

**Application for Security for Costs under Section 70  
In Trade Marks Application T04/17665E  
By Beyond Properties Pty Ltd (“Applicant”)**

**And**

**Objection  
By Andrew Knight (“Opponents”)**

*Principal Assistant Registrar Sandy Widjaja  
30 July 2009*

**Interlocutory hearing** – application for security for costs – objection by opponent -whether trade mark applicant entitled to security for costs – Trade Marks Act Section 70

The Applicant, Beyond Properties Pty Ltd had applied for a mark ‘MYTHBUSTERS’ for services in class 41. The mark was accepted for publication. The Opponent filed an opposition to the application on 27 October 2005. On 11 March 2009, the Applicant requested for security for costs on the basis that the Opponent neither resides nor carries on business in Singapore as per section 70 of the Trade Marks Act (Cap 332) 2005 Rev. Ed. (“TMA”). The amount requested for by the Applicant as security is \$15,000 or such other amount as the Registrar deems fit.

The Applicant also stated that they were informed that a bankruptcy proceeding has been instituted against the Opponent by the Applicant to cover legal costs associated with Federal Court proceedings in Australia. The Opponent did not make written submissions nor did he attend this interlocutory hearing. The Applicant submitted that: (i) there are similar actions in Australia, UK and in the Singapore High Court and in these cases, the Opponent has not complied with orders for costs; (ii) the Opponent has changed several representation here and that the Opponent has no address for service here for many months now; the Opponent is currently residing in a rental property in the UK and it is difficult to serve documents on him, including documents for this interlocutory hearing; (iii) on the issue of ‘carrying on business in Singapore’, that there was no sales invoice tendered in the Opponent’s evidence; even if the Opponent used to have had any business, he does not have any business in Singapore currently; the Opponent presently has no legal representation here and there is currently no other local address for service. On the quantum of security, the Applicant submitted that time was taken to respond to the Opponent’s evidence as apparent from the several volumes of statutory declaration submitted by the Applicant. The Applicant also submitted that there are two sets of legal representation (Singaporean and Australian) involved.

**Held, allowing the application,**

1. As the Opponent did not provide written submissions nor did he attend this interlocutory hearing, the Registrar will proceed on the basis of submissions of the Applicant for this hearing as well as the evidence filed by both parties in relation to the opposition proceedings.
2. The first issue in this instance is whether the Opponent ‘carries on business in Singapore’ as per the phrase in section 70 of the TMA.
3. From the evidence tendered by the Opponent, various different titles of his books were available for sale from bookshops etc in Singapore since 1991. Whilst there is no sales invoice tendered in the Opponent’s evidence as submitted by the Applicant, the Registrar is prepared to accept that there had been sales and there is still some sales of the Opponent’s books in Singapore based on the evidence of the Opponent. However, it cannot be said that the Opponent is thus “carrying on business in Singapore” as a result of such sales. The Opponent does not run any business in Singapore. Section 70 is fulfilled and the Registrar may require Opponent to give security for costs.
4. It is clear that section 70 is discretionary. The Principal Assistant Registrar in the application for security for costs by MGE UPS SYSTEMS in relation to TM 1146/97 held that security should not be granted as a matter of course and the Registrar in exercising her discretion must consider all the circumstances of the case. In exercising her discretion, the Registrar will have to consider what would be oppressive for the Opponent while giving the Applicant some measure of security. In relation to this, the Principal Assistant Registrar alluded that the factors which should be taken into consideration in deciding whether to grant security for costs in a trade mark opposition are similar to the factors which should be taken into consideration in deciding whether to grant security for costs in a civil suit.

5. The Registrar has considered the factors submitted by the Applicant including, the related action in the High Court of Singapore, similar actions in Australia and UK, non-compliance with costs orders pursuant to the above mentioned actions and that the Opposition is not supported by cogent and relevant evidence from the Opponents.
6. The Registrar also considered the fact that the Opponent is self funding the proceedings and therefore, the application for security for costs should not result in an outcome that will be oppressive to the Opponent.
7. Taking into account all of the above, the application for the security for costs is granted and the amount that the Registrar deems fit is S\$4000. Such security shall be in the form of a bank guarantee to be furnished to the Applicant's solicitors on or before 7 September 2009.
8. Costs against the Opponent for this application is awarded in the amount of S\$400.

#### **Legislation References**

- Trade Marks Act (Cap 332), 2005 Revised Edition, Section 70
- Rules of Court, Order 23

#### **Case References**

- L & M Concrete Specialists Pte Ltd v United Eng Contractors Pte Ltd [2001] 4 SLR 524
- Pandian Mariimuthu v Guan Leong Construction [2001] 3 SLR 400

#### **Representation**

- Ms Angeline Raj and Mr Jui Wei Zhong (Ella Cheong Spruson & Ferguson) for the Applicant
- Opponent was in absensure