

Court of Justice EU, 8 May 2014, Assica



GEOGRAPHICAL INDICATIONS

Regulation on the protection of geographical indications and designations of origin for agricultural products and foodstuffs does not oppose additional national legislation, when that legislation does not undermine the objectives of the Regulation or contravene the principle of the free movement of goods

• Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, as amended by Council Regulation (EC) No 535/97 of 17 March 1997, must be interpreted as meaning that it does not afford protection to a geographical designation which has not obtained a Community registration, but that that geographical designation may be protected, should the case arise, under national legislation concerning geographical designations relating to products for which there is no specific link between their characteristics and their geographical origin, provided, however, that, first, the implementation of that legislation does not undermine the objectives pursued by Regulation No 2081/92 as amended by Council Regulation (EC) No 535/97 and, secondly, it does not contravene the principle of the free movement of goods under Article 28 EC, matters which fall to be determined by the national court.

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Court of Justice EU, 8 May 2014

(M. Safjan, President of the Chamber, J. Malenovský (Rapporteur) and K. Jürimäe)

JUDGMENT OF THE COURT (Ninth Chamber)

8 May 2014 (*)

(Agriculture — Agricultural products and foodstuffs — Regulation (EEC) No 2081/92 — Article 2 — Protection of geographical indications and designations of origin — Material scope — Protection on national territory — Absence of Community registration — Consequences — Protection of designations relating to products for which there is no specific link between their characteristics and their geographical origin — Conditions)

In Case C-35/13,

REQUEST for a preliminary ruling under Article 267 TFEU from the Corte suprema di cassazione (Italy),

made by decision of 13 December 2012, received at the Court on 24 January 2013, in the proceedings
Assica — Associazione Industriali delle Carni e dei Salumi,

Kraft Foods Italia SpA

v

Associazione fra produttori per la tutela del ‘Salame Felino’,

La Felinesa Salumi SpA,

Salumificio Monpiù Srl,

Salumi Boschi Fratelli SpA,

Gualerzi SpA,

Alinovi Tullio di Alinovi Giorgio & C. Snc,

Salumificio Gastaldi di Gastaldi Franco & C. Snc,

Boschi Cav. Umberto SpA,

Fereoli Mario & Figlio Snc,

Salumificio Ducale Snc di Morini & Tortini,

Fereoli Gino & Figlio Snc,

Ronchei Srl,

Salumificio B.R.B. Snc,

THE COURT (Ninth Chamber),

composed of M. Safjan, President of the Chamber, J. Malenovský (Rapporteur) and K. Jürimäe, Judges,

Advocate General: E. Sharpston,

Registrar: A. Impellizzeri, Administrator,

having regard to the written procedure and further to the hearing on 9 January 2014,

after considering the observations submitted on behalf of:

– Assica — Associazione Industriali delle Carni e dei Salumi, by N. Lipari and M. Casini, avvocati,

– Associazione fra produttori per la tutela del ‘Salame Felino’, La Felinesa Salumi SpA, Salumificio Monpiù Srl, Salumi Boschi Fratelli SpA, Gualerzi SpA, Alinovi Tullio di Alinovi Giorgio & C. Snc, Salumificio Gastaldi di Gastaldi Franco & C. Snc, Boschi Cav. Umberto SpA, Fereoli Mario & Figlio Snc, Salumificio Ducale Snc di Morini & Tortini, Fereoli Gino & Figlio Snc, Ronchei Srl and Salumificio B.R.B. Snc, by S. Magelli, avvocato,

– Procuratore generale della Repubblica presso la Corte suprema di cassazione, by R. Russo, Sostituto Procuratore Generale,

– the Italian Government, by G. Palmieri, acting as Agent, assisted by P. Gentili, avvocato dello Stato,

– the European Commission, by D. Triantafyllou and P. Rossi, acting as Agents,

having decided, after hearing the Advocate General, to proceed to judgment without an Opinion,

gives the following

Judgment

1 This request for a preliminary ruling concerns the interpretation of Article 2 of Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ 1992 L 208, p. 1), as amended by Council Regulation (EC) No 535/97 of 17 March 1997 (OJ 1997 L 83, p. 3) (‘Regulation No 2081/92’).

2 The request has been made in proceedings between Assica — Associazione Industriali delle Carni e dei

Salumi ('Assica') and Kraft Foods Italia SpA ('Kraft Foods'), and, first, the Associazione fra produttori per la tutela del 'Salame Felino' ('the Associazione fra produttori') and, secondly, La Feline Salumi SpA, Salumificio Monpiù Srl, Salumi Boschi Fratelli SpA, Gualerzi SpA, Alinovi Tullio di Alinovi Giorgio & C. Snc, Salumificio Gastaldi di Gastaldi Franco & C. Snc, Boschi Cav. Umberto SpA, Fereoli Mario & Figlio Snc, Salumificio Ducale Snc di Morini & Tortini, Fereoli Gino & Figlio Snc, Ronchei Srl and Salumificio B.R.B. Snc, all of those 12 companies being members of the Associazione fra produttori, concerning the conditions under which a geographical designation may be used to designate a product manufactured outside of the relevant zone where that designation is not recognised as a protected designation of origin or as a protected geographical indication within the meaning of Regulation No 2081/92.

Legal context

EU law

3 Regulation No 2081/92 states, in the seventh, ninth and twelfth recitals of the preamble thereto, as follows:

'Whereas, however, there is diversity in the national practices for implementing registered designations of origin and geographical indications; whereas a Community approach should be envisaged; whereas a framework of Community rules on protection will permit the development of geographical indications and designations of origin since, by providing a more uniform approach, such a framework will ensure fair competition between the producers of products bearing such indications and enhance the credibility of the products in the consumers' eyes;

...

Whereas the scope of this Regulation is limited to certain agricultural products and foodstuffs for which a link between product or foodstuff characteristics and geographical origin exists; whereas, however, this scope could be enlarged to encompass other products or foodstuffs;

...

Whereas to enjoy protection in every Member State geographical indications and designations of origin must be registered at Community level; whereas entry in a register should also provide information to those involved in trade and to consumers'.

4 According to Article 2(1) and (2) of Regulation No 2081/92:

'1. Community protection of designations of origin and of geographical indications of agricultural products and foodstuffs shall be obtained in accordance with this Regulation.

2. For the purposes of this Regulation:

(a) designation of origin: means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff:
– originating in that region, specific place or country, and
– the quality or characteristics of which are essentially or exclusively due to a particular geographical environment with its inherent natural and human

factors, and the production, processing and preparation of which take place in the defined geographical area;

(b) geographical indication: means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff:

– originating in that region, specific place or country, and

– which possesses a specific quality, reputation or other characteristics attributable to that geographical origin and the production and/or processing and/or preparation of which take place in the defined geographical area.'

5 Under Article 13(1) of that regulation:

'1. Registered names shall be protected against:

(a) any direct or indirect commercial use of a registered name in respect of products not covered by the registration in so far as those products are comparable to the products registered under that name or in so far as using the name exploits the reputation of the protected name;

(b) any misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as "style", "type", "method", "as produced in", "imitation" or similar;

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

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

Where a registered name contains within it the name of an agricultural product or foodstuff which is considered generic, the use of that generic name on the appropriate agricultural product or foodstuff shall not be considered to be contrary to (a) or (b) in the first subparagraph.'

6 Regulation No 2081/92 was repealed by Council Regulation (EC) No 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ 2006 L 93, p. 12). However, having regard to the date of the facts of the dispute in the main proceedings, that dispute is still governed by Regulation No 2081/92.

Italian law

7 Article 31(1) and (2) of Legislative Decree No 198 containing provisions that ensure the conformity of the national industrial property legislation with the mandatory provisions of the Agreement on Trade-Related Aspects of Intellectual Property Rights - Uruguay Round Agreement (Legislative Decree No 198 — Adeguamento della legislazione interna in materia di proprietà industriale alle prescrizioni obbligatorie dell'accordo relativo agli aspetti dei diritti di proprietà intellettuale concernenti il commercio — Uruguay Round), of 19 March 1996 (ordinary

supplement to the GURI No 64), in force at the material time ('Legislative Decree No 198/1996'), provides:

'1. Geographical indications shall be indications which identify a product as originating in a country, a region or a locality, where a given quality, reputation or characteristic of the product is exclusively or essentially attributable to its geographical origin, including natural, human and heritage factors.

2. Without prejudice to the provisions of Article 2598(2) of the Civil Code and to the special provisions applying to this subject matter, as well as to trademark rights which were acquired previously in good faith, the use of geographical indications or of any other means in the designation or presentation of a product which indicate or suggest that such product originates in a locality other than its true place of origin, or that the product has such qualities as are typical of products originating in a locality designated by a geographical indication, shall constitute an act of unfair competition where it is liable to mislead the public.'

The dispute in the main proceedings and the questions referred for a preliminary ruling

8 'Salame Felino' is a pure pork salami sausage. Its name comes from the town of Felino, a conurbation located in the province of Parma (Italy).

9 On 30 January 1998, the Associazione fra produttori brought proceedings against Kraft Jacobs Suchard SpA ('Kraft Jacobs Suchard') before the Tribunale di Parma (District Court, Parma) for unfair competition on the ground that Kraft Jacobs Suchard had offered for sale a salami sausage called 'Salame Felino', whereas it had been produced outside the territory of the Parma region, namely in Lombardy, in Cremona (Italy).

10 La Felinese Salumi SpA, Salumificio Monpiù Srl, Salumi Boschi Fratelli SpA, Gualerzi SpA, Alinovi Tullio di Alinovi Giorgio & C. Snc, Salumificio Gastaldi di Gastaldi Franco & C. Snc, Boschi Cav. Umberto SpA, Fereoli Mario & Figlio Snc, Salumificio Ducale Snc di Morini & Tortini, Fereoli Gino & Figlio Snc, Ronchei Srl, Salumificio B.R.B. Snc intervened in support of the Associazione fra produttori.

11 Assica, of which Kraft Jacobs Suchard is a member, intervened in support of the latter.

12 By judgment of 9 February 2001, the Tribunale di Parma found that the Associazione fra produttori could not rely on Regulation No 2081/92, as the name 'Salame Felino' did not constitute a protected designation of origin or a protected geographical indication within the meaning of that regulation. The Tribunale di Parma nevertheless held that the Associazione fra produttori could rely on the provisions of Article 31 of Legislative Decree No 198/1996. Consequently, having found that the products marketed by Kraft Jacobs Suchard did not come from the territory of Parma, whereas 'Salame Felino' had acquired a reputation among consumers with respect to its characteristics, which stem from a particular feature related to the geographical environment, the Tribunale

di Parma held that the conduct of Kraft Jacobs Suchard constituted an act of unfair competition.

13 Kraft Jacobs Suchard, now Kraft Foods, and Assica brought an appeal against that judgment.

14 By judgment of 12 January 2006, the Corte d'appello di Bologna (Court of Appeal, Bologna) dismissed that appeal on the ground, inter alia, that the protection offered by Legislative Decree No 198/1996 did not conflict with Regulation No 2081/92 and that the registration of a name as a protected designation of origin or as a protected geographical indication was necessary solely in order to benefit from the protection conferred by that regulation.

15 Assica and Kraft Foods brought an appeal in cassation.

16 In support of their appeal, Assica and Kraft Foods claim that the protection of designations of origin provided for by Regulation No 2081/92 precludes any possibility of national law conferring an exclusive right to use a designation of origin which has not obtained a Community registration. In any event, they argue that the existence of a protection granted to a designation of origin presupposes the existence of a specific regulation, which is lacking in the main proceedings.

17 In those circumstances, the Corte suprema di cassazione (Supreme Court of Cassation) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

'(1) Should Article 2 of Regulation No 2081/92 be interpreted as precluding a producers' association from being able to claim the right exclusively to use, within the [European Union], a designation of geographical origin used within a Member State to designate a specific type of salami sausage, without having first obtained a legally binding measure from that Member State establishing the boundaries of the geographical area of production, the rules and regulations governing production, and any requirements which producers may have to satisfy in order to be entitled to use that designation?

(2) In the light of Regulation No 2081/92, which set of rules should be applied within the [European Union] market and also within the market of a Member State to a geographical designation which has not obtained the registration referred to in that regulation?'

Consideration of the questions referred for a preliminary ruling

Admissibility

18 The Associazione fra produttori contends that the request for a preliminary ruling is inadmissible in so far as answers to the questions submitted are not objectively necessary to decide the case in the main proceedings. In the main proceedings, that association never claimed to be the proprietor of an exclusive right to the geographical designation 'Salame Felino', but merely requested that Kraft Foods be censured on the basis of the provisions against unfair competition.

19 In that regard, it is apparent from settled case-law that in proceedings under Article 267 TFEU, which are based on a clear separation of functions between the

national courts and the Court of Justice, it is solely for the national court before which the dispute has been brought, and which must assume responsibility for the subsequent judicial decision, to determine, in the light of the particular circumstances of the case, both the need for and the relevance of the questions which it submits to the Court (Case C-415/11 Aziz EU:C:2013:164, paragraph 34).

20 Accordingly, where a request for a preliminary ruling concerns the interpretation or validity of EU law, the Court may refuse to rule on such a request only where it is quite obvious that the interpretation of EU law that is sought bears no relation to the actual facts of the main action or its purpose, where the problem is hypothetical, or where the Court does not have before it the factual or legal material necessary to give a useful answer to the questions submitted to it (Aziz EU:C:2013:164, paragraph 35).

21 However, that is not the case here. To argue that Kraft Foods carried out an act of unfair competition by using the geographical designation ‘Salame Felino’, the Associazione fra produttori proceeds on the basis of the premise that only producers of salami sausage located in the Parma region, which it represents, have the exclusive right to make use of that designation. Also, for the purposes of determining the merits of the action brought by the Associazione fra produttori, it is for the referring court to ascertain whether that association may rely on the existence of an exclusive right, for producers who fulfil certain conditions, to the geographical designation ‘Salame Felino’.

22 In those circumstances, it cannot be held that it is obvious that the interpretation of EU law sought is unrelated to the actual facts of the main action or its purpose.

23 Since it is not apparent from the case file that the problem is hypothetical, or that the Court does not have before it the factual or legal material necessary to give a useful answer to the questions submitted to it, the request for a preliminary ruling cannot be regarded as inadmissible.

The second question

24 By its second question, which it is appropriate to examine first, the referring court asks, essentially, whether Regulation No 2081/92 must be interpreted as meaning that it affords protection to a geographical designation which has not obtained a Community registration.

25 First, as regards the set of rules to be applied in the EU market to a geographical designation which has not obtained a registration, it should be noted that at the material time in the case before the referring court, the only rules on the protection of geographical designations under EU law were those introduced by Regulation No 2081/92.

26 However, as is apparent from the twelfth recital in the preamble to Regulation No 2081/92 and Article 13(1) thereof, in order to enjoy the protection provided for by it, that regulation introduced an obligation to obtain Community registration of geographical designations (see, to that effect, Joined Cases

C-129/97 and C-130/97 Chiciak and Fol EU:C:1998:274, paragraphs 25 and 26).

27 It follows that, on the Community market, where a geographical designation has not obtained a registration, in the light of the provisions of Regulation No 2081/92, it cannot enjoy the protection provided for by that regulation.

28 As regards, next, the set of rules to be applied in the market of a Member State, it is apparent from the case-law that whilst the aim of Regulation No 2081/92 is to provide a uniform and exhaustive system of protection (see Case C-478/07 Budějovický Budvar EU:C:2009:521, paragraph 114), that exclusivity does not preclude, however, the application of rules governing the protection of geographical designations which fall outside its scope (see, to that effect, Case C-312/98 Warsteiner Brauerei EU:C:2000:599, paragraph 54).

29 In that regard, it is apparent from the ninth recital in the preamble to Regulation No 2081/92 and Article 2(2)(b) thereof that the rules on protection laid down by that provision cover only designations relating to products for which there is a specific link between their characteristics and their geographical origin (see, to that effect, Case C-216/01 Budějovický Budvar EU:C:2003:618, paragraph 76).

30 Accordingly, designations of geographical origin serving only to highlight the geographical origin of a product, regardless of its particular characteristics, do not fall within the scope of Regulation No 2081/92 (see, to that effect, Warsteiner Brauerei EU:C:2000:599, paragraph 44).

31 Consequently, the system of protection that can be applied, should the case arise, on the market of a Member State, to a geographical designation which has not obtained a Community registration is that provided for geographical designations relating to products for which there is no specific link between their characteristics and their geographical origin.

32 In the present case, it is for the national court to determine whether the set of rules on the protection of geographical designations established by Legislative Decree No 198/1996 meets that condition.

33 If the national court reaches the conclusion that the aim of that set of rules is to protect geographical designations relating to products for which there is no specific link between their characteristics and their geographical origin, it should be noted that, for such a set of rules to be applicable, it must comply with the requirements imposed by EU law. In that regard, two conditions must be met, namely, first, its application must not undermine the objectives of Regulation No 2081/92 (see, to that effect, Warsteiner Brauerei EU:C:2000:599, paragraph 49) and, secondly, it must not contravene the principle of the free movement of goods referred to in Article 28 EC (see, inter alia, to that effect, Budějovický Budvar EU:C:2003:618, paragraphs 95 to 97).

34 As regards the first condition, having regard to the scope of Regulation No 2081/92, in order not to undermine the objectives of that regulation, the

protection granted by a national set of rules must not have the effect of guaranteeing to consumers that products which enjoy that protection have a particular quality or characteristic, but only of ensuring that those products do in fact originate from the geographical area referred to.

35 As regards the second condition, it must be pointed out that a national set of rules for the protection of designations, such as that at issue in the main proceedings, even when applied to both domestic products and those imported into the territory of the State concerned, is liable to promote the marketing of products of domestic origin to the detriment of imported products (Joined Cases C-321/94 to C-324/94 *Pistre and Others* EU:C:1997:229, paragraph 45).

36 Consequently, such legislation must be regarded as a measure having an effect equivalent to a quantitative restriction on the free movement of goods, as referred to in Article 28 EC.

37 Whilst such a restriction may be justified by the overriding public-interest requirement of protecting fair competition or that of protecting consumers (see, *inter alia*, to that effect, [Budějovický Budvar EU:C:2003:618, paragraph 109](#)), a given set of national rules, in order to be compatible with EU law, must be applied in a non-discriminatory manner, be suitable for securing the attainment of the objective pursued and must not go beyond what is necessary in order to attain that objective (Case C-500/06 *Corporación Dermoesztética* EU:C:2008:421, paragraph 35 and the case-law cited).

38 It is for the national court to satisfy itself, first, that the application of the national legislation in question does not have the purpose or effect of guaranteeing to consumers that products marketed under a specific geographic designation have a particular quality or characteristic and, secondly, that the implementation of that legislation pursues an overriding requirement in the public interest, is carried out in a non-discriminatory manner, is suitable for securing the attainment of the objective pursued and does not go beyond what is necessary in order to attain that objective.

39 Having regard to all the foregoing considerations, the answer to the second question is that Regulation No 2081/92 must be interpreted as meaning that it does not afford protection to a geographical designation which has not obtained a Community registration, but that that geographical designation may be protected, should the case arise, under national legislation concerning geographical designations relating to products for which there is no specific link between their characteristics and their geographical origin, provided, however, first, that the implementation of that legislation does not undermine the objectives pursued by Regulation No 2081/92 and, secondly, that it does not contravene the principle of the free movement of goods under Article 28 EC, matters which fall to be determined by the national court.

The first question

40 By its first question, the referring court asks, in essence, whether Article 2 of Regulation No 2081/92 must be interpreted as precluding a producers' association, such as that involved in the main proceedings, from being able to claim the right exclusively to use, throughout the European Union, a geographical designation used within a Member State to designate a specific type of salami sausage, without having first obtained a legally binding measure from that State establishing the requirements and boundaries inherent in the protection of such a designation.

41 In that regard, since it is established that the geographical designation in question had not obtained a Community registration at the time of the events in question, and having regard to the answer given to the second question, it must be held that the producers' association involved in the main proceedings cannot, in any event, claim, on the basis of Regulation No 2081/92, the exclusive right to use, throughout the European Union, such a geographical designation.

42 In those circumstances, there is no need to answer the first question.

Costs

43 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Ninth Chamber) hereby rules:

Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, as amended by Council Regulation (EC) No 535/97 of 17 March 1997, must be interpreted as meaning that it does not afford protection to a geographical designation which has not obtained a Community registration, but that that geographical designation may be protected, should the case arise, under national legislation concerning geographical designations relating to products for which there is no specific link between their characteristics and their geographical origin, provided, however, that, first, the implementation of that legislation does not undermine the objectives pursued by Regulation No 2081/92 as amended by Council Regulation (EC) No 535/97 and, secondly, it does not contravene the principle of the free movement of goods under Article 28 EC, matters which fall to be determined by the national court.

[Signatures]