

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

Trade Mark Application Nos. T1305469I and T1305467B
27 January 2014

**APPLICATIONS FOR RESTORATION OF TRADE MARK APPLICATIONS
AND
EXTENSION OF TIME
TO FILE AND SERVE COUNTER-STATEMENTS
IN TRADE MARK APPLICATIONS
BY BRG BRILLIANT RUBBER GOODS (M) SDN BHD**

AND


**OBJECTION THERETO BY
THE POLO / LAUREN COMPANY, L.P.**

Principal Assistant Registrar Sandy Widjaja
25 March 2014

Interlocutory hearing – applications for restoration of trade mark applications and extension of time to file and serve Counter-Statements – Counter-Statements served 7 days after 2-month deadline – request for extension of time made 23 days after 2-month deadline - request for extension of time made after Registrar's notification of deemed withdrawal of trade mark applications - whether restoration of trade mark applications and late request for extension of time under rule 31 can be allowed – rule 83 of the Trade Marks Rules (2008 Rev Ed)

- i. BRG Brilliant Rubber Goods (M) Sdn Bhd ("the Applicants") applied on 1 April

2013 to register the trade marks,  **POLO** (under Application No. T1305469I) and

 (under Application No. T1305467B), for a wide variety of goods in various classes (collectively "the Applications").

- ii. The Applications were published in the Trade Marks Journal No. 030/2013 on 26 July 2013 ("*TMJ*") and the agent for the Applications was indicated in the *TMJ* as "Shook Lin & Bok LLP, 1 Robinson Road, #18-00 AIA Tower, Singapore 048542" ("*SLB Singapore*").

- iii. The Polo / Lauren Company, L.P ("the Respondents") opposed the Applications on 17 September 2013. The Notices of Opposition were filed and served on 17 September 2013. Under cover of the Respondents' letters to the Registrar enclosing the Notices of Opposition, the Respondents also enclosed copies of their letters serving the same on the Applicants. The Respondents' letters to the Applicants were addressed to "Shook Lin & Bok LLP, 1 Robinson Road, #18-00 AIA Tower, Singapore 048542" i.e. ***SLB Singapore***.
- iv. The Applicants, via their letters, dated 12 November 2013, filed their Counter-Statements with the Registrar. The letters were respectively prefaced with the following letter head "*Shook Lin & Bok Est 1918 Kuala Lumpur*" and have the following footer "20th Floor AMBank Group Building, 55 Jalan Raja Chulan, 50200 Kuala Lumpur" ("***SLB Malaysia***"). The Counter-Statements were received by the Registrar on 14 November 2013. On 25 November 2013, the Registrar issued a letter directing the parties to attend a Case Management Conference on 12 December 2013 (this letter was faxed and posted to the parties on 25 November 2013). The Respondents, via their letter dated 25 November 2013 (faxed to the Registrar at 12.21pm), wrote to inform that, while it would appear from the Registrar's letter of 25 November 2013 that the Applicants have filed the Counter-Statements for the Applications, the Respondents were not served the same and have not been served to date. As such the Respondents submitted that the Applicants have failed to comply with Rule 31(2) of the Trade Marks Rules (2008 Rev. Ed.) ("***Trade Marks Rules***") which provides that a copy of the counter-statement shall be served on the opponent at the same time it is filed with the Registrar. Thus, the Respondents submitted that the Applications are deemed to be withdrawn as per Rule 31(3) of the ***Trade Marks Rules***. Subsequently, the Respondents wrote to the Registrar again on the same day i.e. 25 November 2013 (faxed to the Registrar at 17.14pm) that they have on that same afternoon (i.e. on the afternoon of 25 November 2013) just received the Counter-Statements sent by A.R. registered mail from Malaysia. The Respondents submitted that service was out of time. The deadline to file and serve was 18 November 2013 (since 17 November 2013 was a Sunday). While the Counter-Statements for the Applications were filed by 18 November 2013, they were served on the Respondents out of time on 25 November 2013. The Respondents did not raise any issue in their letter with regard to the *locus standi* of ***SLB Malaysia*** to file and serve the Counter-Statements.
- v. The Applicants then wrote to the Registrar on 29 November 2013. The Applicants submitted that:
- (a) the Applicants had sent copies of the Counter-Statements to the Respondents' agent on 16 November 2013 by electronic communication, which is permissible under Rule 7(3)(c). The Applicants submitted that the clerk who handled the matter inadvertently sent the email to the wrong email address. The Applicants submitted that this shows that the Applicants had acted in good faith and had not intentionally withheld service.

- (b) Rule 7(3)[(a)] states that service may be effected by post. It does not specify that the documents/counter-statement should or must reach the opponent *before* the deadline of 18 November 2013. The document is to be treated as having been effected at the time at which the notice or document would have been delivered in the ordinary course of post, as stated under Rule 7(4). The Applicants submitted that the Counter-Statements were delivered to the Respondents in the ordinary course of post on 25 November 2013.
 - (c) the Applicants had served copies of the Counter-Statements on the Respondents and are in compliance with Rule 31(2). The Applicants also submitted that the delay is unintentional and does not adversely affect the rights of the Respondents in the Oppositions.
- vi. The Registrar responded on 4 December 2013 as follows:
 - (a) Rule 7(3)(c) does not apply to the current case. It applies in the context where a document is to be given or sent to or served on any party by the Registrar or Registry.
 - (b) Rule 31(1) requires that the counter-statement be filed with the Registrar within 2 months from the date of receipt of the notice of opposition from the opponent. Rule 31(2) states that the applicant shall serve a copy of the counter-statement on the opponent at the same time as the counter-statement is filed with the Registrar. Read together, Rule 31 requires that the counter-statement be filed with the Registrar and served on the opponent within 2 months from the date of receipt of the notice of opposition from the opponent (unless there is a request for an extension of time pursuant to Rule 31(4)).
 - (c) Rule 7(2) provides that a document to be given or sent to or served on any party other than the Registrar or Registry may be effected by sending the document by post. Rule 7(4) provides that where any document is sent by post under Rule 7(2), such document shall, until the contrary is proved, be treated as having been effected at the time which the document would have been delivered in the ordinary course of post.
 - (d) In light of all of the above, the Counter-Statements sent by A.R. post and received by the Applicants on 25 November 2013 have not been served within the deadline of 18 November 2013 under Rule 31(1). Neither has the Registrar received any request for an extension of time to file the Counter-Statements under Rule 31(4). Thus, the Applicants are deemed to have withdrawn the Applications under Rule 31(3).
- vii. The Applicants via their letter dated 9 December 2013 (which was faxed to the Registrar on 11 December 2013 at 16.44pm) enclosed (a) a copy of their letter dated 10 December 2013 to the Respondents which is essentially a notice as required under Rule 31(6); and (b) a copy of the Applicants' letter to the Registrar dated 10 December 2013 requesting for an extension of time. The Applicants also

made their submissions in relation to the request for an extension of time in the same letter.

- viii. In light of the Applicants' submissions, the Registrar wrote to the Respondents on 31 December 2013 asking if they wish to be heard and if so, whether orally or by way of written submissions. The Registrar also directed the Applicants to copy the Respondents on all correspondences since it is an *inter partes* matter. The Applicants had not been copying the Respondents since their letter dated 29 November 2013 addressed to the Registrar. The Respondents responded on 10 January 2014 confirming that they wish to address the Applicants' request for an extension of time without the need for a hearing. The Respondents, however, submitted that there is a more fundamental issue at hand and contended that neither the filing of the Counter-Statements nor service of the same (albeit out of time) was carried out by an authorized party who has *locus* to represent the Applicants. The Respondents submitted that the agent for the Applications is "M/s Shook Lin & Bok LLP" with the address for service at "1 Robinson Road, #18-00 AIA Tower, Singapore 048542 as per the *TMJ* i.e. *SLB Singapore* (and not *SLB Malaysia*). In light of the new issue raised, the Registrar wrote to the Applicants on 24 January 2014 asking them if they wish to be heard in this regard and if so, whether orally or by way of written submissions. The Applicants responded on 27 January 2014 with their written submissions with regard to the *locus standi* issue.
- ix. The submissions having been closed, the Registrar proceeded to issue this decision.

Applicants' submissions

- x. The Applicants submitted that the irregularity in procedure which is a failure to serve the Counter-Statements on the Respondents before the deadline can be corrected under Rule 83. The Applicants submitted that this is clear from *Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited* [2002] SGIPOS 7 ("*Asian Aisle*").
- xi. The Applicants urged the Registrar to allow the Applicants' applications for an extension of time to serve the Counter-Statements to ensure the proper adjudication on the merits of the case in the interest of justice between the parties. The Applicants submitted that they have filed the Counter-Statements with IPOS before the deadline and the Counter-Statements reached the Respondents 7 days after the deadline. The Applicants submitted that the Respondents would not suffer any real prejudice or harmful consequences if an extension of time to file the Counter-Statements is granted. The Applicants referred to *Procter & Gamble Business Services Canada and Another v Alliance Cosmetics Sdn Bhd* [2009] SGIPOS 9 ("*Procter & Gamble*") and *GSM (Operations) Pty Ltd v Martin Joseph Peter Myers* [2009] SGIPOS 8 ("*GSM*") where the Registrar had allowed the irregularity to be corrected under Rule 83 and allowed the extension of time for the Applicants to file the Counter-Statement.

- xii. The Applicants urged the Registrar to exercise his discretionary powers under Rule 83 to allow the extension of time. The Applicants submitted that it should be taken into consideration that the Applicants would be prejudiced if the extension of time is not granted as the Applicants would be deemed to have withdrawn the Applications by virtue to Rule 31(3) which would prematurely determine the outcome of the opposition proceedings. The Applicants submitted that opposition proceedings should be based on the merits of the case after a full and proper adjudication. The Applicants submitted that, further, parties are also involved in a series of oppositions in other jurisdictions and both parties are well aware of the ongoing disputes between them.
- xiii. Thus the Applicants urged the Registrar to exercise his discretion to accept the Counter-Statements as having been duly served on the Respondents.
- xiv. On the *locus standi* issue, the Applicants responded as follows.
- xv. The Applicants submitted that Mr Michael Soo Chow Ming of "M/s Shook Lin & Bok" with an address at "20th Floor AMbank Group Building, 55 Jalan Raja Chulan, 50200 Kuala Lumpur" (i.e. ***SLB Malaysia***) is at all material times the authorized agent of the Applicants under Rule 10. The physical address of M/s Shook Lin & Bok LLP ie "1 Robinson Road, #18-00 AIA Tower, Singapore 048542", is merely an address for service required under Rule 9. The Applicants submitted that this is clearly stated after the last paragraph of the Counter-Statements respectively and in the [IPOS online] "Details of the Mark" for the Applications respectively where it is stated that the "AFS Details" or "Address for Service" is "M/s Shook Lin & Bok LLP".
- xvi. The Applicants further submitted that the Respondents have not objected to Mr Michael Soo of ***SLB Malaysia*** being the agent for the Applicants when the Respondents received and objected to the late service of the Counter-Statements on 25 November 2013.
- xvii. The Applicants submitted that the fact that Mr Michael Soo is the agent for the Applicants, with an address for service at "1 Robinson Road, #18-00 AIA Tower, Singapore 048542", is also clearly stated in Form TM1 and Form TM4 filed on behalf of the Applicants. Thus the Applicants submitted that they have complied with Rule 10(3).
- xviii. The Applicants submitted that the filing and service of the Counter-Statements and their application for an extension of time of 7 days to file the Counter-Statements are filed by the Applicants' appointed agent who has *locus standi* in the present matters.
- xix. The Applicants submitted that, further, the Respondents have not provided any sound or solid justification as to how they would be prejudiced if the Registrar were to exercise his discretion to grant the Applicants an extension of time of 7 days to serve the Counter-Statements. The Applicants submitted that it should be taken into consideration that the Applicants would be prejudiced if the extension of time

is not granted as this would prematurely determine the outcome of the opposition proceedings.

- xx. The Applicants concluded by requesting the Registrar to exercise his discretion and grant the Applicants an extension of time to serve the Counter-Statements to ensure that there would be a proper adjudication of the merits of the case and in the interest of justice between the parties.

Respondents' Submissions

- xxi. The Respondents submitted that there is a much more fundamental issue at hand than that relating to the request for an extension of time by the Applicants. The Respondents contended that neither the filing of the Counter-Statements nor service of the same on the Respondents, albeit out of time, was carried out by an authorized party who has *locus* to represent the Applicants in the present proceedings in Singapore.
- xxii. The Respondents referred to Rule 10 of the ***Trade Mark Rules***. The Respondents submitted that the agent for the Applications was listed as ***SLB Singapore*** in the ***TMJ***. The Notices of Opposition were filed by the agent for the Respondents at IPOS on 17 September 2013 and served on the same day on ***SLB Singapore***. The Counter-Statements were filed by ***SLB Malaysia***, by their letter of 12 November 2013 and received by the Respondents by post on 25 November 2013.
- xxiii. The Respondents submitted that ***SLB Singapore*** and ***SLB Malaysia*** are different entities.
- xxiv. The Respondents submitted that it is not clear on what basis the Counter-Statements for the Applications were filed and served by ***SLB Malaysia*** rather than ***SLB Singapore***, who are the Applicants' agent on record. The Respondents submitted that a search for the Applications online on IPOS database shows that the Applicants' agent is ***SLB Singapore*** and not ***SLB Malaysia***.
- xxv. The Respondents submitted that the Registrar's letter of 31 December 2013 was also addressed to ***SLB Singapore*** and not ***SLB Malaysia***. The Respondents submitted that this reinforces the fact that ***SLB Singapore*** are continuing as the appointed agent for the Applicants.
- xxvi. The Respondents submitted that ***SLB Malaysia*** has no *locus standi* in the matter as the evidence shows. Thus the Counter-Statements for both matters cannot be considered to have been properly filed or served, albeit out of time. The Respondents submitted that the party which should have done so is the appointed agent ***SLB Singapore*** and they failed to do so.
- xxvii. The Respondents submitted that, in summary, there has been a failure on the part of the Applicants to comply with Rule 31(1) i.e. to file their Counter-Statements by their appointed agent. Correspondingly, there has also been a failure on the part of

the Applicants to comply with Rule 31(2) i.e. to serve their Counter-Statements, albeit out of time, by their appointed agent.

- xxviii. The Respondents submitted that even the request by the Applicants to the Registrar to grant an extension of time in the exercise of his discretion under Rule 83 was not made by the appointed agent *SLB Singapore* but *SLB Malaysia* by their letter of 9 December 2013. The Respondents submitted that the Registrar should not consider the appeal as it has not been made by the appointed agent.
- xxix. The Respondents submitted that the failure to file and serve the Counter-Statements for the Applications by the appointed agent, *SLB Singapore*, and the filing and service of the same by *SLB Malaysia* cannot be considered an irregularity which can be cured by the exercise of the Registrar's discretion under Rule 83. The Respondents submitted that irregularities envisaged by Rule 83 relate to matters that are not complied with by the Applicants themselves or by the appointed agents. In the current case, the Respondents submitted that a third party who is not the appointed agent seems to be acting for the Applicants. The Respondents thus submitted that both the filing and the service of the Counter-Statements are therefore invalid.
- xxx. The Respondents submitted that, given the reasons above, the appeal by the Applicants is academic as there has been no valid filing and service of the Counter-Statements for the Applications. The Respondents concluded that the Registrar's decision as conveyed via the Registrar's letter of 4 December 2013 that the Applicants are deemed to have withdrawn the Applications under Rule 31(3) should not only remain but be reinforced by the failure to file the Counter-Statements by the Applicants' appointed agent.

Held, denying the applications for restoration and extension of time to file and serve the Counter-Statements for Trade Mark Applications No.s T1305469I and T1305467B

1. In relation to the *locus standi* issue, from the facts, it is clear that M/s Shook Lin & Bok with an address at "20th Floor AMBANK Group Building, 55 Jalan Raja Chulan, 50200 Kuala Lumpur", (i.e. *SLB Malaysia*) is the *de facto* agent for the Applicants. It is also clear from the submissions that the intention has only been to utilise the physical address of M/s Shook Lin & Bok LLP (i.e. *SLB Singapore*) i.e. "1 Robinson Road, #18-00 AIA Tower, Singapore 048542" as the address for service.
2. Having said that, the way in which Forms TM4 and TM1 have been completed in the current case left much to be desired. The said forms, in particular, Part 13 of Form TM4 and Part 4 of Form TM1 respectively, have been filled erroneously such as to give an impression that the agent for the Applicants is "M/s Shook Lin & Bok LLP" (i.e. *SLB Singapore*), with an address for service at "1 Robinson Road, #18-00 AIA Tower, Singapore 048542". Accordingly, this is reflected as such in the database of IPOS as can be seen from (i) the *TMJ* and (ii) IPOS Trade Marks

Online Search and Enquiry database under "Details of Mark", in particular, under the part entitled "Agent/Address for Service".

3. Part 13 of Form TM4 as filed appeared as such:

13 Address for service	
<i>Note</i> The address for service must be a Singapore address.	
Agent Code (if applicable)	<input type="text"/>
Name	Messrs. Shook Lin & Bok, LLP
Address	1 Robinson Road, #18-00 AIA Tower, Singapore 048542.

The correct way which Form TM4 should have been filled in this instance would be to insert "M/s Shook Lin & Bok" (i.e. **SLB Malaysia**) in the "Name" box. The "Address" box has been correctly filled with the physical address of **SLB Singapore**. Alternatively, in the "Address" box, one can also insert, in addition, the care of name. So in this instance, it would be acceptable to include, in addition, "C/O Shook Lin & Bok LLP" (i.e. **SLB Singapore**) in the "Address" box (incidentally, Form TM4 has been amended and as such there will be less room for error moving forward).

4. Part 4 of Form TM1 as filed appeared as such:

4 Name and/or address for service to be entered/alterred/substituted	
<i>Note</i> The address for service must be a Singapore address.	
Agent Code (if applicable)	<input type="text"/>
Name	Messrs. Shook Lin & Bok, LLP
Address	1 Robinson Road #18-00, AIA Tower, Singapore 048542.
<input type="checkbox"/> If the address indicated above is the trade or business address of the person indicated on Part 2 of this form, please mark this box.	

Firstly, it is to be noted that there is actually no need to file Form TM1 in this instance. Part 13 of Form TM4 is sufficient to indicate the agent and the address for service for an application. Having said that, the correct way to complete Part 4

of Form TM1 in the instance would be to insert "M/s Shook Lin & Bok" (i.e. **SLB Malaysia**) in the "Name" box. Again, the physical address of **SLB Singapore** has been correctly inserted in the "Address" box. Alternatively, in the "Address" box, one can also insert, in addition, the care of name. So in this instance, it would be acceptable to include, in addition, "C/O Shook Lin & Bok LLP" (i.e. **SLB Singapore**) in the "Address" box (Form TM1 has also been amended such that moving forward there will be less room for error).

5. While the above situation is unsatisfactory, Rule 83 can be applied to the current circumstance to correct the situation. Rule 83 relates to the discretionary power of the Registrar to correct any irregularity in procedure. "Irregularities" in Rule 83 refer to failures to comply with the procedural requirements of the Trade Marks Act (Cap 332, 2005 Rev Ed) and the **Trade Marks Rules**. The exercise of this discretionary power of the Registrar under Rule 83 is a balancing exercise, involving a consideration of the public interest that rules relating to procedure are followed so that there is certainty for trademark owners, and the need to ensure the proper adjudication of the case based on its merits in the interest of justice between the parties. While the balancing exercise is to be carefully weighed and will turn on the particular facts of each case, the overall consideration of public interest of certainty and transparency would warrant the Registrar not overstepping the requirements of the legislation under most circumstances. Therefore, the mere fact that the Registrar has such a discretion under Rule 83 does not justify its exercise in every case.

6. Rule 83 provides that:

Any irregularity in procedure which, in the opinion of the Registrar, is not detrimental to the interests of any person or party may be corrected on such terms as the Registrar may direct.

It will not be detrimental to either party to correct the error in this instance. In particular, the Respondents have not relied on the error to their detriment. The Respondents have not been prejudiced in any way as a result of the irregularity.

7. There is nothing in Rule 83 which limits its application to any irregularities committed by any party / agent only. The Respondents have not submitted any authority in this regard. I also note that neither the Applicants nor **SLB Singapore** have raised any objection to **SLB Malaysia** acting in this matter. As alluded to above, **SLB Malaysia** is the *de facto* agent for the Applicants, and this is sufficient for the purposes of an application of Rule 83.
8. In light of the above, the Counter-Statements were validly filed on 14 November 2013. Had there been no further issues, the Registrar would have directed **SLB Malaysia** to file Form TM1 to rectify the irregularity.
9. However, the Counter-Statements were served on the Respondents late.

10. At the outset, it must be pointed out that, in relation to the applications for the restoration of the Applications and an extension of time to file and serve the Counter-Statements, the body of case law under IPOS has been developing over the years and there are more recent cases than those raised by the Applicants which are applicable to the instant case. Thus, the Registrar will apply these cases to the current case accordingly as appropriate.
11. Rule 31(4) provides that any request for an extension of time must be made within 2 months from the date of receipt by the applicant of a copy of the opponent's notice of opposition. Rule 77 is the general provision which relates to a request for an extension of time to any prescribed period of time under the *Trade Marks Rules*. It is noted that Rule 77(6)(c) specifically provides that Rule 77 shall not apply to the filing of any Counter-Statement under Rule 31. Therefore, there is no general discretion granted to the Registrar to extend any prescribed time period provided under Rule 31. In view of the above, the provisions under Rule 31 in relation to time periods are to be construed strictly unless there are exceptional circumstances which dictate otherwise.
12. As mentioned above, Rule 83 relates to the discretionary power of the Registrar to correct any irregularity in procedure. "Irregularities" in Rule 83 include matters in respect of time. Therefore, the Registrar has the power to restore an application that was earlier deemed withdrawn under Rule 31(3) of the *Trade Marks Rules*.
13. As mentioned above, the exercise of this discretionary power of the Registrar under Rule 83 is a balancing exercise. While the balancing exercise is to be carefully weighed and will turn on the particular facts of each case, the overall consideration of public interest of certainty and transparency, would warrant the Registrar not allowing the overstepping of, in this instance, time limits in the legislation under most circumstances. Thus, it is re-iterated that the mere fact that the Registrar has such a discretion under Rule 83 does not justify its exercise in every case or where no good reasons are shown. Specifically, it is not sufficient to argue that the extension should be granted to a party because otherwise his case fails (as per *Sao Paulo Alpargatas S.A. v But Fashion Solutions Comercio E Industria De Artigos Em Pele, LDA* [2011] SGIPOS 16 (*Sao Paolo*) at [2]).
14. The onus lies on the party applying for the Registrar to exercise discretion in his favour notwithstanding the application of prescribed rules that result in an outcome against his favour. In the present case, under Rule 31(3), the Applications were deemed withdrawn as the Applicants did not serve their Counter-Statements by the deadline. The Applicants are applying for the Registrar to exercise his discretion not to deem the Applications withdrawn notwithstanding Rule 31(3) and for an extension of time to file and serve their Counter-Statements.
15. The Counter-Statements were due on 18 November 2013 (since 17 November 2013 was a Sunday). The Applicants sent the Counter-Statements to the Respondents via

A.R. registered post and the same were received by the Respondents on 25 November 2013. Thus, the Counter-Statements were served 7 days after the 2-month deadline.

16. As mentioned above, on 29 December 2013, the Applicants responded to the Respondents' claim of late service, contending that, amongst others, Rule 7(3)[(a)] states that service may be effected by post and that it does not specify that the documents/counter-statement should or must reach the opponent *before* the deadline of 18 November 2013. The Applicants contended that on an application of Rule 7(4), the Counter-Statements were delivered to the Respondents in the ordinary course of post on 25 November 2013 and that the Applicants have served copies of the Counter-Statements on the Respondents and are in compliance with Rule 31(2).
17. The Registrar then wrote to the parties on 4 December 2013 directing that as the Counter-Statements, which were received by the Applicants on 25 November 2013, had not been served within the deadline of 18 November 2013 under Rule 31(1) and that the Registrar also had not received any request for an extension of time to file the Counter-Statements under Rule 31(4), the Applicants are deemed to have withdrawn the Applications under Rule 31(3). The Applicants then responded on 9 December 2013 (which was faxed to the Registrar on 11 December 2013 at 16.44pm) enclosing a copy of their letter dated 10 December 2013 requesting for an extension of time and their letter of even date to the Respondents enclosing a notice as required under Rule 31(6). Thus, the Applicants only requested for an extension of time 23 days (taking into account the actual receipt date of the Applicants' letter of 10 December 2013) *after* the deadline and 7 days *after* the Registrar's notification. From the chronology of events, it would appear that the Applicants only realized that there was non-compliance with the **Trade Marks Rules** only *after* the Registrar's notification. As held in *Sao Paolo* at [6], such conduct does not assist the Applicants.
18. There is a legitimate expectation that an opposition be dealt with in accordance with the rules of procedure, unless good and sufficient reasons displace this expectation (*Sao Paolo* at [8]). The Applicants' failure to serve any Counter-Statement prior to 18 November 2013 as well as the Registrar's notification of the deemed withdrawal of the Applications on 4 December 2013 would have led the Respondents to believe that the Applications have been deemed withdrawn. Thus the Respondents will be prejudiced if the Applications are restored. There is also public interest in ensuring that rules relating to procedure are followed, especially so in contentious proceedings (*Sao Paolo* at [8]).
19. In this regard, Rule 31(3) provides that if there is non-compliance with Rule 31(1) *or* (2), the applicant shall be deemed to have withdrawn his application. Thus, non-*service* of the counter-statement in *itself*, is sufficient to trigger the application of Rule 31(3).

20. The Applicants have also briefly submitted that parties are also involved in a series of oppositions in other jurisdictions and both parties are well aware of the ongoing dispute between them. However, an equally plausible explanation could be that the Applicants have decided to abandon the fight in Singapore and focus on the other jurisdictions. The Applicants have not provided the Registrar with any evidence as to the other proceedings.
21. The prejudice caused to the Applicants, in this case, in that the Applications will be deemed withdrawn, is a direct factual consequence of the Applicants' default. An Applicant cannot rely on the consequences of his own default as a type of prejudice that the Applicant would suffer, to support his application for an exercise of the Registrar's discretion under Rule 83 *Distileerderij En Likburstokerij Herman Jansen B V v Tilaknagar Industries Ltd [2013] SGIPOS 3* at [10]).
22. At this juncture, I would like to comment upon the cases cited by the Applicants. In *GSM* the Registrar in coming to her conclusion took into account several factors at [5] most of which are absent in this case. *Procter & Gamble* is factually different from the current case in that the case involved an opposition to a mark by two different Opponents. Last but not least, in *Asian Aisle*, the Registrar held at [3] and [4]:

3. In the present case, there is only one opposition against two of the Applicant's marks and the Counter Statements for neither application was filed by the Applicants. The error was discovered only when the Opponents wrote to the Registrar and the Applicants. The only reason given for the omission was that it was an inadvertent oversight.

4. This reason did not persuade the Registrar to exercise her discretion in the Applicants' favour. The Applicants would have to suffer the inconvenience of re-filing their applications and face potential oppositions again...

[Emphasis mine].

23. In light of the above, taking into account all the facts in this case, the Applicants have not shown that there are such exceptional circumstances or good reasons to justify the Registrar's exercise of discretion pursuant to Rule 83. Indeed, the reason for the Applicants' failure to comply with the applicable procedural requirements is simply that they were not aware of, or familiar with, these procedural requirements. This clearly does not constitute "exceptional circumstances" or "good reasons" to justify the Registrar's exercise of discretion in favour of the Applicants.
24. By reason of the foregoing, the Applicants' applications to restore the Applications and request for an extension of time to file and serve their Counter-Statements are refused. Taking into account Rule 75 and the Fourth Schedule of the *Trade Mark Rules*, the Respondents are awarded costs in the total amount of S\$250, S\$150

being costs of preparation for T1305469I and S\$100 being the costs of preparation for T1305467B. Such costs are to be paid by the Applicants to the Respondents within 1 month from the date of this decision.

Legislation discussed:

Trade Marks Rules (Cap 332, Rev. Ed. 2008), Rules 9, 10, 31, 75, 77, 83 and the Fourth Schedule

Cases referred to:

Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited [2002] SGIPOS 7

Procter & Gamble Business Services Canada and Another v Alliance Cosmetics Sdn Bhd [2009] SGIPOS 9

GSM (Operations) Pty Ltd v Martin Joseph Peter Myers [2009] SGIPOS 8

Sao Paulo Alpargatas S.A. v But Fashion Solutions Comercio E Industria De Artigos Em Pele, LDA [2011] SGIPOS 16

Distileerderij En Likburstokerij Herman Jansen B V v Tilaknagar Industries Ltd [2013] SGIPOS 3

Representation:

Mr Michael Soo Chow Ming (Shook Lin & Bok) for the Applicants

Mr Sukumar Karuppiah (Ravindran Associates) for the Respondents (Opponents)