How to Cut the Cheese: Homonymous Names of Registered Geographic Indicators of Foodstuffs in Regulation 510/2006

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HOMONYMOUS NAMES OF REGISTERED
GEOGRAPHIC INDICATORS OF
FOODSTUFFS IN REGULATION 510/2006

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Abstract: Since the 15th century, European states have sought to protect certain foodstuffs originating from a designated geographic location. When multilateral and bilateral agreements failed to establish sufficient protection amongst the European Community member states, the European Community sought to establish uniform standards of protection by adopting Regulation 2081/92 in 1992. While an important step in the harmonization of varying European state practices, Regulation 2081/92 failed to address the problem of names that are homonymous to registered, protected names. In 2006, the European Community attempted to address this issue in Regulation 510/2006. This Note explores the issue of “homonymous names” and how the European Court of Justice has struggled to define the term. The author concludes that Regulation 510/2006 fails to provide a clear standard regarding homonymous names and should be amended to avoid the very problem the European Community sought to address in enacting uniform standards of protection: varying state practices which result in increased litigation.

INTRODUCTION

An essential ingredient in Italian cuisine, Parmigiano Reggiano has become a common household staple in cupboards across the world. Transcending its Italian roots, the hard, often pre-grated cheese can be found in distinctive green cans, labeled “Parmesan cheese.” The real Parmigiano Reggiano, however, originates exclusively from its

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2 See id.
mother country of Italy. To label a cheese “Parmigiano Reggiano” is no small feat—it must be produced from milk originating in the Italian provinces of Parma, Reggio Emilia, Modena, or Bologna and the fermenting process must also be conducted in those same provinces. The large wheels of cheese, made only with Italian milk, rennet, and heat, are aged for eighteen to twenty-four months before inspection to ensure that the quality of the cheese is consistent with Protected Designation of Origin (PDO) requirements.

PDO is a type of geographic indicator regulated under European Community Council Regulation 2081/92. This regulation was adopted in 1992 after European Community (EC) member states realized the need for a uniform registration system of “agricultural products or foodstuffs which have an identifiable geographic origin.” Regulation 2081/92 served not only to define PDOS but also to dictate procedures through which EC members could take steps to enforce PDOS against other member states.

European states have cherished histories with certain foodstuffs, and Regulation 2081/92 was an important step toward harmonizing recognition of such foodstuffs within the EC. In 2006, however, the EC repealed Regulation 2081/92 and replaced it with EC Council Regulation 510/2006. While the majority of Regulation 510/2006 remains true to the preceding Regulation 2081/92, the new regulation added a subsection to Article 3 regarding names that are deemed “homonymous” and therefore cannot be protected under the regulation. The new subsection seeks to provide guidelines regarding when such names can be registered.

4 Id.
6 Council Regulation 2081/92, art. 2, 1992 O.J. (L 208) 2 (EC).
7 See id. pmbl.
8 Id. arts. 1, 13.
9 Id. pmbl.
11 Id. art. 3.
12 Id.
This Note examines the approach taken by the European Court of Justice (ECJ) in interpreting Article 3 of Regulation 2081/92 (Article 3). Part I provides a definition of the term “geographic indicators” as well as a historical background of how they have been treated in the EC. Part II addresses recent case law concerning Article 3 and how the ECJ grappled with how to define “generic names” and other names that conflict with registered ones, as well as what kind of test should apply to those definitions. Part III provides an analysis of the subsection addressing homonymous names in the new Regulation 510/2006 and presents an argument that the regulation should be amended to clarify the definition of a “homonymous name” and to identify the appropriate test to use when registering such a name.

I. Background

A. What Is a “Geographic Indicator”?

“Geographic indicators” is a modern term encompassing a rather broad category of terms historically used by EC member states to refer to labels on products specifying the products’ particular origin. The concept originated in 15th century France when King Charles VI granted a protected status to the infamous Roquefort cheese and the caves in which the cheese is still produced.

Throughout the following five centuries, EC member states further developed this concept of protection for geographic indicators. In France, for example, appellations d’origine signified a particular geographic origins from which products derived their distinctive characteristics and constituted implicit seals of quality. In contrast, indications de provenance composed a broader category of labels which imparted to the consumer the geographic origin of the product’s “location of production, manufacture, or extraction.” Compounding the problem of

17 Id. at 132, 140.
these differing terms was the fact that different EC member states had different standards for their respective geographic indicators.\(^\text{18}\)

When bilateral and multilateral agreements did not sufficiently address geographic indicators of foodstuffs, the EC promulgated Regulation 2081/92 which served to define the terms “designations of origin” and “geographic indicators.”\(^\text{19}\) Much like the difference between the French \textit{appellations d’origine} and \textit{indications de provenance}, the term “designations of origin” includes the requirement of “inherent natural and human factors,” whereas the term “geographic indicators” does not.\(^\text{20}\) Though the EC is clear in drawing a line between the two terms, this Note will use the term “geographic indicators” to encompass both protected “designations of origin” (PDOs) and the broader “geographic indicators.”\(^\text{21}\)

\section*{B. Early Legislation of Geographic Indicators}

The first modern law regulating geographic indicators of foodstuffs was passed in France.\(^\text{22}\) The Law of May 6, 1919, formally recognized \textit{appellations d’origine} and further allowed the courts jurisdiction over issues arising under the geographic indicator.\(^\text{23}\) While at first limited to wines and spirits, the law was later expanded to include other agricultural products such as cheese.\(^\text{24}\) The success of the system instituted by the French—culminating in 1935 with the establishment of the \textit{Institut National des Appellations d’Origine}, which serves to regulate and register protected foodstuffs\(^\text{25}\)—propelled other European states to develop similar systems of protection for their own respective foodstuffs.\(^\text{26}\)

\begin{itemize}
  \item \(^\text{19}\) Council Regulation 2081/92, art. 2, 1992 O.J. (L 208) 2 (EC); see Faulhaber, \textit{supra} note 18, at 625.
  \item \(^\text{20}\) Council Regulation 2081/92, art. 2(2)(a), 1992 O.J. (L 208) 2 (EC).
  \item \(^\text{21}\) See generally id. Both “designations of origin” and “geographical indications” are used together throughout the regulation. \textit{Id.}
  \item \(^\text{22}\) \textit{INTRODUCTION TO INTELLECTUAL PROPERTY THEORY AND PRACTICE} 234 (World Intellectual Property Organization ed., 1997) [hereinafter \textit{INTELLECTUAL PROPERTY}].
  \item \(^\text{23}\) \textit{Id.}
  \item \(^\text{24}\) \textit{Id.}
  \item \(^\text{25}\) Bernard O’Connor, \textit{The Law of Geographical Indications} 167 (2004); Torsen, \textit{supra} note 13, at 1426. An institution overseeing production requirements of \textit{appellations d’origine} was established in 1935; in 1947, it became the \textit{Institut National des Appellations d’Origine}. \textit{Id.}
  \item \(^\text{26}\) \textit{INTELLECTUAL PROPERTY}, \textit{supra} note 22, at 234.
\end{itemize}
Yet, the resulting diversity in regulation of geographic indicators amongst EC member states posed numerous problems of enforcement.\textsuperscript{27} Without an EC-wide regulating authority, member states ensured protection of their registered geographic indicators through bilateral or multilateral agreements.\textsuperscript{28} These agreements either established uniform procedures between the parties or consisted of specific lists of geographic indications which each party agreed to protect.\textsuperscript{29}

\textbf{C. European Community Council Regulation 2081/92}

Despite bilateral and multilateral agreements, the level of protection granted to geographic indicators varied between EC member states.\textsuperscript{30} In an attempt to remedy this situation, and motivated in part by the desire to protect small producers as well as consumer interests, the EC signed Regulation 2081/92 into law on July 14, 1992.\textsuperscript{31} Regulation 2081/92 effectively created a system of registration and enforcement of protected agricultural products, which applied to all EC member states.\textsuperscript{32}

In addition to providing “product specification” to qualify for protected status, the product was only required to be registered by a group or a natural or legal person who produces or processes that particular product.\textsuperscript{33} The registration procedure also required that the application be sent first to the member state.\textsuperscript{34} The member state, upon its approval of the application, forwards it to the Commission of the European Communities (Commission), which would make a decision whether the product could be registered within six months.\textsuperscript{35} If the Commission then approved and registered the product, it would publish that information in the Official Journal of the European Communities.\textsuperscript{36} Article 7

\textsuperscript{27} See id. at 231.

\textsuperscript{28} See Bowers, supra note 15, at 138–43.

\textsuperscript{29} Council for Trade-Related Aspects of Intellectual Property Rights, Note by the Secretariat: Overview of Existing International Notification and Registration Systems for Geographical Indications Relating to Wines and Spirits, IP/C/W/85, 6 (Nov. 17, 1997) [hereinafter TRIPS Council].

\textsuperscript{30} Id.


\textsuperscript{32} See Council Regulation 2081/92, art. 2(1), 1992 O.J. (L 208) 2 (EC). While Regulation 2081/92 covers agricultural products, wines and spirits are expressly excluded. \textit{Id.}

\textsuperscript{33} \textit{Id.} arts. 4, 5.

\textsuperscript{34} \textit{Id.} art. 5.

\textsuperscript{35} \textit{Id.} arts. 5, 6.

\textsuperscript{36} \textit{Id.} art. 6.
also provided for member states to object to the registration within six months of its publication.\textsuperscript{37}

While names that have become generic over time—examples include Brie, Camembert, and Cheddar—cannot be registered, successful registration with the Commission bestows upon products significant economic advantages.\textsuperscript{38} No other product can be labeled with that particular geographic indication if it is likely to mislead consumers or serve to “exploit[ ] the reputation of the protected name.”\textsuperscript{39} In the event that a similar product exists which uses the protected name, member states are permitted to authorize use of the protected name for a period of not more than five years, provided the similar product (a) had been using that name for at least five years prior to the entry into force of Regulation 2081/92, and (b) had clearly indicated the true origin of the product.\textsuperscript{40}

In establishing a uniform system of registration and protection, Regulation 2081/92 produced two important effects.\textsuperscript{41} First, by harmonizing the varying levels of protection afforded to geographic indicators in different member states, the regulation both incorporated existing national registration systems and eliminated those which were not compatible with it.\textsuperscript{42} Second, by allowing only groups of producers or processors working with the product in question to register a geographic indicator, the regulation essentially allowed the formation of collective monopolies.\textsuperscript{43} So long as the group of producers could satisfy the requirements of the regulation, no other producer could market its goods under the protected geographic indicator.\textsuperscript{44}

D. Regulation 510/2006

On March 20, 2006, the EC Council passed Regulation 510/2006 which expressly repealed Regulation 2081/92.\textsuperscript{45} The meaning and function of the new regulation, which still covers the protection of geographic indicators of agricultural products, remains largely unchanged

\textsuperscript{37} Id. art. 7.
\textsuperscript{38} Faulhaber, supra note 18, at 633; see Council Regulation 2081/92, art. 13, 1992 O.J. (L 208) 6 (EC).
\textsuperscript{39} Council Regulation 2081/92, art. 13(1), 1992 O.J. (L 208) 6 (EC).
\textsuperscript{40} Id. art. 13(2).
\textsuperscript{41} See id.
\textsuperscript{42} Faulhaber, supra note 18, at 633.
\textsuperscript{43} Id. at 633; see Council Regulation 2081/92, art. 5, 1992 O.J. (L 208) 3–4 (EC).
\textsuperscript{44} See Council Regulation 2081/92, art. 5, 1992 O.J. (L 208) 3–4 (EC).
from that of its predecessor. Yet, one change, while small, reveals the ECJ’s recognition of the issues presented by homonymous names.

Article 3 of Regulation 510/2006 includes a subsection which specifically addresses homonymous names, an issue that was never addressed in the previous Regulation 2081/92. The new regulation provides guidelines that the Commission must consider when producers seek to register “a name wholly or partially homonymous with that of a name already registered.”

The Commission must consider three principal factors in determining whether to approve product registration. First, the homonymous name cannot be registered if it “misleads the consumer into believing that products come from another territory . . . even if the name is accurate as far as the actual territory, region, or place of origin of the agricultural products or foodstuffs in question.” Second, there is a need for a “sufficient distinction in practice between the homonym . . . and the name already registered.” This second requirement is somewhat qualified in that it also considers the “need to treat the producers concerned in an equitable manner and not to mislead the consumer.” Finally, a name cannot be registered if, “in the light of a trademark’s reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product.”

Although the inclusion of this new subsection is helpful in guiding future ECJ decisions, examination of previous case law under Regulation 2081/92 suggests the need for a more clearly defined standard. Without discretely defined standards, the debate over the gray area of

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46 See generally id. (Regulation 510/2006, while very similar to the repealed Regulation 2081/92, includes more detailed subsections as well as the inclusion of a new subsection under Article 3).
47 See id. art. 3(3).
48 Id.; see Council Regulation 2081/92, art. 3, 1992 O.J. (L 208) 2 (EC). Regulation 2081/92 does not include this subsection on homonymous names. Id.
50 Id. art. 3(3)(a).
51 Id. art. 3(3)(b).
52 Id.
53 Id. art. 3(4).
homonymous names will continue, resulting in more litigation and more confusion.\textsuperscript{55}

II. Discussion

A. Geographic Indicators and the Free Movement of Goods in the EC

Issues surrounding homonymous names are significant precisely because a finding that a registered name is, in fact, generic has far-reaching consequences.\textsuperscript{56} As one of the crucial policies of the EC has been that of the free movement of goods, geographic indicators of food—in essentially setting up monopolies for those holding rights to use a geographic indicator—are the exception to the general rule.\textsuperscript{57}

Articles 30 and 34 of the EC Treaty explicitly prohibit “quantitative restrictions” between member states and impose a duty to abolish such restrictions.\textsuperscript{58} Although no mention is made of geographic indicators of foodstuffs, such protected names tend to fall under one of the exceptions in Article 36, either that of public policy or of the protection of industrial and commercial property.\textsuperscript{59} In addition, the ECJ has held

\textsuperscript{55} See \textit{Feta II}, 2005 E.C.R. I-19115, ¶¶ 84–89; \textit{Feta I}, 1999 E.C.R. I-1541, ¶¶ 64, 70, 84–88. The lack of clarity regarding what factors must be considered to identify a name as generic led to repeated litigation in which the name “Feta” was challenged. \textit{Id.}


\textsuperscript{58} EC Treaty, \textit{supra} note 47, art. 30 (stating that “quantitative restrictions on imports and all measures having equivalent effect shall, without prejudice to the following provisions, be prohibited between Member states”). Article 34 states:

1. Quantitative restrictions on exports, and all measures having equivalent effect, shall be prohibited between Member states. 2. Member states, shall, by the end of the first stage at the latest, abolish all quantitative restrictions on exports and any measures having equivalent effect which are in existence when this Treaty enters into force.

\textit{Id.} art. 34.

\textsuperscript{59} See \textit{id.} art. 36. Article 36 states that:

The provisions of Arts. 30 to 34 shall not preclude prohibitions or restrictions on imports, exports or goods in transit justified on grounds of public morality, public policy, or public security; the protection of health and life of humans, animals or plants, the protection of national treasures possessing artistic, historic or archaeological value, or the protection of industrial and commercial property. Such prohibitions or restrictions shall not, however, constitute a means of
that Articles 30 and 34 of the EC Treaty do not preclude application of bilateral agreements between member states concerning the protection of geographic indicators “provided that the protected names have not become generic in the country of origin.”\textsuperscript{60} Neither do the articles mentioned above prevent member states from taking steps to protect registered names under Regulation 2081/92.\textsuperscript{61}

Such protection, however, is not extended to names that are deemed “generic.”\textsuperscript{62} Ironically, the names of some of the most famous foodstuffs are considered generic, thus preventing their registration.\textsuperscript{63} This peculiar outcome forces producers who produce the protected product to register the product under a more specific name and simultaneously precludes them from bringing suit against producers who use the “generic” name.\textsuperscript{64} For example, European producers are permitted to produce and market cheese under the name “camembert” even if it does not meet the requirements necessary to qualify for the protected status of the “Camembert de Normandie” name.\textsuperscript{65} French cheese makers who produce the protected “Camembert de Normandie” cannot seek protection under Community laws against producers of the generic “camembert” cheese.\textsuperscript{66}

Producers using the protected name can raise the defense that their product uses homonymous names.\textsuperscript{67} This defense has raised the question of how to distinguish homonymous names from translations of protected names, how much of a protected name is actually protected,
and exactly how to weigh all the relevant factors. As Regulation 2081/92 failed to specifically address homonymous names, the ECJ tended to address the issues such names presented under Article 13 regarding protection of registered names.

Article 13 protects registered names from “misuse, imitation or evocation even if . . . the protected name is translated or accompanied by an expression such as ‘style,’ ‘type,’ ‘method,’ ‘as produced in,’ ‘imitation’ or similar.” Producers must cease use of a name that violates this article unless they continuously used and legally marketed the name for the five years preceding publication of the registered name. If producers can successfully demonstrate that they used and legally marketed a name for five years prior to the registration of the protected name, a transitional period of five years is permitted, during which the name must be gradually phased out.

B. Defining the Generic and the Homonymous: Case Law Under Regulation 2081/92

Case law under Regulation 2081/92 illustrates both the issues presented by use of homonymous names and the deficiencies of Article 3 of Regulation 2081/92. In the Kingdom of Denmark v. Commission of the European Communities (Feta I) and Federal Republic of Germany v. Commission of the European Communities (Feta II) cases, the ECJ struggled to articulate the factors that must be considered in determining whether a name is generic and how those factors must be weighed. Criminal Proceedings against Dante Bigi (Parmesan I) and Commission v. Federal Republic of Germany (Parmesan II) presented the unique problem of a homonymous name, an issue which was not mentioned in Regulation

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70 See id. arts. 13, 17; Council Regulation 2081/92, art. 13, 1992 O.J. (L 208) 6 (EC).
2081/92. The lack of textual guidance in the regulation forced the ECJ to stretch the meaning of Article 3 of Regulation 2081/92 to address whether the homonymous name could be deemed generic.

1. The Feta Cases

The Feta cases illustrate the ECJ’s struggle to clarify and weigh factors relevant to determining whether a geographic indicator is generic. Persistent litigation amongst the parties seems to indicate that the factors to be considered in defining “generic” are far from settled. The ECJ has, since Feta I, consistently held that several factors must be taken into account when making this determination, while remaining vague on exactly how each factor should be weighed.

In 1999, in Feta I, Denmark, Germany, and France challenged Greece’s registration of the name “feta,” arguing that the name could not qualify as a protected geographic indicator under Regulation 2081/92 due to its generic character. The three states claimed that the survey on which the registration was based was not an accurate reflection of Community opinion due to the fact that neither nationals of new member states nor trade circles were included, and that it weighed the opinion of Greek consumers more heavily than consumers in other member states.

The ECJ expressly held that “account must be taken of all factors.” Therefore, the status of the name in other member states was to be given equal significance to the status of that name in the member state in which the name originated, namely Greece. As the Commission had not adequately considered the status of the name in the other member states, the ECJ annulled the registration of “feta” as a protected geographic indicator.

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81 Id. ¶ 64.
82 Id. ¶ 88; see Colomer Opinion in Canadane, 1997 E.C.R. I-4681, ¶ 34.
84 Id. ¶ 103.
Three years later, in 2002, Germany, Denmark, and France again challenged the subsequent registration of the name “feta” by the Commission in *Feta II*.\(^85\) Again, these states argued that the name was generic and thus could not be protected.\(^86\) While the ECJ conceded that the existence of other producers of the cheese in question was a relevant factor in determining if “feta” was a generic name, it held that that fact was “only one factor of several which must be taken into account.”\(^87\) Consequently, consistent with its previous holding in *Feta I*, the ECJ weighed all factors—including the status of the name in other member states—equally.\(^88\)

2. The *Gorgonzola* and *Parmesan* Cases

Unlike the *Feta* cases in which the registered name itself was under dispute, the *Consorzio per la Tutela del Formaggio Gorgonzola v. Keserei Champignon Hofmeister GmbH & Co.* (“*Gorgonzola*”) and *Parmesan* cases hinged on whether the disputed name can be used legally alongside the protected, registered name.\(^89\) The ECJ in both cases used Articles 3 and 13 of Regulation 2081/92 to assess the validity of the disputed names and made no mention of homonymous names as Regulation 510/2006 was not yet in effect.\(^90\) The issues presented by both *Gorgonzola* and *Parmesan*, however, reveal the deficiencies of Regulation 510/2006 concerning homonymous names.\(^91\)

*Gorgonzola* involved the question of whether the use of the name “Cambozola” to market a cheese made in Germany impermissibly infringed upon the protected Italian name “Gorgonzola.”\(^92\) A threshold issue concerned whether “Cambozola” qualified as a name which could be protected under Article 13.\(^93\) The ECJ held that the disputed name was an “evocation” of the registered name, and that it was possible “for

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\(^86\) Id. ¶¶ 42–44.

\(^87\) Id. ¶ 84.

\(^88\) Id. ¶¶ 84–94; see *Feta I*, 1999 E.C.R. I-1541, ¶ 88.


\(^93\) See id. ¶ 22.
a protected designation to be evoked where there is no likelihood of confusion between the products concerned and even where no Community protection extends to the parts of that designation which are echoed in the term or terms at issue.”

Advocate General Jacobs elaborated upon this issue in his opinion, stating that the “evocation” standard is an objective one, which requires “a substantial degree of phonetic similarity in the context of goods in a similar market sector.” As applied to this case, Advocate General Jacobs found that this degree of phonetic similarity was satisfied as “the final two syllables are identical, the total number of syllables is the same and the pattern of stress in uttering the two words is very close.”

The *Gorgonzola* case set the precedent for a liberal interpretation of Article 13 regarding names that violate the section. It came as no surprise, then, that in 2002, Nuova Castelli SpA, an Italian cheese producer, was charged, under Italian law, with fraudulent trading for producing a dried, grated cheese called “parmesan” that did not comply with the requirements set forth for the protected name “Parmigiano Reggiano.” The issue was referred to the ECJ by the Tribunale di Parma to settle several questions concerning the legality of a “designation which is open to confusion with the one registered.”

Germany, one of several European governments which submitted written observations regarding the case, argued that the name “parmesan” had become generic, so Community protection only extended to the name “Parmigiano Reggiano” when used in its entirety. In rejecting this argument, the ECJ simply stated that “it is far from clear that the designation ‘parmesan’ has become generic.”

In 2003, the Commission filed suit against Germany for failure to end the marketing of products labeled “parmesan” which did not comply with requirements of the protected geographic indicator “Parmigiano Reggiano.” In response, Germany again argued that the word “parmesan” was only a translation of “Parmigiano,” not “Par-

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94 See id. ¶ 26.
96 Id. ¶ 34.
97 See id.
99 Id. ¶ 14(1).
100 Id. ¶¶ 17, 20.
101 Id. ¶ 20.
migiano Reggiano,” and that the term was generic, precluding application of Regulation 2081/92.\(^{103}\)

The ECJ rejected the first argument, holding that all parts of a registered name could be protected without an explicit request or declaration by the registrants.\(^{104}\) The ECJ held that, in such cases, it defers to the national court to decide whether to protect the name “on the basis of a detailed analysis of the facts presented before it by the parties concerned.”\(^{105}\)

Ultimately, the ECJ held that Germany had not produced enough evidence to show that “parmesan” was a generic term.\(^{106}\) The ECJ looked not only to the factors explicitly mentioned in Article 3, but also to the “conceptual proximity” of the two terms, including the “phonetic and visual similarities” between the names “parmesan” and “Parmigiano Reggiano.”\(^{107}\) The ECJ made clear that the mental images evoked in the mind of the consumer were also relevant to this analysis; accordingly, if the name “parmesan” evoked images of the protected product, “Parmigiano Reggiano,” it would indicate a closer link between the two names.\(^{108}\) Such a link suggested that the disputed name impermissibly misled the consumer and therefore clearly violated Regulation 2081/92.\(^{109}\)

C. Case Law Under the New Regulation 510/2006

Most recent case law in the ECJ concerning Regulation 510/2006 reinforces the court’s previous judgments concerning generic names but has yet to address homonymous ones. *Alberto Severi v. Regione Emilia-Romagna* involved the sale of a sausage labeled “Salame tipo Feline.” The Italian government argued that the label impermissibly infringed on the protected name, “Salame Feline.” The ECJ pointed to previous case law in stating that “[t]he way in which the name of a product becomes generic is the result of an objective process.”\(^{110}\) The ECJ clarified that although protected names can never become ge-

\(^{103}\) Id. ¶¶ 25–26.

\(^{104}\) Id. ¶¶ 29–30.

\(^{105}\) Id. ¶ 30.

\(^{106}\) Id. ¶ 57.

\(^{107}\) Id. ¶¶ 44–48.

\(^{108}\) See * Parmesan II*, 2008 E.C.R. I-00957, ¶ 44.

\(^{109}\) Id. ¶¶ 44–49; see Council Regulation 2081/92, art. 3, 1992 O.J. (L 208) 3 (EC).


\(^{111}\) Id. ¶ 50.
neric, it does not lead to the presumption that unprotected names are generic.112

D. Jurisdiction of the ECJ

The cases above were referred to the ECJ by national courts seeking clarification on the correct interpretation of EC law, or were brought directly to the ECJ by member states.113 The ECJ, while accepting the questions before it in the above mentioned cases, has not always limited itself to the narrow scope of the inquiry.114 Final judgment on questions of fact remain in the exclusive jurisdiction of national courts, yet the ECJ has taken such opportunities to elaborate on all the legal issues arising out of the questions presented to it.115

For example, in Gorgonzola, the ECJ explicitly stated that it is not strictly limited to deciding the questions presented to it, but rather can rule on “all those elements for the interpretation of Community law which may be of assistance in adjudicating on the case pending before it.”116 The broad interpretation greatly expands not only the scope of the inquiry presented in any case, but also the power of the ECJ in formulating the exact interpretation of Regulation 2081/92 and Regulation 510/2006.117

III. Analysis

Regulation 510/2006 is a step forward in addressing the issues presented by disputed names in the Feta, Gorgonzola, and Parmesan cases.118 Despite the added procedure and the addition of subsection 3 to Article 3, however, the new regulation neither defines what constitutes a “homonymous name” nor explicitly states how to weigh the factors considered in registering a homonymous name.119 The subsection is writ-

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112 Id. ¶ 47.
ten in vague, broad terms; without further clarification, such language runs the risk of fostering increased judicial activism on the part of the ECJ.\textsuperscript{120} An amendment to Regulation 510/2006 which sets out a clear test for defining a homonymous name is essential in order to provide notice to member states and producers regarding, when homonymous names can be registered and conversely, when the use of such names is impermissible.\textsuperscript{121}

A. What Constitutes a “Homonymous Name”?

In both the \textit{Gorgonzola} and \textit{Parmesan} cases, the ECJ was left to devise its own test for determining if the disputed name was too similar to the registered one.\textsuperscript{122} Although the court did not explicitly mention “homonymous names,” the facts in both cases—particularly in the \textit{Parmesan} cases—indicate that the ECJ was grappling with that exact issue.\textsuperscript{123} In \textit{Parmesan II}, the ECJ articulated a new test for determining when disputed names are too similar to a registered one and seemed to apply, by analogy, the standard developed in the \textit{Gorgonzola} case concerning the definition of the term “evocation.”\textsuperscript{124} Though the ECJ could continue to apply the same standards it formulated for generic or impermissible names to homonymous ones, the threshold issue of what constitutes a homonymous name should be clarified.\textsuperscript{125}

The fact that Article 3 of Regulation 510/2006 lacks a clear definition of a “homonymous name” indicates that the ECJ will be left with only the \textit{Gorgonzola} and \textit{Parmesan II} cases to serve as guidance in finding whether a name is homonymous.\textsuperscript{126} The test the court articulated in those cases examined whether homonymous names evoked mental images of the registered name in the minds of the consumer.\textsuperscript{127} To conduct this analysis, the ECJ looked to the “conceptual proximity” be-

\textsuperscript{120}See id.
\textsuperscript{121}See id.; Council Regulation 2081/92, art. 3, 1992 O.J. (L 208) 3 (EC).
tween the two names, as well as their “phonetic and visual similarities.”\footnote{Parmesan II, 2008 E.C.R. I-00957, ¶¶ 44–49; see Gorgonzola, 1999 E.C.R. I-1301, ¶¶ 22–26.}

It is significant to note that in *Parmesan II*, the ECJ found it unnecessary to decide whether “parmesan” was an exact translation of “Parmigiano Reggiano.”\footnote{Id. ¶ 47.} The ECJ held that the “[conceptual] proximity and the phonetic and visual similarities” between the two names were sufficient to evoke images of the protected name in the mind of the consumer; thus, use of the name, “parmesan,” violated Regulation 2081/92.\footnote{Id. ¶¶ 48–49; see Council Regulation 2081/92, arts. 3, 13 1992 O.J. (L 208) 3, 6 (EC).} In refusing to rule on whether translations of registered names will always be considered “homonymous,” and by adding several different factors to its analysis, the ECJ only widened the scope of what constitutes a “homonymous name.”\footnote{See Parmesan II, 2008 E.C.R. I-00957, ¶ 44–49.}

A “phonetic and visual” similarity encompasses more than direct translations of protected names, as evident in the *Gorgonzola* case.\footnote{See Parmesan II, 2008 E.C.R. I-00957, ¶¶ 44–49; Gorgonzola, 1999 E.C.R. I-1301, ¶¶ 22–26.} If a name is not a direct translation but looks sufficiently similar to the protected name, the ECJ can find it impermissibly homonymous.\footnote{See Parmesan II, 2008 E.C.R. I-00957, ¶¶ 44–49; Gorgonzola, 1999 E.C.R. I-1301, ¶¶ 22–26.} Moreover, the “conceptual proximity” element of the analysis allows the ECJ to go even further in protecting producers of registered products.\footnote{See Parmesan II, 2008 E.C.R. I-00957, ¶¶ 44–49; Gorgonzola, 1999 E.C.R. I-1301, ¶¶ 22–26.} These elements, coupled with the ECJ’s ruling in *Gorgonzola* that a registered name can be evoked even “where there is no likelihood of confusion between the products concerned,” indicates that producers of unprotected, possibly homonymous names may be at the mercy of the ECJ.\footnote{See id. ¶¶ 45–49; Gorgonzola, 1999 E.C.R. I-1301, ¶¶ 22–26.}

Another concern involves one of the principal tenets of the EC, that of the free movement of goods between member states.\footnote{See EC Treaty, supra note 57, arts. 30, 34.} The collective monopolies enjoyed by producers of protected geographic indicators of foodstuffs constitute an exception to the rule.\footnote{See id. art. 36; Chen, supra note 63, at 62.} When the scope of protection extended to these monopolies is expanded, the
free movement of goods within the Community becomes limited.\textsuperscript{138} Without distinctly defined limits on what constitutes a homonymous name, any name that is found to possess a "conceptual proximity" to a registered name could be in violation of Regulation 510/2006.\textsuperscript{139}

Perhaps a better standard for determining whether a name is homonymous is one which examines only the "visual and phonetic similarities" between the registered name and the disputed name, particularly if both names are in similar product markets.\textsuperscript{140} As the "visual and phonetic similarities" standard encompasses more than mere translations, such a standard would allow the EC to affirmatively prohibit translations of registered names.\textsuperscript{141} In addition, the "visual and phonetic similarities" standard seems to be much more objective than the "conceptual proximity" element articulated in \textit{Parmesan II}.\textsuperscript{142} The latter element simultaneously gives the ECJ much more discretion in determining whether names are homonymous and amplifies the risk of the court issuing inconsistent decisions.\textsuperscript{143}

\textbf{B. Additional Relevant Factors Provided by Article 3(3)}

Subsection 3 of Article 3 of Regulation 510/2006, consistent with Article 13 which protects registered names against "misuse, imitation, or evocation," prohibits registration of homonymous names which "mislead[] the consumer into believing that products come from another territory."\textsuperscript{144} The subsection also expressly adds two requirements to the analysis: "local and traditional usage" of the registered name and a "sufficient distinction in practice" between the homonymous name and the registered name before latter may be registered.\textsuperscript{145} The exact definitions of these terms remain vague, however, and thus pose the risk of allowing the ECJ too much judicial discretion.\textsuperscript{146}

Much like the issues raised in defining homonymous names, the principal concerns are ones of scope and degree.\textsuperscript{147} Neither case law

\textsuperscript{138} See EC Treaty, \textit{ supra} note 57, arts. 30, 34.
\textsuperscript{140} See \textit{Parmesan II}, 2008 E.C.R. I-00957, ¶ 46.
\textsuperscript{141} See id. ¶¶ 44–49.
\textsuperscript{142} See id.
\textsuperscript{144} Council Regulation 510/2006, arts. 3(3), 13, 2006 O.J. (L 93) 14, 19 (EC).
\textsuperscript{145} Id. art. 3(3)(b).
nor Article 3 sheds any light on what criteria will satisfy the “local and traditional” or “sufficiently distinct” requirements. Furthermore, these factors would ultimately preclude producers from registering new products with homonymous names, thereby protecting the older, registered name at the expense of the new product. Although limitation of the number of protected names—and their producers—is consistent with the goal of promoting the free movement of goods within the Community, healthy competition among producers of products with homonymous names is also integral to attaining this goal.

Article 3 runs the risk of curtailing healthy competition if a product with a homonymous name cannot satisfy both of these additional factors. For example, it is conceivable that a producer may wish to market a product that meets the “sufficiently distinct” factor but fails the “local and traditional usage” factor because the product itself is relatively new. Failure to satisfy latter factor would require the producer to market the product under a new name, unless the producer can present a valid, equitable argument as to why it should be permitted to retain the homonymous name. For instance, if the homonymous name had been “legally on the market for at least five years preceding the date of the publication” of the registered name, the ECJ would allow a transitional period of five years within which the name must be gradually phased out. By contrast, if producers have not previously marketed homonymous names, they will be left at the mercy of the ECJ.

C. Balancing the Factors

Compounding the problem of what constitutes a homonymous name is the issue of how to weigh all the relevant factors in determining whether a homonymous name can co-exist with a protected one. In the Feta cases, the ECJ held that all the factors must be weighed equally,
with no preference given to any member state. The question in those cases involved the definition of a generic name, however, not a homonymous one. As homonymous names are now recognized as presenting their own unique problems, there is no guarantee that the ECJ’s approach to generic names will be afforded to homonymous ones.

Going forward, this leaves both the ECJ and concerned producers with little guidance on which to rely. Generic names, unlike homonymous ones, are explicitly provided with a procedure for balancing the relevant factors, even in Regulation 2081/92. Despite this fact, the appropriate method of balancing all relevant factors gave rise to much litigation. It is unusual, then, that Regulation 510/2006 is ominously silent on the issue of how to balance the factors regarding homonymous names. The absence of any express method of balancing the factors established in subsection 3 suggests that European producers will be forced to wait until the ECJ formulates its own balancing method before they know exactly which homonymous names are eligible for registration, or susceptible to challenge in court.

D. The Need for a Clear Standard

Article 3 of Regulation 510/2006 lacks both clear definitions of the terms used and the detailed procedure needed to provide both the ECJ and producers of foodstuffs with notice concerning permissible use of homonymous names. These deficiencies leave the ECJ with very little on which to rely and run the risk of increased judicial activism and inconsistent case law. In light of the repeated litigation that arose un-
der cases concerning generic names, the EC should amend subsection 3 of Article 3 to reflect a clear standard.167

Most changes made in Regulation 510/2006 were procedural: articulating how groups can register names; how those names can be changed; and how to ensure compliance with the regulation.168 Given this degree of added procedure, it is difficult to argue that member states will object to the inclusion of an express balancing test in Article 3, particularly if the test will reduce uncertainty and thus, excessive and expensive litigation.169 Though one could argue that the Feta cases serve as proof that an express balancing test will not necessarily reduce repeated litigation, it is difficult to support a claim that no test would be a better alternative.170

The EC should also clearly define the terms used in Article 3, particularly the terms “local and traditional usage” and “sufficient distinction in practice.”171 Pending the litigation of a case that involves these terms, member states, producers, and even the ECJ will be left in the dark regarding how to define these terms.172 Leaving resolution of this issue to national courts may result in variable treatment of homonymous names by member states.173 This outcome would not only run counter to the purpose of Regulation 510/2006 but would also pose obstacles to the core EC principle of the free movement of goods.174 Despite the fact that registered names and products are the exception to Articles 30 and 34 of the EC Treaty, widely differing standards between national courts could rise to the level of “arbitrary discrimination or a disguised restriction on trade between member states”175 in viola-

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174 See EC Treaty, supra note 57, art. 36.
tion of Article 36. Amending Regulation 510/2006 to provide more procedure and a clear standard for regulating homonymous names could prevent this result, while simultaneously reducing uncertainty and litigation.

**Conclusion**

Although the EC inserted a subsection dealing specifically with homonymous names into the new Regulation 510/2006, pressing issues remain unresolved, including how to define the term “homonymous names” and how to balance factors pertinent to determining the permissible use of such names. The *Feta, Parmesan,* and *Gorgonzola* cases illustrate the problems presented to the ECJ even when definitions and the proper balancing test to be applied are explicitly provided. In light of the oft-times repeated litigation that these cases have produced, it would be wise for the EC to amend Regulation 510/2006 to include a concrete definition of “homonymous names” and a test to determine whether they can be registered.

Such definitions and tests should be promulgated at the Community level, despite the fact that national courts have jurisdiction to resolve questions of fact under Regulation 510/2006. Due to the fact that Regulation 2081/92 and Regulation 510/2006 were passed in an effort to establish a uniform standard for the protection of geographic indicators of foodstuffs within the Community, allowing national courts to form widely diverging tests would be inconsistent with that goal. Alternatively, allowing the ECJ to develop definitions and tests for homonymous names could take time and create increased litigation, which will force the ECJ to develop definitions and tests for homonymous names. These dual concerns indicate that the EC should take steps to amend Regulation 510/2006.

An amendment to Regulation 510/2006 would not only provide notice to member states and producers but would also promote the goals of the EC by reducing uncertainty and litigation and facilitating the free movement of goods. These considerations, together with the issues that arose in the cases mentioned above, demonstrate the need

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176 See id. arts. 30, 34, 36.
177 See *Feta II,* 2005 E.C.R. I-9115, ¶¶ 42–44; *Feta I,* 1999 E.C.R. I-1541, ¶¶ 48–52; Council Regulation 510/2006, art. 3, 2006 O.J. (L 93) 14 (EC); see also Faulhaber, supra note 18, at 665 (arguing that EC member states are not only more willing to bring cases before the ECJ but that such disputes also have a decidedly more political agenda than cases brought under United States law).
to amend Article 3 of Regulation 510/2006 to provide for clearer standards concerning homonymous names of registered products.