

Request to Qualify the GI for “Parmigiano Reggiano” Successfully Opposed – “Parmesan” is a Protectible Translation Falling Within the Scope of GI Protection

Case Update: Consorzio Del Formaggio Parmigiano Reggiano v Fonterra Brands (Singapore) Pte. Ltd. [2022] SGIPOS 7

In a recent Summary Decision, **Consorzio Del Formaggio Parmigiano Reggiano v Fonterra Brands (Singapore) Pte. Ltd. [2022] SGIPOS 7**, the Intellectual Property Office of Singapore (“IPOS”) issued the first Singapore decision relating to the Request for Qualification of Rights Regime in Singapore, where several interesting and novel issues were raised. In particular, IPOS had the opportunity to consider issues pertaining to the scope of protection of translations of geographical indications (“GIs”) in Singapore for the first time.

Brief overview of the Case

This case concerned an opposition action to a request for qualification (“**Opposition to Request**”) of the registered GI No. 50201900057U for “Parmigiano Reggiano” for “cheese” (the “**Registered GI**”) filed in the name of Consorzio del Formaggio Parmigiano Reggiano (the “**Registrant/Opponent**”).

Under the request for qualification regime in section 46 of the Geographical Indications Act (“**GIA**”), third parties are allowed to request that any of the rights provided under the Application GI be restricted on the basis that:

1. Any name or possible translation of the GI is a term to which an exception provided in Part 3 of the GIA applies; or
2. Any name or possible translation of the GI is not a translation of the GI

In the present case, Fonterra Co-operative Group Limited (the “**Requester**”) filed a request for qualification of the Registered GI pursuant to section 46(1)(b) read with section 46(2)(b) of the GIA that the protection of Registered GI “Parmigiano Reggiano” should not extend to the use of the term “Parmesan” as it is a name or possible translation of the GI that is not a translation of the GI (the second case mentioned above).

The Registrant/Opponent then filed the present Opposition to Request on the basis that the conditions for a Request are not made out, and specifically that “Parmesan” is indeed a translation of “Parmigiano Reggiano” and should therefore be protected as part of the Registered GI.

Ultimately, the Registrar allowed the Opposition to Request, holding that:

1. the Registrant/Opponent bore the burden of proof in establishing whether a particular term is a translation of a GI;
2. based on a purposive interpretation of s 46(1)(b) read with section s 46(2)(b), “translation” refers simply to whether words have the same meaning in a different language;

3. in considering the issue of a translation s 46(1)(b) read with section s 46(2)(b), it is not relevant to consider how the terms have been used in the marketplace;
4. the Registrant/Opponent successfully proved that “Parmesan” is a translation of “Parmigiano Reggiano”; and
5. the Requester’s attempt to rely on evidence “Parmesan” has become generic could not be considered as this was not pleaded.

Scope of protection of translations of GIs under the GI regime clarified

Although obiter dictum, the Registrar made some illuminating statements relating to the manner in which “translations” of a GI are protected.

Taking reference 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 IPOS on 1 November 2013 (“**IPOS Public Consultation**”), the Registrar opined the scope of protection for translations of a GI under the GIA are generally controlled by the following:

- (a) Users of a registered GI are firstly empowered to take action against another party using what is purportedly a translation of their GI, and the Courts would be empowered to determine the validity of their argument; and
- (b) The scope of protection of translations of GI can further be considered and clarified using the request for qualification process under section 46 of the GIA.

In an Opposition to Request, the Registrant/Opponent bears the burden of proof

The Registrar considered the issue of who bore the burden of proof in establishing whether a particular term is a translation of a GI.

In this regard, the Registrar considered sections 103 and 104 of the Evidence Act 1893 (“EA”) and concluded that the legal burden of proof lay on the Registrant/Opponent (who commenced the Opposition to Request) to establish whether the term “Parmesan” was a translation of the Registered GI. This is because the Registrant/Opponent would necessarily fail if no evidence at all were given on either side, and the Registrar would have to enter the qualification of rights in the register.

This is further supported by the Registrar’s finding that the IPOS Public Consultation showed a clear intention on the part of the draftsman that the registration of a GI will not equate to automatic protection of any term which the user alleges is a translation of the GI.

Having said that, it is curious whether such a burden was imposed on the Requester at the point of filing the initial Request for Qualification. As the Request for Qualification in this case was specifically filed on the basis of section 46(1)(b) read with section s 46(2)(b), the Requester would (at that point), presumably, have been required to establish that:

1. “parmesan” was a potential translation of “Parmigiano Reggiano”;
BUT
2. Parmesan was not an actual translation of “Parmigiano Reggiano”.



It would be interesting to understand the statements, evidence and circumstances in which the Registrar accepted that the second statement was established by the Requester at the point of filing its Request for Qualification.

A “translation” in section 46 of the GIA should not be restricted to a literal translation but should include “faithful translations”

In determining whether “Parmesan” was a translation of “Parmigiano Reggiano” the Registrar adopted a purposive interpretation of section 46(2)(b) of the GIA and found that the Registrant/Opponent had adduced sufficient evidence (such as dictionary extracts) to establish on a balance of probabilities that “Parmesan” is indeed a translation of “Parmigiano Reggiano” for the following reasons.

1. The relevant inquiry of section 46(2)(b) in the present case was how the word “Parmigiano Reggiano” is converted from its original language (i.e. Italian) into “Parmesan” (in English).
2. Based on the plain dictionary meaning of the word, the Registrar found that “translation” refers simply to the “action of converting from one language to another”.
3. The Registrar also agreed with the Registrant/Opponent that dictionaries have previously been referred to by the Singapore Courts as authoritative sources for meaning of words in the English language.
4. The Registrar also clarified that a “faithful translation” which captures the essence of a word / phrase (as opposed to a literal one which is simply a word for word translation) should be preferred, given that it is more accurate.

The comments relating to “faithful translations” are ostensibly attractive as it appears to expand the scope of protection of GIs beyond mere literal translations. However it remains to be seen what the exact parameters of “faithful translations” will be. For instance, in determining what properly captures the “essence” of a word, would this be done from the perspective of the relevant consumer in Singapore? Would such an enquiry require consideration of certain extraneous factors that inform the perspective of said consumer?

Evidence of use in the market irrelevant to the issue of translations

The Registrar also rejected the Requester’s arguments that the enquiry into a “translation” should take into consideration how terms have been used in the market place.

The Requester had attempted to argue that the term “Parmesan” was commonly used in global cheese production and should not be confined to the Registered GI. To this end, the Requester adduced evidence to show a wide array of “Parmesan” cheese products available in the local market. However, the Registrar rejected the Requester’s argument that a “translation” can be determined by how the terms have been used in the marketplace. The Registrar further opined that it was inappropriate for him to consider whether the use of the word “Parmesan” had become common or generic, given that this was not pleaded by the Requester.

While arguments relating to the alleged genericness of the Registered GI should clearly be disregarded (as it was not pleaded), the Registrar’s finding that a “translation” should not take into consideration how terms have been used in the marketplace appears to generate some conceptual friction, especially considering the Registrar’s earlier comments on “faithful translations”.

Conclusion

The present case provides several helpful clarifications as to the scope of protection for translations of GIs and is an exciting development in the law of Geographical Indications in Singapore. While the Requester did not succeed in this case, it is an interesting thought experiment to consider the circumstances in which a possible translation of a GI would not be held to be a translation of a GI.

On the practical side of things, this is the second case in which parties have unfortunately not been able to fully ventilate potential arguments due to unfortunate omissions from the pleading stage (see also our [previous case note](#)). As this is a new and developing area of law in Singapore, it is essential for interested parties to properly and carefully consider all potential issues and possible avenues of argument.

If you would like to discuss protecting and enforcing GIs in Singapore, please get in touch with us. For queries or more information, please contact:



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