

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

Geographical Indication Application No. 50201900008Q
19 August 2019 (“*Hearing Date*”)¹

**APPLICATION
TO FILE NOTICE OF OPPOSITION
IN A GEOGRAPHICAL INDICATION APPLICATION
BY BAVARIA N.V.**

AND

**OBJECTION THERETO
BY BAYERISCHER BRAUERBUND E.V.**

Principal Assistant Registrar Sandy Widjaja
9 November 2020

Interlocutory hearing – application to file Notice of Opposition – Content of the Notice of Opposition / Statement of Grounds - Opponent’s Statement of Grounds directed at the English translation of the subject Geographical Indication (GI) rather than the subject GI itself - whether this renders the Notice of Opposition nugatory - requirements for the successful filing of a notice of opposition under Rule 28 of the Geographical Indications Rules 2019 (GIR)

Background and Related Proceedings

- (i) The main proceeding to which this interlocutory decision relates is the Opposition to the Application to Register the GI (Case No. C010150201900008Q or “*Opposition to Registration*”).
- (ii) Bayerischer Brauerbund E.V. (“*Applicant*”) sought to register the words “BAYERISCHES BIER” as a GI on 3 April 2019. The *Applicant*’s GI application was published for opposition purposes on 12 April 2019. On 24 May 2019 (“*Opposition Filing Date*”), Bavaria B.V. (“*Opponent*”) filed a notice of opposition to the *Applicant*’s GI application, supported by the Statutory Declaration of Peter-Jan Joost Marie Swinkels dated 22 May 2019.
- (iii) On 29 May 2019, the Principal Assistant Registrar (“*PAR*”) indicated that he is “inclined to reject the Notice of Opposition and the supporting evidence”, on the

¹ The matter was stayed for a period of 12 months (see below).

basis that “the *Opponent*’s Statement of Grounds does not set out any grounds for refusal of registration of the GI as provided for in Section 41² of the Geographical Indications Act 2014” and that instead, the *Opponent*’s complaint is “directed against “Bavarian Beer”, which it alleged is the English translation of the GI applied for”.³

² Section 41(1) provides (1 Apr 2019 version; subsequent versions do not affect the decision):

The following shall not be registered:

- (a) an indication which does not fall within the meaning of “geographical indication” as defined in section 2;
 - (b) a geographical indication which identifies goods that do not fall within any of the categories of goods set out in the Schedule;
 - (c) a geographical indication which is contrary to public policy or morality;
 - (d) a geographical indication which is not or has ceased to be protected in its country or territory of origin;
 - (e) a 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;
 - (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.
- (2) For the purposes of subsection (1)(e), any marketing material in Singapore which uses a geographical indication shall be relevant evidence that the geographical indication is not the common name of any goods in Singapore, if the marketing material suggests (for example, by using words or pictures) in a misleading manner that the goods to which the marketing material relate originate in the geographical origin of the geographical indication, when those goods originate elsewhere.
- (3) Subject to section 42, a geographical indication shall not be registered if there exists a likelihood of confusion on the part of the public because the geographical indication is identical with or similar to, and has the same geographical origin as, an earlier geographical indication.
- (4) Subject to subsection (7), a geographical indication shall not be registered if there exists a likelihood of confusion on the part of the public because –
- (a) the geographical indication is identical with or similar to a trade mark; and
 - (b) the trade mark fulfils either or both of the conditions specified in subsection (5).
- (5) The conditions referred to in subsection (4)(b) are as follows:
- (a) the trade mark is a registered trade mark or an international trade mark (Singapore), and taking into account (where appropriate) the priorities claimed in respect of the trade mark under the Trade Marks Act (Cap. 332) –
 - (i) the application for the registration of the trade mark was made in good faith; or
 - (ii) the trade mark was registered in good faith, under the Trade Marks Act or any previous written law relating to trade marks, before the date of application for registration of the geographical indication in Singapore;
 - (b) the trade mark has been used in good faith in Singapore in the course of trade before the date of application for registration of the geographical indication in Singapore.
- (6) Subject to subsection (7), a geographical indication that is identical with or similar to a trade mark shall not be registered if –
- (a) the trade mark is, before the date of application for registration of the geographical indication in Singapore, a well known trade mark in Singapore; and
 - (b) registration of the geographical indication is liable to mislead consumers as to the true identity of the goods identified by that geographical indication.
- (7) The Registrar may, in his discretion, register any geographical indication referred to in subsection (4) or (6), if the proprietor of the trade mark referred to in subsection (4) or (6), as the case may be –
- (a) consents to the registration; or
 - (b) fails to give notice to the Registrar of his opposition to the registration in accordance with section 45(2).
- (8) In this section, “marketing material” includes material used for labelling or packaging goods, or for advertising goods.

³ See more below.

On 12 June 2019, the **Opponent** requested for an interlocutory hearing. The matter was heard on 19 August 2019.⁴

- (iv) On the same day when the **Opponent** filed its Opposition to Registration (i.e. 24 May 2019), the **Opponent** also filed a request for a qualification of rights pursuant to Section 46(1) read with Section 46(2)(a)⁵ of the Geographical Indications Act (“**GIA**”) in relation to the same GI (Case No. C020150201900008Q or “**Opposition to Qualification**”). The Notice of Opposition to the Request for Qualification was filed by the **Applicant** on 30 September 2019.
- (v) On 18 October 2019, both the **Opposition to Registration** and **Opposition to Qualification** were held in abeyance for a total period of 12 months (until 18 October 2020). This was following settlement negotiations⁶ and mediation⁷ between the parties. However, due to the imposition of the circuit breaker period arising from the Covid-19 pandemic from 7 April – 4 June 2020,⁸ the deadline for the stay ended on 1 November 2020 instead.⁹
- (vi) On 19 October 2020 and on 21 October 2020, the **Opponent** and the **Applicant** respectively requested for a further 6 month stay until 1 June 2021. The parties informed that they are still in negotiations even though the mediation has been terminated. As there was no indication that the disputes are likely to be settled within the extended deadline, to prevent any further delay, on 29 October 2020, parties were directed that the stay would be lifted and both the **Opposition to Registration** and **Opposition to Qualification** are to proceed. Parties can negotiate and gear up for hearings concurrently.

⁴ IPOS letter of 2 July 2019; it was originally set down for hearing on 12 July 2019 (Notice of 17 June 2019).

⁵ Section 46(2)(a) reads:

The request under subsection (1) may only be made on either or both of the following grounds...that one or more of the exceptions referred to under Part III applies.

Note that this is to be read with section 12(2) which is under Part III of the GIA (see [5] – [11] of the Notice of Opposition to the Request for Qualification).

Section 12(2) reads:

12(2) Section 4 shall not apply to the use by a person of a trade mark which is identical or similar to a geographical indication if —

(a) the application for the registration of the trade mark was made in good faith, or the trade mark was registered in good faith, under the Trade Marks Act (Cap. 332) or any previous written law relating to trade marks; or

(b) he has, or he and his predecessor in title have, continuously used that trade mark in good faith in Singapore in the course of trade, either —

(i) before 15th January 1999; or

(ii) before the geographical indication in question is protected in its country or territory of origin.

⁶ **Applicant**'s and **Opponent**'s letters both dated 23 September 2019 respectively (there was originally a disagreement as to whether the stay should apply to both the **Opposition to Registration** and **Opposition to Qualification**; it was ultimately extended to both). The original stay of 3 months (IPOS letter of 18 October 2019) was extended to 12 months (IPOS letter of 22 January 2020).

⁷ **Applicant**'s letter of 30 September 2019.

⁸ Practice Circular No. 2 of 2020.

⁹ IPOS letter of 21 July 2020.

- (vii) For completeness, I should also mention that the *Applicant* had earlier applied to register “BAVARIAN BEER” as a collective mark. The *Opponent* successfully opposed this application (the IPOS decision was issued on 13 August 2019).¹⁰ An appeal against the decision was filed in the High Court¹¹ and, as at the date of this decision, is pending.¹²

Issue

- (viii) The issue for determination in this interlocutory decision is the requirements for a successful filing of a notice of opposition under the *GIR*. Specifically, should the Notice of Opposition be allowed as long as all the procedural requirements for filing have been complied with? Or is it also necessary to examine whether the grounds relied on would, if established, be sufficient to succeed in the opposition?

Relevant Provision

- (ix) The determination of this issue depends on how Rule 28 GIR is interpreted. For ease of reference, I set out this out in full:

Contents of notice of opposition

28.—(1) The notice of opposition must contain a statement of the grounds upon which the opponent opposes the *registration of the geographical indication*.

(2) The grounds in paragraph (1) must be one of the grounds specified in section 41 of the Act.

(3) If registration is opposed on the ground that there exists a likelihood of confusion on the part of the public because the geographical indication is identical with or similar to, and has the same geographical origin as, an earlier geographical indication, the following must be included in the statement for the purpose of determining whether the ground is established:

- (a) a representation of the earlier geographical indication;
- (b) a statement on the geographical origin of the earlier geographical indication;
- (c) such of the following, as applicable:
 - (i) if the earlier geographical indication is registered —
 - (A) its registration number; and
 - (B) the goods in respect of which the earlier geographical indication is registered;
 - (ii) if an application to register the earlier geographical indication is pending —
 - (A) the number accorded by the Registrar to the application; and

¹⁰ [2019] SGIPOS 17.

¹¹ HC/TA1/2020.

¹² Opponent’s letter of 20 January 2020.

(B) the goods in respect of which the earlier geographical indication is sought to be registered.

(4) If registration is opposed on the ground that there exists a likelihood of confusion on the part of the public because —

- (a) the geographical indication is identical with or similar to a trade mark; and
- (b) the trade mark fulfils either or both of the conditions specified in section 41(5) of the Act, the following must be included in the statement for the purpose of determining whether the ground is established:
- (c) a representation of the trade mark;
- (d) if the trade mark is a registered trade mark or an international trade mark (Singapore) mentioned in section 41(5)(a) of the Act —
 - (i) its registration number; and
 - (ii) the class number and specification of the goods or services in respect of which the trade mark is registered;
- (e) if the trade mark is a trade mark mentioned in section 41(5)(b) of the Act, the specification of the goods and services in respect of which the trade mark is used.

(5) If registration is opposed on the ground that —

- (a) the geographical indication is identical with or similar to a trade mark that is, before the date of application for registration of the geographical indication, a well known trade mark in Singapore; and
- (b) the registration of the geographical indication is liable to mislead consumers as to the true identity of the goods identified by the geographical indication, the following additional information must be included in the statement for the purpose of determining whether the ground is established:
- (c) a representation of the trade mark;
- (d) information on the use of the trade mark;
- (e) information on any promotion undertaken for the trade mark.¹³

[Emphasis in bold and italics mine]

Held, allowing the filing of the Notice of Opposition

1. The ***Opponent*** relied on *Application by OOO “TVM Trade” To Strike Out Notice of Opposition and Objection Thereto by Societe Des Produits Nestle SA* [2014] SGIPOS 12 (“*Nestle*”).¹⁴ I agree with the ***Opponent*** that *Nestle* is a case broadly pertaining to striking out¹⁵ and this squares with the current case in that the effect of the rejection

¹³ Version which is applicable for the current decision (1 April 2019 version). Subsequent amendments to the provision do not affect the current decision.

¹⁴ See [16] of the Opponent’s written submissions (OWS).

¹⁵ Albeit on the basis of *res judicata*, see [3(b)] of the ***Applicant***’s rebuttal submissions (ARWS).

of the notice of opposition (and the supporting evidence) is to strike out the Opposition to Registration.¹⁶

2. In particular, I am mindful of the following factors highlighted in *Nestle*:¹⁷
 - (a) there is no express legislative provision [in the GI legislation] giving IPOS the power to strike out a notice of opposition;¹⁸
 - (b) there is no provision [in the GI legislation] which confers this power on IPOS as part of its inherent jurisdiction;¹⁹
 - (c) the lack of recourse by an opponent to an appeal from a decision by IPOS to strike out a notice of opposition is a strong indication that IPOS does not have this power.²⁰
3. In his earlier preliminary view, the *PAR* indicated that the reason for the rejection of the notice of opposition was:²¹

[3] The Opponent’s Statement of Grounds does *not* set out any grounds for refusal of registration of the GI as provided for in Section 41²² of the Geographical Indications Act 2014...Instead, the Opponent’s complaint is directed against “Bavarian Beer”, which it alleges is the English translation of the GI applied for.

[Emphasis in bold and italics mine].

4. In this regard, the Opponent’s Notice of Opposition at [15] and [16] provides:

[15] By virtue of the Opponent’s prior registered rights in Singapore...the Opponent is entitled to oppose the registration of the Applicant’s GI Application which covers a similar mark for identical goods and will in all likelihood give rise to confusion among the public. The Opponent has registered the Opponent’s Mark in good faith, and has used the Opponent’s Mark in Singapore in the course of trade since 1981. Given the striking similarity between the *English translation of the Applicant’s GI Application* and the Opponent’s Mark as well as the clear overlap between the goods covered by the parties’ respective marks, the registration of the Applicant’s GI Application would be contrary to Section 41(4) of the Geographical Indications Act 2014 (hereinafter referred to as the “Act”).

¹⁶ See [17] OWS.

¹⁷ As highlighted by the Opponent at [16] OWS.

¹⁸ [16(a)] OWS.

¹⁹ [16(b)] OWS.

²⁰ [16(f)] OWS. A decision to strike out the opposition to registration is an interlocutory decision, against which there is no appeal under the provisions of the *GIA*.

²¹ IPOS letter of 29 May 2019.

²² See above footnote 2.

[16] Further and/or in the alternative, the registration of the *Applicant's* GI Application should be refused pursuant to Section 41(6) of the Act. The *English translation of the Applicant's GI Application* is confusingly similar to the Opponent's Mark, which is a prior registered mark and a well-known trade mark, and the goods covered by the Applicant's GI Application clearly overlap with the Opponent's Products. The registration of the Applicant's GI Application would be liable to mislead consumers as to the true identity of the goods identified by that geographical indication.

[Emphasis in italics and in bold mine]

5. In essence, the *PAR* was of the view that section 41 of the *GIA* as referred to in the Statement of Grounds does *not* extend to translations of a GI, given that section 4(6)(b)²³ of the *GIA* (which pertains to translations) is *not* yet in force as at the *Opposition Filing Date*, and indeed as at the *Hearing Date*²⁴ such as to render the Notice of Opposition (and the Statement of Ground) *nugatory*.
6. In other words, the *PAR* was proceeding on the basis that the *Opponent* was seeking to oppose an alleged right of the *Applicant's* which was *not* in existence as at the *Opposition Filing Date* (and the *Hearing Date*).
7. Both parties made substantial submissions²⁵ to me at the interlocutory hearing.
8. Upon consideration, I do not think that it is necessary to debate upon such substantial and indeed, important issues pertaining to the *scope* of the right granted to the *Applicant* (and opposed by the *Opponent*) at this stage of proceedings, and in an interlocutory hearing intended to resolve *procedural defaults*.
9. The substantive merits of the *Applicant's* objections, that is, whether the opposition should be directed at the GI itself, and not a translation of the GI, should be dealt with at a full hearing.
10. This is further supported by the fact that there is a lack of recourse by the *Opponent* to an appeal for the purposes of this interlocutory hearing. This is in contrast to the situation if the *Opposition to Registration* proceeds to a full hearing. In such an

²³ Section 4(6)(b) reads:

This section shall apply to any use of a registered geographical indication which identifies any agricultural product or foodstuff (**other than a wine or a spirit**) belonging to a category of goods listed in the Schedule, in relation to any goods which are of the same category as that agricultural product or foodstuff, but which did not originate in the place indicated by the registered geographical indication, *whether or not...the registered geographical indication is used in translation.*

[All emphasis mine]

²⁴ Section 4(6) only came into effect on 19 November 2019 (see the Geographical Indications Act 2014 (Commencement) (No. 2) Notification 2019 at [2]).

²⁵ Opponent's written submissions span 30 pages while the *Applicant's* span 34 pages (including rebuttals but excluding annexes). In relation to bundles of authorities, the Opponent tendered 2 volumes, totaling 376 pages while the *Applicant* tendered 2 volumes as well as a further bundle, totaling 683 pages.

event, any appeal to the High Court can, and indeed should, include a deliberation as to the issues referred to in [7] – [9] above.

11. Rather, I am of the view that the Notice of Opposition should be allowed as long as all the procedural requirements for the filing of a Notice of Opposition as per the **GIR** have been complied with.
12. In this regard, I agree with the **Opponent** that Rule 28 of the **GIR**, has been complied with here. Specifically, the **subject matter** of the Opposition has been **duly identified**²⁶ in the Statement of Grounds (which I read to refer to the English translation of the subject GI) and that is all that is necessary for compliance with Rule 28(1) of the **GIR**.
13. Accordingly, the Notice of Opposition is **valid**. The **Applicant** is directed to file its Counter-statement and supporting evidence within 6 weeks from the date of this decision, that is, on or before **21 December 2020** (Rule 29 of the **GIR**).
14. As this interlocutory hearing is tied to the **Opposition to Registration**, costs pertaining to this hearing shall be taken into account at the **Opposition to Registration**.

Legislation discussed:

Geographical Indications Act (2014) Sections 4 and 41 (as at the **Opposition Filing Date** and the **Hearing Date**)

Geographical Indications Rules (2019) rules 27, 28 and 29 (as at the **Opposition Filing Date** and the **Hearing Date**)

Cases referred to:

Application by OOO “TVM Trade” To Strike Out Notice of Opposition and Objection Thereto by Societe Des Produits Nestle SA [2014] SGIPOS 12

Representation:

Ms Winnie Tham and Mr Marcus Liu (Amica Law LLC) for the **Applicant**
Ms Catherine Lee and Mr Desmond Chew (Rodyk IP) for the **Opponent**

²⁶ Section 2 read with section 4(6)(b) (see above).

Section 2 reads:

2.—(1) In this Act, unless the context otherwise requires —

“geographical indication” means any indication used in trade to identify goods as originating from a place, provided that —

(a) the place is a qualifying country or a region or locality in a qualifying country; and

(b) a given quality, reputation or other characteristic of the goods is essentially attributable to that place.