

**IN THE HEARINGS AND MEDIATION DIVISION OF
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
REPUBLIC OF SINGAPORE**

Trade Mark Application No. T1012199I
30 June 2011

**APPLICATION FOR OPPOSITION NOT TO BE DISMISSED &
APPLICATION FOR LEAVE TO AMEND FORM TM 48
BY CALIDRIS 28AG (SA)**

AND

**OBJECTION THERETO
BY
BARRY CALLEBAUT AG**

Principal Assistant Registrar Sandy Widjaja
6 July 2011

Interlocutory Hearing – Application for Opposition not to be dismissed - Application for leave to amend Form TM 48 – Form TM 48 filed in wrong name - Objection by Applicant – whether identity of the Intended Opponent in doubt

The Applicant, Barry Callebaut AG, applied to register its trade mark, T1012199I "the Mark") in Classes 5 and 32. The Mark was published in the Trade Marks Journal No. 012/2011 on 25 March 2011. The Opponent, Calidris 28AG (SA), sought to apply for an extension of time via their letter of 24 May 2011 to the Registrar enclosing Form TM 48. The letter also provided that a copy of the said letter is also being served on the Applicant for their formal consent to the request for an extension of time. Part 2 of Form TM 48 requires the particulars of the intended Opponent to be inserted. However the particulars of the Applicant were provided under this part of Form TM 48 instead. On 25 May 2011, the Opponent wrote to the Registrar enclosing a copy of the Applicant's consent. The Registrar via her letter of 8 June 2011 then informed the Opponent that the Form TM 48 is rejected as the particulars of the intended Opponent are not provided. The Registrar further informed that as no proper extension of time request was filed by 25 May 2011, the application for registration would proceed to registration. The Opponent then wrote in on 9 June 2011 apologising for the mistake and requesting the Registrar to reconsider her decision. At the same time, the Opponent informed that they would contact the Applicant in relation to the issue in light of the circumstances. The Applicant informed the Registrar via its letter of 14 June 2011 that the Applicant did not agree to a further extension of time. By way of a separate letter of 14 June 2011, the Applicant also informed the Registrar that as there was no proper extension of time request by the deadline, they looked forward to receiving the Certificate of Registration. The Opponent

via its letter of 15 June 2011 thus requested for this hearing pursuant to rule 67 of the Trade Marks Rules (Cap 332, 2008 Rev Ed).

In its letter dated 21 June 2011, the Applicant confirmed that it would not be attending the hearing and instead it made written submissions in the same letter. The Applicant submitted that rule 29(3) has not been complied with as no Form TM 48 has been filed within the prescribed term. The Applicant also submitted that the Opponent is not prejudiced (should the application for registration be granted) as the Opponent can still file for an invalidation action.

At the hearing, the Opponent submitted that the relevant provision in this instance is section 25 of the Trade Marks Act (Cap 332, 2008 Rev Ed). In particular, the Opponent submitted that section 25(a) is relevant in this instance. The Opponent submitted that in this case, rule 29 is not in issue as it has been complied with. The Opponent also referred to the IPOS case of *Application for Opposition to be Struck Out & Application for Leave to amend Opposition in Trade Mark Application No. 1801/91 by Mandarin Oriental Services BV and Opposition by Excelsior Hotel Pte Ltd [2003] SGIPOS 5 ("Excelsior Case")* and submitted that the case is applicable in this instance. In fact the Opponent submitted that in the *Excelsior case* the mistake is more 'serious' in that it involves an amendment to a Notice of Opposition unlike the current case which involves an amendment to Form TM 48. The Opponent submitted that the *Excelsior case* provided that the relevant factors that are to be considered are those which are relevant under Order 20 Rule 5(3) of the Rules of Court.

The Opponent referred to the Court of Appeal case in *The Pacific Wisdom [1998] SGCA 77* where the Court expounded the 3 factors which have to be considered under the said Order (i) that the mistake must be a genuine mistake; (ii) that the mistake was not misleading or such as to cause reasonable doubt as to the identity of the person intending to sue; (iii) that it is just to allow the amendment. The Opponent submitted that the 3 conditions are made out in this instance. In particular, the mistake was not misleading or such as to cause reasonable doubt as to the identity of the person intending to sue. In support of this, the Opponent referred to letters by the Opponent, Registrar and in particular, the Applicant's letter of consent of 24 June 2011. In the header of the said letter, there is reference made to both the names of the Applicant as well as the Opponent. Finally the Opponent submitted that it is just to allow the amendment as the Applicant is not prejudiced in any way having granted its consent to the extension of time initially via their letter of 24 June 2011.

In relation to the Applicant's submissions, the Opponent rebutted that rule 29(3) has been complied with as Form TM 48 has been submitted within the prescribed time frame. The main issue is instead the amendment of Form TM 48 pursuant to s25. The Opponent also submitted that an opposition is not equivalent to an invalidation action and that the Opponent would be prejudiced if it have to proceed to file for an invalidation action. However, the Opponent conceded that the Applicant is entitled to costs based on the circumstances of the case.

Held, allowing the application

- 1 Section 25 of the Act empowers the Registrar with the discretion to amend an application, a notice or a document to correct a clerical error or an obvious mistake at the written request of the person who made the application, or filed a notice or other document or at the written request of the person's agent. It is clear that the provision applies to the current situation in that the Opponent via their agent is requesting for Form TM 48 to be amended to correct a clerical error or an obvious mistake.
- 2 The *Excelsior case* is applicable in this instance. Applying the *Excelsior case*, the factors which may be taken into account by the Registrar in exercising her discretion under the section are the same factors which are to be taken into account under Order 20 Rule 5(3) of the Rules of Court. The Court of Appeal in the *Pacific Wisdom Case* expounded the considerations in the application of O 20 rule 5(3) as follows:
 - (i) The mistake must be a genuine mistake;
 - (ii) The mistake must not be misleading or such as to cause reasonable doubt as to the person intending to sue or be sued;
 - (iii) It must be just to allow the amendment.
- 3 The main considerations in issue in the current case are (ii) and (iii). In this case, the mistake was not misleading nor did it cause any doubt as to the person intending to bring the opposition. The Applicant was aware of the identity of the Intended Opponent. This is evident from the Applicant's letter of 24 June 2011 granting its consent for the extension initially (see Annex C at page 26 of the Written Submissions of the Opponent). Similarly, it is just to allow for the amendment as the Applicant is not prejudiced in that the Applicant is aware of the identity of the Intended Opponent. In any event, if there was any prejudice, it is not such that the Applicant cannot be compensated by costs.
- 4 The application for leave to amend Form TM 48 is thus granted.
- 5 The Applicant's application for an award of costs is granted in the amount of S\$200 and is payable by the Opponent to the Applicant within 2 weeks from the date of this decision.

Legislation discussed:

Trade Marks Act (Cap 332, 2005 Rev Ed), Section 25

Cases referred to:

Application for Opposition to be Struck Out & Application for Leave to amend Opposition in Trade Mark Application No. 1801/91 by Mandarin Oriental Services BV and Opposition by Excelsior Hotel Pte Ltd [2003] SGIPOS 5
The Pacific Wisdom [1998] SGCA 77

Representation:

The Applicant was in absentia

Mr Prithipal Singh on behalf of Patrick Mirandah Co.(S) Pte Ltd for the Opponent