In Memoriam

Law and Legal Mentality Between Italy and Germany *In memoriam* Carlo Luigi Ubertazzi

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I. Prof Ubertazzi as a Bridge Between Italy and Germany

Back in 1992 when I first came to the Max Planck Institute for Comparative and International Patent, Copyright and Competition Law in Munich, Professor Ubertazzi was a frequent guest. In fact, he sent most of his PhD students there and actively participated in seminars and discussions. Although most of us were a bit surprised by the way he treated his PhD students – too hierarchical for an Institute whose motto 'Do as you please' was invisibly written over its entrance door – no one doubted Prof Ubertazzi's excellent knowledge of German, his erudite knowledge of German law, culture and mentality.

This was by no means an easy feat, as the Alps are far more than a geographical boundary. Italians and Germans are a bit like men and women: They complement each other well, but understand each other badly. I will not go further into the anecdotal, but rather refer to an essay once written by Tullio Ascarelli – *nullum par elogium* –: *Antigone e Porzia*.[1] Ascarelli in this essay gives a character interpretation of Antigone's refusal to obey Kreon's laws, and of Portia's decision in Shakespeare's *Merchant of Venice*. Ascarelli's view for the latter is that the contract Shylock wants to enforce is valid:

> 'The contrast between the agreement and a moral need which condemns it, is not resolved through the revolutionary act of denying the agreement. The contrast is bypassed, as some would say, through interpretation'.

The subtlety of contractual interpretation is thereby contrasted with a moral requirement, and this tells us much about the difference in legal perception North and South of the Alps. Ascarelli himself is aware of this and lets us know where

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[1] T. Ascarelli, 'Antigone e Porzia' *Rivista internazionale di filosofia del diritto*, 756 (1955). An English translation has been provided by Camilla Crea: T. Ascarelli, 'Antigone and Portia' (1959), *The Italian Law Journal*, 167 (2015). The quotations of Ascarelli's essay have been taken from this translation.

his sympathies lie:

> 'Portia's intelligence, combined with a hint of probabilism and, morally speaking perhaps even ambiguity, is set against what could be defined as Antigone's Calvinist Puritanism.[2] The human triumph of interests, defended through a winning interpretation that presents itself as a remunerable professional activity, is set against the death of Antigone who only asserts the victory of her truth by sacrificing herself'.

Not only Ascarelli, but also Jhering and Kohler dealt with the contract litigated in The Merchant of Venice. There is now an interesting difference in perception between these two German scholars and Ascarelli: Rudolf von Jhering[3] reasons that Shylock 'in secure confidence of his generally recognised right' goes to court and everyone in court seems to agree that the contract is valid. This being so, according to Jhering, the judge was wrong to 'scornfully deny' the enforcement of the verdict, even if it were for the sake of humanity, because 'does an injustice committed in the interest of humanity no longer remain an injustice?'. For Jhering, Shylock, not Portia, is the hero of the play.[4]

Josef Kohler[5] first of all attests Jhering to have 'understood not a toss of Shakespeare's drama', yet also he is very upset about Portia's reasoning:

> 'It is a solid principle of law that whoever confers another the right to do something, must also confer the right to all what it takes to realise this right (…) who rents out a flat must also concede the tenant to use the door and staircase so as to reach the flat'.

According to Kohler, Portia's decision is a denial of justice, a hairsplitting quibble, an overly sophisticated argument. And yet Kohler approves the decision: according to him, it is the task of the judiciary to render a good decision, even with bad reasons. The more so where legal perception has strayed so far from moral perception that the former appears 'a ruin of ancient circumstances that no longer suits our time'. The victory in this case is 'the victory of a refined legal

[2] As we know, Luther was not minded to reform the catholic church 'through interpretation'. Whether this would have been better, is arguable: Germany lost two-thirds of its population in the thirty years war (1618-1648) that pitted Catholics against Protestants.

[3] R. von Jhering, *Der Kampf um's Recht* (Wien: Manz'sche Verlags- und Buchhandlung, 8th ed, 1886), XI-XII. In the seventh edition, he also vehemently citicises Kohler's approach (first published in 1883). For Jhering, Shylock is the hero of the play, because by insisting on his rights, he defends the legal order as such.

[4] The difference in legal perception between Jhering and any Italian is striking. According to Jhering, 'Law is the certainty of enjoyment'. Which Italian would ever endorse such a definition?

[5] J. Kohler, Shakespeare vor dem Forum der Jurisprudenz (Würzburg: Stahel, 1883), 3-9, 72-73, 88; Id, Nachwort zu Shakespeare vor dem Forum der Jurisprudenz (Würzburg: Stahel, 1884), 1-2.

conscience'. Kohler believes in the evolutionary forces of law driven by legal perception and put into effect by the judiciary. For Kohler, the Merchant of Venice is one of the turning points in legal history, for Jhering a squalor and for Ascarelli an example of a badly drafted contract.[6]

Even to an Italian scholar as great as Ascarelli, the resort to fundamentals was as bewildering as to the German scholar Josef Kohler the resort to the fifty shades of grey, the *sfumato*, the (mere) interpretation of a contractual clause, 'transforming it and thereby adapting it to an ever-changing equilibrium of conflicting forces and evaluations. An ongoing re-creation'.

For a people like the Italians that for centuries has been occupied by foreigners (Saracens, Normans, Byzantines, French, Spanish, Germans, Austrians, you name it), the art of solving problems by sidestepping them becomes a necessity of survival. The only constant is the unchangeable of change.[7]

II. The Importance of The Fundamental

For as much as I admire Tullio Ascarelli, there is room for the fundamentals in addition to the realm of skilful interpretation. The elegance of Ascarelli's *ars interpretatorum* is as much part of the law as Josef Kohler's recognition that legal interpretation must be based on fundamental principles that draw their justification from what is commonly accepted and acceptable: cutting the flesh of debtors in default no longer was.

Even further, the elegance of interpretation may at times even distract the view from issues of fundamental importance. When looking at interests that are of fundamental commercial importance to Italy, one area that comes to mind are geographical indications. Fundamental because the interest in their protectionis not limited to the national territory. No coincidence then that Italy is a member to the Madrid Arrangement for the Suppression of Misleading Indications,[8] hosted negotiations for the Stresa Agreement[9] and sent her most reputed legal scholar – Tullio Ascarelli – to head the negotiations for the

[6] With all due respect to Ascarelli, if he was correct, why would Shylock be punished and lose all his belongings? For bad drafting skills? Kohler appears the most modern scholar: his reasoning could equally apply to such turning points in legal history as the Nuremberg trials that crystallised the crime of genocide out of a moral imperative which provides law with its ultimate justification: 'My Lords, I do not think so ill of our jurisprudence as to suppose that its principles are so remote from the ordinary needs of civilised society and the ordinary claims it makes upon its members as to deny a legal remedy where there is so obviously a social wrong': *Donoghue* v *Stevenson* (1932) UKHL 100 (per Lord Atkin).

[7] Which may be the same as G. Tomasi di Lampedusa's *Il Gattopardo*: 'If we want that everything remains as is, everything has to change'.

[8] Madrid Arrangement for the Repression of False or Deceptive Indications of Source on Goods (1891), to which Italy acceded in 1951.

[9] Stresa Agreement for the Indication of Cheeses 1 June 1951. The agreement entered into force on 8 July 1953.

conclusion of the Lisbon Arrangement for the Protection of Appellations of Origin.[10] In EU negotiations of bilateral and multilateral free trade agreements, proprietary protection of geographical indications has often featured prominently on Italy's insistence.[11]

Different from France, Italian denominations of origin lead an often precarious existence outside national borders. They easily get lost in translation (does 'Parmigiano Reggiano' translate as 'Parmesan'? Why is the indication not simply called 'Parmigiano'? And what about 'Grana Padano'? Also to be protected as 'Parmesan'?), appear contradictory (how can 'Montepulciano' be geographical if in Italy itself, there is an indication 'Montepulciano d'Abruzzo'?), or, *horribile dictu*, de-localised (Prosecco makers from Valdobbiadene are at pains to point out that their fizz is *not* from Prosecco[12] – and is there such place, anyway?). One could therefore think that it may be in the best interest of Italy to do her utmost to protect foreign denominations of origin at home so that Italian denominations be protected abroad. But not so:

- Contrary to the clear wording of Art 6 Lisbon Arrangement,[13] protection was denied for the Czech indication 'Pilsener Urquell' because Art 6 should be considered a mere presumption[14] (1996);

- Contrary to international and European law, beer (in this case 'Budweiser' from Budweis) was considered a product incapable of protection as a geographical indication (2002).[15]

[10] The 1959 Lisbon Arrangement for the Protection of Appellations of Origin remains the most important international agreement for the protection of geographical indications. Under the Agreement, Italy alone has protected one hundred and seventy five indications. The then president of the Fourth Commission, S. Takahashi, ceded presidency to the then vice-president T. Ascarelli, as Japan was not interested in negotiating an agreement for the protection of appellations of origin: *Actes de la Conférence Réunie a Lisbonne*, du 6 au 31 octobre 1958, (Geneva 1963), 830-849.

[11] A. Moerland, Why Jamaica wants to protect Champagne: Intellectual Property Protection in EU Bilateral Trade Agreements (Oisterwijk: Wolf Legal Publishers, 2013).

[12] 'The area of production of Valdobbiadene Prosecco Superiore D.O.C.G. Extra Dry extends over the hill country of the Treviso province, encompassing the cities of Conegliano and Valdobbiadene' available at https://tinyurl.com/yaucbr9r (last visited 31 December 2022).

[13] Art 6 Lisbon Arrangement reads: 'An appellation which has been granted protection in one of the countries of the Special Union pursuant to the procedure under Article 5 cannot, in that country, be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin'. The negotiating history of the Agreement show that this provision was of great importance to the delegations and should be put into terms as clear as possible: 'Consideratons of the Preparation Committee' *La Propriété Industrielle*, 239 (1956): 'Pour exclure toute transformation en dénomination générique d'une appellation d'origine protégée'. Protocol of the Conference itself: 'La Commission estime necessaire de régler d'une manière explicite ce cas. En effet, une exception à la règlre fondamentale qu'une appellation d'origine une fois enregistrée ne pourrait jamais être considérée comme générique dans les pays de l'Union particulière pourrait se presenter'. ('Actes' above n 10, 838).

[14] Corte di Cassazione 28 November 1996 no 10587, *Rivista di diritto industriale*, II, 144-145 (1997).

[15] Corte di Cassazione 21 May 2002 no 13168, 34 *International Review of Intellectual*

- Finally, the Italian Supreme Court denied the Bavarian Brewery Association protection against a third party registration of 'Bavaria' for beer originating in the Netherlands (2012)[16] without having regard to the fact that such registration most likely causes confusion amongst Italian consumers, millions of whom have been to the Oktoberfest that is overlooked by a very sizable statue of the Bavaria: after all, according to Art 14, para 1, lett *b) Codice della proprietà industriale* (IPC),signs that can mislead the public as to the geographical origin of goods (considered as a relevant aspect of consumer choice) cannot be registered or are prone to subsequent revocation.

The Bavarian Brewery Association in the above-mentioned case was represented by Prof Ubertazzi. He had understood that Bavaria for Bavarians carried the same importance as Chianti for the Tuscans. It concerned cultural identity. The fundamentals. Yet the fundamental was lost in the above cases, and, worse perhaps, this was not even noticed.

And while the fundamental, the *chiaroscuro*, was lost, at least for the indication Budweiser, the *sfumato* of skilful interpretation somehow changed the picture: While the Supreme Court in 2002 decided that the plaintiff (a US company) based on a handful of journals circulated in Italy in the 1930s had obtained an unregistered, well-known mark for the term 'Budweiser', the same court ten years later (2013) decided that this well-known, unregistered mark had been misleading all along in regard of its geographical provenance,[17] another five years later that this mark, even though misleading, still gave a right to use (2018),[18] and, in 2021 and without being in contradiction with the earlier verdict, that the right to use a misleading mark was limited to instances where it was not misleading.[19] Someone not initiated in the rites of the 'ever changing equilibrium of contrasting interests and evaluations' may be pardoned for the thought that the court has simply gone haywire.

III. Law Comparison as an Intercultural Dialogue

Law as a discursive science derives its legitimacy from dialogue. Since the ten commandments, no law has dropped from the sky as an absolute truth, although law students often get a different impression when listening to their professors. Understanding different laws, legal cultures and legal perceptions is

Property and Competition Law, 676 (2003) – *Budweiser III*. The case had other irregularities, too, see my comment: C. Heath, 'Il caso Budweiser' *Rivista di diritto industriale*, II, 77 (2004).

[16] Corte di Cassazione 20 September 2012 no 15958, 46 *International Review of Intellectual Property and Competition Law*, 881 (2015) – Bavaria.

[17] Corte di Cassazione 10 September 2013 no 21023, 46 *International Review of Intellectual Property and Competition Law*, 891 (2015) – Budweiser V.

[18] Corte di Cassazione 1 February 2018 no 2499, available at www.dejure.it.

[19] Corte di Cassazione, 30 November 2021 no 37661, 71 *Gewerblicher Rechtsschutz und Urheberrecht - Internationaler Teil* (2022), 1067 with comment by C.Heath and N. Rampazzo.

a first step of understanding one's own.

Professor Ubertazzi, who regularly sent his disciples to Germany for research and cultural understanding, was aware of the importance to bridge the linguistic and cultural gap between Italy and Germany. Those who follow him are hereby warmly encouraged.