

**IN THE GENERAL DIVISION OF
THE HIGH COURT OF THE REPUBLIC OF SINGAPORE**

[2023] SGHC 77

Tribunal Appeal No 8 of 2022

Between

Fonterra Brands (Singapore)
Pte Ltd

... Appellant

And

Consorzio del Formaggio
Parmigiano Reggiano

... Respondent

JUDGMENT

[Intellectual Property] – [Geographical Indications] – [Qualification of rights]
– [Translations of geographical indications]

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Fonterra Brands (Singapore) Pte Ltd
v
Consorzio del Formaggio Parmigiano Reggiano

[2023] SGHC 77

General Division of the High Court — Tribunal Appeal No 8 of 2022
Dedar Singh Gill J
6 February 2023

31 March 2023

Judgment reserved.

Dedar Singh Gill J:

1 Is “Parmesan” a translation of “Parmigiano Reggiano”? The present appeal turns on this very question.

2 The Geographical Indications Act 2014 (Act 19 of 2014) (“the GIA”) accords protection to all registered geographical indications, including the geographical indication “Parmigiano Reggiano” owned by Consorzio del Formaggio Parmigiano Reggiano (“the Respondent”) for cheese. This protection extends to any unauthorised use of a geographical indication in translation. Third parties may, however, submit a request to qualify the scope of such protection from extending to specific terms on the basis that such terms are *not* translations of the geographical indication in question. This was exactly what Fonterra Brands (Singapore) Pte Ltd (“the Appellant”) did with respect to the Respondent’s geographical indication, asserting that the term “Parmesan” is not a translation of “Parmigiano Reggiano”. Unsurprisingly, the Respondent

opposed the request. The Principal Assistant Registrar Sandy Widjaja (“the PAR”) who heard this matter found in favour of the Respondent – *ie*, that “Parmesan” is a translation of “Parmigiano Reggiano” and should therefore be accorded protection under the GIA. The Appellant appeals against the PAR’s decision, thereby presenting the High Court with its first case relating to the qualification of rights process mentioned above.

3 This appeal is by way of rehearing and the evidence used on appeal must be the same as that used before the PAR, with no further evidence to be given unless the court permits otherwise: rr 28(4)–(5) of the Supreme Court of Judicature (Intellectual Property) Rules 2022 (“the SCJ(IP)R”). The court therefore hears the matter afresh; there is no requirement that a “material error of principle” must be shown before intervention is warranted: see *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* [2022] 5 SLR 575 at [11]–[12]. Nevertheless, I will consider the learned PAR’s decision as and when appropriate as the parties have based substantial portions of their submissions in relation to her findings.

Facts

The parties

4 The Appellant is a wholly-owned subsidiary of Fonterra Co-operative Group Limited, a New Zealand-based multinational co-operative company owned by 10,000 dairy farmers.¹ The company is involved in the collection, manufacture and sale of milk and milk-derived products,² which it exports to

¹ Respondent’s Written Submissions dated 2 December 2022 (“RWS”) at para 3; Appellant’s Bundle of Documents dated 10 August 2022 (“ABOD”) at pp 555-556.

² ABOD at p 556.

over 140 countries.³ These products include cheese sold by the Appellant under the “Perfect Italiano” trade mark.⁴ This cheese, which is produced in Australia, is marketed as “traditional style parmesan” and adopts the colours of the Italian national flag on its packaging.⁵

5 The Respondent is a voluntary consortium of Parmigiano Reggiano cheese producers that was established as a non-profit organisation in Italy in 1934. It is tasked by the Italian Ministry of Agricultural, Food Sovereignty and Forestry with the protection, promotion, enhancement, consumer information and general care of the interests relating to Parmigiano Reggiano cheese.⁶

The history of Parmigiano Reggiano

6 As “Parmigiano Reggiano” takes centre stage in this appeal, it is helpful to briefly examine the origins of the term and the product which it refers to. According to the statutory declaration of Mr Nicola Bertinelli, the legal representative of the Respondent, “Parmigiano Reggiano” cheese was first produced in the 1200s in monasteries located in Parma and Reggio Emilia.⁷ The cheese was subsequently traded across Europe, to places such as Germany, France and Spain.⁸ Over the centuries, this cheese has become associated with the term “Parmigiano Reggiano”, with the words “Parmigiano” and “Reggiano”

³ ABOD at p 469.

⁴ ABOD at p 446.

⁵ ABOD at pp 448, 526.

⁶ RWS at para 2.

⁷ ABOD at p 46.

⁸ ABOD at p 47.

meaning “of Parma” and “of Reggio Emilia” respectively.⁹ This development occurred in spite of the fact that the cheese was also being produced in other surrounding provinces such as Bologna and Modena.¹⁰ As production of “Parmigiano Reggiano” expanded in the 1900s, dairy farmers created the Respondent as a vehicle to manage competition from cheaper imitation products.¹¹ These facts have not been disputed by the Appellant.

7 The term “Parmigiano Reggiano” has been recognised as a Protected Designation of Origin in the European Union (“the EU”) since 1996.¹² The legal basis for such protection is Art 11 of Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012. This designation identifies “Parmigiano Reggiano” cheese as cheese originating from specified regions in Italy which bears particular qualities or characteristics.

Procedural history

8 On 23 April 2019, the Respondent filed an application with the Intellectual Property Office of Singapore (“IPOS”) to register “Parmigiano Reggiano” as a geographical indication in respect of cheese originating from Italy.¹³ This application successfully proceeded to registration on 22 June 2019.

9 On 16 September 2019, the Appellant filed a request to qualify the rights conferred on the geographical indication “Parmigiano Reggiano” under

⁹ ABOD at pp 47 and 149.

¹⁰ AWS at para 104; RWS at para 69(b).

¹¹ ABOD at p 125.

¹² ABOD at p 53.

¹³ ABOD at p 4.

s 46(1)(b) read with s 46(2)(b) of the GIA on the basis that “Parmesan” is not a translation of the registered geographical indication “Parmigiano Reggiano” (“the Request”). The Request therefore sought to limit the protection accorded to the geographical indication from encompassing the use of the term “Parmesan”.¹⁴

10 On 12 November 2019, the Registrar of Geographical Indications (“the Registrar”) proposed to allow the Request and published the Appellant’s qualification of rights in the Geographical Indications Journal for opposition purposes pursuant to r 40(4) of the Geographical Indications Rules 2019 (“the GIR”).¹⁵ The Respondent filed an opposition to the Request on 12 March 2020 (“the Opposition”).¹⁶

Decision below

11 The Opposition was heard on 15 March 2022 by the learned PAR,¹⁷ who allowed the Opposition and rejected the Request.¹⁸ Her findings are summarised in the following paragraphs.

12 The PAR made two preliminary points: (a) the Appellant’s case was not inadequately pleaded,¹⁹ and (b) the burden of proof to establish whether a

¹⁴ Appellant’s Written Submissions dated 2 December 2022 (“AWS”) at paras 10-11.

¹⁵ AWS at para 12.

¹⁶ AWS at para 13.

¹⁷ AWS at para 13.

¹⁸ RWS at para 1.

¹⁹ ABOD at p 564.

particular term is or is not a translation of a geographical indication falls on the party opposing the qualification of rights.²⁰

13 On the substantive ground of opposition, the PAR clarified that the request for qualification by the Appellant was confined to s 46(1)(b) read with s 46(2)(b) of the GIA.²¹ In other words, the Appellant was applying for the qualification of rights solely on the ground that the term “Parmesan” was not a translation of the registered geographical indication “Parmigiano Reggiano”. It was *not* the Appellant’s case that, for instance, the term “Parmesan” was or had become the generic name for such products.²² Accordingly, the PAR confined her analysis to the question of whether “Parmesan” was a translation of “Parmigiano Reggiano”.

14 The PAR then considered what the term “translation” refers to under the GIA. She found that “translation” refers to the “question of whether words have the same meaning in a different language”.²³ She made four additional comments:

- (a) A faithful translation (which captures the essence of the relevant word/phrase) should be preferred over a literal translation as the former would be “more accurate”;²⁴

²⁰ ABOD at p 563.

²¹ ABOD at p 540.

²² ABOD at p 540.

²³ ABOD at p 565.

²⁴ ABOD at p 572.

- (b) What was required was a translation of the geographical indication “as a whole”;²⁵
- (c) There was no requirement that the translation be the only translation;²⁶ and
- (d) There was no limitation in s 46 of the GIA which required the translation of the geographical indication to be an English translation.²⁷

The central inquiry before the PAR was therefore whether the geographical indication “Parmigiano Reggiano” could be converted from its original language (*ie*, Italian) into “Parmesan” (in English or otherwise).²⁸

15 In answering this question, the PAR accepted the Respondent’s evidence pertaining to the following dictionary entries:

- (a) The Collins Dictionary, which states that “Parmigiano Reggiano” is defined as “another name for Parmesan cheese” in English;
- (b) The Oxford Dictionary, which defined “parmigiano” as referring to “parmesan cheese”; and
- (c) The Larousse Italian-French Dictionary, which defines “Parmigiano” as “Parmigiano (Reggiano)” or “Parmesan m” in French.

²⁵ ABOD at p 564.

²⁶ ABOD at p 565.

²⁷ ABOD at p 565.

²⁸ ABOD at p 568.

On the other hand, she rejected the Appellant’s argument that a translation of a geographical indication is dependent on how the term has been used in the marketplace. She therefore did not take into account the Appellant’s evidence allegedly pertaining to consumer perception.²⁹ Such evidence bore greater significance to the question of whether “Parmesan” had become generic, which was not pleaded by the Appellant.³⁰ She clarified that such evidence remains relevant to the issue of translation only to the extent that it has been captured within the dictionary entries.³¹

16 Based on the evidence before her, the learned PAR concluded that the Respondent had succeeded in establishing, on a balance of probabilities, that “Parmesan” was a translation of “Parmigiano Reggiano”. The Respondent’s evidence comprised entries in reputable dictionaries and the PAR saw no reason to doubt that the references to “Parmigiano Reggiano” in those entries pointed toward the geographical indication.³²

The parties’ cases

The Appellant’s case

17 The Appellant refutes the Respondent’s complaint that its case was inadequately pleaded as the Respondent was given fair notice of the case which it had to meet.³³ In any case, the Respondent has not given notice that it intends

²⁹ ABOD at p 548.

³⁰ ABOD at pp 577-578.

³¹ ABOD at p 573.

³² ABOD at p 574.

³³ Appellant’s Written Reply Submissions dated 9 January 2023 (“AWRS”) at paras 9–10.

to contest the PAR’s ruling on this point, which is required under the SCJ(IP)R. The Appellant also defends the PAR’s holding that the Respondent bears the burden of proof in opposition proceedings.

18 Turning to the question of whether “Parmesan” is a translation of “Parmigiano Reggiano”, the Appellant submits that the PAR erred in her findings in three main aspects.

19 The first aspect pertains to the PAR’s conclusions on the meaning of “translation” under the GIA. While the Appellant broadly agrees with the plain meaning of “translation” as referring to the action of converting from one language to another, it contends that faithful translations should be eschewed in favour of a strict literal approach to translations.³⁴

20 The second aspect concerns the evidence which the PAR found relevant to the translation inquiry. The Appellant highlights that the PAR erred in relying on dictionary extracts *alone*. Instead, it submits that the Respondent should have adduced a translation of “Parmigiano Reggiano” from a qualified translator.

21 In addition, the Appellant argues that consumer perception must be considered in the determination of whether a term is a translation of a registered geographical indication. The Appellant asserts that the Respondent has failed to adduce sufficient evidence in this regard. On the contrary, it argues that consumers regard “Parmesan” cheese and “Parmigiano Reggiano” cheese to refer to different products.³⁵

³⁴ AWS at paras 37-38 and 74-77.

³⁵ AWS at pp 30-31.

22 The third aspect involves the probative value which the PAR placed on the three dictionary extracts exhibited by the Respondent.³⁶ According to the Appellant, these extracts do not show that the Italian words “Parmigiano Reggiano” may be converted to “Parmesan” in English or French.³⁷

23 As a final point, the Appellant submits that the additional authorities cited in the Respondent’s written submissions should not be relied upon. These include decisions from foreign jurisdictions³⁸ and the Explanatory Statement to the Geographical Indications (Amendment) Bill 2020 (“the Explanatory Statement”).

The Respondent’s case

24 In response, the Respondent claims that the appeal is incongruous with the ground initially pleaded in the Request. The Respondent therefore insists that the Appellant stands by its incorrectly pleaded case.³⁹ The Respondent also disagrees with the PAR’s finding that the burden of proof in such proceedings falls on the Respondent.

25 On the question of whether “Parmesan” is a translation of “Parmigiano Reggiano”, the Respondent maintains that the PAR’s decision should be upheld. It makes three main points.

³⁶ AWS at para 40.

³⁷ AWS at paras 46-48.

³⁸ AWS at para 131.

³⁹ RWS at para 22.

26 First, the Respondent agrees with the PAR’s definition of a “translation”, which refers to whether words have the same meaning in a different language.⁴⁰ It also takes the position that a faithful translation should be preferred over a literal one.⁴¹

27 Second, the Respondent echoes the PAR’s finding that dictionaries may be considered to shed light on the meaning of words in the English language.⁴² The Respondent states that certified translations are not necessary to determine the meaning of words,⁴³ and that translators themselves also refer to dictionary definitions to perform their translations.⁴⁴ The Respondent agrees with the PAR that consumer perception is generally irrelevant to the translation inquiry, with the only exception being where such perception is captured as part of the history and etymology of the term.⁴⁵ As such, marketplace evidence should be excluded from the translation inquiry. In any case, the Appellant’s evidence is insufficient to show that “Parmesan” is not a translation of “Parmigiano Reggiano”.⁴⁶

28 Third, the Respondent argues that the evidence relied on sufficiently demonstrates that “Parmesan” is a translation of “Parmigiano Reggiano”.⁴⁷

⁴⁰ RWS at para 50.

⁴¹ RWS at paras 60-61.

⁴² RWS at para 52.

⁴³ Respondent’s Reply Submissions dated 9 January 2023 (“RRS”) at para 27.

⁴⁴ RRS at para 30.

⁴⁵ RWS at para 55.

⁴⁶ RWS at para 84.

⁴⁷ RWS at para 65.

Issues to be determined

- 29 In my judgment, the following issues arise for determination:
- (a) Whether the Appellant’s pleaded case prevents it from appealing the PAR’s decision that “Parmesan” is a translation of “Parmigiano Reggiano”;
 - (b) Who bears the burden of proof where a proposed qualification of rights is opposed; and
 - (c) Whether “Parmesan” is a translation of “Parmigiano Reggiano”.

Issue 1: Whether the Appellant’s pleaded case prevents it from appealing the PAR’s decision

30 The Respondent relies on *Bumi Geo Engineering Pte Ltd v Civil Tech Pte Ltd* [2015] 5 SLR 1322 (“*Bumi Geo*”) at [56] for the proposition that parties must stand by their pleaded cases in litigation proceedings. It submits that the Appellant’s initially pleaded case, as evinced from the Statement of Grounds filed together with the Request as well as the Statement of Grounds to the Appellant’s counter-statement, relates only to the issue of whether “Parmesan” is a translation of the *single word* “Parmigiano”. This, in its view, should prevent the Appellant from subsequently submitting on appeal that “Parmesan” is not a translation of the *term* “Parmigiano Reggiano”.

31 In response, the Appellant argues that its pleaded case has provided the Respondent “clear and unequivocal notice” of the case which it has to meet.⁴⁸ There was therefore no prejudice or surprise occasioned by the Appellant to the

⁴⁸ AWRS at para 10(b).

Respondent, who has “always been clear that the relevant inquiry is whether “Parmesan” is a translation of “Parmigiano Reggiano” as a whole”.⁴⁹ In any case, the Respondent should not be allowed to raise this contention as it did not give notice of its intention to contest this point on appeal pursuant to r 27(1)(a) of the SCJ(IP)R.

32 On this issue, the PAR held that “[w]hile it certainly helps if there is consistency in the related documents, pleadings, evidence and otherwise, what is crucial is Part 5 of Form GI2 (form for a Request for Qualifications of Rights)” [emphasis in original omitted], which clearly states that the protection of the geographical indication “Parmigiano Reggiano” should not extend to the use of the term “Parmesan”.⁵⁰

33 I see no reason to disturb the PAR’s findings on this point. As I observed in *Yitai (Shanghai) Plastic Co, Ltd v Charlotte Pipe and Foundry Co* [2022] 3 SLR 656 (“*Yitai*”) at [100], the fundamental purpose of pleadings is to define the issues and inform the opponent in advance regarding the case which he has to meet, such that he is able to take steps to deal with the case. This avoids the unhappy situation of parties being caught by surprise at the hearing. For these reasons, parties are therefore not allowed to raise issues beyond the scope of their pleadings. For example, in *Bumi Geo*, the High Court did not allow the plaintiff to apply either a ten per cent or an 18 per cent reduction in calculating a particular metric for the purposes of determining payments accruing to the plaintiff because neither figure was included in the plaintiff’s pleadings. I clarify that for the present proceedings, the Request (in Form GI2), the notice of

⁴⁹ AWRS at para 11.

⁵⁰ ABOD at p 564.

opposition (in Form GI13) and the counter-statement (in Form GI18) effectively constitute pleadings. This is consistent with the approach adopted in contested trade mark registration applications where notices of opposition and counter-statements effectively constitute pleadings, as noted in *Yitai* at [100(a)] citing *CLUB EUROPE Trade Mark* [2000] RPC 329 at 336:

Notices of opposition and counterstatements play the part of pleadings in contested trademark registration applications. To some extent supporting statutory declarations may be regarded as complementing that pleading function.

34 The present case, however, is not one where the Appellant has completely failed to plead the material facts of its case. On the contrary, I find that the Appellant has adequately pleaded the material fact that “Parmesan” is not a translation of “Parmigiano Reggiano”. This was stated not only in Part 5 of Form GI2 (as observed by the PAR),⁵¹ but also in the second paragraph of the Statement of Grounds accompanying the Appellant’s counter-statement.⁵² Moreover, the Appellant stated in its Statement of Grounds accompanying the Request that it was applying for the qualification of rights under s 46(2)(b) of the GIA,⁵³ which in turn refers to the ground on which a term is not a translation of the *geographical indication*. This would have indicated to the Respondent that the Appellant’s case is that “Parmesan” is not a translation of the *entire* geographical indication “Parmigiano Reggiano”.

35 In addition, while the Appellant’s forms do make some inconsistent references to “Parmesan” not being a translation of “Parmigiano”,⁵⁴ I cannot see

⁵¹ ABOD at p 15.

⁵² ABOD at p 36.

⁵³ ABOD at p 18.

⁵⁴ ABOD at p 18.

how this caused any material confusion to the Respondent regarding the case it had to meet or how any prejudice was occasioned to the Respondent by way of this inconsistency. On the contrary, the Respondent acknowledges that “Parmigiano” and “Parmigiano Reggiano” were “used interchangeably in the past to refer to the same product... and continue to be used in this manner today”.⁵⁵ It follows from this recognition that the Respondent would have understood the Appellant’s statements to mean that the Request was premised (at least in part) on “Parmesan” not being a translation of “Parmigiano Reggiano”. In any event, the Respondent was accorded the opportunity to respond to the Appellant’s arguments fully, both before the PAR and in the present appeal.⁵⁶

36 Accordingly, as the Appellant has expressly pleaded that the protection of the geographical indication “Parmigiano Reggiano” should not extend to the use of the term “Parmesan” pursuant to s 46(2)(b) of the GIA and the Respondent was not prejudiced by the inconsistencies within the Appellant’s forms and documents, I dismiss the Respondent’s complaint that the Appellant’s pleaded case prevents it from bringing its current arguments on appeal.

Issue 2: Who bears the burden of proof where a proposed qualification of rights is opposed

37 As a starting point, ss 103 and 104 of the Evidence Act 1893 (Cap 97, 1997 Rev Ed) (“the EA”) provide the relevant evidentiary principles pertaining to the burden of proof. These provisions state:

⁵⁵ RWS at para 71.

⁵⁶ Minute Sheet dated 6 February 2023 (“Minute Sheet”) at p 16.

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.

(2) When a person is bound to prove the existence of any fact, it is said that the burden of proof lies on that person.

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.

38 I first deal with the parties’ arguments arising from the Geographical Indications Consultation Paper dated 1 November 2013 by IPOS (“the IPOS Consultation”). It states that applicants of geographical indications are not required to specify which translations they wish to protect. Instead, if a geographical indication is registered, its owner may bring an action against third parties who use purported translations of the geographical indication.⁵⁷ Alternatively, third parties may themselves apply to qualify the geographical indication rights from extending to purported translations.

39 The PAR held that there was no automatic protection for purported translations of geographical indications because applicants do not need to specify which translations are protected. As such, when an owner of a registered geographical indication seeks to *extend* the protection of its geographical indication to a purported translation, whether by way of enforcement proceedings or by opposing a third party’s request for the qualification of rights, the owner must bear the burden of proof pursuant to s 103(1) of the EA. Conversely, the Respondent argues that the IPOS Consultation is silent on whether translations are protected by default. If such default protection exists, then the party requesting for the qualification of rights should bear the burden

⁵⁷ RWS at para 27.

of proving that the protection accorded to the geographical indication should be *limited*.⁵⁸

40 I am inclined to agree with the PAR on this point. If applicants of geographical indications do not indicate the specific translations which they seek protection for at the outset, it is difficult to see how there can exist default protection for any and all purported translations of these geographical indications. If that were the case, the scope of the rights pertaining to the geographical indication would necessarily be amorphous from the point of registration. Taking the view that translations are not automatically protected upon registration, I find that an application of s 103(1) of the EA indicates that the burden should lie on the party opposing the qualification of rights, as it is this party which seeks to persuade the court that his rights ought to be extended.

41 The parties also dispute the implications of r 40 of the GIR on the issue regarding the burden of proof. Rule 40 states that:

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.

(3) Except where the request is made by an applicant for the registration of the geographical indication or a registrant (as the case may be), the requestor must serve on the applicant or the registrant, as the case may be —

(a) a copy of the request in Form GI2; and

(b) where evidence is required by the Registrar under paragraph (2), such evidence,

⁵⁸ RWS at para 29.

at the same time those documents are filed with the Registrar.

(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 (subject to section 46(6) of the Act) enter the qualification of rights in the register.

42 The Respondent places particular emphasis on r 40(5). As the Registrar must be “satisfied that either or both the grounds in section 46(2) of the [GIA] is or are made out” even where no notice of opposition is filed, the burden of proof in such situations to show that the relevant term is not a translation of the geographical indication necessarily falls on the party requesting the qualification of rights. The Respondent further argues that the Registrar could not have been satisfied in any way given that the Appellant had, at that point, only adduced a two-page Statement of Grounds along with its Form GI2.

43 The Appellant’s response is that r 40(5) of the GIR only applies in situations where no notice of opposition has been filed. In any case, given that the Registrar proposed to allow the request and published the proposed qualification under r 40(4) of the GIR, this means that the Registrar would already have been satisfied that the grounds under s 46(2)(b) of the GIA have been made out.

44 This repeats the findings of the PAR. She held that the reference in r 40(5) of the GIR to the need for the Registrar to be “satisfied” is consistent with the Registrar’s powers to request for evidence under r 40(2) of the GIR. As the Registrar did not ask for more evidence and the request was subsequently

published under r 40(4),⁵⁹ he must have been satisfied that at least one of the grounds under s 46(2)(b) of the GIA had been fulfilled at the point of publication.

45 I prefer the Appellant's view. Strictly speaking, r 40(5) of the GIR does not apply to the present case as the Respondent *has* filed a notice of opposition. More importantly, it will make for an odd state of affairs if the Registrar proposes to allow the request for the qualification of rights without first being satisfied that the grounds in s 46(2) of the GIA have been made out. Consider, for instance, a situation where no notice of opposition has been filed. It is inconceivable that the Registrar will find that the grounds under s 46(2) of the GIA are not made out *after* it has proposed to allow the request. To do so would mean that the Registrar had proposed to allow the request without having been satisfied that sufficient evidence was adduced, even though the Registrar was fully entitled to call for such evidence at any time pursuant to r 40(2) of the GIR. Therefore, I find that the Registrar must have been satisfied that at least one of the grounds in s 46(2) of the GIA was made out when he published the request. Applying s 104 of the EA, this means that if no evidence was given on either side, the party opposing the qualification of rights (the Respondent) would fail as the Registrar, already satisfied, would direct the qualification of rights to be entered in the register. Accordingly, the burden of proof lies on the Respondent.

46 I also reject the Respondent's arguments that the Appellant's two-page Statement of Grounds was necessarily insufficient in satisfying the Registrar that at least one of the grounds under s 46(2) of the GIA was made out. Examining the Statement of Grounds, the Appellant does provide several points

⁵⁹ ABOD at p 563.

of distinction between “Parmesan” cheese and “Parmigiano Reggiano” cheese.⁶⁰ I therefore do not find the Statement of Grounds to be so devoid of justification that the Registrar could not have concluded, whether correctly or incorrectly, that “Parmesan” was a possible translation of “Parmigiano Reggiano”.

47 In the light of the analysis above, I find that the burden of proof where a proposed qualification of rights is opposed lies on the opposing party.

Issue 3: Whether “Parmesan” is a translation of “Parmigiano Reggiano”

Preliminary observations

48 Before addressing the substantive points within this issue, I make four preliminary observations.

49 First, to set the scene, I begin with a summary on the background of the GIA. The GIA was first enacted in 1998 to enhance the level of protection for geographical indications and to enable Singapore to comply with its obligations under the World Trade Organisation Agreement on Trade-Related Aspects of Intellectual Property Rights: *Singapore Parliamentary Debates, Official Report* (26 November 1998) vol 69 at col 1704 (Assoc. Prof. Ho Peng Kee, Minister of State for Law).

50 A re-enactment of the 1998 version of the GIA was proposed in 2014 to ensure compliance with Singapore’s obligations under the EU-Singapore Free Trade Agreement (“EUSFTA”). These obligations include the establishment of a system for the registration and protection of geographical indications (Art 10.17 of the EUSFTA). As part of this system, Parliament approved a

⁶⁰ ABOD at pp 18-19.

process where third parties could request for applicants to disclaim certain elements of the geographical indication for which registration is sought.⁶¹ This includes situations where third parties believe that a term, which is thought to be a possible translation of the geographical indication to be registered, is (a) actually a generic term and a common name for the goods in question or (b) not a translation of the geographical indication. This process forms the legal backdrop for the present dispute. The re-enacted version of the GIA, however, only came into force in 2019 due to further legal hurdles which had to be crossed by the European Parliament.

51 Second, it is clear from the Appellant’s pleadings that its case, both here and before the PAR,⁶² is *not* that the term “Parmesan” has become the generic or common name for “Parmigiano Reggiano”. Instead, it is relying *solely* on the ground in s 46(2)(b) read with s 46(1)(b) of the GIA – that “Parmesan” is not a translation of “Parmigiano Reggiano”. The scope of the appeal is therefore confined to the translation inquiry.

52 Third, it is unlikely that many cases will turn on the translation ground. This observation was also made by Advocate General Ján Mazák in *Commission of the European Communities v Germany* [2008] ETMR 32 (“*CMC v Germany*”). Commenting on the EU legislation, he stated at [AG43]:

“[T]he Basic Regulation is silent as to how to determine what constitutes a translation of a PDO. This question is unlikely to raise difficulties very often, as in most cases either the PDO will not be translated but used in the form used in the language of the country of origin of the PDO or the translation will be so literal that no doubt may arise.”

⁶¹ Appellant’s Bundle of Authorities dated 2 December 2022 (“ABOA”) at p 642.

⁶² ABOD at p 540.

53 Fourth, the present case is also unique in so far as it concerns the translation of the two-word term “Parmigiano Reggiano” instead of a geographical indication consisting only of a single word. In my view, disputes concerning the translation of single-word geographical indications may lend themselves more easily to the courts’ determination than the present case. That being said, I am satisfied that the principles laid out in the following sections will nonetheless be relevant for translation inquiries relating to both geographical indications comprising single words or short terms.

What the meaning of “translation” is in the context of the GIA

54 The central inquiry in this case is therefore whether “Parmesan” is a translation of the geographical indication “Parmigiano Reggiano”. This requires me to first address the meaning of the term “translation” as utilised in the GIA. I agree that the plain meaning of “translation” is the “action of converting from one language to another” or the “rendering from one language to another”.⁶³ This definition was adopted by the PAR and has not been contested by either party.⁶⁴ The parties also do not dispute that:

- (a) What is required is a translation of the geographical indication “as a whole”;⁶⁵ and
- (b) There is no requirement that the translation be the only translation of the geographical indication.⁶⁶

⁶³ ABOD at p 566.

⁶⁴ AWS at para 44; RWS at para 50.

⁶⁵ AWS at paras 64-65; RWS at para 59.

⁶⁶ RWS at para 60.

55 The parties' positions diverge, however, on whether a faithful or a strict literal approach to translation should be taken. In support of its argument that a strict literal approach should prevail, the Appellant seeks to rely on the Explanatory Statement given by Senior Minister of State for Law Mr Edwin Tong Chun Fai during the Parliamentary Debates in 2020. This statement concerned certain amendments which were made to the GIA after its re-enactment in 2019.⁶⁷

56 Addressing changes to the treatment of variants of geographical indications during the application process, Mr Tong used an example of oranges grown on Pulau Ubin to demonstrate the differences between a variant, a transliteration and a translation. Mr Tong explained that these oranges are known in Mandarin as “乌敏橙” (pronounced Wu Min Cheng). According to him, a translation of this term would be “Ubin orange” since “Ubin” is a translation of “乌敏” and “orange” is a translation of “橙”. Mr Tong also stated that the term “Pulau Ubin orange” would not be a translation of “乌敏橙”. Although Mr Tong did not provide further elaboration on this point, the Appellant takes this illustration to mean that a word-for-word strict approach to translation should be adopted.

57 Conversely, the Respondent suggests that the reasoning behind Mr Tong's example was simply that a translated term cannot contain any additional words or meanings.⁶⁸ In his example, “Pulau Ubin orange” was not a translation of “乌敏橙” because the additional word “Pulau”, which means island, was not reflected within the original Mandarin term. This difficulty does not arise on the

⁶⁷ AWS at para 70.

⁶⁸ RRS at para 15.

present facts because “Parmesan” is a single word. There are no additional words to be considered.

58 The PAR held that a faithful translation should be adopted because it captures the essence of the word or phrase in question.⁶⁹ She gave the examples of two phrases – “terima kasih” and “sama sama” – in Bahasa Indonesia. The literal translations of these terms are “receive give” and “same same”, while a faithful translation results in “thank you” and “you are welcome” respectively. With regard to Mr Tong’s speech, she held that his illustration was used solely because it was the clearest example to explain the distinctions between “variations”, “translations” and “transliterations”. As such, she took the view that the example should not prevent or restrict the application of those concepts from being further developed. Instead, a faithful translation would be more accurate and thus preferred.

59 To my mind, it is altogether sensible for a faithful translation to be adopted for the purposes of the GIA. A faithful translation expresses the “historic, cultural, legal and economic reality that attaches to the registered name and to the product covered by that registration”: *re Criminal Proceedings against Bigi (Consorzio del Formaggio Parmigiano Reggiano, intervening)* [2002] 3 CMLR 3 at [A50] (Opinion of Advocate General Philippe Léger).⁷⁰ While the Court of Justice of the European Communities did not decide this case on the translation issue, I nevertheless find the opinion of the Advocate General to be persuasive. Geographical indications serve to establish a link between the quality of a product and its geographical origin. Therefore, a

⁶⁹ ABOD at p 571.

⁷⁰ ABOA at p 545.

faithful translation will ensure that the meanings within these geographical indications – which allow them to fulfil their function – is retained within the purported translations. This, in turn, justifies the protection accorded to these translations. On the other hand, an insistence on word-for-word translations may result in inaccuracies in meaning, which may either allow protection to be extended in an unprincipled manner or unjustifiably restrict protection altogether (as is the risk in the present case).

60 I also do not consider Mr Tong’s Explanatory Statement to run counter to an adoption of faithful translations in the context of the GIA. I agree with the PAR that Mr Tong utilised that illustration only as a simple example to show the distinction between translations, transliterations and other variations of a geographical indication. He was not elaborating on the definition of the term “translation” or formulating an approach which the courts should take in translating geographical indications. On the contrary, his focus was on the set of amendments before Parliament pertaining to *variants* of geographical indications.

61 Given the reasons above, I find no reason to disagree with the PAR’s conclusion that a faithful translation which captures the meaning of the words in question ought to be preferred in the determination of whether a purported translation is the result of a conversion of the geographical indication from one language to another.

What evidence is relevant to the translation inquiry

62 I now address the next issue pertaining to the evidence which is relevant to the translation inquiry. The Appellant raises two main contentions: (a) expert evidence is necessary for the court to make a finding on whether “Parmesan” is

a translation of “Parmigiano Reggiano” and (b) evidence pertaining to consumer perception is relevant to the translation inquiry. I deal with these points in turn.

63 On the first contention, the Appellant submits that the Respondent should have adduced a translation of “Parmigiano Reggiano” from a qualified translator. According to the Appellant, translation “is a form of expert evidence” and translation evidence will only be admissible if the translator is appropriately qualified.⁷¹ This position stems from the fact that the court is “fundamentally not competent to translate foreign languages”. The Respondent’s failure to adduce expert evidence is therefore fatal to its case. Conversely, the Respondent argues that certified translations are not necessary to determine the meaning of words,⁷² and that translators also refer to dictionary definitions to perform their translations.⁷³

64 I am persuaded that expert evidence is not a necessary condition in the present case for the court to make a finding on whether “Parmesan” is a translation of “Parmigiano Reggiano”. The Appellant has cited two English authorities, *Illumina, Inc & Anor v TDL Genetics Ltd & Ors* [2019] EWHC 1497 (Pat) (“*Illumina*”) and *Sobrinho v Impresa Publishing* [2015] EWHC 3542 (QB) (“*Sobrinho*”), as support for the proposition that translation is a form of expert evidence which needs to be provided by qualified translators.⁷⁴ However, these cases do not assist me because they were concerned with the issue of translating words which were situated within a specific larger context. For

⁷¹ AWS at para 79.

⁷² RRS at para 27.

⁷³ RRS at para 30.

⁷⁴ AWS at para 79.

example, in *Illumina*, expert evidence was called to translate the Japanese word, また (or ‘mata’),⁷⁵ found in a conference abstract which comprised at least five sections: *Illumina* at [2] and [116]. It was common ground that the meaning of ‘mata’ depended on whether it was being used as a noun, an adverb or a conjunction and expert evidence was thus instructive: *Illumina* at [123] and [126]. Similarly, in *Sobrinho*, the English High Court was tasked with translating the Portuguese word “saque” located in the headline of an article. The meaning to be given to that word thus depended on how one read it, in its particular context: *Sobrinho* at [20].

65 These cases therefore do not establish any general rule that expert evidence is required for *all* translation-related issues. The absence of such a rule is supported by the Hearings & Mediation Department Circular 4.2 issued by the Hearing & Mediation Department of the Intellectual Property Office of Singapore. This circular, which provides guidance on the Registry’s practice with respect to evidentiary issues,⁷⁶ acknowledges that a certified translation is “desirable”⁷⁷ (but not necessary) in respect of the contents of foreign language *documents*. This clearly contemplates situations where the Registry decides on matters of translation *without* the assistance of certified translations. At the same time, the circular states that dictionary extracts may be taken into account where the content to be translated is “short”, for example, where “the meaning of a single foreign word” is sought.

⁷⁵ Minute Sheet at p 5.

⁷⁶ Respondent’s Supplementary Bundle of Authorities dated 9 January 2023 (“RSBOA”) at p 43.

⁷⁷ RSBOA at p 48.

66 On the present facts, I am inclined to adopt the view that the PAR was justified in solely relying on dictionary extracts to determine potential translations of the two-word term “Parmigiano Reggiano”. It is trite that the courts may refer to dictionaries to ascertain both the meaning of a word (see *Kellogg Co v Pacific Food Products Sdn Bhd* [1998] 3 SLR(R) 904 at [16] and [18]) as well as the use to which the thing denoted by the word is commonly put (see *Coca-Cola Company of Canada Limited v Pepsi-Cola Company of Canada Limited* [1942] 1 All ER 615 at 617, where the Privy Council referred to dictionaries to ascertain the meaning of the word “Cola” or “Kola”). In the context of translations, the case of *Dukhovskoi’s Applications* [1985] RPC 8 (“*Dukhovskoi’s Applications*”) demonstrates that dictionary extracts can be accorded significant weight. In that case, patent specifications were translated from Russian to English. While the translator, relying on one dictionary, translated the relevant Russian word as “carbon tetrafluoride”, the court accepted that the translation “fluorocarbon” taken from another reputable dictionary (which was adduced by one of the parties in evidence) was more accurate: *Dukhovskoi’s Applications* at 11.

67 Given the analysis in the preceding paragraphs, I am convinced that expert evidence is not strictly necessary for the present translation inquiry and that reliance may rightly be placed on dictionaries in situations (such as in the present case) where the content to be translated comprises a single stand-alone word or phrase. At its heart, the search for a faithful translation is a search for meaning. It is the conversion of words from one language to another while retaining their essence. Where these words are placed within a specific context, that context informs the meaning of the words through the addition of background, nuances and implications. It therefore stands to reason that the full meaning of these words will necessarily be lost if one were to use a dictionary

to ascertain the meaning of these words in isolation. In the present case, however, there is no broader context to speak of – the sole question is whether the Italian term “Parmigiano Reggiano”, by itself, can be translated into “Parmesan” (in English or otherwise). In such a situation, I see no reason why reputable dictionaries cannot be relied upon to provide the possible meanings attached to individual terms and thus to determine if one term is a translation of another. That being said, while on these facts it is tolerably clear that dictionary extracts are sufficient by themselves, parties may nevertheless be well-advised to seek certified translations in other cases, especially where context plays a larger role in the analysis.

68 On the second contention, the Appellant submits that the making of a translation involves “the putting into English that which is the exact effect of the language used under the circumstances”.⁷⁸ This means that whether a translation of “Parmigiano Reggiano” amounts to “Parmesan” is dependent on whether they refer to the same cheese products. According to the Appellant, this assessment cannot be achieved without taking consumer perception into account. In support of this position, the Appellant refers to the Opinion of Advocate General Mazák in *CMC v Germany*. There, the Advocate General opined at [AG49] that for “Parmesan” to be considered a translation of “Parmigiano Reggiano” within the meaning of Art 13(1)(b) of the Council Regulation (EEC) No 2081/92 of 14 July 1992 (“the Basic Regulation”), the two terms must generally be regarded by consumers as equivalent. In this case, the Appellant argues that consumers regard “Parmesan” cheese and “Parmigiano Reggiano” cheese to be different in terms of their geographical

⁷⁸ AWS at para 88.

origin, methods of presentation and production methods.⁷⁹

69 In response, the Respondent agrees with the PAR that consumer perception is generally irrelevant to the translation inquiry, with the only exception being where such perception is captured as part of the history and etymology of the term.⁸⁰ As such, marketplace evidence should be excluded from the translation inquiry. This position is supported by policy considerations, such as the need to maintain certainty in ordinary business transactions.⁸¹ In any case, the Appellant’s evidence is insufficient to show that “Parmesan” is not a translation of “Parmigiano Reggiano”.⁸²

70 It seems to me that the Appellant is attempting to admit the argument that the term “Parmesan” has become generic through the backdoor with its submissions on this point. A glimpse into this Trojan horse is provided by the statutory declaration of Mr Stanley Goh, a director of the Appellant. In this declaration, Mr Goh states that the Appellant “does not believe that the [geographical indications] system should be used to put restrictions in place on terms *which are customarily used to describe a variety of cheese*, or terms which have *become the customary name for a product in Singapore*” [emphasis added].⁸³ He further notes that the Appellant’s concern is that the EU’s geographical indications frameworks may be “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 [Appellant] and its predecessors”

⁷⁹ AWS at pp 30-31.

⁸⁰ RWS at para 55.

⁸¹ RWS at para 57.

⁸² RWS at para 84.

⁸³ ABOD at p 146.

[emphasis added].⁸⁴ The fact that this was the underlying crux of the Appellant's case was not lost on the PAR, who made similar observations in her grounds of decision.⁸⁵

71 The relevance of consumer perception to the issue of whether a geographical indication has become generic is obvious: *CMC v Germany* at [AG67]. After all, one cannot determine if a term has become the common name for a good or service if one does not look at how the term is understood and used. Nevertheless, as noted at [51], this issue does not arise for my determination because it was not pleaded.⁸⁶

72 For the purposes of the translation inquiry, I favour the position that consumer perception, as evinced through marketplace evidence, is generally irrelevant. Specifically, I find no reason to disturb the PAR's conclusion that consumer perception is relevant only to the extent that it has been reflected in the entries of reputable dictionaries. My reasons are as follows.

73 First, it is not immediately apparent how consumer perception or marketplace evidence is relevant to the translation of words. As established, translation asks whether words have the same meaning in a different language. But what contributes to a word's meaning? Words owe their meanings to the development of a language over long periods of time through human interaction and experiences – the substance held within them is not (and should not be) easily swayed by the whims of transient business, social or economic trends.

⁸⁴ ABOD at p 147.

⁸⁵ ABOD at pp 575-579.

⁸⁶ ABOD at p 578.

74 On the other hand, and at the risk of engaging too deeply with the metaphysical, given that words are vessels into which we humans imbue meaning, I agree that societal perceptions may bear relevance if they demonstrate that there has been a widespread shift in the meaning of specific words. This begs the question: what is the degree of consumer perception or marketplace evidence necessary to evince such a shift in meaning? Here, I agree with the PAR's suggestion that only such perception as captured in dictionary entries should be relevant.⁸⁷ Significant changes in meaning will logically be reflected in the entries of reputable dictionaries, as these entries will be the layperson's first port of call in ascertaining the proper meaning of particular words. This approach will avoid the need for the courts to consider (and balance) disparate and potentially opposing pieces of marketplace evidence in ascertaining the meaning of specific words.

75 Second, the exclusion of consumer perception (save to the extent that it is reflected in the dictionaries) with respect to the issue of translation will also serve to minimise uncertainty. To this end, the Respondent argues that the addition of consumer perception into the court's determination of translations may lead to differences in the meaning of particular words across various jurisdictions. I agree with this observation. It would indeed be a strange state of affairs if the same word, X, in Language A could be found to be a translation of Y in Language B in one country but not in another. Should consumer perception play a larger role in the translation analysis, more doubt may be generated on the parts of both the owner of the geographical indication as well as third parties as to the scope of protection engendered by the geographical indication. Such an outcome is undesirable and should be avoided.

⁸⁷ ABOD at p 573.

76 Third, the Advocate General’s opinion in *CMC v Germany* does not assist the Appellant. That case, which was decided by the Court of Justice of the European Communities (Grand Chamber) (“the Grand Chamber”), turned on the doctrine of evocation as referred to in Art 13(1)(b) of the Basic Regulation.⁸⁸ In sum, the court held that when consumers are confronted with the term “Parmesan”, the image triggered in their minds would be that of “Parmigiano Reggiano” cheese: *CMC v Germany* at [47]–[49]. The doctrine of evocation, however, is neither statutorily provided for in the GIA nor recognised under Singapore law (see *Scotch Whisky Association v Isetan Mitsukoshi Ltd* [2020] 3 SLR 725 at [39]). In any event, given that the Grand Chamber did not address its mind to the question of whether “Parmesan” is a translation of “Parmigiano Reggiano”,⁸⁹ I abstain from adopting the approach suggested by the Advocate General.

77 For the reasons above, I find that consumer perception is generally irrelevant to the question of whether a term is a translation of a geographical indication under the GIA save to the extent where such perception is reflected in extracts taken from reputable dictionaries. I reiterate that s 46(2)(b) of the GIA focuses on the protection of *translations* of geographical indications. Therefore, as long as a term is found to be a faithful translation of a registered geographical indication, it generally matters not what consumers within the marketplace perceive the words to refer to as long as the term does not amount to the generic or common name for the good or service in question. At the expense of repeating my earlier observation at [51], the ground pertaining to the potential genericism of the geographical indication has not been pleaded by the

⁸⁸ ABOA at p 468 (para 50).

⁸⁹ ABOA at p 468 (para 50).

Appellant.

Whether sufficient evidence has been adduced to prove that “Parmesan” is a translation of “Parmigiano Reggiano”

78 I turn finally to consider the sufficiency of the evidence before me in proving that “Parmesan” is a translation of “Parmigiano Reggiano”. Having found that the PAR was entitled to rely on the dictionary extracts, I now address the probative value of these extracts, which forms one of the main bones of contention between the parties on this issue.

79 The Respondent and the PAR found entries in the Collins Dictionary to be helpful in translating the term “Parmigiano Reggiano”. Specifically, the Collins Dictionary defined “Parmigiano Reggiano” in British English to mean “another name for Parmesan cheese”.⁹⁰ This shows, in the Respondent’s view, that the Italian words “Parmigiano Reggiano” can be converted into “Parmesan” in English.⁹¹ In response, the Appellant argues that the court should place no weight on the Collins Dictionary extract as the Collins Dictionary is an English dictionary and is therefore incapable of converting the Italian term “Parmigiano Reggiano” into the English language.⁹² Instead, the court should only rely on Italian-English dictionaries which are able to properly convert the meaning of Italian terms into English.

80 I do not find the Appellant’s dismissal of the Collins Dictionary extract convincing. The Collins Dictionary extract states (in full):

⁹⁰ Appellant’s Supplementary Bundle of Documents dated 2 December 2022 (“ASBOD”) at p 4.

⁹¹ RWS at para 65.

⁹² AWS at paras 51-53.

Parmigiano (in British English) noun

Another name for Parmigiano Reggiano

Parmigiano Reggiano (in British English) noun

Another name for Parmesan cheese

Parmesan cheese (in British English) noun

A hard dry cheese made from skimmed milk, used grated, esp on pasta dishes and soups

Although “Parmigiano Reggiano” is an Italian term, I am of the opinion that English dictionaries may nevertheless be useful in establishing the meaning of this term in English. This is because “Parmigiano Reggiano” has, through decades of usage, entered into the English vernacular. The term is therefore understood by people when used in the course of spoken or written English. Utilising a dictionary to establish the meaning of “Parmigiano Reggiano” in English is no different from looking up entries pertaining to, for instance, Latin phrases such as “prima facie” which have been integrated into common parlance.

81 The fact that “Parmigiano Reggiano” is reflected in the Collins Dictionary extract as a term in British English therefore does not, by itself, detract from the probative value of the extract. Instead, the extract demonstrates that “Parmigiano Reggiano” and “Parmesan” are understood to be interchangeable labels which refer to the same cheese. I thus find the Collins Dictionary extract persuasive in establishing the unity of meaning between the English word “Parmesan” and the Italian term “Parmigiano Reggiano”.

82 Next, the Respondent refers to the Oxford Dictionary extract, which defines “Parmigiano” as “Parmesan cheese”. The extract also sets out the

history and etymology of the word “Parmigiano”.⁹³ However, I do not place much weight on this extract as it makes no reference to the word “Reggiano” and thus does not assist in the translation of “Parmigiano Reggiano” as a whole.

83 Turning to the extract in the Larousse Italian-French Dictionary, the Italian term “Parmigiano” is defined as “Parmigiano (Reggiano)” or “Parmesan m” in French.⁹⁴ While the extract does not reflect the translation of the entire term “Parmigiano Reggiano”, it does equate “Parmigiano (Reggiano)” with “Parmesan m” (which refers to the masculine noun of Parmesan). A similar result is found in the Cambridge Italian-English Dictionary, which the Respondent had placed before the PAR. That extract defines the Italian term “parmigiano” as “parmigiano (reggiano)” and “parmesan cheese”.⁹⁵

84 I am minded to find that the extracts from the Larousse Italian-French Dictionary and the Cambridge Italian-English Dictionary support the Respondent’s position that “Parmesan” and “Parmigiano Reggiano” bear the same meaning. Given the history and etymology of the term “Parmigiano Reggiano”, as briefly summarised at [5],⁹⁶ it would be pedantic to find that the extracts are of no probative value at all simply because “Parmigiano (Reggiano)” is expressed in these dictionaries as a French or English term instead of an Italian term. This is because “Parmigiano Reggiano” is an undisputedly Italian term which has made its way into the vocabulary of Italy’s neighbouring countries by way of the extensive trading of the cheese which the

⁹³ RWS at para 65.

⁹⁴ ASBOD at pp 8-9.

⁹⁵ ABOD at p 372.

⁹⁶ ABOD at pp 46-49.

term refers to. As such, I find that the Larousse Italian-French Dictionary and the Cambridge Italian-English Dictionary show that the word “Parmesan” bears the same meaning as “Parmigiano Reggiano”. For the avoidance of doubt, I note that I am not prevented from referring to the Cambridge Italian-English Dictionary as well as the other dictionaries put before the PAR (see [3]).

85 The Respondent also adduced extracts from two French dictionaries before the PAR – the French Dictionary Antoine Furetière and the Dictionnaire de l'Academie francaise. These dictionaries define the French word “Parmesan” as “[e]xcellent cheese that comes from Parma”⁹⁷ and “[n]ame of a cheese which comes & that derives its name from the Duchy of Parma” respectively.⁹⁸ The Appellant argues that little weight should be placed on these extracts because the extracts, which are of considerable vintage, provide definitions which are under-inclusive – “Parmigiano Reggiano” cheese now hails from provinces other than Parma. I agree. Although the extracts demonstrate that the word “Parmesan” is associated with cheese made in Parma, they do not go as far as to evidence the translation of “Parmigiano Reggiano” into “Parmesan”.

86 Having considered the probative value of the dictionary extracts on the whole, I am satisfied that the Respondent has fulfilled its burden in proving that “Parmesan” is a translation of the term “Parmigiano Reggiano”. The various reputable dictionaries demonstrate that the Italian term “Parmigiano Reggiano”, which has assimilated into common parlance in the countries around Italy, is understood to bear the same meaning as the word “Parmesan” in English and in French. They also reveal that the terms “Parmesan”, “Parmigiano” and

⁹⁷ ABOD at p 410.

⁹⁸ ABOD at p 416.

“Parmigiano Reggiano” are generally used interchangeably to refer to cheese hailing from the same regions in Italy. Adopting a faithful translation which focuses on the meaning of the words, I agree with the PAR’s decision that “Parmesan” is a translation of the geographical indication “Parmigiano Reggiano” for the purposes of s 46(2)(b) read with s 46(1)(b) of the GIA.

87 For completeness, even if I am incorrect in my earlier finding that consumer perception and marketplace evidence are irrelevant to the translation inquiry under s 46(2)(b) of the GIA, insufficient evidence has been adduced by the Appellant to persuade me that consumers perceive “Parmesan” and “Parmigiano Reggiano” to refer to different products. The Appellant asserts that consumers perceive differences in three main aspects: (a) the geographical origins of the products, (b) the methods of presentation of the products, and (c) the production methods of the products.

88 In support of its assertion, the Appellant relies on the following evidence:

- (a) examples of Parmesan cheese products produced outside Italy as evidence of separate geographical origins;
- (b) the example of a specific mark which producers place on recognised Parmigiano Reggiano cheese products evincing the different methods of presentation; and
- (c) details of varying production standards which the producers of Parmigiano Reggiano are held to as evidence of distinct production methods.

The Appellant supplements its position with the Google search results of the words “Parmesan”⁹⁹ and “Parmigiano Reggiano”.¹⁰⁰ These searches reveal online articles which state the differences between “Parmesan” and “Parmigiano Reggiano”. They also display catalogues of stores in Singapore which purportedly distinguish between “Parmesan” and “Parmigiano Reggiano” cheese.¹⁰¹

89 None of these pieces of evidence provide any indication as to how consumers in the marketplace *actually* understand the terms “Parmesan” and “Parmigiano Reggiano”. Not only is the average consumer unlikely to be familiar with production methods or regulations, he or she may also dismiss differences in presentation as simple marketing techniques for individual companies or brands to stand out. As the Appellant was unable to provide concrete proof of consumer perception, through means such as consumer surveys or other relevant market data, I cannot accept the Appellant’s argument that consumers perceive “Parmesan” and “Parmigiano Reggiano” products to be distinct, and that the terms are not translations of each other.

Conclusion

90 For the foregoing reasons, I find that the Respondent has met its burden of proving that “Parmesan” is a translation of “Parmigiano Reggiano” and I dismiss the appeal accordingly.

⁹⁹ ABOD at pp 150-151.

¹⁰⁰ ABOD at p 164.

¹⁰¹ ABOD at p 152.

91 I will hear parties separately on costs.

Dedar Singh Gill
Judge of the High Court

Chan Wenqiang, Sukumar s/o Karuppiah and Yip Shuen Kai, Harren
(Ravindran Associates LLP) for the appellant;
Sivagnanaratnam Sivananthan and Teo Tze She (Bird & Bird ATMD
LLP) for the respondent.