

**The CJEU denies the extensibility of the protection afforded to the denomination “*Aceto Balsamico di Modena*” (Balsamic Vinegar of Modena, translator’s note) to the single non-geographical components of the PGI: reconstruction of the arguments and analysis of the critical aspects of the ruling.**

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This paper will examine the arguments that were endorsed by the European Union Court of Justice’s judgement of 4 December 2019, with which the Fifth Chamber of the Court, in its decision in case C-432/18, ruled on the extensibility to its single component parts of the protection afforded to the **Protected Geographical Indication “*Aceto Balsamico di Modena*”** as a whole.

This analysis – in which constant comparison is made with the arguments from which the Conclusions were drawn on 29 July 2019 by the Advocate General – brings to light flaws in the arguments underlying said Conclusions, which were not developed in the ruling, giving rise to some critical aspects of the Court's decision to limit the protection granted to the composite name of the PGI as a whole.

### ***1. Premise.***

In its **ruling dated 4 December 2019** (hereinafter the “Ruling”), the Fifth Chamber of the European Union Court of Justice issued a judgement on the request for a preliminary ruling raised by the Bundesgerichtshof (German Federal Court of Justice), concerning the extensibility of the protection granted under Article 13, paragraph 1, first clause, letter a) or b) of Regulation No. 1151/2012 to the single components of the compound denomination of the Protected Geographical Indication “*Aceto Balsamico di Modena*” (hereinafter the “PGI”), according to Commission Regulation (EC) No. 583/2009, 3 July 2009.

The judgement, pronounced by the Court of Luxembourg in case C-432/2018 (Consorzio Tutela Aceto Balsamico di Modena vs. BALEMA GmbH) in which it established the principle “*Article 1 of (EC) Commission Regulation No. 583/2009 dated 3 July 2009, registering a designation in the register of protected designations of origin and protected geographical indications [Aceto Balsamico di Modena (PGI)], must be interpreted as meaning that the protection of the designation “Aceto balsamico di Modena” does not extend to use of the non-geographical terms of the same*”, accepts the assumption of non-susceptibility to extend the protection granted to the sign to its individual components, namely the terms “*Aceto*” (Vinegar, translator’s note), “*Balsamico*” (Balsamic, translator’s note) and “*Aceto Balsamico*” (Balsamic Vinegar, translator’s note.).

The decision was based on arguments – borrowed only in part from the **Conclusions submitted on 29 July 2019** (/pdf/AVUE\_432\_18.pdf in Italian) by the Advocate General Gerard Hogan (hereinafter the “Conclusions” and the “Advocate General”) – the salient features of which merit a brief, non-exhaustive review, especially those paragraphs relating to the analysis of the preliminary question, in order to assess the consistency of their logic and their effectiveness against all possible counterarguments, which will be examined having regard to the broader considerations made in the Conclusions.

### ***2. The arguments on which the Ruling is based.***

The arguments in the Ruling regarding the analysis of the preliminary question acknowledged that, in the system of protection based on Regulation No. 2081/1992 [1], subsequently taken up by Regulation Nos.

510/2006 and 1151/2012, and in the light of previous rulings of the Court of Justice, issues relating to the protection to be accorded to the various elements of a registered name fall within the scope of an assessment that national Courts have to perform on the basis of a detailed analysis of the factual context brought to their attention by the interested parties.

At the same time, the Ruling underlined that “*in the case of a 'compound' name registered in accordance with Regulation No. 2081/92, the circumstance that for the latter there are no indications in the form of footnotes in the regulation registering the same, which specify that registration was not requested for one of the parts of this name, does not necessarily imply that every single part is protected*”, specifying that, in application of Art. 13 of Regulation No. 2081/1992, in the absence of specific circumstances to the contrary, the protection granted to the entire name is also referable to each of its components only if said components are not generic or common terms.

Thus, firstly, the Court highlighted how, in deeming whether the protection granted to the denomination of a PGI should also be granted to its single non-geographical components, it is determinant to focus on whether or not the individual non-geographical components of the PGI, i.e., “*Aceto*”, “*Balsamico*” (and “*Aceto Balsamico*”) can be considered generic or common terms.

In this respect, the Court held that in any event, in order to understand the margin of protection accorded to each individual component of the denomination, it was essential to examine the content of Regulation No. 583/2009, by which specific protection is granted to the denomination “*Aceto Balsamico di Modena*”, and made a first, eminently legislative, argument in support of the decision.

In particular, for the Luxembourg Court, the protection granted to the denomination in its entirety cannot not be extended to the single non-geographical terms of the same, in consideration of (i) the 8<sup>th</sup> Recital of Regulation 583/2009, according to which it is the denomination itself (in its entirety) that enjoys undisputed renown on the national and foreign markets, so as to denote the specific reputation of the marked product; (ii) the 10<sup>th</sup> Recital of the same Regulation, in which specific reference is made to the objections by the German and Greek States to the registration of the PGI, from which it should be deduced that the protection accorded to the entire denomination cannot be considered extended to the individual non-geographical component terms or their translations, even if used jointly, which terms, under the same Regulation, could continue to be used in the territory of the European Union in compliance with the Union’s applicable principles and rules; as well as (iii) the 11<sup>th</sup> Recital of the Regulation, which resulted in the registration in the Register of protected designations of origin and protected geographical indications of the entire denomination “*Aceto Balsamico di Modena*”.

The second argument used in the reasoning by the Fifth Section is, however, based in part on the jurisprudence of the same Court since, in connection with what has already been stated with regard to Art. 13 of Regulation No. 2081/1992, the Court assumes the “common” nature of the term “*aceto*” to be a given by relying on a previous ruling[2], while, as regards the term “*balsamico*” it maintains that the term is “*the translation, in Italian, of the adjective 'balsamique', which has no geographical connotation and which, as regards vinegar, is commonly used to designate a vinegar that is characterized by a sweet and sour taste. It is therefore, also in this case, a common term within the meaning of the aforementioned jurisprudence (...)*”.

This assumption, as will be seen later in this paper, is openly contradicted by the Considerations made by the Advocate General which – although unfavourably condemning the possibility of recognizing protection for the individual non-geographical components of the PGI – allow, on the other hand, that

the term “balsamic” constitutes a peculiarity in the European context with regard to food products, in association with which it has a specific ability to recall, even when considered on its own, the famous typical Modena condiment.

Returning to the arguments endorsed by the Court, the final one raised in support of the ruling refers to the part of the arguments in the Advocate General’s Conclusions wherein it was argued that the restrictive interpretation of the scope of protection accorded to the PGI “*Aceto Balsamico di Modena*” should furthermore be imposed in the light of the registrations of the PDOs “*Aceto balsamico tradizionale di Modena*” and “*Aceto balsamico tradizionale di Reggio Emilia*”, covered by the same Regulation No. 583/2009, in which the use of the terms “*aceto*” and “*balsamico*” and their combinations and translations were not deemed to prejudice the protection conferred on the PGI.

Having illustrated the salient and, in the Court's opinion, determining points for the purpose of the Ruling, it is worth examining the bases of the arguments put forward by the Advocate General in the Conclusions of the hearing which, to the extent that they are specifically referred to or not specifically explained in the Ruling, merit a brief examination.

### ***3. The arguments underlying the reasoning behind the Conclusions.***

#### ***a. The terminological-historical argument.***

The first argument embraced by the Conclusions was of a terminological-historical nature, the Advocate General having noted how the word “balsam” (*balsamico*), commonly used to indicate an “*oily aromatic substance that flows from various plants*”, is, thanks also to its use in literature, strongly perceived by contemporary Europeans as being a substance that is medicinal or used in the field of cosmetics.

Starting from this assumption, the Advocate General acknowledged how the word “balsam” is also widely associated with the extremely famous “*Aceto Balsamico di Modena*”, protected as a PGI, in relation to which he accepted that the use of the adjective “balsamic” would be aimed less at highlighting strictly medicinal or cosmetic properties than at generally indicating a product that originally had widely beneficial properties such as to determine its similarity to a real “balsam”.

By reason of this introductory argument, the Advocate General recognized, therefore, how the term “balsamic” is variously used and perceived in Europe in association with different types of products, be they medicinal, cosmetic or nutritional, given its “balsamic” connotation. In particular, while the term, in the first two instances, expresses the capability of the product to effectively improve the state of health or the skin following its application, in the food sector, it would tend only to evoke presumed healing abilities, which are in fact non-existent but were originally attributed to the product.

In other words – taking the Advocate General’s reasoning a step further – the term “balsamic” associated today with Modenese vinegar expresses a peculiar function of adulation that magnifies the product’s quality (so good that it is “balsamic”).

That said – and here we have the first criticism of the arguments made by the Advocate General – although the first reasoning examined above seems evidently aimed at valorising the diffusion of the use of the term “balsamic” in the European Union and its resulting association with different types of products, the fact that the Advocate General only cites the type of vinegar produced in Modena as an

example of an association of that term with a food product unequivocally underlines that this is, in fact, the only such association between “balsamic” and a food product.

In other words, the Conclusions, when looked at from a terminological-historical standpoint – although not specifically considered by the Ruling in the section under analysis – contain an implicit recognition of the use and association in the mind of the consumer of the term “balsamic” in the food sector, only with the typical vinegar of Modena.

***b. First legislative argument: Art. 41 of Regulation No. 1151/2012.***

Having thus described the genesis of the term “*Aceto Balsamico*” which, as argued by the Advocate General, is the combination of a common term describing a foodstuff or condiment, i.e. “vinegar”, and the adjective “balsamic”, the Conclusions drew on the eminently legislative provision in Article 41 of Regulation No. 1151/2012, pursuant to which, without prejudice to the provisions of Art. 13, the use of generic terms in the European Union should not be considered prohibited even if the generic term is part of a name protected under a quality scheme, since, in order to assess the generic nature of the term, both a) the situation in the area of consumption and b) the relevant national or European Union Law should be taken into consideration.

On this point, when evaluating the applicable legal acts, the Advocate General reflected on how: a) Regulation No. 583/2009 granted protection to the denomination “*Aceto Balsamico di Modena*” in its entirety, as specifically referred to in Annex I to said Regulation; b) the opinion of the Scientific Committee for Designations of Origin, Geographical Indications and Certificates of Specific Character, in Decision 93/53/EC on compliance with the conditions for registration, rendered on 6 March 2006, unanimously recognized the undeniable reputation of “*Aceto Balsamico di Modena*” on the national and international market, as demonstrated by its frequent use in numerous recipes in many Member States, and the many references to it on the internet, in the press and other media, and therefore that it meets the inherent condition for the product to have a specific reputation linked to that name; c) the same opinion found that characteristics, customer base, usage, method of distribution, presentation and price of “*Aceto balsamico tradizionale di Modena* (Traditional balsamic vinegar of Modena, translator’s note)” are different from those of “*Aceto Balsamico di Modena*” and sufficient to ensure that consumers do not confuse one with the other.

The Conclusions noted that, on the basis of these premises, it could be deduced that the single non-geographical terms of the compound denomination, used individually or jointly – namely “*Aceto*”, “*Balsamico*”, and “*Aceto Balsamico*” (present in both “*Aceto Balsamico di Modena*” and “*Aceto balsamico tradizionale di Modena*”) – and their translations, can be used in the EU in compliance with the principles and regulations set out in EU law.

This assumption was repeated unquestioningly in the Ruling.

On this point, it is important to note that the Advocate General deemed both the existing situation in the areas of consumption and the applicable acts, in which use of the terms “*Aceto*”, “*Balsamico*”, “*Aceto Balsamico*” is made both in relation to “*Aceto Balsamico di Modena*” and to “*Aceto balsamico tradizionale di Modena*”, are sufficient to consider the individual components as generic. No relevance was given to the fact that, in both cases, these same terms significantly refer to an Italian vinegar produced in the Modena area, with the consequence that the generic nature ascribed to the use of the terms “*Aceto*” and “*Balsamico*”

could, at most, refer to a specific type of vinegar, that is the Modena balsamic vinegar (be it traditional or not). To which balsamic vinegar specific, exclusive and non-coincidental reference is made in recipes on the Internet, in the press or in the media in various Member States, thus unequivocally confirming that the term “*Aceto balsamico*” is known to be associated, in the average European and international consumers’ minds, solely with Modena vinegar, and that such generic status is not extended to any other product.

***c. First jurisprudential argument: references to the Scotch Whisky judgement.***

The third argument the Conclusions were focused on is purely jurisprudential, since the Advocate General, after having recalled the German decision in favour of Balema, against which the *Consortio dell’Aceto Balsamico di Modena* (Consortium of Balsamic Vinegar of Modena, translator’s note) filed an appeal before the Court of Cassation, reiterated some principles previously established by the Court of Luxembourg, namely: a) the Scotch Whisky judgement [1], in as much as it refers to (i) the need, for the purposes of activating the protection, that the contested sign make “*use of the protected geographical indication itself, in the form in which that indication was registered or, at least, in a form with such close links to it, in visual and/or phonetic terms, that the sign at issue clearly cannot be dissociated from it*”, stating (ii), moreover, that the notion of ‘evocation’ must cover a “*situation in which the term used to designate a product incorporates part of a protected geographical indication, so that when the consumer is confronted with the name of the product in question, the image triggered in his mind is that of the product whose indication is protected*”.

Given the above, it is worth noting that in the Conclusions no further explanation was given as to why these principles should apply in the case at hand.

This omission is even more evident if we take into account the fact that Balema was using the term “balsamic” in relation to a vinegar, just like the typical product to which the Modenese Geographical Indication refers.

The lack of an in-depth analysis of the reasoning behind this point is especially relevant, since – taking into account how the Advocate General openly recognized, in the passage of the Conclusions relating to the terminological-historical reconstruction briefly highlighted in paragraph a. above, how the term “balsamic” is, in the food sector, notably linked only to the typical vinegar of Modena – the same premises, mentioned above, should logically and necessarily have led him to conclude that the use of the term “*Balsamico*” in association with a vinegar must necessarily lead us to believe that, in the presence of such use, “*the image triggered in [the consumer’s] mind is that of the product whose indication is protected*”.

Thus, the reasoning given in the Conclusions regarding the principles previously developed by the Court of Justice, not only is not at all in line with Luxembourg’s jurisprudential orientation – in particular with the principles established in the “Scotch Whisky” judgment – but is in itself lacking, because it does not develop the premises which, had they been examined more in depth, would have necessarily and logically recognised the evocative nature of the term “balsamico” even when taken on its own, when used in reference to the same vinegar food product as that covered by the Geographical Indication that includes the adjective in question.

***d. Second legislative argument: Article 13, paragraph 1, second paragraph of Regulation No.***

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<sup>1</sup> <https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62017CJ0044&from=GA>

*1151/2012.*

The fourth argument in the Conclusions is of a legislative nature, since the Advocate referred to the wording of Article 13, paragraph 1, second paragraph of Regulation No. 1151/2012 (<https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32012R1151&from=EN>), according to which, where a protected designation of origin or a protected geographical indication contains within it the name of a product which is considered to be generic, the use of that generic name shall not be considered to be contrary to Article 13, paragraph 1, letters a) and b), of the Regulation (cf. cases of usurpation, imitation or evocation).

In this regard, express reference was made to a series of arguments, the outcome of which, in the opinion of the Advocate General, should have led to the conclusion that the word “*balsamico*”, when related to the product “*aceto*”, should be considered generic.

On this point, the following were referred to by way of example: a) the case of Parma ham, the registration of which as a PDO does not prohibit use of the term 'ham' for producers and suppliers who are not consortium members; b) the order issued by the Court of Justice on 6 October 2015, in case C-517/2014 P Schutzgemeinschaft Milch und Milcherzeugnisse e.V. vs. European Commission, which clarified how, despite the registration of the PGI “Edam Holland”, the Edam name, being generic, can continue to be used in the territory of the Union.

However, the arguments on this point are not convincing, for several reasons.

First of all, it was the Advocate General himself who deemed the perception of the term “*balsamico*” as relating exclusively to the typical Modena vinegar in the food sector to be consolidated, with the consequence that the use of this term for the product in the food sector cannot be considered generic, but is in fact unique.

Secondly, the reference to the Parma ham case was absolutely forced and not relevant to the case in hand.

In fact, although the term “*aceto*” (vinegar) is as common as the term “*prosciutto*” (ham), the word “*balsamico*”, especially with regard to vinegar, does not find a parallel reference in the Parma ham case that is referred to as being analogous, since there is no common adjective which, through association over time with the typical product being protected, has become expressly associated with and evocative of the quality of that typical product. It is quite clear, in fact, that, even if the remaining part of the Geographical Indication were omitted, the term “*balsamico*”, a common adjective, would in itself be capable of evoking the typical Modena vinegar in the mind of the consumer, whereas evidently the term “*prosciutto*” needs to be associated with the wording “*di Parma*” to evoke the typical ham in the consumer's mind, being incapable, even if we take into consideration Italian consumers only, of evoking the typical product in the same way.

Were this not enough to shed doubt on the Advocate General's arguments, the reference to the Edam Holland case is equally incorrect, since it is well known that the term “Edam” is linked to a cheese which takes its name from the locality of Edam, and is therefore not analogous to an adjective deriving from a common name – such as “balsamic” that derives from the common noun “balsam” – which has acquired an evocative capacity through use over time.

***e. Third legislative argument: the scope of the generic nature that can be deduced from Art. 3, par. 6 of Regulation No. 1151/2012.***

Taking a closer look at the Advocate General's arguments, he also argued that the concept of "generic terms" referred to in Article 3, paragraph 6, of Regulation No. 1151/2012 (<https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32012R1151&from=EN>), should be given a very specific and limited meaning, since it refers to "*the names of products which, although relating to the place, region or country where the product was originally produced or marketed, have become the common name of a product in the Union. The definition thus refers to terms which over time have lost their geographical connotation. In its judgment of 2 July 2009, Bavaria and Bavaria Italia (C-343/07, EU:C:2009:415, paragraph 107), the Court stated that as regards a PGI, a name becomes generic only if the direct link between, on the one hand, the geographical origin of the product and, on the other hand, a specific quality of that product, its reputation or another characteristic of the product, attributable to that origin, has disappeared, and that the name does no more than describe a style or type of product.*"

We cannot fail to notice how, on the one hand, in the case that gave rise to the preliminary question, a term "*which, although relating to the place, region or country where the product was originally produced or marketed, [has] become the common name of a product in the Union*", thus giving rise to a loss of its geographical connotation – such as for example, in the Edam case mentioned above – is not considered to be the name of a product, at least with regard to the component "balsamic", which semantically has no connection to the place, region or country where the product was originally produced or marketed and which subsequently became the common name of a product within the Union, with consequent loss of its geographical connotation.

On the contrary, in the case in hand it should be noted that the common component "*balsamico*" has gradually acquired an increasingly greater geographical connotation, such as to acquire the capacity of evoking the specific reputation of the typical Modenese product when referring to a food product, in particular vinegar, just like the product covered by the PGI.

The foregoing allows us to understand how there are arguments that would make it possible not to define "*balsamico*" as having a generic nature under the terms of Art. 3, par. 6 of Regulation No. 1151/2012.

***f. Second jurisprudential argument: the extent of the generic nature that can be deduced from the previous arrests of the Court of Justice.***

The contents of paragraph e. above also overcome the subsequent observation made by the Advocate General in relation to paragraph 80 of the decision of 16 March 1999, Denmark and others. vs. European Commission, concerning cases C-289/1996, C-293/1996 and C-299/1996 [4], in which it was held that the provision referring to the notion of a "name that has become generic" is also applicable to names that have always been generic.

This reference does not appear entirely appropriate since, as previously explained, the term "*balsamico*", although common, cannot simply be considered generic precisely because of its progressive acquisition of a geographical connotation in the food sector.

Unfortunately, this point was completely neglected in the Conclusions, which simply reiterated the fact that the German, Greek and Spanish governments, like the European Commission, deemed the expressions "*Aceto*", "*Balsamico*", and "*Aceto Balsamico*" to be generic and/or common terms, given the

etymology of the term “*Balsamico*”, that derives from the Latin word “balsamum” or from the Greek word “βάλσαμον”; and is used in Italian, Spanish and Portuguese to identify a preparation with soothing properties used for therapeutic purposes.

On this point, the Advocate General seemed to base his decision on that of the aforementioned States, forgetting that in the opening words of his own Conclusions, he highlighted the specificity deriving from the use of the term “*balsamico*” in the food sector for the typical Modenese product, certainly not to imply soothing or therapeutic properties – although these qualities were originally connected to the term – but to indicate a quality and aromatic flavour such as to make the consumer feel better, just like a balsam would.

As we have seen, the arguments in question have been, albeit briefly, unquestioningly confirmed by the Judgement.

***g. Fourth legislative argument: the scope of the generic nature that can be deduced from Art. 3, par. 6 of Regulation No. 1151/2012.***

However, as stated by the Advocate General, the decisive factor in evaluating the generic nature pursuant to Art. 3, par. 6, Regulation No. 1151/2012 (<https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32012R1151&from=EN>), was the presence (or not) of a current geographic connotation in each specific case.

In this sense, the Conclusions highlighted how the Court declared – in the judgment of 25 October 2005, Germany and Denmark vs. European Commission, in relation to cases C-465/2002 and C-466/2002 – the non-generic nature of the denomination “*feta*”, taking into account the circumstances: (i) of the production of the product in question both within and without the Member State that obtained registration of the denomination, and (ii) of the consumption and perception of the product by consumers both within and without the Member State that obtained registration of the denomination.

Now, with specific regard to the second of the above elements, the Advocate General noted that in the case of *feta*, the circumstance that, with the exception of the Italian consumer – in whose eyes the term in question is allegedly similar to “*fetta*” (Italian for “slice”, translator’s note) – for other European consumers the word has no other meaning, thus excluding a generic nature pursuant to Article 3, paragraph 1, of Regulation No. 2081/1992, in the light of its current geographic connotation.

On the basis of these premises, the Advocate General expressed his personal belief that – while admitting that the final word on the perception of the term by the average consumer who is reasonably well informed and reasonably observant and circumspect lies solely within the realm of a national Judge, through the carrying out of consumer surveys, apart from the evaluation of the term “*Aceto*” which is a common word in the Italian language – the word “*balsamico*” is closely associated, in the minds of many consumers, with the product manufactured by the Consortium.

Nonetheless, contradicting the abovementioned premises, the Advocate General added that the basic term “*balsamo*”: a) being too common and widespread, cannot be susceptible to being protected autonomously by a PGI; b) does not bear a current geographical connotation, resulting in its inclusion among the “generic terms” referred to in Article 3, paragraph 6, of Regulation No. 1151/2012.



Here again, therefore, the Advocate General omitted any appropriate reference to the current geographical connotation obtained, not by the basic term “*balsamo*”, but by the component of the Geographical Indication, “*balsamico*”, in respect of which reference is made to what has already been amply explained in the previous paragraphs.

***h. Fifth legislative argument: the content of the Recitals of Regulation No. 583/2009.***

Finally, the Advocate General specified that, in the absence of any evaluation or reconstruction, and even of an investigation by the national Judge, the Court of Justice could have reached a correct decision simply by interpreting the entire text of Regulation No. 583/2009.

In this sense, in the Advocate General’s opinion it would have been appropriate, first of all, to focus on the fact that in Recitals 2, 3, 5 and 7 of the aforementioned Regulation, reference is made to the objections raised by Germany, Greece and France, to the registration of the name “*Aceto Balsamico di Modena*”, in which it was argued that the term “*Aceto balsamico*” is of a generic nature, as it is commonly used, and that the two terms making up said term are generic.

In particular, in the first place, in the Advocate General’s view, the fact that said Recitals mention these objections means that they are accepted by the Court of Justice.

However, this argument appears to be unacceptable, for various reasons.

First of all, the Advocate General’s view was based on the assumption that the contents of the Recitals are representative of assumptions or principles adopted by the Regulation, whereas it is in fact true to say that the first part of the Regulation does cite all the elements that have been taken into account for the purposes of drawing up its provisions.

This conclusion, moreover, is also the only one that can be married with the legal effects of the Regulation in question, with which the Geographical Indication was registered and which, therefore, presupposes the overcoming of the arguments against the non-generic nature of the non-geographic components making up the expression “*Aceto balsamico*”.

Looking once again at the Conclusions, the Advocate General deemed that the fact that Recital 10 of Regulation No. 583/2009 affords specific protection to the compound denomination “*Aceto Balsamico di Modena*” should not be underestimated. He held the same view regarding the fact that – unlike in other similar cases – the Commission did not, in Article 1 or Annex I of the Regulation, establish whether the terms “*Aceto*”, “*Balsamico*”, or “*Aceto Balsamico*” are generic names or non-geographic terms, and can therefore, despite the registration of the PGI, continue to be used in the territory of the Union in accordance with Article 13, paragraph 1, second subparagraph, of Regulation No. 1151/2012, with the consequence that the single or joint use on the territory of the European Union of the non-geographic terms and their translations should be allowed.

It is worth noting that, in the wake of the foregoing, the Conclusions took care to acknowledge the existence of a jurisprudential conflict within the Court of Justice: on one occasion – in particular, in the judgment of 9 June 1998 in *Chiciak vs. Fol*, in cases C-129/1997 and C-130/1997 – acknowledged that, as regards the use of compound terms in a designation of origin, the absence of a footnote in the Annex to the Regulation for the registration of that denomination, aimed at specifying that registration is not

required for a part of that denomination, does not necessarily imply that every single part of it is protected, thereby theoretically admitting that the protection can also extend to the individual components of the denomination. However, it later significantly reversed its view, in the judgment of 26 February 2008, Commission vs. Germany, ruling on case C-132/2005 [5], in which it argued that a PDO can benefit from protection only in the exact form in which it was registered.

On this point, it is sufficient to note that the Advocate General regarded Regulation No. 583/2009 as limiting the scope of the protection conferred on the name “*Aceto Balsamico di Modena*” as a whole, rather than extending it to the individual non-geographic terms that make it up, based on the Court of Justice judgements dated 9 December 1981, Commission vs. Italy, in case C-193/1980, and 15 October 1985, Commission vs. Italy, in C-281/1983 [6], but that this argument is not conclusive, since, in those judgements, the Court recognised the common/generic nature (as if it were the same thing) of the term “*aceto*” but not of the term “*balsamico*”.

Similarly inconclusive was the reference to the circumstance that the denomination “*Aceto balsamico tradizionale di Modena* (PDO)” also enjoys registration pursuant to Regulation No. 813/2000 – being almost identical to the PGI “*Aceto Balsamico di Modena*”, except for the word “*tradizionale*” and the capital “B” of “*Balsamico*”, as well as to the denomination “*Aceto balsamico tradizionale di Reggio Emilia* (PDO)” – which, taken from the Conclusions as further support for the fact that only “*Aceto Balsamico di Modena*” as a whole, should be deemed to be protected and that the terms “*Aceto*”, “*balsamico*”, and “*Aceto balsamico*” are simply common words or non-geographic terms, since in both cases the registered signs refer to the balsamic vinegar of Modena.

#### **4. Concluding remarks.**

The outcome of this summary examination of the Conclusions by the Advocate General Gerard Hogan in Case C-432/2018 (Consorzio Tutela Aceto Balsamico di Modena vs. BALEMA GmbH), is that there are some significant uncertainties, both legislative and jurisprudential, in the logic of the arguments made in support of the thesis that the protection granted to the PGI *Aceto Balsamico di Modena* should be limited to the denomination as a whole and not extended to its individual components.

These uncertainties are neither addressed nor resolved in the decision of 4 December 2019.

[1] 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.

[2] Judgement of 9 December 1981, Commission v Italy, C-193/80.

[3] Judgement of 7 June 2018, Scotch Whisky Association, v M. Klotz, C-44/17.

[4] Judgements of 16 March 1999, Kingdom of Denmark, Federal Republic of Germany and French Republic v Commission of the European Communities, C-289/96, C-293/96 e C-299/96.

[5] Judgement of 26 February 2008, Grand Chamber, Commission v Germany, C-132/05.

[6] Judgement of 9 December 1981, Commission v Italy, C-193/80, and Judgement of 15 October 1985, Continental Irish Meat Ltd v Minister for Agriculture, C-125/84.