

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

Mediation Success at IPOS

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Mediation Success at IPOS
Gromark Consumers Enterprise & GK Laboratory (Asia)

	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 Mediator	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



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).

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

The Opponent opposed the registration of the Application Mark² 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’ EMPS, 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,³ 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.”

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.”

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² The mediation additionally included the logo mark, which was not opposed.

³ 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.

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 & Kwek Soo Chuan

	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)
Mediator	Joyce A. Tan, of Joyce A. Tan & Partners LLC
Shadow Mediator⁴	Cheryl Lim, of Joyce A. Tan & Partners LLC
Date of Mediation	17 September 2020

Background to the Dispute

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.

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

⁴ It is a condition of funding under the IPOS Enhanced Mediation Promotion Scheme 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.

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 mediator⁵. 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.

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

⁵ 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.

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

	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 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.

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 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.

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), 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.