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ENRICO BONADIO\* / MAGALI CONTARDI\*\* / NICOLA LUCCHI\*\*\*

# Geographical Indications Between the *Old World* and the *New World*, and the Impact of Migration

The article focuses on the use of European geographical names in certain countries of the so-called 'New World' (i.e. nations reached in the past by waves of European migration) and the impact of such migration on the debate around the protection of geographical indications (GIs). Specifically, the article analyses four GIs case studies – 'Prosecco', 'Budweiser', 'Rioja' and 'Parmesan' – which highlight the role of migration in this context and how countries of the New World (e.g. US, Canada, Australia, etc.) emphasise this role to argue that several European geographical names of food and wine products are just the generic terms for the products themselves. The 'migration' factor however is downplayed by the EU (i.e. the Old World), which stresses that European GIs still have a distinctive function linked to the geographical origin of the underlying product and should be protected in Europe and beyond.

## I. Introduction

This article<sup>i</sup> focuses on the use of European geographical names in certain countries of the 'New World' (i.e. nations reached in the past by waves of European migration) and the impact of such migration on the debate around the protection of geographical indications (GIs). Specifically, the paper analyses four GIs case studies which highlight the role of migration in this context and how countries of the New World (e.g. US, Canada, Australia) emphasise this role to argue that several European geographical names of food and wine products are just the generic terms of the products themselves. Those states are in fact nations built by immigrants who brought their culture to the New World. When Europeans emigrated to other countries – it is noted – some of them continued to produce the cheese, wine, and spirits they had traditionally made in Europe. They essentially 'brought' with them both the methods of making the products and their geographical names to their new homes and used them in good faith. The 'migration' factor is, however, downplayed by the EU, which stresses that European GIs still have a distinctive function linked to the geographical origin of the underlying product and should be protected in Europe and beyond.

\* Reader in Intellectual Property Law, City, University of London, United Kingdom.

\*\* Post-doc Research Fellow, Sant'Anna School of Advanced Studies, Pisa, Italy.

\*\*\* Serra Hüner Associate Professor of Law, University Pompeu Fabra, Barcelona, Spain.

<sup>i</sup> This article presents a revised version of the paper that was originally presented at the 14th Annual Workshop of the International Society for the History and Theory of Intellectual Property (ISHTIP), held at Tel Aviv University on 20–21 June 2023 (Israel). We are grateful to the workshop participants for their valuable comments and engaging discussions during the conference. Special thanks go to Dotan Oliar for serving as the paper's commentator and providing helpful insights. This article represents the collaborative efforts of all authors, who are listed in alphabetical order. Each author contributed equally to this work, and the order of authorship does not imply any differences in their individual contributions.

The article is structured as follows. Section II briefly highlights the GIs protection regime within the EU (which here represents the Old World) and beyond. Section III explores the differences between such regimes and how geographical names are protected in countries such as the US, Canada, Australia, and Chile (New World). It also mentions how the EU is trying to use free trade agreements to export its (notoriously strong) regime of GI protection to other areas of the planet. Section IV constitutes the heart of the article as it analyses the four case studies in question which highlight the tension between the systems of GIs protection in the Old World and those in the New World: 'Prosecco', 'Budweiser', 'Rioja' and 'Parmesan'. Section V concludes.

## II. GI Protection within the EU and Beyond

The agricultural and food product quality policy was developed in what is now the EU<sup>1</sup> with the intention of being one of the instruments of the Common Agricultural Policy (CAP) and helping reduce overproduction, increase farmers' incomes and preserve rural communities.<sup>2</sup> There is no doubt that GIs protection, primarily focused on the concept of *terroir* (which can be defined as an ecosystem characterised by several factors including local climatic conditions, geography and topography), is one of the most important titles in the variegated mosaic of EU laws which promote

<sup>1</sup> See 'The future of rural society. Commission communication transmitted to the Council and to the European Parliament. COM (88) 501 final, 28 July 1988. Bulletin of the European Communities, Supplement 4/88' [EU Commission - COM Document]. For ease of reference, in the article we will often also use the acronym EU when referring to its predecessor, ie the European Community.

<sup>2</sup> See Alessandra di Lauro, 'Le Denominazioni di Origine Protette (DOP) e le Indicazioni Geografiche Protette (IGP)' in Paolo Borghi and others (eds), *Trattato di diritto alimentare italiano e dell'Unione europea* (Giuffrè 2021) 431.

the agrifood sector.<sup>3</sup> The mantra is that EU GIs laws do not just protect local producers from those who appropriate and exploit their names in the marketplace. They also contribute to the promotion of public goods such as the conservation of biodiversity, the protection of cultural heritage and know-how, the socio-cultural development and the fight against rural poverty.<sup>4</sup>

There are currently four pieces of EU legislation on GIs addressing different categories of products, i.e. agricultural products and foodstuffs,<sup>5</sup> wines,<sup>6</sup> aromatised wines<sup>7</sup> and spirit drinks.<sup>8</sup> The first piece of EU GI legislation was introduced in the early 1990s, i.e. Regulation 2081/92.<sup>9</sup> It was negotiated while EU decision-makers were discussing the reform of the CAP and ultimately provided an important opportunity to further harmonize GIs by creating two main titles of protection: the Protected Designations of Origin (PDOs) and the Protected Geographical Indications (PGIs).<sup>10</sup> Initially, the process was not a smooth one. There were a variety of reasons for this, including the fact that some EU Member States had not adopted any scheme of GI protection before 1992.<sup>11</sup> Regulation 2081/92 was subsequently replaced by Regulation 510/2006,<sup>12</sup> which in turn was repealed by Regulation 1151/2012.<sup>13</sup> Although

<sup>3</sup> See eg Giovanni Belletti and Andrea Marescotti, 'Origin Products, Geographical Indications and Rural Development' in Elizabeth Barham and Bertil Sylvander (eds), *Labels of Origin for Food: Local Development, Global Recognition* (CABI 2011) 75; Andrea Zappalaglio, *The Transformation of EU Geographical Indications Law: The Present, Past and Future of the Origin Link* (Routledge 2021).

<sup>4</sup> See eg Philippe Cullet, *Intellectual Property Protection and Sustainable Development* (LexisNexis, Butterworths 2005) 333-36 (arguing how geographical indications can function as a tool for addressing traditional knowledge concerns); Daphne Zographos, 'Can Geographical Indications Be a Viable Alternative for the Protection of Traditional Cultural Expressions?' in Fiona Macmillan and Kathy Bowrey (eds), *New Directions in Copyright Law* (Edward Elgar 2006) 37, 55; Toshiyuki Kono, 'Geographical Indication and Intangible Cultural Heritage' in Benedetta Ubertazzi and Esther Muñiz Espada (eds), *Le Indicazioni di Qualità degli Alimenti* (Giuffrè 2009) 289, 293; Daniel Gervais, 'Traditional Knowledge: Are We Closer to the Answers? The Potential Role of Geographical Indications' (2009) 15 *ILSA J. of Int. and Comp. Law* 551; Teshager Dagne, *Intellectual Property and Traditional Knowledge in the Global Economy: Translating Geographical Indications for Development* (Taylor & Francis 2014) (examining the role GIs can play in protecting traditional knowledge).

<sup>5</sup> Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs [2012] OJ L343.

<sup>6</sup> Regulation (EU) No 1308/2013 establishing a common organisation of the markets in agricultural products and repealing Regulations 922/72, 234/79, 1037/2001 and 1234/2007 [2013] OJ L347.

<sup>7</sup> Regulation (EU) 251/2014 on the definition, description, presentation, labelling and the protection of geographical indications of aromatised wine products and repealing Regulation 1601/91 [2014] OJ L84.

<sup>8</sup> Regulation EU 2019/787 on the definition, description, presentation and labelling of spirit drinks, the use of the names of spirit drinks in the presentation and labelling of other foodstuffs, the protection of geographical indications for spirit drinks, the use of ethyl alcohol and distillates of agricultural origin in alcoholic beverages and repealing Regulation 110/2008 [2019] OJ L130.

<sup>9</sup> Regulation (EEC) 2081/92 of the Council of July 14, 1992, on the protection of geographical indications and designations of origin for agricultural products and foodstuffs [1992] OJ L208.

<sup>10</sup> Regulation 2081/92 also created the so-called Certificates of Specificity, now called Traditional Speciality Guaranteed (TSG). This title protects the traditional aspects of a product e.g. the manufacturing technique. When a name is registered as TSG, it is protected against falsification and misuse.

<sup>11</sup> See di Lauro (n 2).

<sup>12</sup> Commission Regulation (EC) No 510/96 of 22 March 1996 concerning the classification of certain goods in the combined nomenclature [1996] OJ L76/7.

<sup>13</sup> Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs [2012] OJ L343.

the original system has been substantially maintained, the current system has undergone some changes, including the legal basis used to enact the act. While the previous basis was the CAP, the current one is found in Art. 118 of the Treaty on the Functioning of the European Union, which allows the European Parliament and the Council to establish measures to create pan-European intellectual property rights.<sup>14</sup> In March 2022, the European Commission adopted a proposal to review the GIs system for wine, spirit drinks and agricultural products, which are currently scattered across the above-mentioned three separate Regulations.<sup>15</sup> The newly proposed instrument aims at boosting the production of traditional quality products and enhancing the level of protection for GIs, including online. Therefore, GIs are protected in the EU not only to implement agricultural product quality policy, but also to promote intellectual property and fair competition in the relevant markets.

The protection offered to PGIs and PDOs in the EU is remarkably strong. Both titles serve to safeguard the names of products that possess characteristics associated with the soil and local regions, and are manufactured in accordance with specific production methods (e.g. 'Rioja' and 'Champagne' wines, 'Parmigiano Reggiano' cheese, 'Salame Felino', 'Mortadella di Bologna', 'Mutarde de Bougorgne', and 'Gruyère' cheese). As is known, Protected Designations of Origin (PDOs) ensure that the entire manufacturing process is conducted within a designated geographical area, from inception to completion. On the other hand, Protected Geographical Indications (PGIs) are awarded even if only a single phase of the production process takes place within the specified territory. Since there is a direct link between the quality and reputation of the product and the place from which it comes, it is argued that the EU system of geographical indications promotes cultural and gastronomic heritage. Moreover, for some years, the possibility of protecting non-agricultural traditional products such as cutlery, leather, ceramics, and glassware (e.g. Murano glass) as GI has also been discussed. Some EU countries have already taken legislative action and introduced GI protection for industrial products, and in April 2022 the Commission adopted a proposal for a new regulation on GIs for this category of goods, which was approved by the European Parliament in September 2023.<sup>16</sup>

<sup>14</sup> See Consolidated Version of the Treaty on the Functioning of the European Union art 118 [2010] OJ C83/47 (stating that 'In the context of the establishment and functioning of the internal market, the European Parliament and the Council, acting in accordance with the ordinary legislative procedure, shall establish measures for the creation of European intellectual property rights to provide uniform protection of intellectual property rights throughout the Union and for the setting up of centralised Union-wide authorisation, coordination and supervision arrangements. The Council, acting in accordance with a special legislative procedure, shall by means of regulations establish language arrangements for the European intellectual property rights. The Council shall act unanimously after consulting the European Parliament').

<sup>15</sup> See Proposal for a Regulation of the European Parliament and of the Council on European Union geographical indications for wine, spirit drinks and agricultural products, and quality schemes for agricultural products, amending Regulations (EU) No 1308/2013, (EU) 2017/1001 and (EU) 2019/787 and repealing Regulation (EU) No 1151/2012, COM/2022/134 final/2 <[https://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:52022PC0134R\(01\)](https://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:52022PC0134R(01))> accessed 29 October 2023.

<sup>16</sup> Proposal for a Regulation of the European Parliament and of the Council on geographical indication protection for craft and industrial products and amending Regulations (EU) 2017/1001 and (EU)

It is interesting to note that what can be protected as a PDO or PGI are also GIs from countries outside the EU.<sup>17</sup> The right to register non-EU GIs was initially subject to the existence in the state where the GI applicant was established of a kind of protection like the one granted by the EU. This condition triggered two parallel disputes at the World Trade Organization (WTO), with the US and Australia challenging certain substantive and procedural requirements imposed on non-EU countries where GI applicants came from – requirements which were considered by the complainants to be discriminatory. The WTO Panel partially sided with the US and Australia.<sup>18</sup> To date, several non-EU countries have registered GIs through the

EU GIs system,<sup>19</sup> with the first African PDO being protected in 2021, i.e. Rooibos/Red Bush.<sup>20</sup>

### III. Old World vs New World

As mentioned, safeguarding GIs through granting PDOs and PGIs constitutes a fundamental aspect of Europe's agricultural and food policy. However, certain countries, particularly in the New World, do not provide the same level of robust GI protection as the EU.<sup>21</sup> The US, Canada and several other states do protect geographical signs via a *sui generis* system, but they do so via trade mark

2019/1753 of the European Parliament and of the Council and Council Decision (EU) 2019/1754 – Outcome of the European Parliament's first reading (Strasbourg, 11 to 14 September 2023). On 15 January 2021 the Commission had launched a public consultation inviting citizens, organisations, national and regional public authorities to contribute to the assessment of how to strengthen the geographical indications' system. The consultation closed on 9 April 2021, and the concluding report was published on 21 December 2021. For an overview of the consultation, responses, and concluding report see: European Commission, 'Food & drink – EU geographical indications scheme' <[https://ec.europa.eu/info/law/better-regulation/have-your-say/initiatives/12664-Revision-of-the-EU-geographical-indications-GI-systems-in-agricultural-products-and-foodstuffs-wines-and-spirit-drinks-public-consultation\\_en](https://ec.europa.eu/info/law/better-regulation/have-your-say/initiatives/12664-Revision-of-the-EU-geographical-indications-GI-systems-in-agricultural-products-and-foodstuffs-wines-and-spirit-drinks-public-consultation_en)> accessed 29 October 2023. The initiative of revising the GIs system was included in the Commission Work Programme 2021 under REFIT initiatives, linked to the European Green Deal. See: European Commission, Commission Work Programme 2021, Annex II: REFIT initiatives, COM(2020) 690 <<https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX:52020DC0690>> accessed 29 October 2023. A study intended to support the evaluation of the European quality policy was published on 3 March 2021. See: European Commission, 'Evaluation support study on geographical indications and traditional specialties guaranteed protected in the EU. Final report' (2 March 2021) <<https://op.europa.eu/en/publication-detail/-/publication/c1d86ba1-7b09-11eb-9ac9-01aa75ed71a1/language-en>> accessed 29 October 2023 (concluding that the EU framework on geographical indications (GIs) and traditional specialties guaranteed (TSGs) is generally effective in reaching its objectives and provides a clear EU added value. The study also found, however, that there is some room for further integration of environmental sustainability and animal welfare, identifying some limits, such as the low awareness and understanding of GIs and TSGs by consumers in some Member States). So far, only few countries have adopted national initiatives to protect certain categories of non-agricultural products or specific products. Such is the case of the Law of the Community of the Region of Murcia (Spain) No 1/2014 of 13 March 2014, which regulates the denomination – 'Artesanía de la Región de Murcia' and the Italian Law No 188 of 9 July 1990, 'Protection of artistic and traditional ceramics and of Italian quality ceramics'. Germany and Portugal count themselves among the countries with specific regulations for specific products, for example, for Solingen knives, in the former case and for 'bordado da Madeira'. All these initiatives fail to provide a full sui generis regime for non-agricultural GIs. An Exception comes from France, which has put into place a regime more like agricultural GIs. See: Contardi Magali, *Relazione AIPPI Le Indicazioni Geografiche non Agricole: Contesto, Legislazione Attuale e Proposte di Riforma* (AIPPI Italia Newsletter, September 2022).

<sup>17</sup> art 11, para 2, Regulation 1151/2012.

<sup>18</sup> See European Communities – Protection of trademarks and geographical indications for agricultural products and foodstuffs (DS174 and DS290). US and Australia claimed that several aspects of the old EU Regulation 2081/92 (related to the filing, opposition and inspection procedures as well as labelling requirements) violated the TRIPS national treatment clause and were therefore discriminatory. Specifically, and more importantly, it was complained that non-EU GIs could be registered in EU only provided that (a) the non-EU country the GI applied for originated from had in place a GI registration procedure like the one provided under the EU Regulation in question, and that (b) the non-EU country offered EU GIs a protection similar to the EU regime. As mentioned, the WTO Panel sided with US and Australia and found that the EU equivalence and reciprocity requirements offered non-EU subjects a less favourable treatment. In other words, those requirements amounted to 'extra hurdles' which ended up in giving non-EU products less chances of access to the EU market. This was confirmed by the fact that no GI from non-EU countries had ever been registered in the EU until the EU regime had been modified by eliminating the equivalence and reciprocity

requirements. The US also partially prevailed as to the aspects related to the inspection procedures. As a matter of fact, under Regulation 2081/92 non-EU GIs could be registered in the EU provided that the country of origin had adopted EU-style inspection procedures. What the WTO Panel found discriminatory was the compulsory involvement of national governments of the country of origin of the GI in setting up the required inspection structures: indeed, it was up to said governments to set up and approve these structures and release non-EU applicants statement confirming that such structures had been set up in their country. As to the claims related to filing and oppositions procedures and labelling requirements, the EU prevailed on both issues.

<sup>19</sup> See eAmbrosia – EU geographical indications register <<https://data.europa.eu/data/datasets/embrosia-eu-geographical-indications-register?locale=en>> accessed 29 October 2023.

<sup>20</sup> On this registration see Enrico Bonadio and Magali Contardi, 'Rooibos tea: EU protection is good news for South African agriculture' (*The Conversation*, 29 June 2021) <<https://theconversation.com/rooibos-tea-eu-protection-is-good-news-for-south-african-agriculture-163502>> accessed 29 October 2023.

<sup>21</sup> Extensive scholarly research has been conducted on the dichotomy between the 'old world' and 'new world' in the field of Geographical Indications (GIs). See eg Christine Haight Farley, 'Conflicts Between U.S. Law and International Treaties Concerning Geographical Indications' (2000) 22 *Whittier L. Rev.* 73; Stacy D Goldberg, 'Who Will Raise the While Flag? The Battle Between the United States and the European Union Over the Protection of Geographical Indications' (2001) 222 *U. Pa. J. Int'l Econ. L.* 107; 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 Martín, 'The WTO TRIPS agreement: the battle between the Old and the New World over the protection of geographical indications' (2004) 7 *J. World Intell. Prop.* 287; Tunisia L Staten, 'Geographic Indications Protection Under The TRIPS Agreement: Uniformity Not Extension' (2005) 87 *J. Pat. & Trade Mark Off. Soc'y* 221; Justin Hughes, 'Champagne, Feta, and Bourbon: The Spirited Debate About Geographical Indications' (2006) 58 *Hastings L.J.* 299; 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 *J. Int'l Econ. L.* 575; Ruth Okediji, 'The International Intellectual Property Roots of Geographical Indications' (2007) 82 *Chi-Kent L. Rev.* 1329; Kal Raustiala and Stephen R Munzer, 'The Global Struggle Over Geographic Indications' (2007) 18 *Eur. J. Int'l L.* 337; Dev S Gangjee, 'Geographical indications and cultural heritage' (2012) 4 *W.I.P.O. Journal* 92; Dev S Gangjee, *Relocating the Law of Geographical Indications* (CUP 2012); Irene Calboli, 'Intellectual Property Protection for Fame, Luxury, Wine, and Spirits: Lex Specialis for a Corporate 'Dolce Vita' or a 'Good Quality Life'?' in Graeme B Dinwoodie (ed), *Intellectual Property and General Legal Principles: Is IP a Lex Specialis?* (Edward Elgar 2015) 156; Irene Calboli, 'Of markets, culture, and terroir: The unique economic and culture-related benefits of geographical indications of origin' in Daniel Gervais (ed), *International Intellectual Property. A Handbook of Contemporary Research* (Edward Elgar 2015) 433; Irene Calboli, 'Time to Say Local Cheese and Smile at Geographical Indications of Origin? International Trade and Local Development in the United States' (2015) 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 *Int. Rev. Intell. Prop. Compet. 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' in William Caenegem and Jen Cleary (eds), *The Importance of Place: Geographical Indications as a Tool for Local and Regional Development* (Springer International 2017) 47-79; Kevin J Fandl, 'Regulatory Policy and Innovation in the Wine Industry: A Comparative Analysis of Old and New World Wine Regulations' (2018) 34 *Am. U. Int'l L. Rev.* 279; Danny Friedmann, 'Geographical Indications in the EU, China and

law based on the ‘first come first served’ rule.<sup>22</sup> This may lead to conflicts between European producers of products such as wine, cheese, and ham, and competitors in the New World. Chile, for example, did not enact a comprehensive GIs law until 2005. As a result, several Chilean wine producers used European GIs in the past. One of these was Champagne (which is protected as a French GI in more than 120 countries). Chile claimed that this term had been used locally by several Chilean winemakers as both a generic term and a component of registered trade marks, dating back to the 1930s.<sup>23</sup> 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 also end up confusing consumers as to the real geographical provenance of the goods. The dispute with Chile was settled in 2002 with a free trade agreement between the South American country and the EU. The agreement established a 12-year period during which the Champagne signs (the Chilean ones and the French ones) would coexist, after which all Chilean trade marks including the term ‘champagne’ would be invalidated and the use of this term as a generic name in Chile would cease.<sup>24</sup> This period ended in 2015.<sup>25</sup>

Similar cases have occurred in industries other than wine. For example, a dispute arose between producers of cured ham from the Italian city of Parma and Maple Leaf Foods Ltd.,<sup>26</sup> a Canadian company that owned trade mark rights in Canada for the term ‘Parma’ (the term ‘Prosciutto di Parma’<sup>27</sup> is protected as EU PDO and

the Italian Consorzio del Prosciutto di Parma owns it).<sup>28</sup> The Canadian trade mark registrations owned by Maple Leaf Foods resulted in Italian producers being prohibited from using marks containing the term ‘Parma’ in Canada. Consequently, until recently, these producers were forced to resort to alternative brands such as ‘Le Jambon original’ or ‘The original prosciutto’.<sup>29</sup>

One of the claims made by New World countries is that these designations are often not distinctive and merely describe the product in question – for example, the typical American consumer does not know that ‘Parmigiano’ refers to the famous cheese from the Italian municipality of Parma. Consequently, the EU’s effort to recapture designations commonly used in these countries is perceived as a protectionist strategy aimed at monopolising descriptive terms and symbols, thereby impeding competition and disadvantaging consumers. So, this is a fight between the New World, which has a minimalist approach to protecting geographic names,<sup>30</sup> and the Old World, especially Europe, which advocates strong protection – not only at home but also in other countries through bilateral trade or economic partnership agreements.

On its part, the EU has constantly put efforts in improving the protection of its geographical names for food and agricultural products at a global level. This has meant a strategic departure from the more than two-decades long discussions within the WTO/TRIPS context, which have proven unproductive.<sup>31</sup> Instead, the EU has opted for a series of bilateral treaties that include both stand-alone agreements focused exclusively on GIs, and sector-specific agreements that facilitate the mutual recognition and protection of names for wines or spirits.<sup>32</sup> In recent years the EU has also entered into comprehensive free trade and economic partnership agreements with other nations that

Australia: WTO Case Bottling Up Over Prosecco’ in Julien Chaisse (ed), *Sixty Years of European Integration and Global Power Shifts Perceptions, Interactions and Lessons* (Hart Publishing 2019) 411–27. Available at SSRN: <<https://ssrn.com/abstract=3218810>>; Andrea Zappalaglio, *The Transformation of EU Geographical Indications Law: The Present, Past and Future of the Origin Link* (Routledge 2021); Julien Chaisse and others (eds), *Wine Law and Policy: From National Terroirs to a Global Market* (Brill Nijhoff 2021).

<sup>22</sup> It should however be noted that the US also provides a *sui generis* protection to GIs identifying appellations of origin for wines, both at state and federal levels. See Calboli (n 21) 373, 418.

<sup>23</sup> See Federico Mekis, ‘Denominaciones de origen: posición de las viñas de Chile en el concierto del nuevo mundo y en relación con negociaciones con la Unión Europea’ (Simposio sobre la protección internacional de las indicaciones geográficas. Organizado por la Organización Mundial de la Propiedad Intelectual (OMPI) y la Dirección Nacional de la Propiedad Industrial (DNPI). Ministerio de Industria, Energía y Minería del Uruguay, Montevideo, 28 and 29 November 2001). Documento OMPI/GEO/MVD/01/4 (2001). The author emphasizes that in 2001, the term ‘champagne’ was widely incorporated into various trade mark labels, creating complex marks that cannot be dismissed without violating constitutionally protected rights. Furthermore, the author contends that when the term ‘Champagne’ is used alone, it would be considered a generic term according to art 19, No 23 of the Chilean constitution. However, when utilized as part of a more intricate symbol, it would qualify as a trade mark and, as a result, be protected by proprietary rights as outlined in the Chilean Constitution.

<sup>24</sup> See 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] OJ L26 of 31 January 2003.

<sup>25</sup> See Vitisphere, ‘Indicación Geográfica: el Champagne es protegido en Chile y Ecuador’ (*Vitisphere*, May 2015) <<https://www.vitisphere.com/news-72912-Indicacion-geografica-el-champagne-es-protegido-en-Chile-y-Ecuador.html>> accessed 29 October 2023).

<sup>26</sup> *Consorzio Del Prosciutto Di Parma v Maple Leaf Meats Inc.* (2001) 205 F.T.R. 176 (TD).

<sup>27</sup> Canadian Intellectual Property Office, Trade mark registration No TMA179637 <<http://www.ic.gc.ca/app/opic-cipo/trdmrks/srch/viewTrademark.html?id=281563&lang=eng&status=&appKey=281563-00&starting-DocumentIndexOnPage=1>> accessed 29 October 2023. For a detailed review of the decision see Emir 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. See also in this regard Crina Viju, William A Kerr and Cherine Mekkaoui, ‘Everything is on the Table: Agriculture in the Canada-EU Trade Agreement’ (2010) Commissioned paper No 2010-01, Canadian Agricultural Trade and Competitiveness Research Network <[https://ageconsearch.umn.edu/record/95800/files/Commissioned\\_Paper\\_2010-03\\_Viju-Kerr-Mekkaoui.pdf?version=1](https://ageconsearch.umn.edu/record/95800/files/Commissioned_Paper_2010-03_Viju-Kerr-Mekkaoui.pdf?version=1)> accessed 29 October 2023.

<sup>28</sup> eAmbrosia No PDO-IT-0067.

<sup>29</sup> La Repubblica, ‘Ceta: Prosciutto di Parma in Canada con proprio nome’ *La Repubblica* (Rome, 20 September 2017) <[https://parma.repubblica.it/cronaca/2017/09/20/news/alimentare\\_prosciutto\\_di\\_parma\\_in\\_canada\\_con\\_proprio\\_nome-176019727/](https://parma.repubblica.it/cronaca/2017/09/20/news/alimentare_prosciutto_di_parma_in_canada_con_proprio_nome-176019727/)> accessed 29 October 2023 (noting that CETA allows for the coexistence between the prior Parma trade mark, owned by Maple Leaf Foods, and the Italian GI ‘Prosciutto di Parma’; and cheering the fact that as of 2018 Italian producers of Parma ham have been able to use the term ‘Parma’ on the packaging and advertising).

<sup>30</sup> See Tim Josling, ‘The war on terroir: geographical indications as a transatlantic trade conflict’ (2006) 57(3) *Journal of agricultural economics* 337.

<sup>31</sup> The TRIPS Agreement is one of the WTO treaties: Agreement on Trade-Related Aspects of Intellectual Property Rights, Marrakesh, 15 April 1994.

<sup>32</sup> For instance, the Agreement between the European Community and Australia on trade in wine (1994, renewed in 2008) [2009] OJ L28/13; the Agreement between the European Community and the United Mexican States on the mutual recognition and protection of designation for spirit drinks [1997] OJ L152/16; 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] OJ L352; the Agreement between the European Community and the Republic of South Africa on trade in wine [2002] OJ L28; and the Agreement between the European Community and the United States of America on trade in wine [2006] OJ L87/2.

include an IP chapter with GIs provisions,<sup>33</sup> such as the treaty between the EU and Canada (CETA).<sup>34</sup>

The GIs rules included in IP chapters of these agreements have always been a sensitive issue for European countries such as Italy, which have a strong wine and food heritage that is often imitated in other countries. Take CETA for example. Canada has accepted protecting just 41 Italian GIs – e.g. ‘Aceto balsamico’ e ‘Aceto balsamico Tradizionale di Modena’, ‘Parmigiano Reggiano’, ‘Culatello di Zibello’, ‘Mozzarella di Bufala Campana’ – out of the 291 names that Italy had sought to protect. As a result, Italy decided to delay the ratification of the agreement on the grounds that it covers only a small number of its protected GIs.<sup>35</sup> The failed negotiations for the Transatlantic Trade and Investment Partnership (TTIP) between the US and the EU also revealed the underlying tension between the Old World and the New World. The failure of these negotiations can also be attributed to the harsh resistance from American cheese, wine, and food producers, who were unwilling to comply with the EU’s requests to claw-back European geographical names. The letter dispatched by 55 US senators to the United States Trade Representative in 2014 was emblematic and eloquent, as it conveyed their strong disapproval of such EU requests.<sup>36</sup> The TTIP negotiations were then interrupted after Trump was elected US President in 2016, and at the date of writing there is no concrete sign that they will be resumed soon.

American producers, especially in the dairy sector, are evidently concerned that caving into Europeans’ demands to monopolise such names would be (in their opinion) unfair as they would not be able to continue using terms that they perceive as generic. In other words, introducing such legal protection would offer European cheese producers an unfair competitive edge – it would essentially be a trade barrier that would drive up customer prices by forcing many US producers to undergo an expensive rebranding process. According to one study,<sup>37</sup> the American dairy industry

could lose as much as US\$20 billion (EUR 18 billion) if the Europeans were successful in restricting the use of common cheese names. The US Consortium for Common Food Names, which represents the interests of American producers and farmers and lobbies US lawmakers into denying legal protection for numerous European geographical terms (not only for cheeses), is particularly vocal in this regard.<sup>38</sup> This consortium obviously welcomed a recent decision by the US Court of Appeals for the Fourth Circuit in early 2023 which found the term ‘Gruyere’ to be the generic name for any nutty, pale yellow cheese made from cow’s milk.<sup>39</sup> This ruling came after representatives of Swiss and French manufacturers of Gruyere (this is the name of a medieval town in the Fribourg canton of Switzerland, where the cheese in question has traditionally been produced) tried to register the term as certification mark in the US (indeed, it is protected in the EU as PDO). This would have restricted the use of the term in the US for cheeses produced in specific parts of Switzerland and France.<sup>40</sup> In backing up this decision, the US Consortium for Common Food Names argued that the US was founded on the work of immigrants, especially from Europe, who brought authentic and artisan traditions from around the world.<sup>41</sup> This is exactly the ‘migration factor’ we are going to analyse in the next section.

#### IV. Migrations’ impact on GI regimes: four case studies

The movement of people through migration is instrumental in transporting food items and forging trading relationships between nations or continents. This is evident in the case of crops such as tubers, coffee, and sugar, which were brought to Europe from far away countries during the period of colonisation.<sup>42</sup> The US provides a prime example of cultural amalgamation, where its diverse cuisine is emblematic of the country’s heterogeneity. And labour migration, predominantly motivated by

<sup>33</sup> See Martijn Huysmans, ‘Exporting protection: EU trade agreements, geographical indications, and gastronomic nationalism’ (2020) 29 *Review of International Political Economy* 1.

<sup>34</sup> EU-Canada Comprehensive Economic and Trade Agreement (CETA) [2017] OJ L11 of 14 January 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’ (NCTM Association d’avocats, 2014), <[https://www.origin-gi.com/wp-content/uploads/2015/02/14.11.24\\_GIs\\_in\\_the\\_CETA\\_English\\_copy.pdf](https://www.origin-gi.com/wp-content/uploads/2015/02/14.11.24_GIs_in_the_CETA_English_copy.pdf)> accessed 29 October 2023.

<sup>35</sup> Being a mixed treaty (an agreement concerning areas of shared competence between of EU Member States) it needs the ratification of individual Member States to become fully applicable. Pending ratification at national level, the agreement then enters into force for all the parts that are the exclusive competence of the EU, postponing the full application of all chapters until the national ratification process of the agreement according to domestic national law. Thus, CETA agreement (partially) entered into force provisionally.

<sup>36</sup> Filippo Arfani, 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 the webpage of US Senator Tammy Baldwin of Wisconsin at <<https://www.baldwin.senate.gov/in-the-news/bipartisan-effort-in-us-senate-to-protect-common-cheese-names>> accessed 29 October 2023. The letter included the following exhortation: ‘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 (eg for cheeses)’.

<sup>37</sup> See Colleen Kottke, ‘Economic losses from EU’s generic cheese name policy could cost dairy industry billions’ (*Wisconsin State Farmer*)

<<https://eu.wisfarmer.com/story/news/2019/03/06/tremendous-losses-face-u-s-dairy-over-eu-cheese-names/3071424002/>> accessed 29 October 2023.

<sup>38</sup> See Consortium for Common Food Names (CCFN), ‘Court of Appeals Extends Huge Victory for Worldwide Producers of ‘Gruyere’ (3 March 2023) <<https://www.commonfoodnames.com/court-of-appeals-extends-huge-victory-for-worldwideproducers-of-gruyere/>> (accessed 29 October 2023)

<sup>39</sup> See *Interprofession du Gruyere v U. S. Dairy Exp. Council* 61 F.4th 407 (4th Cir. 2023)

<sup>40</sup> For a similar case see re *Cooperativa Produttori Latte E Fontina Valle D’Acosta Trade Mark Trial and Appeal Board, Patent and Trade Mark Office (P.T.O.)* 230 U.S.P.Q. 131 (1986). This dispute focused on whether the term ‘Fontina’ in relation to a semi-hard cheese from Val d’Aosta was a generic name. The cheese takes its name from Mount Fontin near the town of Aosta, where the product has been manufactured for centuries (the term Fontina is now protected in the EU as PDO). The US court held the name became generic. Specifically, it noted that ‘... to the American purchaser, ‘fontina’ primarily signifies a type of cheese (much like brie, swiss, parmesan or mozzarella) regardless of regional origin, rather than a mark of certification’.

<sup>41</sup> Missy Green, ‘US dairy sector celebrates ruling on “gruyere” as generic cheese term’ (6 March 2023) <<https://www.foodingredients-first.com/news/us-dairy-sector-celebrates-ruling-on-gruyere-as-generic-cheese-term.html>> accessed 29 October 2023.

<sup>42</sup> See Manuel Calvo, ‘Migration et alimentation’ (1982) 21 *Social Science Information* 383-446.

poverty, has played a significant role since the 18th century,<sup>43</sup> with numerous individuals and families venturing abroad in pursuit of better wages. In a similar manner to way in which sutlers followed armies, food-makers embarked on journeys to cater to the needs of their compatriots.<sup>44</sup> Their objective was to provide their fellow countrymen with valued culinary delights such as wine, cheese, and other cherished delicacies from their native cuisine. In cases where importing such items proved impractical or challenging, emigrants took it upon themselves to locally produce foodstuffs that were characteristic of their countries of origin.

Thus, in the 19th and 20th centuries big waves of European people, including farmers, emigrated to other countries, and some of them continued to produce the cheese, wine, and spirits they had made in Europe. They essentially took the methods of making the products and the names with them to their new homes and used them in good faith. Some also called these products by the names used in Europe (e.g. 'Feta', 'Parmigiano', 'Rioja', 'Budweis' and more recently 'Prosecco'). Therefore, food products were introduced along Italian, Spanish or French lines, or names were used that were associated with the migrants' country of origin. Also, due to these migration waves, some European food names are still used today in some countries of the New World. Italy, for example – one of the countries that have today the largest number of GIs – experienced an extraordinary exodus of approximately 15 million people during the decades spanning the turn of the 19th and 20th centuries.<sup>45</sup> Significant social and economic changes marked this period – and the exodus had a profound impact on the demographic and cultural makeup of both Italy and the countries of destination, shaping their histories and identities in lasting ways.

Considering this historical background, we now highlight four case studies which epitomise the GIs tensions between the Old World and the New World. These case studies relate to well-known geographical names which enjoy PDO status in the EU – i.e. 'Prosecco', 'Budweiser', 'Rioja' and 'Parmesan' – but which have struggled to obtain protection (and in some cases got no protection at all) in countries of the New World.

## 1. Prosecco

Prosecco is the name of a village close to the town of Trieste, situated in the north-eastern part of the Italian peninsula, from where the famous Italian sparkling wine 'Prosecco' takes its name.<sup>46</sup> During ancient Roman times, the village of Prosecco was home to a castle known as 'Castellum Pucinum'. Situated between the city of Trieste and the Timavo River, this castle holds significant historical importance in inspiring the name of the wine, and

there is extensive literature dating back to the 15th century which acknowledges that the 'Castellum Pucinum' gave its name to the Prosecco wine.<sup>47</sup> The region surrounding Conegliano in the adjacent Veneto region has also long served as a significant area for the production of this wine, a tradition that continues to this day.

The name 'Prosecco' has been protected by an EU PDO since 2009,<sup>48</sup> with the protection under Italian law dating back to 1969.<sup>49</sup> The EU has entered into bilateral agreements with various countries, including Armenia, Moldova, the United States, Switzerland, Vietnam, China, and Japan. These treaties aim to protect the 'Prosecco' name within those territories, albeit with varying levels of commitment. The term is additionally safeguarded as an appellation of origin in various countries within the framework of the Lisbon system.<sup>50</sup> Prosecco is also currently afforded legal protection in India, Russia, Canada, and Kazakhstan. This protection stems from national applications made by the *Consorzio di Tutela del Prosecco*, the governing body responsible for overseeing the production of the wine and the use of its brands.<sup>51</sup>

A GI controversy has arisen which involves Australian producers of sparkling wines and focuses on the use of the term 'Prosecco'. Since 2018, Australia and the EU have engaged in negotiations for a comprehensive trade agreement, expected to encompass intellectual property rights including GIs. This agreement, if successfully concluded, would expand upon the existing EU-Australia partnership established in 1994 and revised in 2008, with a particular focus on wine-related matters.<sup>52</sup> Within the framework of these negotiations the EU and Italy assert the need for robust safeguards to protect the Prosecco GI in Australia. However, such protection would impede Australian producers from utilising this term within their domestic market. Consequently, Australia vehemently opposes

<sup>47</sup> *ibid.*

<sup>48</sup> eAmbrosia, No PDO-IT-A0516.

<sup>49</sup> Decree of the President of the Republic 2 April 1969 (GU 7 June 1969, No 141. This decree, along with its subsequent amendments, conferred PDO status upon the term 'Prosecco di Conegliano Valdobbiadene' and effectively governed the use of the Prosecco PDO until the year 2009. From 1969 to 2009, the production of Prosecco DOC ('Denominazione di Origine Controllata') encompassed a geographical region consisting of 15 municipalities located between Conegliano and Valdobbiadene in the province of Treviso. The inclusion of Prosecco GI status for a sparkling wine made from the Glera grapes was officially established in July 2009 through the enactment of a Ministerial Decree (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 <<https://www.gazzettaufficiale.it/eli/id/2009/07/28/09A08700/sg>> accessed 29 October 2023).

<sup>50</sup> 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 No AO906 for Prosecco <<https://www.wipo.int/ipdl-lisbon/result-detail?count=3&total=4&cacheid=21671825&query=prosecco&sortBy=KEY&limit=25>> accessed 29 October 2023.

<sup>51</sup> See for example GI Registration No 503, India; Registration No 1662300, Canada.

<sup>52</sup> Agreement between the European Community and Australia on Trade in Wine, opened for signature Jan. 26, 1994 [1994] OJ L86/3, 3; and Agreement Between the European Community and Australia on Trade in Wine, 30 January 2009 [2009] OJ L28/l.

<sup>43</sup> See Ulrike Thoms, 'From Migrant Food to Lifestyle Cooking: The Career of Italian Cuisine in Europe' (*European History Online*, 2011) at <<http://www.ieg-ego.eu/thomsu-2010-en>> accessed 29 October 2023.

<sup>44</sup> *ibid.*

<sup>45</sup> See Alberto Grandi, *Denominazione di Origine Inventata* (Mondadori 2018) 14.

<sup>46</sup> For an historical perspective of the name prosecco, see: Enrico Bonadio and Magali Contardi, 'The Geographic Indication Prosecco Battle Between Italy and Australia: Some Lessons from the History and Geography of the Most Famous Italian Wine' (2022) 23 *The Journal of World Investment & Trade* 260.

this demand, asserting that its winemakers should possess unrestricted rights to use the Prosecco appellation.<sup>53</sup> The main argument put forth by Australia is that such name has traditionally referred to a grape variety rather than a specific geographical location.<sup>54</sup> There is also an economic angle, because Australia has witnessed a surge in domestically produced sparkling wines sold under the Prosecco brand.<sup>55</sup> From an Italian and EU perspective, the reasons for this rejection are clearly economic, as the Prosecco brand is very popular and has created a loyal and valuable customer base.

And now the ‘migration’ factor specifically comes in. Italian immigrants and their descendants have famously introduced traditional winemaking methods to Australia. In this context, Australian winemakers argue that their right to use the name ‘Prosecco’ comes from this historical fact, i.e. that their wineries were predominantly founded by Italian immigrants, most of whom came from the north-eastern regions of Italy.<sup>56</sup> Indeed, the sparkling wine named ‘Prosecco’ was first sold in Australia in 2004 by an Italian citizen, Otto Dal Zotto, who was born in Valdobbiadene, Veneto, and then emigrated to Australia in 1967.<sup>57</sup> Inspired by how his family used to produce this sparkling wine, at the end of 1998 Dal Zotto planted the variety of grapes used for producing Prosecco in the Australian area of King Valley. He believed that this area possessed a Mediterranean climate, with warm days and cool nights, which made it the ideal location for growing the grape. As Dal Zotto himself testified, the first bottle of Prosecco required six years of hard work, from 1998 to 2004, before the first vintage was released.<sup>58</sup> Numerous Australian winemakers have predictably

used the Dal Zotto’s narrative to claim that abandoning the use of the term ‘Prosecco’ (as advocated by the EU and Italy) would be unfair and disrupt firmly established and legitimate marketing methods.<sup>59</sup> Australian winemakers, and the Australian government, may here try to rely on Art. 24(6) of the TRIPS Agreement which indirectly addresses the needs of emigrants’ businesses that had commenced using geographical terms of the areas where they came from. Indeed, this provision – commonly referred to as the ‘grandfather clause’ or ‘legacy clause’ – allows for continuing uses of trade marks that were considered lawful prior to the implementation of TRIPS. However, the extent to which Australia may benefit from this clause with respect to Prosecco remains uncertain.<sup>60</sup>

It should also be noted that when it comes to marketing strategy, Australian winemakers have consistently exploited the ‘Italian sounding’ phenomenon. This involves the use of terminology and visual representations that evoke associations with Italy, with the intention of enticing consumers to purchase products that in fact do not originate from Italy. For example, the wines produced by Dal Zotto, as well as wines produced by wineries like Pizzini<sup>61</sup> in the King Valley region of Victoria High Country, are extensively marketed as having an ‘Italian style’. However, this does not seem to be an issue for Australian wine producers. Indeed, in the 2013 case *Winemakers’ Federation of Australia v European Commission*, the former emphasised the importance of considering cultural and similar references in the context of Australia’s identity as a community shaped by migration – and it did so by highlighting that the recognition of different historical traditions is a common practice in Australia.<sup>62</sup>

But is this really a strong point? After all, one may argue that the use by Australian wine producers of claims like ‘[Sparkling wine] [c]reated 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 [...]’<sup>63</sup> or that marketing the wine under the name ‘Pucino’, adding that [Pucino] ‘is the ancient Roman name for Prosecco [...]’<sup>64</sup> seem rather aimed at creating confusion among consumers regarding

<sup>53</sup> See Matthew Rimmer, ‘Prosecco wars: An aperitif for New Australia-EU Trade Talks’ (*infojustice*, 26 July 2018) <<https://infojustice.org/archives/40203>> accessed 29 October 2023 (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.’).

<sup>54</sup> 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 *The Journal of World Intellectual Property* 546. See also Daniel Hurst, ‘Hard cheese for Australian producers as they fear losing naming rights in EU food fight’ *The Guardian* (London, 23 May 2023).

<sup>55</sup> In 2019 Prosecco was identified as one of the leading white grape varieties in Australia, occupying a position within the top ten. The total quantity of Prosecco produced during that year amounted to 9,936 tonnes. Australia also engages in the exportation of its Prosecco wine, amounting to nearly 2 million Australian dollars in value during the 2018-19 period. Notably, a significant portion of this export, approximately 80%, is directed towards the market of New Zealand. Therefore, the potential prohibition of Australian producers from utilising the designation ‘Prosecco’ in relation to their wines would significantly impact a sector that is presently undergoing remarkable expansion and already contributes a value of 200 million Australian dollars annually to the domestic wine industry. Please refer to the following academic source for further information on the topic, see Kneller (n 54) 546.

<sup>56</sup> ‘Prosecco Wars: Australian Winemakers Fear ‘devastating’ Impacts of EU Naming Row’ (*SBS Italian*) <<https://www.sbs.com.au/language/italian/en/article/prosecco-wars-australian-winemakers-fear-devastating-impacts-of-eu-naming-row/dkj22i3t1>> accessed 29 October 2023.

<sup>57</sup> See ‘The first Dal Zotto Prosecco is released on to the market – only 200 dozen’ <<https://www.dalzotto.com.au/dal-zotto-timeline>> accessed 29 October 2023.

<sup>58</sup> See at <<https://www.dalzotto.com.au/dz-prosecco>>.

<sup>59</sup> See ‘Prosecco Wars: Australian Winemakers Fear ‘devastating’ Impacts of EU Naming Row’ (n 56); *Winemakers’ Federation of Australia v European Commission* [2013] ATMOGI 1 (22 November 2013). See also: Daniel Hurst, ‘Great Migrant Nation: Bid to Protect Australian Prosecco and Feta from EU Bans’ *The Guardian* (London, 15 December 2022) <<https://www.theguardian.com/australia-news/2022/dec/15/great-migrant-nation-bid-to-protect-australian-prosecco-and-feta-from-eu-bans>> accessed 29 October 2023 (Reporting that ‘The trade minister, Don Farrell, has asked his European counterparts to recognise Australia as a ‘great migrant nation’ and not force its producers to stop using terms like prosecco and feta.’).

<sup>60</sup> See Bonadio and Contardi (n 46).

<sup>61</sup> See Pizzini’s history website at <<https://www.pizzini.com.au/pages/family-history>> accessed 29 October 2023.

<sup>62</sup> See *Winemakers’ Federation of Australia v European Commission* (n 59).

<sup>63</sup> See at <<https://www.pizzini.com.au/>>.

<sup>64</sup> Description of wine label ‘Pucino’ for Australian prosecco commercialized by Dal Zotto. See the website <[https://www.danmurphys.com.au/product/DM\\_377397/dal-zotto-pucino-prosecco](https://www.danmurphys.com.au/product/DM_377397/dal-zotto-pucino-prosecco)> accessed 29 October 2023. The description adds and that [the winery] ‘recreates that ancient style here by using the Charnat method to deliver a Prosecco of true richness and complexity that is perfectly suited to a wide array of occasions’.

the origin of the product and also capitalise on the reputation and historical significance of an established Italian wine.

Also, the adoption of the ‘Prosecco Road’ initiative by Australian winemakers appears to primarily stem from economic motivations rather than cultural or migration factors. The primary objective of this initiative is to emulate the success of the ‘Strada del Prosecco’ in Australia, which is modelled after the Italian area where the production of Italian Prosecco has a longstanding tradition (*strada* means ‘road’ in Italian). This itinerary offers wine enthusiasts an immersive experience in the Italian Prosecco vineyards, encompassing wine tastings and guided tours of local castles, monasteries, and churches.<sup>65</sup> Thus, the Australians have just imitated this initiative, with consumers being invited to choose the ‘King Valley’s Prosecco Road’. Visitors are also invited 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’.<sup>66</sup> Thus, it is clear that these practices go 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 argued by Australian Grape and Wine (formerly, the Winemakers’ Federation of Australia).<sup>67</sup>

## 2. Budweiser

The name ‘Budweis[er]’ refers to a beer produced in the city of České Budějovice, once part of the Kingdom of Bohemia, now part of the Czech Republic. The name of this beer comes from the German name of the town – Budweis – which means [beer] ‘from Budweis’.<sup>68</sup> The location was said to be ideal due to the availability of high-quality water from the nearby Vltava River and the surrounding fertile lands that yielded quality barley. Brewed using artesian water, Saaz hops from Žatec in northern Bohemia, Moravian malted barley, and yeast, Budweis beer is known for being produced with such regional characteristics and using traditional brewing

practices which date back to the 13th century.<sup>69</sup> Over the course of centuries, these practices persisted, particularly with the establishment of a significant town brewery in the 15th century, which specialised in producing ‘white’ (wheat) beer instead of the prevailing dark beers brewed by the local inhabitants. This development led to a notable improvement in brewing quality and reputation. In the subsequent centuries, another town brewery emerged, and both breweries eventually came under the ownership and management of the citizens of the town (Bürgerliches Brauhaus Budweis or ‘civic breweries’).<sup>70</sup>

At the end of the 19th century České Budějovice was a town of mixed nations, with more than 11 thousand citizens of German origin living there along with over 16,000 citizens with a Czech background.<sup>71</sup> Czech brewers faced discontent with the situation because they lacked political representation, which meant that ‘civic breweries’ were largely dominated by their German counterparts. To tackle the issue, in 1895 they established the ‘Český akciový pivovar’ (in English: Czech Joint-Stock Brewery), a Czech-owned brewery, which brought together the local breweries under a single entity, pooling their resources and expertise.<sup>72</sup> Thus, the Bürgerliches Brauhaus, Cesky Akciový pivovar were the predecessors of Budejovický Budvar (‘national corporation’), as the Czech Budweis producer is still known today.<sup>73</sup> In 2003, the EU awarded Budweiser Budvar PGI status.<sup>74</sup> In 1967 Budvar had also registered as appellations of origin under the Lisbon system the names ‘Českobudějovické Pivo/Budweis Bier’, ‘Budějovické Pivo/Budweiser Bier’ and ‘Budějovické Pivo – Budvar/Budweis Beer Budvar’.<sup>75</sup>

What about the New World then? The mentioned dynamics of Czech-German rivalry persisted as the Bohemian beer journeyed to America.<sup>76</sup> In this sense,

<sup>65</sup> 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 Giuseppe Schiratti. See Giuseppe Schiratti, *Invito alla strada del vino bianco: Conegliano, Valdobbiadene* (Editrice trevigiana 1972).

<sup>66</sup> ‘King Valley’s Prosecco Road’ <<https://www.visitmelbourne.com/Regions/High-Country/Food-and-wine/Wine-regions/King-Valley-wine-region/Prosecco-Road>>. See also 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’ (WineNews, 3 August 2011) <[https://winenews.it/en/prosecco-road-in-australia-italian-origin-grape-growers\\_310206/](https://winenews.it/en/prosecco-road-in-australia-italian-origin-grape-growers_310206/)> accessed 29 October 2023 (discussing on Prosecco Road in Australia, evoking the Italian *Strada del Prosecco*).

<sup>67</sup> *Winemakers’ Federation of Australia v European Commission* (n 59).

<sup>68</sup> Under the former Kingdom of Bohemia both Czech and German were official languages of the Kingdom. As to the name ‘Budweiser’, as noted by Philippe Zylberg, in German, it is common to ad[d] the suffix ‘er’ to a town in order to indicate that something or someone originates from that specific town. See: Philippe Zylberg, ‘Geographical Indications v. Trademarks: The Lisbon Agreement: A Violation of Trips’ (2002) 11 University of Baltimore Intellectual Property Law Journal 1.

<sup>69</sup> Ottokar II (Přemysl Otakar II) King of Bohemia, founded the town of České Budějovice bestowing on the town the right to brew beer. This was followed by 1410 King Wenceslas IV ban of locating foreign malt houses, breweries or pubs within a mile of České Budějovice and its surroundings. See: <[https://czechvar.com/brewery/?redirect\\_from=budweiser-budvar&redirect\\_code=3#>](https://czechvar.com/brewery/?redirect_from=budweiser-budvar&redirect_code=3#>); <<http://rumroadravings.com/featured/face-off-the-battle-for-budweiser-part-1/>> accessed 29 October 2023.

<sup>70</sup> See the webpage <[https://kramerius.techlib.cz/search/i.jsp?pid=uid:64d61d40-d95b-11e0-9572-0800200c9a66#monograph-page\\_uid:27ed783c-dcb9-11e1-af45-001b63bd97ba](https://kramerius.techlib.cz/search/i.jsp?pid=uid:64d61d40-d95b-11e0-9572-0800200c9a66#monograph-page_uid:27ed783c-dcb9-11e1-af45-001b63bd97ba)> accessed 29 October 2023.

<sup>71</sup> Czech lands were ravaged in the Thirty Years’ War, and the Kingdom of Bohemia became part of the Habsburg Monarchy. In 1895, the Czech Republic was still part of Austria-Hungary.

<sup>72</sup> During the 19th century, electoral regulations in České Budějovice (Budweis) categorized voters based on their wealth and the amount of tax they paid. As a result, despite their numerical superiority, the Czech population lacked representation vis-à-vis German population in the town-hall due to these criteria. Numerous new Czech companies were established in České Budějovice during the latter part of the 19th century to address this issue, but as result of the pressure received from German employers to indicate German as their spoken language on the census papers, Czech brewers did not achieve any political representation. This led to a first attempt to establish a Czech-owned brewery in Budějovice, initiated in 1891, which however failed. See <<https://www.budejovicky-budvar.cz/tiskove-zpravy/the-first-batch-of-beer-in-budweiser-budvar-brewery-was-brewed-115-years-ago>> accessed 29 October 2023.

<sup>73</sup> See website at <[https://czechvar.com/brewery/?redirect\\_from=budweiser-budvar&redirect\\_code=3](https://czechvar.com/brewery/?redirect_from=budweiser-budvar&redirect_code=3)> accessed 29 October 2023.

<sup>74</sup> ‘Českobudějovické pivo’ No PGI-CZ-0446 and ‘Budějovické pivo’ No PGI-CZ-0444.

<sup>75</sup> Registries Nos 49, 50 and 52. WIPO Lisbon Express Database.

<sup>76</sup> Bernhard Struck, ‘Budweiser Budvar: The Czech and German Origins of the World’s Most American Beer’ (MO3351 *Doing and Practicing Transnational and Global History*, 4 March 2016) <<https://>

the history of Budweiser beer is closely intertwined with a significant wave of German and Czech immigration to America that occurred after 1848.<sup>77</sup> These immigrants brought their cultural heritage, including brewing traditions and preferences. Once settled in America, they continued to brew and consume the beers that had deep historical and cultural significance. Specifically, clashes began as German immigrants Adolphus Busch and Eberhard Anheuser, founders of the US company Anheuser-Busch,<sup>78</sup> had been selling their beer in the US under the name ‘Budweiser’ since 1883.<sup>79</sup> This American beer was produced according to the ‘Budweiser process’ and was ‘similar in quality, colour, flavour and taste to the “Budweiser” beer then being made in Bohemia.’<sup>80</sup> In a nation comprised of European immigrants who probably held nostalgic memories of the exceptional libations from their homelands, it made logical sense to them to market the new beer as a distinguished continuation of Czech and German brewing traditions, rather than as a completely novel ‘American’ style of beer.

However, the decision to adopt the name Budweiser raises questions. In the German language, ‘Budweiser’ literally refers to a product originating from Budweis. It may seem paradoxical to use the German adjectival form to describe a product unrelated to its actual place of production.<sup>81</sup> The distinctive aspect of the Budweiser case is that Anheuser-Busch not only transformed it into an ‘American’ brand, but also boldly trade marked the name in the US and several other countries. This paved the way for a long battle between the Czech brewer, Budejovický Budvar and the US company Anheuser-Busch over the exclusive right to use the ‘Budweiser’ name. Indeed, the

[transnationalhistory.net/doing/2016/03/04/budweiser-budvar-the-czech-and-german-origins-of-the-worlds-most-american-beer/](https://transnationalhistory.net/doing/2016/03/04/budweiser-budvar-the-czech-and-german-origins-of-the-worlds-most-american-beer/) accessed 29 October 2023.

<sup>77</sup> After several political events, including unsuccessful attempts of revolution, there was a massive wave of German immigrants in the 1840s and 1850s in the US. Until then, Americans were not much familiar with beer, but the influx of Germans made that beer become worth producing at commercial levels: See <https://www.immigrantentrepreneurship.org/entries/german-immigrants-in-the-united-states-brewing-industry/> accessed 29 October 2023.

<sup>78</sup> At the time, Anheuser-Busch Inc. was E. Anheuser Company’s Brewing Association. The name of the latter corporation was changed to Anheuser-Busch Brewing Association in 1879, and again changed to Anheuser-Busch, Incorporated, in 1919. See: *Anheuser-Busch Inc, v Du Bois Brewing Co.* 73 F. Supp. 338, 348 (W.D. Pa. 1947) [*Du Bois Brewing Co.*], § 1. For simplicity, throughout the article, it will be used the name ‘Anheuser-Busch’.

<sup>79</sup> Busch arrived in the US in 1857 and married the daughter of Eberhard Anheuser, who had emigrated from Germany to the city of St. Louis, Missouri in 1843. See website at: <https://us.budweiser.com/history>. Anheuser had formerly worked in the soap manufacturing industry and shifted to the beer brewing sector in 1860 where he made contact with a young brewery supplier named Busch who ended up marrying Anheuser’s daughter and joined the business. See <https://www.immigrantentrepreneurship.org/entries/eberhard-anheuser/> accessed 29 October 2023. In 1876, Anheuser-Busch initiated the production of beer for an individual named Carl Conrad. The beer was marketed under the name ‘CCC Budweiser Beer’. In 1883, Anheuser-Busch obtained the rights to use the name ‘Budweiser’ from Conrad, and in 1891, both parties entered into an assignment agreement that officially transferred the rights to the name and associated trade marks from Conrad to Anheuser-Busch. See *Anheuser-Busch Inc, v Du Bois Brewing Co.* 73 F. Supp. 338, 348 (W.D. Pa. 1947) [*Du Bois Brewing Co.*], paras 4-5 and 8.

<sup>80</sup> *ibid* paras 4 and 7.

<sup>81</sup> Yet, this practice does not seem uncommon for products lacking GI protection. Examples of this phenomenon include pilsner, which should theoretically exclusively denote beers originating from the Czech town of Pilsen, as well as the frankfurter and the hamburger. In reality this is not the case.

Budweiser mark has been registered in the US (amongst other jurisdictions) since 1886,<sup>82</sup> and a second registration was obtained in 1907.<sup>83</sup> The registrations were owned and the sign was used by Anheuser-Busch.<sup>84</sup> European producers have constantly objected to such registration and use, arguing that it was misleading and harmful to the reputation of the original Czech brand.

In 1911, Anheuser-Busch entered into a series of legal agreements with its Czech counterparts. These agreements granted Anheuser-Busch the right to use the term ‘Budweiser’ as a trade mark worldwide, except for Europe, so long as it did not use the word ‘Original’ in connection with it.<sup>85</sup> However, the Czech Budejovický Budvar still reserved the concurrent right to continue the use of the trade mark and sell its ‘Budweiser’ in the US and throughout the world.<sup>86</sup> Despite this, the agreement did not resolve the underlying issues, leading to a prolonged conflict that lasted several decades. One factor contributing to the breakdown of the truce is that after World War II the increased competition and market saturation in the American beer industry prompted Anheuser-Busch to seek new business prospects overseas – specifically in the UK, as it was not yet part of the European Community at that time.<sup>87</sup> The decision to engage in exportation resulted in a prolonged dispute between Anheuser-Busch and Budvar, which manifested in various ways, including legal battles in the UK<sup>88</sup> (by then a Member of the European Community), at the European Court of Justice (now the

<sup>82</sup> Trade mark Registration No 13064 in relation to beer. See <https://www.tmdn.org/tmview/welcome#/tmview/detail/US500000070013064> accessed 29 October 2023. The full name is ‘Original Budweiser lager bier only genuine as Decreed by the Courts’.

<sup>83</sup> Trade mark Registration No 64125. See <https://www.tmdn.org/tmview/welcome#/tmview/detail/US500000071009773> accessed 29 October 2023. This second application was sought for the sole name ‘Budweiser’. It is important to note that when in 1905 Adolphus Busch tried to register the word ‘Budweiser’ as a trade mark in the US, the registration was rejected. The US Patent Office again refused to register the name ‘Budweiser’ on 26 February 1906 because of its geographical character, i.e. as it gave rise to the meaning ‘from Budweis’. Finally, registration was granted in 1907. See: Bernard O’Connor, ‘Case C-216/01 Budejovický Budvar Judgment of the Court of Justice of 18 November 2003’ (2004) 5 European Business Organization Law Review 577.

<sup>84</sup> See history summary in: *Anheuser-Busch, Inc. v Caught-On-Bleu, Inc.* Civil No 02-196-JD, Opinion No 2003 DNH 173 (D.N.H. 9 October 2003) (The case deals with the use of ‘Bud’ as an abbreviation of Budweiser and the secondary meaning of the term).

<sup>85</sup> *Anheuser-Busch Inc, v Du Bois Brewing Co.* (n 78) §§ 45-46. See also: Jitka Smith, ‘Budweiser or Budweiser’, 32 J. Marshall L. Rev. 1251 (1999) (1999) 32 UIC Law Review <https://repository.law.uic.edu/law-review/vol32/iss4/11> accessed 29 October 2023.

<sup>86</sup> *ibid*; both sources also confirm that in 1934, the right of Budejovický Budvar to sell beer in the United States was again recognized by Anheuser-Busch and that subsequently, in 1937, Budejovický Budvar registered a beer bottle label with the U.S. patent Office.

<sup>87</sup> In the 1911 agreement no explicit mention of the UK jurisdiction was included. In 1970, when the American company sought to export its beer to the UK. The UK joined the European Economic Communities on 1 January 1973 and withdrew it in 2016 with effect as of 1 January 2020.

<sup>88</sup> See, for instance: *Anheuser-Busch Inc. v Budejovický Budvar Narodni-Podnik* [2000] EWCA Civ 30 [*Anheuser 2000*]. The case revolved around a trade mark dispute between both companies which ultimately established that both trade marks could coexist as none of the contentents was, as against the other, exclusively entitled to the goodwill attaching to the name ‘Budweiser’. For a detailed overview of the case, see: ‘Budejovický Budvar Narodni Podnik v Anheuser-Busch Inc’ (2008) 125 Reports of Patent, Design and Trade Mark Cases 480. In examining the Budweiser disputes in the UK it is also relevant to note that prior to the implementation of the TRIPS Agreement, the UK lacked a system protecting geographical indications. The case was ultimately decided by the CJEU that held that Anheuser-Busch, the proprietor of an earlier BUDWEISER trade mark could not obtain the cancellation

Court of Justice of the European Union – CJEU)<sup>89</sup> and in other, non-European courts.<sup>90</sup>

It is also interesting to cite again the two WTO cases already mentioned above in Section II.<sup>91</sup> These disputes also revolved around the so-called ‘co-existence’ regime adopted by the EU under Regulation 2081/92. In short, under this regime a GI protecting a sign previously registered as trade mark by another entity could co-exist with the latter. The US strongly contended that this regime unfairly restricted market access for the owners of those earlier trade marks. In the allegations, both the US and the EU cited the Budweiser case to substantiate their (conflicting) arguments.<sup>92</sup> Specifically, the US stressed that Anheuser-Busch owned prior trade mark rights in EU countries and that therefore later GIs similar to or identical with the Budweiser should not be allowed.<sup>93</sup> The US tried to rely here on Art. 16<sup>94</sup> as well as Art. 24(5) of the TRIPS Agreement which grants grandfather rights. Indeed, the latter states that ‘where a trade mark has been applied for or registered in good faith, or where rights to a trade mark have been acquired through use in good faith, either’ the protection of a GI should not prejudice the eligibility or validity of identical or similar pre-existing trade marks or the right to use such marks.<sup>95</sup> Yet, the WTO Panel did not agree and ultimately accepted

of the registration of Budvar’s identical later BUDWEISER trade mark where there had been a long period of honest concurrent use of the two marks. Thus, both suppliers of BUDWEISER beer could carry on doing so concurrently, as they had done before. See Case C-482/09 *Budejovický Budvar, národní podnik v Anheuser-Busch, Inc* ECLI:EU:C:2011:605.

<sup>89</sup> See, for instance, Case C-216/01 *Budejovický Budvar* ECLI:EU:C:2003:618. For a full commentary, also Case C-245/02 *Anheuser-Busch Inc. v Budejovický Budvar, národní podnik* ECLI:EU:C:2004:717; see O’Connor (n 83) 577; Robert C Bird, ‘This Bud’s For You: Understanding International Intellectual Property Law Through the Ongoing Dispute over the Budweiser Trademark’ (2006) 23 *Journal of Legal Studies Education* 5; Nicola Lucchi, ‘Il dibattito transatlantico sulla tutela delle indicazioni geografiche e delle denominazioni di origine’ (2008) 87 *Rivista di Diritto Agrario* 49.

<sup>90</sup> O’Connor acknowledges nearly forty-four disputes worldwide, highlighting that Anheuser-Busch has won an exclusive right to use the name ‘Bud’ in Argentina, Australia, Brazil, Denmark, Sweden, Finland, Hungary, Italy, and New Zealand, whereas courts in South Korea, Japan, Tajikistan, Taiwan and some European countries, including Greece, Portugal, Austria, Spain, Switzerland, Germany, Norway, Latvia and Lithuania, have ruled in Budvar’s favour. See O’Connor (n 83). See also Case C-216/01 *Budejovický Budvar* ECLI:EU:C:2003:618, para 26.

<sup>91</sup> See again ‘European Communities – Protection of trademarks and GIs for agricultural products and foodstuffs’ (DS174 and DS290). For a commentary of the case, see Michael Handler, ‘The WTO Geographical Indications Dispute’ (2006) 69 *The Modern Law Review* 70.

<sup>92</sup> World Trade Organization Report of the Panel, WT/DS174/R (15 March 2005), para 7.536 ff <[https://docs.wto.org/dol2fe/Pages/FE\\_Search/FE\\_S\\_S006.aspx?Query=\(%20wt/ds174/\\*\)&Language=ENGLISH&Context=FomerScriptedSearch&languageUIChanged=true](https://docs.wto.org/dol2fe/Pages/FE_Search/FE_S_S006.aspx?Query=(%20wt/ds174/*)&Language=ENGLISH&Context=FomerScriptedSearch&languageUIChanged=true)> accessed 29 October 2023.

<sup>93</sup> The Panel’s report mentioned the US assertion, substantiated by evidence, that the Budweiser trade marks were registered in at least two EU Member States and rights to them appear to have been acquired through use in another EU country. On this account the US contended that under the EU co-existence regime it was possible to register a geographical indication in a manner which precludes trade mark owners to raise objections based on art 14.3 EU Regulation 2081/92 (as mentioned, this regulation has been repealed by subsequent ones). The US added that this is indeed what occurred in the Budweiser case, which was registered through the Czech EU accession treaty (the Czech Republic joined the EU in May 2004), thus precluding trade mark owners to raise any objections. See: WT/DS174/R (15 March 2005), para 7.573.

<sup>94</sup> Specifically, the US invoked art 16 of the TRIPS Agreement: ‘The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion’.

the EU argument that allowing coexistence of an earlier trade mark and a later similar or identical GI was a permissible exception to the trade mark owner’s exclusive rights under Art. 17 TRIPS.<sup>96</sup>

Coming back to the ‘imitation’ factor, we cannot help but compare the Budweiser disputes to the Prosecco case, where – as we have seen – Australian wine producers have taken (more than) inspiration from Italian winemaking culture. In this regard, the US case *Anheuser-Busch Inc, v Du Bois Brewing Co.* is again noteworthy,<sup>97</sup> with Judge Gibson interestingly summarising the history of the ‘Budweiser’ disputes between Anheuser-Busch and the Czech Budejovický Budvar between 1876 and 1939. According to the records of the case (§ 6), both Carl Conrad and Adolphus Busch, who served as President of E. Anheuser Company’s Brewing Association, were well acquainted with the name ‘Budweiser’ and its association with beer produced in the City of Budweis in Bohemia. Carl Conrad, having travelled to Europe prior to 1876, had learned that the European ‘Budweiser’ beer held a reputation as one of the finest beers crafted in the region. Similarly, Adolphus Busch had already been aware of the European Budweiser beer and brewing process employed in Budweis. Furthermore, according to the court’s summary in case *Anheuser-Busch Brewing Ass’n v Fred Miller Brewing Co.*,<sup>98</sup> the American beer in question was crafted using materials imported from the original brewery in Budweis, where the beer was originally manufactured. These materials included Saazer hops, a high-quality type of Bohemian barley, as well as Bohemian pitch and yeast. Initially, Anheuser-Busch imported these specific ingredients for a period of one to two years. They later began incorporating American barley and other substitutes into the production process. Despite the adjustments in ingredients, the resulting beer still maintained similarities to the original European Budweis production.

### 3. Rioja

Rioja is a province in northern Spain well-known for its wine production. The region has a long history of wine-making and has established a reputation for producing high-quality wines under the name ‘La Rioja’. The wines produced in this region now enjoy PDO status in the EU,<sup>99</sup> and in Spain protection as a collective trade mark since 1925 and as a designation of origin since 1991.<sup>100</sup>

<sup>95</sup> These are marks that have been applied for or registered in good faith, or in respect of which rights have been acquired through use in good faith, before 1 January 1996 or the time at which GI was protected in its country of origin.

<sup>96</sup> For an opinion according to which the EU has not sought to put forward a workable compromise solution to the problem of conflicting trade marks and GIs, see Michael Handler and Robert Burrell, ‘GI Blues: The Global Disagreement Over Geographical Indications’ (22 July 2012) <<https://papers.ssrn.com/abstract=2125818>> accessed 29 October 2023, that in the dispute the EU did not deny that ‘Budweiss’ GIs (‘Budejovické pivo’, ‘Ceskobudejovické pivo’) could be used in a manner that would result in a likelihood of confusion with prior trade marks ‘BUDWEISER’ and ‘BUD’.

<sup>97</sup> *Anheuser-Busch Inc, v Du Bois Brewing Co.* 73 F. Supp. 338, 348 (W.D. Pa. 1947) [*Du Bois Brewing Co.*], paras 4 and 7.

<sup>98</sup> *Anheuser-Busch Brewing Ass’n v Fred Miller Brewing Co.* 87 F. 864, 865 (E.D. Wis. 1898).

<sup>99</sup> See PDO-ES-A0117, registered since 13 June 1986.

<sup>100</sup> Royal Order of 6 June 1925 (Gaceta de Madrid No 160 of 1925) which, under the Industrial Property Act of 1902, established the

The origin of wine production in La Rioja dates from ancient times, with a rich history spanning centuries. The region's winemaking tradition can be traced to the period when the Romans conquered the Iberian Peninsula. During Roman rule, the city of Calagurris (present-day Calahorra) in the region of La Rioja became an important hub for wine production. The Romans recognised the region's favourable climate and fertile soil, which provided ideal conditions for viticulture. They introduced advanced techniques and cultivated vineyards, laying the foundation for the wine industry in La Rioja. Following the decline of the Roman Empire, winemaking in La Rioja continued under Moorish and Christian rule. The presence of monasteries played a crucial role in preserving and advancing winemaking practices there. Monastic orders, such as the Cistercians, planted vineyards and improved winemaking techniques, ensuring the continuity and quality of wine production.<sup>101</sup>

During the late 19th and early 20th centuries, Spain experienced significant socioeconomic challenges such as unemployment and political instability, which were worsened by a sharp downturn in the European wine industry.<sup>102</sup> These conditions, coupled with the allure of new opportunities and the promise of a better life in the new continent, prompted many Spanish people, including those from La Rioja, to seek opportunities abroad. Many went to Argentina, where at the time the government actively encouraged immigration as a means to populate and develop the country.<sup>103</sup> It is worth noting that when Spanish explorers and settlers arrived in America for the first time, including in the territory that now encompasses Argentina, they often named places after towns or regions in Spain.<sup>104</sup> This practice served to maintain a connection

creation, as a collective mark, of a seal on the packaging of Rioja wines. The recognition of Rioja as a 'Qualified' Designation of Origin came by the Order of the Ministry of Agriculture of 3 April 1991 (BOE-A-1991-8566) at <<https://www.boe.es/gazeta/dias/1925/06/09/pdfs/GMD-1925-160.pdf>> accessed 29 October 2023, in accordance with the Royal Decree 157/1988 of 22 February 1988 laying down the rules governing designations of origin and geographical indications.

**101** See the website <<https://riojawine.com/en/the-designation/history/>> accessed 29 October 2023.

**102** Phylloxera was one of the main indirect agents of this process. It is an insect native to North America, which was introduced in Europe and quickly spread throughout European vineyards producing devastating effects. The strong retraction of the European wine industry in the last third of the 19th century coincided exactly with the time of the massive migrations to America and the awakening of the modern wine industry in Argentina.

**103** The Argentinean National Constitution of 1853 encouraged (European) immigration. From then on, and especially with the passing of President Avellaneda's immigration law, a strong migratory flow to Argentina was unleashed, reaching nearly 7,000,000 people. Most of these immigrants were Italians (3,000,000) and Spanish (2,000,000). The third largest group was the French (250,000), ahead of Poles (182,000), and Germans (150,000). This period of mass immigration from Europe, including Spain, is often referred to as the 'Golden Age of Argentine Immigration'. See: Noemí Girbal-Blacha, 'Mario Rapoport y colaboradores, Historia económica, política y social de la Argentina (1880-2000), Buenos Aires, Ediciones Macchi, 2000' [2001] *Anuario del Centro de Estudios Históricos Profesor Carlos S A Segreti* 39. It is also interesting to note that in 1914, foreigners accounted for 30% of the country's total population. Mendoza, Argentina's great wine capital, was one of the regions of the country that received the most European immigrants, followed by Catamarca and La Rioja. See Javier Ozollo, 'El Vino Del Inmigrante: Los Inmigrantes Europeos y La Industria Vitivinícola Argentina: Su Incidencia En La Incorporación, Difusión y Estandarización Del Uso de Topónimos Europeos 1852-1980' (2005) 20 *Universum* (Talca) 325.

**104** As is known, Christopher Columbus, on behalf of the Catholic Monarchs of Spain, reached the American continent for the first time on

with their Spanish heritage and honour their places of origin. As a result, many cities, provinces, and regions in Argentina bear names that can be traced back to Spain.<sup>105</sup> This is also the case of 'La Rioja', a province in Argentina named as such by Juan Ramírez de Velasco, a Spanish citizen from the Spanish Rioja, to pay homage to the place where he was born and raised.<sup>106</sup> This area has a long winemaking tradition that began with the Spanish colonisation.<sup>107</sup>

Thus, there is an Argentine wine region, known as 'La Rioja', which shares the same name as a Spanish wine region. As just mentioned, during the 19th century many Spanish individuals and families, including those from the Spanish Rioja, emigrated to Argentina. These migrants played a significant role in shaping the foundation of modern winemaking in Argentina. Their influence had a lasting impact, including the adoption of European toponyms or place names, which became deeply ingrained in the country's viticultural practices.<sup>108</sup> Their use of European toponyms influenced, in turn, the state's decision-making process. As a result, laws and decrees were passed that standardised the use of European toponyms for Argentinean wine products.<sup>109</sup> Argentina passed the Law on 'Designation of Origin of Wines and Spirits' on 15 September 1999,<sup>110</sup> and subsequently the Resolution of the Instituto Nacional de Vitivinicultura de Argentina (INV) n. 32 of 14 November 2002 recognised the term 'La Rioja Argentina' as a 'Geographical Indication'.<sup>111</sup>

This geographical homonymity has posed significant challenges. Indeed, the Argentinean recognition of 'La Rioja' GI inevitably led to a conflict, resulting in

12 October 1492. The name Argentina would be coined later and officially established with the first constitution of the country in 1853. See the website of the Argentine government at <<https://www.argentina.gob.ar/pais/territorio/denominacion>> accessed 29 October 2023).

**105** For instance, 'Corboda', 'Santa Fe', 'Santa Cruz' which are both a province in Spain and in Argentina. See Luis Rubio Chávarri y Alcalá-Zamora, 'Ciudades homónimas de América y España' [1995] *Mar oceana: Revista del humanismo español e iberoamericano* 361.

**106** La Rioja province in Argentina was founded on 20 May 1591. Its original name, given by Velasco, was 'Ciudad de Todos los Santos de la Nueva La Rioja', which means 'City of all Saints of the New La Rioja'. See the website of the Tribunal Superior de Justicia de La Rioja <<https://justicialarioja.gob.ar/index.php/features/resena-historica?showall=1&limitstart=>>> accessed 29 October 2023) and the site Real Academia de la Historia <<https://dbe.rah.es/biografias/22250/juan-ramirez-de-velasco>> accessed 29 October 2023.

**107** Fernando González Botija and Carlos Coello Martín, 'Sobre el conflicto de nombres geográficos vinícolas: La Rioja argentina y el Rioja' [2004] *Anuario Jurídico de La Rioja* 25.

**108** Ozollo (n 103); Botija and Martín (n 107).

**109** Previously, various resolutions classified the wines of the Rioja Argentina in the hierarchy of wine quality. Examples are art 18 of the General Law of Wines No 14.872 of 1959 (BO 25/11/59) and art 1094 Law 18.284 of 1969 approving the Argentine Food Code (BO 28/7/69), which established the category 'Regional wine', introducing a criterion of territorial origin. This was understood as 'the wine made in the provinces of La Rioja, San Luis, Catamarca, Córdoba, Jujuy and Salta or wines from other provinces that the I.N.V. declares to be included in this denomination'.

**110** Ley de 'designación de origen de vinos y bebidas espirituosas', B.O.12/10/99.

**111** art 3 and Annex II, Resolution No C.32 dated 14 November 2002 <<https://www.argentina.gob.ar/normativa/nacional/resolucion-32-2002-79896/texto>> accessed 29 October 2023. Likewise, this resolution recognises (art 1) as Indication of Origin all table wines produced in the provinces of Jujuy, Catamarca, Córdoba, La Rioja, Mendoza, Neuquén, Río Negro, Salta, San Juan, Tucumán and the regional wines provided for in Law 14.878, among them those of La Rioja. For the use of these indications of origin, 80% of the wines must come from grapes produced and elaborated in the area where they bear the name (art 2).

the Spanish ‘Consejo Regulador de la Denominación de Origen Calificada Rioja’ challenging Resolution C-32 before the INV (this was an administrative proceedings).<sup>112</sup> From a Spanish perspective, by using the term ‘La Rioja’, Argentinean winemakers usurped the prestige of the Rioja GI. More specifically, the use of this GI by Argentinean producers – the argument goes – might have confused consumers, as they would associate the Argentinean wine with the Spanish wines’ quality and reputation. On the other hand, Argentinean winemakers argued that ‘La Rioja’ was a legitimate geographical name that refers to their region and that they have the right to use it to promote their wines. They further contended that they had no intention to mislead consumers, as they had labelled their wines as ‘La Rioja, Argentina’ or included other distinctive elements to differentiate them from the Spanish wines. Additionally, they stressed that the name ‘Rioja’ as linked to Argentinian wines had already been accepted by the EU itself before Spain’s accession to the bloc.<sup>113</sup>

The INV rejected the Spanish complaint, giving rise to a court case before the Argentinean Federal Court.<sup>114</sup> The first instance court ruling<sup>115</sup> also dismissed the Spanish claim, stating that the evidence presented by the Consejo Regulador did not demonstrate any potential confusion among consumers. Instead, it emphasised that the addition of the word ‘Argentina’ served as a distinguishing term, leaving no doubt that ‘La Rioja Argentina’ is a product originating from the Argentinean Republic. In this regard, the court’s decision aligned with the opinion expressed by the INV Legal Affairs Department, which preceded the administrative decision to reject the claim. Interestingly, the court further acknowledged that the distinguishing element – again, the term ‘La Rioja Argentina’ – also represents the name of the province from which the product actually originates. On account of this the Court concluded that the INV had followed the procedures under Art. 23(3) TRIPS concerning homonymous geographical indications which states that ‘[i]n the case of homonymous geographical indications for wines ... [e]ach Member shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled’.

In the Federal Court’s view, the measures adopted by the Consejo Regulador ensured fair treatment of producers and prevented consumer deception. The first instance

judgment was subsequently appealed before the National Court of Appeals for Federal Administrative Disputes, but the appeal was also unsuccessful.<sup>116</sup> The Consejo Regulador also appealed to the Supreme Court of Justice of the Nation (Corte Suprema de la Nación) that ultimately upheld the second instance’s judgment.<sup>117</sup> The ruling obviously only produces effects in Argentina, which means that Argentinean ‘La Rioja’ wines cannot be sold in the EU or countries with which the EU has concluded bilateral trade agreements protecting the Spanish ‘Rioja’ PDO.<sup>118</sup> It should moreover be noted that the ‘Rioja’ issue between Spain and Argentina is also a sticky point within the ongoing negotiations for a comprehensive trade agreement between the EU and Mercosur (of which Argentina is a member).<sup>119</sup>

#### 4. Parmesan

The cheesemaking tradition in the New World, especially in the US, can be traced back to its European roots, brought over by European immigrants. For example, Cheddar cheese was introduced by English immigrants who brought with them their cherished cultures and traditional cheesemaking techniques (Cheddar is a small town in the English county of Somerset from where this cheese originates).<sup>120</sup> Over time, as immigrants from various European countries arrived, they contributed their own cheesemaking methods, enriching America’s cheesemaking industry with diverse flavours and varieties. The

<sup>116</sup> Rodrigo Ramirez Herrera, ‘La Rioja versus La Rioja: Denominaciones de Origen de Vinos Españoles y Argentinos En Conflicto’ (*IP Tango*, 17 May 2012) <<https://iptango.blogspot.com/2012/05/la-rioja-versus-la-rioja-denominaciones.html>> accessed 29 October 2023.

<sup>117</sup> Corte Suprema de Justicia 1442/2012 (48-C)/CS1, Consejo Regulador Denominación Origen Calificada Rioja c/ E.N. – IN Vitivinicultura- Resol C 32/02 s/ proceso de conocimiento, judgment of 29 December 2015. The ruling only produces effect in Argentina. See also Marcela S Molina, ‘Las indicaciones de origen geográfico de vinos en la legislación argentina’ [2020] *Revista de la Facultad de Derecho* <[http://www.scielo.edu.uy/scielo.php?script=sci\\_abstract&pid=S2301-06652020000201103&lng=es&nrm=iso&tlang=es](http://www.scielo.edu.uy/scielo.php?script=sci_abstract&pid=S2301-06652020000201103&lng=es&nrm=iso&tlang=es)> accessed 29 October 2023; Leonardo Fabio Pastorino, ‘La justicia argentina resuelve el caso de la indicación geográfica ‘La Rioja-Argentina’ ante el reclamo del Consejo Regulador de la denominación ‘Rioja’ de España’ (2018) 34 *Revista de derecho agrario y alimentario* 85.

<sup>118</sup> See in this regard Botija and Martín (n 107). (Evidencing a number of practices which highlight the problems of marketing Argentine Rioja wine). The PDO Rioja is protected in several countries, including Albania (Agreement between the European Community and Albania [2009] OJ L107, 28 April 2009), Australia (Agreement between the European Community and Australia [2009] OJ L28, 30 January 2009), Japan (Agreement between the European Union and Japan for an Economic Partnership [2018] OJ L330, 27 December 2018) and South Korea (EU-South Korea Free Trade Agreement [2011] OJ L127, 14 May 2011) to name a few examples.

<sup>119</sup> The European Union and Mercosur States – Argentina, Brazil Paraguay, and Uruguay – reached a political agreement on 28 June 2019 for an ambitious, balanced, and comprehensive trade agreement. The Agreement includes a chapter on GIs, which means that both parties will mutually recognise certain GIs in their respective territories. Interestingly, the Annex II (listing the potential names to be protected) does not include ‘La Rioja Argentina’. By contrast, the EU seeks protection for Rioja, except in the territory of Argentina. See: Intellectual Property Annexes <<https://circabc.europa.eu/ui/group/09242a36-a438-40fd-a7af-fe32e36cbd0e/library/fd3f6c9f-1371-440f-b2ff-9357ea63bcc2/details>> accessed 29 October 2023. For a complete overview of the negotiations and the Agreement, see the EU-Mercosur Trade Agreement (*European Commission*, 8 March 2023) <[https://policy.trade.ec.europa.eu/eu-trade-relationships-country-and-region/countries-and-regions/mercosur/eu-mercosur-agreement\\_en](https://policy.trade.ec.europa.eu/eu-trade-relationships-country-and-region/countries-and-regions/mercosur/eu-mercosur-agreement_en)> accessed 29 October 2023.

<sup>120</sup> See Gordon Edgar, *Cheddar: A Journey to the Heart of America’s Most Iconic Cheese* (Chelsea Green Publishing 2015).

<sup>112</sup> Botija and Martín (n 107).

<sup>113</sup> The name ‘La Rioja/Argentina’ was officially recognized by the Community in Annex II of Regulation (EEC) No 1608/76 and later in Commission Regulation (EEC) No 997/81 on March 26, 1981. Available at <<https://www.boe.es/doue/1981/106/L00001-00071.pdf>> accessed 29 October 2023. This recognition allowed the designation to be used for Argentine wines imported into the Community territory. While this indication was then removed (but before Spanish accession to the EU), Argentinean authorities considered it as a precedent that demonstrates that the recognition of ‘Rioja-Argentina’ as a geographical indication predates Spain’s EU membership. See *ibid*.

<sup>114</sup> The case was heard by the Federal Administrative Court No 4 in the Federal Capital (Juzgado Contencioso Administrativo Federal No 4).

<sup>115</sup> Expediente N° 36.619/04 Caratulado *Consejo Regulador Denominación Origen Calificada da Rioja y Otro c/ E.N.* – In. *Viticultura-Resol C32/02 y Otros/ Proceso de Conocimiento*, judgment of 24 February 2011.

names of these artisanal cheeses remained unchanged, reflecting the homage to their European origins: Gouda, Emmentaler, Gruyère, Asiago, Parmesan, Fontina, and more. However, these newfound American cheeses did not receive the same level of admiration back in Europe. European cheesemakers saw those cheeses as being of an inferior quality. They argued that the milk used in America came from different breeds of cattle, fed on grass grown in different soils, ultimately lacking the distinct terroir that characterized European cheeses.<sup>121</sup>

The same story unfolded with the Parmigiano Reggiano cheese. This is a type of Italian cheese that has been produced since the 15th century around the towns of Parma and Reggio Emilia in the Emilia-Romagna region of Italy. It is a hard white cheese with small holes and is ideal for grating. And once again the ‘migration’ factor comes in. Countless individuals and families, both from Europe and other continents, embarked on journeys to these ‘new’ territories with the aspiration of attaining improved living standards.<sup>122</sup> Inevitably, upon arrival in unfamiliar territories, individuals sought to recreate the familiar conditions reminiscent of their places of origin. Consequently, upon the migration of Italians from towns such as Parma, Bologna, Reggio Emilia, and Modena to North America, Brazil, Argentina and other countries, they commenced the production of cheese akin to the variety they were accustomed to crafting.<sup>123</sup> Many Italians who arrived in these countries referred to the cheese now known as Parmigiano Reggiano as ‘Parmesan’, an English translation of the Italian word. Parmigiano Reggiano did not receive formal recognition in Italy until the 20th century. Specifically, the name ‘Parmigiano Reggiano’ was coined in 1934 by an Italian inter-provincial consortium and then was granted protected status in 1954.<sup>124</sup> For over half a century Italian producers were able to market their cheese under this unique and recognizable appellation. Representatives from the cheese factories of the Italian

towns of Parma, Reggio, Modena, and Mantua unanimously agreed on the importance of establishing an origin label for their cheese. The primary objective behind this initiative was to promote and safeguard the traditional production methods and distinctive characteristics of the Parmigiano Reggiano cheese.<sup>125</sup> In 1969 Parmigiano Reggiano was officially registered as an Appellation of Origin (AO) under the Lisbon Agreement, further solidifying its status,<sup>126</sup> and in 1996 it also achieved EU PDO status.<sup>127</sup> Then in 2008, the CJEU ruled that the PDO owner, the Consorzio del Formaggio Parmigiano Reggiano, can prevent in the EU the use of the translated term ‘Parmesan’ in relation to any cheese produced outside the relevant geographical area in Italy.<sup>128</sup> This ruling did not come as a surprise, as EU GIs law has always allowed GIs owners to also enforce their exclusive rights where third parties who manufacture the relevant product in different territories use a translated name.

Outside Italy, however, the term ‘Parmesan’ has become a generic identifier for dry grated cheeses of a comparable style, and the process of this brand becoming a generic name has also been influenced by migration waves. Indeed, drawing upon their rich heritage and the expertise acquired in Italy, talented artisans carried with them the know-how and techniques of Parmigiano Reggiano cheese production across the Atlantic. They adapted to local resources while adhering to the methods they had mastered in their homeland, transplanting the tradition across the ocean. According to commentators from the New World, part of Parmigiano Reggiano’s popularity in the New World can be attributed to waves of Italian immigrants.<sup>129</sup>

It is also important to note that the Parmesan cheese produced in the New World was a variation, albeit a skillfully crafted one, due to certain inherent differences. The replica created by these immigrant cheesemakers embodied the artistry and techniques of its Italian counterpart, but the distinct characteristics of the foreign terroir necessarily influenced the final product. One significant factor was the variation in cattle breeds and their diet. The milk used for the New World Parmesan came from different breeds of cows than those traditionally used in Italy. Indeed, the unique qualities of the milk from specific Italian cattle breeds, combined with their diet – primarily consisting of lush grasses from the rich soil – have contributed to the distinctive flavours and textures found in the authentic Italian Parmigiano Reggiano.<sup>130</sup> However, these qualities, flavours and textures have not been replicated

<sup>121</sup> See Parmigiano Reggiano official website in the US: <<https://parmigianoreggiano.us/the-cheese/>> accessed 28 November 2023.

<sup>122</sup> See Alberto Grandi, *Denominazione di Origine Inventata* (Mondadori 2020) 83.

<sup>123</sup> *ibid*; for example, Reggianito is the generic name used to describe variety of hard cheese produced in Argentina. Its origins can be traced back to the Italian hard cheeses Parmigiano Reggiano and Grana Padano. The cheese-making techniques used for Reggianito are an adaptation of the Italian methods introduced to the country by Italian immigrants. See Guillermo Hough and others, ‘Sensory profiling during ripening of reggianito grating cheese, using both traditional ripening and in plastic wrapping’ (1994) 5 *Food Quality and Preference* 271. The countries of Mercosur (Argentina, Brazil, Paraguay, and Uruguay) have established a ‘technical regulation’ regarding the ‘identity and quality’ conditions of certain hard cheeses such as ‘Queso Parmesão’, ‘Queso Parmesano’, ‘Queso Reggianito,’ and ‘Queso Reggiano.’ This regulation governs the technical characteristics of these cheeses, providing definitions, classifications, requirements, and compositions for this type of cheese. See Mercosur/GMC/RES No 1/97 Reglamento Técnico Mercosul de Identidad e Calidad del Queso Parmesão, Parmesano, Reggiano, Reggianito y Sbrinz.

<sup>124</sup> The Parmigiano Reggiano Consortium, formerly known as ‘Consorzio volontario Grana-Tipico’, was renamed on 12 November 1954 and was officially awarded the supervision of Parmigiano Reggiano cheese production and trade in 1957. See Decreto ministeriale 17 giugno 1957, incarico di vigilanza sulla produzione ed il commercio del formaggio ‘Parmigiano Reggiano’, *Gazzetta Ufficiale della Repubblica Italiana*, 25 Giugno 1957, Anno 98, n. 157 p 2384. See also art 3 and Annex A, Legge 10 aprile 1954, n. 125, Tutela delle denominazioni di origine e tipiche dei formaggi. (GU Serie Generale n. 99 del 30-04-1954) and art 1, D.P.R. 30 ottobre 1955, n. 1269, Riconoscimento delle denominazioni circa i metodi di lavorazione, caratteristiche merceologiche e zone di produzione dei formaggi.

<sup>125</sup> See The History of Parmigiano-Reggiano <<https://www.parmigianoreggiano.com/consortium-history/>> accessed 29 October 2023.

<sup>126</sup> See WIPO, ‘The King of Cheese and its IP Crown’ <<http://www.wipo.int/ipadvantage/en/details.jsp?id=3664>> accessed 29 October 2023.

<sup>127</sup> See: eAmbrosia No PDO-IT-0016.

<sup>128</sup> Case C-132/05 *Commission of the European Communities v Germany* ECLI:EU:C:2008:117, [2008] E.C.R. I-957, [2008] 2 WLUK 640.

<sup>129</sup> See for example Alexis Benveniste, ‘The Small Town Where Beloved Parmesan Cheese Got Its Start’ *The New York Times* (New York, 7 January 2022) <<https://www.nytimes.com/2022/01/07/crosswords/the-small-town-where-beloved-parmesan-cheese-got-its-start.html>> accessed 29 October 2023.

<sup>130</sup> Yet a few scholars argue that prior to the 1960s, Parmigiano Reggiano cheese allegedly possessed distinct characteristics, including a significantly smaller size, a softer texture, and a completely black rind. Interestingly, these qualities were strikingly similar to the Parmesan

by Italian immigrants and their descendants in the New World.<sup>131</sup> In other words, what can never be ‘exported’ is the so-called ‘*genius loci*’ of the Italian production area (e.g. microbiological aspects derived from the natural environment, such as lactic acid bacteria, thermophiles, and mesophiles, but also enzymes typical of the environment where milk and cheese are produced). Such ‘*genius loci*’ is indeed unique to these zones and greatly influences the final product.

The case of Parmigiano Reggiano and Parmesan epitomises the GIs tensions between the Old World and New World countries. Commentators in the latter states claim that Parmesan – a term initially introduced by Italian immigrants as a simplified and anglicised version of Parmigiano Reggiano – has surpassed its original geographical association and evolved into a widely recognized and accepted generic identifier. On the other hand, the voice from the Old World, especially Europe, proclaims that the generic use of ‘Parmesan’ in many non-European countries has led to a dilution of the distinctiveness and exclusivity associated with the Parmigiano Reggiano brand, and risks confusing consumers as to the place of production of the cheese – which would jeopardise the business of the Italian producers of the original Parmigiano Reggiano. The proliferation of ‘Parmesan’ as a generic term – the argument goes – is the result of the extensive marketing and distribution efforts by non-Italian producers who have capitalised on the popularity of the cheese and its association with the Italian culinary tradition to market their own products. In other words, to Italian eyes, by using the term Parmesan, producers of similar cheeses from the new World tap into the established recognition and positive reputation of a genuine Italian product while bypassing the stringent production requirements and quality standards associated with the ‘real’ Parmigiano Reggiano.

## V. Conclusion

In this article, after briefly highlighting the EU system of GIs protection, we have expanded on the tension between the Old World and the New World when it comes to protecting these intellectual property rights and specifically on the impact of migration from Europe on GIs regimes in some countries of the New World. The US, Canada, Australia, Argentina, and other states have indeed relied on this ‘migration’ factor to resist the EU’s demands to claw back what Europeans believe are names for food and alcoholic products which should exclusively be exploited by producers located in those European geographical areas. As we have seen, the EU is particularly protective when it comes to safeguarding the cultural heritage embodied in those names and, more importantly, the reputation behind those terms, which can guarantee consumers’ preference and loyalty and, consequently, market shares. As we also have seen, the EU is pursuing a GI

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cheese produced in Wisconsin today. These scholars suggest that the expertise and techniques required for crafting this cheese were purportedly transferred to the New World during the late 19th and early 20th centuries, thanks to the mass immigration of millions of Italians to America. See Grandi (n 122) 87–88.

<sup>131</sup> Kees De Roest, *The Production of Parmigiano-Reggiano Cheese: The Fource of an Artisanal System in an Industrialized World* (Van Gorcum Assen Publisher 2000) 34.

protective agenda when negotiating international trade and economic partnership deals with other nations. In this concluding section, we outline a couple of proposals which could be adopted to achieve workable solutions which could strike a balance between the two polarised positions of the Old World and New World.

One of them has been put forward by Irene Calboli in an article she published in 2015 in the *Houston Law Review*.<sup>132</sup> She suggests adopting the same kind of compromise reached by the EU and Canada when concluding the CETA. For example, CETA has grand-fathered pre-uses of several European GIs which had been used by Canadian producers before its entry into force. Also, several EU wine and spirit GIs are protected in Canada, but Canadian producers are free to use the English or French translations of those names. Thus, while Europeans have exclusive rights over the terms ‘Naranjas de Valencia’ and ‘Parmigiano’, Canadian producers can adopt the translated brands ‘Valencia oranges’ and ‘Parmesan’ as well as other translations of European names such as ‘Black Forest ham’, ‘Tiroler bacon’, ‘Munich beer’ and ‘Bavarian beer’. Also, CETA protects some European GIs for cheeses, including ‘Fontina’, ‘Asiago’, ‘Feta’, ‘Gorgonzola’, and ‘Münster’ but Canadians can also use them accompanied by terms ‘style’, ‘type’, ‘kind’, ‘imitation’, etc. Moreover, several European GIs are now protected in Canada but just as compound names. For example, the sign ‘Edam Holland’ is protected, but not the term ‘Edam’ as a single word; the expression ‘Gouda Holland’ gets protection, but the single word ‘Gouda’ does not; the term ‘Mortadella Bologna’ is protected, but not the names ‘Mortadella’ or ‘Bologna’; the expression ‘Brie de Meaux’ is protected, the sign ‘Brie’ is not. There are also European GIs like ‘Noix de Grenoble’ and ‘Budejovicke beer’, which have obtained no protection even after CETA. The lack of protection for the latter GI is probably a concession to the US company which owns registered trade marks for the sign ‘Budweiser’ in many countries of the world<sup>133</sup> – an outcome which has evidently left several European producers rather disappointed. It should also be remembered – as we have noted in Section 3 – that under CETA Canada has agreed to protect just 41 Italian GIs out of the 291 names that Italy had tried to protect. After all, during the CETA negotiations, the EU (and Italy) also had to compromise and make concessions.

What about the ‘migration’ factor we have constantly referred to in our article? Could this factor (which is often stressed by producers and commentators in the New World to substantiate their claims) be a valid argument against European demands to protect their GIs in the countries in question? While we recognise the role migration has had in shaping agricultural practices in the New World and the need felt by European migrants to adopt in their new ‘home’ the names of the areas they had left to describe their cheeses, ham, wines and other traditional products, we also acknowledge the fact that the number of anti-GI claims made by immigrants is often exaggerated in the New World. This has again been noted by Irene Calboli, who also notes that the ‘anti-GI camp’

<sup>132</sup> See Calboli (n 21) 373, 418.

<sup>133</sup> *ibid* 412.

often uses the immigrant narrative to contribute to ‘the emotional rhetoric that characterizes the GI debate’.<sup>134</sup> It should also be remembered that those who produce foodstuffs or alcoholic drinks in the New World and use European geographical names are big companies, not the descendants of those Europeans who migrated decades or centuries ago – which inevitably weakens the argument based on the ‘migration’ factor. Moreover, a CETA-like compromise such as the grandfather clause may again provide a solution here, as it would safeguard the pre-existing rights over the names in question of any entity, both transnational corporations and small and medium-sized enterprises once founded by immigrants.<sup>135</sup>

A compromise solution could also be based on specific provision of the TRIPS Agreement on homonymous GIs for wines, which we have already mentioned in Section IV of this article, i.e. Art. 23(3). The Argentinean court in the Rioja case explicitly referred to this provision. As we noted, the court found that the procedures under this

provision were correctly applied in the dispute in question. It should also be borne in mind that that Art. 23(3) of the TRIPS Agreement provides that ‘[i]n the case of homonymous geographical indications for wines ... [e]ach Member shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled’. It could be proposed to extend this provision to all types of GIs, not only in relation to wines.<sup>136</sup> Indeed such ‘practical conditions’ – which could include, for example, the requirement that in addition to the GI in question, the country of origin also be stated on the label of the product, be it a cheese, ham or other foodstuff – would go in the direction of maximising consumers’ information and minimising the risk of confusing purchasers about the geographical origin of the product – an outcome which a CETA-style solution would also be able to achieve.<sup>137</sup>

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<sup>136</sup> Yet the experience of the latest decades shows how difficult modifying TRIPS is, as it would require the consensus of all WTO countries including those in the New World which would obviously be against this change.

<sup>137</sup> However, the addition of the country of origin as an input to differentiate the country of production seems to have been rejected in the current EU Regulation proposal for amending the current GIs regime for agricultural products, mentioned at the above n 15; art 30 of this text indeed states that: ‘1. A geographical indication that has been applied for after a wholly or partly homonymous geographical indication had been applied for or protected in the Union, shall not be registered unless there is sufficient distinction in practice between the conditions of local and traditional usage and the presentation of the two homonymous indications, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled as to the true identity or geographical origin of the products. 2. A wholly or partly homonymous name [*is suggestive of another product or*] which misleads the consumer into believing that products come from another territory shall not be registered even if the name for the actual territory, region or place of origin of the products in question is accurate.’ (emphasis added). It is worth mentioning that the proposal for the Regulation of GIs for industrial products contained a similar provision in art 43 (see n 16). The recent Parliament approval eliminated the reference to the refusal of wholly or partially homonymous names that are ‘suggestive of another product’. It remains to be seen if the Parliament will follow the same approach when approving the Proposal for Amending the Regulation for agricultural GIs (n 15).

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<sup>134</sup> *ibid* 418.

<sup>135</sup> *ibid* 418.