

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

Trade Mark Application Nos. T1016517A
Hearing Date: 19 August 2013

APPLICATION FOR AMENDMENT OF NOTICE OF OPPOSITION BY MHCS

AND

OBJECTION THERETO BY J.-E. BORIE SA

Principal Assistant Registrar Mark Lim Fung Chian
Decision date: 2 October 2013

Interlocutory hearing – application for amendment of notice of opposition after filing of Opponents' statutory declaration – objection by Applicants – meaning of "any person" in Section 13(2) of the Trade Marks Act (Cap. 332, 2005 Rev. Ed.) – whether application for amendment of notice of opposition to include a third party's marks allowed

Facts Relevant to the Present Application

- i) J.-E. Borie SA (the "**Applicants**"), filed international trade mark number 1058310 on 18 October 2010 and applied for the said trade mark in Class 33 of the International Classification of Goods and Services ("**ICGS**") in Singapore:

Singapore Trade Mark Application No.	Trade Mark	Specifications
T1016517A (published for opposition purposes on 1 April 2011)	THE YELLOW LABEL	AOC (Appellation d'origine controlee) wines (wines with protected appellation of origin)

(the "**Application Mark**")

- ii) MHCS (the "**Opponents**"), filed international trade mark number 1080267 on 18 April 2011 and applied for the said mark in Class 33 of the ICGS in Singapore:

Singapore Trade Mark Application No.	Trade Mark	Specifications
T11089331 (not yet published)	YELLOW LABEL	Wines, wines of French origin namely Champagne and sparkling wine

(the "**Opponents' Mark**")

- iii) The Opponents then filed their notice of opposition to oppose the registration of the Application Mark on 1 August 2011.
- iv) On 5 October 2011, the Opponents received a Provisional Refusal of Protection to their mark dated 26 September 2011, citing a number of prior marks (the "**Cited Marks**"). The Opponents wrote to the Intellectual Property Office of Singapore ("**IPOS**") on 23 October 2012 requesting that the power to revoke the acceptance of the Application Mark under Section 16 of the Trade Marks Act (Cap. 332) (Rev. Ed. 2005) (the "**Act**") be exercised, citing the "divergence and material inconsistency in the examination process."
- v) On 6 June 2013, the Opponents wrote to IPOS and to the Applicants to request an amendment to their notice of opposition to rely on most (but not all) of the Cited Marks in support of their ground of opposition under Section 8(2)(b) of the Act, as follows:

Registration No.	Mark	Class	Specification
T0208551B	GOLD LABEL	33	Alcoholic beverages.
T0308717I	GREEN LABEL	33	Whisky.
T0808015F	GOLD LABEL RESERVE	33	Alcoholic beverages (except beers); wines, spirits and liqueurs.
T0904600H	GOLD LABEL XR	33	Alcoholic beverages (except beers).
T0904841H	GREEN LABEL 180 CASK	33	Alcoholic beverages (except beers).
T4911924C	RED LABEL	33	Scotch whisky.
T4911925A	BLACK LABEL	33	Scotch whisky.
T9400787D	BLUE LABEL	33	Scotch whisky.

- vi) These marks were all registered in the name of Diageo Brands B.V. ("**Diageo**"; marks referred to collectively as the "**Diageo Marks**"), which is not party to the opposition proceedings. At the hearing, the Opponents submitted that they did not know if Diageo were interested in these proceedings and that the Opponents had not notified them of the present application.

- vii) On 22 July 2013, the Applicants wrote to the Opponents, refusing consent to the proposed amendments. On 26 July 2013, the Opponents therefore proceeded to request for the present hearing.

Background on amendment of pleadings at IPOS

viii) Rule 29 of the Trade Marks Rules (Cap. 332, Rule 1, 2008 Rev. Ed.) (the "**Rules**") provides that a person may file a notice opposing the registration of a trade mark by filing a notice of opposition. The notice of opposition must contain the grounds upon which the opposition is sought (Rule 30). As it presently stands, the Act does not contain any specific provision on the amendment of a notice of opposition, although in practice, amendments are sometimes sought and made by way of filing an amended notice of opposition. IPOS issued HMD Circular No. 2/2010 (the "**IPOS Circular**") to address issues concerning amendments of pleadings.

- ix) This is the first time that IPOS is addressing the question of whether it should allow an amendment made by an opponent to rely on trade marks which belong to a third party who is not a party to the opposition proceedings.

Opponents' submissions

x) The Opponents submitted it would be relevant and appropriate to amend their notice of opposition to include the Diageo Marks, since the Application Mark "THE YELLOW LABEL" and the Opponents' Mark "YELLOW LABEL" are "virtually indistinguishable" and should therefore face the same objection from the Diageo Marks (paragraph 21, page 15, Opponents' written submissions).

xi) The Opponents submitted that it is manifestly clear that under the current regime of the Act, there is no prohibition against an opponent relying on a third party's trade mark when proceeding in an opposition under Section 8(2), given that the wording in Section 13(2) of the Act states that "any person" may give notice of an opposition. The Opponents made comparison to two other provisions of the Act, namely Sections 67 and 9 of the Act. Section 67 of the Act, relating to rectification or correction of the Trade Mark Register (the "**Register**"), states that "[a]ny person having a sufficient interest" may apply for rectification; Section 9 of the Act provides that where an applicant relies on honest concurrent use to overcome the Registrar's citation of an earlier trade mark or earlier right, only "the proprietor of that earlier trade mark or other earlier right" may raise objection to the registration of the applicant's mark. At the hearing, the Opponents also referred to Section 23(5) read with Section 23(3) of the Act. Section 23(5) provides that an application for a declaration of invalidity could be made by "any person", while Section 23(3) provides that the registration of a trade mark may not be declared invalid on the ground of an earlier trade mark or earlier right if "the proprietor of that earlier trade mark or other earlier right" has consented to the registration. The Opponents' point was that it would make no sense if "any person" in Section 23(5) is confined to the proprietor of the earlier trade mark or earlier rights since the proprietor would not apply for a declaration of invalidity if the proprietor had consented to the registration in the first place. The Opponents also cited the IPOS decision in *In the Matter of Trade Mark Application No. T0514255Z by Lohmun Leather Products and Opposition thereto by The Polo/Lauren Company, L.P.* ("*Swiss Club*") and the decision of the Australian Trade Marks Office in *Omega SA (Omega AG) (Omega Ltd) v Mark Robinson and*

Brenda Robinson [2011] ATMO 123 (13 December 2011) ("**Omega**") for the proposition that an opposition could succeed on the basis of a third party's (and not the Opponents') prior rights.

- xii) In terms of policy, whether or not a trade mark should be admitted onto the Register is a matter that goes beyond the interests of the two parties as it has a much wider impact on trade and the general public, who rely on the Register as presumptive evidence of the right of a registered proprietor to the exclusive use of the mark for the specified goods (paragraph 8, pages 6-7, Opponents' written submissions). As such, it would be crucial to maintain the accuracy of the Register and ensure that undeserving trade marks (such as the Application Mark) are not registered (paragraph 19, page 13 of the Opponents' written submissions).
- xiii) The Opponents submitted that the principles in Order 20 Rule 5 of the Rules of Court (Rule 5, Cap. 322, Rev Ed. 2006) ("**Order 20 Rule 5**"), relating to the amendment of pleadings with leave, are similar to the guidance set out in the IPOS Circular, although there is an added dimension of the public function of the Register in opposition proceedings. In applying Order 20 Rule 5, a distinction has been made between amendments applied for before and amendments applied for after the expiry of any limitation period: *Lim Yong Swan v Lim Jee Tee and another* [1992] 3 SLR(R) 940 ("*Lim Yong Swan*") at [12]. The principles in *Lim Yong Swan* should be confined to cases where the applying party has breached a limitation period and are not of general application. Counsel submitted that the following authorities stood for the proposition that the default position is that an application for amendment should be allowed subject to penalties on costs and adjournment, provided that allowing it will not prejudice the other party: *Singapore Civil Procedure (2013)* at paragraph 20/8/8 (page 359); *Wright Norman v Oversea-Chinese Banking Corp Ltd* [1993] 3 SLR(R) 640; *Ketteman v Hansel Properties Ltd* [1978] AC 189 ("*Ketteman*"). The court's focus would be on the consequences flowing from the amendment to the pleadings, as opposed to the nature of the amendment: *Chwee Kin Keong v. Digilandmall.com Pte Ltd* [2004] 2 SLR(R) 594 ("*Chwee Kin Keong*") at [87]. In this regard, the amendment would not cause any prejudice to the Applicants because of the early stage at which the amendment is sought and the fact that they are not seeking to add a new ground of opposition.
- xiv) Lastly, the amendment was not taken out in a frivolous and vexatious manner. The Opponents submit that they were prompted to take out the present application due to the provisional refusal that their mark had been met with and was not a delay tactic. The amendment would therefore enable the real issues between parties to be tried. The Opponents submitted that the fundamental issue was whether the Application Mark "THE YELLOW LABEL" should be permitted to be registered in Singapore (at paragraph 19, page 13, of the Opponents' written submissions).

Applicants' Submissions

- xv) The Applicants submitted that the key takeaway in *Lim Yong Swan* was that in an evenly balanced case, if the court concludes that it cannot decide whether or not it is just to allow the amendment, the party applying for leave must fail. The main issue was whether the amendment would cause injustice to the other party and such principles of justice are of general application, regardless of the fact that the case pertained to an application to amend to include a time-barred cause of action. The court would have regard to the

following principles in relation to amendments of pleadings (*G.P. Selvam, Singapore Civil Procedure Vol. 1* (Sweet & Maxwell Asia, 2013) ("*Singapore Civil Procedure (2013)*") at paragraph 20/8/27) (emphasis added by Applicants):

1. The court will always look at the materiality of the proposed amendment.
 2. Leave to amend a defence should not be granted where the amendment raises no reasonable defence to the claim. The same applies to applications for leave to amend a statement of claim.
 3. In an evenly balanced case, if the court concludes that it cannot decide whether or not it is just to allow the amendment, the party applying for leave must fail. The burden of persuasion (as opposed to the burden of proof) lies on him and if it is not discharged his application should not succeed.
 4. An inconsistent or useless amendment will not be allowed.
- xvi) The Applicants submit that the present amendment would not facilitate the determination of the real issues in controversy between the parties as they are wholly irrelevant to the subject opposition. They point out that the Diageo Marks are dissimilar to their Application Mark and are registered for different types of alcoholic beverages. If the amendment was allowed, and the marks were to be considered similar in the final determination of the dispute, the monopoly over the Diageo Marks would "unilaterally and arbitrarily" extend to all colours: paragraph 14, page 6, of the Applicants' written submissions.
- xvii) In any event, the Applicants also raised two procedural objections to the present application. The first is that the dispute is between the Opponents and the Applicants only, and not between the Applicants and Diageo. The Diageo Marks would not assist in determining the "real issues in controversy" (paragraph 17, page 7, of the Applicants' written submissions), which the Applicants submit are:
1. whether the Opponents' alleged "YELLOW LABEL" mark is an earlier mark in Singapore for identical goods in relation to the Application Mark;
 2. whether the Opponents' alleged "YELLOW LABEL" mark is identical or similar to the Application Mark in respect of similar goods such that there exists a likelihood of confusion as a result of the registration of the Application Mark;
 3. whether the Opponents' alleged "YELLOW LABEL" mark is a well-known mark such that the use and/or proposed use of the Application Mark is likely to damage the Opponents' interests; and
 4. whether the application to register the Application Mark is liable to be prevented by the law of passing off.
- xviii) The Applicants submit that the notice of opposition is filed on the basis of Section 7 or 8 of the Act and not Section 13 of the Act. As a matter of policy, an opposition that is

brought under Section 8 of the Act should only be brought by the owner of the relative right, ie. the registered proprietor of an earlier trade mark. The language in Section 8(9) and 8(10) of the Act on "Relative Grounds for Refusal of Registration" refers to the "proprietor of the earlier trade mark or other earlier right" as the person entitled to raise an objection or give his consent to registration. The Trade Mark Work Manual on Relative Grounds for Refusal of Registration (Ver 1, 13 January 2006, as found on the IPOS website) (the "**Work Manual**") states that when two marks are considered to be in conflict, "the dispute is best left to be resolved between parties". As the trade mark right is a private law right, it should be left to the parties to enforce.

- xix) The Applicants submit that the Opponents are essentially seeking to introduce a cause of action for which it has no relevant rights by way of the present proposed amendment. Allowing such amendments would open the floodgates for unmeritorious third parties to file frivolous opposition actions using registered trade marks which do not belong to them.
- xx) The Applicants' position is that one cannot rely on *Swiss Club* for the general proposition that any person can file an opposition against a trade mark. The Applicants sought to distinguish this case on the basis that the opponent there had succeeded on the basis of an absolute ground under Section 7(11) of the Act, namely, that the mark was contrary to Sections 56(1) and 56(4) of the Act – which the opponent would have been entitled to plead at law. The opponent in that case had also pleaded absolute grounds under Section 7(5) of the Act. This was different from the present case where the Opponents did not have the any legal basis to plead relative grounds under Section 8 to oppose the Application Marks on the basis of the Diageo Marks. The Applicants also pointed out that in that case, the Swiss Embassy had objected to the application (*Swiss Club* at [65] to [67]), unlike Diageo, whom the Opponents had not even consulted. With regard to the *Omega* case, the Applicants submit that this case is not binding on the Registrar as it is an Australian decision.
- xxi) The Applicants also argue that allowing this amendment would not serve the interests of justice. The Applicants emphasized that since Diageo is not a party, the Opponents would have to rely on hearsay evidence as to the actual use of the Diageo Marks. The Applicants would therefore not be able to understand the case it has to meet because the Opponents' case would be speculative in the first place. Diageo would also be prejudiced in that they would be legally bound by the decision in the opposition proceedings despite not knowing about the proceedings. They point out that the Opponents had admitted they have not even spoken to Diageo. Even if prejudice to Diageo is not something to take into account in this particular case, it should be considered as part of the consideration of the larger public interest.
- xxii) The Applicants allege that the present amendment is sought by the Opponents to overcome the objections to their own application. The Applicants pointed out that the Opponents amended the specification of goods in their application from "Alcoholic beverages (except beers)" to "Wines, wines of French origin namely Champagne and sparkling wines", which served to narrow the scope of the original specification, and which is closer to the Applicants' specification. Essentially, the Applicants submit that if the amendment was made in response to the Registry's citation of the Diageo Marks, the inference is that it was made to *distinguish* the Opponents' Mark from the Diageo Marks. The Opponents would be taking an inconsistent position by making the present

amendment, since it would mean that they are now alleging that the Diageo Marks are *identical and/or similar* to the Application Mark (which is identical to the Opponents' Mark save for the inconsequential addition of the word "the"). In reply, the Opponents stated that this request to amend the specification took place at the international level. It was not a pro-active step to overcome IPOS' objection to the Opponents' Mark and had only come to the Opponents' counsels' attention when they received the Applicants' submissions.

xxiii) The Applicants also submit that it is contrary to procedural certainty for the Registry to be asked to re-examine their registered mark retrospectively after a decision had previously been made to allow it to proceed to publication. This effectively creates an avenue for an opponent (which on the Opponents' argument can be any person, regardless of interest or standing) to question and challenge the Registrar's judgment and assessment in the examination of a third party trade mark application (ie. the Application Mark in this case). In support of this submission the Applicants tendered a recent IPOS Trade Marks Registry Circular No. 4/2013, which announced the Registry's decision to stop the current practice of revoking trade marks that have been published in the Trade Marks Journal, to give greater certainty to applicants. The Applicants point out that a potential opponent is not without remedy since he/she could still file for invalidation of the trade mark after it has been published.

Held, allowing the Opponents' request to amend their notice of opposition in the manner indicated in their letter dated 6 June 2013

1. Firstly, a word of thanks to counsels for both parties for their thoughtful submissions and arguments.
2. There are two issues in the present proceedings although counsels have elided these issues in their submissions. The first threshold issue is whether an opponent can rely on a third party trade mark in support of an opposition under Section 8(2) of the Act, which provides that:

A trade mark shall not be registered if because —

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public.

If the answer to the first issue is positive, the next issue is whether the amendment proposed by the Opponents in the present proceedings should be permitted.

Threshold issue – whether an opponent can rely on third party trade marks in support of an opposition under Section 8(2)

3. Section 13(2) of the Act provides that:

Any person may, within the prescribed time from the date of the publication of the application, give notice to the Registrar of the opposition to the registration. (Emphasis added)

4. Several other jurisdictions share the same or similar legislation to that of our Section 13(2), in that they also provide that "any person" may oppose a trade mark application. Their position on this issue is that an opponent may rely on third party trade marks in support of an opposition.
5. Section 38(2) of the UK Trade Marks Act 1994 ("**UKTMA**") is *in pari materia* with Section 13(2) of our Act (not surprisingly, given that our Section 13(2) was modelled after Section 38(2) of the UKTMA). In the case of **Wild Child Trade Mark [1988] RPC 455 ("Wild Child")** at 458, Mr Geoffrey Hobbs, QC held that there appeared to be no requirement under the UKTMA for the person claiming protection for an earlier right to be the proprietor of the right for which protection is being claimed, citing Section 38(2) of the UKTMA to illustrate his point. This position was echoed in the case of **BALMORAL Trade Mark [1999] RPC 297 ("Balmoral")** at 299 (also decided by Mr Geoffrey Hobbs, QC), in the following terms: "The person objecting to registration under section 5(1), 5(2) or 5(3) need not be the proprietor of the "earlier trade mark" for which protection is claimed: see sections 38(2), 46(4) and 47(3)." Sections 46(4) and 47(3) of the UKTMA refer to an application for revocation and invalidity respectively, which can also be made by "any person".
6. In Australia, the equivalent provision is Section 52(1) of the Australian Trade Marks Act 1995 ("**ATMA**"), which states that:
 - (1) If the Registrar has accepted an application for the registration of a trade mark, a person may oppose the registration by filing a notice of opposition. (Emphasis added)
7. In **Omega**, an opposition action under Section 52 of the ATMA, the opponent pointed out a number of other trade marks owned by third parties which were similar to the application mark (at [9]). The hearing officer in the Australian Trade Marks Office took into consideration these trade marks in making her decision on the registerability of the application mark (at [34]).
8. In Canada, Section 38(1) of the Canadian Trade-marks Act (R.S.C., 1985, c. T-13) provides that:
 38. (1) Within two months after the advertisement of an application for the registration of a trade-mark, any person may, on payment of the prescribed fee, file a statement of opposition with the Registrar. (Emphasis added)
9. It has been established that the words "any person" do not require that the potential opponent show a likelihood that he might in some way be adversely affected in order to support an opposition to the registration of a trade mark: **Roma Colbert and Douglas Fyfe, Opposition before the Canadian Trade-Marks Office, 14 C.I.P.R. 173 (1997)** at 174-175, citing **Parlam Corporation v. Ciba Company Limited (1961) 36 C.P.R. 78**, at 81.

10. However, none of these decisions is binding on the interpretation of Section 13(2) of the Act in Singapore. These decisions also do not appear to have considered this point in great detail.
11. There appears to be academic support for the view that the Singapore position is similar to that of the UK, albeit relying on the cases cited in paragraph 5 above. Eminent author Tan Tee Jim, S.C., in his textbook *The Law of Trade Marks and Passing Off in Singapore (2nd ed.)* (Sweet & Maxwell Asia, 2005) ("*Tan Tee Jim*") (at paragraph [6.3], page 136) writes that:

The burden of preventing registration is on the person relying on the earlier trade mark or the earlier right. There is no requirement that he must be the proprietor of the earlier trade mark or right [citing *Wild Child, Balmoral* and Sections 13(2), 22(6) and 23(5) of the Act].
12. Section 13(2) of the Act provides that "any person" may give notice to the Registrar of an opposition proceeding. Similarly, there are other provisions of the Act that allow "any person" to take action with regard to trade mark proceedings in the Registry, such as in revocation and invalidation proceedings in Sections 22(5) and 23(5) of the Act. The word "person" is not defined in the Act, although it is defined in Section 2 of the Interpretation Act (Cap. 1, Rev. Ed. 2002) as "includ[ing] any company or association or body of persons, corporate or unincorporated." Specifically, there is no restriction on who may bring opposition proceedings under Section 8(2) of the Act.
13. In contrast, Sections 67 and Section 9 of the Act specify the party who may take action. Section 67, dealing with rectification or correction of the register, uses the language "any person *having a sufficient interest*", whilst Section 9, dealing with honest concurrent use, says that where the Registrar is satisfied that honest concurrent use is established, he shall not refuse the application by reason of the earlier trade mark unless objection on that ground is raised in opposition proceedings "*by the proprietor of that earlier trade mark*".
14. Perhaps most pertinently, in the case of proceedings for invalidation, Section 23(3) of the Act provides that the registration of the trade mark may be declared invalid on certain grounds "unless the proprietor of the earlier trade mark or other earlier right has consented to the registration." Section 23(5) of the Act then provides that "[a]n application for a declaration of invalidity may be made by any person." It would make no sense if "any person" is confined to the proprietor of the earlier trade mark or right since the proprietor would not file an application for a declaration of invalidity if he had in fact consented to the registration in the first place.
15. Counsel for the Applicants has argued that there is a distinction between who may oppose the registration of a mark on absolute grounds and relative grounds respectively (see paragraph (xviii) above). This appears to be the position in the UK with effect from 1 October 2007. However, this was due to the UK Trade Marks (Relative Grounds) Order 2007 ("**Relative Grounds Order**"), which came into force on 1 October 2007. Paragraph 2 of the Order expressly provides that "[t]he Registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or earlier right." No basis for such a distinction under Section 13(2) of the Act exists and such a dichotomy would do violence to the language of

Section 13(2), which specifically provides that "any person" may commence an opposition. This was also the position in the UK prior to the coming into force of the Relative Grounds Order: see paragraph 5 above.

16. Further, under Section 7 of the Act (absolute grounds for refusal), an opponent may also rely on third party marks, for example, to argue that certain elements in a trade mark application are common to the industry in respect of certain goods or services and are therefore not distinctive. Objections can also be raised under Section 7(11) of the Act against marks that contravene Section 56 of the Act. In *Swiss Club*, The Polo/Lauren Company L.P. opposed the application mark, which consisted of the shadow of a polo player against the background of the Swiss national flag, with the Swiss Federal Cross in white on a red background. The Registrar was of the view that registration of this application mark would be contrary to Section 56(1) of the Act, or in the alternative, the application mark imitated the Swiss national flag and would offend Section 56(1) when read with Section 56(4) of the Act. Section 56 provides for the application of Article 6ter of the Paris Convention, essentially refusing registration for national emblems of countries to the Convention (as defined in Section 2 of the Act). Section 56(1) of the Act provides that a trade mark which consists of or contains the flag of a Convention country (such as Switzerland) shall generally not be registered without the authorisation of the competent authorities of that country, whilst Section 56(4) of the Act provides that this section applies to imitations of, *inter alia*, such flags. The Applicants sought to distinguish this case on the basis that the Swiss Embassy in Singapore had objected to the registration of this mark (at [83]). It is not clear from the decision the context in which the objection was raised. However, it could be equally argued that whilst the Swiss Embassy (or, Switzerland) had raised an objection, they did not themselves commence opposition proceedings. There is perhaps more reason why a third party should not be permitted to put forward arguments on behalf of the Swiss Embassy when they were not prepared to do so themselves. The Applicants' argument in this regard is therefore not persuasive.
17. I will now discuss the provisions in the Act and the statements in the Work Manual relied on by the Applicants' at (xviii). As a general comment, I am of the view that these provisions/statements are not relevant to the present case. I will examine each of them in turn.
18. Section 8(9) of the Act relates to the situation where the Registrar cites an earlier trade mark or other earlier right when examining the trade mark application, and the applicant seeks to overcome this objection by furnishing a letter of consent from the proprietor of the earlier trade mark or other earlier right. In such a situation, the Registrar "may, in his discretion," waive the citation. As an aside, I note that even in this situation, the Registrar retains a residual discretion to refuse the application. In contrast, under Section 5(5) of the UKTMA, the UK Registrar has no discretion to refuse registration where consent has been given.
19. Section 8(10) of the Act provides that the Registrar "may in his discretion, register any trade mark referred to in subsection (3), (4) or (7) where the proprietor of the earlier trade mark or other earlier right fails to give notice to the Registrar of opposition to the registration in accordance with section 13." Subsection (3), (4) and (7) refer to objections premised on an earlier trade mark being well known in Singapore, or prior rights under the laws relating to passing off, copyright, designs or other laws. Such prior interests would

not be apparent on the face of the Register, and it is not surprising that the Registrar may permit registration in these circumstances if the proprietor of the earlier trade mark or other earlier right does not oppose the application. On its terms, Section 8(10) does not relate to an opposition under Section 8(2) of the Act. It is clear that the standing of a person to bring opposition proceedings under Section 8(2) is not constrained by Section 8(10), and is governed by Section 13(2) of the Act, which as discussed above provides that "any person" may oppose a trade mark application.

20. Finally, the reference by the Applicants to the statement in the Work Manual that when two marks are considered to be in conflict, "the dispute is best left to be resolved between parties" needs to be understood in context. The relevant portion of the Work Manual states as follows:

3 MEANING OF “EARLIER TRADE MARK”

Objections to registration of a trade mark under Section 8 can only be taken if the conflicting mark is an “earlier trade mark”. “Earlier trade mark” is defined in Section 2(1). The Examiner must determine whether the conflicting mark qualifies as an earlier trade mark, before it can be raised as a citation. A citation can only be raised if it does.

(a) Where the conflicting mark is registered

Where the search reveals a registered mark that is considered to be in conflict, the determining factor rests on the respective relevant dates (priority dates and application dates).

If no priority dates are claimed, the registered mark is the “earlier trade mark” and will be raised as a citation.

If the later application has a priority date, then it depends on whether the priority date of the later application pre-dates that of the priority date or application date of the registered mark. If so, no citation can be raised.

The above could lead to a situation where two identical marks get onto the register. In such a situation, the owner of the registered mark has the option to oppose the new mark when its acceptance is published. Alternatively, the owner of the new mark can bring invalidation proceedings to invalidate the registration after the new mark is registered. The dispute is best left to be resolved between the parties.

The Trade Marks Act does recognise the existence of identical marks for identical goods on the register, for instance where:

- (i) there is honest concurrent use (Section 9); or
- (ii) where the owner of the earlier trade mark or earlier right has consented to the situation (Section 8(9)).

(emphasis added)

This portion of the Work Manual relates to a claim to priority resulting in two identical (or similar) marks being accepted for registration. In general, when considering conflicts

between similar marks, the mark which is applied for at an earlier date (first-to-file) will proceed to registration while the later mark will be blocked by the earlier mark. However, under Section 10 of the Act, it is possible for the later application to make a "claim to priority" based on a corresponding trade mark which had been filed in a country which is a member of the Paris Convention or the World Trade Organisation within six months after the date of the first application in one of these countries. If this "priority date" pre-dates the date of the earlier application, as indicated in the Work Manual, there is a possibility that two identical marks could get on the Register. Let me illustrate this with a simple example:

1 February 2013	Company A applies to register Mark X for Goods Y in Singapore.
1 June 2013	Company A's application for Mark X is registered in Singapore.
30 June 2013	Company B applies to register the identical Mark X for identical Goods Y in Singapore. Company B claims a <u>priority date of 1 January 2013</u> based on a corresponding application filed in a Convention country.

In this situation, the Registrar cannot object to Company B's application on the basis of Company A's application since Company B's application, in view of the priority claim, would predate Company A's application. At the same time, Company A's application has already proceeded to registration. It is in this type of hypothetical situation (which is very unlikely to occur in practice) that the Work Manual states that "the dispute is best left to be resolved between parties." Clearly, this does not apply in the present case.

21. I will now address the Applicants' arguments based on policy (see paragraphs (xix) and (xxi) above). Although there is some merit to these arguments, they are largely overstated. The issue of the Opponents' locus to rely on third party rights has already been addressed above. With regard to the possibility of opening the floodgates for opposition actions made on the basis of third party trade marks, potential opponents can already rely on Section 7 of the Act, e.g. to argue that the mark is devoid of distinctive character, to commence opposition proceedings. This has not led to the opening of the floodgates for such actions, and there is no reason why permitting an opponent to rely on third party marks would do so. In general, a potential opponent would be circumspect about commencing unnecessary adversarial proceedings, given the commitment of time and resources required to do so.
22. With regard to potential unfairness to the Applicants in having to defend their applications even where the proprietor of the earlier mark relied upon has no objections, the present opposition proceedings will be based on submissions which are made on record to IPOS – which is essentially not dissimilar to overcoming a citation of an earlier mark against a trade mark application, save that opposition proceedings are *inter partes*. The Applicants also raised the spectre of dangerous reliance on hearsay evidence by the Opponents because they do not have any direct contact with Diageo. This argument is premature since the hearing officer at the opposition hearing will make the necessary decisions in this regard. Furthermore, the legal burden of proof lies on the Opponents throughout the proceedings and it is up to the Opponents as to how they wish to prove their case based on their pleadings and evidence. With regard to potential prejudice to Diageo, this is again more illusory than real, since Diageo is not bound by the decision in the present

opposition proceedings. If Diageo's mark is challenged in the future, e.g. by invalidation proceedings, they may seek to rely on additional facts in those proceedings.

23. To summarise, I am of the view that a party may rely on third party marks in opposition proceedings under Section 8(2) of the Act. Firstly, a plain reading of Section 13(2) of the Act states that "any person" may give notice of an opposition. Secondly, an examination of the Act shows that the issue of the requisite standing of a person to bring various types of proceedings is spelt out in the relevant provisions (e.g. "any person" may give notice of an opposition, whereas only a "person having a sufficient interest" may apply for the rectification of an error or omission in the Register). Thirdly, such an interpretation is also consistent with the approach taken by other common law jurisdictions in relation to the corresponding provisions in their respective legislations which adopt similar language to our Section 13(2). Fourthly, a person can in any event rely on third party marks in support of an opposition brought under other sections in the Act.

Whether the amendment proposed by the Opponents should be permitted

24. As stated at paragraph (viii) above, the IPOS Circular sets out the following non-exhaustive factors the Registrar will weigh in the situation where amendments are sought after the close of pleadings and are not agreed to by the other party:

1. whether the party seeking the amendment could have claimed the particular ground/defence or cited the additional "earlier trade mark" earlier, when filing [the notice of opposition];
2. whether the amendment is necessitated by the pleading or evidence filed by the other party;
3. whether the other party would suffer any real prejudice which cannot be compensated with costs if the amendment is allowed;
4. whether allowing the amendment will facilitate the determination of the real question in controversy between the parties or whether the amendment is only a tactical manoeuvre and allowing the amendment would result in prejudice to the other party;
5. whether the amendment raises grounds or facts which the applicant need not set out in reply, for example, the ground was not raised by the opponent and is therefore inapplicable to the particular proceedings at hand;
6. the substantiality of the amendment;
7. the stage of the proceedings the amendment is sought.

25. Although counsels for both parties agreed that the above guidance set out in the IPOS Circular is not dissimilar to the practice and law as applicable to amendment of pleadings in civil proceedings generally pursuant to Order 20 Rule 5, parties adopted somewhat different positions on the law as applied to the present context (see paragraphs (xiii) and (xv) above). I agree with the Opponents that *Ketteman* and the principles enunciated at paragraph 20/8/8, page 359 of *Singapore Civil Procedure (2013)* are more relevant to the present proceedings, as they refer to the "general principles for the grant of leave to amend". The Applicants had referred to a paragraph further down in *Singapore Civil Procedure (2013)* pertaining to "immaterial and useless amendments" (at paragraph 20/8/27, pages 374-5), which are not applicable to the present case, especially in view of my decision on the threshold issue. In exercising its discretion, the Registry should be

cognizant of the fact that a trade mark registration confers monopoly rights against other traders, and it would be against the public interest to permit unmeritorious applications to proceed to registration. I will proceed to go through each of the non-exhaustive factors listed at paragraph 24 above.

26. *Whether the party seeking the amendment could have claimed the particular ground/defence or cited the additional "earlier trade mark" earlier:* Whilst the Opponents could theoretically have included the Diageo Marks in their notice of opposition at the drafting stage, they have explained that the amendment was sought soon after they had notice of the existence of the Diageo Marks (see paragraph (xiv) above). The Opponents have not acted capriciously or in a frivolous or vexatious manner in this regard.
27. *Whether the amendment is necessitated by the pleading or evidence filed by the other party:* The amendment by the Opponents was not occasioned by the Applicants' pleadings or evidence, but for the reasons explained in the paragraph above. This factor may be more relevant for consideration in a case where there is a positive answer to the question posed.
28. *Whether the other party would suffer any real prejudice which cannot be compensated with costs if the amendment is allowed:* I have dealt with the Applicants' argument that they would be prejudiced by Diageo not being made a party to the proceedings (see paragraph 22 above). I would add at this juncture that the fact that the Applicants have to deal with an opposition on the basis of third party marks is a natural consequence of the threshold issue being decided in favour of the Opponents. To put it another way, if the amendment would not have been objectionable if it was included in the notice of opposition in the first place, it should not be objected to for this reason when sought to be introduced by way of amendment – especially at an early stage of proceedings, when the Applicants have yet to file their evidence. There would be little prejudice to the Applicants since the Applicants need not incur additional costs in obtaining a second statutory declaration.
29. *Whether allowing the amendment will facilitate the determination of the real question in controversy between the parties or whether the amendment is only a tactical manoeuvre and allowing the amendment would result in prejudice to the other party:* Essentially, the Applicants submit that the issues should be confined to the Application Mark and the Opponents' alleged earlier rights to the "YELLOW LABEL" mark, whilst the Opponents submit that the issue is much broader and should be about whether the Application Mark should be registered on the Register (see paragraphs (xvii) and (xiv) above respectively). Whilst the Applicants are correct to say that the main issue is to ascertain which party has better rights over the mark, an ancillary issue is whether either party should be conferred a monopoly over the mark, and the Diageo Marks would be relevant to this question. With regard to the Applicants' argument at (xvi) above, I am of the view that the Applicants are jumping the gun to say that the monopoly over the Diageo Marks would extend to all colours if the Opponents are to succeed on the basis of this amendment. Even if the Registrar decides that the Application Mark is similar to the Diageo Marks, the determination is only in relation to the Application Mark and not the Diageo Marks.
30. *Whether the amendment raises grounds or facts which the applicant need not set out in reply:* The Opponents' amendment would necessitate amendments to the Applicants'

counter-statement. However, this would be a relatively straightforward amendment and would not cause any prejudice that cannot be compensated by costs.

31. *The substantiality of the amendment:* The Opponents' amendments do not add any new grounds of opposition, since the Opponents have already pleaded Section 8(2)(b) of the Act at paragraph 8 of the notice of opposition, albeit using a different set of facts. Whilst the amendment widens the scope of the Opponents' objection under Section 8(2)(b), it is something that should be relatively easy for both parties to make their submissions on.
32. *The stage of the proceedings the amendment is sought:* The present amendments are sought at a relatively early stage of the proceedings, after the close of pleadings and the filing of the Opponents' first statutory declaration. The Applicants have not filed any evidence as yet. As submitted by the Opponents, local case law has shown that courts have granted leave to amend pleadings at more advanced stages than the present, depending on the facts and circumstances of the case: *Chwee Kin Keong* (leave to amend granted to the defendant to amend its pleadings after parties' closing submissions); *Tang Chay Seng v Tung Yang Wee Arthur* [2010] 4 SLR 1020 (defendant was allowed to amend his pleadings after trial); *Soon Peng Yam v Maimon bte Ahmad* [1995] 1 SLR(R) 279 (respondent was allowed to amend the capacity in which she originally brought proceedings in the course of an appeal).
33. That said, the factors raised for consideration by the IPOS Circular are not exhaustive. The Applicants have raised other issues as regards hearsay evidence but this issue is inherent in permitting the opponent to rely on third party marks in the first place (and is discussed in paragraph 22 above), and cannot be taken into account. The Applicants also raised the issue of procedural certainty in asking the Registry to re-examine the Application Mark, which has already passed through the eyes of the examiners at IPOS (see paragraph (xxiii) above). I am unable to accept this argument, since it would essentially render the opposition process otiose. Trade Marks Registry Circular No. 4/2013 is not applicable to this issue as it addresses the current practice where the Registrar seeks to revoke a mark that has been published in the Trade Marks Journal on his own volition, and not to the opposition process.
34. What appears to be more troubling is that, at first sight, the Opponents need to take conflicting positions in the current opposition proceedings and in their own application for the Opponents' Mark. The Applicants have also referred to this apparent conflict in their submissions and alleged that the Opponents ultimately appear to be trying to overcome the objections to their own application (see paragraph (xxii) above). By seeking this amendment in the current opposition proceedings, the Opponents would be relying on Diageo Marks as being *similar* to the Application Mark, which is a word mark for "THE YELLOW LABEL". However, when faced with the Diageo Marks in the form of a cited objection to the Opponents' Mark "YELLOW LABEL", it would appear that the Opponents would be forced to take a contrary position to try to distinguish the Diageo Marks and say that they are *not similar* to the Opponents' Application Mark. This would be contrary to the principle that a party should not be allowed to approbate and reprobate: see, for example, *Projector SA v Marubeni International Petroleum (S) Pte Ltd* [2005] 2 SLR(R) 144 at [43].
35. In the present case, however, the Opponents have explained that they have not taken any position in relation to the Registry's objection to their trade mark application, which is

currently being kept in abeyance in view of the current opposition (see also paragraph (xxii) above). The Opponents stated that they could, for example, argue that their mark should be permitted to co-exist with the Diageo Marks on the Trade Marks Register by virtue of them having concurrent rights to the mark, for example, as a result of long use.

Conclusion

36. To disallow the amendment would have the effect of barring the Opponents from raising an opposition on the basis of third party marks under Section 8(2) of the Act, which they would have had locus to do at the notice of opposition stage. Taking into account all the factors considered above, and given the early stage of the present proceedings, I would allow the Opponents' request to amend their notice of opposition. However, I would stress that the Opponents will not be permitted to take a different position in their corresponding trade mark application T1108933I.
37. As agreed by the parties at the hearing, in the event the Opponents' application is allowed, the Opponents are to file their amended notice of opposition within two weeks from the date of this decision, ie. on 15 October 2013. The Applicants are to file their amended counter-statement two months from the date on which the Opponents file their amended notice of opposition. The Opponents are to file their supplemental statutory declaration within one month from the date of the Applicants' amended counter-statement and the Applicants are to file their statutory declaration within three months from the date of the Opponents' supplemental statutory declaration. The issue of the Opponents' statutory declaration in reply was not discussed at the hearing and will be governed in any event by Rule 34 of the Rules. I order accordingly.

Costs

38. Parties had also addressed me on the issue of costs should the Opponents' application be allowed. The Opponents referred me to *Chwee Kin Keong* (at [89], page 617), where the court awarded \$1,000 to the plaintiffs for the defendants' amendment to its defence. The Opponents submitted that since the Fourth Schedule of the Rules provided that the maximum costs which can be awarded for preparing for and attending all interlocutory hearings at IPOS is up to \$1,000, the costs awarded in *Chwee Kin Keong* should therefore be reduced accordingly in the context of proceedings at IPOS. On the other hand, the Applicants submitted that the Opponents should be made to pay an additional \$150 in costs as the Applicants would also have to review the additional statutory declaration to be filed by the Opponents (see item 4 in the Fourth Schedule of the Rules), bringing the total costs payable by the Opponents to \$1,150.
39. Bearing in mind that costs awarded in proceedings before IPOS are not intended to compensate the parties for the expense to which they may have been put (see Rule 75(2) of the Rules) and taking into account the Scale of Costs set out in the Fourth Schedule of the Rules, the Applicants are awarded costs of \$800. Such costs are to be paid by the Opponents to the Applicants within one month from the date of this decision.

Legislation discussed:

Trade Marks Act (Cap 332, Rev Ed. 2005), Sections 7, 8, 9, 13, 22, 23, 67
Trade Marks Rules (Cap 332, Rev. Ed. 2008), Rule 29, 30

Interpretation Act (Cap. 1, Rev. Ed. 2002), Section 2
Order 20 Rule 5 of the Rules of Court (Rule 5, Cap. 322, Rev Ed. 2006)
UK Trade Marks Act 1994, Section 38(2)
UK Trade Marks (Relative Grounds) Order 2007, Section 2
Australian Trade Marks Act 1995, Section 52(1)
Canadian Trade-marks Act 1985, Section 38(1)

Cases referred to:

Wild Child Trade Mark [1988] RPC 455
BALMORAL Trade Mark [1999] RPC 297
Parlam Corporation v. Ciba Company Limited (1961) 36 C.P.R. 78
Omega SA (Omega AG) (Omega Ltd) v Mark Robinson and Brenda Robinson [2011] ATMO 123 (13 December 2011)
In the Matter of Trade Mark Application No. T0514255Z by Lohmun Leather Products and Opposition thereto by The Polo/Lauren Company, L.P.
Chwee Kin Keong v. Digilandmall.com Pte Ltd [2004] 2 SLR(R) 594
Tang Chay Seng v Tung Yang Wee Arthur [2010] 4 SLR 1020
Soon Peng Yam v Maimon bte Ahmad [1995] 1 SLR(R) 279
Projector SA v Marubeni International Petroleum (S) Pte Ltd [2005] 2 SLR(R) 144
Lim Yong Swan v Lim Jee Tee and another [1992] 3 SLR(R) 940
Wright Norman v Oversea-Chinese Banking Corp Ltd [1993] 3 SLR(R) 640

Textbooks referred to:

Tan Tee Jim, S.C., The Law of Trade Marks and Passing Off in Singapore (2nd ed.) (Sweet & Maxwell Asia, 2005)
G.P. Selvam, Singapore Civil Procedure Vol. 1 (Sweet & Maxwell Asia, 2013)

Representation:

Ms Teresa O'Connor and Mr Gene Kwek (Infinitus Law Corporation) for the Opponents
Ms Kylie Peh and Ms Nicole Oh (Wong Partnership LLP) for the Applicants