

A toast to all Italian Prosecco makers – Australian Grape and Wine Incorporated v Consorzio di Tutela della Denominazione di Origine Controllata Prosecco [2021] SGIPOS 4

It is a great time for all Italian Prosecco makers to celebrate, perhaps with a glass or two of their own wine, as the Consorzio di Tutela della Denominazione di Origine Controllata Prosecco's (the "**Applicant**") application to register "Prosecco" as a geographical indication in respect of wines proceeds to registration in Singapore.

Case facts:

The Applicant is a consortium established and organised under the laws of Italy. The Applicant applied to register "Prosecco" as a geographical indication in respect of wines ("**Application GI**"). The geographical area claimed in the application was "located in the North East region of Italy, and includes the entire territory of Belluno, Gorizia, Padova, Pordenone, Treviso, Trieste, Udine, Venice and Vicenza" (the "**Specified Region**").

Australian Grape and Wine Incorporated (the "**Opponent**") is the representative body for grape growers and winemakers in Australia. The Opponent opposed the registration of the Application GI on the following grounds:

- (a) The indication "contains the name of a plant variety ... and is likely to mislead the consumer as to the true origin of the product" pursuant to Section 41(1)(f) of the Geographical Indications Act ("**GIA**") ("**Ground 1**"); and
- (b) The indication "does not fall within the meaning of "geographical indication" as defined in section 2" pursuant to Section 41(1)(a) of the GIA ("**Ground 2**").

Decision:

The Principal Assistant Registrar (the "**PAR**") held that the opposition failed on both grounds.

- (a) Ground 1

In relation to Ground 1, while the PAR accepted that "Prosecco" is the name of a grape variety, she was not convinced that there was a likelihood that the consumer would be misled as to the true origin of the product. In doing so, the PAR clarified that for an opposition under Section 41(1)(f) of the GIA to succeed, it must be established that the consumers would be likely to be misled as to the true geographical origin of the product, and not the true plant (or animal origin) of the product.

The factors that supported the PAR's decision that the consumers are unlikely to be misled include:

- consumers are likely to pay a relatively high degree of attention to the purchase of wines;
- it is a common industry practice in Singapore for wines to be marketed and sold along with descriptions of their country of origin;
- the length of time "Prosecco" has been used on Italian wines from the geographical area claimed in the application, the length of time Italian "Prosecco" has been available in Singapore, as well as its popularity, reputation and renown, further reduce the likelihood of consumers being misled; and
- the use of "Prosecco" as a grape variety is not so widespread and pervasive as to increase the likelihood of the consumers being misled.

The PAR also observed that no evidence has been lodged to show that consumers have actually been misled, although Australian "Prosecco" have been sold alongside "Prosecco" wines from the Specified Region for a period of at least 4 years in Singapore before the date of application for registration of the Application GI. Although Section 41(1)(f) uses the phrase "likely to mislead" and thus, evidence of

consumers being actually misled is not mandatory, such evidence, if available, would have helped to establish this element of the ground of opposition more readily.

Accordingly, the opposition under Ground 1 failed.

(b) Ground 2

In relation to Ground 2, the PAR found that the Application GI fell within the meaning of “geographical indication” under Section 2 of the GIA. In doing so, the PAR was satisfied that the Application GI has been used in trade to identify goods as originating from the geographical area claimed in the application.

While the Opponent sought to contend that the Application GI does not have any qualities, reputation or other characteristics that are essentially attributable to the geographical area claimed, the PAR was not satisfied that the Opponent has discharged its burden of proof on this point. In particular, in support of this contention, the Opponent only relied on a single report that was prepared at the request of the Opponent and was not entered into evidence via a statutory declaration by the writers of the same report. The PAR therefore did not attach too much weight to the report given that it could be biased, and that the writers of the report were not subject to sanctions for knowingly making false declarations.

Accordingly, the opposition under Ground 2 failed.

Comments:

(a) The importance of sufficient evidence

This decision highlights, once again, the importance providing sufficient evidence to support one’s grounds of opposition. The Opponent ultimately failed to establish their grounds of opposition due to the lack of evidence supporting the same. Practitioners should also keep in mind the importance of the credibility and reliability of their evidence, and ensure that the evidence they seek to rely on comes from a non-biased source.

(b) The importance of carefully-crafted arguments to further one’s case

In this case, in claiming that the Application GI is likely to mislead the consumer, the Opponent sought to establish that the average consumer in Singapore will recognise the term “Prosecco” to refer to wines produced from a grape variety of the same name which can also originate from Australia instead of being limited to wines originating from a particular region in Italy. Apart from the lack of evidence to support this contention, the PAR was also of the view that if consumers indeed recognise that “Prosecco” may refer to wines from Australia as well as Italy, they would be more careful to check the country of origin of the wine and would not be misled. This serves as a reminder to practitioners to carefully craft their arguments to further, and not to undermine, their case.

Should you have any queries as to how this update may affect you or your organisation or require further information, please do not hesitate to email us.



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