Reports of Cases

JUDGMENT OF THE COURT (Third Chamber)

11 September 2025 *

(Reference for a preliminary ruling – Agriculture – Common organisation of the market in wine – Community framework for the protection of wine names – Regulation (EC) No 1493/1999 – Article 54 – Quality wines produced in specified regions (quality wines psr) – Regulation (EC) No 479/2008 – Article 43(2) and Article 51 – Regulation (EC) No 1234/2007 – Article 118k(2) and Article 118s – Regulation (EU) No 1308/2013 – Article 101(2) and Article 107 – Protection, under EU law, of quality wines psr recognised under national law – Conflict between a protected wine name and an earlier well-known mark containing a word identical to that name – Allegedly misleading name – Transitional regime – Automatic extension of protection – Complete nature of the system of protection – Legal certainty)

In Case C-341/24,

REQUEST for a preliminary ruling under Article 267 TFEU from the Corte suprema di cassazione (Supreme Court of Cassation, Italy), made by decision of 8 May 2024, received at the Court on the same day, in the proceedings

Duca di Salaparuta SpA

v

Ministero dell'Agricoltura, della Sovranità alimentare e delle Foreste,

Consorzio volontario di tutela dei vini DOC Salaparuta,

Baglio Gibellina Srl,

Cantina Giacco Soc. coop. agricola,

Madonna del Piraino Soc. coop. agricola,

interveners:

Botte di Vino di VH & C. Snc,

Baglio San Vito Srl, in liquidation,

Romeo Vini di CZ & C. Sas,

* Language of the case: Italian.

THE COURT (Third Chamber),

composed of C. Lycourgos, President of the Chamber, S. Rodin, N. Piçarra, O. Spineanu-Matei and N. Fenger (Rapporteur), Judges,

Advocate General: M. Campos Sánchez-Bordona,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

– Duca di Salaparuta SpA, by S. de Bosio, R. Vaccarella, G. Vecchione, avvocati, and D. Philippe, avocat,

– Consorzio volontario di tutela dei vini DOC Salaparuta, Baglio Gibellina Srl and Madonna del Piraino Soc. coop. agricola, by F. Pacciani and S. Parlatore, avvocati,

– the Italian Government, by G. Palmieri, acting as Agent, and by M. Auciello and M. Di Benedetto, avvocati dello Stato,

– the Portuguese Government, by P. Barros da Costa, J. Ramos and A. Ribeiro de Almeida, advogados,

– the European Commission, by L. Di Masi, M. Konstantinidis and F. Thiran, acting as Agents,

after hearing the Opinion of the Advocate General at the sitting on 3 April 2025,

gives the following

Judgment

1 This request for a preliminary ruling concerns the interpretation of Council Regulation (EC) No 1493/1999 of 17 May 1999 on the common organisation of the market in wine (OJ 1999 L 179, p. 1), Council Regulation (EC) No 479/2008 of 29 April 2008 on the common organisation of the market in wine, amending Regulations (EC) No 1493/1999, (EC) No 1782/2003, (EC) No 1290/2005, (EC) No 3/2008 and repealing Regulations (EEC) No 2392/86 and (EC) No 1493/1999 (OJ 2008 L 148, p. 1), Council Regulation (EC) No 1234/2007 of 22 October 2007 establishing a common organisation of agricultural markets and on specific provisions for certain agricultural products (Single CMO Regulation) (OJ 2007 L 299, p. 1), as amended by Council Regulation (EC) No 491/2009 of 25 May 2009 (OJ 2009 L 154, p. 1) ('Regulation No 1234/2007'), and Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007 (OJ 2013 L 347, p. 671).

2 The request has been made in proceedings between the company Duca di Salaparuta SpA and the Ministero dell'Agricoltura, della Sovranità alimentare e delle Foreste (Ministry of Agriculture, Food and Forestry, Italy), the Consorzio volontario di tutela dei vini DOC Salaparuta (Voluntary Consortium for the Protection of DOC Salaparuta wines, Italy) and the associations Baglio Gibellina Srl, Cantina Giacco Soc. coop. agricola, Madonna del Piraino Soc. coop. agricola, Botte di vino di VH & C. snc, Baglio San Vito Srl, in liquidation, and Romeo Vini di CZ C. Sas, concerning an application for annulment and/or a declaration of invalidity of the registration at EU level of the protected designation of origin 'Salaparuta' and the recognition under Italian law of the word 'Salaparuta' as a registered designation of origin, on the ground that that designation and name create a risk of conflict with the earlier well-known marks registered for wines held by Duca di Salaparuta and which contain words identical to that designation and that name.

Legal context

International law

The Paris Convention

3 The Paris Convention for the Protection of Industrial Property was signed in Paris on 20 March 1883, last revised at Stockholm on 14 July 1967 and amended on 28 September 1979 (*United Nations Treaties Series*, Vol. 828, No 11851, p. 305; 'the Paris Convention'). All Member States of the European Union are parties to that convention.

4 Article 10bis of that convention provides:

'(1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.

(2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

(3) The following in particular shall be prohibited:

1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;

…

3. indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.'

The Madrid Agreement

5 Under Article 3*bis* of the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods of 14 April 1891, as last revised at Stockholm on 14 July 1967 (*United Nations Treaty Series*, Vol. 828, No 11848, p. 163; 'the Madrid Agreement'):

'The countries to which [the Madrid Agreement] applies also undertake to prohibit the use, in connection with the sale or display or offering for sale of any goods, of all indications in the nature of publicity capable of deceiving the public as to the source of the goods, and appearing on signs, advertisements, invoices, wine lists, business letters or papers, or any other commercial communication.'

The TRIPS Agreement

6 The Agreement on Trade-Related Aspects of Intellectual Property Rights ('the TRIPS Agreement'), constitutes Annex 1C to the Marrakesh Agreement Establishing the World Trade Organization (WTO), signed at Marrakesh on 15 April 1994 and approved by Council Decision 94/800/EC (of 22 December 1994) concerning the conclusion on behalf of the European Community, as regards matters within its competence, of the agreements reached in the Uruguay Round multilateral negotiations (1986-1994) (OJ 1994 L 336, p. 1). The members of the WTO, including all EU Member States and the European Union itself, are parties to the TRIPS Agreement.

7 Article 2 of that agreement, in Part I thereof, provides, in paragraph 1:

'In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Article 19, of the Paris Convention …'

8 Article 22(1) of the agreement, in Part II thereof, states:

'Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.'

European Union law

Regulation No 1493/1999

9 Article 52(1) of Regulation No 1493/1999 provided:

'If a Member State uses the name of a specified region to designate a [quality wine produced in specified regions (quality wine psr)] or, where appropriate, a wine intended for processing into such a quality wine psr, that name may not be used to designate products of the wine sector not produced in that region and/or products not designated by the name in accordance with the provisions of the relevant Community and national rules. …

…'

10 Article 54 of that regulation provided:

‘1. Quality wines produced in specified regions (“quality wines psr”) shall mean wines which comply with the provisions of this Title and the Community and national provisions adopted in this connection.

…

4. Member States shall forward to the [European] Commission the list of quality wines psr which they have recognised, stating, for each of these quality wines psr, details of the national provisions governing the production and manufacture of those quality wines psr.

5. The Commission shall publish the list in the “C” Series of the *Official Journal of the European Communities*.’

11 Section F, entitled ‘Brand names’, of Annex VII to that regulation stated:

‘…

2. By way of derogation from point (b) of the first subparagraph of paragraph 1, the holder of a registered trade mark for a wine [or] a grape must which is identical:

– to the name of a geographical unit smaller than a specified region used to describe a quality wine psr, or

– to the name of a geographical unit used to describe a table wine designated by means of a geographical indication, or

– to the name of an imported wine described by means of a geographical indication

may, even if he is not entitled to use such a name pursuant to the first subparagraph of point 1, continue to use that trade mark until 31 December 2002, provided that the trade mark in question:

(a) was registered not later than 31 December 1985 by the competent authority of a Member State in accordance with the legislation in force at the time of registration; and

(b) has actually been used without interruption since its registration until 31 December 1986 or, if registration took place before 1 January 1984, at least since the latter date.

Moreover, the holder of a well-known registered brand name for a wine or grape must which contains wording that is identical to the name of a specified region or the name of a geographical unit smaller than a specified region may, even if he is not entitled to use such a name pursuant to point 1, continue to use that brand name where it corresponds to the identity of its original holder or of the original provider of the name, provided that the brand name was registered at least 25 years before the official recognition of the geographical name in question by the producer Member State in accordance with the relevant Community provisions as regards quality wines psr and that the brand name has actually been used without interruption.

Brand names complying with the conditions of the first and second subparagraphs may not be invoked against the use of the names of geographical units used to describe a quality wine psr or a table wine.

…’

Regulation No 479/2008

12 Regulation No 1493/1999 was repealed by Regulation No 479/2008. Under Article 129(2)(e) of the latter regulation, Chapter IV of Title III thereof applied from 1 August 2009, save as otherwise provided by way of regulation to be adopted in accordance with the procedure referred to in Article 113(1) of the regulation.

13 Recital 5 of Regulation No 479/2008 stated that it was ‘appropriate fundamentally to change the Community regime applying to the wine sector’.

14 Recital 36 of that regulation stated:

‘Existing designations of origin and geographical indications in the Community should for reasons of legal certainty be exempt from the application of the new examination procedure. The Member States concerned should, however, provide the Commission with the basic information and acts under which they have been recognised at national level failing which they should lose their protection as designations of origin or geographical indications. The scope for cancellation of existing designations of origin and geographical indications should be limited for reasons of legal certainty.’

15 Article 43 of that regulation, entitled ‘Grounds for refusal of protection’, provided, in paragraph 2:

‘A name shall not be protected as a designation of origin or geographical indication where, in the light of a trademark’s reputation and renown, protection is liable to mislead the consumer as to the true identity of the wine.’

16 Article 46 of the regulation provided:

‘The Commission shall establish and maintain an electronic register of protected designations of origin and geographical indications for wine which shall be publicly accessible.’

17 Article 50 of Regulation No 479/2008, entitled ‘Cancellation’, provided:

‘It may be decided, in accordance with the procedure referred to in Article 113(2), at the initiative of the Commission or at a duly substantiated request of a Member State, of a third country or of a natural or legal person having a legitimate interest, to cancel the protection of a designation of origin or a geographical indication if compliance with the corresponding product specification is no longer ensured.

…’

18 Article 51 of the regulation, entitled ‘Existing protected wine names’, was worded as follows:

‘1. Wine names, which are protected in accordance with Articles 51 and 54 of Regulation [No 1493/1999] and Article 28 of [Commission Regulation (EC) No 753/2002 of 29 April 2002

laying down certain rules for applying Council Regulation (EC) No 1493/1999 as regards the description, designation, presentation and protection of certain wine sector products (OJ 2002 L 118, p. 1)], shall automatically be protected under this Regulation. The Commission shall list them in the register provided for in Article 46 of this Regulation.

…

4. Article 50 shall not apply in respect of existing protected wine names referred to in paragraph 1.

It may be decided, until 31 December 2014, at the initiative of the Commission and in accordance with the procedure referred to in Article 113(2), to cancel protection of existing protected wine names referred to in paragraph 1 if they do not meet the conditions laid down in Article 34.'

19 Regulation No 479/2008 was repealed by Council Regulation (EC) No 491/2009 of 25 May 2009 amending Regulation (EC) No 1234/2007 establishing a common organisation of agricultural markets and on specific provisions for certain agricultural products (Single CMO Regulation) (OJ 2009 L 154, p. 1), amending the Single CMO Regulation, with effect from 1 August 2009.

20 The second subparagraph of Article 3(1) of Regulation No 491/2009 provides that references to the repealed regulation, that is to say, Regulation No 479/2008, are to be construed as references to Regulation No 1234/2007 and are to be read in accordance with the respective correlation table set out in Annex XXII to the latter regulation.

Regulation No 1234/2007

21 Accordingly, Regulation No 1234/2007 has, pursuant to Regulation No 491/2009 and with effect from 1 August 2009, incorporated Regulation No 479/2008.

22 Article 118k of Regulation No 1234/2007, entitled 'Grounds for refusal of protection', provided, in paragraph 2:

'A name shall not be protected as a designation of origin or geographical indication where, in the light of a trademark's reputation and renown, protection is liable to mislead the consumer as to the true identity of the wine.'

23 Article 118n of that regulation provided:

'The Commission shall establish and maintain an electronic register of protected designations of origin and geographical indications for wine which shall be publicly accessible.'

24 Article 118r of the regulation, entitled 'Cancellation', provided:

'The Commission may decide … to cancel the protection of a designation of origin or a geographical indication if compliance with the corresponding product specification is no longer ensured.

…'

25 Article 118s of that regulation, entitled 'Existing protected wine names', was worded as follows:

'1. Wine names, which are protected in accordance with Articles 51 and 54 of Regulation [No 1493/1999] and Article 28 of [Regulation No 753/2002], shall automatically be protected under this Regulation. The Commission shall list them in the register provided for in Article 118n of this Regulation.

…

4. Article 118r shall not apply in respect of existing protected wine names referred to in paragraph 1.

The Commission may decide, until 31 December 2014, at its own initiative and in accordance with the procedure referred to in Article 195(4), to cancel protection of existing protected wine names referred to in paragraph 1 if they do not meet the conditions laid down in Article 118b.'

Regulation No 1308/2013

26 Under the first subparagraph of Article 230(1) of Regulation No 1308/2013, Regulation No 1234/2007 is repealed, except for its provisions which, pursuant to the second subparagraph of Article 230(1) and Article 230(2) and (3) of Regulation No 1308/2013, continue to apply. It is apparent from the second subparagraph of Article 232(1) of that regulation that it is to apply from 1 January 2014, without prejudice to the special provisions laid down in Article 232.

27 Article 101(2) of Regulation No 1308/2013 states:

'A name shall not be protected as a designation of origin or geographical indication where, in the light of a trade mark's reputation and renown, protection could mislead the consumer as to the true identity of the wine.'

28 Article 104 of that regulation provides:

'The Commission shall establish and maintain an electronic register of protected designations of origin and protected geographical indications for wine which shall be publicly accessible. …'

29 Article 106 of the regulation provides:

'The Commission may, on its own initiative or on a duly substantiated request by a Member State, a third country or a natural or legal person having a legitimate interest, adopt implementing acts cancelling the protection of a designation of origin or a geographical indication if compliance with the corresponding product specification is no longer ensured.

…'

30 Article 107(1) and (3) of that regulation reads as follows:

'1. Wine names referred to in Articles 51 and 54 of [Regulation No 1493/1999] and Article 28 of [Regulation No 753/2002] shall be automatically protected under this Regulation. The Commission shall list them in the register provided for in Article 104 of this Regulation.

…

3. Article 106 shall not apply to existing protected wine names referred to in paragraph 1 of this Article.

Until 31 December 2014, the Commission may, on its own initiative, adopt implementing acts cancelling the protection of existing protected wine names referred to in paragraph 1 of this Article if they do not meet the conditions laid down in Article 93.

…'

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

31 Duca di Salaparuta SpA is a wine company established in Sicily (Italy), which is the holder of several national and EU trade marks, including several containing the word 'Salaparuta'.

32 On 13 July 1989, the sign 'Salaparuta' was registered as a national trade mark (No 511337). On 25 October 2000, that sign was also registered as an EU trade mark as a word mark in respect of goods in Class 33 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended (alcoholic beverages). Those marks have since been renewed.

33 The marketing of wines under the Salaparuta marks bears no relation to the local administrative area of Salaparuta (Italy), situated in Sicily. Duca di Salaparuta is established outside that local administrative area and the grapes used do not come from Salaparuta.

34 The decreto 'Riconoscimento della denominazione di origine controllata dei vini "Salaparuta" e approvazione del relativo disciplinare di produzione' (decree recognising the registered designation of origin 'Salaparuta' and approving the product specification relating thereto) (GURI No 42 of 20 February 2006) recognised, at national level, the registered designation of origin 'Salaparuta' ('DOC "Salaparuta"'), which is intended to designate and protect a range of wines produced from grapes from vineyards situated within the territorial boundaries of the local administrative area of Salaparuta.

35 The protection of those wines was subsequently extended to EU level. In particular, it is apparent from the file submitted to the Court that, in accordance with Article 54(4) of Regulation No 1493/1999, a list of quality wines psr containing the DOC 'Salaparuta' was published on 8 August 2009 by the Commission in the *Official Journal of the European Communities* (OJ 2009 C 187, p. 1) and that that DOC was entered, with effect from 1 August 2009, in the electronic register of protected designations of origin (PDO) and protected geographical indications (PGI) relating to wines, as PDO PDO-IT-A0795 ('the PDO "Salaparuta"').

36 On 8 February 2016, Duca di Salaparuta brought an action before the Tribunale di Milano (District Court, Milan, Italy) seeking, inter alia, the annulment or a declaration of invalidity of the PDO 'Salaparuta' and the DOC 'Salaparuta', on the ground that those names are misleading and, in any event, that they interfere with the trade mark Salaparuta, registered for wine and containing a word identical to those names, and with the other marks held by that company, which contain that word and are regarded by that company as being well-known.

37 By a judgment of 16 February 2021, that court dismissed that action on the ground that the conflict between the protected name 'Salaparuta' and the earlier mark of the same name had to be resolved on the basis of the rule that the protected name should take precedence over that trade mark, without prejudice to the possibility for the holder of that mark to continue to use it under certain conditions.

38 Duca di Salaparuta brought an appeal against that judgment before the Corte d'appello di Milano (Court of Appeal, Milan, Italy), which, by a judgment of 5 May 2023, upheld the ruling at first instance. That court held, in essence, that wine names protected under Regulation No 1493/1999 were granted, automatically, protection by means of the recognition of a PDO at EU level. That court concluded that the conflict between the DOC 'Salaparuta' and the earlier mark containing a word identical to that name should be resolved on the basis of Regulation No 1493/1999, Section F(2)(b) of Annex VII thereto in particular, which was in force on the date on which that protected wine name was recognised at national level. That annex laid down a criterion of primacy of the protected name over that trade mark, without prejudice to the possibility for the holder of that mark to continue, under certain conditions, to use that trade mark.

39 Duca di Salaparuta brought an appeal on a point of law against that judgment before the Corte suprema di cassazione (Supreme Court of Cassation, Italy), the referring court, claiming, in essence, that Regulation No 1493/1999 does not govern such conflicts.

40 Duca di Salaparuta submits in that regard that, contrary to the finding of the court of appeal, by its publication, the PDO 'Salaparuta' replaced the DOC of the same name. Having regard to the date on which the entry of the PDO 'Salaparuta' in the E-Bacchus register took effect, namely 1 August 2009, Article 43(2) of Regulation No 479/2008, Article 118k of Regulation No 1234/2007 or Article 101(2) of Regulation No 1308/2013 should apply. Those provisions exclude the protection of a name where, in view of the reputation and renown of an earlier mark, consumers could be misled as to the identity of the wine in question. In addition, it submits that, in view of the conditions laid down in the second subparagraph of Section F(2) of Annex VII to Regulation No 1493/1999, it would be prevented from using the Salaparuta mark, of which it is the holder, even if the coexistence regime laid down in that provision did apply.

41 The referring court states, in the first place, that it is necessary to determine the protection regime applicable where there is a conflict between, on the one hand, well-known trade marks registered in 1989 and, on the other hand, a wine name, protected at national level in 2006, containing a word identical to that contained in those marks, followed by publication and registration of that name at EU level in 2009.

42 In that regard, the referring court asks whether DOC 'Salaparuta' should be regarded as still having effect and that, therefore, the second subparagraph of Section F(2) of Annex VII to Regulation No 1493/1999 applies, or whether that national protection must, on the contrary, be regarded as having been replaced by the recognition of the PDO 'Salaparuta' at EU level, with the result that Article 43(2) of Regulation No 479/2008 should be applied, or the equivalent provisions in Article 118k of Regulation No 1234/2007 or in Article 101(2) of Regulation No 1308/2013, relating to the grounds for refusing protection of a name where, in the light of the reputation and renown of an earlier trade mark, protection is liable to mislead the consumer as to the true identity of the wine in question.

43 In the second place, should Regulation No 1493/1999 apply, the referring court asks, in essence, whether the protection regime laid down by that regulation is complete, in that it covers all cases of coexistence between various signs, including protected wine names in particular, or whether the conflict between a well-known wine trade mark and a protected name that was granted subsequently, and includes a word identical to that mark, can be resolved on the basis of the general principle that distinctive signs must not be misleading.

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

'(1) Are PDO/PGI registrations, in the wine sector, of designations that existed prior to [Regulation No 1234/2007] – subsequently replaced by [Regulation No 1308/2013] – such as, in particular, the PDO "Salaparuta" PDO-IT-A0795 of 8 August 2009, subject – in terms of the impediment to registration based on an earlier trade mark that, because of its reputation and renown, is liable to render the PDO/PGI in question misleading ("protection is liable to mislead the consumer as to the true identity of the wine") – to Article 43 [paragraph 2] of [Regulation No 479/2008], recte [Article] 118k of [Regulation No 1234/2007] (then Article 101, [paragraph 2,] of [Regulation No 1308/2013]), which excludes protection of the PDO or PGI where the name in question is liable to mislead the consumer, "in the light of a trade mark's reputation and renown", or is that rule inapplicable to names already enjoying national protection prior to unitary European registration being granted, in application of the principle of legal certainty [(judgment of 22 December 2010, *Bavaria*, C-120/08, EU:C:2010:798)], according to which a factual situation must, as a general rule, unless otherwise expressly provided, be assessed in the light of the legal rules in force at the time when the situation obtained, with the consequent application of the earlier regulatory situation as laid down in [Regulation No 1493/1999], and with the conflict between the designation of origin and the earlier trade mark to be resolved on the basis of the provisions of that legislation, laid down in [Section F(2)(b)] of Annex VII to that regulation?

(2) If the answer to the first question affirms the necessary application of [Regulation No 1493/1999] to the factual situation at issue in the present case, … do the rules laid down in Section F [of Annex VII] to [Regulation No 1493/1999], which are intended to regulate the conflict between a trade mark registered for a wine or a grape must that is identical to protected designations of origin or geographical indications for a wine, exhaust all possible circumstances of coexistence between the different signs and all possible mechanisms providing protection for the wine names, or does there still exist a possible situation where later PDOs or PGIs might be invalid or not subject to protection, in cases where the geographical indication is liable to mislead the public as to the true identity of the wine because of the reputation of an earlier trade mark, by virtue of the general principle of non-deceptiveness of distinctive signs?'

The request to reopen the oral part of the procedure

45 By documents lodged at the Registry of the Court of Justice on 14 and 28 April 2025, respectively, Duca di Salaparuta requested the Court to order the oral part of the procedure to be reopened, pursuant to Article 83 of the Rules of Procedure of the Court.

46 In support of its request, it submits, in essence, first, that, in his Opinion, the Advocate General relied on incorrect elements of fact and of law in order to answer the questions referred and therefore introduced arguments which had not been debated between the parties. Second, Duca di Salaparuta submits that the fact that no hearing was held before the Court, despite its request to that effect, infringes its right to a public hearing, enshrined in Article 6 of the European Convention for the Protection of Human Rights and Fundamental Freedoms, signed at Rome on 4 November 1950.

47 Pursuant to Article 83 of its Rules of Procedure, the Court may, at any time, after hearing the Advocate General, order the reopening of the oral part of the procedure, in particular if it considers that it lacks sufficient information or where a party has, after the close of that part of the procedure, submitted a new fact which is of such a nature as to be a decisive factor for the decision of the Court, or where the case must be decided on the basis of an argument which has not been debated between the parties or the interested persons referred to in Article 23 of the Statute of the Court of Justice of the European Union.

48 In that regard, it should be noted, however, that the content of the Advocate General's Opinion cannot constitute in itself a new fact, otherwise it would be possible for the parties, by invoking such a fact, to respond to that Opinion. The Advocate General's Opinion cannot be debated by the parties. The Court has thus had the opportunity of underlining that, in accordance with Article 252 TFEU, the role of the Advocate General is to make, in open court, acting with complete impartiality and independence, reasoned submissions on cases which, in accordance with the Statute of the Court of Justice of the European Union, require the Advocate General's involvement in order to assist the Court in the performance of the task assigned to it, which is to ensure that, in the interpretation and application of the Treaties, the law is observed. Pursuant to the fourth paragraph of Article 20 of that statute and Article 82(3) of the Rules of Procedure, the Opinion of the Advocate General brings the oral part of the procedure to an end. The Opinion does not form part of the proceedings between the parties, but rather opens the stage of deliberation by the Court. It is not therefore an opinion addressed to the judges or to the parties which stems from an authority outside the Court, but rather, it is the individual reasoned opinion, expressed in open court, of a Member of the Court of Justice itself (judgment of 8 May 2025, *Beevers Kaas*, C-581/23, EU:C:2025:323, paragraph 29 and the case-law cited).

49 In the present case, first, the Court finds, having heard the Advocate General, that the elements put forward by Duca di Salaparuta do not disclose any new fact capable of having a decisive influence on the decision that it is called upon to deliver in the present case and that it is not necessary to make that decision on the basis of an argument which has not been debated between the parties or the interested persons referred to in Article 23 of the Statute of the Court of Justice of the European Union. Duca di Salaparuta is in fact criticising the merits of certain sections of the Advocate General's Opinion, which cannot validly substantiate its request that the oral part of the procedure be reopened. Furthermore, the Court has at its disposal, at the close of the written and oral parts of the procedure, all the elements necessary and therefore has sufficient information to make a ruling.

50 Second, it should be borne in mind that neither Article 6(1) of the European Convention for the Protection of Human Rights and Fundamental Freedoms nor Article 47 of the Charter of Fundamental Rights of the European Union imposes an absolute obligation to hold a public hearing in all proceedings and do not necessarily require a hearing to be held in all proceedings. That is true, inter alia, where the case does not raise questions of fact or law which cannot be resolved adequately on the basis of the file and the written observations of the parties.

Article 76(2) of the Rules of Procedure provides specifically that the Court may decide not to hold a hearing if it considers, on reading the written pleadings or observations lodged during the written part of the procedure, that it has sufficient information to make a ruling (see, to that effect, judgment of 21 December 2021, *Euro Box Promotion and Others*, C-357/19, C-379/19, C-547/19, C-811/19 and C-840/19, EU:C:2021:1034, paragraphs 123 and 124 and the case-law cited).

51 In the light of the foregoing, there are no grounds to grant the request that the oral part of the procedure be reopened.

Admissibility of the request for a preliminary ruling

52 The Italian Government calls into question the jurisdiction of the national courts to hear a dispute in which the question of the validity of an EU act is at issue, arguing that, in so far as Duca di Salaparuta seeks the annulment or a declaration of invalidity of the registration of the PDO 'Salaparuta', which is an act of the European Union, jurisdiction to annul such a registration lies with the Courts of the European Union by virtue of Article 263 TFEU.

53 Furthermore, that government argues that the DOC 'Salaparuta' has never been challenged before the national courts, even though Duca di Salaparuta was informed of the national recognition procedure and was invited to submit its observations in that context.

54 It follows that those claims seek, in essence, to call into question the admissibility of the request for a preliminary ruling.

55 In that regard, it should be noted, first, that the publication of the list of protected wine names in the *Official Journal of the European Communities* pursuant to Article 54(4) and (5) of Regulation No 1493/1999 and the entry in the electronic register of PDOs and PGIs relating to wines pursuant to Article 51(1) of Regulation No 479/2008 cannot, in view of the automatic nature of the protection of protected wine names, be regarded as producing legal effects and therefore as constituting acts open to challenge for the purposes of Article 263 TFEU.

56 The Court has held, in essence, that, in accordance with Article 54(5) of Regulation No 1493/1999, the entry in the electronic register of PDOs and PGIs relating to wines made by the Commission as regards wine names protected by the Member States as designations of origin before 1 August 2009 cannot be regarded as intended to produce binding legal effects that are characteristic of acts open to challenge (see, to that effect, judgment of 13 February 2014, *Hungary* v *Commission*, C-31/13 P, EU:C:2014:70, paragraph 63).

57 Therefore, Duca di Salaparuta cannot be criticised for not having brought an action against the PDO 'Salaparuta' before the Courts of the European Union directly.

58 Furthermore, as the Advocate General observed, in essence, in point 41 of his Opinion, the system of references for a preliminary ruling is based on a dialogue between one court and another, the initiation of which depends entirely on the national court's assessment as to whether a reference is appropriate and necessary (judgments of 12 February 2008, *Kempter*, C-2/06, EU:C:2008:78, paragraph 42 and the case-law cited, and of 16 July 2015, *Diageo Brands*, C-681/13, EU:C:2015:471, paragraph 59 and the case-law cited). While it is true that only the Court may declare that an act of the EU institutions is invalid, the fact remains that, in the present case, the

referring court is merely asking the Court, in its reference for a preliminary ruling on a question of interpretation, to establish the legal framework of the European Union applicable to a potential conflict between a protected wine name and an earlier well-known trade mark registered for wine that contains a word identical to that name.

59 Second, it is for the referring court, not for the Court of Justice, to assess the effect on the dispute in the main proceedings of the possible absence, on the date on which the DOC 'Salaparuta' was recognised, of a challenge to it by Duca di Salaparuta. In any event, such an absence could not prevent the referring court from making a reference to the Court, in the context of a reference for a preliminary ruling on a question of interpretation, in order to determine the EU legal framework applicable to a conflict such as that referred to in the preceding paragraph of the present judgment.

60 It follows from the foregoing that the request for a preliminary ruling is admissible.

Consideration of the questions referred

61 By its questions, which it is appropriate to examine together, the referring court asks, in essence, whether Article 51 of Regulation No 479/2008, Article 118s of Regulation No 1234/2007 and Article 107 of Regulation No 1308/2013 must be interpreted as meaning that Article 43(2) of Regulation No 479/2008, Article 118k of Regulation No 1234/2007 and Article 101(2) of Regulation No 1308/2013, respectively, are applicable to a conflict between a wine name protected under Article 54 of Regulation No 1493/1999 and earlier well-known marks registered for wines containing words identical to that name, or whether that conflict must be settled solely on the basis of the second subparagraph of Section F(2) of Annex VII to Regulation No 1493/1999.

62 The Court notes at the outset that Article 54(1) of Regulation No 1493/1999 defined quality wines psr as wines complying with the provisions of Title VI of that regulation and the Community and national provisions adopted in that connection.

63 Article 54(4) and (5) of that regulation provided for protection, under EU law, of quality wines psr recognised under national law. More specifically, Article 54(4) of Regulation No 1493/1999 provided that Member States were to forward to the Commission the list of quality wines psr which they had recognised, stating, for each of these quality wines psr, details of the national provisions governing the production and manufacture of those quality wines psr. Pursuant to Article 54(5), the Commission published that list in the C series of the *Official Journal of the European Communities*.

64 In the present case, the DOC 'Salaparuta' falls within the category of quality wines psr under Article 54(1) of Regulation No 1493/1999. Moreover, as is apparent from the file before to the Court, the list of those wines was notified to the Commission and published, pursuant to Article 54(5) of that regulation, on 8 August 2009 in the C series of the *Official Journal of the European Communities* as the PDO 'Salaparuta' (OJ 2009 C 187, p. 1).

65 According to Article 52(1) of Regulation No 1493/1999, the name of the region attributed to a quality wine psr could not be used to designate products of the wine sector not produced in that region and/or products not designated by the name in accordance with the provisions of the relevant Community and national rules. The same would apply if a Member State had, inter alia,

assigned to a quality wine psr the name of a local administrative area. That provision thus established a rule intended to protect geographical names from the use, by any other sign, of the terms of which they are composed.

66 As regards a possible conflict between such a protected name and an earlier well-known mark containing words identical to that name, the second subparagraph of Section F(2) of Annex VII to Regulation No 1493/1999 provided that such a conflict could be resolved under a regime providing for that name and that mark to coexist.

67 More specifically, it followed from that provision that the holder of a well-known trade mark registered for a wine or grape containing words identical to the name of a specified region could continue to use that brand name where it corresponded to the identity of its original holder or of the original provider of the name, provided that the brand name was registered at least 25 years before the official recognition of the geographical name in question by the producer Member State in accordance with the relevant Community provisions as regards quality wines psr and that the brand name had actually been used without interruption. In addition, the third subparagraph of Section F(2) of Annex VII to Regulation No 1493/1999 stated that those brand names could not be relied on against the use of the names of geographical units used, inter alia, to describe a quality wine psr.

68 It follows that the second and third subparagraphs of Section F(2) of Annex VII to Regulation No 1493/1999 established the pre-eminence of a protected wine name over earlier well-known marks containing words identical to that name, by authorising, subject to compliance with the conditions laid down in that provision, the continued use of such marks.

69 In the present case, since, as is apparent from the order for reference, the DOC 'Salaparuta' was recognised on 8 February 2006, namely while Regulation No 1493/1999 was in force, and since that protected wine name corresponded to quality wines psr within the meaning of Article 54(1) of that regulation, a conflict between such a name and earlier well-known trade marks registered for wines, which contain words identical to that name, must be resolved on the basis of the provisions of that regulation, Section F(2) of Annex VII thereto, in particular. That finding is, moreover, borne out by the express reference to Article 54(4) and (5) of that regulation at the time of the notification and publication of the DOC 'Salaparuta' in the *Official Journal of the European Communities*, referred to in paragraph 64 of this judgment.

70 Duca di Salaparuta nevertheless relied, before the national courts and in its written observations before the Court, on the application of Article 43(2) of Regulation No 479/2008, Article 118k of Regulation No 1234/2007 or Article 101(2) of Regulation No 1308/2013. It argues that, since a new registration of the PDO 'Salaparuta' was published on 8 August 2009, those new rules are applicable to the conflict at issue in the main proceedings. In those circumstances, the referring court is asking the Court about the effect of those provisions on resolving such a conflict.

71 In that regard, it should be noted at the outset that, by the three provisions referred to in the preceding paragraph of the present judgment, the EU legislature provided that no name is to be protected as a designation of origin or geographical indication if, in the light of the reputation and renown of a trade mark, protection is liable to mislead the consumer as to the true identity of the wine in question.

72 Moreover, it is clear from recital 5 of Regulation No 479/2008 that the EU regime applicable to the wine sector has, by way of that regulation, been fundamentally changed with a view to achieving objectives related, inter alia, to the quality of wines. That regulation amended and repealed Regulation No 1493/1999 and was applicable from 1 August 2009.

73 While it is true that that new system for the protection of names makes any application for protection of a wine name subject to a detailed examination which is carried out in two stages, namely at national level and then at EU level, with the Commission having genuine decision-making power to grant or refuse protection to the designation of origin or geographical indication (see, to that effect, judgment of 13 February 2014, *Hungary* v *Commission*, C-31/13 P, EU:C:2014:70, paragraph 74), this is not the case with regard to wine names already protected under Article 54 of Regulation No 1493/1999.

74 In accordance with that provision, the Member States forwarded to the Commission the list of quality wines psr that they had recognised, indicating, for each of them, a reference to the national provisions governing their production and manufacture. Subsequently, in accordance with Article 54(5) of that regulation, and without any further examination by the Commission, the Commission merely published that list in the C series of the *Official Journal of the European Communities*.

75 Under the transitional regime laid down in Article 51(1) of Regulation No 479/2008, wine names which were protected in accordance with Article 54 of Regulation No 1493/1999 were protected 'automatically' under Regulation No 479/2008. Article 51 also specified that the Commission was to enter those names in the publicly accessible electronic register of PDOs and PGIs relating to wines.

76 As was reflected in recital 36 of Regulation No 479/2008, the purpose of the transitional system provided for in Article 51(1) of that regulation was to exempt designations of origin and geographical indications which already existed in the European Union from the application of the new examination procedure, and to limit the possibilities of cancellation of those designations and indications, for reasons of legal certainty (see, to that effect, judgment of 13 February 2014, *Hungary* v *Commission*, C-31/13 P, EU:C:2014:70, paragraph 57).

77 The same automatic protection was guaranteed under Article 118s of Regulation No 1234/2007, which seeks to maintain, for reasons of legal certainty, the protection of wine names protected before 1 August 2009 in domestic law and therefore at EU level pursuant to Article 54 of Regulation No 1493/1999 (see, to that effect, judgment of 13 February 2014, *Hungary* v *Commission*, C-31/13 P, EU:C:2014:70, paragraphs 56 and 58).

78 The same automatic system for the protection of wine names protected in accordance with Article 54 of Regulation No 1493/1999 was confirmed again by the legislature in Article 107 of Regulation No 1308/2013, which repealed Regulation No 1234/2007, without prejudice to the application of certain provisions of that regulation, with effect from 1 January 2014.

79 In the present case, it follows that, in the light of the automatic nature of the protection regime laid down in Regulations No 479/2008, No 1234/2007 and No 1308/2013, a name such as the PDO 'Salaparuta', notified and published in the C series of the *Official Journal of the European Communities*, with an express reference to Article 54(4) and (5) of Regulation No 1493/1999, must be regarded as the extension of the wine name protected at national level, not the result of a new registration.

80 Such an interpretation is, moreover, supported, as the Commission maintained in its observations, by the development of the rules governing the protection of wine names. Thus, EU legislation laying down a system for the recognition and protection of geographical indications in the wine sector has been adopted in successive stages. The Commission is correct to submit that Regulation No 1493/1999 contained non-detailed basic rules, which were not aligned with the system of geographical indications already in force in the food sector, since those rules formed part of a transitional phase between the protection granted by the Member States and that granted at EU level.

81 Furthermore, it should be noted that the withdrawal of protection granted to a wine name, provided for in Article 50 of Regulation No 479/2008 and the provisions equivalent to that article in Regulations No 1234/2007 and No 1308/2013, was not, in principle, possible in respect of wine names protected in accordance with Article 54 of Regulation No 1493/1999.

82 Under the first subparagraph of Article 51(4) of Regulation No 479/2008, similarly to the equivalent provisions in Regulations No 1234/2007 and No 1308/2013, namely, the first subparagraph of Article 118s(4) and the first subparagraph of Article 107(3), respectively, such a possibility of withdrawal did not apply to such names.

83 Nevertheless, the second subparagraph of Article 51(4) of Regulation No 479/2008, similarly to the equivalent provisions in Regulations No 1234/2007 and No 1308/2013, had created an exception to that rule in that a decision could be made, until 31 December 2014, on the Commission's initiative, to withdraw the protection granted to the protected wine names referred to in Article 51(1) of Regulation No 479/2008 if they did not satisfy the conditions laid down in Article 34 of that regulation. The EU legislature has thus limited the possibilities of withdrawing protected names which are covered by the transitional regime laid down in Regulation No 479/2008 to situations that have been expressly provided for.

84 Since that transitional regime provides for the automatic extension of the protection of wine names protected under Article 54 of Regulation No 1493/1999 and, moreover, expressly governs the situations in which those names are withdrawn, the Court holds that Article 43(2) of Regulation No 479/2008, Article 118k of Regulation No 1234/2007 and Article 101(2) of Regulation No 1308/2013 do not apply to a conflict such as that arising in the dispute in the main proceedings.

85 Article 43(2) of Regulation No 479/2008, Article 118k of Regulation No 1234/2007 and Article 101(2) of Regulation No 1308/2013 apply to applications for protection subject to the new regime established by Regulation No 479/2008, as referred to in paragraph 73 of the present judgment, not to protected wine names recognised under the regime set out in Regulation No 1493/1999. As is apparent from the title itself of the articles in which those provisions appear, namely 'Grounds for refusal of protection' or 'Additional grounds for refusal of protection', those provisions provide only for a situation in which registration of a new name is refused because of a conflict with an earlier well-known mark, not in which a name which had already been registered under Article 54(4) and (5) of Regulation No 1493/1999 is withdrawn.

86 Furthermore, it is apparent from the wording itself of the second subparagraph of Section F(2) of Annex VII to Regulation No 1493/1999 that that provision covers the situation where the well-known mark registered for a wine or grape must contains words identical to a name, by

providing, under certain conditions, for the principle of coexistence between that mark and that name. Therefore, the EU legislature necessarily considered, when Regulation No 1493/1999 was adopted, that such a name could be registered despite the existence of an earlier well-known mark.

87 Furthermore, while, as regards agricultural products and foodstuffs, Article 14(3) of Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ 1992 L 208, p. 1), which is not applicable to wine products, provided that a designation of origin or a geographical indication was not to be registered where, in the light of a trade mark's reputation and renown and the length of time it has been used, registration was liable to mislead the consumer as to the true identity of the product, it should be noted that the EU legislature chose deliberately not to include an analogous provision in Regulation No 1493/1999.

88 Consequently, a conflict between a wine name protected at national level, subsequently extended automatically at EU level, and earlier well-known marks registered for wines, containing words identical to that name, must be resolved by applying Section F(2) of Annex VII to Regulation No 1493/1999, as the EU legislature had intended that such a name prevail over those trade marks, while providing for a regime under which they may coexist.

89 The Court also adds that Article 22 of the TRIPS Agreement, Article 10bis of the Paris Convention and Article 3*bis* of the Madrid Agreement, relied on by Duca di Salaparuta and mentioned in the order for reference, relating to the alleged incompleteness of the protection established by Regulation No 1493/1999, must be regarded as irrelevant in that regard.

90 Under Article 22(1) of the TRIPS Agreement, 'geographical indications' are indications which identify a product as originating in the territory of a Member of the WTO, or a region or locality in that territory, where a given quality, reputation or other characteristic of the product is essentially attributable to its geographical origin.

91 The Court has already held that, having regard to the nature and general scheme of that agreement, its provisions do not have direct effect. Thus, those provisions are also not such as to create rights upon which individuals may rely directly before the courts by virtue of EU law (judgment of 27 February 2024, *EUIPO* v *The KaiKai Company Jaeger Wichmann*, C-382/21 P, EU:C:2024:172, paragraph 63 and the case-law cited).

92 As regards Article 10bis of the Paris Convention, which prohibits, inter alia, any act capable of creating confusion with the products of a competitor, the rules set out in that article must be regarded as producing the same effects as those produced by the TRIPS Agreement. In that regard, the Court has already held that the rules set out in certain articles of that convention have been incorporated into the TRIPS Agreement, which was concluded by the European Union (see, to that effect, judgment of 27 February 2024, *EUIPO* v *The KaiKai Company Jaeger Wichmann*, C-382/21 P, EU:C:2024:172, paragraph 80 and the case-law cited). More specifically, that agreement provides, in Article 2(1) thereof, that WTO Members, including the European Union, are to comply with Articles 1 to 12 and Article 19 of the Paris Convention in so far as concerns Parts II to IV of that agreement, which cover Articles 9 to 62 thereof.

93 As regards the Madrid Agreement, it follows from Article 3*bis* thereof that the countries to which that agreement applies undertake to prohibit the use, in connection with the sale, display or offering for sale of any goods, of all indications in the nature of publicity capable of deceiving the

public as to the source of the goods. Since that provision is comparable, in essence, to Article 22 of the TRIPS Agreement, it must also be regarded as not having direct effect, since it is not such as to create rights upon which individuals may rely directly before the courts by virtue of EU law.

94 In any event, those provisions of international law are not capable of invalidating the finding that the regime laid down in the second subparagraph of Section F(2) of Annex VII to Regulation No 1493/1999 is complete.

95 Having regard to the foregoing considerations, the answer to the questions referred is that Article 51 of Regulation No 479/2008, Article 118s of Regulation No 1234/2007 and Article 107 of Regulation No 1308/2013 must be interpreted as meaning that Article 43(2) of Regulation No 479/2008, Article 118k of Regulation No 1234/2007 and Article 101(2) of Regulation No 1308/2013 are not applicable to a conflict between a wine name protected under Article 54 of Regulation No 1493/1999 and earlier well-known marks registered for wines and containing words identical to that name; such a conflict must be resolved solely on the basis of the second subparagraph of Section F(2) of Annex VII to Regulation No 1493/1999.

Costs

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

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

Article 51 of Council Regulation (EC) No 479/2008 of 29 April 2008 on the common organisation of the market in wine, amending Regulations (EC) No 1493/1999, (EC) No 1782/2003, (EC) No 1290/2005, (EC) No 3/2008 and repealing Regulations (EEC) No 2392/86 and (EC) No 1493/1999, Article 118s of Council Regulation (EC) No 1234/2007 of 22 October 2007 establishing a common organisation of agricultural markets and on specific provisions for certain agricultural products (Single CMO Regulation) (OJ 2007 L 299, p. 1), as amended by Council Regulation (EC) No 491/2009 of 25 May 2009, and Article 107 of Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products and repealing Council Regulations (EEC) No 922/72, (EEC) No 234/79, (EC) No 1037/2001 and (EC) No 1234/2007,

must be interpreted as meaning that Article 43(2) of Regulation No 479/2008, Article 118k of Regulation No 1234/2007, as amended by Regulation No 491/2009, and Article 101(2) of Regulation No 1308/2013 are not applicable to a conflict between a wine name protected under Article 54 of Council Regulation (EC) No 1493/1999 of 17 May 1999 on the common organisation of the market in wine and earlier well-known marks registered for wines and containing words identical to that name; such a conflict must be resolved solely on the basis of the second subparagraph of Section F(2) of Annex VII to Regulation No 1493/1999.

[Signatures]