

**Application For Opposition To Be Struck Out &
Application For Leave To Amend Opposition
In Trade Mark Application No. 1801/91
By Mandarin Oriental Services B V**

And

**Opposition
By Excelsior Hotel Pte Ltd**

*Before Principal Assistant Registrar P Arul Selvamalar
9 May 2003*

Interlocutory hearing – Notice of Opposition filed in wrong name - Opponent non-existent at the point of filing - whether genuine mistake – whether identity of Opponent in doubt - whether Notice of Opposition may be amended to reflect proper name of Opponent

The Opponents lodged a notice of opposition in the name Excelsior Hotel Private Limited against a trade mark application by Mandarin Oriental Services B V in 1997. Excelsior Hotel Private Limited had been dissolved since 1995 and the assets and undertakings of the company had been distributed to YTC Hotels Ltd. The Opponents explained that they lodged the notice of opposition in the name Excelsior Hotel Pte Ltd because their opposition was based on their application for a trade mark T91/4332 which was in the name of Excelsior Hotel Pte Ltd. When they discovered the mistake, they applied to correct the error by amending the Notice of Opposition and other documents to reflect the name of the Opponents as YTC Hotels Ltd. The Applicants applied for the opposition to be struck out on the grounds that Excelsior Hotel Pte Ltd was not in existence at the time the notice of opposition was filed. The Opponents submitted that Order 20 Rule 5(3) of the Rules of Court applied and that it allowed the Registrar to correct the name of the party even if it meant the effect would be to substitute a new party.

Held, granting leave to correct the error,

- Section 77 of the old Trade Marks Act (Cap 332 1992 Ed) gave the Registrar the power to permit the amendment of a Notice of Opposition or other document lodged at the Registry for the purpose of correcting a clerical error or obvious mistake. This provision has not been reproduced in the new Trade Marks Act (Cap 332 1999 Ed). However rule 83 of the new Trade Mark Rules 1998 gives the Registrar the power to correct any irregularity in procedure if it is not detrimental to the interests of any party. The naming of the wrong party in the Notice of Opposition and other documents is a procedural irregularity which the Registrar may correct under this rule.
- The factors that may be taken into account before allowing an amendment to filed documents are similar to the considerations under order 20 rule 5(3) of the Rules of Court. In the Pacific Wisdom case, the Court of Appeal set out 3 conditions that have to be satisfied for the exercise of the power in allowing amendments under order 20 rule 5(3). First, the mistake must be a genuine mistake, second, the mistake must not be misleading or such as to cause reasonable doubt as to the identity of the person intending to sue or be sued, third it must be just to allow the amendment.
- The Registrar is satisfied that the Opponents made a genuine mistake in the filing of the opposition in the name Excelsior Hotel Pte Ltd instead of YTC Hotels Ltd. The error originated from the fact that the Excelsior Hotel Pte Ltd was the applicant for the trade mark Excelsior which forms the basis for the opposition. The mistake did not mislead the Applicants as to the identity of the party intending to take out the opposition. The Applicants were aware that it is the owner of the Excelsior Hotel that was taking out the opposition to their mark Excelsior. It is just to allow the amendment and it is not detrimental to the interests of the Applicants if the amendment is allowed.
- The application for striking out the opposition is therefore denied and the application for leave to amend the name of the Opponent in the notice of opposition and the Opponents' statutory declarations is granted. The Opponents are to pay the costs of the Applicants fixed at \$170.

Legislation referred to:

- Trade Marks Act (Cap 334 1992 Ed) s 77, Trade Marks Act (Cap 332, 1999 Ed)
- Trade Mark Rules 1998
- Order 20 Rule 5(3), Rules of Court

Cases referred to:

- Trade Mark Application No 649830 by Pharmedica GmbH (United Kingdom High Court Appeal from Patent Office)
- Lazard Brothers & Company v Midland Bank Ltd (1933) AC 289
- Dubai Bank Ltd v Galadari (No. 4) (1990) Times 23 February
- Toprak Enerji Sanayi AS v Sale Tilney Technology plc (1994) 3 All E R 483
- The Virginia Rhea (1984-1985) SLR 214
- Re Applications by Stratco Metal Pte Ltd (4 IPR 48)
- The Pacific Wisdom(1998) 3 SLR 705
- The Sardinia Sulcis & Al Tawwab (1991) 1 Lloyd's Rep 201
- Payabi v Armstel Shipping Corp (1992) 3 All E R 329
- International Bulk Shipping & Services Ltd v Mineral & Metals Trading Corp of India (1996) 1 All E R 1017
- Evans Construction Co Ltd v Charrington & Co Ltd (1983) 1 All E R 310
- Mitchell v Harris Engineering Company Ltd (1967) 2 QB 703
- Lim Yong Swee v Lim Jee Tee (1993) 1 SLR 500
- Gregson v ChannelFour Television (2000) All ER (D) 956
- Canadian Pacific (Bermuda) Ltd v Nederkoorn Pte Ltd (1998) 3 SLR 309
- The Casper Trader (1991) 2 Lloyds Rep 237
- Re Application by Havana Commercial Compay (1916) 33 RPC 399
- Re Application by Egg Products (1922) RPC 155
- Re Application by Arthur Fairest (1951) 68 RPC 197

Representation:

- Ms Moi Sok Ling (Khattar Wong) for the Opponents
- Mr Jason Chan & Ms Seow Wan Li (Allen & Gledhill) for the Applicants