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

Trade Mark Application Nos. T1215563G
8 November 2016

APPLICATION TO AMEND PLEADINGS AND FILE FURTHER EVIDENCE IN A TRADE MARK OPPOSITION BY MONSTER ENERGY COMPANY

AND

OBJECTION THERETO BY CHUN-HUA LO

Principal Assistant Registrar Sandy Widjaja
Decision date: 9 January 2017

Interlocutory hearing *– application to amend pleadings to add Section 8(4) under Section 25 of the Trade Marks Act (Cap 332, 2005 Rev Ed) – application to file further evidence under Rule 35 of the Trade Marks Rules (Cap 332, 2008 Rev. Ed) – request made one day before the written submissions and bundle of authorities are due – whether such an amendment allowed – whether such further evidence allowed*

Relevant Facts

1. The Opponents ("Monster Energy Company") filed a Notice of Opposition ("NOP") in Classes 30 and 43 on 7 February 2014. In the NOP, the Opponents relied on Sections 8(2)(b) and 8(7) of the Trade Marks Act (Cap 332, 2005 Rev Ed) ("the Act").

2. The Applicant ("Chun-Hua LO") filed his Counter-Statement on 14 May 2014. The Opponents filed their statutory declaration on 19 March 2015. The Applicant filed his statutory declaration on 19 November 2015. The Opponents filed their evidence in reply on 17 February 2016. A Pre-Hearing Review (PHR) was conducted on 14 March 2016 where the Applicant asked for leave to file further evidence. The Opponents consented to the request on the basis that the Opponents be given the right of reply. The Applicant then filed his further evidence on 13 April 2016 while the Opponents filed their reply to the same on 3 June 2016.

3. On 8 June 2016, the Registrar issued a notice and the hearing was set for 8 August 2016. Following this, the written submissions and bundle of authorities were due on 8 July 2016. On 7 July 2016, the Opponents wrote to the Registrar to seek leave to amend the NOP to add Section 8(4) as a ground of objection[1]. The Opponents also sought leave to

[1] The Opponents also sought the Applicant's consent to amend the NOP.

adduce further evidence[2]. The further evidence specifically sought to show the relevant connection between the Applicant's Class 43 services and the Opponents' goods under Section 8(2)(b). The same evidence would also be relevant for the same purpose with regard to Section 8(4), should it be allowed to be added.

4. In order to facilitate the above requests, the Opponents sought an extension of time to file the written submissions and bundle of authorities for the full hearing in the same letter of 7 July 2016.

5. On 8 July 2016, the Applicant informed the Registrar that while he consents to the request for an extension of time pending the resolution to the issues, he does not consent to the Opponents' request to amend the pleadings and file further evidence.

6. The Registrar wrote to the parties on 11 July 2016 suspending the deadline for the filing of the written submissions and bundle of authorities for the full hearing and vacating the hearing date of 8 August 2016 while directing the Opponents to provide a short written explanation for the requests and the Applicant to respond to the same. The Registrar indicated that he will give a preliminary indication / view on the requests upon hearing from both parties.

7. On 18 July 2016, the Opponents explained that they have only decided to request to amend the pleadings at this stage as they were of the view that it would be prudent to have regard to the evidence filed by both parties and that the parties were in negotiations. On the issue of the request to file further evidence, the Opponents submitted that one of the reasons for this request accords with the request to amend the pleadings as the Opponents are seeking to file further evidence to show the connection between the parties' goods / services. The Opponents enclosed a copy of the draft further evidence. The Applicant responded on 1 August 2016 providing details of his objection.

8. On 10 August 2016, the Registrar wrote to the parties indicating that he is not inclined to grant the two requests. The Registrar directed the parties to indicate if they wish for the matter to be determined by way of an interlocutory hearing and if so, if they prefer for the hearing to be by way of written submissions and bundle of authorities only or by way of an oral hearing, in addition to written submissions and bundle of authorities.

9. The Applicant indicated on 26 August 2016 that he preferred to be heard by way of written submissions and bundle of authorities only while the Opponents indicated on 23 August 2016 that they wish to be heard orally as well. In light of the above, on 14 September 2016, the Registrar indicated that there will be an oral hearing in addition to written submissions and bundle of authorities. The Applicants will have an option to file a reply within 2 weeks from the filing of the written submissions and bundle of authorities by both parties after which there will be an oral hearing unless the Applicants elect otherwise.

10. On 15 September 2016 the Applicant indicated that in light of the Registrar's direction that there will be an oral hearing, his agent would attend the hearing to protect his interests.

[2] The Opponents only sought the Applicant's consent with regard to adducing further evidence via their letter of 18 July 2016 where they also included the draft further evidence.

Held, disallowing the request to amend the Notice of Opposition to add Section 8(4) as a ground of objection but allowing the request to file further evidence

(A) *Request to amend the Notice of Opposition to add Section 8(4) as a ground of objection*

1. As submitted by the Opponents at paragraph 16 of their written submission, Section 25 of the Act governs the request to amend the NOP. In particular, Section 25(b) provides as follows:

> **Amendment of other documents**
>
> 25. The Registrar may, at the written request of the person who has made an application (other than an application for the registration of a trade mark), or filed a notice or other document for the purposes of this Act, or at the written request of the person's agent, amend the application, notice or document…
>
> (b) if the Registrar is of the opinion that it is *fair and reasonable* in all the circumstances of the case to do so.

[Emphasis as italicized mine]

2. Further Circular **2/2010** provides guidance as to the factors which the Registrar will take into consideration where amendments are sought to be made after the close of pleadings and where the opposite party does not consent to the request:

> **B. AMENDMENTS AFTER CLOSE OF PLEADINGS**
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> Where amendments are sought after pleadings are deemed to be closed, consent from the other party must first be sought. If there is consent from the other party, the Registrar will in appropriate cases generally allow the amendment and if necessary, issue such directions on the subsequent procedure as is deemed fit.
>
> Where there is no consent, leave of the Registrar must be obtained for any amendment after the close of pleadings. Whether leave would be granted depends on the facts and circumstances of each case. In considering whether to grant leave for the amendments, the Registrar will conduct a *balancing* exercise, involving a consideration of the public interest that rules relating to procedure are complied with and the need to ensure that there is proper adjudication of a case based on its merits in the interest of justice between the parties. In particular, the Registrar will carefully weigh the following *non-exhaustive factors on a case by case basis*:
>
> (i) whether the party seeking the amendment could have claimed the particular ground/defence or cited the additional "earlier trade mark" earlier, when filing Form TM 11, Form TM 28 or Form TM 12
>
> (ii) whether the amendment is necessitated by the pleading or evidence filed by the other party

(iii) whether the other party would suffer any real prejudice which cannot be compensated with costs if the amendment is allowed

(iv) 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

(v) 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

(vi) the substantiality of the amendment

(vii)the stage of the proceedings the amendment is sought.

If leave to amend is granted, the Registrar may issue such necessary directions on the subsequent procedure as is deemed fit, including but not limited to adjourning the case, allowing amendments to be made to the Counter-Statement by the other party, granting extensions of time for the filing of further evidence by both parties as well as awarding such costs as may be just against the party seeking the amendments.

[Emphasis as italicized mine]

3. I will consider each factor set out in Circular **2/2010** in turn below.

4. In addition to the above, the Opponents also referred to Order 20, Rule 5 of the Rules of Court (R 5, Cap 322, Rev Ed 2014) ("ROC") which provides as follows:

> 5.—(1) Subject to Order 15, Rules 6, 6A, 7 and 8 and this Rule, the Court *may* at any stage of the proceedings allow the plaintiff to amend his writ, or any party to amend his pleading, on such terms as to costs or otherwise as may be just and in such manner (if any) as it may direct.

[Emphasis as italicized mine]

5. In this regard, the Opponents referred to ***J.E. Borie SA v MHCS*** [2013] SGIPOS 4 ("***Borie***") at paragraph 22 of their written submission. The Principal Assistant Registrar (PAR) at paragraph 25 of ***Borie*** provided as such:

> [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)**[3] are more relevant to the present proceedings, as they refer to the "general principles for the grant of leave to amend".

[3] The most recent version is the 2017 edition, although the principles remain largely the same.

[Emphasis as italicized mine]

In light of the above, where the factors overlap with that provided in Circular **2/2010**, they will be dealt with together as far as possible.

(i) *Whether the party seeking the amendment could have claimed the particular ground/defence or cited the additional "earlier trade mark" earlier, when filing Form TM 11, Form TM 28 or Form TM 12*

6. In relation to this factor, I agree with the Applicant that as a matter of good practice, an opponent should consider all the necessary facts before commencing an opposition action (paragraph 20 of the Applicant's written submission). This is necessary so that an opponent would be able to plead all the necessary grounds of objection and Section 8(4) is one such ground.

7. Further, as pointed out by the Applicant at paragraph 22 of his written submission, the Opponents had admitted via their letter of 18 July 2016 that the evidence that has been provided thus far already demonstrates the well-known nature of the Opponents' marks. In this regard, the Opponents submitted, at paragraph 28 of their written submission:

> [28] In respect of the well-known claim, the Opponents will *not* be submitting additional evidence but will *rely on the evidence already submitted*.

[Emphasis as italicized mine]

Thus, the Applicant's position is that since all the evidence that is necessary to support the well-known ground has already been filed when the Opponents' evidence fell due on 19 November 2015, it suggests that the Opponents had been in possession of the relevant facts such that the Opponents could have included Section 8(4) at the point of drafting and filing the NOP (paragraphs 22 and 23 of the Applicant's written submission).

8. In light of the above, the Opponents' reasoning, at paragraphs 24 to 25 of their written submission, that parties were in settlement negotiations and that the Opponents do not wish to jeopardize the same by requesting for the pleadings to be amended does not stand up to scrutiny (paragraph 27 of the Applicant's written submission).

9. Further, parties only considered the possibility of negotiations, at the earliest, at the Case Management Conference (based on the file record). In this regard, the Opponents, via their Notification to the Registrar which was filed after the pleadings closed, indicated that they had not contacted the Applicant and that they were not interested in negotiations (paragraph 28 of the Applicant's written submission). Thus it was open to the Opponents to include Section 8(4) at the point of drafting and filing the NOP since there were no negotiations then.

10. The Applicant also argued that the Opponents had several opportunities to consider making the request to amend the pleadings (paragraph 29 of the Applicant's written submission). In this regard, the Applicant submitted that active negotiations were only ongoing between June – September 2015. The Applicant referred to the Opponents' letter of 21 September 2015 where the Opponents indicated that there were no active

negotiations between the parties (paragraphs 29.1 and 29.2 of the Applicant's written submission).

11. The Applicant also referred to the Pre-Hearing Review (PHR) of 14 March 2016 where the Opponents' (counsel) indicated that they had no instructions pertaining to the settlement negotiations (paragraphs 29.3 of the Applicant's written submission).

12. In response, the Opponents countered at the oral hearing that:

    (i) Not being in active negotiations does not mean that negotiations have failed; and
    (ii) Having no instructions pertaining to the negotiations is not the same as parties not being in settlement negotiations.

13. To put matters in context, the Opponents' counsel clarified at the oral hearing that they were not privy to the settlement negotiations, which were between the United States (US) counsel of both parties, although they have knowledge of the same. The Opponents submitted that as early as January 2016, there had been exchange of settlement proposals between both parties:

> [24] …In particular, the Opponent was considering a potential settlement then and in fact, made a settlement proposal to the Applicant's US counsel on 20 January 2016. The Applicant made a counter-proposal on 19 February 2016, and made a further counter-proposal on [29 August] 2016. The Opponent has not yet replied to that proposal…
>
> [25] On 8 June 2016, the opposition was fixed for a hearing on 8 August 2016 with written submissions due on 8 July 2016. The Opponent was then still considering the possibility of settlement and recognized that the Applicant would unlikely agree to further extensions in these proceedings and thus after the hearing date was fixed, the Opponent decided that it had to move forward with seeking to amend the Notice of Opposition. For the record, the Opponent is still considering the Applicant's counter-proposal.

14. It is noted that 20 January 2016 is a date after the filing of the Applicant's evidence on 19 November 2015 and before the PHR on 14 March 2016. Thus I note that there have been exchanges between parties with regard the settlement negotiations since that date.

15. I am prepared to accept that "not being in active negotiations" does not mean that negotiations have failed. In particular, I am prepared to accept the Opponents' arguments above that "no instructions for negotiations" *per se* is not equivalent to "not in settlement negotiations". However, to put the matters at the PHR in context, in addition to the Opponents indicating that they had "no instructions for negotiations", the Applicant also indicated that "worldwide negotiations have not come to fruition". It is no wonder then that it was indicated on the PHR file record that "parties are not settling". It is also in this light that our letter of 10 August 2016 at paragraph 5 stated that, at the PHR on 14 March 2016, "both parties indicated that there was no possibility of settlement".

16. Counsel should be aware that the main purpose of a PHR is to assess if a matter is gearing up for a full hearing and, if so, to deal with all procedural issues to render the case ready. Therefore, it is a matter of good practice and courtesy, for counsel to seek pertinent

instructions from their clients / foreign counsel, as appropriate, in relation to the developments with regard to the matter, at the very latest, by the PHR date so that the matter can move forward. Counsel should caution their foreign counterparts (in this instance) that should such updates not be forthcoming, then the relevant party would have to be prepared to bear the consequences of non-committal answers.

17. However, even if I accept the Opponents' argument above that they were unable to request for the pleadings to be amended at various points in time during the opposition action as a result of ongoing negotiations up until the point of the PHR, it still remains the position that the Opponents were in a position to include Section 8(4) at the point of drafting and filing of the NOP, since they should and would have had at hand the relevant information and parties were not in settlement negotiations then.

18. Therefore, in light of the circumstances, the Opponents could have included Section 8(4), at the point of filing the NOP.

(ii) Whether the amendment is necessitated by the pleading or evidence filed by the other party

19. The Opponents submitted that the other reason why they did not seek to amend the pleadings earlier is because they were of the view that it would be prudent to consider the Applicant's evidence given that costs considerations are likely to flow from such an amendment (paragraph 23 of the Opponents' written submission).

20. In relation to this factor, the Applicant submitted (paragraph 34 of the Applicant's written submission) that, since Section 8(4) is premised on facts well within the Opponents' knowledge, such that the objection could have been included at the point of drafting and filing the NOP (discussed above), the amendment is not necessitated by the pleading or evidence filed by the Applicant (as alluded to earlier, the Opponents had admitted via paragraph 28 of the Opponents' written submission, that the evidence that has been provided thus far already demonstrates the well-known nature of the Opponents' marks).

21. Further, in an opposition proceeding, the opponents would have to file their evidence before the applicants file their evidence in response such that any pleading or evidence filed by the applicants will necessarily be restricted to matters raised by the opponents. In light of this, it is difficult to understand what type of evidence by the Applicant the Opponents wished to review before proceeding to add Section 8(4) (paragraph 33 of the Applicant's written submission).

22. In any event, the Applicant has in fact filed no pleading or evidence which would necessitate the proposed inclusion of Section 8(4) (paragraph 36 of the Applicant's written submission).

23. I agree with the Applicant that to begin with, since Section 8(4) is premised on facts well within the Opponents' knowledge (above), the objection should and could have been included at the point of drafting and filing of the NOP.

24. While I am of the view that there may be instances where an applicant's evidence could possibly trigger the need for an opponent to add another ground of objection, even though sequentially an opponent's evidence is filed before the applicant's evidence, I have

considered the Applicant's evidence filed for the current proceedings and I am of the view that the Applicant has *not* in fact filed evidence which would necessitate the proposed inclusion of Section 8(4).

(iii) Whether the other party would suffer any real prejudice which cannot be compensated with costs if the amendment is allowed

25. The Applicant argued, at paragraphs 37 – 39 of his written submission, that the proposed amendment will cause the Applicant to suffer real prejudice which cannot be compensated by costs. The Applicant submitted that the proposed amendment involves the introduction of a new cause of action which would have the effect of unravelling and delaying the matter. The Applicant submitted that it would lead to additional inconvenience, expense and "strategy costs" which in totality, cannot be compensated by [costs].

26. At the oral hearing, the Applicant elaborated on the unravelling of the case as follows:

(i) The Counter-Statement will have to be amended; and
(ii) The Applicant will have to re-file his evidence as he would have to respond to the new cause of action.

The Applicant added that it has been two and a half years since the action was initiated and such a delay is extremely prejudicial since there would be a need to return to the pleadings stage of the proceedings (paragraphs 41 and 42 of the Applicant's written submission).

27. On the other hand, Opponents argued at paragraph 28 of their written submission, that since in relation to Section 8(4) the Opponents will not be submitting additional evidence but will rely on the evidence already submitted, there is no prejudice to the Applicant.

28. Further, the Opponents relied on ***Wright Norman v OCBC*** [1994] 1 SLR 513 ("***Wright Norman***") (paragraph 21 of their written submission), for the proposition that delay *per se* does not equate to prejudice or injustice (***Wright Norman*** at [23]):

> [23] …While the time at which an amendment is made is a relevant consideration it is not necessarily decisive. Delay *per se* does not equal prejudice or injustice. We do not think any rigid rule should or can be laid down on this.

29. I agree. This is also clear from Circular **2/2010**, which provides *one* of the relevant factors to be the "the stage of the proceedings the amendment is sought" (discussed below). It will be apparent below that the prejudice which the Applicant will suffer in this instance entails more than just delay *per se*.

30. The Opponents rely on ***Branov v Sleep Better Bedding Mfg Pty Ltd*** 32 IPR 171 ("***Branov***") at paragraph 29 of their written submission and submitted that the Applicant cannot be said to be prejudiced by any delay arising from the proposed amendment to the NOP:

> [29] Moreover, the Applicants cannot be said to be prejudiced by any delay arising from the proposed amendment to the [NOP]. It was recognized in the case of

> [***Branov***] that any delays caused by an opposition to a mark's registration are part and parcel of that process and if, the final outcome, the Applicants are successful, the registration of the mark will extend from the date of application. Equally, the inconvenience and expense of the opposition process itself are inherent in any dispute.

31. However, the context of ***Branov*** is different from the current case. To begin with, it is in relation to an application to file for an extension of time to file an NOP. The background is that under Section 49 of the Australian Trade Marks Act 1995, a person wishing to oppose the registration of an application may do so within 3 months of the date of advertisement. The same provision also allows for an extension of the initial opposition period by a further period of time not exceeding 3 months as long as such further request is made within the initial 3-month period. In that case, the opponents sought to apply for a further 3 months extension of time to file their NOP against Mr Branov's mark. Mr Branov's mark has been cited against the opponents' mark as a bar to registration. Mr Branov objected to the request for a further extension of time.

32. More importantly, it is noted (page 177 of ***Branov***, lines 9 - 16):

> …On the other hand, if I did not allow the time sought, then [the Opponents'] case would be immediately brought to an end. This would mean that the citation of the present mark as a bar to the registration of [the Opponents'] mark would, in all probability, be maintained and *lead to its lapsing*. Consequently, I think that a refusal would be more damaging to [the Opponents'] interest than those of Mr Branov. I therefore find that the balance of convenience lies with granting the extension [of time to file the NOP] and allowing the case to be decided upon its merits.

[Emphasis as italicized mine]

33. On the other hand, in the current case, in the event that the request to amend the pleadings to add the well-known ground is rejected, the Opponents' case can still proceed to a full hearing based on the original grounds pleaded in the NOP.

34. As already pointed out by the Applicant (above), the proposed amendment involves the introduction of a new cause of action which would have the effect of unravelling the matter. Inherent in the unravelling of the matter is additional expense in having to re-draft the Counter-Statement and the Applicant's evidence, as well as the "strategy costs", for clearly the Applicant would have to re-strategize in light of the new objection added (for example, the Applicant would have to re-evaluate the strength of the respective objections in charting his defence; see also ***Avtar Singh and Harikat Singh trading as Aero Club v Timberland Company*** [2011] SGIPOS 4 ("***Harikat Singh"***) at [5], below). The above is *in addition* to the issue of delay, which in itself, is a factor which the Registrar takes into account (discussed below).

35. In relation to this element, the case of ***Harikat Singh*** is relevant (although the Applicant only raised this case at the oral hearing in relation to the issue of further evidence). It is noted, in particular, at paragraph 5 of ***Harikat Singh***:

> [5] This is not a case where the prejudice to the Applicants could be remedied by compensating the Applicants with costs. The Applicants had prepared their case on the basis of the grounds of opposition in the Notice of Opposition and all the grounds pertain to the Opponents' earlier rights in their "Timberland" with tree device marks. The bad faith ground under section 7(6) is a *distinct ground* and *very different* from the opposition grounds based on "earlier rights". A case of bad faith introduced at this stage therefore *presents a totally new case* against the Applicants. Consequently, the considerations and the assessment of the Applicants' case in response to the opposition against their application would *take on a different dimension* for the Applicants. Put in another way, the Applicants *could well have adopted a response strategy different* from what the Applicants had done if they had known that the case for them to answer includes that of bad faith. Now at this late stage, when the case was proceeding to a hearing and indeed has proceeded to a hearing with submissions, it would be *highly prejudicial to the Applicants* if the Registrar were to allow the inclusion of this new ground and the further evidence in support of this new ground. Further, the whole proceedings would have to be *unraveled* and the Applicants would have to *backtrack to the filing of their Counter-statement. The inconvenience, expense and strategy costs in totality cannot be easily compensated with costs to the Applicants*.

[Emphasis as italicized mine].

It is clear from the above that the issue of prejudice is a multi-faceted and inter-related one and includes concerns, amongst others, such as substantiality of the proposed amendment (below). In so far as the issue of prejudice is concerned, the above highlights that the costs of having to re-strategise is one factor which is clearly prejudicial to the Applicant in the current case.

(iv) 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

36. The Opponents argued that the amendment will facilitate the determination of the real question in controversy between the parties since a significant part of the evidence submitted thus far demonstrates that the Opponents' marks are well known in Singapore (paragraph 27 of the Opponents' written submission).

37. The Opponents further submitted that it is trite law that multiplicity of proceedings is undesirable and should be avoided, relying on ***Hunt-Wesson Inc.'s Trade Mark Application*** [1996] RPC 233 (paragraph 26 of the Opponents' written submission).

38. The Applicant submitted that allowing the amendment to facilitate the determination of the real question in controversy between the parties is not an unqualified right and is subject to there being no prejudice to the other party (paragraph 40 of his written submission). I agree.

39. The fact that the above consideration (i.e. allowing the amendment to facilitate the determination of the real question in controversy between the parties), is only *one* of the many factors which the Registrar takes into account, supports the argument that this right is not an unqualified right, albeit an important one.

40. This has been made clear in Circular **2/2010**:

> In considering whether to grant leave for the amendments, the Registrar will conduct a *balancing* exercise, involving a consideration of the public interest that rules relating to procedure are complied with and the need to ensure that there is proper adjudication of a case based on its *merits* in the interest of justice between the parties.

[Emphasis as italicized mine].

41. In this regard, I agree with the Applicant that (at paragraph 45 of his written submission):

> Procedural justice is an important aspect of the holistic ideal and concept of justice itself and there must be fairness in the procedure or manner in which the final outcome is achieved.

42. In the same vein, the unfortunate consequence of having multiplicity of proceedings is only *one* of the many factors taken into consideration.

43. The Opponents also referred to ***Borie*** (paragraph 22 of their written submission):

> [25]…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…

[Emphasis as italicized mine]

44. The use of the term "cognizant" simply indicates that the Registrar keeps in mind, against the backdrop of all the relevant considerations, that a trade mark registration confers monopoly rights against other traders. As alluded to above, the Registrar's exercise of discretion entails the Registrar to consider *all* the relevant circumstances and while the above element is an important one, it is not determinative.

(v) 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

45. In relation to this factor, it is clear that if the amendment is allowed, there is a need for the Applicant to reply, by re-filing:

(i) The Counter-Statement; and
(ii) The Applicant's evidence.

(vi) the substantiality of the amendment

46. The Applicant submitted that the amendment which the Opponents sought is an entirely new cause of action and not merely an amendment to clarify matters already pleaded (paragraph 38 of the Applicant's written submission). Where the amendment is

substantial and a whole new cause of action is introduced it should not be allowed (paragraph 39 of the Applicant's written submission).

47. In ***Harikat Singh***, the ground which was sought to be added was Section 7(6) which relates to bad faith. The Registrar disallowed the application to add Section 7(6):

> [6] The amendment sought to be made to the Notice of Opposition is *substantial* in nature in that it is a *whole new case* against the Applicants altogether…By extrapolation, it can also be said the ground of bad faith must be specifically pleaded right at the outset or if not at the outset, it should be pleaded at an early stage to allow ample opportunities for both parties to present their respective case. The ground of bad faith and further evidence in support thereof should not be slipped in just before the hearing to *scuttle* the case for the Applicants…upon an examination of the circumstances of this case, there is also no reason for allowing the Opponents to *spring a surprise* on the Applicants or to subject the Applicants to answering to a totally new case against them.

[Emphasis as italicized mine].

48. For completeness, there is also some discussion with regard to the substantiality of the proposed amendment above under the issue of prejudice. For ease of reference, the relevant portion is reproduced below:

> [5] ...The Applicants had prepared their case on the basis of the grounds of opposition in the Notice of Opposition and all the grounds pertain to the Opponents' earlier rights in their "Timberland" with tree device marks. The bad faith ground under section 7(6) is a *distinct ground* and *very different* from the opposition grounds based on "earlier rights". A case of bad faith introduced at this stage therefore *presents a totally new case* against the Applicants. Consequently, the considerations and the assessment of the Applicants' case in response to the opposition against their application would take on a *different dimension* for the Applicants. Put in another way, the Applicants could well have *adopted a response strategy different* from what the Applicants had done if they had known that the case for them to answer includes that of bad faith…the whole proceedings would have to be *unraveled* and the Applicants would have to *backtrack to the filing of their Counter-statement. The inconvenience, expense and strategy costs in totality cannot be easily compensated with costs to the Applicants*.

[Emphasis as italicized mine].

49. The Opponents argued that unlike ***Harikat Singh*** where the ground sought to be included was Section 7(6), in the current case, the ground which is sought to be included is Section 8(4), which, similar to the ground of objection under Section 8(2)(b) (which had been pleaded), is based on earlier rights. The only distinction is in relation to the well-known element.

50. I agree that Section 8(4) is similar to Section 8(2)(b) to some extent since both Sections 8(4) and 8(2) relate to earlier rights. However, I am of the view that the well-known element renders Section 8(4) sufficiently distinct from Section 8(2)(b) such that the

extent of prejudice that will ensue should the proposed addition be allowed is not far from that described above in ***Harikat Singh***.

51. As alluded to above, should the amendment be allowed, the whole matter would have to be backtracked to the pleadings stage since the Applicant would have to re-draft and re-file his Counter-Statement as well as his evidence. In this regard, not only is there the additional expense in having to re-draft the relevant documents, there is also the strategy costs, in addition to delay.

52. In light of the above, the proposed amendment in this case is substantial.

(vii) the stage of the proceedings the amendment is sought.

53. The request was only made one day before the written submissions and bundle of authorities for the full hearing were due.

54. In this regard, the Opponents sought to explain that the reason why they only made the request at this stage was that negotiations were ongoing and that the Opponents did not wish to jeopardize the same, in addition to the fact that they were waiting to see the Applicant's evidence (discussed above). The Opponents submitted that while they could have sought to amend the NOP following the review of the Applicant's evidence which was filed on 19 November 2015, parties were then in negotiations.

55. I have already discussed above that the state of negotiations is irrelevant and insufficient justification for the Opponents' late request for the amendment of the NOP. It is common practice for parties to plead all the relevant causes of action at the outset.

56. Further, in this instance, Section 8(4) *could* have been included in the NOP at the point of drafting and filing the same since facts pertaining to the well-known ground, premised on the Opponents' own evidence, in all probability, was *available* prior to the drafting and filing of the NOP (discussed above). Parties were also not in negotiations at the time of the drafting and filing of the NOP (discussed above).

57. The Opponents continued:

> [25] On 8 June 2016, the opposition was fixed for a hearing on 8 August 2016 with written submissions due on 8 July 2016. The Opponents were then still considering the possibility of settlement and recognized that the Applicants would unlikely agree to further extensions of time in these proceedings and *thus after the hearing date was fixed the Opponents decided that it had to move forward with seeking to amend the Notice of Opposition*. For the record, the Opponents are still considering the Applicants' counter-proposal.

[Emphasis as italicized mine]

58. From the above, it would appear that as at 8 June 2016, when the hearing date was fixed, the Opponents "decided that it had to move forward with seeking to amend the Notice of Opposition". Yet it still took them until 7 July 2016 (approximately another 4 weeks) before they wrote in to request for the same.

59. The Applicant also relied on ***Harikat Singh*** in relation to this factor. However, the Opponents argued at the oral hearing that the current case is different and that the delay is not as great (paragraph 3 of ***Harikat Singh***):

> [3] Considering that the hearing date was postponed a few times and considering that there was representation from the Opponents that they were ready to proceed to a full hearing as early as 1 December 2010 and that both parties have already filed their written submissions and bundles of authorities for the hearing, it cannot be said that the need for an amendment to the Notice of Opposition and inclusion of the further evidence could not have been anticipated or foreseen earlier.

In contrast, in the current case, the request was made one day before the written submissions and bundle of authorities were to be filed (the deadline has since been postponed in light of the developments – see our letter of 11 July 2016).

60. I agree that the delay in the current case is not as serious as that in ***Harikat Singh***. However, ***Harikat Singh*** is a rather *unusual* case where the hearing date was postponed 3 times. In general, parties are expected to raise any procedural request pertaining to the matter, in order to gear the matter for a full hearing, at the PHR. Afterall, that is the whole purpose of convening a PHR, which is a forum to ensure that the case is ready for hearing, should that be the case.

61. The Opponents also sought to argue that there were no new developments which justify the late request to add Section 7(6) in ***Harikat Singh***:

> [4] The Opponents could not point to any new development or any new information or evidence that triggered the investigations that led to the need for further evidence to be admitted and consequently, the need to include the new ground of opposition under section 7(6). The Opponents did not supply any reasonable explanation as to why they conducted the investigations at a very late stage…Thus, any necessary investigations by the Opponents should have been triggered as early as November 2009…If the Opponents had sought the amendment and the inclusion of the further evidence following such investigations then, the amendment and further evidence would have been allowed, the justification being that the amendment and further evidence were necessitated by the evidence filed by the Applicants.

However, in the current case, the Opponents have already explained above that it is due to the negotiations which were ongoing.

62. I have already dealt with this issue and will not repeat my analysis here. In short, the proposed inclusion of Section 8(4) is one which should and could have been included at the point of drafting and filing the NOP, at which point there were *no* negotiations ongoing.

Other factors

63. I will now refer to some of the principles relevant to Order 20 Rule 5 of the ROC, as enunciated at paragraph 20/8/8, page 359 of ***Singapore Civil Procedure* (2013)**. In particular, the Opponents referred to the factors provided in ***Ketteman v Hansel***

Properties Ltd [1987] A.C. 189 and endorsed in ***Wright Norman*** and ***Chwee Kin Cheong v Digilandmall.com*** [2005] 1 SLR(R) 502 (paragraph 19 of their written submission):

> *First*, all such amendments should be made as are necessary to enable the real questions in controversy between the parties to be decided. *Secondly*, amendments should not be refused solely because they have been made necessary by honest fault or mistake of the party applying for leave to make them: it is not the function of the court to punish parties for mistakes which they have made in the conduct of their cases by deciding otherwise than in accordance with their rights. *Thirdly*, however blameworthy (short of bad faith) may have been a party's failure to plead the subject matter of a proposed amendment earlier, and however late the application for leave to make such amendment have been, the application should, *in general*, be allowed, provided that allowing it will *not* prejudice the other party. *Fourthly*, there is no injustice to the other party *if* he can be compensated by an appropriate order as to costs.

[Emphasis as italicized mine]

64. With regard to the first factor, it has been discussed above that it is only one of the many factors taken into consideration. As argued by the Applicant, it is not an unqualified right and is subject to there being no prejudice to the other party (discussed above).

65. With regard to the second factor, it is noted that the Court in ***Wright Norman*** provided as follows (paragraph 21 of the Applicant's written submission):

> [23] …In our opinion, at the end of the day, the most important question which the court must ask itself is, *are the ends of justice served* by allowing the proposed amendment. Pleadings should not be used as a means to punish a party for his errors or the errors of his solicitors. All relevant issues should be investigated, *provided* the other party will not be prejudiced in a way which cannot be compensated by costs. All relevant circumstances should be considered by the court before it exercises its discretion whether it would allow an amendment…

[Emphasis as italicized mine]

66. I agree. The above pronouncement is consistent with Circular **2/2010**, replicated here for ease of reference:

> In considering whether to grant leave for the amendments, the Registrar will conduct a *balancing* exercise, involving a consideration of the public interest that rules relating to procedure are complied with and the need to ensure that there is proper adjudication of a case based on its merits in the interest of justice between the parties.

[Emphasis as italicized mine]

The Registrar is concerned as to whether the ends of justice are served by allowing the proposed amendment and thus the balancing exercise. Nowhere is it indicated in Circular **2/2010** that punishment of a party for his errors or the errors of his solicitors is a relevant consideration. Rather, *all* relevant factors will be duly considered, including if the

opposite party will be prejudiced in a way which cannot be compensated by costs, before coming to a final decision. In this regard, while Circular **2/2010** is only meant to be a guide, and the factors listed in the same are not meant to be exhaustive, it is nonetheless instructive.

67. I will deal with the third and fourth factors together as they are intertwined. The key is to determine if the Applicant in this case would be prejudiced and, if so, whether such prejudice can be compensated by costs. In the current case, as discussed above, I am of the view that the Applicant will be prejudiced in a way which cannot be compensated by costs for reasons discussed above.

68. In light of all of the above, the request to amend the pleading to add Section 8(4) is refused.

69. Finally, with regard to reliance on court authorities, I refer to ***A.T.X. International, Inc. v SGP International Enterprise*** [2016] SGIPOS 14 where the PAR cautioned as follows:

> [20] I also take the opportunity to make a passing comment on the Applicants' heavy reliance on the Court of Appeal decision in ***Tokai Maru***. As cited from [2] in the decision in ***MGG Software*** at [12] above, there is a basic *distinction* between court proceedings and proceedings before the Registrar of Trade Marks... *In light of the different contexts, parties should not expect the Registrar, being part of a low-cost administrative tribunal with an interest in transparency and certainty, to, as a matter of course, adopt more liberal court authorities when dealing with breaches of procedure*.

[Emphasis as italicized mine]

(B) *Request to file further evidence*

70. The relevant provision is Rule 35 of the Trade Marks Rules (Cap 332, 2008 Rev. Ed) as follows:

> **Further evidence**
>
> 35. No further evidence may be filed by either party except that, in any proceedings before the Registrar, the Registrar may at any time, if he thinks fit, give leave to either party to file further evidence upon such terms as to costs or otherwise as the Registrar may think fit.

71. Further, Circular **1/2011** provides guidance as to the factors which the Registrar will take into consideration when such a request is made and where the opposite party does not consent to the request:

> **A. FURTHER EVIDENCE WITHOUT CONSENT**
>
> If there is no consent from the other party, the Registrar does not allow further evidence to be filed simply as a matter of course. Whether leave would be granted depends on the facts and circumstances of each case. In considering whether to grant leave for the further evidence, the Registrar will conduct a balancing exercise, involving a

consideration of the public interest that rules relating to procedure are complied with and the need to ensure that there is proper adjudication of a case based on its merits in the interest of justice between the parties. In particular, the Registrar will carefully weigh the following *non-exhaustive factors on a case by case basis*:

(i) why the party seeking to file the further evidence did not do so earlier when the main evidence or evidence in reply fell due; it should be shown that the evidence could not have been obtained earlier with reasonable diligence
(ii) whether the further evidence is necessitated by the evidence filed by the other party
(iii) whether the other party would suffer any real prejudice which cannot be compensated with costs if the further evidence is allowed
(iv) whether allowing the further evidence will allow the substantial issues to be satisfactorily and fully considered and determined or whether the application is only a tactical manoeuvre and allowing the further evidence would result in prejudice to the other party
(v) the stage of the proceedings at which the further evidence is sought (e.g. at the Pre-Hearing Review in contrast to one day before the hearing), considerations of disruption to proceedings and extra costs generated by the delay being relevant.

All relevant factors will be considered, though *the main weight is attached to the desirability of having the substantial issues satisfactorily and fully considered* and determined. However, this factor may be outweighed by the totality of the other factors in certain cases.

[Emphasis as italicized mine]

72. I will consider each factor in turn.

73. First and foremost, the Opponents clarified at paragraph 38 of the Opponents' written submission that the further evidence which the Opponents is seeking to adduce is intended to demonstrate that there is a connection between the Applicant's Class 43 services and the Opponents' goods under Section 8(2)(b). The Opponents further submitted that the further evidence will allow, in particular, Section 8(2)(b) to be fully ventilated (paragraph 39 of the Opponents' written submission).

74. However, the same evidence is also relevant for Section 8(4) such that in the event leave is granted for the Opponents to add Section 8(4), the Opponents will necessarily need to file the further evidence to demonstrate the relevant connection between the Applicant's Class 43 services and the Opponents' goods under Section 8(4) (paragraph 38 of the Opponents' written submission). In this regard, the Opponents have submitted (in the context of their arguments for the addition of Section 8(4)) that in relation to the well-known claim, the Opponents will not be submitting (any other) additional evidence but will rely on the evidence already submitted (paragraph 28 of the Opponents' written submission).

(i) Why the party seeking to file the further evidence did not do so earlier when the main evidence or evidence in reply fell due; it should be shown that the evidence could not have been obtained earlier with reasonable diligence

75. In relation to this, the Opponents submitted that the same reasons as provided in paragraphs 23 – 25 of their written submission apply (paragraph 40 of the Opponents' written submission):

(i) The Opponents wanted to review the Applicant's evidence first, given that there are costs considerations;
(ii) there were ongoing negotiations and the Opponents did not want to jeopardize the same by requesting for leave to file the further evidence earlier.

76. The Applicant submitted, at paragraph 53 of his written submission, that the further evidence relates to matters which may be considered relevant under the Opponents' pleaded ground of objection under Section 8(2)(b)[4]. Since this ground of objection was pleaded as early as 7 February 2014, the further evidence should and could have been adduced when the Opponents' evidence fell due (on 19 November 2015).

77. Further, the Applicant argued that the draft further evidence is merely intended to be exemplary demonstrations of the allegedly common practice of using a trade mark for both restaurant / café services and beverages and there is nothing to suggest that the above evidence could not have been adduced at an earlier stage such that this is not a case where the intended further evidence only became available after the close of evidence (paragraph 52 of his written submission).

78. I agree. However, it is noted that the Opponents also submitted, at paragraph 41 of their written submission, and emphasized, at the oral hearing, that it was recent changes to the Office of Harmonisation of the Internal Market[5] guidelines (OHIM Guide) which necessitated the filing of the further evidence at this late stage despite the fact that the further evidence sought to support Section 8(2)(b) which was pleaded at the beginning when the NOP was drafted and filed.

79. The recent changes to the OHIM Guide sought to demonstrate that based on current market reality, the Applicant's [Class 43] services are similar to the Opponents' goods (paragraph 41 of the Opponents' written submission). In this regard, the Opponents referred to the OHIM Guide, as dated 2 January 2014[6]:

> 5.5 Provision of food and drinks vs. food and drinks
>
> …The market reality shows that some producers of foodstuffs and / or drinks also provide restaurant services under their brand…however, this is *not* an established trade custom and rather applies to (economically) successful undertakings…

80. In contrast, the OHIM Guide as dated 2 January 2016[7] provides as follows:

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[4] It was also the Opponents' submission that the further evidence will also be relevant for Section 8(4) (which was proposed to be added) as well. However, since the request to include Section 8(4) has been refused (above), there is no need to discuss it here.

[5] Now known as European Union Intellectual Property Office. It is an agency of the European Union (EU) that administers the registration of EU trade marks and registered Community design.

[6] Tab 10, page 118 of the Opponents' bundle of authorities.

[7] Tab 10, page 131 of the Opponents' bundle of authorities. The OHIM Guide has been renamed as ***GUIDELINES FOR EXAMINATION OF EUROPEAN UNION TRADE MARKS EUROPEAN UNION***

5.5 Provision of food and drinks vs. food and drinks

…On the other hand, consumers may think that responsibility lies with the same undertaking if the *market reality* is that the provision of food and drinks and the manufacture of such goods are commonly offered by the same undertaking under the same trade mark…In such cases, there is a low degree of similarity…

[Emphasis as italicized mine]

81. The change in the OHIM Guide was published on 2 January 2016. By that time, parties would have been in negotiations, although the exact status of the negotiations is unclear (for example, whether the negotiations were active – see above). As mentioned above, active negotiations were ongoing between June – September 2015. Thereafter, around January 2016, there were some exchanges of settlement proposals between both parties' US counsel. The Opponents submitted that as at the point of submission of the written submission for this interlocutory hearing (14 October 2016), the Opponents were still considering the Applicant's proposal (paragraphs 24 and 25 of the Opponents' written submission).

82. I have already stated above that I am prepared to accept the Opponents' argument above that they were unable to request for the pleadings to be amended at various points in time during the opposition action due to the "settlement negotiations" (see above).

83. In light of the above, I am prepared to accept that this further evidence could not have been obtained as early as at the point of filing of the Opponents' evidence (19 November 2015) and subsequently at any point in time after 2 January 2016, including at the point of the PHR (14 March 2016), even though Section 8(2)(b) was pleaded and filed as early as 7 February 2014. The Opponents only sought to file the further evidence on 7 July 2016, one day before the written submissions and bundle of authorities were due for the full hearing.

84. Before I leave this ground, I caution that the above conclusion should not be taken as a conclusive indication that the OHIM Guide applies to the current case. All I am saying is that at first blush it would appear that the OHIM Guide (and thus the further evidence sought to be filed) *may* be of some persuasive value. Ultimately whether this is so will depend on a thorough analysis of the evidence and submissions of parties at the full hearing.

85. Last but not least, the Applicant relied on ***Harikat Singh*** in relation to this request to file further evidence. In light of the above discussion, ***Harikat Singh*** can be distinguished on the basis that:

    (i) the opponents in ***Harikat Singh*** could not point to any new development that triggered the investigations that led to the need for further evidence to be admitted; and

INTELLECTUAL PROPERTY OFFICE (EUIPO) (dated 23/03/2016). However the content of the specific section remains the same.

(ii) the opponents did not supply any reasonable explanation as to why they conducted the investigations at a very late stage.

(ii) Whether the further evidence is necessitated by the evidence filed by the other party

86. Having regard to the fact that the further evidence sought to be adduced is relevant to Section 8(2)(b), which was originally pleaded by the Opponents as early as 7 February 2014, it is not necessitated by the evidence filed by the Applicant.

(iii) Whether the other party would suffer any real prejudice which cannot be compensated with costs if the further evidence is allowed

87. In relation to this, the Applicant argued that the present matter has been ongoing for more than 2.5 years over which there were several exchanges of evidence between the parties. The Applicant submitted that it is now at an advanced stage of the matter and that the Applicant was led to believe that the existing evidence was all the evidence that the Opponents had wanted to rely on (paragraph 65 of the Applicant's written submission).

88. At the oral hearing, the Applicant referred to ***Harikat Singh***. The relevant paragraphs are paragraphs 5 and 6 and they have been discussed above in the context of the request to add Section 8(4). However, the context for the request to file further evidence is different. In particular, it is noted that:

(i) the scope of the further evidence sought to be adduced is explicit and is not extensive. Specifically, it relates to the issue of similarity between the Opponents' goods and the Applicant's Class 43 services (below);
(ii) the issue only pertains to a specific element in a ground which was originally pleaded, thus, the whole matter would not have to be backtracked to the pleadings stage;
(iii) neither would the matter have to be backtracked to the Applicant's evidence stage. Instead, the Applicant can be given a right of filing reply evidence, should he so wish. In this regard, the Applicant would be able to make any necessary adjustment to his evidence which had been previously filed at the same time;
(iv) any costs incurred in relation to the (potential) filing of a reply evidence would not be extensive;
(v) Any delay would also not be lengthy (below).

(There is some overlap between the issue of prejudice and substantiality of the proposed further evidence (below).)

89. In short, I am of the view that any prejudice caused to the Applicant is one which can be compensated by costs. On this note, it is also clear that the current case can be distinguished from the case of ***Autozone Parts, Inc v Autozone Automotive Enterprise*** [2013] SGIPOS 7 (Applicant's written submission at paragraph 52 albeit under factor (i) above).

(iv) whether allowing the further evidence will allow the substantial issues to be satisfactorily and fully considered and determined or whether the application is only a tactical manoeuvre and allowing the further evidence would result in prejudice to the other party

90. In relation to this factor, the Applicant argued at paragraphs 58 – 64 of his written submission that the further evidence sought to be adduced does not have an important influence on the case as they are not relevant to show the alleged similarity between the Opponents' goods and the Applicant's Class 43 services. The reasons are as follows.

91. The further evidence relates only to the businesses, goods and services of third parties and does not refer to the Opponents' goods whatsoever. Further, the examples fail to demonstrate the close relationship between the Opponents' goods and the Applicant's Class 43 services as they are not analogous to the Opponents' goods. The Opponents are an energy drink and beverage manufacturer and distributor such that the Opponents' main avenues of trade are primarily through third party retailers and to the best of the Applicant's knowledge, the Opponents do not operate any restaurants / cafés etc from which they sell their products.

92. The Applicant submitted that the examples provided by the Opponents (via the draft further evidence) are from companies which have a different business model and in particular, the examples relate to companies whose primary business model involves the operation of restaurant / café services from which they sell their products. One example is Starbucks, which operates cafés under the Starbucks brand and sells coffee through the cafés under the Starbucks brand.

93. On the other hand, the Opponents use a different business model. The Opponents are beverage manufacturers and distributors and the examples do not show that a manufacturer and distributor of beverages (in particular one that does not operate and has no intention to run any restaurant / café services) may operate restaurant / café services using the same mark as that used in relation to their beverages.

94. At the oral hearing, the Opponents argued that one of the examples provided in the draft further evidence, Haagen Daz (the draft further evidence is not paginated) started off as a manufacturer and then expanded to restaurant services.

95. My comments in relation to the Applicant's submissions above are as follows:

(i) it is not fatal to the Opponents' case that the examples sought to be adduced via the further evidence pertain only to the businesses, goods and services of third parties. This is because in relation to the issue of similarity of goods / services, both the *notional* and actual fair uses of the mark are relevant (see the Court of Appeal decision in ***Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide*** [2014] 1 SLR 911 ("***Staywell***") at [60]).

(ii) Further, from the Opponents' argument above and a cursory review of the OHIM Guide as well as the draft further evidence, it is an open argument if an analogy can be drawn from the examples tendered in the further evidence to the current case. In addition, with regard to the relevant classes which relate to beverages[8], for example, Class 32, there is no distinction drawn between a retailer versus a manufacturer / distributor of such beverages. Class 32 simply provides the types of beverages for which a mark can be registered.

[8] For the full list of the Opponents' earlier marks and the relevant classes they are registered for, see the schedule attached to the NOP.

96. The issue of similarity of goods / services is one of relative importance in the context of the objection under Section 8(2)(b). This is so in light of ***Staywell*** where it was clarified that the correct approach for the purposes of the application of Section 8(2)(b) is a step-by-step approach:

> [19]…A productive and appropriate application of the step-by-step approach necessitates that the court reach a *meaningful conclusion at each stage* of the inquiry…

[Emphasis as italicized mine.]

This means that it is of importance to establishing the ground of objection under Section 8(2)(b), if a party can show that the goods / services of the marks are similar.

97. In light of the above, I agree with the Opponents that this issue should be allowed to be properly and fully considered in the context of Section 8(2)(b) (paragraph 39 of the Opponents' written submission).

(v) the stage of the proceedings at which the further evidence is sought (e.g. at the Pre-Hearing Review in contrast to one day before the hearing), considerations of disruption to proceedings and extra costs generated by the delay being relevant.

98. In relation to this factor, the Applicant also relied on ***Harikat Singh*** (see above), while the Opponents also sought to similarly distinguish the case with the same reasoning, that is, that the delay in the current case is not as extensive as that in ***Harikat Singh***.

99. My comments in relation to the application of ***Harikat Singh*** in relation to this factor remain largely the same, that is:

(i) the delay in the current case is not as extensive as that in ***Harikat Singh*** and that ***Harikat Singh*** is a rather unusual case where the hearing date was postponed 3 times;
(ii) in general, parties are expected to raise any request for the filing of any further evidence (in this context) at the PHR (in fact, it is noted that the Applicant previously requested for leave to file further evidence at the PHR[9]).

100. However, in the context of the request to file further evidence, it is noted that the change in the OHIM Guide occurred on 2 January 2016 and that between this date through to the PHR (14 March 2016) and ultimately on the date when the request was made (7 July 2016), there was some form of negotiations (although it is unclear as to the exact status of such negotiations (above)). Thus the only possible issue which the Opponents could be "faulted" in relation to this factor is that there is a delay of about one month, from the date when the Registrar issued the notice to set the date for the hearing (8 June 2016), to the date when the request to file further evidence was made (7 July 2016).

101. It is to be recalled that Circular **1/2011** provides:

[9] This was granted as the Opponents consented to the same subject to having a right of reply.

> All relevant factors will be considered, *though the main weight is attached to the desirability of having the substantial issues satisfactorily and fully considered* and determined. However, this factor may be outweighed by the totality of the other factors in certain cases.
>
> [Emphasis as italicized mine]
>
> Specifically, I am of the view that in the current case, the above factor is *not* outweighed by the totality of the other factors.

102. In light of the above, the request to file further evidence is allowed.

103. The Opponents are to file their further evidence as per the draft submitted on 18 July 2016 within **1 month** from the date of this decision. The Applicant may, if he so wishes, file his reply evidence to the same within **2 months** from the date of receipt of the Opponents' further evidence.

104. With regard to costs, it is noted that only the Applicant made submission in relation to the same (paragraph 66 of the Applicant's written submission). The Opponents had indicated via their letter of 17 November 2016 that they make no submission as to costs. In light of the above, costs are awarded to the Applicant as follows:

Costs Awarded to the Applicant		
S/N	**Description**	**Amount Awarded**
1	Preparing for all interlocutory proceedings	$450
2	Attending all interlocutory proceedings	$300
3	Preparing further evidence in reply	Quantum to be decided upon receipt of the reply evidence[10]
Total		**$750**

Such costs are to be paid by the Opponents to the Applicant within **1 month** from the date of this decision.

Legislation discussed:

Rules of Court (R 5, Cap 322, Rev Ed 2014) Order 20

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

Trade Marks Rules (Cap 332, Rev. Ed. 2008), Rule 35, Fourth Schedule

HMG Circulars **2/2010** and **1/2011**

Cases referred to:

[10] The Registrar will make further directions as to the payment of this specific item upon receipt of the reply evidence.

J.E. Borie SA v MHCS [2013] SGIPOS 4
Wright Norman v OCBC [1994] 1 SLR 513
Branov v Sleep Better Bedding Mfg Pty Ltd 32 IPR 171
Avtar Singh and Harikat Singh trading as Aero Club v Timberland Company [2011] SGIPOS 4
Hunt-Wesson Inc.'s Trade Mark Application [1996] RPC 233
Ketteman v Hansel Properties Ltd [1987] A.C. 189
Chwee Kin Cheong v Digilandmall.com [2005] 1 SLR(R) 502
A.T.X. International, Inc. v SGP International Enterprise [2016] SGIPOS X
Autozone Parts, Inc v Autozone Automotive Enterprise [2013] SGIPOS 7
Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide [2014] 1 SLR 911

Representation:

Ms Lim Siau Wen (Drew & Napier LLC) for the Opponents (Appellants)
Mr Melvin Pang (Amica Law LLC) for Applicant (Respondent)