wine related EU-Australia partnership established in 1994 and amended in 2008.³⁷ It does not come as a surprise that one of the sticky issues in the current negotiations is over the use of the term Prosecco. The EU and Italy are obviously on the offensive, demanding a strong protection of the GI Prosecco in Australia,³⁸ which would however prevent Australian producers to use the term in question in their own country. That would be another tile in the mosaic of nations which have protected the Italian Prosecco GI as

²⁹ *ibidem* (offering an overview of the Australian system and suggesting that such system was not designed to bring terroir into a close regulatory association with the production of wine - it rather had a market-access goal; and further suggesting that this is clear from the Explanatory Memorandum to the Australian Wine and Brandy Corporation Amendment Act 1993 when it states that in order “to enable wine labelled by region to be marketed in the EC, the boundaries of Australian geographical indications concerned must be defined”). See also P. DRAHOS, Q. van Caenegem and J. Cleary. 'Provenance of Australian Food Products: is there a place for Geographical Indications? Rural Industries Research and Development Corporation' (2015)

³⁰ Vicki Waye and Stephen Stern. 'The next steps forward for protecting Australia's wine regions' (2016) Monash University Law Review (defining “typicality as the sensory perceivable characteristics of a wine, derived from the terroir, viticultural techniques, varieties of grapes, vintage and local oenological practices”).

³¹ Explanatory Memorandum, Australian Wine and Brandy Corporation Amendment Bill 1993. Available at: http://classic.austlii.edu.au/au/legis/cth/bill_em/awabcab1993471/memo_0.html.

³² See, Article 5. Agreement Between the European Community and Australia on Trade in Wine, Eur.-Austl., opened for signature Jan. 26, 1994, 1994 O.J. (L 86) 3, 3.

³³ See, Article 4, Annex I. Agreement Between the European Community and Australia on Trade in Wine, Eur.-Austl., opened for signature Jan. 26, 1994, 1994 O.J. (L 86) 3, 3.

³⁴ Des Ryan. 'The protection of geographical indications in Australia under the EC/Australia wine agreement' (1994) 16(12) European Intellectual Property Review 521.

³⁵ Mariusz Rybak. 'EXPLAINING THE EUROPEAN COMMUNITY-AUSTRALIA WINE TRADE AGREEMENT. IMPACT OF NATIONAL PREFERENCES ON A CHANGE OF SCENE IN TRADE POLITICS' (2012) 11(1) Studia Humanistyczne AGH (od 2012) 1356.

³⁶ See also Danny Friedmann. 'Geographical Indications in the EU, China and Australia, WTO Case Bottling Up Over Prosecco' (2018) European Integration and Global Power Shifts: What Lessons for Asia 18.

³⁷ European Commission, European Union's (EU) proposal for the EU-Australia FTA: Intellectual property chapter, available at: http://trade.ec.europa.eu/doclib/docs/2018/july/tradoc_157190.pdf.

³⁸ See: European Food Agency News, Prosecco DOC. Tutela Internazionale: “avanti tutta, Australia in primis”, (March 2019), Available at: <https://www.efanews.eu/it/item/6947-prosecco-doc-tutela-internazionale-avanti-tutta-australia-in-primis.html> (pointing out that the Italian Agricultural Minister's commitment to the protection of Prosecco within EU-Australian negotiations should be maximised). See also *ibid* 18.

a consequence of a trade deal with EU. The latter has indeed signed bilateral agreements with countries such as Armenia, Moldova, US, Switzerland, Vietnam, China and Japan, that guarantee with different degrees of intensity the protection of GIs containing the term Prosecco in those states. The term is also protected as appellation of origin in several countries under the Lisbon system.³⁹ Also, Prosecco currently enjoys protection under Indian, Russian, Canadian, and Kazakh domestic laws, as a consequence of national filings in those countries by the Consorzio di Tutela del Prosecco, the entity which regulates and supervises the production of the wine and the use of its brands.⁴⁰

As mentioned, the EU/Italy position *vis-a'-vis* the Prosecco name in the context of the current trade negotiations between EU and Australia are clearly anathema to the latter, where stakeholders such as Australian Grape and Wine criticise what they see as an EU hyper-protectionist approach which would inevitably cut off competition in Australia. Indeed, caving in to EU demands would seriously jeopardise a thriving market.⁴¹ In 2019 Prosecco ranked amongst the top ten white grapes in Australia, with an annual production volume of 9,936 tonnes. Australia also exports some of its Prosecco wine with a total value of almost 2 million Australian dollars shipped in 2018–19, with 80% going to New Zealand.⁴² Thus, if Australian producers were no longer able to use the term Prosecco in connection with their wines, that would hit hard a sector which is currently experiencing an exceptional growth, and already brings 200 million Australian dollars value per year to the local wine industry.⁴³

That said, we now turn our attention to the history of Prosecco wine in the north-Eastern part of Italy, especially in what is currently the Friuli Venezia Giulia region, and in particular the territory around the village of Prosecco. As mentioned, looking at this history (and related geography) shows how the name in question has been used throughout the centuries not only

³⁹ World Intellectual Property Organization, *Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration: Of October 31, 1958, as Revised at Stockholm on July 14, 1967, and as Amended on September 28, 1979; And, Regulations (as in Force on January 1, 1994).*, vol 264 (WIPO 2002). Under the Lisbon system, see Registration n. AO906 for Prosecco, available at: <https://www.wipo.int/ipdl-lisbon/result-detail?count=3&total=4&cacheid=21671825&query=prosecco&sortBy=KEY&limit=25>

⁴⁰ See for example GI Registration No. 503, India; Registration no. 1662300, Canada.

⁴¹ See Courtney Schiessl, *Inside the Great Italian- Australian Prosecco Debate*, 23 August 2018, Forbes, available at <https://www.forbes.com/sites/courtneyschiessl/2018/08/23/italian-australian-prosecco/?sh=345c485cc3a3> (noting that Prosecco sales jumped 50% last year, reaching AU\$60 million in 2017. While this comprises just 1.5% of the country's total wine value, estimated at AU\$40 billion, the dramatic increase forecasts the category's huge potential value).

⁴² Wine Australia, *Market Bulletin, Issue 170*, (20 August 2019), available at: <https://www.wineaustralia.com/news/market-bulletin/issue-170>.

⁴³ Elyse Kneller, 'EU-Australia FTA: Challenges and potential points of convergence for negotiations in geographical indications' (2020) 23(3-4) *The Journal of World Intellectual Property* 54620

to describe a grape variety, but also to distinguish wines produced in the areas surrounding the homonymous village.

3. A historical perspective: the roots of Prosecco

Before delving into the history of Prosecco, it is important to highlight the definition of GI under Article 22(1) TRIPS: “geographical indications are [...] indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin”.⁴⁴ This definition requires a causal interaction: the characteristics of the product, including its reputation, need to be “essentially attributable” to the geographical area where the products come from - which in relation to wines has been traditionally expressed in terms of *terroir*. While literature on *terroir* is extensive, there is no universally accepted definition.⁴⁵ The term points first to the physiology of the place, the soil and grape types, as well as the climate and production methods. Some have added the human factor and the historical link, highlighting technical and social connotations.⁴⁶ Thus, the *terroir* identifies a place whose natural factors such as soil and climate, together with human elements (particularly the local techniques of production), give distinctive qualities to the wine. There is also an economic angle as the *terroir* and its positive connotations amongst consumers are often capable of driving purchase decisions.⁴⁷ That said, the historical analysis developed in

⁴⁴ TRIPS Agreement. 'Agreement on Trade-Related Aspects of Intellectual Property Rights 15 Apr. 1994' (1994) 33 Marrakesh, reprinted in International Legal Materials 1125

⁴⁵ See: Josling, Tim. (2006). The War on Terroir: Geographical Indications as a Transatlantic Trade Conflict (describing the different approach to *terroir* between old and new world: the “old world” emphasises the notion of *terroir* whereas the “new world” considers GIs as a sub-set of trademarks, thus emphasising an utilitarian economy theory based on individual, exclusive ownership).

⁴⁶ Irene Calboli, 'Of markets, culture, and *terroir*: the unique economic and culture-related benefits of geographical indications of origin', *International Intellectual Property* (Edward Elgar Publishing 2015) (discussing the definition and role of *terroir*); Philippe Prévost and others. 'Le *terroir*, un concept pour l'action dans le développement des territoires' (2014) 14(1) *VertigO: la revue électronique en sciences de l'environnement* (proposing a definition of *terroir* as social construction); David Ballantyne. 'Sustaining the promise of *terroir*: the case of the Central Otago Wine Region' (6th Academy of Wine Business Research Conference (AWBR) 2011) 9 (proposing a definition of *terroir* that advocates for a social and technical construction, based on the case of Central Otago Wine Region); François Casabianca and others. 'Terroir et typicité: deux concepts-clés des appellations d'origine contrôlées. Essai de définitions scientifiques et opérationnelles' (Colloque international de restitution des travaux de recherche sur les Indications et Appellations d'Origine Géographiques 2005) (stressing the importance of both natural and human factors in the definition of *terroir*); Andrea Zappalaglio, *The Transformation of EU Geographical Indications Law: The Present, Past and Future of the Origin Link* (Routledge 2021) (expanding on the importance of natural and human factors, and concluding that the historical link between a product and its place of origin is an essential component of both the qualitative (*terroir*) and reputational link. The human factor contributes to describe the local know-how, i.e. the human component of *terroir*, which together with the physical peculiarities of the area, determines the product's qualities, while the historical link proves the existence of the reputation of the product, due to its history, that links it to a specific area even in the absence of evidence of *terroir*. There is also other literature which has focused on the natural scientific perspectives of *terroir*: see David Ballantyne and others. 'Old world and new world wine concepts of *terroir* and wine: perspectives of three renowned non-French wine makers' (2019) 30(2) *Journal of wine research* 122 (presenting six case studies).

⁴⁷ Elizabeth Barham. 'Translating *terroir*: the global challenge of French AOC labeling' (2003) 19(1) *J Rural Stud* 127 (discussing the importance of GIs for producers as building reputation around a product is understood to have a commercial

this article aims at showing that the link between Prosecco and the geographical area where this wine originates is strong, and that the relevant *terroir* is one of the factors which gives Prosecco its recognised qualities and reputation.

Wine has been produced in the North-Eastern regions of Italy for long time. It was also produced in the area of the Timavo River (close to the village of Prosecco) and – it has been noted - was much appreciated.⁴⁸ It has been reported that the configuration of the soil, which runs almost in a straight line from north to south, the sheltered position from the north winds and the excellent sunshine in that area greatly favoured copious vineyards - some of them clinging to the cliffs, some staggering on the hillsides.⁴⁹

The village of Prosecco hosted a castle in ancient roman times, i.e. “*castellum Pucinum*”. This castle, located between the city of Trieste and the Timavo river, plays an important role in the history of this wine, with several documents showing that it inspired its name. The book *Historia di Trieste* of 1698 reported that “Castellum pucino ancient castle from which the delicate Prosecco takes its name, [is] located between the city of Trieste and the Timavo River”.⁵⁰ Moreover, in its *Naturalis Historia*, a collection of 37 books of the first century BC, Gaius Plinius Secundus, a Roman natural philosopher, wrote: “the ‘*castellum nobile vino Pucinum*’” is located “near the source of the Timavo River [...] in the direction of the colony of Tergeste [today, Trieste]”.⁵¹ And Philipp Klüver, an early modern German geographer, also described the area from where the *Pucino* wine comes from: in *Italia Antiqua*, a general study of the geography of antiquity dated 1624, Klüver situated the *castellum pucinum*, known as

value); David Ballantyne and others. 'Old world and new world wine concepts of terroir and wine: perspectives of three renowned non-French wine makers' (2019) 30(2) Journal of wine research 122 (expanding on the economic significance of *terroir*, as 'premium wines' with a difference); Russell D. Warman and Gemma K. Lewis. 'Wine place research: getting value from terroir and provenance in premium wine value chain interventions' (2019) International Journal of Wine Business Research (noting that from the consumer's perspective, the terroir is more than the geographical place or physical environment of a wine. The terms influence and reflect ideas of sense of self, of others, prestige and belonging that influence perceptions, and hence, behaviours and actions of actors throughout the value chain).

⁴⁸ Relazione di Zaccaria Contarini, Podestà e Capitano di Conegliano che afferma: “... cavandosi dalli monti ... quantità di vini dolci e di altra sorta eccellentissimi, dei quali se ne vanno in gran parte in Alemagna e fino nella corte di Polonia”, citata in Tiziano Tempesta, Revisione dei Disciplinari del Prosecco e Propensione all'acquisto dei consumatori: Un'analisi con un esperimento di scelta, Tesi di Laurea Magistrale in Scienze e Tecnologie Agrarie, Università di Padova, Facoltà di Agraria, anno accademico 2010-2011, p. 8; available at: http://tesi.cab.unipd.it/35218/1/FRONTESPIZIO_TESI_merged.pdf.

⁴⁹ Tiziano Tempesta, *ibid*, p. 8.

⁵⁰ *Historia Antica, e Moderna: Sacra, e Profana, Della Città Di Trieste, Celebre Colonia de' Cittadini Romani: Con la Notitia di molt'Arcani d'Antichità, Prerogative di Nobiltà, e Gesti d'huomini Illustri sin'à quest'anno 1698*. Opera del R.R Fireneo della Croce. Venezia, Italy: 1698.

⁵¹ Precisely, in the III book, which covers the geography of the Iberian Peninsula and Italy, and where Plinius describes the tenth region of Italy: *Carnorum haec regio junctaque- Japidum, amnis Timavus, castellum nobile vino Pucinum Tergestinus sinus, colonia Tergeste XXIII M. pass. ab Aquileia*. Hist. Nat. L. III. C. 18. – Plinius books were first printed in Venice in 1467.

Prosecco, between Timavus and Trieste (*Tergeste*),⁵² which is exactly the area where the village of Prosecco is situated. Other sources confirm that the Prosecco wine originated from “those territories facing the Adriatic Sea, in the sources of the Timavo, a few miles away from Trieste, where the sea gave a special breeze”.⁵³ Furthermore, the journal *il Mentore il Perfetto dei Negozianti* of 1797 revealed that the grapes “from which this delicious wine is extracted were cultivated [...] in the entire coastline of the sea from Trieste to Sistiana, where the most beautiful grapes grew [...]”.⁵⁴ And the village of Prosecco is exactly located on that coastline. It is moreover worthwhile to note that Girolamo Agapito (a history professor who taught in secondary school in Trieste in the early 19th century), reported that this wine was already so esteemed that when the Trieste area came under the protection of the Archduke of Austria in 1382, it assumed the obligation to pay annually the sovereign court one hundred barrels of Prosecco wine.⁵⁵ There are also more recent sources. In 1922 the *Annuario Vinicolo D’Italia* [Wine Yearbook of Italy] focused on the production of wine in the province of Trieste: it reported that in the territories of Santa Croce, Prosecco e Contovello there was a production of 1,000 hectolitres of Prosecco wine; and Prosecco was listed amongst the “special wines” (*vini speciali*).⁵⁶

The above quotes are important. They link a product to a territory, as required by Article 22 TRIPS. Such territory includes the already mentioned Timavo river, which has often been reported in the literature. Its sources are about 18 km from the village of Prosecco. It is mostly a subterranean river, and attracted the attention of geologists during the 18th century. In his book *Delle antichità italiane* [Of Italian Antiquities] of 1788, the Italian economist and historian Gian Rinaldo Carli situated the village of Prosecco about eight miles (approximately 10 km) from the Timavo River, and mentioned the wine produced there: “We would say, therefore, that the first [city] to be encountered is Pucino, now Prosecco, about eight miles from Timavo; a castle of Plinius’ time, the wine of which was so famous, as has been mentioned above, and which only now, having completely destroyed the buildings of Roman times, retains

⁵² ‘Castellum id hodiè putant esse eum vicum, qui, millia passuum à Tergeste distus, vulgò vocatur Prosecco’ (‘The village [...], a mile from Trieste distant, commonly called Prosecco’) cfr. description “Pvcincm Castellum”, Philippi Cluverii, *Italia Antiqua*, 1624.

⁵³ Plinius, *ibid* 51; see also *Giornale della Provincia di Bergamo*, n. 53, 3 July 1838; Villafranchi G.C., *Oenologia Toscana*, 1773.

⁵⁴ *Il Mentore, Perfetto dei Negozianti*, Trieste, 1797.

⁵⁵ [Allorché nell’anno 1382 Trieste si dedicò sotto la protezione dell’Arciduca d’Austria essa assunse l’obbligo di corrispondere annualmente alla sovrana Corte cento orne di vino Prosecco], Girolamo Co. Agapito, *Compiuta e distesa descrizione della fedelissima città di Trieste*, Vienna 1824. This was also mentioned in *Il Mentore*, *ibid* 54.

⁵⁶ *Annuario vinicolo d’Italia*. Italia, Unione italiana vini, 1922.

its ancient quality”.⁵⁷ In its work Carli also reminded that “since ancient times the wine of Pucino, now Prosecco, was famous” and that by drinking such wine, as narrated by Plinius, “Julia Augusta [the wife of the Roman Emperor Augustus] prospered and led a happy life until the age of eighty-two”.⁵⁸ Pucino wine was thus considered suitable for medical use, as Plinius refers to it as an elixir of long life.⁵⁹ Indeed, the Empress Augusta - having reached an age well beyond eighty – attributed her longevity to her consumption of Pucino wine, the only wine she had ever drunk.⁶⁰ In their works Wolfgang Lazius (an Austrian historian, cartographer and physician),⁶¹ and again Philipp Klüver⁶² also referred to the link between the longevity of Augusta and the medicinal qualities of *Pucino*. Such qualities were also acknowledged by the Greek physician Galen when living in Rome (129 - 216 AD)⁶³ and the Holy Roman Emperor Frederick III, who praised Prosecco in his edict of 1479, ordering to choose the best Prosecco wine from the annual payment that Trieste gives to the court and to keep it for treating sick people.⁶⁴ Another document on the medical properties of Pucino / Prosecco is the Inventory of 1712 described in a paper written by Andrea Peressini, which confirms that about 74 litres of Prosecco wine were sold in Bortolo Nicolini’s *Malvasia magazzino* [wine shop].⁶⁵ At that time, fine wines (“vini pregiati”) were bought from the Trieste area to be sold in Venice in different *magazzini* depending on their quality. Nicolini’s *magazzino*, situated in Calle del Remedio in the Venetian district of Santa Maria Formosa, was known for its excellent quality wine. Some even claim that the Prosecco wine gave the street such name (“Calle del Remedio”, “street of remedy” in English), which hints to the therapeutic properties of the wine.⁶⁶

⁵⁷ Gian Rinaldo Carli, *Delle antichità italiane. Parte prima. Nell'imperial monistero di S. Ambrogio maggiore.*, Italy, 1788. *Delle antichità italiane*. See also, Gian Rinaldo Carli. *Delle antichità italiane*. 2. ed. riveduta dall'autore ed accresciuta. Italy: Monastero di S. Ambrogio Maggiore, 1793 (describing the cities, products and climate close to the Timavo river, starting from Istria).

⁵⁸ *Ibid.* See also: “*Julia Augusta LXXXII annos vitae Pucino vino rettulit acceptos, non alio usa*”, Plinius, NH = C. Plini Secundi, *Naturalis historiae libri XXXVII*, B.G. Teubneri, Lipsiae, vol. II (1875), XIV.6.60. The Miramar castle, built between 1856 and 1860 by the Archduke Ferdinand Maximilian of Habsburg in the bay of Grignano (a district in the municipality of Trieste, situated near the Prosecco village), hosts a painting made by Cesare dell’Acqua between 1857 and 1858, that witnesses Augusta’s interest in Pucino wine. The opera reads “*Pucino vino ned alid vsa vitiferos colles, Grinianos invisit*”.

⁵⁹ [“ned aliud optius medicamentis indicatur”], Plinius, *ibid* 51.

⁶⁰ Plinius, *ibid* 51.

⁶¹ Il mentore, *ibid* 54, citing Wolfgang Lazio, *Reipublicae Romanae*, lib. 12.

⁶² Philipp Klüver [Philippi Cluverii], *ibid* 52.

⁶³ Girolamo Co. Agapito citing physician Galeno, *ibid* 54. In fact, the famous Galen attributes medicinal qualities to it], Girolamo Co. Agapito, *ibid* 55.

⁶⁴ [L’Imperatore Federico III, che con suo rescritto del 1479 fa l’encomio del Prosecco ordinò di sceglierne il migliore dall’annua corresponsione che Trieste dà alla Corte e di conservarlo per uso degli ammalati] Girolamo Co. Agapito, *ibid* 54.

⁶⁵ A. Peressini, Per la storia del Prosecco: l’inventario (1712) dei vini del «magazzino da malvasia» in calle del Remedio a Venezia, in *Economia e Commerci nelle Prealpi Venete* (sec. XIII - sec. XX), Circolo Vittorioso di Ricerche Storiche (Atti del Convegno, Vittorio Veneto, 15 aprile 2018), Vittorio Veneto 2018, II, pp. 87-98.

⁶⁶ A. Peressini, *ibid* 65, citing Giuseppe Tassini in *Curiosità veneziane* (1863).

As mentioned, the Prosecco wine was known in ancient times as Pucinum. This is further confirmed by Wolfgang Lazius in his above mentioned work: “The growth of vines in this region is, as reported above, very delicious, especially in Proseggk [Prosecco in German], named after the old Pucinum and only a mile away from Tybein, where the world-famous Proseggk wine or Reinfall is produced, which is said to prolong the life of the people”.⁶⁷ The link between Prosecco and Pucinum had also been mentioned in his memoirs by the English nobleman Fynes Moryson during his journey to Italy in 1593. He considered *prosecho* one of the best Italian wines: “Here grows the Pucinum wine, now called Prosecco, much celebrated by Plinius. [...] These are the most famous wines in Italy”.⁶⁸ Moreover, Cosimo Villifranchi, a botanist and doctor from Florence, noted that Prosecco came from the Trieste area, that the wine was the ancient and famous *Pucino* wine, and that the name is borrowed from the village of Prosecco, where the wine originates. Indeed, in his work *Oenologia Toscana* of 1773, Villafranchi wrote: “Among those [wines] of Italy, the Romans infinitely appreciated the wine *Pucino*, in Latin *Puxinum*, today called Prosecco, whose [grapes] are still cultivated on the slopes of Mount Contuel facing the Adriatic Sea, a few miles from the Adriatic Sea, a few miles away from Trieste [...]”.⁶⁹ And in 1830 the *Archeografo Triestino* of 1830, a compilation of articles made by Domenico Rossetti, reported that the wine in question ‘*et nostra lingua Prosecum hodie nominatur*’ [in our language today it is called Prosecco].⁷⁰

The fame of Prosecco also spread overseas.⁷¹ A document describing a wine fair held in Trieste in 1888 confirms that Prosecco was commercialized beyond the regional territory.⁷² Amongst the wines on display and tasted at the fair there was the “Vino spumante Prosecco” (produced by two persons, Giovanni Balanc of Prosecco and Giuseppe Klampferer of Grignano) as well

⁶⁷ [Der Weinwuchs In dieser Gegend ist wie oben gemeldet kllstlich, absonderlich aber zu Proseggk, so von dem alten Pucinum benamset und nur eine Meile von Tybein entlegen, wo der weltbekannte Proseggker Wein oder Reinfall gekältert wird, der das menschlich Leben verlängert], citing Wolfgang Lazius V. II, L. 4, p. 607. [Si nostri temporis situm municipiaque spectes, occurrunt Moys Falcone ubi est ostium et portus Lisontii fluminis, Timavus fluvius cum suis fontibus, Duinum et Proseccium: atque toto isto litore vineta sunt electissima et ubi optimum Rifolium vinum praecipue Proseccchi nascitur, quod dubio procul Pu cinum illud Plinii fui]. See Carlo Marchesetti, *Del sito dell'antico castello Pucino e del vino che vi cresceva* (1878). The term ‘gekältert’ (from German verb keltern) is a word from viticulture that is often used as a synonym for winemaking (‘Herstellung’).

⁶⁸ F. Colombo, *Storie di vini dell'Adriatico*, New investigations on the relationship between Prosecco and Dalmatian Prosek, “La Ricerca”, (2014) 65, pp. 11-13.

⁶⁹ Villafranchi G.C., *ibid* 53.

⁷⁰ Joannes Baptista Goynæus Pyrrhanensis, *Archeografo triestino*, Raccolta Di Opuscoli E Notizie Per Trieste E Per l'Istria V. 2, Dottor Domenico Rossetti di Società di Minerva, Italia, 1830.

⁷¹ [È famoso oltremonti ed oltremare l'eccellente vino di Prosecco] Girolamo Agapito, *ibid* 55.

⁷² Trieste economica, n. 2, April 2009, p. 35 (citing Stefano Cosma, journalist and author of monographs on the wines of Gorizia and Trieste wines, who brought historical evidence on the origin of Prosecco).

as two Prosecco white wines produced in 1886 and 1887 by a person named Marino Luxa. These were all wine producers coming from the area around the village of Prosecco.

The above review of Prosecco's roots not only sheds light on the origins of the wine, but also on the natural and social factors contributing to the relevant *terroir*, and its reputation through the centuries. This analysis shows a connection of Prosecco with a specific geographical place which gives the wine certain qualities, with the soil, wind, hills of such area, combined with the skills and knowledge developed by the community of producers and transmitted across generations, being the main factors for such qualities.⁷³ In other words, these natural, historical and social facets of its *terroir* are at the basis of Prosecco's reputation. And more importantly, these factors confirm that the Prosecco GI meets the requirements laid down by Article 22(1) TRIPS, as it will be further explained infra, especially in Section 6.

4. Prosecco and Glera

As mentioned, it has been noted that Prosecco is just the name of the grape variety. What has been criticised in particular is the removal in 2009 of the term in question from the catalogue of varieties – the *Registro Nazionale delle Vite* –⁷⁴ and its replacement by the name “Glera”, with Prosecco being given official GI status under Italian and EU law in the very same year (but as we will see, the name “Prosecco di Conegliano Valdobbiadene” had already been protected in Italy since 1969). It has been argued that such replacement would aim at hiding the fact that before 2009 the term Prosecco had only been used to refer to the grape vine, and that the name Glera was used just sporadically in relation to the variety.⁷⁵ Several documents are relied on to support this point.⁷⁶ Yet, this argument seems weak, with the above assertions being contradicted by a multitude of other documents.

⁷³ In that regard, a precise know-how for the production of Prosecco has been developed by local manufacturers, also due to the geographical characteristics. The major milestone coincided with the creation in 1876, of the first School of Viticulture and Oenology in Italy, after Italy's King Vittorio Emanuele II signed the decree authorising its opening upon initiative of the minister of agriculture who helped collect the necessary funds. The school's predecessor was probably the Trevigiana oenological society (Societa' Enologica Trevigiana) - which had been created ten years before. These institutions contributed to the dissemination of agronomic culture, gathered resources of the territory and enhanced them through the qualitative improvement of the wine. See: Prosecco Conegliano-Valdobbiadene, '140 years School of Oenology' (5 July 2016), <https://www.prosecco.it/en/the-superiore-school/>.

⁷⁴ Ministerial Decree n. 173 of 28-7-2009.

⁷⁵ Mark Davison, Caroline Henckels and Patrick Emerton. 'In Vino Veritas? The Dubious Legality of the EU's Claims to Exclusive Use of the Term 'Prosecco'' (2019) 29 *The Dubious Legality of the EU's Claims to Exclusive Use of the Term 'Prosecco'* (December 20, 2018) 110; Danny Friedmann. 'Geographical Indications in the EU, China and Australia, WTO Case Bottling Up Over Prosecco' (2018) *European Integration and Global Power Shifts: What Lessons for Asia* 18.

⁷⁶ Prosecco has been listed as grape variety in Australia (in 2011) and Argentina (in 2012). See International Organisation of Vine and Wine, [OIV], 'International list of vine varieties and their synonyms' (2013).

While it is true that the term Prosecco was used in the past to refer to the grape, many documents (including several mentioned in the previous section) confirm that it was also used as the name of the wine produced with that grape. For example, in 1874 the Italian Professor of Agriculture Angelo Vianello and wine chemist Antonio Carpenè published the work *La vite ed il Vino nella Provincia di Treviso*.⁷⁷ By the time of this publication Antonio Carpenè was the Technical Director of the Società Enologica Trevigiana, formerly the Oenological School of Conegliano. Vianello and Carpenè noted: “With the same quality of raw material, the company obtained two types of wine [...] one, for example, is the white Prosecco, which the Society will only be able to rely on in the future, since the excellent variety from which the grapes come is now greatly extended. We are confident that the small capital of this oenological society will be greatly increased”.

References to Glera as the name of the variety can be found in non-Italian literature as well. Take the book *The World of Wines*,⁷⁸ authored by Creighton Churchill, an American wine writer and consultant. It describes the history, manufacture, appearance, and taste of wines from all regions of Europe and other areas of the world. In the first edition of 1964 Churchill writes that “Prosecco is usually found as a sparkling wine though better when made as still one”. In his work the author also acknowledges the long-standing history of Prosecco: “the Prosecco grape, known as the *Glera*, was well known in the days of the Romans”. The work further acknowledges that Prosecco is used to identify both the grape and the wine (“Prosecco (grape & wine)”) and mentions “Glera (grape) as synonym for ‘Prosecco’”. The *Statistisches Jahrbuch*⁷⁹ (Annual Abstract of Statistics) of Austria, published in 1894, is another relevant publication. It contains a comprehensive collection of grapes and production divided by territory and year: the work notes that “the territory of Trieste has 1,089 hectares of reduced vineyards”, further clarifying that “the predominant varieties are: Glera, Malvasia” and importantly that “the wine called Prosecco is made of both varieties”.⁸⁰ The *Bulletin International du Vin* of 1952 is also of interest.⁸¹ It mentions that in Trieste what is produced

⁷⁷ Angelo Vianello, and Antonio Carpenè. *La vite ed il vino nella provincia di Treviso* per Angelo Vianello e Antonio dott. Carpenè. Italia, Loescher, 1874.

⁷⁸ Creighton Churchill, *The World of Wines*, Ed. Macmillan, 1964.

⁷⁹ *Statistisches Jahrbuch*. Austria, n.p., 1895.

⁸⁰ Triest [...] Das Gebiet von Triest besitzt 1089 ha reduziertes Rebland [...]. Weißwein wird vorzüglich in den Gemeinden Opeina, Prosecco und Santa Croce erzeugt. Vorherrschende Sorten dasselbe sind: *Glera*, Malvasia (der Prosecco genannte Wein besteht aus beiden Sorten. *Ibid*, *op.cit*.

⁸¹ *Bulletin international du vin*, V. 25, pt. 1, Office international de la vigne et du vin, F. Alcan., 1952

is a white grape variety “called Glera [...]”. The Bulletin was published by the International Wine Office created on 29 November 1924 and subsequently becoming the International Vine and Wine Office in 1958. In 2001 it was replaced by the International Organisation of Vine and Wine.

Other documents are of relevance to our debate. Volume 15 of the *Agricoltura: attualità italiane e straniere* (Agriculture: Italian and foreign current events),⁸² for example, is a work published by the Istituto di Tecnica e Propaganda Agraria in 1966. It establishes a clear-cut connection between *Pucino*, Prosecco and Glera. It explains that “towards the mouth of the Timavo (Venezia Giulia) it [the grape] is cultivated under the name Glera on the pastures of Miramare and Prosecco, just above Trieste and along the Istrian coast”. Another reference to Glera as synonym for Prosecco can be found in the second volume of the *Enciclopedia monografica del Friuli-Venezia-Giulia*.⁸³ This work, published in 1971 under the title “Prosecco”, specifies “Synonym: Glera nel Friuli Venezia Giulia”. And in 1972 in his work *Invito alla strada del vino bianco* (Invitation to the street of white wine) Giuseppe Schiratti writes “it is a fact that even today in the Prosecco area (and to some extent also in the rest of the Trieste coast, as well as in some areas of eastern Friuli) a *grape* vine called *Glera* is cultivated” (emphasis added).⁸⁴ Similarly, the Volume 110 of *L'Italia Agricola*,⁸⁵ a monthly journal published by the Italian Federation of Agricultural Consortium, included an entire section on Prosecco, confirming again that Glera is a synonym for Prosecco: “Prosecco is also cultivated in the Euganean Hills in the province of Padua under the name of *Serpina* and in the province of Trieste under the name of *Glera*”. The second volume of *Storia d'Italia. Il Friuli-Venezia Giulia* is also noteworthy.⁸⁶ It is a comprehensive work of 1,140 pages written by Roberto Finzi, Claudio Magri and Giovanni Miccoli on the political and economic history of the Friuli Venezia Giulia region, published in 2002. When describing grape varieties of the region, the authors remind that in the province of Trieste one should “mention the resurrected Glera”.⁸⁷

⁸² *Agricoltura: attualità italiane e straniere*. Istituto di Tecnica e Propaganda Agraria, Vol. 15, Italia, 1966.

⁸³ *Enciclopedia monografica del Friuli-Venezia Giulia*: pt.1-2. La vita economica (2 v.). Italia, Istituto per l'Enciclopedia del Friuli-Venezia Giulia, 1971.

⁸⁴ Schiratti, Giuseppe. *Invito alla strada del vino bianco*: Conegliano, Valdobbiadene. Italia, Editrice trevigiana, 1972.

⁸⁵ *L'Italia agricola*. Italia, Ramo Editoriale Degli Agricoltori, 1973.

⁸⁶ *Storia d'Italia. Il Friuli-Venezia Giulia*. Italia, Einaudi, 2002.

⁸⁷ On the identification of Glera as the name of the vine also see P Viala and V Vermorel, *Ampelografie Tome VII* (Libraires de l'Academie de medicine, 1909). (acknowledging that Glera was as a name used in Trieste and Udine); Vitis Rauscedo, *General Catalogue* (2007), (identifying Glera and Serprina as synonyms for Prosecco); Cosmo, Grafiche Longo & Zoppelli, *Indici del Principali Vitigni Da Vino Coltivati in Italia E Guida vinicola D'Italia Volume V*, p.82-83 (noting that Glera is listed as a synonym under the heading for Prosecco along with Prosecco Balbi, Prosecco Bianco, Prosecco Tondo and Serprina); A

The latest sources are important. They not only confirm that the name Glera has been frequently and repeatedly⁸⁸ used throughout the decades to describe the grape, but also that such variety was cultivated in the area surrounding the village of Prosecco (in this regard, see again the *Statistisches Jahrbuch* and Schiratti's work). Therefore, the arguments that in 2009 the Prosecco grape was allegedly "renamed" Glera⁸⁹ is quite weak. In fact this "renomination" (or "transubstantiation", as it has also been called)⁹⁰ has never occurred: Glera has always been a name for the vine and Prosecco has always been a geographical term which distinguishes a well-known sparkling wine, and this cannot be changed by the fact that Prosecco has also been used as a synonym of Glera to refer to the grape (also, it should be reminded that there is no rule in TRIPS that prevents the name of a GI from coinciding with that of a grape variety). We will also see more in depth in the following section that the removal in 2009 of the name Prosecco from the Italian catalogue of varieties and its replacement by the name "Glera" is not arbitrary, but grounded on historical reasons.

5. The path to Prosecco GI recognition under Italian and EU law

As mentioned, Prosecco was registered as EU PDO in 2009. The European labelling system for wines, which also regulates PDO and PGI registrations, is governed by Regulation 1308/2013.⁹¹ EU Member States play a role within the system as applications are filed with competent national offices. To understand the process that have led to the PDO recognition of Prosecco it is necessary to take a step back and briefly highlight the Italian rules on GIs.

Calo, G Moretti, A Costacurta, Aree Viicole Del Veneto: Vitigni Consigliati per nuovi impianti (Allegato Al Vol XLV (1998) Degli Annali Dell'Istituto Sperimentale per la viticoltura (mentioning Glera as one of the synonyms for Prosecco at page 79). All the documents mentioned in this footnote have also been cited in the article authored by Davison, Henckels and Emerton, *ibid* 19.

⁸⁸ Conversely, Davison, Henckels and Emerton, *ibid* 19, pp. 4-5, note that "Glera is but one of several, infrequently used synonyms for Prosecco".

⁸⁹ Davison, Henckels and Emerton, fn. 2 of their article.

⁹⁰ Friedmann, *ibid* 1 p. 18.

⁹¹ Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007; OJ L 347, 20.12.2013, p. 671–854. This regulation superseded COUNCIL REGULATION (EC) No 479/2008 of 29 April 2008 on the common organisation of the market in wine, amending Regulations (EC) No 1493/1999, (EC) No 1782/2003, (EC) No 1290/2005, (EC) No 3/2008 and repealing Regulations (EEC) No 2392/86 and (EC) No 1493/1999. OJ L. 148/1 of 06.06.2008 (so called 'single CMO Regulation'). Before 2008 there was no EU wine or spirit GI names, various national laws regulated the area. See in this regard: I. Kireeva. 'European legislation on protection of geographical indications: overview of the EU member states' legal framework for protection of geographical indications' (2011) EU-China IPR2 Project, available at: <http://www.ipkey.org/en/ip-law-document/download/1165/1947/23> (accessed 15 May 2017); Andrea Zappalaglio, *The Transformation of EU Geographical Indications Law: The Present, Past and Future of the Origin Link* (Routledge 2021).

The first law on the designations of origin of wines in Italy was adopted in 1963 with the Decree of the President of the Republic n. 930/1963 “on the protection of the designations of origin of musts and wines”.⁹² This decree introduced three types of labels: Simple Designation of Origin (Denominazione d’Origine Semplice, DOS); Controlled Designation of Origin (Denominazione di Origine Controllata DOC) and Controlled Designation of Origin Guaranteed (Denominazione di Origine Controllata e Garantita DOCG). Particular attention deserves the definition of the umbrella term “denominazioni d’origine” (denominations of origin):

“the geographical names and geographical descriptions of the corresponding production areas - *whether or not accompanied by grape names* or other indications - used to designate wines which originate there and whose characteristics depend essentially on the grape varieties and the natural environmental conditions” (emphasis added).⁹³

Such a definition shows that these protected terms can include the name of a grape variety originating from the local area.⁹⁴ It is a legislative approach which clearly emphasises the strong link between the territory of origin of the grape, based on the acknowledgment that the combination of certain natural and human factors are irreproducible elsewhere. That is why it is not unusual for a wine’s name to incorporate the term for the grape,⁹⁵ with the varietal status of a GI being irrelevant for the purpose of protection (and as mentioned there is no TRIPS

⁹² Decree of the President of the Republic 930/1963 ‘on the protection of the designations of origin of musts and wines’; Decreto del Presidente della Repubblica 12 Luglio 1963 n 930 recante norme sulla tutela delle denominazioni d’origine dei mosti e dei vini, GU 15 July 1963.

⁹³ Art. 1 DPR 930. Subsequently in 1992 Italian Law No. 164 was passed which recognised the IGT (Indicazioni Geografiche Tipiche) as a type of wine with geographical indication. The Simple Designations of Origin (Denominazioni di Origine Semplice: DOS) disappeared, instead. See Andrea Zappalaglio, *ibid* 91. The IGT label represented the first step towards the Italian quality scheme. An antecedent of the IGT could be found in the Italian Royal Decree n. 1440 of 1927, protecting ‘vini tipici’ (typical wines), whose superior quality was due to ‘(...) the type of grapevines, the zone of production and the methods of production’. See Regio Decreto Legge 6 Marzo 1924 n 497, disposizioni per la difesa dei vini tipici, GURI 24 April 1924 n 97. It was converted in law by the Legge 18 Marzo 1926 n 562, GURI 3 May 1926, n 102, and subsequently amended by the Royal Law Decree 62/1930, concerning ‘Provisions for the protection of the typical Italian wines’. Legge 10 Luglio 1930 n 1160 recante disposizioni per la difesa dei vini tipici italiani, GURI 18 August 1930, n 192. It converted in law the Regio Decreto Legge, 11 Gennaio 1930 n 62. This Italian labelling system remained in force until 2009, when it was superseded by the above EU Regulation 479/2008. Yet, the EU regime on PDOs and PGIs has not entirely removed the DOCG, DOC and IGT titles – indeed, these designations have been transformed into traditional expressions, which are recognised and defined by art. 112-a) EU Reg. 1308/2013. These traditional terms serve as a parameter to further highlight the quality of a wine in relation to its area of provenance. Similar expressions are also used in France (e.g., “Château”, “cru”, “côte”, “clos”). See Art. 34 (2) and art. 54 Reg. 479/2008. See also Federdoc, ‘The Pyramid of Italian Wines’, Federdoc <https://www.federdoc.com/en/the-pyramid-of-italian-wines/> (Last accessed 15 November 2021).

⁹⁴ Mario Fregoni, *piramide DOC* (Edagricole 1994);Eugenio Pomarici. ‘Origine e qualità del vino della tradizione europea’ (2005) 58(1) Rivista di viticoltura e di enologia 15.

⁹⁵ *Ibid*.

provision which prevents a GI from also being the name of the vine). An Italian example is “Brunello di Montalcino”, a well-known wine from the hill town of Montalcino in Tuscany, made from the Sangiovese grape. Besides being an EU PDO⁹⁶ and a protected GI in Italy, “Brunello” has been considered for long time a synonym of “San Giovese”, which is name used to refer to the grape variety from which the wine is made.⁹⁷

What about the protection of the Prosecco GI in Italy? Italy’s Presidential Decree of 2 April 1969 granted the term “Prosecco di Conegliano Valdobbiadene” DOC protection.⁹⁸ This decree, and its subsequent amendments,⁹⁹ have regulated the use of the Prosecco DOC until 2009. Between 1969 and 2009 the production of Prosecco DOC comprised an area of 15 municipalities¹⁰⁰ situated between Conegliano and Valdobbiadene in the province of Treviso. A second Presidential Decree of 27 June of 1977 protected the Prosecco DOC “Montello e Colli Asolani”, whose production area was formed by 18 municipalities.¹⁰¹ The area around the village of Prosecco was not within the above-mentioned municipalities. It would be added in July 2009, when a Ministerial Decree was passed confirming the Prosecco GI status for a sparkling wine produced by using Glera grapes.¹⁰² And four months before, in March 2009, another Ministerial Decree had introduced the name Glera into the register of grapevines as a synonym of Prosecco.¹⁰³ Subsequently, in November 2009 the EU also granted PDO status to

⁹⁶ eambrosia no. PDO-IT-A1199.

⁹⁷ Art. 2, Disciplinare di produzione del vino a denominazione di origine controllata e garantita “Brunello di Montalcino” Decreto 19/5/1998 G.U. n° 133 del 10/6/1998. <https://www.consorziobrunellodimontalcino.it/en/583/>. But as will be mentioned infra in 1990 the term Brunello was deleted from the National Registry of Grape Varieties.

⁹⁸ Decree of the President of the Republic n. 930/1963 ‘on the protection of the designations of origin of musts and wines’.

⁹⁹ In particular D.P.R. del 12.06.1985; il D.P.R. del 29.08.2000; il D.M. del 30.06.2005; Decree of 25.05.2007 and Decree of 31.07.2020, published in the G.U. of 11.08.2020.

¹⁰⁰ Conegliano, San Vendemiano, Colle Umberto, Vittorio Veneto, Tarzo, Cison di Valmarino, Follina, Miane, Valdobbiadene, Vidor, Farra di Soligo, Pieve di Soligo, San Pietro di Feletto, Refrontolo, Susegana.

¹⁰¹ The entire territory of the municipality of Monfumo and part of the territory of the following municipalities: Asolo, Caerano, S. Marco, Castelcuoco, Cavaso del Tomba, Cornuda, Crocetta del Montello, Fonte, Giavera del Montello, Maser, Montebelluna, Nervesa della Battaglia, Paderno del Grappa, Pederobba, Possagno del Grappa, S. Zenone degli Ezzelini and Volpago del Montell. Disciplinare Montello Colli Asolani; source: Veneto Region Archives, 2002.

¹⁰² Ministero delle politiche agricole alimentari e forestali, Decreto 17 luglio 2009 Riconoscimento della denominazione di origine controllata dei vini «Prosecco», riconoscimento della denominazione di origine controllata e garantita dei vini «Conegliano Valdobbiadene - Prosecco» e riconoscimento della denominazione di origine controllata e garantita dei vini «Colli Asolani - Prosecco» o «Asolo - Prosecco» per le rispettive sottozone e approvazione dei relativi disciplinari di produzione, *Gazzetta Ufficiale della Repubblica Italiana*, No 173, 17 July 2009, available at <https://www.gazzettaufficiale.it/eli/id/2009/07/28/09A08700/sg>. See also V. Boatto, M. Balestrieri and L. Barisan. 'Il Mercato della Denominazione Conegliano Valdobbiadene' (2009) AA.VV. Rapporto 29.

¹⁰³ Ministero delle politiche agricole alimentari e forestali, Decreto 27 marzo 2009 Modificazioni al registro nazionale delle varietà di viti, *Gazzetta Ufficiale della Repubblica Italiana*, No 146, 26 March 2009, available at <https://www.gazzettaufficiale.it/eli/id/2009/06/26/09A07121/sg>. At that time, Prosecco wine was already acknowledged as Prosecco IGT (Indicazione Geografica Tipica), whose production area covered all regional and interregional area located between the Veneto and Friuli Venezia Giulia regions - in particular: Colli Trevigiani (concerning partially the Province of

three Italian wine, i.e. “Prosecco”, “Colli Asolani Asolo – Prosecco” and “Conegliano Valdobbiadene – Prosecco”, with Glera being listed as grapevine to avoid confusion with the name of the wine.¹⁰⁴

Having said that, the fact that the territory surrounding the village of Prosecco was not included in the pre-2009 GI production areas cannot be relied on to make the point that the term Prosecco has not been constantly used to refer to a wine produced (also) in that area. The broad literature highlighted in this article confirms such use. Obviously, the fact cannot be denied that the territory around Conegliano has historically been an important area where this wine has been produced. But this cannot refute the fact that wine called Prosecco (or Pucinum) has been produced in the Friuli Venezia Giulia and the Trieste coastline for centuries. Therefore, the 2009 Italian decrees and the EU PDO recognition above mentioned have not produced any legal fiction. They have just ratified what has occurred for hundreds and hundreds of years, i.e. the production of a wine called with the name of the place where it has been produced (through the use of a grape also called Glera) - and the fact that the production has occurred in areas such as Conegliano in the neighbouring Veneto region does not change that reality.

Also, amendments and changes in relation to grape names are not unusual. The database of the Institute for Grapevine Breeding Geilweilerhof, a German institute supported by the Federal Research Centre for cultivated plants, contains records of more than 60 changes of grape names between 2016-2020. For instance, in 2017 the grape Nitra was renamed Nitranka (which was also protected as EU PDO) to avoid confusion with the Slovakian town and wine region Nitra.¹⁰⁵ And in 1990 the term “Brunello” was deleted from the National Registry of Grape Varieties in order to avoid any risk of consumers’ confusion between the term for the grape and that of the wine.¹⁰⁶ Furthermore, the foreword to the 2013 Edition of the International list

Treviso), Delle Venezie (concerning all the provinces of the Veneto and the provinces of Pordenone, Udine and Trieste); della Marca Trevigiana (concerning the whole province of Treviso) del Veneto (concerning the provinces of Belluno, Padova, Rovigo, Treviso, Venezia, Verona, Vicenza), and Vini dell'Alto Livenza (Province of Pordenone). This IGT area played a complementary commercial role with respect to the DOC, and developed almost simultaneously to it.

¹⁰⁴ Commission Regulation (EC) No 1166/2009 of 30 November 2009 amending and correcting Commission Regulation (EC) No 606/2009 laying down certain detailed rules for implementing Council Regulation (EC) No 479/2008 as regards the categories of grapevine products, oenological practices and the applicable restrictions [2009] OJ L 314/27.

¹⁰⁵ eAmbrosia n. PDO-SK-A1357. (Nitrianska / Nitrianske / Nitriansky).

¹⁰⁶ Decree of 2.12.1993, GU n. 2 del 04.01.1994. Available at: <https://www.gazzettaufficiale.it/eli/id/1994/01/04/093A7392/sg>. [“Considerato che la varietà 'Brunello di Montalcino N, sia per il riferimento geografico che per l'omonimia con il vino a D.O.C.G. "Brunello di Montalcino", può dar luogo, nella situazione attuale, a confusione sulla zona di origine in sede di destinazione in etichetta della produzione enologica”]. [“ In view of the fact that the Brunello di Montalcino N variety, both because of its geographical reference and because of its homonymity with the D.O.C.G. wine 'Brunello di Montalcino', may at present give rise to confusion as to the area of origin when wine production is indicated on the label”]

of vine varieties and their synonyms reminds that Argentina, France, Japan, Portugal, Romania and Switzerland have requested either additions or deletions to the varieties or their synonyms.¹⁰⁷

As mentioned, one of the main objections brought by the GI Prosecco opponents is that the area of production for the GI Prosecco is now too broad, as it covers nine provinces across two regions, Friuli Venezia Giulia and Veneto, with such large territory being widened in 2009.¹⁰⁸ But it should be reminded that amendments of GI protection areas are not uncommon, also in the field of wines.¹⁰⁹ For example, in 2008 it was decided to add other 40 villages into Champagne's region.¹¹⁰ As far as the breadth of GI areas is concerned, again it is not rare to protect very large territories, especially when it comes to wines.¹¹¹ This also happens in Australia, as the case of the GI Riverina shows. Its production area stretches for 77,974 square km.¹¹² Similarly, the GI Tasmania covers an area of 68,582 square km. These are huge territories whose size can be compared to the whole of Italian regions of Sicily, Lombardy and Piemonte considered altogether, or even the whole of Switzerland. Another example is the South-Eastern Australia wine GI,¹¹³ whose territory includes the state of New South Wales (NSW), Victoria, Tasmania and the Capital Territory in their entirety. NSW alone (800,642 square km) is as big as France, Switzerland, Belgium, the Netherlands and Denmark all together.

In the past, discussions over precise boundaries regarding production areas have also caused disputes.¹¹⁴ In the case concerning Melton Mowbray Pork Pie, a group of producers opposed

¹⁰⁷ International Organisation of Vine and Wine, [OIV], 'International list of vine varieties and their synonyms' (2013).

¹⁰⁸ *Gazzetta Ufficiale della Repubblica Italiana* (Italy) No 173, 28 July 2009.

¹⁰⁹ See also Andrea Marescotti and others. 'Are Protected Geographical Indications Evolving Due to Environmentally Related Justifications? An Analysis of Amendments in the Fruit and Vegetable Sector in the European Union' (2020) 12(9) *Sustainability* 3571 (Discussing on amendments for foodstuff PDO for fruits and vegetables).

¹¹⁰ Sadie Gray, 'Celebrations in Champagne as wine region expands', *Independent UK*, (March 2008). Available at: <https://www.independent.co.uk/news/world/europe/celebrations-in-champagne-as-wine-region-expands-795818.html>

¹¹¹ Peter Drahos. 'Sunshine in a bottle? Geographical indications, the Australian wine industry, and the promise of rural development' (2017) *Geographical indications at the crossroads of trade, development and culture* 2596.

¹¹² *Geographical Indications of Australia (Wine Zones, Regions and Subregions)*. Published 2021. Available at: https://wineaustralia-opendata.wineaustralia.hub.arcgis.com/datasets/33a5831a427c44c4844c9d8120ee2fae_1/explore?location=-35.528051%2C141.376632%2C5.93. The Riverina GI has been registered in 1998, n. 59.

¹¹³ South Eastern Australia Geographical Indication, Wine Australia – Australian Government. Available at: <https://www.wineaustralia.com/labelling/register-of-protected-gis-and-other-terms/geographical-indications/south-eastern-australia>

¹¹⁴ Dev Saif Gangjee. 'Melton Mowbray and the GI pie in the sky: exploring cartographies of protection' (2006) 3 *Intellectual Property Quarterly* 291.

the PGI application for a foodstuff,¹¹⁵ arguing that the production boundaries should be limited to the English town of Melton Mowbray. The UK High Court first¹¹⁶ and the European Commission later did not agree and acknowledged that the geographical *milieu* may extend beyond formal administrative bounds.¹¹⁷ Another interesting example is the delimitation of the Australian Coonawarra wine GI area.¹¹⁸ This only materialised after nearly 10 years of a dispute between those who sought protection of the solely ‘red’ strip (an area which is known for producing high quality wine), and those winemakers which – because they are located outside such area – advocated for a broader boundary.¹¹⁹ The Geographical Indication Committee eventually agreed on an initial delimitation based on both scientific and historical usage criteria, but the Administrative Appeals Tribunal (AAT) enlarged the boundary, giving importance to historical evidence.¹²⁰

6. The EU PDO Prosecco and the GI definition under TRIPS

It has been noted that the Prosecco EU PDO does not fulfil the requirements laid down by Article 22(1) TRIPS (which as mentioned states that “geographical indications are [...] indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is

¹¹⁵ Melton Mowbray Pork Pie Application to Register PGI (National File No. PGI/05212).

¹¹⁶ Northern Foods Plc v. DEFRA, Melton Mowbray Pork Pie Association [2005] EWHC 2971 (Admin).

¹¹⁷ See also Matthew J. Rippon. 'Traditional foods, territorial boundaries and the TRIPS Agreement: the case of the Melton Mowbray Pork Pie' (2013) 16(5-6) The Journal of World Intellectual Property 262.

¹¹⁸ *Penola High School v. Geographical Indications Committee*, 2001 WL 1191982; [2001] AATA 844 (first instance); *Beringer Blass Wine Estates Ltd v. Geographical Indications Committee*, 20 September 2002, Federal Court of Australia, 125 FCR 155 (appeal decision).

¹¹⁹ Gary Edmond. 'Disorder with law: determining the Geographical Indication for the Coonawarra wine region' (2006) 27 Adel.L.Rev. 59 (describing the dispute, the characteristics of the soil and interests at stake, and noting in particular that since the 1960's this slightly raised “red” platform, also known as the ‘strip’, ‘cigar’ or ‘ridge’, is one of the defining features in the history of grape and wine production in the district, but as the wine industry rapidly expanded, in the 1980s and particularly the 1990s, vineyards were planted well beyond the famous *terra rossa* soils conventionally associated with the platform and the town of Coonawarra.) The dispute arose along with the need of delineating the boundaries for the GI. See also Chris Shanahan, Coonawarra Boundary controversy (July 1993), available at <https://chrisshanahan.com/articles/1993/coonawarra-boundary-controversy/>. Those producers falling inside the GI delineated in the Final Determination were trying to argue that the Coonawarra wine region should be proximate to the township and immediate surrounds, particularly the red stripe, whereas those excluded were attempting to correlate the Coonawarra wine region with the broader district. It took from 1994 to 2000 to produce a boundary which was set by the Australian Administrative Court. See in this regard *Penola high School v Geographical Indications Committee* 2001 WL 1191982; [2001] AATA 844 (striking a compromise: the appeals tribunal reinstated 25 vineyards that were left out by the Geographical Indications committee, but the whole area is not as large as some wine producers would have liked). See also Harvey Steiman, Australia Court Settles Dispute over Coonawarra's Boundaries, Wine spectator, (October 2001), available at: <https://www.winespectator.com/articles/australian-court-settles-dispute-over-coonawarras-boundaries-21053>.

¹²⁰ Dev Gangjee, *Relocating the law of geographical indications*, vol 15 (Cambridge University Press 2012) p. 106-108.

essentially attributable to its geographical origin”).¹²¹ They argue so on the grounds mentioned in the previous pages, i.e. the wine in question (i) would not originate from the village of Prosecco and (ii) would not have a particular quality and reputation linked to the area around that village. We have already seen that many sources prove point (i) wrong. What about the link between the territory around the village of Prosecco and the quality and reputation of the wine?

As also mentioned earlier in the paper and confirmed in the EU PDO application filed by the Consorzio di Tutela del Prosecco, the territory in question is characterised by a unique microclimate. Situated between the sea and the Pre-Alps, it has a mild temperate climate which plays a fundamental role in the aromas of the wine. The alps located in the north from mountain range work as a barrier to northern cold winds, while the Adriatic Sea in the south results in a constant ventilation that allows the vineyards to dry out quickly from the rain, which is very frequent, especially in summer. The hills of the Prosecco area have excellent exposure to the sun on the southern side, while on the northern side they are mostly covered by woodland. The soil is made up of rock, sand and clay that has absorbed the sediment carried downstream by the Friulan Dolomite glaciers. Another peculiarity of the soil is the slope of the hills, which ensures the drainage of rainfall and prevents it from stagnating.¹²²

Both the provinces of Trieste and Treviso play an important role in the history of prosecco (in particular, the Trieste area - where the village of Prosecco is located - reflects the historical link between the local area and the quality of the wine). Such role - as mentioned, also highlighted by Plinius -¹²³ is clearly evidenced in the EU PDO registration:¹²⁴ “When the grapes are harvested and the wine produced and bottled exclusively in the provinces of Treviso and Trieste, the special mention Treviso or Trieste may be written on the label in recognition of the invaluable part these two provinces have played in the history of ‘Prosecco’”.

¹²¹ Mark Davison, Caroline Henckels and Patrick Emerton. 'In Vino Veritas? The Dubious Legality of the EU's Claims to Exclusive Use of the Term 'Prosecco'' (2019) 29 The Dubious Legality of the EU's Claims to Exclusive Use of the Term 'Prosecco'(December 20, 2018) 11020, Sec. IIIA.

¹²² The above description of the pedoclimatic area is highlighted in the Prosecco's GI application EU PDO and the reply letter to the Indian trademark office of December 2014 in the context of the GI registration proceedings n. 503 before the Indian Intellectual Property Office: PDO Application for Prosecco: docket number PDO-IT-A0516-AM01; Application No. 503, India; see also Roberta Lucci, *Il Prosecco: ruolo del terroir nella definizione della qualità* (Prosecco: the role of the *terroir* in the definition of quality attributes), Tesi di Laurea Magistrale in scienze e tecnologie alimentari, Università degli Studi di Padova Dipartimento di Agronomia, Animali, Alimenti, Risorse Naturali e Ambiente, Anno Accademico 2012-2013, available at: http://tesi.cab.unipd.it/44343/1/Lucci_Roberta.pdf.

¹²³ Plinius, *ibid* 51.

¹²⁴ *Ibid* 122.

It is true that the broad production area stretching from Conegliano (in the Treviso area) to Trieste (including the area around the village of Prosecco) is characterised by the coexistence of different types of soil as well as a hilly conformation with steeper and gentler slopes, with such micro-zones producing different kinds of Prosecco wine.¹²⁵ Yet, despite these differences, all territories within the broader geographical area share a common natural factor. As reminded in the Prosecco GI application filed in India: “[A]s can be expected, the land in this relatively large territory is very diverse but the climate on the whole is mild: the area is protected by the Alps to the north and caressed by the warm breezes which come off the Adriatic Sea to the east”.¹²⁶

In addition to the documents highlighted in Section 3, several others specifically confirm the high quality and reputation of the Prosecco wine throughout the centuries. This wine was regularly reported as a “delicious”,¹²⁷ “excellent”¹²⁸ and “famous”,¹²⁹ and even as the “king of wines”.¹³⁰ In 1754 the dithyramb poem *Il Rocco*, authored by Aureliano Acanti, a poet and priest of the Congregation of Clerics Regular, praised its “melaromantic” quality: “and now I would like so much to wet my mouth with the melaromantic Prosecco”.¹³¹ Furthermore, in 1838 *Il Giornale della Provincia di Bergamo* reported that “there is no wine that is not as highly regarded as this one [Prosecco]”.¹³² The high quality of wine produced in the Trieste area is further confirmed by a decree introduced by Archduke Maximilian Ernest of Austria, dated 3 April 1610, according to which the introduction of grapes from other areas into the territory of Trieste was prohibited, “so as not to harm the glory” of Trieste’s wine.¹³³ Philipp Klüver’s study, mentioned above, is also important when it comes to acknowledging the link between the Prosecco wine and the area where the village of Prosecco is, especially around the Timavo river. Klüver indeed highlighted the good quality of the wine and mentioned the local

¹²⁵ Such diverse characteristics are reflected in the different PDOs owned by the Consorzio di Tutela del Prosecco, i.e. Colli Asolani – Prosecco, Asolo -Prosecco and Conegliano Valdobbiadene. Furthermore, some include the special mentions “superiore” or “province of Treviso”.

¹²⁶ Application No. 503, India.

¹²⁷ *Giornale della Provincia di Bergamo*, *ibid* 53.

¹²⁸ Philipp Klüver [Philippi Clvverii], *ibid* 52.

¹²⁹ Girolamo Agapito, *ibid* 55.

¹³⁰ [“il vino di *Prosecco* fu dagli antichi incoronato re de’ vini”], Giuseppe Vallardi, *Itinerario d’Italia*, Milano, 1835

¹³¹ Dittirambo, A.A., *Il Rocco*, Venice, 1754.

¹³² [“non vi è vino che non sia tanto riputato quanto lo è questo”], *Giornale della Provincia di Bergamo*, *ibid* 53.

¹³³ Girolamo Agapito, *ibid* 55.

landscape, soil and climate: “excellent wines [...] among [...] Timavus and Trieste are produced by the inhabitants of the region learned; the names of which [...] [is] prosecco”.¹³⁴

In light of the above, it seems that the Prosecco GI does in fact satisfy the requirements laid down by Article 22(1) TRIPS.

7. The TRIPS grandfather clause and generic name exception

One may also make the point that Australian winemakers have the right to use the term Prosecco because their wine making business had often been started by immigrants coming from Italy, especially from its North-Eastern regions. Seen from their perspective, being obliged to stop using the term Prosecco (what the EU and Italy aim at in the current negotiations for a trade agreement between the EU and Australia) would be unfair and disrupt existing legitimate marketing practices. After all, it may be argued that Italian immigrants (and their descendants) who have brought to Australia the centuries-old methods of production of this wine should be able to use the Prosecco name. As noted by the Winemakers’ Federation of Australia in the 2013 case *Winemakers’ Federation of Australia v European Commission* (where the Australian Trade Marks Office found that the term Prosecco should be considered just the name of the grape variety):¹³⁵ “cultural and other similar references must be seen in the context of Australia as a migrant community where references to the rich tapestry of history and tradition of our forebears are commonplace”.

The needs of emigrants’ businesses that had started using geographical names of the areas where they came from are indirectly addressed by the TRIPS Agreement. Article 24(4) sets out an exception aimed to safeguard the acquired rights of producers who had been continuously using a GI protected for wines and spirits in another country in respect to the same goods and services.¹³⁶ In other words, where in Country A producers use a GI similar to a GI already

¹³⁴ “Nobilissimum illud vinum tribus potissimum locis five vicis inter Timavum & Tergeste gigni, ab incolis huius regionis didici; quorum nomina, prosecco” Philipp Klüver [Philippi Clvverii], *ibid* 52.

¹³⁵ *Winemakers’ Federation of Australia v European Commission* [2013] ATMOGI 1 (22 November 2013).

¹³⁶ “Nothing in this Section shall require a Member to prevent continued and similar use of a particular geographical indication of another Member identifying wines or spirits in connection with goods or services by any of its nationals or domiciliaries who have used that geographical indication in a continuous manner with regard to the same or related goods or services in the territory of that Member either (a) for at least 10 years preceding 15 April 1994 or (b) in good faith preceding that date” TRIPS Agreement. 'Agreement on Trade-Related Aspects of Intellectual Property Rights 15 Apr. 1994' (1994) 33 Marrakesh, reprinted in *International Legal Materials* 1125. In this regard, see also: Felix Addor and Alexandra Grazioli. 'Geographical

protected in Country B, the former state is not required to prevent continued and similar use of the GI.¹³⁷ This is the so-called grandfather clause, or legacy clause, which permits companies and people to continue carrying out activities or operations that were legitimate before the entry into force of the new rules. Those who are exempted from the new provisions are said to enjoy “acquired rights” or “grandfather rights”.

Yet, for the grandfather clause to apply it is necessary under Article 24(4) TRIPS that the use of the GI in Country A (in our case, Australia) had been taking place in a continuous way at least ten years before the date of entry into force of TRIPS: for Australia that would be 1st January 1995. A second (alternative) criterion under Article 24(4) TRIPS is that the GI has been used “in good faith” prior to 15 April 1994, the date the TRIPS Agreement was signed. That said, it is clear that the use by Australian winemakers of the term Prosecco (which had already been officially protected in Italy as a GI), cannot be grandfathered because it was first commercialised in 2004,¹³⁸ therefore after 1994.

That said, could Australia then invoke Article 24(6) TRIPS claiming that the expression Prosecco has become in its territory the customary name of the grape? This provision states that TRIPS does not “require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to products of the vine for which the relevant indication is identical with the customary name of a grape variety *existing* in the territory of that Member as of the date of entry into force of the WTO Agreement [1st January 1995]” (emphasis added).

We believe it would be difficult for Australia to make that point. Indeed, although the 1994 Agreement did mention Prosecco as the name of the vine,¹³⁹ until the late 1990s and early 2000s, no grape known as ‘Prosecco’ has ever been imported to, or grown in, Australia. In other words, no such grape with that name was “existing” in Australia on 1st January 1995. This is a fact. And such fact cannot be undermined by a mention of the term Prosecco as grape

indications beyond wines and spirits: A roadmap for a better protection for geographical indications in the WTO/TRIPS agreement’ (2002) 5 J. World Intell. Prop. 865.

¹³⁷ Meir Perez Pugatch, *The intellectual property debate: Perspectives from law, economics and political economy* (Edward Elgar Publishing 2006).

¹³⁸ See “*The first Dal Zotto Prosecco is released on to the market - only 200 dozen*”, Dal Zotto Website, Timeline, (last accessed 15 July 2021). Available at: <https://www.dalzotto.com.au/dal-zotto-timeline>.

¹³⁹ See Annex II, V(A)(2.2.5) of the 1994 Agreement, with which Australia agrees to protect EU GI “Montello e Colli Asolani, accompanied by [...] the name of one of the following vine varieties: - Prosecco”.

variety in the 1994 Agreement (Australia, for example, may be tempted to argue that the main purpose of this reference in the list was to allow Australian wine makers to use the name of the grape variety).¹⁴⁰ But what makes Australia's position even weaker is the fact that only after the commercial success of the Italian Prosecco well before the late 90s, Australian winemakers have started growing a vine which they call Prosecco. It thus seems that the 'need' to actually consider the term in question as just "the customary name of a grape variety"¹⁴¹ has arisen in Australia as a consequence of the commercial boom of the Italian Prosecco. Before that, Australia had even recognised in the 1994 Agreement that "Prosecco di Conegliano (Valdobbiadene)", whether or not accompanied by the term "Superiore di Cartizze", was a GI also protected in Australia.¹⁴² And the fact that the subsequent 2008 Agreement between the EU and Australia only refers to just "Conegliano-Valdobbiadene", the term Prosecco having been removed, does not seem to constitute a solid ground for claiming that such name refers just to the grape.

There is another related factor which weakens Australia's point that Prosecco should be considered just the name of a grape variety, but not an Italian GI. When marketing and promoting their Prosecco labelled wine, Australian winemakers have constantly relied on the so-called 'Italian sounding', i.e. a phenomenon consisting of the use of terms and images that evoke Italy to push consumers into buying products which in fact do not originate from Italy. Take the wine making business of Otto Dal Zotto, an Italian citizen who was born in Veneto and then emigrated to Australia. Dal Zotto pioneered the commercialization of Australian Prosecco, by also using the name Pucino (as mentioned earlier, this is the ancient Roman name for Prosecco).¹⁴³ The wine is produced by Dal Zotto (as well as other wineries, e.g. Pizzini)¹⁴⁴ in the area of King Valley in Victoria High Country, and widely promoted as an "Italian style" product. What is also striking is the appropriation of the "Prosecco Road" initiative by Australian winemakers. The original Italian "Strada del Prosecco" was created in Italy in 1938 by Professor Italo Cosmo (an agronomist and viticulture expert) and then realised in 1966 by

¹⁴⁰ See also Danny Friedmann. 'Geographical Indications in the EU, China and Australia, WTO Case Bottling Up Over Prosecco' (2018) *European Integration and Global Power Shifts: What Lessons for Asia* 18, pp. 7-11 (discussing the Australian GI system), and pp. 18-20 (discussing the Prosecco controversy).

¹⁴¹ This is the language used by Article 24(6) TRIPS, *ibid* 136.

¹⁴² See above Section 2.

¹⁴³ Description of wine label "Pucino" for Australian prosecco commercialized for first time in 2004 by Dal Zotto, an Italian born in Valdobbiadene, Italy. See the website at <https://www.dalzotto.com.au/dz-prosecco>

¹⁴⁴ See the website at <https://www.pizzini.com.au/>. "Created from Prosecco grapes in the northern Veneto region of Italy in the foothills of the Alps; We plant Prosecco on the cool King Valley floor" [...] "A fun Italian style sparkling [...]"

Giuseppe Schiratti.¹⁴⁵ It is an established itinerary which takes wine lovers into a journey through the Prosecco vineyards, including wine testing experiences and visits to castles, abbeys and churches. Such idea has been replicated in Australia, with consumers being invited to choose the “King Valley’s Prosecco Road”: visitors are suggested to “[v]enture to the King Valley in Victoria’s High Country and [you] could be forgiven for thinking you[’d] been transported to the picturesque hills of northern Italy” and experience “an exciting new food and wine trail especially for lovers of the sparkling Italian white”, through driving and cycling “the trail as you enjoy intimate tastings with the makers, savouring rustic Italian cuisine”.¹⁴⁶

It thus seems rather difficult to agree on the argument put forward by Australia, and its wine industry, namely that Prosecco is just a name which describes a specific grape but does not refer to an Italian wine. If that is true, why would Australian winemakers need to rely on Italian sounding terminology when advertising and selling their bottles? This seems to be an attempt to confuse consumers about the origin of the product and capitalise on the prestige of an established and historic Italian wine. In other words, it appears to be a behaviour which goes well beyond the use of mere “cultural [...] references [...] in the context of Australia as a migrant community” and its “rich tapestry of history and tradition”, as instead argued by Australian Grape and Wine.¹⁴⁷

Finally, it should also be reminded that under international law rules governing the use of the grapevine as a generic term are quite strict. The 1891 Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods¹⁴⁸ provides that, while designations of products could legitimately be used in a generic sense, this does not apply to grapevines’ names.¹⁴⁹ More specifically, Article 4 states that: “The courts of each country shall decide what appellations, on account of their generic character, do not fall within the provisions of this Agreement, *regional appellations concerning the source of products of the vine being, however, excluded from the reservation specified by this Article*” (emphasis added). The reason

¹⁴⁵ Schiratti, Giuseppe, *ibid* 84.

¹⁴⁶ Kings Valley Prosecco Road’, available at: <https://www.visitmelbourne.com/Regions/High-Country/Food-and-wine/Wine-regions/King-Valley-wine-region/Prosecco-Road>. See also See for instance Wine News, Prosecco Road in Australia: Italian origin grape growers have created a “wine road” in king valley, dedicated to the famous venetian grapevine. Talk about “Italian sounding” (August, 2011), available at https://winenews.it/en/prosecco-road-in-australia-italian-origin-grape-growers_310206/ (discussing on Prosecco Road in Australia, evoking the Italian *Strada del Prosecco*).

¹⁴⁷ *Ibid* 135.

¹⁴⁸ Madrid Agreement for the Repression of False and Deceptive Indications of Source on Goods, Apr. 14, 1891, 828 U.N.T.S. 168.

¹⁴⁹ See also Felix Addor and Alexandra Grazioli. 'Geographical indications beyond wines and spirits: A roadmap for a better protection for geographical indications in the WTO/TRIPS agreement' (2002) 5 J.World Intell.Prop. 8659.

of this exception is that grape varieties are anchored more tightly to their origin as they are intrinsically linked to the climate and terroir of a particular area, so as to make genericide almost impossible. As noted by Dev Gangjee, “their designations are *de jure* inoculated”.¹⁵⁰ While the Madrid Agreement has not been signed by countries such as Australia, US and Canada, it still constitutes relevant international treaty law, and as such could be taken into account by an adjudicating body such as a WTO panel when it comes to deciding cases.

8. Concluding remarks

The EU (and Italy) regularly seek to protect GIs for agricultural and food products as well as wine and spirits, at home and in countries with which bilateral negotiations are undertaken. The Prosecco case epitomises both this quest for protection and the attempt of a *New World* country (Australia) to resist such demands from the *Old World*. This is thus a tale of different approaches: while the EU and Italy do believe that these names must be safeguarded by strengthening the monopoly GIs secure, Australia invokes a less protectionist regime, which should allow all wine producers to use names locally considered the common name of the grapevine.

We do believe that Italy has the chance of prevailing in a hypothetical WTO dispute, should such an action be started by Australia. The history of Prosecco wine, highlighted in this article, suggests that the name Prosecco has been used not only to describe the grape but also as a geographical name. We have seen that (i) it is not unusual for wines’ names to incorporate the terms describing the variety (and TRIPS does not prevent that); (ii) GI areas may be so broad to include a wide territory, including in regions neighbouring the geographical location which gives the wine its name; and (iii) the area surrounding the village of Prosecco has been important to give the wine the quality and reputation it now undoubtedly has. Therefore, far from being a “legal fiction”, the recognition of Prosecco as GI under EU and Italian laws just ratifies something which is rooted in history (and geography): i.e. the production of wine in and around a specific village, the identification of such wine with the name of that village and the quality and reputation of a product intrinsically linked with that local area. That is the reason why the Prosecco GI is likely to satisfy the definition of geographical indication under Article 22(1) TRIPS.

¹⁵⁰ Dev Gangjee, *Relocating the law of geographical indications*, vol 15 (Cambridge University Press 2012) *ibid* 120 p. 68.

Italy, supported by the EU, will certainly put all its efforts to try to prevail in this row. It does not have other options. Protecting the powerful Prosecco brand is an imperative priority for the Italian government, not only to protect its gastronomic heritage but also to safeguard the revenues this wine generates and the worldwide boost it gives to the Italian economy. Also, this is not the only Prosecco front Italy is currently fighting on. Threats also come from within the EU. The European Commission has recently announced it will follow up soon on the Croatia's application to register the traditional expression "Prošek". This term refers to a sweet wine made from sun-dried grapes from Dalmatia. Although this dessert wine has nothing to do with Prosecco, Croatia's move is controversial because the two names are similar.¹⁵¹

So, it seems that GI academics and lawyers will soon be busy in observing and commenting on how these disputes will end up. As the rows promise to be harsh, they would better get ready and wait ... while sipping a good Prosecco wine.

¹⁵¹ Bonadio – Contardi, *ibid* 23.