

**“Parmesan” vs “Parmigiano Reggiano”:
Protection for Translations of Geographical Indications
Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano
[2024] 2 SLR 624; [2024] SGCA 53**

I. Executive Summary

In the context of the Geographical Indications Act 2014 (Act 19 of 2014) (the “GIA”), the protection of geographical indications (“GI”s) safeguards the interests of Singapore’s consumers by providing greater assurance that food products truly carry the characteristics that they are known for, and which are attributable to their geographical origin. Consumers rely on GIs – being indications used in trade to identify goods as originating from a certain place – to convey accurate information about the geographical origins of the product in question, and the given quality or reputation of the product that is essentially attributable to that place.

In Singapore, the term “Parmigiano Reggiano” is a registered GI for cheese originating from the specified region of “the part of the province of Bologna to the left of the River Reno, the part of the province of Mantua to the right of the River Po, and the provinces of Modena, Parma and Reggio Emilia” in Italy (the “**Specified Region**”). In *Fonterra Brands (Singapore) Pte Ltd v Consorzio del Formaggio Parmigiano Reggiano* [2024] 2 SLR 624, the question arose as to whether the term “Parmesan” could be considered a translation of the term “Parmigiano Reggiano” under section 46(1)(b) read with section 46(2)(b) of the GIA. If it was considered as such, then the protections accorded to the GI “Parmigiano Reggiano” could extend to the term “Parmesan.” (For instance, the term “Parmesan” would probably not be permitted on labels for cheese-related food products which do not come from the Specified Region).

The Court of Appeal (“CA”) held that “Parmesan” was not, in fact, a translation of the term “Parmigiano Reggiano”. Briefly: to be a translation of a registered GI, the term in question must be known to the average consumer in Singapore at the time the request for the qualification of rights (“QoR”) is filed. However, based on the range of “Parmesan” cheese products marketed and sold to consumers in Singapore, Singapore consumers did not regard “Parmesan” cheese as cheese which must originate exclusively from the Specified Region in Italy. As such, the protections of the GI “Parmigiano Reggiano” did not extend to the term “Parmesan”.

II. Material Facts

The respondent is the Consorzio del Formaggio Parmigiano Reggiano (the “**Consorzio**”). The Consorzio is the registrant and owner of the GI “Parmigiano Reggiano” in Singapore. The Consorzio is a voluntary consortium of Parmigiano Reggiano cheese producers, tasked by the Italian government with the protection, promotion, enhancement, consumer information and general care of the interests relating to Parmigiano Reggiano cheese. The appellant is Fonterra Brands (Singapore) Pte Ltd (“**Fonterra**”), a wholly-owned subsidiary of a New Zealand co-operative company owned by 10,000 dairy farmers in New Zealand, selling, inter alia, “Parmesan” labelled cheese products in Singapore under the “Perfect Italiano” trade mark.

The Consorzio successfully registered the GI in Singapore in 2019. Three months later, Fonterra filed a QoR request seeking that “[t]he protection of the geographical indication ‘PARMIGIANO REGGIANO’ should not extend to the use of the term ‘Parmesan’”. If successful, this would mean that the Consorzio, as the owner of the GI, could not prevent others from using the term “Parmesan” on their products. Fonterra relied on section 46(2)(b) of the GIA, which states that a request for a QoR conferred in respect of a registered GI “in relation

to any term which may be a possible translation” of the GI may be made on the ground that the term “is not a translation” of the GI. (Essentially, Fonterra’s argument was that the term “Parmesan” was not a translation of the GI “Parmigiano Reggiano”, and therefore none of the protections accorded to the GI “Parmigiano Reggiano” should apply to products using the term “Parmesan”. This would serve as a carve-out of the rights conferred under the GIA.)

The Registrar of Geographical Indications (the “**Registrar**”) proposed to allow the request. In response, the Consorzio filed an opposition on the basis that the ground on which Fonterra relied – section 46(2)(b) – was not established. The Principal Assistant Registrar (the “**PAR**”) heard the opposition and rejected the QoR request, defining “translation” in section 46(2)(b) of the GIA as simply whether words had the same meaning in a different language. Among other things, the PAR considered that an extract from the Collins Dictionary showing that “Parmesan” was a translation of “Parmigiano Reggiano” was persuasive, because Singapore uses British English as our official working language. The PAR also said that the Consorzio bore the burden of proof in this regard.

On appeal by the Consorzio, the High Court (“**HC**”) agreed that the Consorzio bore the burden of proof of its claim. It further held that “Parmesan” was a translation of the GI “Parmigiano Reggiano” and dismissed Fonterra’s appeal. The HC ruled that a “faithful” translation which captures the meaning of the words in question, as opposed to a “strict literal” translation, should be adopted for the purposes of the GIA, and the three dictionary extracts provided by the Consorzio proved that “Parmesan” was indeed a faithful translation of the term “Parmigiano Reggiano”. Fonterra then appealed to the CA.

III. Issues on Appeal

The CA addressed the following main issues on appeal:

- A. The qualification of rights mechanism under the GIA.
- B. Which party bears the burden of proof when a proposed QoR is opposed?
- C. What is the proper approach to the meaning of a “translation” under section 46(1)(b) read with section 46(2)(b) of the GIA?
- D. Applying this approach, is “Parmesan” a translation of “Parmigiano Reggiano”?

A. The qualification of rights mechanism under the GIA

The CA first considered the qualification of rights mechanism under the GIA. To obtain protection, a GI must first be registered. However, the registrant applying for the registration need not specify all the translations they wish to protect during registration. Instead, whether a term is a translation of a GI is determined on a case-by-case basis, either when infringement proceedings are brought, or as in the present case, upon a request for a QoR. A successful request would essentially provide a carve-out for “any term which may be a possible translation of the [GI]” from protections accorded to the GI.

Under section 46(2) of the GIA, a QoR request can only be made under either or both of the section 46(2)(a) and section 46(2)(b) grounds. The CA noted that the translation ground under section 46(2)(b) of the GIA only allows for “any term which may be a possible translation of the [GI]”. In comparison, the grounds under section 46(2)(a) read with Part III of the GIA appears to be for *both* “any name contained in the [GI]” *and* “any term which may be a possible translation of the [GI]”.

The CA also observed that while the present case uses the GIA in force as of 16 September 2019, it has since been amended on 15 August 2020. This amendment changed the QoR

mechanism ‘pre’ vs ‘post’ registration of the GI: it replaces the post-registration QoR regime with a new limitation of scope (“LoS”) regime, applications for which are filed in and heard by the High Court, while the pre-registration QoR regime remains unchanged, and will still be filed in and heard by the GI Registry. However, the CA noted that while this changed *which body* would hear an application of qualify the rights of a GI post-registration, it does not change the *basis* upon which an application of qualification or limitation rights in respect of a GI can be made. As such, it did not affect the present case, and the judgment is likely to apply to LoS applications all the same.

B. Which party bears the burden of proof when a proposed qualification of rights is opposed?

The CA held that the party making the QoR request (the “Requestor”) bears the burden of proof when the QoR request is opposed. Regardless of whether the proposed QoR is opposed or unopposed, there are two thresholds a Requestor must cross before the QoR request is allowed:

- 1) The Registrar must first be satisfied that the request discloses a *prima facie* case pursuant to rule 40(4) of Geographical Indications Rules 2019 (“GIR”), meaning that the requirements for the request appear fulfilled at first glance. Only then is the Registrar obliged to publish the proposed QoR in the Geographical Indications Journal for opposition purposes. (The Geographical Indications Journal is a journal published by the Registrar in which proposed additions, alterations, or removals from the register of GIs are published for the purpose of advertising these changes, so that those whose interests are affected by the change may challenge it.)
- 2) After the proposed QoR is published, the Requestor must satisfy the Registrar on a balance of probabilities that it has made out either or both of the grounds in section 46(2) of the GIA – only then is he obliged to enter the QoR in the register of geographical indications. In this regard, the opposition to a proposed QoR does not shift the burden of proof.

Finally, since it is the Requestor who is seeking the carve-out of the rights accorded to the registered (or soon-to-be-registered) GI, it is the Requestor who must prove that the carve-out to the rights under the GIA should be made. Thus, the CA held it was for Fonterra, the requestor, to prove that the ground for their QoR request was made out in the face of the Consorzio’s opposition.

C. What is the proper approach to the meaning of a “translation” under section 46(1)(b) read with section 46(2)(b) of the GIA?

The CA agreed with the HC that a *faithful* translation which captures the meaning of the word or phrase, as opposed to a literal translation, should be adopted for the purposes of the GIA, even if the translations usually overlap. The CA also held that what is required of the translation ground in section 46(1)(b) read with section 46(2)(b) (the basis of Fonterra’s argument) is a translation of the registered GI *as a whole*.

However, the CA did not consider it a binary choice between a faithful and literal translation. Instead, it considered the following: what is meant by a “faithful” translation, and does it imply understanding (and whose understanding is relevant)? The CA held that a “translation” under the GIA cannot be divorced from the fact that it must be a translation known to the average consumer in Singapore. The function of a GI is, after all, to indicate to consumers that the product originates from a specified region. Therefore, if a translation is not known or used by the average consumer in Singapore, it is difficult to see how the translated term can be said to indicate to consumers that the product which it describes originates from a specified geographical region. The purpose of protecting translations of registered GIs under the GIA is

the same as that of protecting GIs in their native language – to address the unfair trade practice of using in Singapore the GI on a product which may lead the public into the false belief that that product originated from the particular geographic location. This affords a more complete protection and ensures that merchants are unable to circumvent the protection of GIs by simply changing the form and language in which they are presented. It also makes GIs more accessible to people who speak a different language.

However, the CA stressed that not every single translation of a registered GI will be protected by default. The determination of whether a particular term is a translation of a registered GI falls to be undertaken on a case-by-case basis, at the time of infringement proceedings under section 4 of the GIA or upon a request for a qualification of rights under section 46 of the GIA.

The CA also clarified that the concern was about the average consumer in Singapore, i.e. Singapore citizens and residents and not those who were merely passing through. In the context of the present dispute, the average consumer was also not someone with a specialist knowledge of cheese, or necessarily a member of the expatriate community or just the Italian community in Singapore.

The assessment of whether a translated term is known to the average consumer in Singapore must also be supported by credible evidence. Such evidence may come from a variety of sources and need not be restricted to the meaning of words as reflected in the entries of reputable dictionaries, so long as the sources relied upon can be shown to be relevant and credible to the inquiry in question.

Dictionaries remained a helpful starting point for ascertaining the ordinary meanings of words. However, dictionaries may not accurately reflect the usage of certain words among the local population in Singapore: words do not exist in a vacuum, and how a particular word is used and the meaning or meanings which it bears over time may vary depending on the particular context and local conditions in which the word is used. Foreign published dictionaries also may not accurately reflect the usage of a word in Singapore, because its curators may not know how it is commonly used in Singapore.

Further, other than dictionaries, evidence of the general usage of the term in Singapore may come from credible tomes (e.g., on cheese). It may also come from consumer surveys, although the probative value of such surveys often varies depending on how the survey in question has been conducted.

Thus the CA held that a “translation” for the purposes of section 46(1)(b) read with section 46(2)(b) of the GIA must be a translation known to the average consumer in Singapore. The relevant time at which this was to be assessed was at the time the request for the QoR is filed. In the present case, Fonterra must thus show, that at least by 16 September 2019, “Parmesan” was not a translation known to the average consumer in Singapore of the term “Parmigiano Reggiano”.

D. Applying this approach, is “Parmesan” a translation of “Parmigiano Reggiano”?

Applying the above approach, the CA held that Fonterra had discharged its legal burden of proving that “Parmesan” is not a translation of “Parmigiano Reggiano” for the purposes of the GIA.

The CA noted that the Consorzio’s use of the Collins Dictionary and the Cambridge Italian-English Dictionary could be said to provide some support for their argument that there was

equivalence in meaning between the terms “Parmigiano Reggiano” and “Parmesan Cheese” in the (British) English language. However, the CA stressed that although Singapore adopts British English as its official working language, these dictionary extracts were meanings compiled by foreign publishers who may not have been informed of the way in which the word has been used in Singapore. Put differently, these dictionaries are not written in (and were not designed to reflect) the vernacular used by locals in Singapore.

Conversely, the CA held that sufficient evidence had been tendered by Fonterra to support an inference that consumers in Singapore regard “Parmesan” and “Parmigiano Reggiano” as referring to two different kinds of cheese products distinguishable by origin, in that Parmigiano Reggiano originates from a specific region in Italy, whereas Parmesan can come from several countries or regions. Its evidence consisted of: (a) at least ten product listings which showed that “Parmesan” cheese products are marketed and sold to Singapore consumers in-stores and online with clear indications that these products originate from countries outside Italy; and (b) the online catalogues of groceries and cheese stores in Singapore as well as Amazon Singapore, which categorise “Parmigiano Reggiano” cheese separately from “Parmesan” cheese.

The advertisements and marketing material tendered by Fonterra showed how “Parmesan” cheese has been marketed and sold to consumers in stores and on online platforms in Singapore. The CA held that the differences in the overall visual cues between, on the one hand, the products labelled and sold as “Parmesan” and, on the other hand, those labelled and sold as “Parmigiano Reggiano” were considerable. “Parmesan” labelled cheese often had no mention of any association with “Parmigiano Reggiano”. Further, the country of origin or production of “Parmesan” cheese products is often conspicuously displayed in the marketing and advertising material. In fact, under Singapore’s Food Regulations (2005 Rev Ed) it is mandatory for information relating to the country of origin of a food product offered for sale in Singapore to be displayed “conspicuously and in a prominent position on the label and shall be clearly legible”.

Fonterra’s evidence on *online* catalogues also showed that “Parmigiano Reggiano” cheese is categorised separately from “Parmesan” cheese, with an Amazon Singapore online store search giving completely different results.

The CA reiterated that the average consumer is a literate consumer, who would take some notice of the manner in which a food product has been marketed or advertised. He or she may not, depending on the individual priorities and concerns of the consumer in question, ordinarily take notice of the product’s precise ingredient list or its production methods. However, information relating to the country of origin is typically a selling point because it presumably speaks to the quality or authenticity of the product in question, and it is not inconceivable that Singaporean consumers would tend to become familiar with such information through purchasing “Parmesan” cheese over time. Therefore, the manner in which various “Parmesan” cheese products have been marketed and sold to consumers in Singapore would have influenced the average Singapore consumer to consider that, unlike “Parmigiano Reggiano” cheese which must originate from the Specified Region in Italy, “Parmesan” is not “Parmigiano Reggiano” and can and does, in fact, originate from locations outside Italy.

IV. Conclusion

The CA held that “Parmesan” is not a translation of “Parmigiano Reggiano” for the purposes of section 46(1)(b) read with section 46(2)(b) of the GIA.

School of Law.

Edited by: Ong Ee Ing, Principal Lecturer, Singapore Management University Yong Pung How School of Law.