



“Aceto Balsamico tradizionale di Modena” and a recent decision of the CJEU. Protected geographical indications in danger?

Case C-432/18, Consorzio Tutela Aceto Balsamico di Modena

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A German producer of vinegar, “Balema GmbH”, had commercialized for about 25 years a spiced sweet-sour vinegar obtained from wines of the Baden region used as dressing, called “*Balsamico*” and “*Deutscher balsamico*”. The plaintiff, the Italian “Consorzio di Tutela dell’ Aceto Balsamico di Modena IGP”, a collective body whose mission is to promote and protect the original product from the Modena region, took the view that the use of the Italian adjective “*balsamico*” for a German product represented a violation of their protected

geographical indication (PGI) “*Aceto Balsamico di Modena*”, which is registered in the register of protected designations of origin and protected geographical indications and of Art. 13 (1) (b) of Regulation No. 1151/2012/EU. After a cease-and-desist letter that remained unheeded and an unsuccessful attempt to obtain an injunction in Germany, in both first and second instance, the Consorzio brought an appeal of law before the German Supreme Court (BGH).

The case before the BGH revolved on the interpretation of certain definitions



contained in Regulation No. 1151/2012/EU, on which the answer to the question of whether “*German vinegar and balsamico*” amounted to an infringement of the rights of the Consorzio hinged.

Point (b) of the first subparagraph of Art. 13 (1) of the Regulation provides that “*Registered names shall be protected against: ... any misuse, imitation or evocation, even if the true origin of the products or services 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, including when those products are used as an ingredient*”. It furthermore provides that “*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 points (a) or (b) of the first subparagraph*” (that is, not an infringement). In turn, the expression “*generic name*” according to Art. 3 No. 6 of the Regulation “*means 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 issue was, therefore, to determine whether the protection afforded to the geographical indication “*Aceto Balsamico di Modena IGP*” equally extended to the non-geographical components of that expression. To that end, the BGH stayed the proceedings before itself, and referred a preliminary question to the CJEU, in substance, to whether, also in the light of Art. 1 of Regulation No. 583/2009, the protection enjoyed by the whole expression “*Aceto Balsamico di Modena*” included as well the isolated use of its non-geographical elements (“*Aceto*”, “*Balsamico*”, “*Aceto Balsamico*”).

Commission Regulation No. 583/2009 concerns the entering in the register of protected designations of origin and protected geographical indications of “*Aceto Balsamico di Modena (PGI)*”. Art. 1 of this Regulation only says that this full

name “*shall be entered in the register*”. No restrictions regarding the scope of protection are addressed in the recitals. The CJEU was quite clear in holding that the protection afforded to the whole was not comprised of the separable protection of the single terms, amongst others, stating that: “*... Moreover, first, it is established that the term ‘aceto’ is a common term, as previously held by the Court (see, to that effect, judgment of 9 December 1981, Commission v Italy, 193/80, EU:C:1981:298, paragraphs 25 and 26). Second, the term ‘balsamico’ is the Italian translation of the adjective ‘balsamic’ which has no geographical connotation and which, in the case of vinegar, is commonly used to refer to a vinegar with a bitter-sweet flavour. It is therefore also a common term within the meaning of the case-law referred to in paragraph 26 of this judgment. [...] In the light of all the foregoing considerations, the answer to the question referred is that Article 1 of Regulation No 583/2009 must be interpreted as meaning that the protection of the name ‘Aceto Balsamico di Modena’ does not extend to the use of the individual non-geographical terms of that name ...*”

As a result, the use of the adjective “*Balsamico*” without any reference to the “*Modena*” geographical region does not infringe the rights conferred by the protected geographical indication of the Consorzio.

Will the ruling impact other PGIs?

Looking beyond this ruling, the question is if the rightholders of other PGIs, such as well-known “*Prosciutto di Parma*”, “*Allgäuer Bergkäse*”, “*Nürnberger Bratwurst*” etc. might be at risk of seeing their rights weakened or diluted by similar (as a rule inferior) products whose denomination is identical except for the geographical element in strict sense. The reply is far from clearcut. Whilst nobody could seriously think of monopolizing “*prosciutto*” – which means “*ham*” – the solution may be less evident if the generic component is itself strongly linked to the geographical component in the perception of the relevant public, as in the case of “*aceto balsamico*”.

As a general remark, the legislative objective of PGIs as spelled out in Art. 1 and Art. 13 of Regulation No. 1151/2012/EU, which is to defend regional specialties against usurpation and imitation, as well as consumers against misleading labelling, will need to be borne in mind, and the specific circumstances of each case will be relevant.

Significantly, protection was in some instances granted to single components of combined denominations, like “*Parmigiano*” as a part of “*Parmigiano Reggiano*” (CJEU, Case C-132/05, “*Parmigiano Reggiano*”), where, however, there were two geographical components. On the other hand, there is no certainty that the combination confers automatic protection to each component of the whole (“... *Even if it may prove to be the case that it follows from Article 13 of the 1992 regulation that, in the absence of specific circumstances pointing to the contrary, the protection afforded by that provision covers not only the compound designation as a whole, but also each of its constituent parts, provided they are not generic or common terms, that provision cannot constitute a sufficient basis for interpreting the 1996*

regulation as meaning that, in the absence of a footnote, each constituent part of the compound name is protected...” (CJEU, Case C-129/97, “*Chiciak*”, rec. 37).

There are indeed a number of European cases that decided for a restrictive scope of protection similar to the “*Balsamico*” ruling, such as for “*Gouda*” cheese (CJEU, Case C-519/14, “*Gouda Holland*”). The same solution was adopted for “*Ricotta Romana*”, where the term “*Ricotta*” was held to be generic and capable of unrestrained use as explicitly clarified in recital (5) of Commission Regulation No. 737/2005.


A tip for rightholders could be to make sure that they always use the whole protected indication comprised of geographical and non-geographical elements alike, in order to be in a position to counter claims whereby non-geographical parts constitute generic names. Another perspective could be to also register the full indication as a trademark, accompanied by specific graphic or color elements to further emphasize the uniqueness of the original product and improve the tools for its defence.




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