IN THE HEARINGS AND MEDIATION DEPARTMENT OF THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE

[2022] SGIPOS 11

Geographical Indication Application No. 50201900057U

IN THE MATTER OF A REQUEST FOR A QUALIFICATION TO GEOGRAPHICAL INDICATION APPLICATION BY

FONTERRA BRANDS (SINGAPORE) PTE. LTD.

… Requester

AND OPPOSITION THERETO BY

CONSORZIO DEL FORMAGGIO PARMIGIANO REGGIANO

… Proprietor / Opponent

GROUNDS OF DECISION

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Fonterra Brands (Singapore) Pte. Ltd.
v
Consorzio del Formaggio Parmigiano Reggiano

[2022] SGIPOS 11

Geographical Indication Application No. 50201900057U
Principal Assistant Registrar Sandy Widjaja
15 March 2022

12 July 2022

Principal Assistant Registrar Sandy Widjaja:

Introduction

1 The new Geographical Indications Act 2014 ("Act") came into force on 1 April 2019[1] and the new Geographical Indications Registry ("Registry")[2] commenced operations on the same date. With this new Registry it is possible to apply for the registration of a geographical indication.[3]

2 Upon registration, in addition to the relevant geographical indication itself, protection may also extend to translations of the geographical indication. However, there is *no* need to specify any possible translation at the point of application for registration. The Act's approach to a "translation" can be

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[1] This is also the version which is applicable as at the date of the request for qualification, that is, 16 September 2019 (see more below).

[2] See Part IV of the Act.

[3] See definition in section 2 of the Act:

> "geographical indication" means any indication used in trade to identify goods as originating from a place, provided that —
>
> (a) the place is a qualifying country or a region or locality in a qualifying country; and
>
> (b) a given quality, reputation or other characteristic of the goods is essentially attributable to that place…

gleaned from the *Public Consultation on Changes to be made to the Geographical Indications Act and the Trade Marks Act to Enhance Singapore's Regime for the Protection of Geographical Indications,* prepared by the Intellectual Property Office of Singapore on 1 November 2013 ("IPOS Public Consultation"):[4]

> [4.4] Singapore will *protect translations of registered GIs on a case-by-case basis*, thus applicants *will not be required to specify* which translations of their GIs they wish to protect. Instead, *if a GI is registered* on the GI Registry, and *users of the registered GI wish to take an action against another party* using what is *purportedly a translation* of their GI, the courts will be empowered to determine the validity of the argument.

[Emphasis in italics mine]

3 Any issues pertaining to the protection of any possible translations of a geographical indication can be dealt with via the request for qualification process:[5]

> [4.14] Separate from the opposition process, it is proposed that there will be a process for third parties to request for applicants to disclaim certain elements of the GI for which registration is sought…It is envisioned that, *similar to an opposition hearing, such a disclaimer request process* may include hearings where both the requester and applicant for the registration of the GI can provide arguments and evidence for their case.
>
> [4.15] An example where such a *disclaimer request process* could be useful would be where third parties believe that a term, thought to be a possible translation of the GI to be registered, is actually a generic term and a common name for certain goods or services**.** *As translations of registered GIs will be protected on a case-by-case basis (and may not even be sought at the outset) as explained in paragraph 4.4, it may not be clear what translations of the GI will be protected at the point of the application of the registration of the GI.* By allowing third parties to request for disclaimers of protection, both the applicant and interested third party can achieve clarity on whether specific terms will or will not be available for use by third parties.

4 More elaboration below.

5 IPOS Public Consultation at [4.14] and [4.15]. More elaboration below.

[Emphasis in italics mine]

Background facts

4 As alluded to briefly above, this proceeding concerns an opposition to a request for qualification of the registered Geographical Indication No. 50201900057U for "Parmigiano Reggiano" for "cheese"[6] ("Registered GI") filed in the name of Consorzio del Formaggio Parmigiano Reggiano ("Registrant / Opponent"). The Registered GI was formally registered on 22 June 2019.[7]

5 The Registrant / Opponent is a voluntary consortium of Parmigiano Reggiano cheese producers that was (through its predecessor) established in 1934 in Italy. The Registrant / Opponent, which is established as a non-profit organisation in Italy, is tasked by the Italian Ministry of Agricultural, Food and Forestry Policies with the functions of protection, promotion, enhancement, consumer information and general care of the interests relating to "Parmigiano Reggiano" cheese. [8]

6 Fonterra Brands (Singapore) Pte Ltd ("Requester"), is a wholly owned subsidiary of Fonterra Co-operative Group Limited ("Fonterra").[9] Fonterra is a New Zealand based multinational co-operative company owned by New

6 For the full details, see Form GI 1 dated and lodged on 23 April 2019.

7 As per the records on IP^{2}SG (then) now known as IPOS Digital Hub ("IDH").

8 Registrant / Opponent's written submissions filed on 16 February 2022 ("OWS") at [2] and Registrant / Opponent's first evidence dated 23 December 2020 at [7] and [8] (see below).

9 Requester's evidence dated 24 June 2021 at [17] (see below).

Zealand-based farmers which exports a wide range of dairy products to over 140 countries.[10]

7 Fonterra as a co-operative, is owned by its 10,000 farmer shareholders. It is involved in the collection, manufacture and sale of milk and milk-derived products. Fonterra's products account for approximately 30% of the world's dairy exports, and it has a revenue of NZ$17.2 billion.[11]

Procedural history

8 On 16 September 2019,[12] Requester[13] filed a request for qualification in respect of the Registered GI, pursuant to section 46(1)(b) read with section 46(2)(b)[14] of the Act (see above),[15] on the basis that the term "Parmesan" is not a translation of the Registered GI.[16] Specifically, the Requester sought the qualification that:

10 Requester's written submissions filed on 15 February 2022 ("RWS") at [4] and Requester's evidence dated 24 June 2021 at [14].

11 Requester's evidence dated 24 June 2021 at [15].

12 There is an error in the Registrar's summary decision *Consorzio del Formaggio Parmigiano-Reggiano v Fonterra Brands (Singapore) Pte Ltd* [2022] SGIPOS 7 ("Summary Decision") at [11] in that while the document was dated 13 September 2019, it was only lodged on 16 September 2019.

13 In the same vein, there is an error in the Summary Decision at [11] to the effect that the Requester has been defined as *Fonterra Co-operative Group Limited* when it should be its subsidiary, *Fonterra Brands (Singapore) Pte Ltd.*

14 See [3] of the Requester's Statement of Grounds dated 13 September 2019 and lodged on 16 September 2019 ("RSoG").

15 As alluded to above, the relevant version which is applicable is that as at the date for the request for the qualification, that is, 16 September 2019 ([10] OWS).

16 See [3] RSoG.

> *The protection of the geographical indication "PARMIGIANO REGGIANO" should not extend to the use of the term "Parmesan"* ("Request for Qualification").[17]

[Emphasis in italics mine]

9 On 12 November 2019, the Registry informed the Requester that the Request for Qualification had been published in the Geographical Indications Journal No. 13/2019 for opposition purposes.[18]

10 On 12 March 2020, the Registrant / Opponent filed the present opposition on the basis that section 46(2)(b) is not established[19] and that "Parmesan" is indeed a translation of *"PARMIGIANO REGGIANO"* ("Opposition to the Request for Qualification").[20]

11 The Requester filed its counter-statement on 5 June 2020. The Registrant / Opponent filed its evidence on 28 December 2020. The Requester filed its evidence on 25 June 2021. The Registrant / Opponent filed its evidence in reply on 25 October 2021. Thereafter, the Registrant / Opponent also filed supplementary evidence on 24 November 2021.

12 Following the close of evidence, a Pre-Hearing Review was held on 21 December 2021 and the matter was set down for a hearing on 15 March 2022. The Registrar issued her summary decision, *Consorzio del Formaggio Parmigiano-Reggiano v Fonterra Brands (Singapore) Pte Ltd* [2022] SGIPOS 7 on 18 April 2022.

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17 Part 5 of Form GI 2 dated 13 September 2019 and lodged on 16 September 2019.

18 Rule 40(4) of the Geographical Indication Rules 2019, again also the version which is relevant as at 16 September 2019 ("Rules").

19 See [7] of the Registrant / Opponent's opposition to the request for qualification (Form GI 13) Statement of Grounds dated and lodged on 12 March 2020 ("OSoG").

20 See [9] OSoG.

13 On 5 May 2022, the Requester applied for the full grounds of decision under Rule 37 of the Geographical Indication Rules 2019 ("Rules"). On 6 May 2022, the Registrant / Opponent made the same application.

14 These grounds of decision are issued pursuant to the requests.

Preliminary points

15 The relevant sections of the Act provide as follows:

> 46.—(1)(b) Any person may, at any time after the date of the publication of an application for registration under section 45, request that a qualification, of the rights conferred under this Act in respect of a registered geographical indication, be entered in the register…in relation to any term which may be *a possible translation of the geographical indication.*
>
> (2) The request under subsection (1) may only be made on *either or both* of the following grounds:
>
> (a) that one or more of the *exceptions referred to under Part III applies*;
>
> (b) that the *term referred to in subsection (1)(b) is not a translation of the geographical indication.*
>
> 11…(c)[21] Section 4[22] shall not apply to…the use of a geographical indication in relation to any goods or services which is identical with the *common name* of the goods or services in Singapore…

[Emphasis in italics mine]

16 For clarity, the above version is the relevant version as at 16 September 2019 ("Relevant Date"), which is the date when the Request for Qualification was lodged by the Requester.

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21 Section 11 falls under Part III of the Act.

22 Section 4 sets out certain uses of a geographical indication which may amount to an infringement.

17 In addition, it is *crucial* to note that, in this case, the request for qualification is brought under section 46(1)(b) read with section 46(2)(b) of the Act *only*.[23]

18 The Requester did not plead that the term "Parmesan" is or has become generic such that protection of the geographical indication should not extend to this term pursuant to section 46(1)(b) read with section 46(2)(a), which is in turn read with section 11(c) of the Act.

19 In light of the above, it is not necessary for me to decide (more below) whether or not the term "Parmesan" is or has become generic.

Registrant's / Opponent's evidence

20 The Registrant /Opponent's evidence comprises the following:

(a) Statutory Declaration of Ms Nicola Bertinelli, President of the Registrant / Opponent ("Ms Bertinelli") dated 23 December 2020 ("Registrant / Opponent's 1st SD");

(b) Statutory Declaration of the same Ms Bertinelli dated 20 October 2021 ("Registrant / Opponent's 2nd SD"); and

(c) Supplementary Statutory Declaration of the same Ms Bertinelli dated 23 November 2021.

23 See [3] RSoG.

Applicant's evidence

21 The Applicant's evidence comprises a statutory declaration of Mr Goh Yuen Por Stanley, Director of the Requester dated 24 June 2021 ("Requester's SD").

Applicable law and burden of proof

22 This is one issue which I must determine, that is, who bears the burden of proof to establish whether a particular term is or is not a translation of a geographical indication.

23 As submitted by the Requester, sections 103 and 104 the Evidence Act 1893 ("EA") provide:[24]

> 103. — (1) Whoever *desires* any court to give judgment as to any legal right or liability, *dependent* on the existence of facts which the person asserts, *must* prove that those facts exist…
>
> 104. The burden of proof in a suit or proceeding lies on that person who would *fail* if *no* evidence at all were given on either side.

[Emphasis in italics mine]

24 The Requester further elaborated as follows, referring to the Court of Appeal's decision in *Cooperatieve Centrale Raiffeisen-Boerenleenbank BA v Motorola Electronics* [2011] 2 SLR 63 (at [30]), which in turn quoted *Britestone Pte Ltd v Smith & Associates Far East, Ltd* [2007] 4 SLR(R) 855 at [58]:[25]

> [58] The term 'burden of proof' is more properly used with reference to the obligation to prove. There are in fact two kinds of burden in relation to the adduction of evidence. The first, designated the *legal burden of proof*, is, properly speaking, a burden of proof, for it describes *the obligation to persuade the trier of fact that, in view of the evidence,*

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24 See [19] RWS.

25 See [22] RWS.

> *the fact in dispute exists*…The second is a burden of proof only loosely speaking, for it falls short of an obligation to prove that a particular fact exists. It is more accurately designated the evidential burden to produce evidence…[W]henever it operates, the failure to adduce some evidence…will mean a failure to engage the question of the existence of a particular fact or to keep this question alive.

[Emphasis in italics mine]

25 As alluded to earlier, the Act's approach to a "translation", as gleaned from the IPOS Public Consultation, is as follows (replicated here for ease of reference):[26]

> [4.4] Singapore will *protect translations of registered GIs on a case-by-case basis*, thus applicants *will not be required to specify* which translations of their GIs they wish to protect. Instead, *if a GI is registered* on the GI Registry, and *users of the registered GI wish to take an action against another party* using what is *purportedly a translation* of their GI, the courts will be empowered to determine the validity of the argument.
> …
>
> [4.14] Separate from the opposition process, it is proposed that there will be a process for third parties to request for applicants to disclaim certain elements of the GI for which registration is sought…It is envisioned that, *similar to an opposition hearing*, such a *disclaimer request process* may include hearings where both the requester and applicant for the registration of the GI can provide arguments and evidence for their case.
>
> [4.15] An example where such a *disclaimer request process* could be useful would be where third parties believe that a term, thought to be a possible translation of the GI to be registered, is actually a generic term and a common name for certain goods or services. *As translations of registered [GI]s will be protected on a case-by-case basis (and may not even be sought at the outset) as explained in paragraph 4.4, it may not be clear what translations of the GI will be protected at the point of the application of the registration of the GI.* By allowing third parties to request for disclaimers of protection, both the applicant and interested third party can achieve clarity on whether specific terms will or will not be available for use by third parties.

[Emphasis in italics mine]

[26] Requester's bundle of authorities ("RBoA") at Tab 11, pages 226 and 229.

A contextual reading of [4.14 – 4.18] of the IPOS Public Consultation[27] will reveal that the "disclaimer request process" is one and the same as the process for a request for qualification.

26 I agree with the Requester that the above "shows a clear intention on the part of the draftsman that the registration of a [geographical indication] will *not equate to automatic protection* of any term which the user alleges is a translation of the [geographical indication]" (emphasis in italics mine).[28]

27 Applying section 103(1) of the EA, "[i]t remains for the user of the registered [geographical indication] *to establish* that the term in question is a valid translation of the said [geographical indication]" (emphasis in italics mine),[29] such that, the legal burden of proof in this opposition lies on the Registrant / Opponent.

28 This is supported by an application of section 104 of the EA. Having regard to Rule 40(4) and (5) of the Rules. Specifically, rule 40 reads:

> 40.—(1) A person (called in this Part the requestor) desiring to request for a qualification of the rights conferred under the Act (called in this Part a qualification of rights) to be entered in the register under section 46(1) of the Act, *may make the request to the Registrar in Form GI2*.
>
> (2) The requestor must provide to the Registrar such evidence in respect of the request as the Registrar may require.
> …
>
> (4) Where the Registrar *proposes to allow the request,* the Registrar must *publish* the proposed qualification of rights in the Geographical Indications Journal.
>
> (5) Where no *notice of opposition* has been filed within the period mentioned in rule 41(1), and the Registrar is satisfied that either or

27 RBoA at Tab 11, pages 229 - 230.

28 See [25] RWS.

29 See [25] RWS.

> both of the grounds in section 46(2) of the Act is or are made out, the Registrar *must…enter the qualification of rights in the register.*

[Emphasis in italics mine]

29 As indicated above, "if no evidence at all were given on either side"[30] the Registrant / Opponent "would *fail*"[31] since "the Registrar must…enter the qualification of rights in the register".[32]

30 For clarity, I am of the view that at this stage, there is no *additional* requirement for the Registrar to be satisfied "that either or both of the grounds in section 46(2) of the [Act] is or are made out".[33] I am of the view that this is simply a reference to Rule 40(2) which has been satisfied since the Request for Qualification has been published.[34]

31 In light of the above, I am of the view that the burden of proof in this case falls on the Registrant / Opponent.

Ground of Opposition under section 46(1)(b) read with section 46(2)(b)

32 Section 46 of the Act provide as follows:

> 46.—(1)(b) Any person may, at any time after the date of the publication of an application for registration under section 45, request that a qualification, of the rights conferred under this Act in respect of a registered geographical indication, be entered in the register…in relation to any term which may be *a possible translation* of the *geographical indication.*
>
> (2)(b) The request under subsection (1) may only be made on…the following grounds…that the term referred to in subsection (1)(b) is *not a translation* of the *geographical indication.*

30 Section 104 EA (above).

31 Section 104 EA (above).

32 Rule 40(5) of the Rules (above).

33 Rule 40(5) of the Rules (above).

34 See [11] – [14] OWS.

[Emphasis in italics mine]

Meaning of "translation" in section 46(1)(b)

33 At this juncture, it is apposite to make a few comments in relation to the above provisions.

34 *Firstly*, I agree with the Registrant / Opponent that what is required is a translation of the "geographical indication" as a whole. This is in contrast to "any name contained in the geographical indication" as provided in section 46(1)(a):[35]

> 46.—(1)(a) Any person may, at any time after the date of the publication of an application for registration under section 45, request that a qualification, of the rights conferred under this Act in respect of a registered geographical indication, be entered in the register…in relation to *any name contained in the geographical indication…*

[Emphasis in italics mine]

Thus, what is required is a translation of the Registered GI that is, "Parmigiano Reggiano".[36]

35 The Registrant / Opponent took issue with the Requester's pleading that it is unclear.[37] While it certainly helps if there is consistency in the related documents, pleadings, evidence and otherwise, what is crucial is Part 5 of Form GI 2 (form for a *Request for Qualifications of Rights*), which provides (above and replicated here for ease of reference):

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35 OWS at [18] - [19].

36 See above.

37 OWS at [21].

> *The protection of the geographical indication "PARMIGIANO REGGIANO" should not extend to the use of the term "Parmesan".*[38]

36 *Secondly*, I also agree with the Registrant / Opponent that all that is needed is *a translation* of the geographical indication. There is *no* requirement that the possible translation be the *only* translation.[39]

37 *Thirdly*, the above definition does *not* limit the translation to a translation into the English language. There is nothing in section 46 which requires the translation of the geographical indication to be an *English* translation.

38 I should add, out of an abundance of caution, that this is outside the purview of Rule 4(2)(a) and (b) of the Rules, which pertains to *working documents* and mandates that "every document filed at the [Registry] must be in *English*; or where the document is not in English, must be accompanied by an English translation of the document" (emphasis in italics mine).[40]

39 Returning to the main issue of what is required of a "translation", I agree with the Registrant / Opponent that based on a purposive interpretation of Section 46(2)(b) of the Act, "translation" refers simply to the question of whether words have the same meaning in a different language.[41]

40 The relevant provisions in section 9A of the Interpretation Act 1965 read:

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38 See above.

39 OWS at [45].

40 See [27] OWS.

41 See [26] OWS.

> 9A.—(1) In the interpretation of *a provision of a written law,* an interpretation that would *promote the purpose or object underlying the written law* (whether that purpose or object is expressly stated in the written law or not) shall be preferred to an interpretation that would not promote that purpose or object.
>
> (2)(a) … in the interpretation of *a provision of a written law*, if any material *not forming part of the written law* is capable of assisting in the ascertainment of the meaning of the provision, consideration may be given to that material…to confirm that the meaning of the provision is the *ordinary meaning* conveyed by the text of the provision taking into account its context in the written law and the purpose or object underlying the written law…
>
> (3)(a) Without limiting the generality of subsection (2), the material that may be considered in accordance with that subsection in the interpretation of a provision of a written law shall include…all matters not forming part of the written law[42] that are *set out in the document containing the text of the written law as printed by the Government Printer…*

[Emphasis in italics mine]

41 In this regard, the plain meaning of "translation" is simply the "*action of converting from one language to another"*[43] or the "*rendering from one language to another"*.[44]

42 As submitted by the Registrant / Opponent, the Court of Appeal has previously considered dictionary meanings to shed light on the ordinary meaning conveyed by the text of the provision (see *Bi Xiaoqing v Chinese Medical Technologies, Inc and another* [2019] SGCA 50, at [38] and [39]):[45]

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42 This is defined as "…*all Acts*, Ordinances and enactments by whatever name called and subsidiary legislation made thereunder for the time being in force in Singapore" (section 2 of the Interpretation Act 1965).

43 See [39(a)] OWS; Registrant / Opponent bundle of authorities ("OBoA") at Tab 20, page 451

44 See [39(b)] OWS; OBoA at Tab 18, page 444.

45 See [39] OWS.

> [38] …the first step in the court's approach towards the *purposive interpretation* of statutes is to ascertain the possible interpretations of the text. This in turn entails an analysis of the *ordinary meaning* of the "words of the legislative provision" (*Tan Cheng Bock* at [38]). Put differently, an "interpretation" of a provision cannot be plucked out of the air, without being grounded in the actual words used in the provision…
>
> [39] We did not, however, accept that the *ordinary meaning* of "injunction" would naturally carry such a specific exclusion[46] *Black's Law Dictionary* (Bryan A Garner ed) (Thomson Reuters, 10th Ed, 2014) *defines* "injunction" as "[a] court order commanding or preventing an action" (at p 904). This seemed to us to be *a fair way* to put the ordinary meaning of "injunction".

[Emphasis in italics mine]

43 Some examples of dictionaries previously referred to by the Courts as authoritative sources for the meaning of words in the English language are as follows:

(a) *Chua Hock Soon James v Public Prosecutor and other appeals* [2017] SGHC 230 at [188]):[47]

> [188]…it becomes apparent that HIN had "promoted" the GEP.[48] Its provision of financial services through its bank account amounts to, at the very least, an act of *engaging* in the GEP. One *legal dictionary* defines the verb "engage" as "to employ or *involve* oneself …" [emphasis added] (see *Black's Law Dictionary* (Bryan A Garner ed-inchief) (Thomson Reuters, 10th Ed, 2014) at p 646). *A similar definition is found in the Merriam-Webster Dictionary* where "engage in" is stated as either "to do (something)" or "to cause (someone) to take part in (something)"…

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46 That is, excluding injunctions in aid of foreign court proceedings (see [38] of *Bi Xiaoqing v Chinese Medical Technologies, Inc and another* [2019] SGCA 50) at OBoA Tab 5, page 41.

47 See [40] OWS; OBoA at Tab 6, page 140.

48 This refers to the impugned scheme in question in that case, namely, the Global Edupreneur Program (see OBoA at Tab 6, page 82).

(b) *Saravanan Chandaram v Public Prosecutor and another* [2020] SGCA 43, at [91]:[49]

> [91] In assessing which of these possible interpretations is the correct one, we begin by determining the ordinary meaning of the words in the statutory definition of "cannabis mixture" (see *Tan Cheng Bock* at [38]). The *Oxford English Dictionary* (Oxford University Press, 2nd Ed, 1989) defines "mixture" as a "[m]ixed state of condition; coexistence of different ingredients or of different groups of classes of things mutually diffused through each other" and "[a] product of mixing; a complex unity or aggregate (material or immaterial) composed of various ingredients or constituent parts mixed together"…
>
> [Emphasis in italics mine]

44 Support can also be found from a contextual reading of the ***Act***, including section 84(2)(d), which states that "rules may make provisions requiring and regulating the *translation* of documents and the filing and authentication of any *translation*" (emphasis in italics mine).[50]

45 In sum, as submitted by the the Registrant / Opponent,[51] the issue of "translation" focuses on how the Registered GI, that is, the word "Parmigiano Reggiano", is converted from its original language (i.e. Italian) into "Parmesan" (in English or otherwise). This is the central inquiry under Section 46(2)(b) of the Act.

"Parmesan" is a translation of "Parmigiano Reggiano"

46 In this regard, the Registrant / Opponent has provided evidence of dictionary entries as follows:[52]

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49 See [40] OWS; OBoA at Tab 10, page 249.

50 See [27] OWS.

51 See [41] OWS.

52 See [43(b) and (c)] OWS.

(a) In the Collins Dictionary, "Parmigiano" is stated to be "another name for Parmigiano Reggiano". "*Parmigiano Reggiano*" in turn is defined as "another name for *Parmesan cheese*" in English (emphasis in italics mine);[53]

(b) In the Oxford English Dictionary, "Parmigiano" refers to "Parmesan cheese".[54] Since "Parmigiano" is another name for "Parmigiano Reggiano" (above at item (a)), therefore, "Parmigiano Reggiano" would also refer to "Parmesan cheese".

(c) In the Larousse Italian-French Dictionary, "Parmigiano" is defined as "*Parmigiano (Reggiano)" or "Parmesan m"* in French.[55]

[Emphasis in italics mine]

47 The Registrant / Opponent also made several other submissions to buttress its argument that "Parmesan" (in English or otherwise) is a translation of "Parmigiano Reggiano", but I do not think it is necessary for me to rely on them. For example:

(a) decisions from foreign jurisdictions. They are clearly not binding on me;[56]

53 Registrant / Opponent's 2nd SD, page 44, Exhibit NB-17.

54 Registrant / Opponent's 2nd SD, page 59, Exhibit NB-19.

55 Registrant / Opponent's 2nd SD, page 55, Exhibit NB-18.

56 See OWS at [50]. The Requester relied on a later decision where Advocate General Léger expressed the same opinion (see *Commission of the European Communities v Germany* [2008] E.T.M.R. 32 *("EC v Germany")*, at [AG46]) that "given the historical and etymological evolution of the designation, it could be considered that "Parmesan" was the "faithful" rather than the literal translation of the [protected designation of

(b) the Explanatory Statement to the Geographical Indications (Amendment) Bill No. 4/2020 ("GI Amendment Bill").[57] Documents relating to *subsequent* amendments to the Act, *may not necessarily* assist. In any event, the Requester also relied on Hansard, in the Second Reading speech in relation to the same bill, with regard to a similar issue, and I have addressed it below;[58] and

(c) Similarly, Decision No. 2/2020 of the EU-Singapore Trade Committee of 27 April 2020 clearly only applies to qualification of rights requests made *on or after 21 November 2019.*[59] There surely must be a reason for the *staged* implementation of the different processes.

48 Returning to the Registrant / Opponent's reliance on dictionary entries to augment its submissions that "Parmesan" refers to "Parmigiano Reggiano", the Requester submitted that the Registrar "should not give weight to the dictionary references cited by the [Registrant / Opponent] as the [Registrant / Opponent] has not shown the relevance of these terms in Singapore".[60] The Requester relied on *Courts (Singapore) Pte Ltd v Big Box Corporation Pte Ltd* [2018] 5 SLR 312 ("Big Box").

49 However, I am of the view that the current case can be distinguished from Big Box. Specifically, Justice George Wei provided at [70]:

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origin] and that the names "Parmigiano" or "Parmesan" and "Parmigiano Reggiano" were interchangeable or equivalent". (See RBoA at Tab 7, page 77).

[57] OWS at [37].

[58] RWS at [35] – [36].

[59] OWS at [88] - [89] and Requester's SD at [22].

[60] At [55] RWS.

> [70] I am of the view that the IP Adjudicator was correct in coming to his conclusion that the definitions did not assist or advance the Applicant's case. The Oxford online dictionary definition makes clear that the definition provided was "*North American informal*". There is nothing to suggest that the definition had entered the vernacular in Singapore by the Application Date…

[Emphasis in italics mine]

50 In the current case, it is clear from the Collins Dictionary that "*Parmigiano Reggiano*" in *British English* is "another name for *Parmesan cheese*" (emphasis in italics mine).[61] Singapore being a former colony of the United Kingdom adopts (British) English as the official working language.[62] This being so, I am of the view that the dictionary entries above *can* and *do* reflect the understanding of the consumer in the *local* context.

51 The Requester countered the Registrant / Opponent's reliance on dictionary entries as follows.

52 The Requester submitted that there is a need for a literal rather than a faithful translation.[63] A literal translation is simply a word for word translation. On the other hand, a faithful translation captures the essence of the word / phrase.

53 For example, in Bahasa Indonesia, when someone says "terima kasih", a literal translation is "receive give" while a faithful translation is "thank you". In the same vein, when someone says "sama sama" in response to "terima kasih", the literal translation is "same same" while a faithful translation is

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61 Registrant / Opponent's 2nd SD, page 44, Exhibit NB-17.

62 See Rule 4(2)(a) and (b) of the Rules, above.

63 RWS at [34].

"welcome". In my view, it is obvious from the above that a faithful translation would be more accurate and thus *preferred*.[64]

54 The Requester argued that a literal translation is required on the basis of the comments of Senior Minister of State for Law Mr Edwin Tong (as he then was) ("Minister Tong") in the Second Reading of the GI Amendment Bill, in relation to variant:[65] [66]

> A variant of a GI can be a translation, or a transliteration, or any other variation of the indication constituting the GI…Say, for example, that oranges grown on Pulau Ubin are known to bear a unique and highly-prized sweet and sour quality attributable to the natural environment of Pulau Ubin, and such oranges are known by the Chinese characters 乌敏橙 – in Chinese – oranges…So let me give you the different ways in which it could be referred to. For example, they may be referred or identified in Hanyu Pinyin as "Wu Min Cheng", which is a transliteration. Or they may be also known as "Ubin Orange", which is a translation of the words in Chinese. *They could also be called "Pulau Ubin Orange", which is neither a translation nor a transliteration.* All of these can be variants of a GI and they can be registered.

[Emphasis in italics mine]

55 It is perfectly understandable why the above illustrations were used by Minister Tong for the GI Amendment Bill. This is because they are the clearest examples to *explain the distinctions* amongst the terms "variations", "translations" and "transliterations". However, in cases where the

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64 As briefly alluded to above, this issue was also considered in *EC v Germany*, albeit in the context of an infringement scenario (*Article 13 of Regulation 2081/92)* - see [AG 46] – [AG 47] at RBoA at Tab 7, pages 77 - 78).

65 The definition of a "variant", in relation to a geographical indication, means a variant of the indication constituting the geographical indication, and includes any translation, transliteration or other variation of the indication (Geographical Indications Act 2014 version as at 15 March 2022; see also RWS at [29]).

66 RWS at [35], RBoA at Tab 14, see page 251.

circumstances so justify, the above examples should not prevent or restrict the application of the same.

56 Specifically, the current case can be distinguished as there are dictionary entries to the effect that "Parmigiano Reggiano" is "another name for Parmesan cheese" in English, or otherwise (above).

57 In the same vein, the evolution of the perception of the consumer is relevant *only* to the extent that it has been captured in the dictionary entries.[67] One example is in the Oxford English Dictionary (above) which traces the "history and etymology" of "Parmigiano" and "Parmesan".[68]

58 *Subject* to the above, I agree with the Registrant / Opponent that the Requester is misguided in that for the purposes of Section 46(1)(b) read with 46(2)(b) of the Act, what is, or is not, a "translation", is *not* determined by how the terms have been used in the marketplace.

59 Last but certainly not least, despite the description for the Registered GI in the application for the same,[69] I do not think it is necessary for the evidence pertaining to the translation to make specific references to the technical details as reflected in the annexes.[70] [71] These include particulars such as the specific demarcation of the geographical areas, as well as the "principle physical, microbiological, chemical and organoleptic" character of the goods.[72]

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[67] RWS at [47].

[68] Registrant / Opponent's 2nd SD at [13] and exhibit NB-19, page 59.

[69] Above, via Form GI 1.

[70] See Form GI 1 (above).

[71] RWS at [57.1] and [57.2].

[72] Annex B of Form GI 1.

60 To begin with, I observe that the Geographical Indications Register ("GI Register") also only provides the geographical indication, as well as the relevant good.

61 The evidence in this case are entries in reputable dictionaries (above). I see no reason to doubt that the reference to "Parmigiano Reggiano" in such dictionary entries *point towards* the Registered GI. For example, "champagne" has been defined, in the Collins Dictionary, as "a white sparkling wine produced around Reims and Epernay, France" (British English).[73] While the exact geographical area of production is not provided in the dictionary entry, *in all likelihood*, readers *understand* it to refer to the registered geographical indication, "Champagne" for wines (50201900128W).[74]

62 Finally, since the issue is whether "Parmesan" is *a translation* of "Parmigiano Reggiano", it is *inconsequential* even if ""Parmesan" is broader [and encompasses more] than "Parmigiano Reggiano"".[75]

63 In light of *all* of the above, I am of the view that the Registrant / Opponent has discharged its burden and shown that "Parmesan" is indeed a translation of *"PARMIGIANO REGGIANO"*.

64 For completeness, the Requester argued that "[t]*he protection of the geographical indication "PARMIGIANO REGGIANO" should not extend to the use of the term "Parmesan""* as "Parmesan" was not expressly listed as an

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73 https://www.collinsdictionary.com/dictionary/english/champagne

74 As per the records on the IDH.

75 RWS at [57.3].

alternative name or translation to "Parmigiano Reggiano" in Annex 10-B itself.[76] [77]

65 I agree with the Registrant / Opponent that "the express listing of an alternative name simply indicates that those items fall within the scope of protection" but it does not follow that the converse (that is, that names *not* expressly listed fall *outside* of the scope of protection) is true.[78] For my own purposes, I note that in the European Union, the use of "Parmesan" has been prevented under Article 13 of Regulation 2081/92 on the basis that "Parmesan" is an *evocation* (rather than a translation) of "Parmigiano Reggiano".[79] [80]

The crux of the Requester's concern

66 The *crux* of the Requester's concern is as follows:[81]

> [8] The [Requester] has grown increasingly concerned that the European Union's Geographical Indications frameworks are being significantly extended beyond their original intent, and have been misused to *unfairly monopolise* the use of product names *(such as*

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76 OWS at [91] and Requester's SD at [21].

77 These are the geographical indications from Annex A of *the Free Trade Agreement of the European Union and Singapore* of which Singapore has completed the procedures for protection. See the preamble of *Decision No 1/2020 of the EU-Singapore Trade Committee of 17 April 2020* at Exhibit NB-4, page 54 of the Opponent's 1st SD.

78 OWS at [91(a)].

79 See *EC v Germany*, above, RBoA at Tab 7, page 90 at [8]: Article 13(1)(b) of Regulation 2081/92 provides:

> Registered names shall be protected against…any misuse, imitation or *evocation*, even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation' or similar…
>
> [Emphasis in italics mine]

80 The European Court of Justice did not see it necessary to deal with the issue of translation (*EC v Germany*, above, RBoA at Tab 7, page 66 at [H7]).

81 See [8] and [12] of the Requester's SD.

> *parmesan) in common use* in global cheese production for many decades, including by the [Requester]…
> …
>
> [12] The [Requester] believes that a legitimate Geographical Indications framework must still enable the continued and future use of *common or generic (cheese) names…*

[Emphasis in italics mine]

67 The Requester sought to support its argument that there is a need to take into account "the perspective of the consumer in determining whether a term is a possible translation" on the basis of the following excerpts in the IPOS Public Consultation:[82]

> 4.5 Similar to trade mark applications, applicants can voluntarily disclaim protection for specific elements of a GI, or specify that a particular term is not a translation of the GI, and so disclaim protection in relation to that term. Applicants may wish to do this…for translations which they do not intend to protect. For example, as many GIs are not originally in English, there might be some *translations which may be perceived as generic* to consumers, *and thus may not meet the definition of a GI.* In such a case, the applicant may *specify that a certain term is not to be considered as a translation* of the GI for which registration is sought.
>
> …
>
> 4.15 An example where such a disclaimer request process could be useful would be where third parties believe that a term, thought to be *a possible translation of the GI to be registered, is actually a generic term and a common name for certain goods or services…*

[Emphasis in italics mine]

68 At the oral hearing, the Registrant / Opponent submitted, and I agreed, that to address the above scenario, having regard to the relevant provisions (replicated here for ease of reference):[83]

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[82] RWS at [44] and [45].

[83] Above at [15].

> 46.—(1)(b) Any person may, at any time after the date of the publication of an application for registration under section 45, request that a qualification, of the rights conferred under this Act in respect of a registered geographical indication, be entered in the register…in relation to *any term which may be a possible translation of the geographical indication.*
>
> (2) The request under subsection (1) may only be made on *either or both* of the following grounds:
>
> (a) that one or more of the *exceptions referred to under Part III applies*;
>
> (b) that the term referred to in subsection (1)(b) is *not a translation* of the geographical indication.
>
> 11…(c) Section 4 shall not apply to…the use of a geographical indication in relation to any goods or services which is identical with the *common name* of the goods or services in Singapore.

[Emphasis in italics mine]

The Requester's would have to claim that,

> Applying *section 46(1)(b) read with section 46(2)(a), which is in turn read with section 11(c)*, that the use of "Parmesan" (which is a possible translation) in relation to cheese is identical with the *common name* of cheese in Singapore.
>
> Accordingly, a *request for the qualification* of the rights conferred under the Act in respect of "Parmigiano Reggiano" should be *entered* in the Register in relation to "*Parmesan*" to the effect that "[t]*he protection of the geographical indication "PARMIGIANO REGGIANO" should not extend to the use of the term "Parmesan"*".[84]

[84] See above.

69 For the avoidance of doubt, I am *not* commenting on the viability of the above cause of action to address the Requester's concern. The current cause of action *as pleaded* does *not* address this concern. In addition, I also make no finding as to whether the translation "Parmesan" is generic in this decision.

70 As alluded to above, the Requester did not plead that the term "Parmesan" is or has become generic. The *sole* ground for the Request of the Qualification (and thus, the *sole* ground for this Opposition to the Request of the Qualification) is that the term "Parmesan" is not a translation of the Registered GI, that is, section 46(1)(b) read with section 46(2)(b) of the Act *only*.[85]

71 As provided in *Yitai (Shanghai) Plastic Co, Ltd v Charlotte Pipe and Foundry Co* [2021] SGHC 198 (albeit *obiter*):

> [100(b)] Each party's pleadings must be *full* in the sense that they *outline each of the grounds relied upon* and state the case relied upon in support of those grounds (*DEMON ALE* at 357):
>
> > *Considerations of justice, fairness, efficiency and economy* combine to make it necessary for *the pleadings of the parties in Registry proceedings to provide a focused statement of the grounds* upon which they intend to maintain that the tribunal should or should not do what it has been asked to do....
>
> [100(c)]…The *pleadings should identify the issues to which the evidence will be directed*, so that *no party is taken by surprise* (*Julian Higgins' Trade Mark Application* [2000] RPC 321 at 326)…

[Emphasis in italics mine]

72 Since the Requester did *not* plead the relevant ground in relation to the issue of genericism, the Registrant / Opponent did not address this. Consequently, it would be unfair to base my decision on a ground which was

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85 Above at [17].

not pleaded and which the Registrant / Opponent has not had the opportunity to respond to.

73 In light of all of the above, the Opposition to the Request for Qualification *succeeds* as the Registrant / Opponent has established on a balance of probabilities that "Parmesan" is indeed a translation of *"PARMIGIANO REGGIANO"*.

Conclusion on section 46(1)(b) read with 46(2)(b)

74 The ground of opposition under section 46(1)(b) read with section 46(2)(b) therefore *succeeds*.

Overall conclusion

75 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition *succeeds.* The Registered GI will proceed to registration *as is* and the Registrant / Opponent is entitled to costs to be taxed, if not agreed.

76 It only leaves me to express my appreciation to counsel for their helpful submissions.

Sandy Widjaja
Principal Assistant Registrar

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