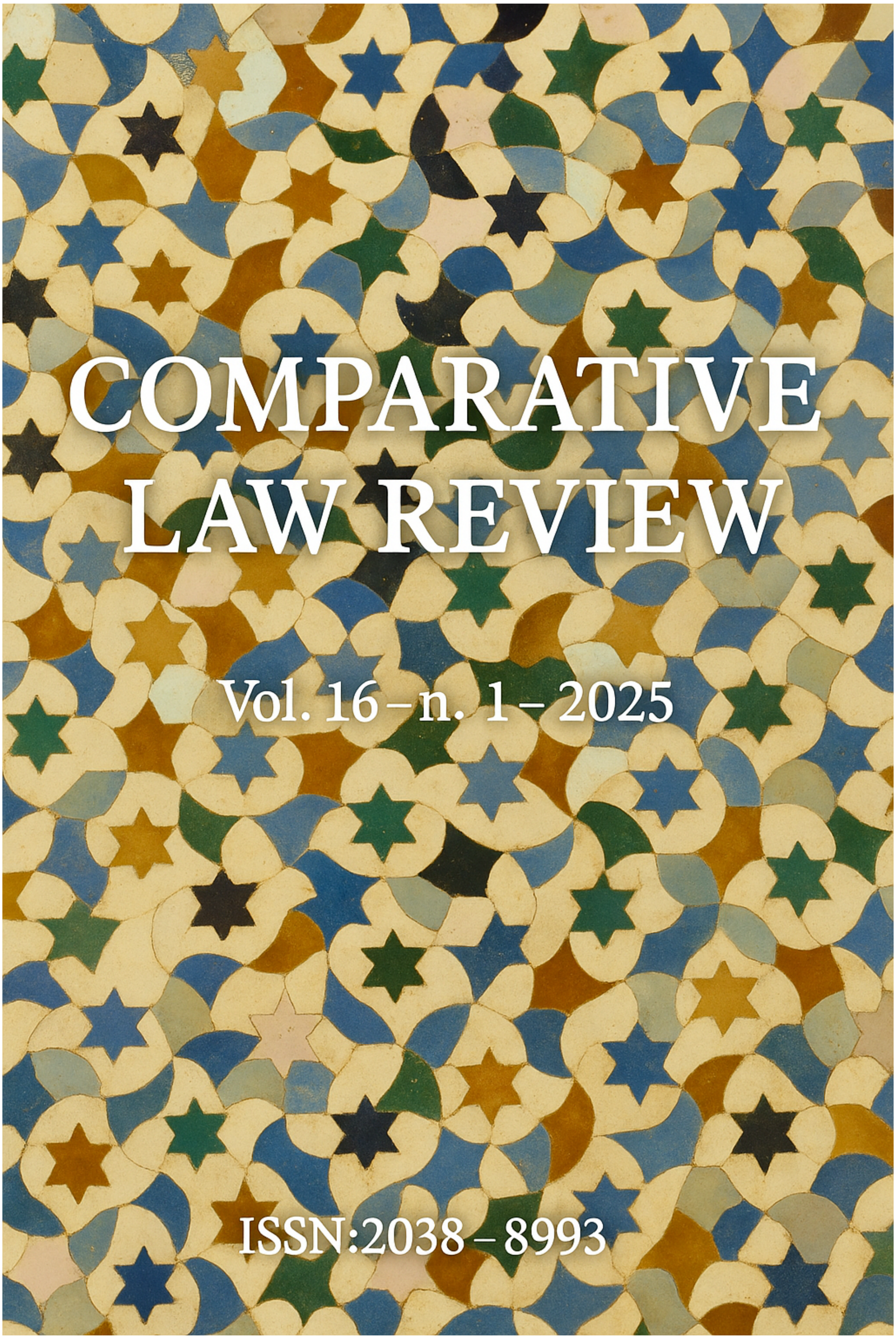

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A DELECTABLE DECEPTION: FIGHTING ITALIAN-SOUNDING IN GLOBAL MARKETS

*Luca Ettore Perriello**

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Italian sounding is not merely counterfeiting; it ranges from evocative marketing to blatant misuse of Italian symbols and names. Today, Italian sounding products flood foreign markets, overshadowing authentic Italian foods, and misleading consumers. Enforcement of EU geographical indications in non-European markets is problematic, due to differing legal standards. International treaties fall short on protecting geographical indications against Italian-sounding imitations, letting such terms become generic. Bilateral agreements may offer a more pragmatic approach, allowing for tailored solutions and better protection, though they demand compensation for non-European producers. In the absence of broad legal remedies, market-based strategies, such as consumer education and branding initiatives, are proving effective, highlighting the need for a combined approach of legal protection and market-driven initiatives to safeguard the integrity of Italian indications against Italian-sounding imitations.

Keywords: Italian sounding; Made in Italy; geographical indications; genericization; TRIPS Agreement

Originality is the one thing
which unoriginal minds cannot feel the use of
John Stuart Mill, On Liberty, 1859

I. BEYOND THE LABEL: THE COMPLEX REALITY OF ITALIAN SOUNDING AND ITS GLOBAL IMPACTS

Worldwide, the "Made in Italy" indication is perceived as synonymous with quality, embodying the positive values traditionally attributed to Italy and Italians, such as experience, specialization, innovation, flexibility, customization, and creativity. In the agri-food sector, "Made in Italy" evokes delicacy, naturalness, attention to detail, and a focus on health and food safety. However, this empirical reality, consisting of indisputable acknowledgments of the quality of "Made in Italy", is not supported by equally robust legislation. In fact, "Made in Italy" lacks a well-defined legal framework[1]. It is a fragmented concept across various legislative sources, hindering unified regulation.

Italian courts have clarified that "Made in Italy" is comparable to a simple geographical indication, informing consumers that the product comes from a specific place, but not that it owns certain qualities linked to its place of origin. These are instead the qualified

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[1] The recent Law no. 206 of December 27, 2023, containing «Comprehensive Provisions for the Enhancement, Promotion, and Protection of Made in Italy», does not appear to have established a unified system for referencing Made in Italy.

geographical indications, like PDOs and PGIs[2]. Under the EU Customs Code[3], a product can bear the "Made in Italy" origin mark when the last substantial transformation or processing occurs in Italy, even if all parts of the product are manufactured abroad and only assembled in Italy (Art. 60, Regulation EU no. 952/2013). A food product could use the "Made in Italy" label even if made with raw materials from abroad, provided that the last substantial transformation or processing occurs in Italy. Conversely, the "Made in Italy" indication can be placed on products assembled abroad with parts originating from Italy, as long as the semi-finished products sent abroad are not subject to substantial transformations that would attribute the origin to that country.

The "Made in Italy" and the PDO/PGI labels may both relate to Italian products and their authenticity, but they serve different purposes and have distinct meanings and implications. The "Made in Italy" is not as strictly regulated as PDO or PGI labels, and it doesn't guarantee that every ingredient or material originates from Italy, as long as significant production steps occur there. The regulation of "Made in Italy" does not go beyond general rules for determining the country of origin[4]. Essentially, a "Made in Italy" product must have gone through a significant portion of its manufacturing or transformation process in Italy to qualify. Accordingly, "Made in Italy" carries some assurance of Italian origin, but it does not guarantee strict adherence to traditional methods, ingredients, or regional origins as PDOs and PGIs do. On the contrary, PDOs and PGIs are EU labels used to protect and authenticate traditional foods and agricultural products from specific regions. These certifications guarantee that a product has qualities or characteristics resulting from its geographical origin and traditional production methods. Examples include Parmigiano Reggiano (PDO), Prosciutto di Parma (PDO), Aceto Balsamico di Modena (PGI), and Limoncello di Sorrento (PGI). PDO products, especially, are subject to strict EU regulations that govern every part of production, from the sourcing of raw materials to production and processing methods.

"Italian sounding" does not necessarily come down to counterfeiting but more frequently consists in the evocation of Italy[5] through words, images, colors, and expressions that clearly, if not emphatically, suggest an Italian origin for products that are actually produced abroad. This is particularly relevant in the agri-food sector, where Italy boasts a leading position in many unique high-quality and diverse productions. Geographically, although Italian sounding mainly concerns non-European markets, it may take place even in Europe, including Italy.

Truth is stranger than fiction when it comes to Italian sounding techniques[6]. In the most common situations, attributes like "Italian" or "Italy" are used, or Italian-sounding words are made up to influence consumer attitudes (e.g., Prisecco, Palenta, Pasta Shuta). Well-

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[2] Cass. pen., 15 March 2007, no. 27250, in *Dir. giur. agr.*, 2007, 9, p. 547.

[3] Art. 60 of Regulation (EU) no. 952/2013 of the European Parliament and of the Council of 9 October 2013 laying down the Union Customs Code.

[4] See V. RUBINO, *I limiti alla tutela del "Made in" fra integrazione europea e ordinamenti nazionali*, Torino, 2017.

[5] In reality, evocation can also apply to products from places other than Italy: I. CARREÑO and P.R. VERGANO, *Geographical Indications, "Food Fraud" and the Fight Against "Italian Sounding" Products*, in *Eur. J. Risk Reg.*, 2016, 7(2), pp. 416 ff., 416.

[6] A. BRANDONISIO, *Il fenomeno dell'*Italian Sounding *e la tutela dell'agroalimentare italiano*, in *Cult. dir.*, 2019, 1, pp. 101 ff., 104.

known Italian names at the international level can be used to mark goods having entirely different characteristics (e.g., the fast-food chain Bellini Pasta, which evokes the famous cocktail). There have even been instances where the names of famous athletes or artists have been exploited to market pasta sauces or chocolate creams (e.g., Gattuso and Davinci sauce).

In some cases, the Italian flag or other symbols are depicted on the packaging, or names and images of famous Italian places and monuments are used (e.g., Pecorino Romano made in…Illinois; Pompeian olive oil made in…Maryland). Italian brands or names might be translated more or less accurately (e.g., Parmesan, Parmesao, or Regianito for Parmigiano Reggiano; Barollo for Barolo; Cantia for Chianti; Monticino for Brunello di Montalcino). At times, references are made that evoke a mafia or criminal image of Italy, which sadly appeals to foreigners (e.g., Al Capone cigars in Honduras; Mafiozzo coffee in Bulgaria; Chilli Mafia snacks in England; Il Padrino wine, Don Corleone limoncello, Cosa Nostra hot sauce in the United States; the Spanish restaurant chain La Mafia). These are the most blatant cases, but often Italian sounding takes subtler forms, such as when a typically Italian recipe, not registered and therefore not protected, is altered to suit local tastes while retaining the original name (e.g., Bolognese Sauce).

The origins of Italian sounding can be traced back to the intense waves of Italian migration that occurred between the 19th and 20th centuries[7]. Since raw materials could only be transported by sea and without advanced preservation methods, Italian immigrants began using ingredients available in their new territories. The finished products were sold under Italian commercial names or with slogans evoking an Italian image. Gradually, the connection between these products' names and their place of origin got blurred. Many processes were patented, and trademarks registered. Even today, a common argument is that Italian immigrants should have the right to exploit the know-how from their places of origin, fueling the debate among those opposing the introduction of strengthened protection for European geographical indications in non-EU legal systems[8].

Later, when Italian agri-food companies began entering foreign markets, they ran into an immense array of pseudo-Italian products. This is particularly evident in the U.S. market, where several agri-food companies, originally founded by Italian Americans, were incorporated by multinationals ready to meet the ever-growing demand for Italian foods[9].

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[7] *ibid.*

[8] M. TORSEN, *Apples and Oranges (and Wine): Why the International Conversation Regarding Geographical Indications Is at a Standstill*, in *J. Pat. & Tradem. Off. Soc.*, 2005, 87, pp. 31 ff., 51 ff.; L.A. LINDQUIST, *champagne or Champagne? An Examination of U.S. Failure to Comply with the Geographical Provisions of the TRIPS Agreement*, in *Georgia J. Int. & Comp. L.*, 1999, pp. 309 ff., 313. But see I. CALBOLI, *Time to Say Local Cheese and Smile at Geographical Indications of Origin? International Trade and Local Development in the United States*, in *Houston L. Rev.*, 2015, 53(2), pp. 373 ff., 418 fn. 219, highlighting the complexities of the migration issue. While it is true that migrants should be allowed to use the know-how acquired from their homeland, they should also support the precise use of geographical names associated with the replicas they produce.

[9] F. BONAIUTO, S. DE DOMINICIS, U. GANUCCI CANCELLIERI, W.D. CRANO, J. MA and M. BONAIUTO, *Italian Food? Sounds Good! Made in Italy and Italian Sounding Effects on Food Products' Assessment by Consumers*, in *Front. Psych.*, 3 March 2021, p. 4. See also I. CALBOLI, *Time to Say Local Cheese and Smile at Geographical Indications of Origin? International Trade and Local Development in the United States*, cit., p. 417, arguing that the migratory narrative surrounding the debate on the protection of geographical indications in the United States is illusory,

Political contingencies and international trade crises may also contribute to Italian sounding. For example, between 2013 and 2015, the embargo with Russia caused a collapse in exports. It became impossible to buy Italian food in Russia, leading to a domestic demand that was met by Italian sounding products, such as Russkiy Parmesan. Other nations also benefited from the embargo by exporting counterfeit Italian products to Russia[10].

Italian sounding can be deceptive or non-deceptive. It is misleading when a product is presented as Italian but is not made in Italy, not produced with Italian techniques, or not made from Italian raw materials. The most severe case is counterfeiting, which can seriously jeopardize consumer health[11]. Imitation and violation of origin protection laws may raise concerns too.

There are many other subtler forms of Italian sounding that are harder to sanction because they are not deceptive. It might be the case that the producer specifies on the label that the product is not made in Italy, that the name under which it is marketed, while sounding Italian, is different from the registered Italian product, or that it is simply inspired by an original Italian recipe but modified to suit foreign tastes. This is mere evocation, which, while complying with regulations requiring information about the product's origins and characteristics, can still distort competition and consumer rights through the improper exploitation of Italy's image. Such evocation can be part of a specific commercial strategy to "romanticize" the past and evoke a simpler, slower lifestyle in contrast to the fast pace of contemporary technological society, based on the idea that tradition guarantees the authenticity and naturalness of the product[12].

Italian sounding influences the cognitive dimension of consumer choices, as the geographic origin of a product—specifically its Italian identity—is widely perceived as a guarantee of high quality, environmental respect, sustainability, and preservation of local traditions. Made in Italy or Italian sounding products enjoy a significant competitive advantage over their foreign equivalents, particularly in non-EU markets[13]. The middle classes in many emerging countries are adopting European dietary styles and supermarkets are filling up with Italian products[14].

The Italian identity becomes a predominant element over any other characteristics of food, even its taste, especially when consumers lack sufficient information. There are various reasons for this informational deficit. A consumer might not have a sophisticated

especially today, as many of the migrant-run businesses producing replicas of Italian products have been acquired by large multinational corporations.

[10] S. MAGAGNOLI, *The Italian Way of Eating Round the World: Italian-Sounding, Counterfeit, and Original Products*, in *Senri Ethn. St.*, 2019, pp. 173 ff., 180.

[11] See S. MAGAGNOLI, *The Italian Way of Eating Round the World: Italian-Sounding, Counterfeit, and Original Products*, cit., p. 182, claiming that counterfeiting can take various forms. Not all counterfeit products come from underground labs. Sometimes, the same manufacturer who works for an official client creates counterfeit parallel lines using sophisticated machinery.

[12] L. BAIRATI, *Narratives of Quality in European Food Governance and Beyond*, in *FIU L. Rev.*, 2021, pp. 457 ff., 464.

[13] In the United States and Canada, 97% of pasta sauces, 94% of pickles, and 76% of canned tomatoes are imitations of Italian products. Only 1 in 6 products labeled as Italian is authentic: S. MAGAGNOLI, *The Italian Way of Eating Round the World: Italian-Sounding, Counterfeit, and Original Products*, cit., p. 179.

[14] See *Across China: From Panettone to Pasta, China's Love Affair with Italian Food*, available at https://english.news.cn/20240112/e72e9b7a22c54f7f8ff4fa5a2b023345/c.html.

culinary knowledge or might simply be shopping in a hurry. In such situations, the Italian identity compensates for the lack of information. Especially in the food sector, the impact of Italian origin is evident, as food items are experience goods, that is, they can be evaluated only after consumption, and credence goods, that is, some characteristics like health effects, use of additives and preservatives, and compliance with food safety regulations are not perceptible through consumption but through trust or identity.

Yet, a careful reading of the label does reveal the true origin of the product. Barring cases of counterfeiting, the label doesn't lie. It states that the Italian sounding product is made in Maryland or New South Wales. Nevertheless, consumers might still buy it, driven by social status reasons that can even outweigh the authenticity of the food's taste. Consumers in this category purchase products with Italian names, fully aware of their non-Italian origin, because their consumption signifies high social status. To satisfy this need, they are willing to accept alterations in the original flavor. The food's characteristics are intentionally modified to meet local preferences because, for these consumers, the status associated with its consumption may matter more than its authentic taste[15].

This way, Italian sounding harms consumer culture by trivializing the food's connection to its territory. If it is true that Italian sounding is not necessarily deceptive, that buyers may know the true origin of the product, and that Italianness is just an evocation, then the connection to the territory may become a mere manipulative marketing technique rather than an expression of quality[16]. Producers of Italian sounding foods exploit the growing demand for the Mediterranean diet, associated with high-quality nutrition, knowing that the influence of geographic origin on consumer choices is greater than that of the brand. After all, a brand effectively guides consumer choices when the product has achieved a certain level of notoriety. It is mainly the weaker and lesser-known brands that benefit from Italian sounding[17].

Italian sounding reflects a deliberate business strategy, as the perceived high quality of food products linked to their geographic origin increases consumers' willingness to pay. Consumers are willing to pay higher prices for products with strong identities, and this tendency is statistically evident, especially among families with children, small households, high-income earners, and women. Studies have shown that in the United States, some consumers are willing to pay approximately 7-8% more for a package of Italian sounding pasta compared to a corresponding product. For Chinese consumers, this percentage rises to an astonishing 93%. In fact, in China, the willingness to pay for a package of Italian sounding pasta is identical to that for an authentic package of pasta made in Italy[18].

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[15] See S. MAGAGNOLI, *Consuming the World: Eating and Drinking in Culture, History and Environment*, 2018, 11(1), pp. 154 ss., 170, contending that «food has become a status good, subject to trends in social fashion in a similar way to clothing, shoes or cars. Food has become something that confers prestige and distinction, which often overshadows its primary function of feeding and nourishing».

[16] L. BAIRATI, *Narratives of Quality in European Food Governance and Beyond*, cit., p. 476.

[17] S.A. AHMED and A. D'ASTOUS, *Country-of-Origin and Brand Effects: A Multidimensional and Multi-Attribute Study*, in *J. Int. Cons. Mark.*, 1996, 9(2), p. 93 ff.

[18] See F. BONAIUTO, S. DE DOMINICIS, U. GANUCCI CANCELLIERI, W.D. CRANO, J. MA and M. BONAIUTO, *Italian Food? Sounds Good! Made in Italy and Italian Sounding Effects on Food Products' Assessment by Consumers*, cit., p. 26. See also D.S. GANGJEE, *Proving Provenance? Geographical Indications Certification and Its Ambiguities*, in *World Develop.*, 2017, 98, pp. 12 ss., 15. But see M. HANDLER, *Rethinking GI Extension*, in D.S. GANGJEE (ed.), *Research Handbook on Intellectual Property and Geographical Indications*, Cheltenham UK – Northampton USA,

This phenomenon has significant repercussions for the Italian economy. The agri-food industry is the second most important sector of the Italian economy, with Italy being a leading exporter. Recent macroeconomic estimates suggest that the economic impact of Italian sounding on the global Made in Italy agri-food sector ranges between 50-90 billion euros annually, sometimes reaching up to 100 billion euros[19]. This figure is more than double the value of Italy's agri-food exports, with a 70% increase over the past 10 years.
Italian companies struggle to access foreign markets or achieve limited distribution because their products are priced higher than Italian sounding products, as they must recoup substantial research and development costs. In contrast, those evoking the Italianness are not interested in creating perfect replicas of the original but are satisfied with similar products that are more economically advantageous. They exploit the achievements of others without bearing the associated costs. Over time, Italian sounding drives away those who bear higher production costs in the name of quality, leading to a downward leveling of quality, reduced variety for consumers, and the gradual disappearance of authentic Made in Italy products.
Italian companies have the highest number of registered geographical indications in Europe. They, along with other Southern European businesses, push for radical protection of their products outside Europe, attempting to influence common trade policy[20]. However, they have not always received satisfactory responses, and protection remains weak due to a culture that is not always sensitive to the connection between food and territory, especially in Northern Europe and beyond the European context.

II. NAVIGATING EU AND ITALY'S REGULATIONS AND ENFORCEMENT

In the European Union, Regulation (EU) 2024/1143 governs qualified geographical indications, i.e. PDOs (Protected Designations of Origin) and PGIs (Protected Geographical Indications)[21]. For PDOs, the connection to the territory is more stringent, as the product's qualities must be due essentially or exclusively to a specific geographical environment and its intrinsic natural and human factors, with all production stages occurring in a defined geographical area. For PGIs, it is sufficient that a particular quality or reputation of the product can be attributed to a geographical origin and that at least one production stage takes place in the defined area. Natural factors of the product may not be linked to the territory where the *savoir-faire* preserved by the local community matters.

2016, p. 176, and further references therein, claiming there is a lack of sufficient empirical evidence to show that consumers are willing to pay higher prices for products marked with protected geographical indications.
[19] Cf. F. BONAIUTO, S. DE DOMINICIS, U. GANUCCI CANCELLIERI, W.D. CRANO, J. MA and M. BONAIUTO, *Italian Food? Sounds Good! Made in Italy and Italian Sounding Effects on Food Products' Assessment by Consumers*, cit., p. 1 ff.
[20] Five European countries hold 70% of the protected geographical indications, that is, France, Greece, Italy, Portugal, and Spain: D. CURZI and M. HUYSMANS, *The Impact of Protecting EU Geographical Indications in Trade Agreements*, in *Am. J. Agric. Econ.*, 2021, pp. 364 ff., 368.
[21] Regulation (EU) 2024/1143 of the European Parliament and of the Council of 11 April 2024 on geographical indications for wine, spirit drinks and agricultural products, as well as traditional specialities guaranteed and optional quality terms for agricultural products, amending Regulations (EU) No 1308/2013, (EU) 2019/787 and (EU) 2019/1753 and repealing Regulation (EU) No 1151/2012.

The EU Common Agricultural Policy (CAP) has provided a legal framework for the protection of PDOs and PGIs. The relationship between CAP and these quality schemes revolves around agricultural development and the economic support of rural regions across the EU, sustainability and the protection of intellectual property rights.

Firstly, CAP includes several financial measures to support rural development and sustainable agricultural practices, with a strong focus on preserving local traditions and biodiversity. PDOs and PGIs align with CAP's goal to enhance the socio-economic viability of rural areas, as these quality labels provide economic opportunities for farmers and food producers. They allow producers to differentiate their products in the market, often fetching premium prices that help stabilize local economies. Also, CAP provides subsidies and grants for farmers producing PDO and PGI products as part of its rural development measures. This financial support is meant to offset the higher production costs that are sometimes associated with adhering to the rigorous standards of these quality schemes. Farmers and producers may also receive CAP funding to promote PDO and PGI products, increasing consumer awareness and market demand for these unique regional goods.

Secondly, CAP emphasizes environmental sustainability, and PDOs and PGIs support this goal by encouraging producers to maintain traditional practices often considered more environmentally friendly or sustainable. The quality standards under PDO and PGI schemes frequently require adherence to strict guidelines that preserve natural resources, reduce chemical use, and protect biodiversity. This complements CAP's greening initiatives, which reward sustainable farming.

Lastly, CAP funds the registration process of PDO and PGI products, which helps protect the intellectual property rights of producers and the cultural identity associated with these regional products. PDO and PGI labels provide legal protection to certain regional products, preventing imitation or misuse of a product's name that does not meet the origin or production standards. CAP supports this legal framework as a way to preserve Europe's cultural and culinary heritage.

As a matter of fact, the Regulation prohibits «any misuse, imitation or evocation, even if the true origin of the products or services is indicated or if the protected name is translated, transcribed or transliterated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation', 'flavour', 'like' or similar, including when those products are used as an ingredient» (Article 26, paragraph 1, letter b, Reg. 2024/1143). These measures, while applicable within EU member states, are effective against Italian sounding as they also cover non-deceptive evocation.

Significantly, Regulation 2024/1143 extends the protection of geographical indications to goods sold by means of distance selling (Article 26, paragraph 4, letter b), such as electronic commerce; and to goods intended for export to third countries (Article 26, paragraph 4, letter c). On one hand, Article 26(4)(b) implies that products sold via distance selling platforms (such as e-commerce websites) should be protected under EU GI regulations, similar to products sold through traditional retail channels. This means that EU laws governing PDOs and PGIs apply equally to online sales, ensuring that only authentic products can bear these labels, regardless of the sales platform. On the other, upholding earlier case law[22], Article 26(4)(c) suggests that the EU aims to extend GI protections for its products even outside the EU, meaning that when EU-certified goods (PDOs, PGIs) are exported, they are still protected from imitation or misuse in third countries. The goal is to ensure that products exported to other markets maintain their value and authenticity, thereby preventing deceptive practices that could harm the reputation of EU products in the global markets.

Additionally, the Regulation clarifies the relationship between trademarks and geographical indications (Article 31, Reg. 2024/1143)[23]. No one may register a trademark that imitates or evokes an already registered geographical indication, as this would appropriate a name that should be accessible to all producers from a defined area. Unlike other intellectual property rights, geographical indications cannot be subject to exclusive ownership because they identify a product through its connection to a territory, not a producer. They also cannot be licensed like trademarks. Geographical indications are, instead, collective rights held and exercised by all producers in a given territory[24]. However, if a trademark was registered or acquired through use in good faith prior to the registration of the geographical indication, the holder of the pre-existing trademark cannot oppose the registration of the same as PDO or PGI if the trademark has come to be understood as a geographical indication, although the holder may continue to use their trademark[25]. This reflects the priority given to geographical indications over trademarks.

Italian sounding may also target products not registered in the European Union as PDO or PGI. The Italian Industrial Property Code contains specific provisions for conducts using a geographical name to deceive the public, evoke or suggest that the product is identical or similar to an original, or involve unfair exploitation of its reputation (Articles 29 and 30, Legislative Decree No. 30 of February 10, 2005). Accordingly, conducts that are not explicitly deceptive are also affected. Penalties include injunctions, orders to withdraw products from the market, fines for subsequent violations or delays in compliance, destruction of goods, damages, and restitution of profits (Articles 124 ff.).

However, case law has progressively narrowed the scope of application of these provisions[26]. In compliance with the priority of EU law over domestic law, unregistered geographical indications at EU level are not protected under the Industrial Property

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[22] See Eur. Court J., 14 July 2022, C-159/20, *Commission* v *Denmark (AOP Feta)*, ECLI:EU:C:2022:561, where the Court ruled that Denmark had infringed EU law by permitting Danish producers to label cheese as "Feta" for export to third countries. "Feta" is registered as a PDO, meaning only cheese produced in Greece according to specific traditional methods can be marketed as "Feta" within the EU. The court established that PDO protection under EU law extends to exports to third countries, not just within the EU's internal market. Therefore, Denmark's authorization of "Feta" labeling for export undermined the exclusive rights granted to Greek producers of PDO "Feta".

[23] For a detailed analysis of this relationship, see B. GOEBEL and M. GROESCHL, *Learning to Love my PET – The Long Road to Resolving Conflicts Between Trade Marks and Geographical Indications*, in D.S. GANGJEE (ed.), *Research Handbook on Intellectual Property and Geographical Indications*, cit., p. 361 ff.

[24] F. ADDOR and A. GRAZIOLI, *Geographical Indications Beyond Wines and Spirits. A Roadmap for a Better Protection for Geographical Indications in the WTO TRIPS Agreement*, in *J. World Intell. Prop.*, 2002, 5(6), pp. 865 ff., 869.

[25] See C. GALLI, *Food and Intellectual Property Rights: A Comprehensive Approach*, in L. SCAFFARDI and V. ZENO-ZENCOVICH (eds), *Cibo e diritto. Una prospettiva comparata*, II, Roma, 2020, p. 477, arguing that, in these cases, it would be advisable to prohibit the use of the trademark when it is misleading to the public or leads to parasitic exploitation of the reputation of the geographical name.

[26] E. GAMBARO and P. MISSANELLI, *La tutela dei prodotti agroalimentari tra disciplina italiana e europea: pratiche commerciali sleali e concorrenza estera*, in *Dir. agroalim.*, 2019, 2, p. 167 ff.

Code[27]. The Italian Supreme Court has aligned with the Court of Justice, which had previously ruled that unregistered geographical indications could not access protection under the EU Regulation but might be protected under national laws concerning products without a specific connection between their qualities and their geographical origin[28]. This way, the dual protection for unregistered geographical indications has been ruled out.

The Italian Competition Authority (AGCM) has sometimes applied laws on misleading advertising (Legislative Decree No. 145 of August 2, 2007) concerning the geographical origin of advertised products. For example, the AGCM considered the label of a liqueur depicting images and expressions evocative of Sardinian tradition to be misleading, as the selection of the grapes and the distillation were done by a company in San Marino. Although the place of production and bottling was mentioned in smaller print at the bottom of the label, the advertising led consumers to believe that the product was a typical Sardinian liqueur[29]. In another case, the AGCM addressed a company distributing milk labeled «Latte Reggiano» that did not come from farms in the Reggio Emilia province, lacking indications specifying the actual geographical origin. The Authority found the advertising message to be misleading[30].

On other occasions, the Authority has sanctioned various forms of Italian sounding as unfair commercial practices, under Articles 18 ff. of the Consumer Code. Unlike civil code rules protecting competition (Articles 2598 ff. of the Civil Code)[31], which require a competitive relationship between businesses, consumer protection laws on unfair commercial practices can also be enforced by consumers. Moreover, unfair commercial practices can be sanctioned even if they are not deceptive, just like Italian sounding cases. Recently, for example, the AGCM challenged Lidl for selling pasta under the «Italiamo» brand, with packaging that misleadingly represented the product's characteristics, emphasizing Italian origin without adequate information about the foreign origin of the durum wheat used[32]. According to the Authority, this behavior created the misconception

[27] Cass., 12 February 2015, no. 2828, in *Riv. dir. ind.*, 2015, 4-5, II, p. 251. The case concerned «Salame Felino», a product typical of the Parma tradition, which was being produced by Kraft S.p.A. in its facilities in the Cremona area. The appeal by the Salame Felino Protection Association was rejected on the grounds that while the designation «Salame Felino» is qualified as it links the qualities of the food to its geographical origin, it is not registered as a PDO or PGI.

[28] Eur. Court J., 8 May 2014, C-35/13, *Assica – Associazione Industriali delle Carni e dei Salumi and Kraft Foods Italia SpA* v *Associazioni fra produttori per la tutela del 'Salame Felino' and Others*, ECLI:EU:C:2014:306.

[29] AGCM, 26 April 2007, order no. 16785.

[30] AGCM, 20 July 2000, order no. 8539.

[31] There is a tendency in the lower courts to apply Article 2598 of the Italian Civil Code to geographical indications that are not registered at EU level. For instance, in the case decided by the Court of Alba on July 9, 2005, in *Dir. ind.*, 2006, pp. 60 ff., F.lli Carli S.p.A. was sanctioned under Article 2598 of the Civil Code for unfair competition. The company had been accused by a competitor of misleading the public about the origin of the olives used in their oil production, claiming they were from the Oneglia region in Liguria, when in fact most were sourced from Spain, Greece, and other Italian regions. This judicial approach, however, may run into the same criticism raised by the Court of Justice and accepted by the Italian Supreme Court in the Salame Felino case.

[32] AGCM, 20 December 2019, order no. 28059. In other cases, the Authority closed proceedings without imposing sanctions, due to the commitment of the producing companies to modify their labels. For instance, order no. 26765 of 20 September 2017 involved a tomato processing company that marketed its products with the label «Product of Italy» accompanied by the Italian flag, despite the raw materials being imported from Turkey and Morocco. See also: AGCM, 20 September 2017, order no. 26766, where the unfair commercial practice in question was the labeling of jarred vegetables with «Produced and Packaged in Italy»

among consumers that the entire production chain, starting from the raw material, was Italian, whereas only the transformation process and the expertise were Italian. The Authority deemed compliance with the labeling rules in Regulation (EU) No. 1169/2011 insufficient, as «the company's choice to emphasize the Italian origin of the product requires a more prominent and concurrent indication of the durum wheat's origin on the label. This is to prevent the consumer from being immediately and more strongly influenced by claims of Italian origin and thereby led to believe that the pasta is made with exclusively Italian durum wheat». After identifying an unfair commercial practice under Articles 21 and 22 of the Consumer Code, the AGCM not only prohibited its dissemination but also imposed a financial penalty of one million euros on Lidl.

However, the role of the AGCM should not be overstated, as the Authority has limited resources and broader responsibilities beyond merely enforcing Consumer Code regulations. Also, the Authority's focus on Italian sounding practices might decline if policy decisions shift towards other sectors[33].

III. HOW GLOBAL MARKETS AND LEGAL LOOPHOLES THREATEN MADE IN ITALY PRODUCTS

In Europe, once a geographical indication is registered, it cannot become generic, meaning it cannot become a common term used by anyone, including those who do not respect the necessary territorial link associated with the indication. The genericization or vulgarization of geographical indications, which involves their gradual loss of the distinctive origin character to become common terms in everyday language, is explicitly prohibited[34]. No producer in Europe can use an Italian PDO or PGI name for a product if it is not connected to that specific protected region, even if that name has become commonly used over time. Once registered, a geographical indication is protected against any genericization in EU member states, without it being necessary for right holders to take additional action.

When looking beyond the European Union, the situation changes dramatically. Due to the principle of territoriality, the protection of EU geographical indications is governed not by the laws of the country of origin but the laws of the country where protection is sought. This means that the criteria for determining whether a geographical indication registered in Europe has become generic or common, and thus unprotected in a non-European market, are set by the laws of the countries where the indication is claimed to have become generic[35]. These countries, unlike the European Union, are often skeptical of any attempt to restrict the evolution of common language through legislative bans.

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along with the Italian flag, while the raw materials were imported from Egypt; AGCM, 20 September 2017, order no. 26767, involving an Italian company that sold lentils imported from Canada with graphic symbols, colors, and the name «Colfiorito», which the Authority believed suggested Italian origin, while present indication of the actual Canadian origin was deemed insufficient.

[33] E. GAMBARO and P. MISSANELLI, *La tutela dei prodotti agroalimentari tra disciplina italiana e europea: pratiche commerciali sleali e concorrenza estera*, cit., p. 190.

[34] Article 26, paragraph 6, Reg. 2024/1143. Arguing that a legal prohibition would be an effective antidote against the "virus" of genericization, see J. AUDIER, *Indications Géographiques: Le Virus "Générique"*, in *Rev. Propr. Intell.*, 2003, 8, p. 252 ff.

[35] J. AUDIER, *Generic and Semi-Generic Denominations: Determination Criteria and Methods to Reduce Their Effects*, in *AIDV Bulletin*, 2000, 22, pp. 29 ff., 30; D.S. GANGJEE, *Genericide: The Death of a Geographical Indication?*, in ID.

The genericization of European geographical indications is a significant issue for Italian businesses operating in non-European markets and affects many Italian-made or Italian-sounding products (such as Parmesan or Fontina[36]). The paradox is that the more successful an Italian food product is in foreign markets, the greater the risk that its geographical indication will be treated as a generic name and thus lose its protection. Many indications from Europe are now considered generic elsewhere, leading to a proliferation of Italian-sounding names[37].

Genericization processes have a recurring origin[38]. Migrants bring with them production techniques and associated terminology. Local producers start using foreign names for their products because of their positive reputation[39]. Meanwhile, consumers begin to use the term in good faith to describe any products with certain characteristics, gradually losing the connection to the original place of origin until it is completely lost.

Defense of genericization is common in new world nations, which strongly oppose the enhanced protection of European geographical indications. The reason is that widespread recognition of such indications would harm non-European producers eager to enter the global market. This is the case for American or Australian companies selling dairy products with generic European names in Asian markets, where demand for these products, traditionally low, is now steadily increasing[40]. For these companies, leveraging Italian-sounding names is crucial to selling their products in emerging markets. Universal protection of geographical indications would force these producers to change their brands, resulting in significant economic damage. Additionally, recognizing the geographical indication would create confusion among consumers in domestic markets who are already accustomed to using the Italian-sounding name, as businesses would be forced to change names that consumers no longer recognize[41].

(ed.), *Research Handbook on Intellectual Property and Geographical Indications*, cit., p. 542. This way, see also Eur. Court J., *Exportur SA* v. *LOR SA and Confiserie du Tech SA*, C-3/91, [1992] ECR I-5529, §12.

36 «Fontina» has been considered generic in the US: *In Re Cooperativa Produttori Latte e Fontina Valle D'Aosta*, 230 U.S.P.Q. (BNA) 131, 134 (T.T.A.B. 1986).

37 D. RANGNEKAR and S. KUMAR, *Another Look at Basmati: Genericity and the Problems of a Transborder Geographical Indication*, in *J. World Intell. Prop.*, 2010, 13(2), p. 202 ff. For an overview of the European geographical indications considered generic in the United States see J. HUGHES, *Champagne, Feta, and Bourbon – the Spirited Debate About Geographical Indications*, in *Hastings L. J.*, 2006, 58, p. 299 ff.

38 Eur. Court J., 25 October 2005, C-465/02 and C-466/02, *Federal Republic of Germany and Kingdom of Denmark* v *Commission of the European Communities*, [2005] ECR I-9115; [2006] ETMR 16(AG) §§134-135.

39 According to M. HANDLER, *Rethinking GI Extension*, cit., p. 154, the history of champagne in Australia highlights that at the heart of genericization is the desire of producers in the new world to emulate products from the old world.

40 I. CALBOLI, *Geographical Indications of Origin at the Crossroads of Local Development, Consumer Protection and Marketing Strategies*, in *Int. Rev. Intell. Prop. & Comp. L.*, 2015, 46(7), pp. 760 ff., 777.

41 L.A. LINDQUIST, *champagne or Champagne? An Examination of U.S. Failure to Comply with the Geographical Provisions of the TRIPS Agreement*, cit., p. 309 ff.; S.A. BOWERS, *Location, Location, Location: The Case Against Extending Geographical Indication Protection Under the TRIPS Agreement*, in *AIPLA Quart. J.*, 2003, 31(2), pp. 129 ff., 154 ff.; F. ADDOR and A. GRAZIOLI, *Geographical Indications Beyond Wines and Spirits. A Roadmap for a Better Protection for Geographical Indications in the WTO TRIPS Agreement*, cit., p. 890. But see I. CALBOLI, *Time to Say Local Cheese and Smile at Geographical Indications of Origin? International Trade and Local Development in the United States*, cit., p. 398, arguing that the idea that renaming products would create confusion among consumers is unfounded. In fact, consumers might benefit from the new designation, as it would provide them with more accurate information.

It is also argued that any limitation on the genericization of a geographical indication would restrict freedom of commercial expression, hindering the sale of more competitive alternatives[42], or that a generic name provides free advertising for the original product[43]. In some markets, like Australia, the positive reputation behind commercial names like champagne or feta might not be due to the efforts of European producers but to locals who have made these foods or beverages famous even when produced locally. Accordingly, it would be unreasonable to strip local producers of such a competitive advantage, gained through hard work and investment, and unfairly transfer it to European producers[44].

In reality, these defenses are not entirely convincing. Genericization raises many issues. In the United States, it is enough for the majority of consumers to consider the term generic for it to be freely used[45]. For example, if over 50% of American consumers believe that Parmesan no longer refers exclusively to cheese from Parma, then that indication can be used freely. This is certainly a weaker standard compared to the much stricter one followed in Europe, where a geographical indication can only be deemed generic for a type of product if a significant portion of the relevant public within the territory is no longer convinced that the name remains a geographical indication[46].

Another issue is the category of consumer considered when determining genericness, specifically whether an average consumer is sufficient or if a more sophisticated consumer is required, and what tools should be used to argue that a geographical indication has become generic. There are concerns about the accuracy and impartiality of consumer surveys, as they might be biased in favor of the producers commissioning them[47].

However, it must be acknowledged that genericization for many names is accelerated by the inertia of many Italian producers in taking the necessary steps offered by foreign legal systems to protect geographical indications. This includes registering certification trademarks, i.e. marks certifying that a product meets specific quality standards set by a certifying body[48]. Arguably, where no formal agreements exist between the EU and third countries, Article 26(4)(c) Reg. 1143/2024 encourages alternative protections through local intellectual property systems, such as certification trademarks. These can be registered even before the producer achieves a certain level of recognition. For instance,

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42 S. DAMER, *Not Confused? Don't Be Troubled: Meeting the First Amendment Attack on Protection of "Generic" Foreign Geographical Indications*, in *Cardozo L. Rev.*, 2009, 30, p. 2257 ff.; B. BEEBE, *Intellectual Property Law and the Sumptuary Code*, in *Harvard L. Rev.*, 2010, 123, pp. 809 ff., 873.

43 F.G. ZACHER, *Pass the Parmesan: Geographic Indications in the United States and the European Union – Can There Be Compromise?*, in *Emory Int. L. Rev.*, 2005, 19, pp. 427 ff., 434, contends that Kraft played a key role in popularizing Parmesan cheese in the United States.

44 M. HANDLER, *Rethinking GI Extension*, cit., p. 170.

45 J.T. MCCARTHY, *McCarthy on Trade Marks and Unfair Competition*, Eagan, 2014, §12:6.

46 Recital 23 of Commission Regulation (EC) no. 1829/2002 of 14 October 2002 amending the Annex to Regulation (EC) no. 1107/96 with regard to the name "Feta".

47 D.S. GANGJEE, *Genericide: The Death of a Geographical Indication?*, cit., p. 528, cites the Darjeeling case in the United States, where a survey commissioned by a producer seeking the cancellation of the trademark on the grounds that it was generic was contested. The objections were based on the broad scope of the questions and the ambiguity in how the responses were analyzed.

48 For a comparative analysis of the protection of geographical indications see M. FERRARI, *La dimensione proprietaria delle indicazioni geografiche. Uno studio di diritto comparato*, Trento, 2015, p. 41 ff.; A. BORRONI, *La protezione delle tipicità agroalimentari*, Napoli, 2012, p. 267 ff.

it is well known that Australia introduced a certification trademark regime as early as the 1950s. However, it wasn't until the mid-1990s that the Parmigiano Reggiano Cheese Consortium took action to register its protected geographical indication as a certification trademark[49].

IV. How International Treaties Fall Short on Protecting Italian Geographical Indications

International treaties do not provide adequate protection for geographical indications used for their Italian-sounding effect, and the lack of an effective regulatory framework has facilitated their genericization. The Lisbon Agreement of 1958, to which the European Union acceded in October 2019, requires signatory countries to recognize the names of other member countries within their own territories. This prevents not only misleading use but also any imitation or usurpation, even if the true origin of the product is indicated or the name is used in a translated form or accompanied by delocalizers like "type", "style", "like", etc. The Lisbon Agreement could effectively counter Italian-sounding practices globally if more countries had joined it, but major players such as the United States, Canada, Australia, and China are not among the signatories[50].

Similarly, the TRIPS Agreement of 1995[51], which applies to the 164 countries that are members of the World Trade Organization (WTO), does not seem to effectively address Italian sounding. Member countries are only required to provide means to prevent the misuse of geographical indications, but TRIPS does not specify what these means should be. This leaves states free to choose between a certification trademark system and a geographical indications system, or between a "first in time, first in right" approach and a system where the geographical indication prevails over conflicting trademarks[52].

Most importantly, if the holder of a geographical indication wants to oppose its improper use, they must prove that such use is likely to mislead the public regarding the true origin of the product or amounts to unfair competition (Article 22). Accordingly, the most insidious aspect of Italian sounding—namely, mere evocation or parasitic attachment—is not protected, as long as the true origin of the product is indicated and there is no deception or confusion for the consumer. There are only limited opportunities to counter Italian sounding by proving deception, which is a challenging task both because the origin is likely indicated on the label (thereby excluding deception at the outset) and because, even if the origin is not indicated, the costs of litigation in a foreign country with uncertain

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49 M. Handler, *Rethinking GI Extension*, cit., p. 166. Another emblematic case involved Sherry wine, originally from the Jerez district in Spain. A British court declared Sherry generic in the UK due to the Spanish producers' acquiescence to the use of «British Sherry» for many decades: *Vine Products Ltd* v. *Mackenzie & Co. Ltd (No. 3)* [1967] FSR 402, 423 (Ch D).

50 D.J. Gervais, *Irreconcilable Differences? The Geneva Act of the Lisbon Agreement and the Common Law*, in *Houston L. Rev.*, 2015, 53, p. 339 ff.

51 The Agreement on Trade Related Aspects of Intellectual Property Rights.

52 L.A. Lindquist, *champagne or Champagne? An Examination of U.S. Failure to Comply with the Geographical Provisions of the TRIPS Agreement*, cit., p. 316.

outcomes might exceed the economic damages associated with the evocation of the Italian image[53].

Moreover, the idea that Italian sounding can only be prohibited if it is misleading presupposes that consumers have a binary and stable understanding of geographical indications—that is, that they can discern whether a particular indication is authentic or a mere metaphor[54]. This is not always the case. For most geographical indications, consumers do not have enough knowledge to determine whether they represent the true origin of the product[55]. There cannot be confusion or deception if the consumer is unaware of the link between a specific commercial name and the place of origin. How can an Illinois consumer be said to be deceived if they do not know that Pecorino Romano is a protected designation of origin recognized only for certain producers from Lazio, Tuscany, and Sardinia?

The fight against Italian sounding is further hindered by the acceptance of genericized indications. Member states are not required to respect the geographical indication of goods or services that is identical to the common term used for that good or service (Article 24, paragraph 6). This is the case for names like Asiago or Fontina.

Only wines and alcoholic beverages receive enhanced protection, as this is independent of the risk of confusion or unfair competition (Article 23). Member states are required to prevent any use of geographical indications for wines or alcoholic beverages that do not come from the indicated location, even if the true origin is stated or the geographical indication is translated or accompanied by delocalizers like "kind", "type", "style", "imitation", or similar. This way, indications such as "sparkling wine style Prosecco made in Chile" are banned, while indications like "Parma ham made in Wisconsin" may be permitted.

Article 23 is not the result of convergence between new and old world countries but rather a compromise where the former granted an exception to the latter for their wines and spirits, which are frequently subject to imitation or evocation, in exchange for an EU commitment to reduce subsidies to its agri-food enterprises[56]. Nonetheless, the use of genericized indications remains possible. For example, it will continue to be acceptable to

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[53] X. WANG, *Absolute Protection for Geographical Indications: Protectionism or Justified Rights?*, in *Queen Mary J. Intell. Prop.*, 2018, 8(2), pp. 73 ff., 77. See also A.C. LANG, *On the Need to Expand Article 23 of the TRIPS Agreement*, in *Duke J. Comp. & Int. L.*, 2006, 16, pp. 487 ff., 494, arguing that the limited use of Article 22 by states is primarily due to the high costs associated with potential litigation, concluding that «the current system has thus created an unsavory incentive for manufacturers to engage in low-impact infringements that are unlikely to be brought to the attention of a court». But see M. HANDLER, *Rethinking GI Extension*, cit., p. 167, contending «enforcement costs and expediency are hardly sufficient reasons to increase minimum standards of GI protection at a global level».

[54] This way, X. WANG, *Absolute Protection for Geographical Indications: Protectionism or Justified Rights?*, cit., p. 78. See also R. BRAUNEIS and R.E. SCHECHTER, *Geographic Trademarks and the Protection of Competitor Communication*, in *Trademark Rep.*, 2010, pp. 782 ff., 813.

[55] K. WEATHERALL, *Does the Unfair Competition Approach to Geographical Indications of Origin Have a Future?*, in I. CALBOLI and J.C. GINSBURG (eds), *The Cambridge Handbook of International and Comparative Trademark Law*, Cambridge, 2020, p. 277 points out that many geographical indications have a strong reputation only within their country of origin, in culturally similar nations, or within diaspora communities.

[56] J.H. REICHMAN, *Compliance with the TRIPS Agreement: Introduction to a Scholarly Debate*, in *Vanderbilt J. Transn. L.*, 1996, 29, pp. 363 ff., 387; T. JOSLING, *The War on* Terroir: *Geographical Indications as a Transatlantic Trade Conflict*, in *J. Agric. Econ.*, 2006, 57, pp. 337 ff., 351.

call a sparkling wine "Prosecco" if that is the commonly understood meaning in a given territory.

In preventing any evocation of European geographical indications, especially for wines and spirits, even when accompanied by delocalizers, Article 23 seeks not so much to protect non-European consumers from misleading practices (as the true origin of the product is indicated[57]) but to safeguard the investments made by European producers to ensure the high quality of their products and the appeal of famous geographical indications. Otherwise, the geographical indication would lose its ability to convey information about the product's origin and quality.

Attempts have been made to extend the same level of protection prescribed by Article 23 to all geographical indications, but they have been unsuccessful. During negotiations to revise TRIPS, the European Union even proposed a list of the old continent's most famous geographical indications, including Prosciutto di Parma and Parmigiano Reggiano, requesting that other countries be prohibited from using these names to identify products other than the originals. If this were implemented, Italian sounding would be addressed at its core, simply because a geographical indication registered in Italy would not be evoked for different products, even where the label indicates a non-Italian origin, and without needing to prove consumer deception. These requests were supported by many developing countries eager to promote their own geographical indications that have already gained international recognition[58].

However, any extension of Article 23 TRIPS has faced staunch opposition from other major agricultural exporting countries, such as the United States, Australia, Canada, Argentina, and Chile, which accuse old world producers of protectionism[59]. If there is no deception to the consumer from using a European geographical indication—since the true origin of the product is indicated on the label and perhaps the commercial name is accompanied by a delocalizer—why ban it[60]? Nor has it been sufficiently demonstrated

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57 However, it has been argued that anti-dilution laws like Article 23 TRIPS are designed to reduce the "imagination costs" that consumers might face when trying to recall a famous trademark used by another producer for their goods, even when consumers are not misled about the actual origin of the product: *Ty, Inc.* v. *Perryman*, 306 F 3d 509, 511 (7th Cir., 2002).

58 Many Southeast Asian countries have introduced regulations to protect geographical indications: D. MARIE-VIVIEN and I. VAGNERON, *One Size Fits all or Tailor-Made? Building Appropriate Certification Systems for Geographical Indications in Southeast Asia*, in *World Food Policy*, 2016-2017, p. 105 ff. It is believed that small producers in developing countries could benefit from better access to foreign markets and higher selling prices through legislative recognition of their geographical indications: G. EVANS and M. BLAKENEY, *The Protection of Geographical Indications after Doha: Quo Vadis?*, in *J. Int. Econ. L.*, 2006, 9, pp. 575 ff., 607-608. For critical remarks, see J. HUGHES, *Coffee and Chocolate – Can We Help Developing Country Farmers Through Geographical Indications?*, available at https://ssrn.com/abstract=1684370, arguing that the only way to support agricultural production in developing countries is by enhancing their global market reputation, which is not achieved through the introduction of legislation on geographical indications but through significant investments in quality and safety. Additionally, it is crucial to ensure that the profits from sales go directly to the farmers and not to government authorities or other private entities: W.D. MCBRIDE, *GI Joe? Coffee, Location, and Regulatory Accountability*, in *NYU L. Rev.*, 2010, 85, p. 2138 ff.

59 C. FARLEY, *Conflicts Between US Law and International Treaties Concerning Geographical Indications*, in *Whittier L. Rev.*, 2000, 22, pp. 73 ff., 74; D. SNYDER, *Enhanced Protections for Geographical Indications under TRIPs: Potential Conflicts under the US Constitutional and Statutory Regimes*, in *Fordham Intell. Prop., Media & Ent. L. J.*, 2008, 18(5), p. 1297.

60 See C.H. FARLEY, *Why We Are Confused About the Trademark Dilution Law*, in *Fordham Intell. Prop., Media & Ent. L. J.*, 2006, 16, pp. 1175 ss., 1184, claiming that «the main problem with dilution law is that it provides

that the lack of absolute protection, like that of Article 23 TRIPS, for goods other than wines and spirits has led to a shortfall in investments in geographical indications in the agri-food sector[61].

The underlying issue is that the European Union's agenda, and that of the emerging countries that align with it, seems to be based more on a principle of entitlement—a right acquired—than on a precise strategy to initiate a broader political negotiation. In this negotiation, it is likely that new world countries would need to make commercial concessions in exchange for stronger protection of European geographical indications. A multilateral solution to the Italian sounding issue, treating geographical indications solely as intellectual property rights rather than as bargaining chips for greater opportunities in agri-food markets, seems highly unlikely.

V. FROM LEGISLATION TO MARKET: STRATEGIES FOR PROTECTING AUTHENTIC ITALIAN PRODUCTS

If multilateral negotiations within the WTO have failed, it is possible to pursue bilateral agreements to address the issue of Italian sounding. Negotiations with individual countries may allow for the regulation of the use of names exploiting Italian cultural imagery, harming businesses and consumers. A contractual approach to Italian sounding appears to be more aligned with the dynamics and interests underlying international trade. While this approach sacrifices the consistency of open-ended, broadly applicable legislative rules, it offers the advantage of flexibility, focusing on pragmatic, fair, and case-specific solutions ("one-to-one").

Within the framework of Article 26(4)(c) Regulation 1143/2024, which extends GI protection to goods intended for export to third countries, the EU may pursue bilateral or multilateral agreements with third countries to enable mutual recognition of GIs, allowing the third country to enforce protections similar to those within the EU. The Regulation could encourage EU institutions to pursue international cooperation on GI protection or to seek commitments from third countries to recognize and protect EU-designated GIs. For producers of PDOs and PGIs in the EU, Article 26(4)(c) means that they have a stronger legal framework protecting their exports, helping them to maintain the value and reputation of their products internationally, and that they can pursue enforcement actions in third countries more easily. The EU should actively work to expand international recognition of these geographical indications, which can boost export opportunities and market confidence in the authenticity of EU-origin products.

Europe has a long history of such agreements designed to strengthen the protection of its geographical indications. For example, the EU concluded wine agreements with several new world countries, such as Australia, South Africa, and the United States. These agreements protect certain European geographical indications related to wines and spirits in exchange for improved access for foreign products in European markets, even if

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a remedy without a supportable theorization of the harm». Further critical remarks in M. LAFRANCE, *No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, in *South Carolina L. Rev.*, 2007, 58(4), pp. 709 ff., 716-717.

[61] M. HANDLER, *Rethinking GI Extension*, cit., p. 165.

produced using techniques not recognized in Europe[62]. The goal of these free trade agreements is to add value to the basic TRIPS rules by negotiating a list of geographical indications to be protected in the non-European country and ending any harmful practices. The basic framework is absolute protection, similar to Article 23 TRIPS, which prohibits any use of the protected geographical indication by non-European producers, even with delocalizers like "style" or "type" or "imitation". This has allowed European producers to reclaim indications such as port, sherry, and champagne in non-European markets, at the expense of producers in these markets who have had to find new ways to describe their products.

A similar strategy could be employed for Italian-sounding names. The stakes are high, as foreign producers would have to abandon a deeply rooted language and rename their products[63]. The EU would need to adequately compensate for the reclamation of meanings that have become generic in non-European markets with appropriate commercial benefits. However, reaching an agreement will be facilitated by the shared interests between new and old-world countries on specific products, as the case of wine demonstrates[64].

Where specific agreements are lacking with third countries, the only recourse is to combat Italian sounding using the remedies provided by foreign legal systems. Article 26(4)(c) Regulation 1143/2024 likely promotes the use of trademark and intellectual property protections. In practice, this often means seeking certification mark status for PDO or PGI labels in the country of export (which is the case with countries like the United States or Australia). The certification trademark indicates that the product has been produced according to certain quality standards, allowing one to prevent others from using that name, even if only evocatively. The problem, however, is that the trademark can become

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62 D.S. GANGJEE, *Genericide: The Death of a Geographical Indication?*, cit., p. 544; D. VIVAS-EUGUI and C. SPENNEMANN, *The Treatment of Geographical Indications in Recent Regional and Bilateral Free Trade Agreement*, in M. PEREZ PUGATCH (ed.), *The Intellectual Property Debate: Perspectives from Law, Economics and Political Economy*, Cheltenham UK – Northampton MA, 2006, p. 305 ff. On the agreement between the European Community and Australia on trade in wine, see V.C. WAYE, *Wine Market Reform: A Tale of Two Markets and Their Legal Interaction*, in *Univ. Queensland L. J.*, 2010, 29(2), p. 211 ff.; on the agreement with the United States see B. ROSE, *No More Whining About Geographical Indications: Assessing the 2005 Agreement Between the United States and the European Community on the Trade in Wine*, in *Houston J. Int. L.*, 2007, 29, p. 731 ff. Concerns about the bilateral strategy have, however, been voiced by M. HANDLER, *Rethinking GI Extension*, cit., p. 180, contending that the United States has also established specific trade agreements seeking to resist the European model of geographical indications. Instead of imposing a list of U.S. indications to be protected absolutely, the goal has been to promote a system that tends to settle any intellectual property conflicts by prioritizing trademarks that were registered first. Moreover, it is likely that the United States will require its partners not to enter into agreements with third parties that include automatic recognition of geographical indications.

63 A. TAUBMAN, *Thinking Locally, Acting Globally: How Trade Negotiations over Geographical Indications Improvise "Fair Trade" Rules*, in *Intell. Prop. Quart.*, 2008, pp. 231 ff., 262-263; B. BEEBE, *Intellectual Property Law and the Sumptuary Code*, cit., p. 873 ff.

64 This way, I. CALBOLI, *Geographical Indications of Origin at the Crossroads of Local Development, Consumer Protection and Marketing Strategies*, cit., p. 775, noting that the U.S. system for protecting wine-related indications is very similar to the European one, which would have facilitated the conclusion of trade agreements in this area.

generic, and it is not always possible to register a geographic term as a trademark if it lacks distinctiveness[65].

Most importantly, trademark protection follows the "first in time, first in right" rule[66]. Accordingly, an Italian producer might be at a disadvantage if someone else has already registered that trademark in the foreign country. This is the story of Parma ham in North America. In 1969, a Pennsylvania company, Parma Sausage Products Inc., founded by an immigrant from Parma, registered the trademark «Parma Brand» to sell locally produced pork products. It was only in 1984—demonstrating the delayed reaction of some Italian producers—that the Consortium for Prosciutto di Parma applied to register three certification marks: «Parma Ham», «Prosciutto di Parma», and «Parma», along with the famous ducal crown. However, following a lengthy dispute, the application was rejected[67]. Despite recognizing the Consortium's notable efforts to promote Parma ham and its global reputation, the Trademark Trial and Appeal Board favored the fact that the trademark had been registered fifteen years earlier and was not misleading to the public at the time of registration.

The story of Parma ham in Canada has unfolded in a very similar way. When Maple Leaf Meats acquired the «Parma» trademark in 1997, which had been registered in 1971, the Consortium took legal action to have it canceled. Just like in the analogous U.S. case, the request was denied because the Consortium failed to prove that the trademark was misleading at the time of registration[68]. The court ruled that, at the time the «Parma» trademark was registered, most Canadians were not aware that Parma was an Italian city known for its high-quality ham.

Another route for Italian producers would be to rely on actions against unfair competition, such as passing off in the UK and other similar jurisdictions, which protect the reputation linked to the origin and quality of certain products. In an English case[69], a group of French producers succeeded in preventing the sale of «Spanish champagne» in the UK on the grounds that the term «champagne» was generally associated solely with sparkling wine made from a particular grape variety grown in a specific region of France using the *méthode champenoise*. The same reasoning was extended to South African Sherry[70] and Ecuadorian Scotch Whisky[71].

In none of these cases was there a dispute over the false indication of the product's origin. Rather, the issue was the appropriation of qualities that consumers exclusively associate with producers from the protected geographical indication. However, the problem with

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[65] R. BRAUNEIS and R.E. SCHECHTER, *Geographic Trademarks and the Protection of Competitor Communication*, cit., p. 1 ff.; M. FERRARI, *Il nesso fra origine geografica e qualità dei prodotti agroalimentari: i diversi modelli di tutela europei e nordamericani*, in *Riv. dir. agr.*, 2014, pp. 142 ff., 148-149.

[66] D.S. GANGJEE, *Quibbling Siblings: Conflicts Between Trademarks and Geographical Indications*, in *Chicago-Kent L. Rev.*, 2007, pp. 1253 ff., 1256 ff.

[67] *Consorzio del Prosciutto di Parma* v. *Parma Sausage Products Inc.*, 23 U.S.P.Q.2d (BNA) 1894, 1992 WL 233379 (T.T.A.B. 1992). The episode is told by D.S. GANGJEE, *ibid.*, p. 1270 ff.

[68] *Consorzio del Prosciutto di Parma* v. *Maple Leaf Meats Inc.* [2001] F.C. 536 (Fed. Ct.), then upheld on appeal in [2002] F.C.A. 169.

[69] *J. Bollinger SA* v. *Costa Brava Wine Co. Ltd* [1960] Ch 262, noted by D.S. GANGJEE, *Spanish Champagne: An Unfair Competition Approach to GI Protection*, in R. COOPER DREYFUSS and J.C. GINSBURG (eds), *Intellectual Property at the Edge. The Contested Contours of IP*, Cambridge, 2014, p. 105 ff.

[70] *Vine Products Ltd* v. *Mackenzie & Co. Ltd* [1969] RPC 1 (Ch.) (Eng.).

[71] *John Walker & Sons Ltd* v. *Henry Ost & Co. Ltd* [1970] RPC 489 (Ch.) (Eng.).

these types of actions is that they rely on consumer perceptions and only protect well-known indications. To gain recognition for their own indication, producers must prove not that the product objectively possesses certain qualities linked to its geographical origin, but that consumers believe it does[72]. This means that a small producer with a geographical indication known in Italy but not abroad cannot prevent its use in Italian-sounding products.

Clearly, there are significant legal obstacles for Italian producers trying to combat Italian sounding. Where legislation fails (both internationally and within domestic legal systems), the answer may lie in the market[73]. Recent signals from the North American market show that authentically made-in-Italy products are gaining market share previously occupied by Italian-sounding or counterfeit products. This has also been facilitated by consumer education.

An example is the «Academia Barilla», which engages high-end restaurants in Italian-themed evenings featuring top-quality products, sometimes even exceeding the requirements for geographical indications, to educate American palates—and not just the most sophisticated ones—on the concept of "original" food, in a holistic approach to Italian culture that also includes music and art. Barilla has managed to become the most purchased pasta brand in the United States by educating consumers that Italian pasta, though more expensive, is genuinely superior in quality compared to Italian-sounding products[74].

It is difficult but not impossible to reclaim generic terms, which can regain their distinctive quality thanks to producers' efforts over time. This seems to be the case with champagne in the U.S. market, which has seen increased sales following intense English-language advertising campaigns designed to convince the public that «champagne» refers only to a type of sparkling wine from a specific district in France[75].

These success stories demonstrate that combating Italian sounding cannot be achieved solely through laws and sanctions. Even the strictest regulations cannot help foreign consumers appreciate quality flavors, and the preferred way to establish authentic made-in-Italy products is to educate consumers to distinguish the original from counterfeit and evocative products on their own[76].

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72 K. WEATHERALL, *Does the Unfair Competition Approach to Geographical Indications of Origin Have a Future?*, cit., p. 286.

73 See L. BAIRATI, *Narratives of Quality in European Food Governance and Beyond*, cit., p. 477, arguing that «businesses will be fundamental in replacing legislatures in the food quality communication sector […] Private regulators have demonstrated to be much more efficient and effective than their public counterparts, and the consequences of their initiatives can be just as effective in terms of consumer awareness».

74 S. MAGAGNOLI, *The Italian Way of Eating Round the World: Italian-Sounding, Counterfeit, and Original Products*, cit., pp. 179, 181 and 189 fn. 13. See also G. GONIZZI and G. ZENTI, *Beyond Business: "Academia Barilla" and the Defense of the Italian Way of Eating*, in G. CECCARELLI, A. GRANDI and S. MAGAGNOLI (eds), *Typicality in History. Tradition, Innovation, and Terroir*, Brussels, 2013, p. 421 ff.

75 J. HUGHES, *Champagne, Feta, and Bourbon – the Spirited Debate About Geographical Indications*, cit., p. 377 ff.

76 S. MAGAGNOLI, *The Italian Way of Eating Round the World: Italian-Sounding, Counterfeit, and Original Products*, cit., p. 182.