

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

Trade Mark Application No. T0719918D
29 May 2012

IN THE MATTER OF TRADE MARK APPLICATION BY

TAN SIEW KENG ANGELINE

AND

OPPOSITION THERETO BY

LEONID KOVALKOV

Hearing Officer: Ms Sandy Widjaja
Principal Assistant Registrar of Trade Marks

Mr Ignatius Joseph (Ignatius J & Associates) for the Applicant

Mr Alvin Lim (Tito Isaac & Co LLP) for the Opponent

Cur Adv Vult

GROUND OF DECISION

1 This is an opposition to the registration of the trade mark T0719918D (“the Application Mark”):

JNBK |

for "Air filters for commercial vehicles, oil filters, fuel filters for land vehicles; fuel pumps and water pumps for land vehicles; all included in Class 7." in class 7.

2 The Applicant is Tan Siew Keng Angeline ("the Applicant") and the Opponent is Leonid Kovalkov ("the Opponent").

3 The Application Mark was accepted and published on 26 October 2007 for opposition purposes. The Opponent opposed this application on 21 December 2007. The Applicant filed their Counter-Statement on 20 February 2008.

4 The Opponent filed evidence in support of the opposition on 3 October 2008. The Applicant filed evidence in support of the application on 4 December 2008. Evidence in reply was filed by the Opponent on 21 August 2009. The Pre-Hearing Review was conducted on 10 September 2009 and the opposition was only heard on 29 May 2012 as parties were awaiting the resolution of proceedings in the Subordinate Court.

Grounds of Opposition

5 The Opponent relied on Section 7(6) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act").

Opponent's Evidence

6 The Opponent's evidence comprises of a Statutory Declaration made by Mr Leonid Kovalkov on 3 October 2008 ("Opponent's 1st SD"), as well as a Statutory Declaration in Reply made by the same deponent on 19 August 2009 ("Opponent's 2nd SD").

Applicant's Evidence

7 The Applicant's evidence comprises of a Statutory Declaration made by Ms Tan Siew Keng, Angeline, on 2 December 2008 ("Applicant's SD").

Applicable Law and Burden of Proof

8 The applicable law is the Trade Marks Act (Cap 332, 2005 Rev Ed) and there is no overall onus on the Applicant either before the Registrar or in opposition proceedings. The undisputed burden of proof in the present case falls on the Opponent.

9 The Singapore Court of Appeal in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] SGCA 14 ("*Valentino*") at [21] stated that:

It is in line with common sense and logic that he who asserts must prove although, depending on the evidence tendered, the evidential burden could shift to the other side. The legal burden of proof required to substantiate a ground to oppose the registration of a trade mark remains throughout on the

party making the application, and this would be the Appellant in the present case.

10 Further exposition of the above can be found in *Evidence, Advocacy and the Litigation Process* (LexisNexis, 3rd Ed, 2010) by Jeffrey Pinsler at 12.05:

The legal burden (the burden of proving a fact to the requisite standard of proof) always remains on the party who seeks to prove the fact. The evidential burden (the burden of adducing evidence to meet the standard of proof or to prevent the opposite party from meeting the standard of proof) may be on either party depending on the circumstances of the case.

Background

11 The Opponent entered into a business arrangement with one Boris Nefedov ("Boris"), Goh Boon Sin ("Goh") and Ong Hoe Koon ("Ong") to be part owner of the Company EPL Distribution Pte Ltd (company registration number 199205246 - now liquidated) ("EPL"), formally known as EPL Distributions Private Limited (26 November 2003) and ENESI Pte Ltd (30 September 1992).

12 The individuals were also the shareholders of EPL and each held varying shares in EPL. The Opponent deposed that Ong and himself were actively involved in the general operation of EPL while Boris and Goh had more limited roles in the running of EPL.

13 The Applicant is the wife of Ong and worked as a secretary cum administrative staff for EPL since 1999.

MAIN DECISION

Ground of Opposition under Section 7(6)

14 Section 7(6) of the Act reads:

7.— (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Opponent's Submissions

15 The Opponent submitted that the following factors show that the Applicant filed the Application Mark in bad faith:

(i) The Applicant was well aware that the creator and the proprietor of the JNBK mark is the Opponent;

(ii) The Application Mark was filed in her personal name and when she was still an employee of EPL. If (which is not admitted) the Applicant had created the Application Mark, it was during the course of her employment and as such, EPL would be the owner of the Application Mark;

(iii) Before the filing date of the Application Mark, the Applicant had already admitted in the presence of witnesses that she was not the owner of T0312074E and T0615020C (“JNBK Marks”);

(iv) The Applicant had filed for the Application Mark on 9 October 2007 which was after she had received a letter of demand dated 17 September 2007 from the Opponent's solicitors which clearly asserted the Opponent's claim to the ownership of the JNBK Marks.

16 The Opponent submitted that he is the bona fide proprietor and rightful owner of the JNBK mark, including all its variants. The JNBK mark was created sometime in 2002 and is an abbreviation of "Japan New Brake Kits".

17 The Opponent submitted that he was the Marketing Director of EPL. He took the lead in the sales and marketing of EPL's products including products bearing the JNBK mark and planned and executed the advertising and promotional activities for EPL. Because of his role and designation, it is more natural and logical for him to create brand names and trade marks, including the JNBK mark. In contrast, the Applicant has admitted that she was a secretary cum administrative staff. The Opponent submitted that it is not believable that a person having such a role and designation would naturally create intellectual property such as trade marks for her employer.

18 The Opponent referred to the evidence [/letters via exhibits attached to the Opponent's evidence] of Mr Hirokazu Soma ("Soma"), Boris, Ho Chong Tat, Ivan (“Ivan Ho”) and Komyza Alexey (“Alexey”). The Opponent submitted that the independent, corroborated evidence [/letters] of four different witnesses point to the same conclusion that the JNBK mark was created by the Opponent. These four persons worked in EPL at the relevant time and had personal knowledge of the facts that they had attested to.

19 In contrast, the Applicant has not been able to produce any witness whatsoever to substantiate a claim that she had created the JNBK mark. The Opponent pointed out that even her own husband, Ong, did not file any evidence to support her claim that she created the JNBK mark. The Opponent submitted that this is puzzling in view of her assertion that she created the JNBK mark and had filed trade mark applications in her name in order to help protect EPL and her husband. The Opponent submitted that if her claim that she had created the JNBK mark was true, then one would normally expect at the very least her own husband, to back her claim.

20 The Opponent also referred to the evidence of Goh where he stated that he heard the Applicant admit that she is not the owner of the JNBK Marks which were registered in Singapore in her personal name.

21 The Opponent submitted that there has been use of the JNBK mark since 2002. The Opponent submitted that around July 2002, he had instructed a Taiwanese company, Luh Dah Corporation (“Luh Dah”), to produce brake pads and shoes applying the JNBK mark to these goods.

22 The Opponent submitted that the Opponent's ability to instruct foreign friends to assist in registering the JNBK trade mark in their respective home countries (Japan, and Russia) indicates strongly that he is the owner of the JNBK mark. The Opponent submitted that it is a hallmark of ownership that an owner can instruct other persons to carry out instructions in connection with his property. The Opponent submitted that his action was congruent with the proposition of proprietorship.

23 The Opponent submitted that the Applicant's evidence is notable for the frequent and highly derogatory remarks about the Opponent. The Opponent submitted that the remarks are insulting and are calculated to damage the Opponent's character. The Opponent submitted that when the Registrar weighs up the merits of each party's case, she must also have cognizance of the way that each party handled his or her case. The Opponent submitted that this have a bearing on the veracity of each party and directly goes to the weight of each party's evidence.

24 The Opponent referred to of *Valentino Globe BV v Pacific Rim Industries Inc* [2010] SGCA 14 ("*Valentino*") and submitted that he accepts that the primary onus of proof to show bad faith lies on him. However, the Opponent submitted that he has discharged the burden of proof. The Opponent submitted that he has, in his evidence, exhibited letters and statutory declarations from not less than four other parties to attest to the fact that he was the creator and owner of the JNBK mark. The Opponent submitted that there was even the statutory declaration of Goh which positively affirms that the Applicant admitted that she did not own, amongst others, the JNBK Marks.

25 The Opponent submitted that in light of such statements, the evidential burden has shifted to the Applicant. The Applicant should produce counter-evidence to show why the Opponent's witnesses' statement should not be accepted. The Opponent pointed out that the Applicant has produced no evidence whatsoever to shift the burden back to the Opponent. She has not even denied the meeting of July 2007 in which Goh attested to the fact that the Applicant admitted that she did not own the JNBK Marks.

26 The Opponent referred *Valentino* which accepted the case of *Gromax Plastics Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 for the definition of bad faith as behaviour that:

... includes dishonesty and...dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area of trade being examined.

The Opponent also referred to *Valentino* at [29] that:

...the "combined" test of bad faith, contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think).

The Opponent submitted that in connection with the subjective element, the time that the test is to be applied is at the date of the filing of the Application Mark *Borri S.P. A v Bees S.R.L* [2011] SGIPOS 5 ("*Borri*"). The Opponent also submitted that *Borri*

also repeated the proposition that the applicant's own standards of dishonesty is irrelevant.

27 The Opponent submitted that the Applicant must be aware at the filing of the Application Mark that there were adverse claims to her alleged ownership of the Application Mark. The Opponent submitted that the fact that she was an employee of EPL should have at least, made her aware that EPL had a claim towards ownership.

28 The Applicant, in the meeting in July 2007, admitted to the persons present, including Goh, that she did not own, amongst others, the JNBK Marks. The Applicant has not disputed that this meeting occurred. The Opponent submitted that in view of such an admission, the Applicant should have been aware that she could not legitimately claim to be the proprietor of the Application Mark.

29 The Applicant also had received a letter of demand from the Opponent's solicitors which set out the Opponent's claim to ownership of the JNBK Marks. The letter was received before the filing date. The Applicant however did not even bother to respond to dispute the Opponent's claim but chose to proceed with the filing of the Application Mark.

30 The Opponent referred to *Weir Warman Ltd v Research & Development Pty Ltd* [2007] SGHC 59 ("*Weir Warman*"):

It appears to me to be an incontrovertible proposition that if a registrant of a trade mark has proprietorship of that trade mark, or at the very least, the *right to register* that trade mark, then such registration of the trade mark should fall well within the standards of acceptable commercial behaviour observed by reasonable and experienced persons in the particular trade. Conversely, where it can be shown that the applicant knew of an *exclusive* proprietary right of *another* in relation to the trade mark it seeks to furtively register, then any such registration would, almost invariably, quite clearly fall short of the relevant standards.

The Opponent submitted that in the present case there cannot be any doubt that the Applicant knew of the "exclusive proprietary right" of the Opponent.

Applicant's Submissions

31 The Applicant submitted that the Applicant had not made the Application Mark in bad faith and that the Opponent had not tendered any proof of the same. The Applicant submitted that she is the creator of the JNBK mark and that she has filed the application to register the Application Mark in good faith.

32 The Applicant referred to the Court of Appeal in *McDonald's Corp v Future Enterprises Pte Ltd* [2005] 1 SLR(R) 177 at [78] which cited with approval the holding in *Royal Enfield Trade Marks* [2002] RPC 508 that:

“ *an allegation of ...bad faith made under section 3(6) [of the UK Trade Marks Act 1994]...should not be made unless it can be fully and properly*

pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference.

[emphasis added].

The Applicant also referred to *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 (“*Festina*”) at [101] which cited an oft-quoted passage from *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 as to what the concept of bad faith connotes:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.

The Applicant then referred to *Festina* at [103], where Justice Tay cited with approval from *Intellectual Property Law* (Oxford University Press, 3rd Ed, 2009) by Bently & Sherman the three categories of bad faith:

- (i) no intention to use the mark;
- (ii) abuse of relationship;
- (iii) where the applicant was aware that a third party had some sort of claim to the goodwill in the mark.

The Applicant also referred to *Festina* at [101] that:

Bad faith is to be determined as at the date of application and matters which occurred after the date of application which may assist in determining the applicant’s state of mind as at the date of application can be taken into consideration, see Ferrero SpA’s Trade Marks [2004] RPC 29.

33 The Applicant submitted that the Applicant had at the time of application and continues at present to have every intention to use the Application Mark. The Applicant is already the registered trade mark owner of the JNBK Marks for goods specified under Class 12 as well as J.SAKURA (T0307028D) and J.ZAKURA (T0409752F) trade marks (“Sakura Marks”). The Applicant submitted that the Applicant has used [the JNBK Marks] via its licensees, EPL (now liquidated) and Zonac Pte Ltd (now Sintrade Pte Ltd (“Sintrade”)).

34 The Applicant further submitted that even if it were true that the Opponent created all the materials (as per the exhibits in the Opponent’s SD), the Opponent did so in the Opponent’s capacity as the “Marketing Director” of EPL. Thus the JNBK Marks never belonged to the Opponent personally and neither were the materials he purportedly created.

35 The Applicant submitted that the Applicant’s licensee companies in Singapore produced packaging bearing the [JNBK Marks] and completed the packaging in Singapore of the goods sold under the [JNBK Marks] in Singapore, whether for local sale or export. The Applicant submitted that she plans to license Sintrade to use the Application Mark once it is registered. As JNBK is a popular mark known for brake

pads and brake shoes both overseas and in Singapore, the Applicant plans to tap on this popularity to expand the brand to include goods under Class 7 as well. This the Applicant can easily do as Sintrade already distributes the goods specified under the Application Mark, under the Sakura Marks, and the Applicant has a ready supply of such goods.

36 The Applicant submitted that the Opponent has provided no evidence that the Applicant has abused a pre-existing relationship in filing the Application Mark. The Applicant submitted that the Opponent claimed that all four of the trade marks previously registered by the Applicant (ie the JNBK Marks as well as the Sakura Marks) were filed in bad faith, as the Applicant had "usurped" marks created by the Opponent. The Applicant submitted that no evidence has been given of this either, and it is noteworthy that despite the fact that the [JNBK Marks] were registered from as early as 2003, the Opponent has not taken any steps to invalidate [them] on the basis of this alleged bad faith.

37 The Applicant submitted the relevant facts surrounding the registration of the [JNBK Marks] are as follows.

38 From 1998, EPL distributed the products of Nisshinbo Corporation. However, Nisshinbo Corporation then began to bypass EPL and sell directly in Russia. The resulting loss of sales made the Opponent so anxious that he entered into the risky business of selling counterfeit products under the Nisshinbo mark. Ong tried to persuade the Opponent not to do so but to no avail.

39 The Applicant submitted that the Applicant then suggested to Ong that EPL should begin to distribute brake pads and filters using different brands. The Applicant suggested that she would create new brands, register them as trade marks in her own name and license these trade marks to EPL as agents. As the Applicant was not one of the directors or shareholders of EPL, this licensing arrangement would allow EPL to distribute a competing line of products to that of their principals in a manner that would not be easily detected by them.

40 Based on the foregoing facts, the Applicant submitted that she did not take advantage of any pre-existing relationship.

41 The Applicant submitted that as far as she is aware, there are no third parties currently existing which have any claim to the goodwill in the mark. The Applicant submitted that the Opponent did not create the JNBK mark. The Applicant submitted that she created it and registered it in her own name. The Applicant submitted that she developed the JNBK mark, the letters being taken from the words "Japan Brake". These words were chosen as EPL was selling brakes for Japan made cars. The Applicant conceived that the letters were an acronym for "Japan New Brake Kit".

42 The Applicant submitted even if it were true that the Opponent had created the JNBK mark (which is denied), as the Opponent was at the relevant time, the Marketing Director for EPL, the copyright in the marks which he purportedly created in order to market EPL's products belonged to the EPL and not to him personally.

43 Further, the Applicant submitted that the Opponent's instructions to his own solicitors with regard to the purported transfer of ownership have been inconsistent. The Applicant submitted that the Opponent has been deliberately vague and inconsistent about whether the Applicant's purported agreement was to transfer these rights to [EPL] or to its directors personally. The Applicant submitted that the Opponent's version of the facts is highly contradictory and inconsistent as the Opponent has been untruthful in claiming that the Applicant had agreed to transfer her rights.

Decision on Section 7(6)

44 The applicable principles of law for bad faith have been set out by parties above and I only need to summarise here for the sake of completeness.

45 Firstly, bad faith is a distinct and independent argument from the issue of confusing similarity; secondly and importantly, the combined test of bad faith contains both a subjective element (*viz*, what the particular applicant knows) and an objective element (*viz*, what ordinary persons adopting proper standards would think); thirdly, bad faith includes behaviour which otherwise involves no breach of any duty, obligation, prohibition or requirement that is legally binding upon the applicant. Finally, bad faith is to be determined as at the date of application for registration of the application mark although bad faith did not exclude from consideration matters which occurred after the date of application in that they may assist in determining the applicant's state of mind at the date of registration (*Ferrero SpA's Trade Marks [2004] RPC 29*).

46 Last but not least, as per *Royal Enfield* which was cited with approval in *McDonald's Corp*:-

“An allegation that a trade mark has been applied for in bad faith is a serious allegation...A plea of fraud should not lightly be made...and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts...In my judgment precisely the same considerations apply to an allegation of ... bad faith made under section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference.”

47 The Opponent's version of the facts is that he created the first JNBK mark, with “J” in smaller font sometime in 2002. The Opponent deposed that “JNBK” is an abbreviation of “Japan New Brake Kit”. The Opponent deposed that Ong and himself were actively involved in the general operation, running, planning, sales and marketing of EPL. Initially, EPL was appointed as distributors for Nisshinbo Corporation and also Sakura Corporation (Japan) (“Sakura Corporation”) for the sale of brake pads, brake shoes, amongst others, in Russia. However, in 2001, Nisshinbo Corporation decided to venture to sell their products directly to Russia. The Opponent deposed that this turn of events prompted him to invest more time and effort to create his own trade marks and to promote brake pads using new branding strategies. The Opponent further deposed that in 2002, he instructed Luh Dah, to produce brake pads and brake shoes applying the JNBK mark to these products.

48 Sometime in 2003, the Opponent discussed with Ong about the registration of JNBK marks in Singapore and Ong asked him to speak to the Applicant. The Opponent deposed that the Applicant then wrongly misrepresented to him that it would be easier for her as a Singaporean to register marks under her personal name (rather than using the Opponent's personal name) as this would expedite the registration process.

49 Importantly, the Applicant advised that if the marks are registered under her personal name instead of EPL's name/the Opponent's personal name, it would help to avoid the potential cancellation of the distributorship arrangement by Nisshinbo Corporation and Sakura Corporation.

50 The Applicant's version is that EPL had been selling Nisshinbo products since 1998 until 2003. When Nisshinbo Corporation started to go into the Russian market on their own, the Opponent became very anxious and that he began to counterfeit the products by producing similar brake pads with similar markings and packings. Essentially, the Applicant deposed that EPL purchased brake pads from Malaysian manufacturers as well as Luh Dah and then packed them in Singapore. The Applicant deposed that Ong spoke to the Opponent to desist but he refused. The Applicant became very worried as Ong would be implicated by such actions.

51 The Applicant then suggested to her husband that since EPL already had all the contacts of the manufacturers for brake pads and filters, it would be easy for EPL to make orders for them and package them the way EPL wanted. As EPL was a distributor, it could not come up with its own brand as it would conflict with its position with its principal. As such, the Applicant suggested that there is no point in EPL taking any risk. Rather, she would be the brand owner and principal and would start her own line of brands and allow EPL to market the same as agents. The Applicant deposed that this idea was finally taken up by the Opponent.

52 The Applicant deposed that she then suggested to Ong that since EPL were selling brake pads for Japan made cars, so why not use "Japan Brake". The Applicant deposed that she told Ong to use "JNBK" which come from the letters "Japan Brake" which means "Japan New Brake Kit".

53 The Opponent also deposed that he was the Marketing Director and the key personnel who planned and executed the advertising and promotional activities for EPL. The Opponent further deposed that he took the lead in the sales and marketing direction of EPL and had worked closely with Ong to execute some of these marketing strategies (paragraph 22 of the Opponent's 2nd SD). That the Opponent is the Marketing Director is corroborated by Goh's evidence (Exhibit LK-1 of the Opponent's 2nd SD at page 40, in particular at paragraph 8). The Opponent's role in marketing and sales for EPL is also corroborated by the evidence of Alexey (Exhibit LK-11 of the Opponent's 2nd SD at page 95, in particular at paragraph 10). The Opponent submitted that due to his role and designation, it is more natural and logical for the Opponent to create trade marks for EPL, including the JNBK mark.

54 On the other hand, the Opponent submitted that it is less believable that the Applicant, being a secretary and administrative staff, would create trade marks for her

employer. The Applicant confirmed in the Applicant's own SD at paragraph 18 that her role was as such. The Opponent tendered evidence via the statutory declaration of Ivan Ho (Exhibit LK-11 of the Opponent's 2nd SD at pages 89 and 90, in particular at paragraphs 10, 12 – 17) that the Applicant mainly provided “backend support” and was not involved in any decision making process/meetings of EPL, nor was she consulted with regard to EPL's sales and marketing strategies. The Opponent also tendered the evidence of the statutory declaration of Alexey (Exhibit LK-11 at page 95 in particular at paragraphs 11 to 13) to of the effect that she was not involved in any sales/marketing of EPL and that the Applicant's duties were clerical cum administrative work.

55 Last but not least, the Opponent tendered two statutory declarations of two individuals who attested that it was the Opponent who coined the JNBK mark. Reference is again made to Ivan Ho's (Exhibit LK-11, page 90 of the Opponent's 2nd SD at paragraph 18); and Alexey's evidence (also Exhibit LK-11, page 96 at paragraph 16 of the Opponent's 2nd SD). The Opponent also tendered the statutory declaration of Goh (Exhibit LK-1, page 41 at paragraphs 10 – 12 of the Opponent's 2nd SD) who attested that at a company meeting in July 2007, the Applicant admitted that she is not the owner of, amongst others, the JNBK Marks and that she agreed to transfer the marks back to EPL.

56 Taking all of the above into consideration, I am of the view that it is more likely than not that the Applicant did not create nor own the JNBK Marks for the following reasons.

57 First of all, I find that the Opponent's account of how the JNBK Marks come to be registered in the Applicant's personal name believable. While I question the appropriateness of such an action, I find the Applicant's account as to the reason why the JNBK Marks are registered in the Opponent's name credible.

58 Overall, I also find the Opponent to be a more credible witness. The Applicant made several allegations about the Opponent, including the Opponent's “counterfeiting” activities. However, the Opponent was able to provide explanations for the situations. For example, in the case of the Opponent's “counterfeiting” activities, he explained, in relation to the “Sakura” boxes as per page 90 of the Applicant's evidence, that the boxes were as a result of a trial project with PT Selemat Sempurna Tbk. That there was no counterfeiting activities was further corroborated by the evidence of Ivan Ho (Exhibit LK-11 at pages 91 and 92, in particular at paragraphs 25 – 28) and the evidence of Alexey (Exhibit LK-11 at page 96, in particular at paragraphs 17 – 19).

59 Further, I also agree with the Opponent's argument that should it be true that the Opponent was involved in “counterfeiting” activities, then it is curious that the Applicant and Ong did not seek to distance themselves from the Opponent but continued, via Zonac Pte Ltd (of which the Applicant is one of the directors – see Exhibit A of the Applicant's SD at pages 41 and 42), to do business with the Opponent via JNBK Corporation Pte Ltd (“JNBK Corporation”) of which the Opponent is one of the directors – see Exhibit A of the Applicant's SD at pages 38 and 39) (paragraph 44 of the Applicant's SD).

60 I also agree with the Opponent that it is more logical that as the Marketing Director of EPL, he would be the person most likely to be charged with the responsibility with regard to EPL's intellectual property.

61 Last but not least, the Opponent had tendered evidence by parties who attested to the Opponent's version of the story. The Applicant submitted that the evidence tendered by the Opponent is provided by parties who are not independent, in this case, namely Ivan Ho, who is currently in the employ of the Opponent via JNBK Corporation, Alexey, who, as alleged by the Applicant, is still in a working relationship with the Opponent, as well as Goh, who is a current shareholder of JNBK Corporation. However, I agree with the Opponent that these parties have made declarations pursuant to the Oath and Declaration Act (Cap 211, 2001 Rev Ed). Thus should these parties make any false declaration, they will be subject to the penalties under the said Act. Further, I also agree with the Opponent that it is curious that the Applicant did not file any evidence, in particular, that of her husband, Ong, to substantiate her argument that she created the JNBK mark since based on her evidence (paragraph 31 of the Applicant's SD), he was present throughout the process.

62 The Opponent submitted that the Applicant, prior to registering the Application Mark, was aware of the claims made against her. In support of this the Opponent referred to the meeting in July 2007 (see Goh's evidence – Exhibit LK-1 of the Opponent's 2nd SD at page 41, in particular at paragraphs 10 - 12), and the letter of demand dated 17 September 2007 (Exhibit LK-10 of the Opponent's SD).

63 I refer to Goh's evidence (Exhibit LK-1 of the Opponent's 2nd SD at page 41, in particular at paragraphs 11 and 12) where Goh deposed that the Applicant admitted at the meeting that she is not the owner of, amongst others, the JNBK Marks. Goh also deposed at paragraph 12 that the Applicant orally agreed to transfer the trade mark registrations, which include the JNBK Marks, back to "the Company" namely, EPL. The same scenario was recounted in the letter of demand dated 17 September 2007 (see reference above), at paragraph 7 of page 2 of the said letter. The paragraph stated to the effect that the Applicant had, on her own volition, admitted to EPL's auditor and in the presence of EPL's directors, which included Goh, that the JNBK Marks did not belong to the Applicant and that the Applicant was prepared to transfer the JNBK Marks back to EPL (it is noted that the draft assignment attached to the said letter was drafted such that the Applicant was to have assigned the JNBK Marks back to the Opponent).

64 It is not in dispute that the test for bad faith as per *Valentino* encompasses two components, the subjective element (what the Applicant knows) and the objective element (what ordinary persons adopting proper standards would think). The relevant time to assess this is the point of the filing of the Application Mark. Further, in this instance, the case of *Weir Warman* as submitted by the Opponent is insightful:

It appears to me to be an incontrovertible proposition that if a registrant of a trade mark has proprietorship of that trade mark, or at the very least, the *right to register* that trade mark, then such registration of the trade mark should fall well within the standards of acceptable commercial behaviour observed by reasonable and experienced persons in the particular trade. Conversely, where it can be shown that the applicant knew of an *exclusive* proprietary right of

another in relation to the trade mark it seeks to furtively register, then any such registration would, almost invariably, quite clearly fall short of the relevant standards.

65 I have concluded that it is more probable than not that the Applicant did not create nor own the JNBK Marks. In light of this and in light of the Applicant's awareness of the claims made against her, as at the point of filing of the Application Mark on 9 October 2007, the Applicant would be aware that she does not have a right to file for the Application Mark.

66 In a civil matter as this, the legal burden of proof is on the Opponent and the standard of proof is on a balance of probabilities. I am of the view that in light of the above, the Opponent has, succeeded, on a balance of probabilities, in making out a *prima facie* case that the Applicant did not have a right to apply for the Application Mark.

67 In light of the above, the ground of opposition under Section 7(6) succeeds.

Conclusion

68 Having considered all the pleadings, evidence and submissions made in writing and orally, I find that the opposition succeeds. Accordingly, the Application Mark shall not proceed to registration. The Opponent is also entitled to costs to be taxed, if not agreed.

Dated this 29th day of August 2012

Sandy Widjaja

Principal Assistant Registrar of Trade Marks

Hearings and Mediation Group

Intellectual Property Office of Singapore