

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

Geographical Indication Application No. 50201900088S
9 April 2021

IN THE MATTER OF A GEOGRAPHICAL INDICATION APPLICATION BY

**CONSORZIO DI TUTELA DELLA DENOMINAZIONE DI ORIGINE
CONTROLLATA PROSECCO**

AND

**OPPOSITION THERETO BY
AUSTRALIAN GRAPE AND WINE INCORPORATED**

Hearing Officer: Ms Tan Mei Lin
 Principal Assistant Registrar of Geographical Indications

Representation:

Mr Gene Kwek, Ms Penelope Ng and Ms Teo Tze She (Bird & Bird ATMD LLP) for the Applicant

Mr M. Ravindran and Mr Jon Chan Wenqiang (Ravindran Associates LLP) for the Opponent

FULL GROUNDS OF DECISION

Introduction

1 Is “Prosecco” the name of a grape variety or a geographical indication (“GI”), or can it be both? This is one of the issues to be decided in this first full hearing under the GIs Act 2014 (“Act”) which came into force on 1 April 2019.

2 According to Australian Grape and Wine Incorporated (“Opponent”), the representative body for grape growers and winemakers in Australia, “Prosecco” is the name of a grape variety. Although not framed in such stark terms, the Opponent in effect argues that it cannot therefore be a GI.

3 Consorzio di Tutela della Denominazione di Origine Controllata Prosecco (“Applicant”), a consortium established and organised under the laws of Italy, rejects the suggestion that “Prosecco” is the name of a grape variety. In any event, the Applicant asserts that even if it is, it can still be registered as a GI.

4 I find that “Prosecco” is indeed the name of a grape variety. However, the legislative regime for GIs in Singapore makes clear that it does not follow that “Prosecco” cannot also be a GI. This would be the case only if “Prosecco” is also likely to mislead consumers as to the true origin of the products bearing the “Prosecco” GI.

5 On the evidence before me, the Opponent has not established that consumers are likely to be misled. Accordingly, the opposition fails. I set out my detailed reasons below.

Background and procedural history

6 On 3 May 2019, the Applicant applied to register “Prosecco” in respect of wines (“Application GI”). The claimed geographical area is “the North East region of Italy, and includes the entire territory of Belluno, Gorizia, Padova, Pordenone, Treviso, Trieste, Udine, Venice and Vicenza” (“Specified Region”).

7 The Application GI was accepted and published on 21 June 2019 for opposition purposes. On 9 September 2019, the Opponent filed its notice of opposition and supporting evidence. The Applicant filed its counter-statement and supporting evidence on 21 January 2020. The Opponent filed evidence in reply on 17 June 2020. A Pre-Hearing Review was conducted on 20 August 2020. On 30 November 2020, the Applicant filed evidence in reply and on 15 January 2021, the Opponent filed further evidence in reply. The matter was set down for hearing on 9 April 2021.

8 After hearing parties, I delivered my decision on 4 May 2021 (see *Australian Grape and Wine Incorporated v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco* [2021] SGIPOS 4). On 24 May 2021, the Opponent applied for my full grounds and on 3 June 2021, the Applicant made a similar application. Under Rule 37 of the GIs Rules 2019, this is a pre-requisite before parties can file an appeal with the High Court.

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

Grounds of opposition

10 The Opponent relies on Sections 41(1)(a) and 41(1)(f) of the Act in this opposition.

Evidence and written submissions

11 The following statutory declarations (“SD”) were filed in these proceedings:

S/N	Document	Abbreviation
Opponent's SDs		
1.	SD of Anthony Nicholas Battaglene, Chief Executive of the Opponent, (“Battaglene”) dated 3 September 2019	ANB SD1
2.	Reply SD of Battaglene dated 11 January 2021 (re-executed)	ANB SD2
3.	Further Reply SD of Battaglene dated 11 January 2021 (re-executed)	ANB SD3
4.	SD of Patrick Sng, Group Chief Executive Officer of Straits Wine Company Pte Ltd (“Straits Wine”), dated 1 June 2020	PS SD1
5.	Reply SD of Patrick Sng dated 5 January 2021	PS SD2
6.	SD of James Blue, CFO of Indigo Wine Co. Pte. Ltd. (“Indigo Wine”), dated 17 June 2020	JB SD
Applicant's SDs		
7.	SD of Stefano Zanette, President of the Applicant, dated 15 January 2020	SZ SD1
8.	Reply SD of Stefano Zanette dated 17 November 2020	SZ SD2
9.	SD of Quek Chin Chye Gary, Director of Via Serica Pte Ltd, dated 17 January 2020	QCC SD

12 The parties also filed:

- (a) Opponent's written submissions and bundle of authorities both dated 9 March 2021 (“OWS” and “OBOA” respectively); and
- (b) Applicant's written submissions and bundle of authorities both dated 9 March 2021 (“AWS” and “ABOA” respectively).

Applicable law and burden of proof

13 As the applicable law is the Act, there is no overall onus on the Applicant either before the Registrar or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent and the relevant date by which the merits of this opposition should be assessed is the date of application for registration of the Application GI, that is, 3 May 2019 (“Relevant Date”).

MAIN DECISION

Ground of opposition under Section 41(1)(f) of the Act

14 Section 41(1)(f) provides:

41.—(1) The following shall not be registered:

(f) a geographical indication which contains the name of a plant variety or an animal breed and is likely to mislead the consumer as to the true origin of the product.

15 To succeed on this ground, the Opponent must establish on a balance of probabilities that:

(a) The Application GI contains the name of a plant variety or an animal breed; and

(b) The Application GI is likely to mislead the consumer as to the true origin of the product.

Application GI contains the name of a plant variety or an animal breed

16 The Opponent's case is that "Prosecco" is and has always been the name of a grape variety. Its pleading states:

4. "Prosecco" has been referred to as the name of a grape variety from as early as 1773. Today, "Prosecco" is widely recognized to refer to a grape variety and which has seen longstanding use by wine industries, consumers, and exporters internationally to describe the said grape variety. Leading vine and grape research institutes and international wine authors, as well as the intentional (sic) vine and grape community have confirmed "Prosecco" to be the name of a grape variety. "Prosecco" has also been referred to as a grape variety in an international treaty between the European Union and Australia and under Italian law.

5. It was not until 2009 that Italy decided to change the name for the "Prosecco" grape varieties to "Glera" and claimed the "Prosecco" name as a protected designation of origin such that only wines produced in a specified region in Italy can be labelled as "Prosecco". Shortly thereafter, the European Union ("EU") declared in Commission Regulation (EC) No 1166/2009 of 30 November 2009 that the grape variety formerly known as "Prosecco" is now referred to as "Glera" as a matter of EU law.

6. Grape vines called "Prosecco" were first imported into Australia from Italy in 1997, and a sparkling wine called "Prosecco" has been produced in Australia in commercial quantities since the early 2000s. The "Prosecco" wines have been named as such on the basis that "Prosecco" is a term referring to grape varieties and not a GI.

17 The Applicant's position on the other hand is:

- (a) As at the Relevant Date, "Prosecco" is not the name of a grape variety. The term of reference for the grape variety from which "Prosecco" wine is made is "Glera";
- (b) "Prosecco" is recognised and known worldwide as a GI;
- (c) "Prosecco" already enjoyed protection in Singapore as an unregistered GI before the filing of the Application GI and the coming into force of the Act.

18 The issue I have to decide is whether "Prosecco" is still a grape variety as at the Relevant Date. In my view, the issue is not whether "Prosecco" is the name of the grape variety from which the Applicant's wines are made, but whether "Prosecco" is still a name of a grape variety. At this stage, this issue is also separate and distinct from whether "Prosecco" is protected as a GI, or as a grape variety, in Singapore or elsewhere.

19 I am satisfied that "Prosecco" is still a name of a grape variety at the Relevant Date. As I am not required to, I make no finding as to whether "Prosecco" may be used, is recognised, or is protected, as a grape variety in Singapore.

20 While the EU may have renamed the grape variety "Prosecco" to Glera, this name change only applies to the EU. I have to take into account the position outside the EU as well. Having considered the evidence, I am satisfied that as at the Relevant Date, "Prosecco" is still a grape variety outside the EU.

21 The 2013 Edition of the "*International List of Vine Varieties and their Synonyms*" ("International List"), published by the Organisation of International Vine and Wine ("OIV") lists "Prosecco" as a grape variety in countries such as Argentina, Australia and Bosnia-Herzegovina¹. While this edition of the International List was published before the Relevant Date, it was nonetheless published after "Prosecco" was recognised as a GI in Italy and in the EU.

22 The Applicant highlights that under the EU-MERCOSUR Free Trade Agreement (the "FTA"), Argentina agreed to fully protect the term "Prosecco" as a GI and to phase out all local uses of the term "Prosecco" as the name of a grape variety². However, the FTA is not yet in force and there is no evidence to suggest that Argentina has phased out local use of "Prosecco". As for the Applicant's point that Singapore is not part of the OIV and is therefore not bound by the International List, I find that the International List is nonetheless helpful in shedding light on the situation outside Singapore.

23 I accept that the term "Prosecco" is used in Australia as the name of a grape variety. As the Applicant submits³, the OIV database, when accessed in French (which is one of

¹ Pp 158 & 160 of ANB SD1.

² AWS at [85(iii)(c)].

³ AWS at [85(iii)(d)].

the OIV's official languages), reflects "Glera" as the official name of the grape variety ("nom variété") for Australia, while "Prosecco" is indicated as the national name ("nom national de variété"). This suggests that Australia recognises the official name as "Glera" and acknowledges "Prosecco" as the name for local use that applies to Australia only.

24 Wines produced in Australia from the "Prosecco" grape variety ("Australian "Prosecco" wines") have been exported to Singapore since 1995 and the volumes are as follows:

Year	Volumes (Litres)
2015	900
2016	5,702
2017	7,316
2018	9,657

25 This element is thus established.

The Application GI is likely to mislead the consumer as to the true origin of the product

26 Under this limb, the Opponent has to show that the Application GI is likely to mislead the consumer as to the true origin of the product.

27 The Opponent submits that Australian wines made from the "Prosecco" grape variety have been sold in Singapore since 2015 and consumers "recognise the "Prosecco" term to refer to wines produced from a grape variety of the same name which can also originate from Australia as opposed to being limited to wines originating from a particular region in Italy"⁴. If the indication is allowed to be registered on the GI register, "it will mislead Singaporean consumers into thinking that "Prosecco" wines can only originate from the Specified Region in Italy when this is in fact untrue"⁵.

28 Additionally, the Opponent submits that, in light of the state of the Singapore market for wines from "Prosecco" grapes and the perception of the average consumer as of the Relevant Date, a GI registration of the Application GI is also likely to mislead the Singaporean consumer as to the meaning of the "Prosecco" term whereby they will be unable to answer with confidence whether the term refers to:

- (a) The name of a grape variety which can be grown and cultivated anywhere in the world for wine-making purposes; or
- (b) A type of wine which must originate exclusively from the Specified Region in Italy⁶.

⁴ Counter-statement at [10].

⁵ OWS at [60].

⁶ OWS at [64].

29 The Applicant, on the other hand, submits that the Opponent's argument must fail for two reasons:

- (a) The Opponent's interpretation of Section 41(1)(f) of the Act is untenable. On a proper statutory interpretation, the phrase "true origin" actually refers to the true plant (or animal) origin of the product rather than its true geographical origin;
- (b) In any event, even if one accepts the Opponent's interpretation, the Applicant's use of "Prosecco" does not mislead consumers as to the true geographical origin of the product. Quite the opposite, it is in fact the Opponent's own use of "Prosecco" in respect of Australian wines that is likely to mislead consumers⁷.

30 At the outset, I note that the Opponent's position is tantamount to saying that since "Prosecco" is the name of a grape variety, its use as a "GI" would inevitably mislead consumers; consumers would not know whether wines labelled as "Prosecco" are made from "Prosecco" grapes or originate from the Specified Region. Such an approach would render the second limb (i.e. that the Application GI is likely to mislead the consumer as to the true origin of the product) otiose, and is inconsistent with the legislative framework for the registration of GIs in Singapore. I consider the relevant provisions of the Act in greater detail below.

Whether "true origin" refers to "true plant origin" or "true geographical origin"

31 I will first consider whether the phrase "true origin" refers, in the present context, to the plant origin of the product or geographical origin of the product as this sets the context for the discussion under this ground.

32 The Applicant submits⁸:

92 ... the ground of opposition under Section 41(1)(f) of the [Act] assumes that the indication in question (i.e. the Application GI) fulfils the definition of a "geographical indication" under Section 2 of the [Act]. This is clear from a comparison of the grounds under Sections 41(1)(a) and 41(1)(f):

41. – (1) The following shall not be registered:

- (a) *an **indication** which does not fall within the meaning of "geographical indication" as defined in section 2;*
[...]
- (f) *a **geographical indication** which contains the name of a plant variety or an animal breed and is likely to mislead the consumer as to the true origin of the product.*

⁷ AWS at [91].

⁸ OWS at [92]-[93].

93 Whereas Section 41(1)(a) refers to an “indication” which does not fall within the meaning of “geographical indication”, **Section 41(1)(f) assumes that the indication being challenged already fulfils the definition of a “geographical indication”.** The use of the term “*geographical* indication” in Section 41(1)(f) means that the “indication” in question already fulfils the requirement of designating *geographical* origin – otherwise it would be refused under subsection (a) as an “indication” that does not qualify as a “*geographical* indication”.... So when the framework for refusal under the various subsections of Section 41 is properly understood, the ambit of limb (f) actually concerns a situation where a GI is likely to mislead the consumer *as to the product’s true plant or animal origin*, by virtue of the GI containing the name *of that plant variety or animal breed*, as the case may be.

[bold, italics and underline in original]

33 Section 2 of the Act defines a “GI” as:

... 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;

34 It appears to me that the definition of “GI” in Section 2 only requires the indication to be “*used in trade to identify goods as originating from a place*”. Whether or not the indication in fact guarantees to the consumer that the goods originate from that place is not within the ambit of Section 2. It is therefore conceivable that a GI which satisfies the definition of Section 2 may be liable to mislead the consumer as to the true geographical origin of the product under Section 41(1)(f). As an illustration, this may happen, for example, if the consumer associates the grape variety with geographical place A but the GI is intended to identify goods originating from geographical place B.

35 The Applicant further submits⁹:

96 Moreover, the Opponent’s interpretation of “true origin” (being the “true *geographical* origin”) bears no apparent link to rest (sic) of the wording in Section 41(1)(f) of the [Act] – that the GI sought to be registered contains the name of a plant variety or animal breed. There is a gaping disconnect between the fact that the GI contains the name of a plant variety or animal breed, and the fact that this could result in consumers being misled as to the true *geographical* origin of the product. Logic and common sense dictate that the “origin” referred to is to be understood in light of the immediately preceding references to “plant variety” or “animal breed”; therefore

⁹ AWS at [96].

the “origin” must refer to the “plant” or “animal” origin, as the case may be.

[italics in original]

36 In my view, the link is clear when we consider the definition of a GI in Section 2, which is any “*indication used in trade to identify goods as originating from a place*”. The Opponent submits, and I agree, if the words “GI” in Section 41(1)(f) are substituted with these words, the link becomes clearer as the provision will now read:

41. – (1) The following shall not be registered:

(f) [an indication used in trade to **identify goods as originating from a place**] which contains the name of a plant variety or an animal breed and is likely to mislead the consumer as to the **true origin of the product**.

37 I am of the view that the words “true origin” refer to “true geographical origin” of the product.

Whether the Application GI is likely to mislead the consumer

38 I will now proceed to consider whether the Application GI is likely to mislead the consumer as to the true geographical origin of the product.

39 There appears to be two central points to the Opponent’s submission here¹⁰. First, the Singapore consumer is aware that wines made from the “Prosecco” grape variety can originate from both Australia and Italy. Second, the registration of the Application GI will mislead the consumer.

The Singapore consumer is aware that wines made from the “Prosecco” grape can originate from both Australia and Italy

The Opponent’s case

40 The Opponent submits as follows.

41 Since 2015, Australian wine producers have been exporting their wines made from the “Prosecco” grape to Singapore with a healthy increase in export volumes over the years as seen in the table at [24] above¹¹.

42 In the *2015 Singapore Wine Industry: Q2 Highlights and Outlook*, a publication by The Singapore Wine Vault, a provider of cellar services, it was reported that 89% of Singapore wine drinkers were more inclined to choose sparkling wines than other types of wines as of 2014¹².

¹⁰ See [27]-[28] above.

¹¹ OWS at [49].

¹² OWS at [51].

43 Australian “Prosecco” wines have been marketed and promoted in Singapore. These include¹³:

- (a) Various point of sale and promotional materials featuring Australian “Prosecco” wines displayed at Cold Storage supermarket outlets across Singapore in 2016.
- (b) A photograph of Australian “Prosecco” wines made available for sale at the October 2017 Wine Fiesta Singapore event.
- (c) Website printouts of Australian “Prosecco” wine listings being offered for sale on the websites of Singapore wine distributors dated 20 January 2016, 27 December 2018, 15 August 2019, 20 August 2019, and 4 December 2020.
- (d) Various photographs of Australian “Prosecco” wines displayed for sale at supermarkets in or around late November 2018 to early 2019.
- (e) A brochure promoting a dining event held on 13 June 2018 at Crystal Jade Palace, Takashimaya Shopping Centre and which featured Australian “Prosecco” wines.
- (f) Various order forms and wine tasting sheets by Indigo Wine, featuring Australian “Prosecco” wines and which pertained to a wine tasting event conducted at Grand Hyatt Singapore on 19 June 2019.
- (g) A bottle and label design for an Australian “Prosecco” wine pursuant to a business tie-up between Dal Zotto Wines Pty Ltd, an Australian wine producer, and Tippling Club, a multi-award winning local restaurant.
- (h) Promotional materials and photographs of events held in Singapore in which Australian “Prosecco” wines were displayed and offered, such as:
 - (i) “Australian Fare” at the Australian High Commission Building held in August 2019;
 - (ii) The inaugural “Wine Pinnacle Awards” held in Resorts World Sentosa Singapore from 10 to 12 October 2019; and
 - (iii) “POP UP @The Botanic Gardens” shopping event hosted at the Botanic Gardens on 28 November 2019.

44 Wines made from the “Prosecco” grape variety, whether originating from Australia or Italy, are marketed and sold with reference to “Prosecco” as a grape variety. The geographical origins of these wines are also clearly displayed. Some examples of how they are presented to the Singapore consumer are set out below¹⁴.

¹³ OWS at [53].

¹⁴ OWS at [55].

Examples

CORIOLE PROSECCO



CORIOLE PROSECCO

☆☆☆☆☆ Write a review

\$\\$48.00

VINTAGE: 2018
WINERY:Coriole Vineyards
COUNTRY: Australia
REGION: McLaren Vale
BODY:Light

QTY

ADD TO CART

Heart 0

Prosecco is the traditional Sparkling Wine of Northern Italy made from the grape of the same name. Unlike Champagne, Prosecco is made using the Charmat method, which is tank fermented as opposed to bottle. Prosecco is the lastest in the batch of Italian varieties to be released by Coriole – inspired by Tim Lloyd, young brother of Mark. It is a fresh and delicate style Sparkling wine...the perfect aperitif. The

Comments: The country of origin (*i.e.*, Australia) for this “Prosecco” wine is stated and this wine is also stated to be made from the “Prosecco” grape.

https://straitswine.com/collections/prosecco
1 capture
27 Dec 2018

Search...

DEALS ▾

Home > Prosecco > Page 1

SCOTT LA PROVA PROSECCO 2

\$50.30

Quantity

ADD TO CART

Wine Region: King Valley, Australia Grape: Tasting Notes Whitfield, King Valley...

[View full product details >](#)



Comments: The region of origin for this Australian “Prosecco” wine is stated to be King Valley, Australia.

PETE'S PURE PROSECCO 2020



\$38.30
Wine Region : Euston, New South Wales, Australia Grapes : **Prosecco** Tasting notes : A bright, fresh and tangy example of **prosecco**, with lovely fruit notes of green apple and ripe apricot, with a touch of savoury grassiness, almost hay-like. Fresh acidity...

COL VETORAZ VALDOBBIADENE DOCG BRUT PROSECCO 2019



\$50.30
Wine Region: Valdobbiadene, Italy Tasting Notes A sparkling wine made using the "Charmat" method. This **prosecco** has a creamy mousse, scents of rose, citrus fruit, acacia, white peach, pear and apple in the fresh bouquet. The taste is dry and...

PASQUA PASSIMENTO ROMEO & JULIET IGT PROSECCO NV



\$46.30
Region: Treviso, Italy Grapes: Glera Tasting Notes This **prosecco** has a brilliant straw yellow colour, with greenish highlights; its nose is fruity and rather intense and it is fresh and well-balanced on the palate. With a fruity nose of peaches...

Comments: The relevant regions of origin for these Australian and Italian “Prosecco” wines are stated. The description for the Australian wine “Pete’s Pure Prosecco 2020” states the relevant grape variety to be “Prosecco”.



Like 0
Tweet
Share

Wine:	Santa Margherita Prosecco Brut Valdobbiadene Spumante
DOC/G:	
Product Code:	ITCW027
Availability:	In stock

\$44.00

QTY
1

ADD TO CART

ADD TO WISHLIST

Description

Country: Italy, Valdobbiadene

Tasting Notes: Sparkling wine with a clean aroma, fruity, reminiscent of rennet apple and peach flowers. The taste is soft and balanced, with a vibrant freshness that combined with the finesse of the bead prolongs the pleasant aromatic sensations.

Varietal: 100% Glera (Prosecco)

Pairing: Perfect as an aperitif, it is ideal with small fish and cheese appetizers, or even the whole meal with delicate dishes.

Volume: 750ML

Vintage: NV

Comments: The country of origin (*i.e.*, Italy Valdobbiadene) is stated and the relevant varietal is also stated to be “100% Glera (Prosecco)”.



Nino Franco Faive Rose Brut Prosecco
2017

☆☆☆☆☆

Country: Italy
Region: Veneto
Grape Variety: 80% Merlot, 20% Cabernet Franc
Vintage: 2017
Aging Potential: Drink now through 2022
Serving Temperature: 6 ~ 8 °C
Alcohol Level: 12%

The Wine
Rose petal-like pink. Aromas of fruity, red fruit, and floral notes. In the mouth, pleasurable fresh. A long persistence, creamy, brut but with natural softness on the palate.

Qty

Add to Cart

Add to Compare	Add to Wishlist
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The Winery

Antonio Franco founded the "Cantine Franco" winery in Valdobbiadene in 1919. Valdobbiadene is located at the foot of the Prealps, in the Venetian region, and is famous for the Prosecco vine and wine production. This winery is proud to be one of the oldest in Valdobbiadene, located in the town centre, not far away from the countryside and the vineyards.

Thanks to a careful and wise management, the estate has been growing and evolving throughout three generations of producers. Antonio founded it, Nino expanded it and Primo improved the company performance throughout the years. 1982, when Primo took over its management, was the turning point.

Primo began to travel and to successfully export the wines in Europe as well as in the Americas and the Far East. At the same time he invested in the production process in order to make higher quality wines, eliminating all those wines that were atypical for the area. He also started to monitor closely the grape cultivation with the aim of achieving high quality from the raw material level to the final product.

Primo Franco was one of the first pioneers to export the Prosecco and to introduce a different sparkling wine than Champagne into the international market. He has been successful, thanks to his open mind personality, his spontaneity, reliability and competence as well as his charm and ability to communicate his love for his job, and last but not least thanks to his high quality and delicious wines.

Comments: The country of origin (*i.e.*, Italy) is stated and the description of the relevant winery states: "*Anton Franco founded the "Cantine Franco" winery in Valdobbiadene in 1919. Valdobbiadene is located at the foot of the Prealps, in the Venetian region, and is famous for the Prosecco vine and wine production.*" (*emphasis added*)



Comments: There are clear references to Australia being the place of production, with the words "King Valley" and "Milawa Australia" on the bottle label.



Our aim is simple, to deliver wines of exception backed by the knowledge and service to provide our customers with a valued experience.

Australia Fare Tasting

Product description	Region	Vintage	Rating	RRP	Special Price	Qty
Dal Zotto Prosecco	King Valley	NV	JH - 90	\$33	\$27	
Dal Zotto Pinot Grigio	King Valley	2017	JH - 91	\$37	\$30	
Dal Zotto Sangiovese Cabernet	King Valley	2016	JH - 90	\$46	\$37	
Larry Cherubino Chardonnay	Margaret River SA	2017	JH - 92	\$46	\$37	



Dal Zotto PUCINO PROSECCO NV – King Valley VIC

Tantalizing hints of fresh cut pear, citrus blossom bouquet. Soft, appealing and approachable with gentle bubbles and alcohol combining seamlessly with the fresh citrus flavours.



Dal Zotto PINOT GRIGIO – King Valley VIC

Immediately appealing aromatics of fennel and pear. The dry, taut and savoury nature of the wine demands another mouthful, as the wine is full of crunchy and refreshing fresh fruit with a touch of nuttiness.

Comments: The tasting notes for Australian “Prosecco” wine clearly state the relevant geographical region of production, *i.e.*, King Valley.

45 Straits Wine and Indigo Wine, which have been selling and distributing wines in Singapore for 14 and 4 years respectively, have further stated on oath that¹⁵:

¹⁵ [7] of PS SD1 and [5] of JB SD.

“It is [their] understanding that “Prosecco” is a grape variety and “Prosecco” wines are referred to on this basis. Accordingly, “Prosecco” wines are and can be produced from “Prosecco” grapes in different countries, including Australia and Italy. In this regard, [they] are aware that the Australian wine industry makes many wine products from “Prosecco” grapes.”

46 Given the above stated industry practices of marketing “Prosecco” wines with accompanying descriptions of the relevant grape variety and/or region of production, the end consumers, who will be particularly discerning and knowledgeable regarding their choice of alcoholic beverages, will properly appreciate that “Prosecco” wines are made from a grape variety of the same name and can originate from both Australia and Italy¹⁶.

The Applicant’s case

47 The Applicant on the other hand submits as follows.

48 Consumers in Singapore have a high degree of familiarity with “Prosecco” wine and recognise “Prosecco” as a GI for wine originating from Italy¹⁷.

49 The export volumes of “Prosecco” wines from Italy to Singapore are as follows¹⁸:

Year	Litres	Bottles (750 ml)
2011	84,200	112,267
2012	151,200	201,600
2013	214,000	285,333
2014	216,200	288,267
2015	247,100	329,467
2016	251,400	335,200
2017	380,700	507,600
2018	387,100	516,133

50 The above figures attest to the fact that the “Prosecco” GI has been used in Singapore for a long period of time, well before the Relevant Date and the alleged use of the term “Prosecco” by any Australian producer or trader, which started in 2015. Notably, export volumes of “Prosecco” wines from Italy far exceed export volumes of Australian sparkling wine being marketed under the indication “Prosecco”¹⁹.

¹⁶ OWS at [58].

¹⁷ AWS at [48].

¹⁸ AWS at [51].

¹⁹ AWS at [52].

My decision

51 I find that the Opponent's evidence is insufficient to prove that the Singapore consumer is aware that wines referred to as "Prosecco" can originate from both Australia and Italy. To prove this, it is not sufficient just to show that Australian "Prosecco" wines have been exported to Singapore and are available to consumers in Singapore. I must consider, among other things, how intensive, widespread and long-standing the consumers' exposure to Australian "Prosecco" wines is, and whether as a result, a significant proportion of the relevant public is aware that wines labelled as "Prosecco" can originate from both Australia and Italy.

52 Australian "Prosecco" wines have been exported to Singapore since 2015. This means that for a period of at least 4 years before the Relevant Date, consumers in Singapore have been exposed to wines referred to as "Prosecco" from Australia as well as from the Specified Region. This period is not very long but this has to be considered in conjunction with all relevant factors as a short period of exposure may be compensated by other factors such as high market share, or intensive and extensive exposure.

53 No advertising and promotional figures were lodged in this case. I only have the export volume to gauge the extent consumers in Singapore could have been exposed to Australian "Prosecco" wines. Based on this, the exposure does not appear to be very intensive. It is also not clear from the evidence how many retail outlets in Singapore carry Australian "Prosecco" wines during the period before the Relevant Date.

54 While I accept the Opponent's evidence that it is industry practice to market the concerned wines with accompanying descriptions of the relevant grape variety and region of production, the extent this was done accurately²⁰ and consistently before the Relevant Date, and, the effect of such a marketing practice on the consumer at the Relevant Date, are not clear.

55 I am therefore unable to conclude that on the Relevant Date, consumers in Singapore are aware that wines made from "Prosecco" grapes can originate from both Australia and Italy.

The registration of the Application GI will mislead the consumer

56 The Opponent submits that if the Application GI is allowed to be registered, the GI register will mislead Singaporean consumers into thinking that wines referred to as "Prosecco" can only originate from the Specified Region in Italy when this is in fact untrue. Additionally, the registration of the Application GI is also likely to mislead the Singaporean consumer as to the meaning of the "Prosecco" term whereby they will be unable to answer with confidence whether the term refers to:

²⁰ There is evidence that at least one wine retailer, Straits Wine, has erroneously not listed their only Australian "Prosecco" product, "Pete's Pure Prosecco 2019", under the "Prosecco" section. Further, the product description of the wine refers to the grape variety as "Glera" (SZ SD2 at [20]).

(a) The name of a grape variety which can be grown and cultivated anywhere in the world for wine-making purposes; or

(b) A type of wine which must originate exclusively from the Specified Region in Italy²¹.

57 In my view, what has to be shown under Section 41(1)(f) is that the “*geographical indication....is likely to mislead the consumer*”, and not that the GI register or the registration of the GI is likely to mislead the consumer. In any event, in the present case, there is no evidence to show, and it cannot be assumed, that the consumer is cognisant of the state of the register and is likely to be misled by it.

58 The ground of opposition under Section 41(1)(f) therefore fails.

59 I will nonetheless go on to consider whether the Application GI is likely to mislead the consumer as to the true geographical origin of the product.

60 I have found earlier that the Application GI is also the name of a grape variety. Notwithstanding, it does not automatically follow that the Application GI is “likely to mislead the consumer”.

61 It is clear from Section 15(b) of the Act that there is no absolute prohibition against the registration of GIs that are identical with the names of plant varieties, as it provides exceptions to the scope of protection for registered GIs where the GI consists (or contains) of the name of a plant variety. Section 15(b) reads:

15. Section 4 shall not apply to —

...

(b) the use in the course of trade of a registered geographical indication, or any term contained in a registered geographical indication, that is the name of a plant variety or an animal breed.

(Section 4 sets out certain uses of a GI against which producers or traders (or associations of such producers or traders) of goods identified by that GI may bring an action.)

62 Taking all relevant circumstances into account, including the overall perception that the consumer might have of the product, I am unable to find any evidence to support a finding that the Application GI is likely to mislead the consumer as to the true geographical origin of the product.

63 Firstly, no evidence has been lodged to show that consumers have actually been misled, although Australian “Prosecco” wines have been sold alongside “Prosecco” wines from the Specified Region (“Italian “Prosecco””) for a period of at least 4 years in Singapore before the Relevant Date. Although Section 41(1)(f) uses the phrase “*likely to*

²¹ OWS at [25].

mislead" and thus, evidence of consumers being actually misled is not mandatory, such evidence, if available, would have helped to establish this element of the ground of opposition more readily.

64 Secondly, consumers are likely to pay a relatively high degree of attention when purchasing a bottle of wine. Consequently, the likelihood of them being misled as to their origin is reduced. This is because the distinctions made between such goods, which are to be imbibed, are often matters of consumer preference. Consumers are more likely than not to consider, among other things, the country of origin, the grape variety, and the tasting notes of the wine. In this regard, they are not likely to be misled into thinking that a bottle of Italian "Prosecco" comes from Australia or vice versa. Further, if as the Opponent alleges (which I do not find), consumers truly recognise that "Prosecco" may refer to wines from Australia as well as Italy, they would be even more careful to check the country of origin of the wine and would not be misled.

65 Thirdly, the way wines are marketed and sold in Singapore will influence consumers' understanding of the wines and this prevents consumers from being misled. It is the Opponent's case, and I agree, that it is industry practice to market the concerned wines with accompanying descriptions of the relevant grape variety and region of production.

Conclusion on Section 41(1)(f)

66 The ground of opposition under Section 41(1)(f) therefore fails.

Ground of opposition under Section 41(1)(a) of the Act

67 Section 41(1)(a) provides:

41.—(1) The following shall not be registered:

(a) an indication which does not fall within the meaning of "geographical indication" as defined in section 2;

68 For ease of reference, I repeat the definition of "GI" under Section 2 of the Act. It is:

... 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;

69 It is the Opponent's case that the Application GI does not satisfy the definition of a GI as set out at Section 2 for two reasons as follows:

(a) The Application GI does not identify wines as originating from the Specified Region; and

(b) “Prosecco” wines do not have any qualities, reputation, or other characteristics that are essentially attributable to the Specified Region²².

70 I will discuss each of these points below.

The Application GI does not identify wines as originating from the Specified Region

71 The Opponent submits, relying on the ECJ in *The Tea Board v European Union Intellectual Property Office (EUIPO)* [2018] Bus LR 1095 at [56], that the “essential function of a geographical indication is to guarantee to consumers the geographical origin of the goods and the specific qualities inherent in them”. I agree.

72 The Application GI, in the Opponent’s view, is unable to perform the essential function of guaranteeing to consumers that “Prosecco” wines originate exclusively from the Specified Region. This is because, on the Relevant Date, the average Singaporean consumer would simply have regarded the term “Prosecco” as a generic term for a type of sparkling wine made from the “Prosecco” grape variety, and would not have identified “Prosecco” as originating exclusively from the Specified Region.

73 Again, the Opponent is essentially asserting that “Prosecco” cannot be a GI because it is the name of a grape variety. This approach cannot be reconciled with several other provisions in the Act (e.g. Sections 15(b) and 41(1)(f) which I have considered above, and Section 41(1)(e) which I consider below).

74 In my view, Section 2 merely requires the indication to be “*used in trade to identify goods as originating from a place*”. It is not concerned with how the indication is perceived by the consumers, and in particular, whether the indication is a generic term for a type of product or an indicator that the product originates from a specific region. I am satisfied that the Application GI meets the relevant threshold in Section 2 in that it is an indication “*used in trade to identify goods as originating from a place*”.

75 Another reason why Section 2 is not concerned with generic terms is because a separate ground for refusal of registration exists for generic terms under Section 41(1)(e) of the Act. Section 41(1)(e) reads:

41.—(1) The following shall not be registered:

(e) geographical indication which is identical to the common name of any goods in Singapore, where registration of the geographical indication is sought in relation to those goods;

²² OWS at [70].

76 The Opponent did not plead Section 41(1)(e) as a ground of opposition.

77 The Opponent's first reason thus fails.

"Prosecco" wines do not have any qualities, reputation, or other characteristics that are essentially attributable to the Specified Region

78 The Opponent's second reason is that the "Prosecco" wines do not have any qualities, reputation, or other characteristics that are essentially attributable to the Specified Region. In particular, the Opponent contends that:

- (a) the Applicant has only based its application on the alleged quality or other characteristic (and not the reputation) of "Prosecco" wines produced in the Specified Region; and
- (b) the qualities and/or other characteristics of "Prosecco" wine are owed to the underlying grape variety and not to the Specified Region.

79 I will consider each of these points in turn.

The Applicant has only based its application on the alleged quality or other characteristic (and not the reputation) of "Prosecco" wines produced in the Specified Region

80 The Opponent points to paragraph c) of Annex C of the application for registration, which states:

- c) Cause-effect relationship between environment and Prosecco

The temperate climate, with rains and warm sirocco winds during the summer influence correct development of the plant during the vegetative stage. The temperature range between day and night and the mainly dry bora winds in the final stage of ripening of the fruit encourage the persistence of the "acid" substances as well as the production of significant amounts of aromatic precursors that define the floral and fruity hints typical of Prosecco wine. The fertility of the alluvial soils with clay-loam texture is good, enabling excellent productions to be obtained in terms of quantity and helping to produce a moderate sugar accumulation as well as making minerals and microelements available that are necessary for obtaining the balanced chemical-sensory composition of the fruit. These lands, with the particular climatic contribution of the area, are suitable for cultivating the varieties destined for the production of Prosecco, because they allow a base sparkling wine to be obtained that is not excessively alcoholic and has a fresh, dry and fruity sensory/tasing profile that is typical of Prosecco, making it recognisable to national and international consumers.

81 The Opponent submits that the Applicant's application can be contrasted with other GI registrations such as "Münchener Bier" (GI No. 50201900013W)²³ and "Aceto

²³ P 361 of OBOA.

Balsamico di Modena” (GI No. 50201900055P)²⁴ which makes it clear that they are claiming GI protection based on a certain reputation associated with the relevant goods.

My decision

82 I am not satisfied that the Opponent has sufficiently made out its case that the Application GI is not applied for on the basis of reputation. The “Münchener Bier” and “Aceto Balsamico di Modena” applications do not set the standard which other applications have to follow in order to qualify as having made a claim for reputation. To substantiate an allegation of this nature, it is not helpful to point to other applications made to the Registrar and say that those applications have done it better. This is because each application is assessed based on its own merits. An opponent has to show in what way the application it is opposing is deficient.

83 It is also pertinent to note that Annex C does not just contain the portion reproduced in [80]. Paragraphs a) and b) which also pertain to the “Link to geographical environment” have not been addressed by the Opponent.

The qualities and/or other characteristics of “Prosecco” wine are owed to the underlying grape variety and not to the Specified Region

84 The Opponent submits as follows:

113 ... the specified geographical area in relation to a GI application must be carefully delimited as it must be shown that the qualities and/or other characteristics of the product in question is attributable to the entire specified geographical area. In **Paolo Berizzi, “The impact of Community protection measures introduced by Regulation (EEC) N.2081/92 and by Regulation (EEC) N.2082/92” (1997)**, the author highlighted at p 3:

“It is very important to define the relevant geographical area carefully and clearly. The link between the product and the PDO is so close, because of such factors as weather, geology, and expertise, that the area should not be too wide, otherwise it would be difficult to prove that the same product cannot be obtained elsewhere, which is an implicit criterion for registration. For PGI products, it is equally clear that the area should not be too wide, or varied, as the product's reputation is assessed in relation to the whole area.” (emphasis added)

114 On a related note, the authors in **Calboli, Crossroads** considered, in relation to the Australian wine GI system, the difficulties and costs involved in determining the boundaries of a GI when applying for a wine GI at p 268:

“The real costs of application, however, lie in the evidence that is required to convince the [Geographical Indications Committee] that it should determine the boundaries of a GI. The applicant has to provide evidence on matters such

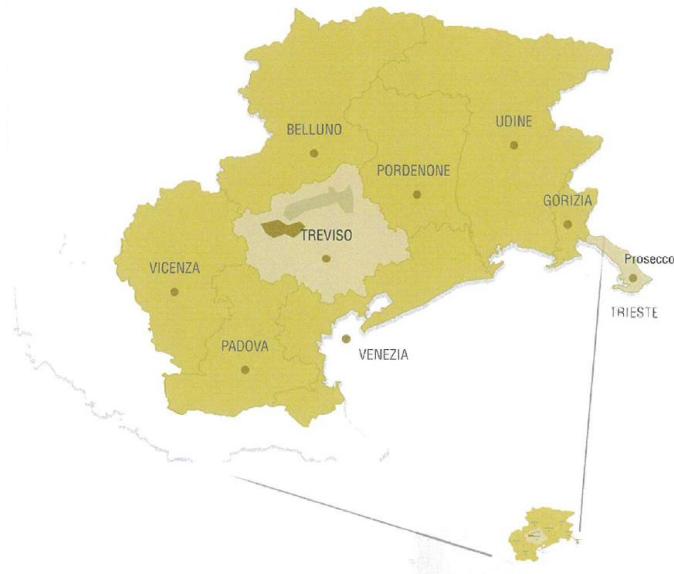
²⁴ P 370 of OBOA.

as the history of an area, its discreteness, and homogeneity by reference to attributes such as climate and geology, all of which require expert evidence

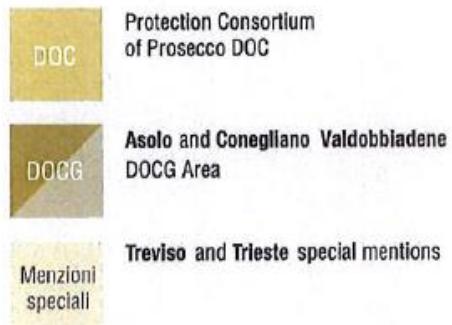
(Respondent #94). Estimates from the interviews suggest that such costs amount to tens of thousands of dollars. Costs might rise to a six-figure sum if, for example, there is opposition to the GI from a trademark owner. This sum might be larger still if, as in the case of the dispute over the determination of the boundary for the Coonawarra GI in South Australia, the matter ends up before the Federal Court with many years of legal expenses having to be met.”

(emphasis added)

115 In the present case, the Specified Region as stated in the Indication occupies a large geographical area:



116 The Specified Region can be further sub-divided into distinct areas, such as the DOC and DOCG regions, as shown in the Applicant’s evidence:



[bold, italics and underline in original]

85 The Opponent further submits:

117 The Opponent's filed evidence establishes that the climate and wine-making methods across the Specified Region differs (*sic*) greatly:

- (a) The DOCG zones "*are very different from the DOC zone, in just about every respect*" and the "*effects of these differences in terrain and climate within the DOC, and differences in production methods, are profound*".
- (b) In the DOCG zones, the "*vines are exposed to extreme climate variations, the slopes bringing swings in temperature and humidity every day, with the ground always well drained*."
- (c) DOCG production "*will be subject to rules prohibiting mechanisation or irrigation (except in emergencies), in order to maintain high quality*", However, "*mechanisation is common in the broader DOC*."
- (d) Wines in the DOCG area are "*more complex, refined, important, emotional and, inevitably, costly*" as compared to the DOC area where "*simplicity is the goal, yields are higher, and costs are low thanks to mechanisation (flat terrain, no steep hills)*".

118 In light of the major differences in the climate and wine-making methods shown above, the only common factor linking "Prosecco" wines produced in the Specified Region is really just the "Prosecco" grape variety itself. As stated by the [the Faculty of Law of Monash University in a 2019 research report titled "*The European Union's attempts to limit the use of the term 'Prosecco'*" (the "Monash Report")]:

The breadth of different growing conditions (and methods) demonstrates that the grape variety is key. Were the specific geographic conditions of a particular area really the basis for the Prosecco DOC designation rather than the grape, one might have expected some consistency in those conditions, whereas in fact this is not the case at all. Nor are production methods consistent. As rather starkly noted by the Fraternity of Valdobbiadene in 2018, DOCG production will be subject to rules prohibiting mechanisation or irrigation (except in emergencies), in order to maintain high quality. By contrast, mechanisation is common in the broader DOC. This variety underscores the reality that the common factor is the grape variety grown, and not the geographic location or method.

[bold, italics and underline in original]

My decision

86 Apart from the fact that the Opponent's case rests only on a single piece of evidence, I also do not attach too much weight to the Monash Report as I note that it was prepared at the request of the Opponent and could be biased. More importantly, the writer(s) of the Monash Report did not themselves make the statutory declaration which exhibited this item

of evidence and were therefore not subject to sanctions for knowingly making a false declaration, should this be established.

87 I am not satisfied that the Opponent has substantiated its claim that “Prosecco” wines do not have any qualities, reputation, or other characteristics that are essentially attributable to the Specified Region.

Conclusion on Section 41(1)(a)

88 The ground of opposition under Section 41(1)(a) fails.

Overall Conclusion

89 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the opposition fails on both grounds. The application shall proceed to registration. The Applicant is also entitled to costs to be taxed, if not agreed.

Date of Issue: 12 August 2021

[The appeal from this decision to the General Division of the High Court was successful on Section 41(1)(f). Upon further appeal to the Court of Appeal, the decision of the General Division of the High Court was reversed and IPOS' decision was upheld.]