

Opposition to Amendment of Trade Mark Application after Publication (HMD Circular No. 8/2011, dated 26 August 2011)

Rule 23 of the Trade Marks Rules (Cap 332, 2008 Rev Ed) provides for opposition to amendment of a trade mark application for registration, where the amendment affects the representation of the trade mark or the goods or services covered by the application.

Rules 23(1) and (2) provide that the proposed amendment or a statement of the effect of the amendment shall be published for opposition purposes. The process for such opposition is similar to the process for opposing an application for registration under Rule 29. The same rules apply to these two types of oppositions (Rule 23(4)).

A Rule 23 action opposes the amendment of an application (which will move on to registration) while a Rule 29 action opposes the registration of the application mark itself.

A. OPPOSITION TO AMENDMENT – NO RE-OPENING OF SUBSTANTIVE OPPOSITION

An opposition under Rule 23 is confined to objections to the proposed amendment of an application and is not meant to re-open the application for opposition.

Thus, if a prospective opponent had missed the deadline for opposition when the application was first published, and there is subsequently an amendment to the application which is then published, he cannot file an opposition within 2 months of the publication of the amendment, unless his grounds of opposition are directly attributed to the published amendment. If his grounds of opposition are leveled against the registration of the application mark, the prospective opponent should instead apply to invalidate the registration after the application mark has been registered.

In summary, the publication of the amendment is not intended to extend the time for a prospective opponent to oppose the registration of a mark nor give him two bites of the cherry.

B. NOTICE OF OPPOSITION

The Notice of Opposition must contain a statement of the grounds upon which the person opposes the amendment. Such grounds include:

- (i) The amendment is contrary to Section 14(3) of the Trade Marks Act (Cap 332, 2005 Rev Ed) because it does not correct the name or address of the applicant or errors of wording or of copying or obvious mistakes.

- (ii) The amendment is contrary to Section 14(3) of the Trade Marks Act because it substantially affects the identity of the trade mark.
- (iii) The amendment is contrary to Section 14(3) of the Trade Marks Act because it extends the goods or services covered by the application.
- (iv) The amendment to the trade mark will render it contrary to specific absolute or relative grounds under Rules 7 and 8, to be specified in the statement of grounds.

C. APPLICATION OF THE PRINCIPLE OF RES JUDICATA

Where the substantive opposition to an application for registration has already been dealt with and results in an amendment which is published, it is not possible to revisit the issues raised in the substantive opposition by filing an opposition under Rule 23. The principle of *res judicata* applies. This means that a judicial decision is conclusive as between the parties.

In such a case, if an opponent disputes the decision of the Registrar in the substantive opposition, he has the right to appeal to the High Court. It is not for the Registrar to sit on appeal or review a decision that has been made by the Registrar on the same issues and between the same parties. The opponent is not entitled to a second opposition on the same issues.

The principle of *res judicata* was applied by the Registrar in ***Campomar S.L. v Nike International Ltd and Another*** [2004] SGIPOS 3. On appeal, the High Court in ***Nike International Ltd and Another v Campomar S.L.*** [2005] 4 SLR(R) 76 affirmed the application of this principle.