

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

Geographical Indication Application No. 50201900057U
15 March 2022

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

FONTERRA BRANDS (SINGAPORE) PTE. LTD.

AND

OPPOSITION THERETO BY

CONSORZIO DEL FORMAGGIO PARMIGIANO REGGIANO

Principal Assistant Registrar Sandy Widjaja
18 April 2022

REGISTRAR'S SUMMARY DECISION¹

Introduction

1. The new *Geographical Indications Act 2014* (“*Act*”) came into force on 1 April 2019² and the new Geographical Indications Registry (“*Registry*”)³ commenced operations on the same date. With this new *Registry* it is possible to apply for the registration of a geographical indication.

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 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

¹ Pursuant to Rule 37(1)(a) read with Rule 47 of the Geographical Indications Rules 2019.

² 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).

³ See Part IV of the *Act*.

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 bold and italics mine]

3. Any issues pertaining to the protection of any possible translations of a geographical indication can also 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.

[Emphasis in bold and italics mine]

4. The relevant sections of the *Act* provide as follows:⁶

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.*

⁴ More elaboration below.

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

⁶ This is the version which is applicable as at the date of the request for qualification, that is, 16 September 2019 (see more below).

(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)⁷ Section 4⁸ 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 bold and italics mine]

5. The opposition process to a request for qualification is set out in rules 40 – 47 of the Geographical Indication Rules 2019⁹ (“**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 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*.

6. In this case, the request for qualification is brought under section 46(1)(b) read with section 46(2)(b) of the *Act* only.¹⁰

7. At the outset, I should stress that the *Requester* did not plead that the term “Parmesan” is or has become generic; if so, protection of the geographical indication will not extend to this term pursuant to section 46(1)(b) read with section 46(2)(a) read with section 11(c) of the *Act*.

⁷ Section 11 falls under Part III.

⁸ Section 4 sets out certain uses of a geographical indication which may amount to an infringement.

⁹ This is also the version which is applicable as at the date of the request for qualification, that is, 16 September 2019.

¹⁰ [3] *Fonterra’s* Statement of Grounds to the request for qualification (Form GI 2) dated 13 September 2019.

8. In order to reach a decision on this opposition, two issues arise for my determination:
- (a) Who bears the burden of proof to establish whether a particular term is or is not a translation of a geographical indication; and
 - (b) What is meant by a “translation”, as referred to in section 46.
9. In light of the *Requester’s* pleadings, it is not necessary for me to decide (more below) whether or not the term “Parmesan” is or has become generic.

Background

10. 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” (“*Registered GI*”) filed in the name of Consorzio del Formaggio Parmigiano Reggiano (“*Registrant / Opponent*”). The *Registered GI* was formally registered on 22 June 2019.¹¹

11. On 13 September 2019, Fonterra Co-operative Group Limited (“*Requester*”) filed a request for qualification in respect of the *Registered GI*, pursuant to section 46(1)(b) read with section 46(2)(b)¹² of the *Act* (see above),¹³ on the basis that the term “Parmesan” is not a translation of the *Registered GI*.^{14 15} Specifically, the *Requester* sought the qualification that:

*The protection of the geographical indication "PARMIGIANO REGGIANO" should not extend to the use of the term "Parmesan" ("Request for Qualification").*¹⁶

12. 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.¹⁷

13. On 12 March 2020, the *Registrant / Opponent* filed the present opposition on the basis that section 46(2)(b) is not established¹⁸ and that “Parmesan” is indeed a translation of “*PARMIGIANO REGGIANO*” (*Opposition to the Request for Qualification*).¹⁹

¹¹ As per the records on IP²SG.

¹² See [3] of the *Requestor’s* Statement of Grounds dated 13 September 2019 (“*Requester’s SoG*”).

¹³ 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] of the *Registrant / Opponent* written submissions (“*OWS*”).

¹⁴ [3] *Requester’s SoG*.

¹⁵ For clarity, I am prepared to accept that this is the *Requester’s* pleaded case (see [18] - [23] of *OWS*).

¹⁶ Part 5 of Form GI 2 dated 13 September 2019.

¹⁷ Rule 40(4) of the *Rules*.

¹⁸ [7] of the *Registrant / Opponent’s* opposition to the request for qualification (Form GI 13) Statement of Grounds dated 12 March 2020 (“*OSoG*”).

¹⁹ [9] *OSoG*.

14. The evidence filed by the parties are as follows:

- (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 Mr Goh Yuen Por Stanley, Director of the **Requester** dated 24 June 2021 (“**Requester’s 1st SD**”);
- (c) Statutory Declaration of the same **Ms Bertinelli** dated 20 October 2021 (“**Registrant / Opponent’s 2nd SD**”); and
- (d) Supplementary Statutory Declaration of the same **Ms Bertinelli** dated 23 November 2021.

Decision

15. Having considered all the pleadings and evidence filed, and the submissions made in writing and orally, I find that the **Opposition to the Request for Qualification succeeds**. My findings are as follows.

Burden of Proof

16. I am of the view that the burden of proof in this case falls on the **Registrant / Opponent**.

17. As submitted by the **Requester**, sections 103 and 104 the Evidence Act 1893 (“**EA**”) provide:²⁰

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 bold and italics mine]

18. The **Requester** further elaborated as follows, referring to the Singapore 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]:²¹

[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

²⁰ [19] **RWS**.

²¹ [22] **RWS**.

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, 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]henver 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 bold and italics mine]

19. As alluded to earlier, the *Act's* approach to a “translation” can be gleaned from the *IPOS Public Consultation* (replicated here for ease of reference):²²

[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 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.

[Emphasis in bold and italics mine]

²² *Requester's* bundle of authorities at Tab 11, pages 226 and 229.

A contextual reading of [4.14 – 4.18] of the *IPOS Public Consultation*²³ will reveal that the “disclaimer request process” is one and the same as the process for a request for qualification.

20. 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]”.²⁴

21. 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 bold and italics mine).²⁵ Accordingly, the legal burden of proof in this opposition lies on the *Registrant / Opponent*.

22. This is supported by an application of section 104 of the *EA*. Having regard to Rule 40(4) and (5) of the *Rules* above, “if no evidence at all were given on either side”²⁶ the *Registrant / Opponent* “would fail”²⁷ since “the Registrar must...enter the qualification of rights in the register”.²⁸

Section 46(1)(b) read with section 46(2)(b) – Whether or not “Parmesan” is a translation of the Registered GI

23. In this case, I am of the view that the *Registrant / Opponent* has discharged its burden of proof that “Parmesan is indeed a translation of *“PARMIGIANO REGGIANO”*”.²⁹ My reasons are as follows.

24. 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.³⁰ The relevant provisions in section 9A of the Interpretation Act 1965 read:

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.

²³ *Requester’s* bundle of authorities at Tab 11, pages 229 - 230.

²⁴ [25] *RWS*.

²⁵ [25] *RWS*.

²⁶ Section 104 *EA*.

²⁷ Section 104 *EA*.

²⁸ Rule 40(5) of the *Rules*. 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”. 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 (see [11] – [14] *OWS*).

²⁹ [9] *OSoG*.

³⁰ [26] *OWS*.

(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 law³¹ that are ***set out in the document containing the text of the written law as printed by the Government Printer...***

[Emphasis in bold and italics mine]

25. Support can 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 bold and italics mine).^{32 33}

26. The above is consistent with the plain meaning of “translation” which is simply the “*action of converting from one language to another*”.^{34 35} As submitted by the ***Registrant / Opponent***, the Singapore Court of Appeal has previously considered dictionary meanings to shed light on the ordinary meaning conveyed by the text of the provision (see *Bi Xiaqing v Chinese Medical Technologies, Inc and another* [2019] SGCA 50, at [38] and [39]).³⁶

[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...

³¹ 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).

³² [27] ***OWS***.

³³ The corresponding provision is Rule 4(2)(a) and (b) of the ***Rules***, which 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 bold and italics mine) ([27] ***OWS***).

³⁴ [39(a)] ***OWS***.

³⁵ For clarity, this definition does ***not*** limit the translation to a translation into the English language.

³⁶ [39] ***OWS***.

[39] We did not, however, accept that the *ordinary meaning* of “injunction” would naturally carry such a specific exclusion³⁷ *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 bold and italics mine]

27. In addition, I agree with the *Registrant / Opponent* that dictionaries have previously been referred to by the Singapore Courts as authoritative sources for the meaning of words in the English language (*Chua Hock Soon James v Public Prosecutor and other appeals* [2017] SGHC 230 at [186] and [188]):³⁸

[186] Section 2(1) of the [*Multi-Level Marketing and Pyramid Selling (Prohibition) Act 1973*] defines “promote” as follows:

‘promote’, with its grammatical variations and cognate expressions, includes to manage, form, operate, carry on, engage in or otherwise to organise;

...

[188]...it becomes apparent that HIN had “promoted” the GEP.³⁹ 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-in-chief) (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)”...

[Emphasis in italics and in bold mine]

28. In sum, as submitted by the the *Registrant / Opponent*,⁴⁰ the issue of “translation” focuses on how the word “Parmigiano Reggiano” is converted from its original language (i.e. Italian) into “Parmesan” (in English) – this is the central inquiry under Section 46(2)(b) of the *Act*.⁴¹

29. In this regard, the *Registrant / Opponent* has provided evidence of dictionary entries as follows:⁴²

³⁷ That is, excluding injunctions in aid of foreign court proceedings (see [38] of *Bi Xiaoping v Chinese Medical Technologies, Inc and another* [2019] SGCA 50).

³⁸ [40] *OWS*.

³⁹ This refers to the impugned scheme in question in that case, namely, the Global Edupreneur Program.

⁴⁰ [41] *OWS*.

⁴¹ For clarity, all that is needed is to show that “Parmesan” is a *possible translation* of the *Registered GI* and the possible translation need not be the only translation ([45] *OWS*).

⁴² [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*.⁴³
- (b) In the Larousse Italian-French Dictionary, “Parmigiano” is defined as “*Parmigiano (Reggiano)*” or “*Parmesan m*” in French.⁴⁴

[Emphasis in italics and in bold mine]

30. There is also an issue of whether a literal or faithful translation is required. A literal translation is simply a word for word translation. On the other hand, a faithful translation captures the essence of the word / phrase.

31. 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 “welcome”.

32. It is obvious from the above that a faithful translation would be more accurate and thus preferred to a literal translation.⁴⁵

33. 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.

34. The crux of the ***Requester’s*** concern is as follows:⁴⁶

[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 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 bold and italics mine]

⁴³ ***Registrant / Opponent’s 2nd SD***, page 44, Exhibit NB-17.

⁴⁴ ***Registrant / Opponent’s 2nd SD***, pages 53- 55, Exhibit NB-18.

⁴⁵ This issue was also considered in the European Union albeit in the context of an infringement scenario (*Article 13 of Regulation 2081/92*) - see ***Commission of the European Communities v Germany*** [2008] E.T.M.R. 32 at [AG 46] – [AG 47] (Requester’s bundle of authorities at Tab 7, pages 77-78).

⁴⁶ [8] and [12] of the ***Registrant / Opponent’s 1st SD***.

To that end, the bulk of the *Requester's* evidence attempts to show the wide array of “Parmesan” cheese products which are available in the local market.

35. 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*.

36. 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 and in bold mine]

37. Pleadings are core to the issues which the Tribunal is to decide. Since the *Requester* did *not* plead the relevant ground in relation to the issue of genericism, the *Registrant / Opponent* did not address this in its evidence. Consequently, it would be unfair to base my decision on a ground which was not pleaded and which the *Registrant / Opponent* has not had the opportunity to respond to.

38. 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*”.

Next Steps

39. The *Registered GI* will proceed to registration as is and the *Registrant / Opponent* is entitled to costs to be taxed, if not agreed.

40. Parties are reminded that this decision does *not* constitute the Registrar’s grounds of decision. Under Rule 47 read with 37(3) of the *Rules*, where a party wishes to have the Registrar’s grounds of decision, the party must, *within one month* after the date of the Registrar’s decision, file with the Registrar a request in Form GI14.

41. Finally, for the avoidance of doubt, in this decision, I make no finding as to whether the translation “Parmesan” is generic.

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

Representation:

Mr Gene Kwek and Ms Teo Tze She (Bird & Bird ATMD LLP) for the *Registrant / Opponent*

Mr Alvin Lim and Mr Zachery Tay (Withers KhattarWong LLP, Instructed Counsel) for the *Requester*

(The full grounds of decision can be found at *Conorzio del Formaggio Parmigiano Reggiano v Fonterra Brands (Singapore) Pte. Ltd.* [2022] SGIPOS 11.)