

## SINGAPORE'S HIGHEST COURT CONFIRMS "PROSECCO" MAY BE REGISTERED AS A GEOGRAPHICAL INDICATION

### Background

1. The Singapore Court of Appeal in *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* [2023] SGCA 37 held that the application for a geographical indication, "prosecco", must be allowed to proceed to registration in Singapore.
2. Generally, a geographical indicator ("**GI**") protects any indication used in trade to identify goods as originating from a place, provided that a given quality, reputation or other characteristic of the goods is essentially attributable to that place. For example, a well-known GI is wine from Champagne.
3. In this case, *Consorzio di Tutela della Denominazione di Origine Controllata Prosecco v Australian Grape and Wine Incorporated* ("**Consorzio**"), an Italian trade body responsible for protecting, promoting, marketing and generally overseeing the use of the term "Prosecco" applied to register "Prosecco" as a GI for wines in Singapore (the "**Prosecco GI**"). The Australian Grape and Wine Incorporated ("**AGWI**"), the representative body for grape growers and winemakers in Australia, opposed the application.
4. AGWI's case is that the Prosecco GI should not be registered as it contravenes section 41(1)(f) of Singapore's Geographical Indications Act 2014 ("**GIA**"), which prohibits a GI which contains the name of a plant variety and is likely to mislead the consumer as to the true origin of the product from being registered. Such misleading may occur if the plant variety is cultivated in large quantities outside the area for which the GI is registered.

### Analytical Framework

5. The Court of Appeal held that the inquiry under GIA section 41(1)(f) proceeds in two stages:
  - (a) Does the name of the Prosecco GI contain the name of a plant variety?
  - (b) If so, whether it is likely that the Prosecco GI will mislead consumers into thinking the product could only originate from that specific region when this is not the case.

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## Does the Prosecco GI contain the name of a plant variety?

6. As regards the first stage of the test, the Court of Appeal agreed with AGWI that “Prosecco” is the name of a plant variety. It held that this requirement is an objective assessment - it is fulfilled if the GI does in fact contain a name of a plant variety.

## Whether it is likely that the Prosecco GI will mislead consumers into thinking the product could only originate from that specific region when this is not the case.

7. As regards the second stage of the test, the Court of Appeal held that AGWI had failed to establish that the Singapore consumer was likely to be misled by the Prosecco GI at the relevant time.
8. The court held that it is necessary to focus on matters which the Singapore consumer is aware of, given that such awareness naturally affects whether the Singapore consumer is likely to be misled by the Prosecco GI.
9. The court’s decision turned on the evidence produced by AGWI. It noted that “AGWI did not produce any evidence of consumer surveys and instead chose to rely on advertising materials as well as statistics showing the increase in the volume of Australian “Prosecco” imported into Singapore”. The court cautioned that adducing surveys showing that consumers are likely to be deceived will not be determinative. The party adducing the survey should also adduce evidence of how the surveys were conducted.

## **Conclusion**

10. Singapore enacted the GIA to enable Singapore to comply with its obligations under the European Union – Singapore Free Trade Agreement. The GIA provides enhanced protection to GIs by providing a system of registration. A review of the “*List of Names to be applied for protection as geographical Indications In the Territory of the Parties*”<sup>1</sup>, an annex to the European Union – Singapore Free Trade Agreement, reveals that the European Union intends to protect no less than 196 indications as GIs in Singapore.
11. In this context, the present case sets an important precedent as regards the framework and evidence that will be pertinent in future GI disputes. At a high level, the requirements appear to be clear. Nonetheless, deeper issues remain unresolved. What are the characteristics of the “Singapore consumer”? Does the “Singapore consumer” comprise the general public or a segment the general public? How easily will such a “Singapore consumer” be misled? How would a party commissioning a survey convince the court that the survey results were not skewed in his favour?
12. Please do not hesitate to reach out to us if you have any question.

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<sup>1</sup> [https://www.enterprisesg.gov.sg/-/media/esg/files/non-financial-assistance/for-companies/free-trade-agreements/eusfta/EUSFTA\\_Annex\\_10A.pdf](https://www.enterprisesg.gov.sg/-/media/esg/files/non-financial-assistance/for-companies/free-trade-agreements/eusfta/EUSFTA_Annex_10A.pdf)

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