

**Intellectual Property Office of Singapore
Hearings & Mediation Department**

Mediation at IPOS

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Mediation Success at IPOS

K & Q Brothers Electrical Engineering Co. Pte. Ltd.
&
K&Q Fatt Pte Ltd, Quek Jia Ling, Quek Hong Peng, Quek Jia Hao
[2021] SGIPOS MED 2

	Party	Party
Name	K & Q Brothers Electrical Engineering Co. Pte. Ltd.	1. K&Q Fatt Pte Ltd 2. Quek Jia Ling 3. Quek Hong Peng 4. Quek Jia Hao
Nationality / Country of Incorporation	Singapore	Singapore
Representation	Kalco Law LLC	Ravindran Associates
Lawyers	Xhuanelado Owen	Alvin Lim

Mediation institution	World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) ¹
Mediator	Jonathan Agmon, of Soroker Agmon Nordman
Shadow Mediator	Jocelyn Toh, of Soroker Agmon Nordman
Date of Mediation	18 November 2020

Background to the Dispute

The dispute involved two Singapore registered companies, K & Q Brothers Electrical Engineering Co. Pte. Ltd. (the Opponents) and K&Q Fatt Pte Ltd (the 1st Applicants). Both companies are in the business of manufacture, repair and wholesale of a variety of goods including refrigerators, air conditioning and ventilating machinery.

The Opponents have been registered in Singapore since 1989 and had successfully obtained registration of the trade mark “YODA” since 18 May 1994. “YODA” was registered in Class 11 in respect of refrigerators, food and drink chillers, freezers and ice machines. The Applicants have more recently attempted to register a trade mark called “YUDA”, similarly in Class 11, in the same trade and for the same purposes of utilisation as “YODA”.

The Opponents therefore opposed the registration of the Applicants’ trade mark “YUDA” on the alleged grounds of confusing similarity with the Opponents’ earlier trade mark, “YODA”.

Bridging the Divide

Parties had already filed their evidence and the dispute would have proceeded to a hearing had it not been settled. The Principal Assistant Registrar suggested, at the Pre-Hearing Review, that parties

¹ The WIPO Center’s only office outside Geneva, Switzerland is in Singapore.

consider WIPO's offer of free mediation² and attempt to resolve their dispute amicably. In the event that they could not settle, it was still open to parties to have a hearing.

Reaching a settlement was by no means an easy feat. The mediation ran parallel with ongoing shareholder dispute litigation between the parties and they were initially not on speaking terms. This was also essentially a family dispute. Parties have shared history, with the 1st Applicants' founder being a former director of the Opponents, and tensions were understandably high.

Ever the skilful and tactful mediator, Mr Jonathan Agmon managed to get both parties to resolve this trade mark dispute amicably.

The Mediation Process

Prior to the mediation on 18 November 2020, Mr Agmon made extensive preparations, including encouraging parties' mediation advocates to prepare comprehensive mediation statements. This was crucial in allowing Mr Agmon to visualise all angles for the co-existence of the two trade marks and businesses.

Mr Agmon graciously offered the office of Soroker Agmon Nordman as mediation venue. The mediation took place in person and comprised a combination of joint sessions, held in the firm's meeting room; and break-out caucus sessions, held in the rooms of the senior partners. It was a quiet and spacious office which provided a conducive environment for the mediation.

The first joint session was particularly helpful in bringing parties together. This allowed them to discuss and hear each other's positions. The caucuses were important for parties to consider and reflect on each other's positions and offers for settlement. Mr Agmon effectively used these private caucuses to persuade parties to compromise. Another joint session was used towards the end of the mediation to draft the settlement agreement and iron out the final details of the settlement before parties signed the co-existence agreement. All of this was achieved within a day.

Mr Agmon was friendly and kept a cheerful spirit which helped pave the way for parties to open up to each other. At the same time, he was firm and professional and dictated the pace of the mediation with great control. As the neutral mediator, his constant reality testing of the matter allowed parties to focus on commercial sensibilities and put their family dispute aside.

The constant emphasis on facilitating a resolution to the trade mark dispute allowed parties and their mediation advocates to focus on discussing ways of avoiding confusion for customers with the use of the respective marks, which allowed parties to see a possible reality for their respective brands and businesses to co-exist.

Had the parties decided to fight it out in an adversarial setting, it would have taken much more time and they would have incurred substantial costs. Mediation was thus a much more suitable platform for their dispute. The 1st Applicants' Business Development Director, Ms Janelle Quek, found the mediation "beneficial and fruitful" because it provided "a more effective and efficient means to resolve the dispute". She also said that the Applicants are "extremely grateful that the environment provided by the mediator was a very peaceful and pleasant one", which aided the negotiation process.

Mediation for IP Disputes

² In light of the global economic difficulties due to COVID-19, WIPO Center offered mediation services at no charge for mediation requests filed within the period 12 June to 31 August 2020.

With the conclusion of this successful mediation, Mr Agmon shared his views on the suitability of mediation for IP disputes:

“I consider IP disputes to be particularly suited for mediation not only because the process allows the parties to discuss freely and confidentially their interests but also because unlike court or tribunal proceedings, the process allows for out-of-the box solutions. Such solutions could in many cases bring the parties to an agreement where both parties benefit without the need to reach a judicial resolution and the costs involved.”

EMPS Funding

As the subject matter of mediation involved only Singapore IP rights, funding under the IPOS EMPS was capped at S\$10,000 in total (for the entire case involving two parties). The funding was applied to 50% of the parties’ mediation-related lawyer fees and disbursements³. In this regard, the Opponents received funding of S\$5,000 and the Applicants S\$2,675.

Written by Chloe Chua, Young IP Mediator
20 April 2021

Conditions of the Enhanced Mediation Promotion Scheme (EMPS)

The following conditions must be satisfied in order to qualify for funding under the EMPS:

- (i) Parties have an existing dispute before IPOS which is the subject-matter of a mediation on or after 1 April 2019, in any event, no later than 31 March 2022 or until the available funding is drawn down, whichever is earlier.
- (ii) The mediation takes place in Singapore. This may include the use of video-conferencing to involve party representatives who are not able to be present in Singapore during the mediation, as long as the mediator is physically in Singapore during the mediation, and is a Singaporean or is based in Singapore.
- (iii) Parties allow a “shadow” mediator to sit in and observe the mediation; or have a co-mediator to assist in the mediation.
- (iv) Parties disclose their lawyer / agent fees incurred from the start to the end of the IPOS proceedings.

³ EMPS funding did not need to be applied to the mediator’s fees as parties had the benefit of the complimentary mediation service offered by the WIPO Center.

- (v) Parties give feedback on their mediation experience.
- (vi) Parties agree to named publicity, excluding details of the settlement terms (such as the quantum of the settlement). The purpose of the named publicity is to give concrete, relatable examples to other businesses and individuals and thus encourage them to consider mediation. The amount of detail in the publicity is not expected to disclose much more than the identity of the parties, the nature of their disputes, the countries spanned by their disputes, the duration of their disputes, the parties' comments on the mediation process, any advice they have for others facing disputes etc.
- (vii) Parties co-pay at least 50% of their lawyer / agent fees relating to mediation (and mediation-related disbursements charged by the party's lawyer / agent).

Reflection on an IP Mediation by a Young IP Mediator

Stratech Systems Limited, The Stratech Group Limited & Chew Rong-Qi Phoebe, Chew Rong-Jie David [2021] SGIPOS MED 1

	Party	Party
Name	(i) Stratech Systems Limited (In Liquidation) (ii) The Stratech Group Limited (In Liquidation)	(i) Chew Rong-Qi Phoebe (ii) Chew Rong-Jie David
Nationality / Country of Incorporation	Singapore	Singapore
Representation	Rajah & Tann Singapore LLP	Ravindran Associates LLP
Lawyers	Nicholas Lauw	(i) Paul Teo (ii) Alvin Tan

Mediation Institution	World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) ¹
Mediator	Alban Kang, accompanied by Just Wang, both of Bird & Bird ATMD LLP
Shadow Mediator²	Levin Lin, IPOS Young IP Mediator
Date of Mediation	18 August 2020

Background³

To provide some context to this mediation, the parties involved were, on the one hand, individuals who sought to register the trade marks in issue (“the applicants”) and on the other hand, a company that opposed the registration of these marks (“the opponents”). The applicants were the children of the opponents’ ex-directors.

Application of Mediation Theory in the Mediation

As a shadow mediator at the mediation, it was my first opportunity to be part of an IP mediation and from the perspective of a mediator. Prior to the mediation, I had only experienced the application of mediation skills in the hypotheticals and roleplays that were given to me as part of my learning and training. The mediation was an enlightening experience, allowing me to observe the mediation theory and skills that I have learnt being applied in a commercial dispute.

¹ The WIPO Center’s only office outside Geneva, Switzerland is in Singapore.

² It is a condition of funding under the IPOS Enhanced Mediation Promotion Scheme (EMPS) that parties allow a “shadow” mediator to sit in and observe the mediation; or have a co-mediator to assist in the mediation. The objective is to give more exposure on how mediation can resolve IP disputes and build up experience among those who may mediate or represent parties in IP mediation in future.

³ It is a condition of funding under the IPOS EMPS that parties agree to named publicity, without the need to disclose specific details of the settlement agreement.

One thing that struck me right from the beginning of the mediation was the mediator's ability to build rapport with the parties and the respective counsel. Building rapport was always emphasised in training as a key component in any mediation as it helped to facilitate communication and build trust. This time, I was able to observe the effects of having good rapport and quickly came to the realisation that there is no one correct way to go about doing so. The mediator was able to communicate with the parties in a manner which allowed them to feel understood and heard. This was obvious through the occasions when the parties and counsel expressed that the mediator knows how they feel about certain issues and trust that the mediator would communicate their concerns to the other party. Having good rapport not only smoothed the communication between the parties and the mediator, it also enabled the mediator to reality test the parties when necessary. The mediator was able to ask questions and suggest limitations in a frank and honest manner while appearing to the parties that this was done trying to bring them to a solution together. It quickly helped the parties to realise the realities of their positions and how they had to manoeuvre through various other alternatives if they wanted to come to an agreement.

Online Mediation Process

A relevant point to building rapport and the application of mediation skills was the online nature of the mediation. With everyone in different locations for health and safety reasons, it led to me wonder how this has influenced the mediation process. For example, there were instances where the internet was not stable, causing parties to drop out of the joint meeting on the WebEx⁴ platform. Separately, there were also times when computer glitches led to parties' audio or visual dropping. While these were not frequent in the mediation that took place, it may have become distracting if major internet or audio issues had occurred. At the same time, I noticed that such instances actually provided the parties with the opportunity to make small talk.

Another thought that crossed my mind was the lack of a 'whiteboard' or 'paper' which allowed the mediator to present the options that were being discussed or to pen down ideas that were suggested by the parties. I find that visual presentation in face-to-face mediation helps parties to recognise where they are at with their discussion and how much more they need to traverse. Having the benefit of observing an online mediation, it allowed me to think more about how to best carry out the mediation process online and how to manage situations that would not have occurred in a face-to-face mediation.

Suitability of IP Matters Being Resolved by Mediation

Lastly, in my observation of the mediation, it stood out to me that the heart of the dispute was not simply commercial. One side had sentimental ties to the marks. This was a very human and emotional issue that is very suited to be resolved by mediation. I watched how the mediator navigated the emotions of the individuals by taking it step by step: listening to the applicants share about what the mark means to them, asking the applicants questions to understand and subsequently reframing their emotions to better explain it to the opponents.

The mediation process gave the applicants the time and space to talk about how they felt and to explore the various options before them. After hours of expressing what and how much the mark means to them, the applicants were more open and ready to move from their original position. The flexibility of the process and presence of a safe space vis-à-vis the parties and the mediator allowed the applicants to feel heard and understood. This was what I thought to have moved the mediation forward despite it being very much a commercial issue.

⁴ Parties separately arranged their respective private sessions with the mediator, on the Zoom platform.

Ending Thoughts

Although no resolution was arrived at during the mediation, the mediation provided the parties with the opportunity to clarify their concerns with each other and the presence of the mediator had influenced the way in which they approached the dispute as well. The mediation helped the parties to navigate the limits of what was acceptable to them and to address emotional issues that would have otherwise never been shared. It was an illuminating experience for a young mediator like me and it has taken me one step forward in my understanding and skills as a mediator.

Written by Levin Lin, Young IP Mediator
5 March 2021

Mediation Success at IPOS

Gromark Consumers Enterprise Pte. Ltd. & GK Laboratory (Asia) Pte. Ltd. [2020] SGIPOS MED 2

	Party	Party
Name	Gromark Consumers Enterprise Pte. Ltd.	GK Laboratory (Asia) Pte. Ltd.
Nationality / Country of Incorporation	Singapore	Singapore
Representation	Harry Elias Partnership LLP	Chow Ng Partnership
Lawyers	(i) Brian Law (ii) Tan Weiyi (iii) Esther Wee	Patrick Chow

Mediation institution	World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) ¹
Mediator	Andy Leck, of Baker McKenzie Wong & Leow LLC
Shadow Mediator²	Utsav Rakshit, IPOS Young IP Mediator
Date of Mediation	30 October 2020

Note: *This is the first successfully mediated case where a Young IP Mediator had a first hand experience of witnessing how a mediation was steered to success within a day. IPOS is grateful to the WIPO Center, Mediator Andy Leck, the parties and their lawyers for giving Mr Utsav Rakshit this invaluable opportunity. For more information about the Young IP Mediators initiative and Utsav's experiences in this case, see Annex A below. Please see the accompanying [media release](#).*

Gromark Consumers Enterprise Pte Ltd (the Opponent) is a beauty and supplement manufacturer, exporter and distributor in the cosmetic and cosmeceutical industry. Its products are sold in Singapore and various countries overseas, including China and Japan. Over the years, the Opponent has established its "Crystal Tomato" brand of products and has also registered numerous trade marks in Singapore and overseas.

GK Laboratory (Asia) Pte Ltd (the Applicant) is in the business of health supplements and aesthetic, beauty products and has sales both in the local and overseas market, particularly in China.

The Applicant applied to register "timeless tomato" in Classes 3, 5 and 35 (the goods mainly pertain to cosmetic preparations, nutritional supplements as well as retail / wholesale services relating to the

¹ The WIPO Center's only office outside Geneva, Switzerland is in Singapore.

² It is a condition of funding under the IPOS Enhanced Mediation Promotion Scheme (EMPS) that parties allow a "shadow" mediator to sit in and observe the mediation; or have a co-mediator to assist in the mediation. The objective is to give more exposure on how mediation can resolve IP disputes and build up experience among those who may mediate or represent parties in IP mediation in future.



same) (the Application Mark) as well as the logo in Classes 3 and 5 (similarly, the goods mainly pertain to cosmetic preparations and nutritional supplements).

The Opponent opposed the registration of the Application Mark³ on the basis that it would cause confusion in the market and adversely affect the “Crystal Tomato” brand.

After parties exchanged their initial pleadings in the opposition proceedings, they were invited to consider mediation as an option to resolve the dispute. Parties received information from IPOS on the Enhanced Mediation Promotion Scheme (EMPS), and agreed to try and resolve their dispute through mediation administered by the WIPO Center.

Under IPOS’ EMPS⁴, the parties could receive funding of S\$12,000 for the mediation as the subject matter of mediation involved both Singapore and foreign IP rights. Further, as parties applied for the complimentary mediation service offered by the WIPO Center,⁵ the full amount of the subsidy can be applied towards up to 50% of the parties’ mediation-related lawyer fees and disbursements.

The WIPO Center provided the parties with 3 proposed candidates for appointment as mediator. Parties agreed to appoint one of the candidates, Mr Andy Leck, who is a principal at Baker McKenzie Wong & Leow LLC, as the mediator.

Parties met in person on the day of the mediation and the session lasted about 8 hours. After a series of discussions, some of which took place in the presence of the mediator and some of which were amongst parties themselves, parties were able to resolve the disputed issues and finalise the terms of the settlement agreement. The outcome of the mediation was positive and met the commercial concerns and objectives of both parties, not only in respect of their businesses in Singapore, but also overseas.

Had the parties decided to fight it out in an adversarial setting, it would have taken much more time and both parties would have incurred substantial costs.

Both parties were satisfied with the mediation process.

The Opponent’s Managing Director, Ms Catherine Tan, said, “We are grateful to the mediator for helping to facilitate the negotiations between the parties. It means a lot to us and our business that this mediation was successful. We not only managed to resolve the underlying disputes to reach an amicable resolution, but we also took a step forward in safeguarding the reputation of our brand and business in Singapore and overseas.”

³ The mediation additionally included the logo mark, which was not opposed.

⁴ It is a condition of funding under the IPOS EMPS that parties agree to named publicity, without the need to disclose specific details of the settlement agreement.

⁵ In light of the global economic difficulties due to COVID-19, WIPO Center offered mediation services at no charge for mediation requests filed within the period 12 June – 31 August 2020.

The Applicant's Director, Mr Stanley Siu, indicated that it is likely to use mediation again and commented that mediation is "[l]ess stressful and quicker in result. Parties have the opportunity to understand each other's case and to negotiate in a more business-like manner with less animosity".

The Opponent's agent, Ms Tan Weiyi, Partner at Harry Elias Partnership LLP added, "[a]s solicitors for our client, we are pleased that parties were able to resolve the dispute through the mediation process and reach a resolution that addressed the commercial concerns and objectives of both parties."

7 December 2020

Annex A

Young IP Mediators Initiative – Student Mediator Participates in his First Mediation Success Case

1 The Young IP Mediators initiative (YIPMI) was launched by Second Minister for Law Edwin Tong on 26 August 2020 during the annual IPOS flagship event, IP Week@SG. The initiative seeks to nurture and build up IP mediation experience among our youth by giving them an opportunity to be involved in mediation.

2 This is the first successfully mediated case where a Young IP Mediator had a first hand experience of witnessing how a mediation was steered to success within a day. Under the lead of experienced mediator, Mr Andy Leck, Mr Utsav Rakshit, a final year student at the National University School of Law (NUS), participated in a mediation involving a multi-jurisdictional trademark dispute.

3 About the YIPMI, Professor Joel Lee from NUS opined, “The YIPMI allows for the nurturing of the next generation by giving them an opportunity to be involved in mediation, and specifically in Intellectual Property mediations. This will grow a generation of mediation-friendly IP mediators and advocates which will then feed into the mediation ecosystem.”

4 Similarly, Professor Nadja Alexander, from the Singapore Management University School of Law (SMU), commented, “The [YIPMI] is a wonderful initiative that allows students and young mediators to get their teeth into real life mediation cases by shadowing an experienced mediator in an actual case. Students learn practical skills and mediation theory at courses we teach...The [YIPMI] allows them the opportunity to complete the practical experience by seeing how a real-life dispute is mediated. This is a precious opportunity for our students, especially since they are also given the opportunity to interact with a seasoned mediator and to learn from his/her experiences.”

5 Indeed, Mr Rakshit has found this experience extremely meaningful. He reflects, “I had thoroughly enjoyed the process and had the chance to learn a lot just from observing Mr Leck in terms of his demeanour, how he reframed matters, his choice of words, and how he kept the parties on track and assisted in generating options.” Commenting on the Young IP Mediator, Mr Leck shared “I hope [Utsav], as a shadow mediator, managed to experience first-hand how a mediation is conducted from the perspective of the mediator. This initiative may hopefully spark interest in mediation and IP in the future generation of young lawyers.”

6 Ms Chiara Accornero, representative of the World Intellectual Property Organisation (WIPO) Arbitration and Mediation Center in Singapore (the only office outside Geneva), commented, “ As effective mediation proceedings depend to a large extent on the quality of the mediator, we fully support IPOS new [YIPMI] to offer hands-on training and exposure to real mediation practice to motivated law graduates interested in mediation. We are delighted that a number of IPOS Young IP Mediators were able to shadow some WIPO mediations and we hope that this will contribute to further build IP mediation experience and awareness.”

7 Commenting on the early success of the YIPMI, Mr Mark Lim, Chief Legal Counsel, and the Director of the Hearings and Mediation Department of IPOS, which played an integral role in the genesis of this initiative, stated, “We are delighted that our appointed Young IP Mediators have been offered hands-on induction and exposure to real mediation practice. This move is part of our continuous capability building effort to raise the next generation of IP mediation expertise, and it complements Singapore’s drive towards becoming a global IP dispute resolution hub.”

Mediation Success at IPOS

Eley Trading Sdn Bhd & Kwek Soo Chuan [2020] SGIPOS MED 1

	Party	Party
Name	Eley Trading Sdn Bhd	Kwek Soo Chuan
Nationality / Country of Incorporation	Malaysia	Singapore
Representation	Ravindran Associates LLP	Bird & Bird ATMD LLP
Lawyers	Paul Teo	(i) Alban Kang (ii) Just Wang

Mediation Institution	World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) ¹
Mediator	Joyce A. Tan, of Joyce A. Tan & Partners LLC
Shadow Mediator²	Cheryl Lim, of Joyce A. Tan & Partners LLC
Date of Mediation	17 September 2020

Background to the Dispute³

This dispute revolves around the Singapore registered trade mark 菩提 (“Bodhi” in English) in Class 4. Mr Kwek Soo Chuan owns this trade mark and was the sole proprietor of Bodhi Buddhist Products in Singapore, which is in the business of distributing Buddhist religious products. The other party, Eley Trading Sdn Bhd (Eley) is a Malaysian manufacturer and distributor of Buddhist religious goods in Malaysia, Thailand, Indonesia, Hong Kong and Singapore.

The parties had an earlier dispute over the same mark in Class 3. Subsequently, Eley commenced 3 other invalidation proceedings against Mr Kwek in 2018, of which 2 were settled, leaving only the invalidation proceedings against the 菩提 mark in Class 4. This was the subject of the present mediation.

The Seemingly Unbridgeable Gap

The parties had already filed their pleadings and evidence and were on the brink of another hearing. The only thing standing in between was mediation. The parties were strongly encouraged by the Registrar of Trade Marks to mediate since there was only one outstanding dispute after their own negotiations settled the 2 other invalidation actions.

¹ The WIPO Center’s only office outside Geneva, Switzerland is in Singapore.

² It is a condition of funding under the IPOS Enhanced Mediation Promotion Scheme (EMPS) that parties allow a “shadow” mediator to sit in and observe the mediation; or have a co-mediator to assist in the mediation. The objective is to give more exposure on how mediation can resolve IP disputes and build up experience among those who may mediate or represent parties in IP mediation in future.

³ It is a condition of funding under the IPOS EMPS that parties agree to named publicity, without the need to disclose specific details of the settlement agreement.

Once the parties submitted their dispute to mediation under the World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center), Ms Chiara Accornero, the WIPO Center's representative in Singapore, rendered strong support and timely guidance to the parties. The appointment procedure followed Article 7(a) of the WIPO Mediation Rules. The WIPO Center prepared a shortlist of three possible mediators, taking note of the subject matter of the case and the preference of the parties for a mediator specialised in IP law and of one party for a Mandarin-speaking mediator⁴. The parties ranked the shortlisted names by preference and, based on both parties' rankings, Singaporean mediator, Ms Joyce A. Tan of Joyce A. Tan & Partners LLC, was appointed.

Prior to the mediation, Ms Tan, the mediator, held separate preparatory sessions with each party. Having heard from both sides, she realized that it would be a difficult mediation as there was "a great and apparently unbridgeable distance between them".

The Mediation Process

The mediation was entirely conducted online on the WebEx platform, hosted by the WIPO Center. There were certain challenges associated with the mediation process. First, Ms Tan was acutely sensitive to the possibility of online fatigue from showing up in an all-day online engagement. Accordingly, to address this, she let the parties take turns to come online.

A unique feature of WIPO's online service is a virtual private room, with extended duration availability, which promoted the use of multiple private sessions with the relevant parties. Even though both parties were present throughout the session, the mediation was largely conducted via multiple private sessions with each party, without the presence of the other. The only exceptions were during the opening and closing sessions.

Second, there was a language barrier. The mediation was held in English whilst the parties were more comfortable speaking in Mandarin. The most significant of those barriers were the impasses at pivotal moments which seemed unsurmountable and at one point it appeared that a settlement was out of reach. However, it all boiled down to trusting the mediation process. For Ms Tan, it simply became a matter of not giving up, and "letting hope spring eternal and ceaselessly deploying the imagination to convey an empathetic rhetoric to each party, in eventually finding solutions for a settlement that both sides would be happy with".

The Settlement Agreement

True enough, at 8.30 p.m., after 10 ½ hours of mediation (and a lunch break), both parties came to an amicable solution and signed off on the settlement agreement. Mr Kwek was satisfied with the mediation process, and the support provided by the mediator and the WIPO Center. Notwithstanding the language barrier, the mediation was able to proceed effectively with translation support from parties' counsel. Eley found the pre-mediation session very useful as it saved time at the actual mediation. This was the first time Eley used mediation to resolve a dispute, and it was likely to both use mediation again and recommend it to others.

Mediation as the Way Forward

At the conclusion of yet another successful mediation, we had an opportunity to chat with Ms Tan.

⁴ Before the shortlist is prepared, parties are able to state their preferences or requirements for a mediator e.g. qualifications, expertise, nationality, languages spoken etc.

Q: How is mediation an appropriate way to address IP disputes?

A: I find that mediation is particularly suited to the resolution of cross-border IP disputes, whether involving parties from different jurisdictions and/or IP existing under the laws of different jurisdictions, as these require the handling of potentially complex legal technicalities, formalities and/or boundaries. Mediation can liberate the parties from having to navigate these commercially artificial barriers and allow them to focus on business-oriented considerations in finding solutions which are meaningful to them in relation to the IP concerned and the marketplace involved.

Q: Are there any particular trends you notice in IP mediation?

A: Anecdotally, I sense a growing amiability towards mediation for the resolution of such disputes, perhaps due to the documented positive experiences of others and the widening awareness and better understanding of mediation for what it is, what it can do and how it works. In a nutshell, mediation can dissolve barriers, be they of a legal, geographical, technical, financial, commercial or formal nature, that can otherwise keep disputants apart or a dispute alive.

Written by Utsav Rakshit, Young IP Mediator
7 December 2020


Mediation Success at IPOS

**Suravit Kongmebhol
&
Aftershokz, LLC
[2019] SGIPOS MED 1**


	Party	Party
Name	Suravit Kongmebhol	Aftershokz, LLC
Nationality / Country of Incorporation	Thailand	United States of America
Representation	That.Legal LLC	(i) Foo & Quek LLC (ii) NLC Law Asia LLC
Lawyers	(i) Mark Teng (ii) Lim Tianjun	(iii) Ng Lip Chih (iv) Alex Goh

Mediation institution	World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) ¹
Mediator	Joyce A. Tan, of Joyce A. Tan & Partners LLC
Shadow Mediator²	Cheryl Lim, of Joyce A. Tan & Partners LLC
Date of Mediation	30 August 2019 to 31 August 2019

Bone conduction technology allows the deaf to hear and swimmers to listen to music underwater. It works by conducting sound through the hearer's bones to the inner ear, in contrast to conventional technology which conducts sound through air. With this promising technology as the backdrop, in 2012, Aftershokz, LLC, a New York company, saw its "AfterShokz" headphones win the Consumer Electronics category in the Wall Street Journal Technology Innovation Awards. In Singapore, however, Mr Suravit Kongmebhol, a Thai citizen and serial businessman, had, in 2017, already registered the

mark  in respect of headphones, loudspeakers and headsets.

Aftershokz, LLC and Mr Kongmebhol became embroiled in cross-actions at the Intellectual Property Office of Singapore (IPOS). Aftershokz, LLC sought to invalidate Mr Kongmebhol's 2017 registration; while Mr Kongmebhol opposed four trade mark applications involving the marks SHOKZ, OPTISHOKZ

and  filed by Aftershokz, LLC in 2018.

Mr Kongmebhol, represented by Mr Mark Teng and Mr Lim Tianjun of That.Legal LLC, submitted a unilateral request for mediation to the WIPO Center. This process allows a party to submit a request for mediation while the other party has yet to agree to mediation, and WIPO Center may assist the

¹ The WIPO Center's only office outside Geneva, Switzerland is in Singapore.

² It is a condition of funding under the IPOS Enhanced Mediation Promotion Scheme (EMPS) that parties allow a "shadow" mediator to sit in and observe the mediation; or have a co-mediator to assist in the mediation. The objective is to give more exposure on how mediation can resolve IP disputes and build up experience among those who may mediate or represent parties in IP mediation in future.

other party in its consideration of the request for mediation. Aftershokz, LLC, represented by Mr Ng Lip Chih of Foo & Quek LLC and Mr Alex Goh of NLC Law Asia LLC, agreed to mediation.

In accordance with the appointment procedure under Article 7 of the WIPO Mediation Rules, the WIPO Center prepared a shortlist of five possible mediators, taking note of the subject matter of the case and the location of the mediation³. In this case, the parties did not exercise their right to rank the shortlisted names by preference⁴ and instead requested the WIPO Center to select the mediator. Singaporean mediator, Ms Joyce A. Tan of Joyce A. Tan & Partners LLC, was thus appointed. The parties agreed to extend the scope of the mediation to foreign IP rights as they also had an opposition in Vietnam; and as Mr Kongmebhol and another person also filed trade mark applications for



, and for variants of ASHOKZ and SHOKZ in Indonesia, the Philippines, Malaysia and Thailand.

The mediation took place in Singapore on 30 August 2019 at the mediator's office. Mr Kongmebhol and Aftershokz, LLC's representatives flew to Singapore to take part in the mediation. The session started in the morning and the parties reached a win-win outcome after 19.5 hours, ending with a settlement agreement after midnight into the next day. Had the parties decided to fight it out in an adversarial setting, it could have taken about two more years and several-fold costs to file evidence and submissions in five sets of proceedings, and obtain the Registrar's decisions after hearings. This could take even longer in other jurisdictions, and may have resulted in uneven global outcomes in relation to the same or similar marks.

Under IPOS' Enhanced Mediation Promotion Scheme (EMPS)⁵, the parties received funding of S\$12,000 for this mediation case where the subject matter of mediation additionally involved foreign IP rights. This fully subsidised WIPO Center's administration fee and the mediator's fees and expenses, and partially defrayed the parties' mediation-related lawyer fees and disbursements.

Both parties were very satisfied with the mediation process, and thought that the mediation was effective in resolving their disputes. They were likely to use mediation again, and to recommend mediation to others. Mr Kongmebhol said, "I am very glad that mediation in Singapore has helped us resolve the existing disputes and achieved a win-win outcome for all parties". Aftershokz, LLC's Mr Wan Jingchun, IP Manager and Ms Daisy Gong, IP Consultant commented, "The success of the mediation is very significant to us. Apart from settling existing disputes, the settlement ensured the protection of our company's brand image and the rapid development of our business in Southeast Asia."

This case is only one of others worldwide, where parties with IP issues were able to amicably resolve their differences through mediation. Consider mediation for your IP disputes. Especially with the availability of funding under EMPS, there is little to lose and much to gain.

12 November 2019

³ Before the shortlist is prepared, parties are generally able to state their preferences or requirements for a mediator e.g. qualifications, expertise, nationality, languages spoken etc. In this case, the parties did not specify any particular preferences.

⁴ Nor to delete any candidate's name to whose appointment they object.

⁵ It is a condition of funding under the IPOS EMPS that parties agree to named publicity, without the need to disclose specific details of the settlement agreement.