

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

Geographical Indication Application No. 50201900057U
23 July 2019

**APPLICATION FOR EXTENSION OF TIME
TO FILE NOTICE OF OPPOSITION AND EVIDENCE
BY U.S. DAIRY EXPORT COUNCIL**

AND

**OBJECTION THERETO BY
CONSORZIO DEL FORMAGGIO PARMIGIANO REGGIANO**

Principal Assistant Registrar Mark Lim Fung Chian
2 August 2019

Interlocutory hearing – application for extension of time to file Notice of Opposition and evidence under Rule 30 of the Geographical Indications Rules – objection by the Applicant – whether application should be allowed.

GROUND OF DECISION

1. This decision concerns an ordinary application (for an extension of time) made in extraordinary circumstances.
2. Consorzio Del Formaggio Parmigiano Reggiano (“**the Applicant**”) applied to register the geographical indication (“**GI**”) “Parmigiano Reggiano” (“**the Application GI**”). The application was accepted and published for opposition purposes on 10 May 2019.
3. The deadline to file a notice of opposition together with evidence in support of the opposition was 21 June 2019. On 10 June 2019, U.S. Dairy Export Council (“**the Opponent**”) requested for an extension of time to file its notice of opposition and supporting evidence.
4. Rule 30(5) of the Geographical Indications Rules 2019 (“**GIR**”) provides that the Registrar may refuse to grant a request for an extension of time if the requestor “*fails to show a good and sufficient reason for the extension.*”
5. I reject the application for an extension of time for the following reasons:

- a. The Application GI is one of the items in a list of 196 GIs (“**Annex 10-A GIs**”) of interest to the European Union (“EU”) as set out in Annex 10-A of the European Union-Singapore Free Trade Agreement (“EUSFTA”). This list has been made public since as far back as 21 January 2013 pursuant to a public consultation in which the Opponent participated. Thus, the Opponent has had ample time to prepare for any possible opposition action.
- b. An extension of time could potentially delay the coming into force of the EUSFTA and hence the attendant benefits to Singapore companies.
- c. As at the date of writing these grounds of decision, the Opponent has still not indicated the basis of its opposition to the Application GI. At the same time, the Opponent has confirmed that its objection is actually not to the Application GI—namely, “Parmigiano Reggiano”—but to what it describes as the “common name” for the Application GI (purportedly “parmesan”). Under Section 41 of the Geographical Indications Act 2014 (“GIA”), this is not a ground for objection to the registration of the Application GI. The opposition is therefore bound to fail. Instead, the Opponent should apply for a qualification of rights under Section 46 GIA.

6. I discuss these reasons in greater detail below.

Parties and Procedural Background to Current Application

7. The Applicant is an association of Italian cheese producers in the geographical area comprising “*the part of the province Bologna to the left of the River Reno, the part of the province of Mantua to the right of the River Po, and the provinces of Modena, Parma and Reggio Emilia*” (“**the Defined Geographical Area**”). The Application GI is a hard cheese made from milk from cows reared in the Defined Geographical Area. These cows are fed primarily on fodder from the Defined Geographical Area. According to the Applicant, the quality of cheese bearing the Application GI is derived from “*the characteristics of the soil found within the Defined Geographical Area... coupled with climate conditions that directly influence both the composition of the natural flora and the fermentation of the cheese itself.*” Further, “*the complex operations performed on ‘Parmigiano Reggiano’ cheese have been developed over centuries of traditional cheesemaking practices within the production area, handed down from generation to generation with respect for authentic and unvarying local practices.*”¹
8. The Opponent is a “*non-profit independent membership organisation that represents the global trade interests of dairy producers, proprietary processors and cooperatives, ingredient suppliers and export traders in the United States of*

¹ See Form GI1 (Application to Register a Geographical Indication) filed by the Applicant on 23 April 2019. The form sets out in much greater detail a description of the goods to which the Application GI applies, and how the quality, reputation and other characteristics of these goods are essentially attributable to the Defined Geographical Area.

America.” The Opponent is also “*a founding member of the Consortium for Common Food Names*”, whose “*mission is to protect worldwide the right to use common food names through various means.*”²

9. As mentioned above, the Application GI was accepted and published for opposition purposes on 10 May 2019, and the deadline for filing a notice of opposition together with evidence in support of the opposition was 21 June 2019.
10. On 10 June 2019, the Opponent requested for an extension of time “*for up to 6 months*” to file its notice of opposition and supporting evidence. The usual reasons were put forward for the request, viz that the Opponent was recently made aware of the publication of the Application GI, its agent has just been appointed and needs more time to take instructions, and the Opponent needs more time to prepare the evidence in support of the opposition. The Opponent also stated that the intended opposition “*is part of the larger and worldwide series of oppositions that [it] undertakes in pursuit of protecting the right to use common food names.*”³
11. On 11 June 2019, the Registrar expressed his preliminary view that the Opponent had “*fail[ed] to show a good and sufficient reason for the extension*” as: (i) the Application GI is among the Annex 10-A GIs which have been made public since as far back as 21 January 2013 pursuant to a public consultation; and (ii) an extension of time could potentially delay the coming into force of the EUSFTA and hence the attendant benefits to Singapore companies.
12. The Registrar asked the Opponent if it wished to be heard on the issue. Alternatively, the Opponent could file its Notice of Opposition and supporting evidence by the deadline of 21 June 2019.
13. On 18 June 2019, the Opponent informed the Registrar that it wished to be heard on the issue via written submissions as well as an oral interlocutory hearing.
14. On 9 July 2019, the Opponent filed its Written Submissions (“**OWS**”) and Bundle of Authorities (“**OBOA**”). In its written submissions (at [37]), the Opponent stated that it is content with an extension of time of three (3) months from the date of the hearing (i.e. 23 October 2019 as the hearing had been fixed on 23 July 2019). The Applicant also filed Written Submissions (“**AWS**”) and Bundle of Authorities (“**ABOA**”) objecting to the request for an extension of time.
15. The matter was heard before me on 23 July 2019.
16. As at the date of this Grounds of Decision, the Opponent has not set out the grounds upon which it opposes the registration of the Application GI.

² See Initiator’s Written Submissions dated 9 July 2019 at [1] & [2].

³ See Form GI17 (“Request for Extension of Time to File Notice of Opposition, Counter-statement, Statutory Declaration or Other Matter in Inter Partes Proceedings”) filed by the Opponent on 21 June 2019.

Geographical Indications and the EUSFTA

17. Before going into the specific reasons for rejecting the Opponent’s application for an extension of time, it is important to understand the background to the current GI legislation, which consists of the GIA and the GIR (collectively, “**GI Legislation**”).
18. The GI Legislation was enacted to facilitate the conclusion of the EUSFTA, which includes Annex 10-A that lists a series of GIs. These GIs have been made public since 21 January 2013, pursuant to a public consultation jointly organized by the Ministry of Trade and Industry, the Ministry of Law and the Intellectual Property Office of Singapore (“**IPOS**”).⁴
19. The close link between the EUSFTA and the GI Legislation is made clear from the Second Reading of the GI Bill 2014 (Singapore Parl. Debates; Vol 91, Sitting No. 15; 14 April 2014), where Senior Minister of State (“**SMS**”) Indranee Rajah (as she then was) observed that “[t]he proposed changes in our GI regime will put [Singapore] in a position to meet [its] obligations under the EUSFTA, should the conditions for implementation arise.” Moreover, SMS Indranee Rajah emphasized that:

The changes under the Bill will only be implemented in stages to correspond with the EUSFTA ratification timeline.

The GI Registry will be established only if the EU Parliament ratifies the EUSFTA. The enhanced protection for all categories of registered GIs will only kick in when the benefits of the EUSFTA is provisionally applied both ways. Improved border enforcement measures will only be effected within three years after the EUSFTA enters in force...

The staged implementation ensures that any potential disruption to local businesses dealing with or using GI products do not kick in before the benefits of the EUSFTA start to accrue.

20. Thus, although the GI Bill was passed on 14 April 2014, it only came into force on 1 April 2019. This is because after the original EUSFTA had been agreed to, an issue arose in Europe as to whether or not the European Parliament had the requisite competence to sign and conclude the EUSFTA, or whether each EU Member State had to agree to the EUSFTA. On 16 May 2017, the Court of Justice of the European Union held that a majority of the provisions of the EUSFTA, including those concerning intellectual property protection, fell within the exclusive competence of the EU; while certain provisions related to non-direct foreign investment and investor-state dispute settlement fall within a competence shared between the EU and its Member States.⁵ In the circumstances, the chapter on investment was separated

⁴ Ministry of Trade and Industry, Ministry of Law & IPOS, *Geographical Indications Consultation Paper: List of Terms in Relation to 196 Products* (21 January 2013).

⁵ Opinion 2/15 of the Court (Full Court), 16 May 2017.

from the original EUSFTA, and the current EUSFTA was signed on 19 October 2018, and approved by the European Parliament on 13 February 2019.⁶

21. Further, as presaged by SMS Indranee Rajah during the Second Reading of the GI Bill 2014, the provisions conferring enhanced protection to GIs (e.g. protection of translations, and prohibition of the use of a GI accompanied by words such as ‘kind’, ‘type’, ‘style’ or ‘imitation’⁷) and border enforcement measures have not yet come into operation.⁸
22. With regard to the GI registration procedure, although the overall architecture is modeled on the trade mark registration procedure,⁹ there are significant differences in implementation details. For example, GI opposition proceedings are greatly truncated compared to trade mark opposition proceedings. Among other things:
 - a. The initial deadline to file a notice of opposition against a trade mark is two (2) months from the date of publication.¹⁰ Evidence is filed after close of pleadings and the opponent is usually given between two (2) to nine (9) months to file its evidence in support of the opposition.¹¹ In contrast, for GI proceedings (such as the current case), the opponent is given a much shorter initial period of six (6) weeks to file both its notice of opposition as well as the evidence in support of the opposition.¹²
 - b. There is no appeal against a refusal to grant an extension of time in GI proceedings,¹³ whereas for trade mark proceedings, an appeal to the High Court is available if the refusal to grant an extension of time would bring proceedings to an end.¹⁴
23. It can be seen that the legislature evidently intended GI opposition proceedings to be expedited to ensure minimal delay to the coming into force of the EUSFTA.

Parties’ Submissions

24. I briefly outline the parties’ respective positions below. I will also address the relevant portions of submissions in the section below setting out “My Decision”.

⁶ European Parliament, Non-Legislative Resolution of 13 February 2019 on the Draft Council Decision on the Conclusion of the Free Trade Agreement between the European Union and the Republic of Singapore (2018/0093M (NLE)).

⁷ For agricultural products and foodstuffs (other than wines or spirits).

⁸ See GIA (Commencement) Notification 2019 dated 28 February 2019 (S124/2019), which provides for the coming into force of the GIA on 1 April 2019, with the exception of certain enumerated sections, including those conferring enhanced protection to GIs and border enforcement measures.

⁹ Registration is a three-stage process, involving: (i) application, (ii) examination, and (iii) publication and opposition.

¹⁰ Rule 29(1), Trade Mark Rules (Cap 332, 2008 Rev Ed) (“TMR”).

¹¹ Rule 31A TMR read with HMG Circular No. 2/2017 dated 31 January 2017.

¹² Rule 27(1) GIR.

¹³ Section 32 GIA.

¹⁴ Section 75(3) Trade Marks Act (Cap. 332, Rev Ed 2005).

Opponent's Submissions

25. The Opponent submits that the threshold for proving “*good and sufficient*” reasons for an extension of time as required under Rule 30(4) GIR “*must not be a high one.*”¹⁵ In the absence of guidelines in the context of GI proceedings, the Opponent seeks to rely on guidance issued by the IPOS with respect to trade mark opposition proceedings.¹⁶ Although the factors listed in these guidelines¹⁷ do not apply in the present case, the Opponent argues that these are just examples of “*an almost infinite variety of matters which may, depending on the facts of a particular case, be capable of amounting to good and sufficient cause or reason.*”¹⁸
26. The Opponent also relies on the cases of *Ong Cheng Aik v Dayco Products Singapore Pte Ltd (in liquidation)* [2005] 2 SLR(R) 561 and *Hau Khee Wee v Chua Kian Tong* [1985-1986] SLR(R) 1075. Although these cases concern applications for an extension of time to file a Record of Appeal, the Opponent argues that they are relevant to a situation whether a party has complied with procedural timelines in making a request for an extension of time. These cases apply a four-factor test to assess whether an extension of time should be granted: (1) the length of the delay; (2) the reason for the delay; (3) the merits of the appeal; and (4) the question of prejudice.¹⁹
27. With regard to the EUSFTA, the Opponent argues that what constitutes a “*good and sufficient reason*” within the meaning of Rule 30(5)(a) GIR “*ought not be construed within the sole or primary context of the EUSFTA.*” Further, the “*EUSFTA has proper rules for the opposition of geographical indication applications and this must be respected... Notably, under (sic) paragraph 2(c) of Article 10.17 provides for ‘an objection procedure that allows the legitimate interests of third parties to be taken into account.’ In addition, it is not envisaged by the EUSFTA that every single name in Annex 10-A must be registered.*”²⁰
28. In conclusion, the Opponent asserts that an extension of time should be granted as there was “*no procedural defect or delay*”, “*time thresholds were well respected*”, the “*opposition proceedings... in this case is just one of the many proceedings commenced by the [Opponent] worldwide, and as such, the matter may not be so straightforward*” and “*there is no real prejudice to the [Applicant] if an extension of time is granted.*”²¹

Applicant's Submissions

¹⁵ OWS at [11].

¹⁶ *Deadlines to File Evidence and Extensions of Time to File Evidence in Opposition Proceedings* (HMG Circular No. 2/2017 dated 31 January 2017).

¹⁷ At [2.1] of the Circular, and reproduced in OWS at [13].

¹⁸ OWS at [14].

¹⁹ OWS at [16]-[19].

²⁰ OWS at [24] & [25(b)].

²¹ OWS at [34] & [35].

29. The Applicant submits that *“there are compelling factors against granting the [request for an extension of time], namely: (i) policy grounds under the EUSFTA; (ii) the Opponent’s lack of vigilance in protecting its own interests; and (iii) the injustice, if any, to the Opponent is outweighed by the countervailing interests not only of the Applicant, but also Singaporean businesses and the Singapore government.”*²²
30. With regard to policy grounds, the Applicant asserts that the Application GI is one among *“a special category of GIs which have been specifically identified as being of importance to the EU, and accepted by the Singapore government as being of such importance.”* There is *“a public policy interest to conclude the registration of Annex 10-A GIs because the reciprocal benefit to Singaporean businesses as intended under the EUSFTA can only be realised after Annex 10-A GIs have been granted substantive protection by way of registration in Singapore.”* The GI Legislation *“must be understood and appreciated in light of Singapore’s obligations under the EUSFTA.”* Specifically, the *“opposition framework under the GIR reflects the deliberate policy to streamline the opposition process for GIs.”* According to the Applicant, the *“fulfilment of this policy objective does not come at the expense of fairness and justice, taking into account in particular that i) the proposed list of Annex 10-A GIs... was made public more than 6 years ago, i.e. since 21 January 2013, as part of the public consultation process, and ii) the GIA and GIR provide for a post-registration cancellation mechanism on the very same grounds as an opposition.”*²³
31. On the Opponent’s alleged lack of vigilance, the Applicant reiterates that the proposed list of Annex 10-A GIs was made public since 21 January 2013. Since then, there have been several occasions when this list of GIs has been publicised.²⁴ Therefore, the Opponent cannot *“claim that it was only recently made aware of the Application.”* In the Opponent’s view, the fact that this opposition is *“part of a larger and worldwide series of oppositions”* indicates that *“the Opponent ought all the more to have been fully alive, better placed, and better prepared to initiate its opposition in Singapore.”*²⁵
32. Finally, in relation to the balance of interests, the Applicant argues that there is *“a legitimate expectation by the Applicant that the Application GI attains registration expeditiously as part of Singapore’s implementation of the EUSFTA.”* An *“extension of time could potentially cause delay to the coming into force of the EUSFTA”* and result in *“objective injustice and prejudice not only to the Applicant, but also to Singapore as a whole.”* In contrast, no injustice would be caused to the Opponent by the refusal of an extension of time as the GI Legislation provides *“a framework for post-registration cancellation”* and *“all the grounds for opposition... likewise apply for cancellation.”*²⁶

²² AWS at [3].

²³ AWS at [5]-[12].

²⁴ As elaborated upon in AWS at [16]-[19].

²⁵ AWS at [15], [20]-[23].

²⁶ AWS at [24]-[27].

My Decision

33. Parties are in agreement that the Opponent is required “*to show a good and sufficient reason for the extension*” pursuant to Rule 30(5) GIR.
34. The GI Legislation does not provide any guidance as to what would amount to “*a good and sufficient reason.*” It is clear from the discussion above that the GI Legislation was enacted to facilitate the conclusion of the EUSFTA. In my view, it follows that the provisions of the GI Legislation must be construed in a manner which expedites the entry into force of the EUSFTA.
35. I agree with the Opponent that what amounts to “*a good and sufficient reason*” must depend on the facts of each particular case. In the present case, the Application GI is among the Annex 10-A GIs. Furthermore, the side letter to the EUSFTA from then-Minister of Trade and Industry Mr Lim Hng Kiang to Commissioner Karel De Gucht of the European Commission dated 21 January 2013 at [8] specifically notes “*the importance of [the Application GI] to the EU*” and “[*t]he EU states its expectation that Parmigiano Reggiano will be registered as a geographical indication in Singapore with exclusive rights.*” Consequently, the provisional application of the EUSFTA may be delayed if these opposition proceedings are not disposed of. This may hinder Singaporean companies from enjoying the substantial benefits conferred by the EUSFTA.
36. It is reasonable to expect a greater degree of expedition in relation to the Annex 10-A GIs as these have been made public since as far back as 21 January 2013 pursuant to a public consultation.²⁷ Indeed, the Opponent acknowledges that it “*did contribute its comments and/or inputs when public consultations were held.*”²⁸ While I agree with the Opponent that it is not reasonable to expect it to keep track of the Application GI from 2013, I am unable to accept that the length of delay by the Opponent should be measured from the date of publication of the Application GI on 10 May 2019. The Opponent must have been aware of the impending publication of the Application GI at least by 13 February 2019 when the European Parliament gave its consent to the EUSFTA,²⁹ particularly if (as it asserts) it undertakes a worldwide series of oppositions against the Application GI. This would be ample time for the Opponent to put together its Notice of Opposition and supporting evidence by the deadline of 21 June 2019. Indeed, it is now asking for a similar period of time (a further three months) to prepare the necessary documents.³⁰
37. As mentioned (at [26] above), the Opponent urges me to apply a four-factor test (length of delay; reason for delay; merits of appeal; and the question of prejudice) put forward by the Singapore courts in cases involving an application for an

²⁷ See footnote 4 above.

²⁸ OWS at [21].

²⁹ See Press Release (European Parliament Approves EU-Singapore Free Trade Agreement and EU-Singapore Investment Protection Agreement by the Ministry of Trade and Industry, Singapore dated 13 February 2019.

³⁰ OWS at [37].

extension of time to file a Record of Appeal. I do not agree that the situations are analogous since the refusal of an extension of time to file a Record of Appeal would mean that there will not be any opportunity for the appellant to overturn an adverse judgment. In contrast, here the Opponent can still institute post-registration cancellation proceedings (under Section 52(1)(b) GIA) on the same grounds as it can rely on in opposition proceedings (see Section 52(2)(a) read with Section 41 GIA).

38. Be that as it may, one of the factors which the Opponent urges me to consider is the merits of the opposition. This is ironic as the Opponent has not to-date given any indication as to the basis of its proposed opposition on which I would be able to assess such merits. Leaving this aside, I am of the view that an opponent would generally not be required to establish any likelihood of success on the merits at this preliminary stage.
39. In the current case, however, the Opponent's objection is not to the Application GI (namely, "Parmigiano Reggiano") but to a possible translation (namely, "parmesan"). This is reflected in a press release by the Opponent dated 28 September 2017,³¹ which states: " *'Parmigiano Reggiano' is an acceptable geographical term, but the common name 'parmesan' is already used by non-EU producers and widely used in Japan.*" At the oral hearing, the Opponent confirmed that the Opponent's objection is to "parmesan" and not to "Parmigiano Reggiano".
40. An objection to a possible translation of a GI is not one of the grounds for refusal of a GI, which are set out in Section 41 GIA. It follows that the opposition, if allowed to proceed, is doomed to failure. Instead, the Opponent should request for a qualification to be entered in the register pursuant to Section 46 GIA.
41. Taking into account all the circumstances, I am of the view that the Opponent has failed to show a "good and sufficient reason" for the extension of time requested, within the meaning of Rule 30(5)(a) GIR. Accordingly, I refuse to grant the request for an extension. The Application GI shall proceed to registration.
42. I will hear the parties on costs.

Legislation discussed:

Geographical Indications Act 2014, Sections 32, 41, 46 & 52

Geographical Indications Rules 2019, Rules 27(1), 30(4) & 30(5)

Geographical Indications Act (Commencement) Notification 2019 dated 28 February 2019 (S124/2019)

Trade Marks Act (Cap. 332, Rev Ed 2005), Section 75(3)

³¹ See ABOA at Tab-5.

Trade Mark Rules (Cap 332, 2008 Rev Ed), Rules 29(1) & 31A

Cases referred to:

Court of Justice of the European Union, Opinion 2/15 of the Court (Full Court), 16 May 2017

Hau Khee Wee v Chua Kian Tong [1985-1986] SLR(R) 1075

Ong Cheng Aik v Dayco Products Singapore Pte Ltd (in liquidation) [2005] 2 SLR(R) 561

Other references:

IPOS HMG Circular No. 2/2017 dated 31 January 2017 (*Deadlines to File Evidence and Extensions of Time to File Evidence in Opposition Proceedings*)

Ministry of Trade and Industry, Ministry of Law & Intellectual Property Office of Singapore, *Geographical Indications Consultation Paper: List of Terms in Relation to 196 Products* (Jan. 21, 2013)

European Parliament, Non-Legislative Resolution of 13 February 2019 on the Draft Council Decision on the Conclusion of the Free Trade Agreement between the European Union and the Republic of Singapore (2018/0093M (NLE))

European Union-Singapore Free Trade Agreement

Press Release (European Parliament Approves EU-Singapore Free Trade Agreement and EU-Singapore Investment Protection Agreement (“EUSIPA”)) by the Ministry of Trade and Industry, Singapore dated 13 February 2019

Press Release by U.S. Dairy Export Council dated 28 September 2017

Second Reading of the GI Bill 2014 (Singapore Parl. Debates; Vol 91, Sitting No. 15; 14 April 2014)

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