

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

Trade Mark Nos. 40201606062U and 40201606064Y
Hearing Date: 19 November 2018

**IN THE MATTER OF TRADE MARK REGISTRATIONS IN THE NAME OF
NAVIN TRADING PTE LTD**

AND

**APPLICATIONS FOR DECLARATIONS OF INVALIDITY THEREOF BY
MAHENDRA NAIDU A/L R. MANOGARAN TRADING AS SRI SAI TRADERS**

Hearing Officer: Ong Sheng Li, Gabriel
Principal Assistant Registrar of Trade Marks

Representation:

Mr G Radakrishnan (Grays LLC) for the Applicant

Mr Sudeep Kumar (S K Kumar Law Practice LLP) for the Registrant

GROUND OF DECISION

Introduction

1 Before this tribunal are two trade mark invalidation actions that have been consolidated. They were commenced by Mahendra Naidu A/L R. Manogaran trading as Sri Sai Traders (“Applicant”) on 12 May 2017 against the following registered trade marks owned by Navin Trading Pte Ltd (“Registrant”).



- a. (Trade Mark No. 40201606062U) in Classes 29 and 30 (“62U”); and



- b. (Trade Mark No. 40201606064Y) in Classes 29 and 30 (“64Y”).

For convenience, I refer to 62U and 64Y collectively as the “Subject Marks”.

2 The Subject Marks were applied for on 4 April 2016, and are registered in respect of the following goods:

Class 29

Cooking oils; Dried pulses; Canned pulses; Pulses (for food); Pulses (foodstuffs).

Class 30

Spices; Spice mixes; Spice mixes; Spiced salt; Curry spices; Pizza spices; Pepper spice; Curry [spice]; Baking spices; Curry [spice]; Curry [spice]; Baking spices; Edible spices; Cloves [spice]; Spice extracts; Cloves [spice]; Ginger [spice]; Ginger [spice]; Ginger [spice]; Cloves [spice]; Cinnamon [spice]; Cinnamon [spice]; Cinnamon [spice]; Spice preparations; Food pastes (spices); Ginger puree [spice]; Curry powder [spice]; Clove powder [spice]; Caraway seeds (spice); Pepper powder [spice]; Mustard powder [spice]; Mustard powder [spice]; Cinnamon powder [spice]; Hot pepper powder [spice]; Hot pepper powder [spice]; Bread flavored with spices; Marinades containing spices; Bread flavoured with spices; Spices in the form of powders; Processed grains; Grain-based chips; Toasted grain flour; Processed grains for use in food; Snack foods prepared from grains; Snack foods consisting principally of grain; Snack bars containing grains (confectionery); Processed grains for food for human consumption; Snack bars containing a mixture of grains, nuts and dried fruit (confectionery); Flour; Flour; Flour; Rye flour; Rye flour; Nut flours; Nut flours; Soya flour; Nut flours; Rice flour; Cake flour; Corn flour; Rice flour; Soya flour; Soya flour; Corn flour; Soya flour; Rice flour; Corn flour; Nut flours; Wheat flour; Maize flour; Wheat flour; Flour mixes; Maize flour; Rice; Rice; Rice; Rice; Liquorice; Rice cakes; Rice flour; Rice cakes; Rice crust; Rice cakes; Fried rice; Rice chips; Rice flour; Rice flour; Brown rice; Rice mixes; Rice cakes; Cooked rice; Cooked rice; Rice sticks; Puffed rice; Puffed rice; Husked rice; Puffed rice; Husked rice; Rice salads; Steamed rice; Rice tapioca; Creamed rice; Instant rice; Rice pudding; Rice pudding; Rice pudding; Rice pudding; Steamed rice; Flour of rice; Rice biscuits; Rice crackers; Rice crackers; Wholemeal rice; Flavoured rices; Stir-fried rice; Sauces for rice; Puto [rice cake]; Edible rice paper; Suman [rice cake]; Rice starch flour; Edible rice paper; Dried cooked-rice; Edible rice paper; Tupig [rice snack]; Natural rice flakes; Frozen prepared rice; Lemang [cooked rice]; Espasol [rice cakes]; Bibingka [rice cake]; Prepared rice dishes; Wild rice (prepared); Rice-based snack food; Rice-based snack food; Rice-based snack food; Onde-onde [rice cake]; Taperr [rice dessert]; Rice-based foodstuffs; Pulut [glutinous rice]; Rice crackers [senbei]; Rice products for food; Kheer mix (rice pudding); Wajid [sticky rice cake]; Kra-ya-sart [rice snack]; Enriched rice [uncooked]; Liquorice [confectionery]; Lort [rice flour dessert]; Gimbap [Korean rice dish]; Muruku [rice flour snack]; Gimbap [Korean rice dish]; Gimbap [Korean rice dish]; Liquorice [confectionery]; Liquorice [confectionery]; Pounded rice cakes (mochi); Rice-based pudding dessert; Artificial rice [uncooked]; Lupis [glutinous rice cake]; Bubur Sum-sum [rice pudding]; Putu Mayam [rice flour cake]; Fermenting malted rice (Koji); Putu mayang [rice flour cake]; Rice pulp for culinary purposes; Rice pulp for culinary purposes; Stick liquorice [confectionery]; Stick liquorice [confectionery]; Rice pulp for culinary purposes; Stick liquorice [confectionery]; Liquorice flavoured confectionery; Extruded food products made of rice; Chinese rice noodles (bifun, uncooked); Dodol [snack food made from

rice flour]; Snack foods consisting principally of rice; Kalamay [dessert containing glutinous rice]; Ampiang [traditional glutinous rice crisps]; Flour for making dumplings of glutinous rice; Rice prepared for food for human consumption; Prepared meals containing (principally) rice; Lontong [prepared meal predominantly of rice]; Nasi kapau [prepared meal predominantly of rice]; Cooked rice mixed with vegetables and beef (bibimbap); Cakes of sugar-bounded millet or popped rice (okoshi); Kror-lan [prepared meal predominantly consisting of rice]; Nasi Uduk [prepared meals consisting predominately of rice]; Galamai [Sumatran dodol being snack food made from rice flour]; Nasi Lemak [prepared meals consisting predominately of coconut rice]; Phad-Thai [prepared meals consisting predominantly of rice noodles]; Pre-packaged lunches consisting primarily of rice, and also including meat, fish or vegetables.

In case it is not immediately apparent, the sole difference between 62U and 64Y is that the key portion of the latter trade mark is spelt “SREE” whereas the former is spelt “SHREE”.

Background and procedural history

The Applicant

3 The Applicant is based in Johor, Malaysia. It is a sole-proprietorship in the business of manufacturing, packing and selling goods in Malaysia and Singapore under the trade marks “SHREE” and “SHREE GOLD”. (The Applicant uses “SHREE” in block letters as well as in stylised form, as in the following example: “”. Sometimes other colours are used, but the “S” is always stylised in the same way. The word “GOLD”, however, is never stylised and is always used in block letters.)

4 On 12 May 2017, the Applicant filed for a declaration of invalidity in respect of the Subject Marks. The following 3 grounds of invalidation were pleaded.

- a. Bad faith under Section 23(1) read with 7(6) of the Trade Marks Act (Cap. 332, Rev. Ed. 2005) (“TMA”);
- b. Passing off under Section 23(3)(b) read with 8(7)(a) TMA; and
- c. Fraud or misrepresentation under Section 23(4) TMA.

The Registrant

5 The Registrant was incorporated in Singapore on 31 March 2016. Four days after it was incorporated, it applied to register the Subject Marks.

Evidence

6 Evidence is usually filed sequentially in trade mark invalidation proceedings. The party who brought the action goes first. Thereafter, it is the trade mark proprietor’s turn.

- 7 The following Statutory Declaration(s) (“SD(s)”) were filed in support of the Applicant.
 - a. SD of Mr Mahendra Naidu A/L R. Manogaran (i.e. the individual who is the sole proprietor of the Applicant). His SD formed the bulk of the Applicant’s evidence

in these proceedings. I will return to his evidence, where relevant and necessary, later in this decision.

- b. SD of Mr Arumugam Veeramani, a director of Selvi Mills (S) Pte Ltd and Selvi Store Trading Pte Ltd. These two companies are related to a third company: Selvi Stores Pte Ltd. In his SD, he testified to the fact that the three Selvi companies had bought the Applicant's "SHREE" or "SHREE GOLD" goods. These goods were purchased either directly from the Applicant or through the Applicant's distributor in Singapore: Sri Sai Traders Pte Ltd.
- c. SD of Mr Kalai Meyappan Ramalingam, a director of Sri Murugan Manufacturing Pte Ltd and Sri Murugan Trading Pte Ltd. He was also previously a director of Sri Murugan Stores Pte Ltd (which later changed its name to Krishna Stores Pte Ltd following a change in ownership). In his SD, he testified to the fact that the three Sri Murugan companies had bought the Applicant's "SHREE" or "SHREE GOLD" goods from the Applicant. He also corroborated key aspects of Mr Mahendra Naidu A/L R. Manogaran's evidence relating to bad faith.

8 The Registrant did not file its evidence in support of the Subject Marks. After the Registrant's deadline to file evidence had passed, the Registrar noted the default and notified the parties that as a consequence the Registrant would be treated, under rule 59(2)(d) as read with rule 31A(9) of the Trade Marks Rules (Cap. 332, R1) ("TMR"), as having admitted to the facts alleged by the Applicant. (For another recent decision where this rule came into play, see *Inner Mongolia Little Sheep Catering Chain Co. Ltd. v Grassland Xiao Fei Yang Pte Ltd* [2018] SGIPOS 6 at [33].)

The interlocutory application

9 64 days after the Registrant's deadline to file evidence, the Registrant's agents, S K Kumar Law Practice LLP, applied for an extension of time in an attempt to remedy the situation. Filed together with the request was an affidavit of Mr Dhanwant Singh, an advocate and solicitor in the firm (S K Kumar Law Practice LLP) who acted for the Registrant. In his affidavit, Mr Singh did not dispute that the Applicant's evidence had been served on the Registrant's agents. However (according to Mr Singh), no action was taken, as the SDs were "*not sighted as the receiving clerk had misfiled the documents*".

10 Naturally, the Applicant objected to the Registrant's out-of-time request for an extension of time to file evidence. After consideration, I issued a preliminary view: that the request should be refused. As it did not agree with my preliminary view, the Registrant requested for an interlocutory hearing. The Applicant filed written submissions but the Registrant did not.

11 Regrettably, the Registrant's representatives arrived almost 45 minutes late for the interlocutory hearing. The Applicant's counsel, Mr G Radakrishnan, had been kept waiting all this time. When counsel for the Registrant, Mr Sudeep Kumar, finally appeared, he was accompanied by Mr Steven Roy, a paralegal. Mr Dhanwant Singh did not attend. Mr Kumar apologised and explained that they had been in a court hearing that had taken longer than expected. I gave directions for the hearing to proceed.

12 In the course of the interlocutory hearing, Mr Roy identified himself as the paralegal who was assisting with the Registrant's case. He sought leave to address this tribunal. Given the

circumstances (and since he appeared to have first-hand knowledge of what had transpired), I permitted him to speak.

13 Mr Roy's account of the facts was broadly aligned with that which was set out in Mr Singh's affidavit. I asked Mr Roy a number of questions with a view to understanding more about what had happened. In the ensuing exchange, Mr Roy made a number of statements concerning matters not touched upon by Mr Singh in his affidavit. Among them were the following: (a) Mr Roy was away on his yearly vacation when the Applicant served its evidence in December 2017; (b) the receiving clerk had taken the hard copies of the Applicant's evidence and placed them together with some old files; and (c) Mr Roy did not have sight of the Applicant's evidence but maintained that if he had seen it, he would have definitely done "*what was necessary*".

14 Mr Roy said various other things, but I need only highlight one critical point. After the filing of the Applicant's evidence, the Registrar issued a letter, by post, which: (a) confirmed that the Applicant's evidence was accepted; and (b) reminded the Registrant of its deadline to file evidence (which by that time was still more than 10 weeks away). When asked whether he had seen the Registrar's letter in question, Mr Roy acknowledged that he had, but "*did not think much of it*". Given that the Registrar's letter bore the following caption in bold and uppercase: "ACCEPTANCE OF EVIDENCE FILED BY INITIATOR", I found this explanation to be surprising as well as severely lacking.

15 After hearing parties, I took time for consideration and issued my interlocutory decision by way of letter. In short, I decided to refuse the Registrant's request to file its evidence out-of-time, and awarded costs to the Applicant. A brief outline of my reasons is set out in paragraphs [16] – [18] below. For completeness, I should add that the Registrant did not challenge my interlocutory decision.

Brief outline of reasons for refusing the interlocutory application

16 It is clear that the Registrar has no power to grant the Registrant an out-of-time extension of time request to file evidence on these facts (see *SOS International A/S v AEA International Holdings Pte Ltd & Anor* [2011] SGIPOS 10). However, there is authority (see *Distileerderij En Likburstokerij Herman Jansen B.V. v Tilaknagar Industries Ltd* [2013] SGIPOS 3 at [4] which referred to an unreported decision of the High Court in OS 601099 of 2001 (Trade Mark Application No. 10300/98)) for the proposition that the Registrar may, under rule 83 TMR, allow out-of-time requests to file pleadings (and by extension, evidence). Rule 83 TMR reads as follows:

"83. 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."

17 The cases clearly establish that the Registrar's power under rule 83 TMR to correct irregularities in procedure is to be exercised sparingly and in exceptional cases or where good reasons exist. In exercising his discretion, the Registrar must balance the potential prejudice to the party in default as against the other side's legitimate expectation that contentious proceedings will be dealt with in accordance with the rules of procedure. A party in default generally cannot rely on his own poor conduct (whether due to the acts or omissions of his solicitors/agents or otherwise) as the sole reason for the Registrar to correct the irregularity in

procedure. One relevant consideration is the length of delay in seeking the extension of time. (Out-of-time requests for an extension of time to file counter-statements were refused in *The East India Company Holdings Pte Ltd v Metrojaya Bhd. and anor* [2015] SGIPOS 16 and *Kok Han Marketing Services v Sing Brothers Hardware Pte Ltd* [2002] SGIPOS 11. In the former, the missed deadline was attributed to staff movements as well as the trade mark agent's change in address. In the latter, the paralegal went on leave after seeing the notice of opposition and the lawyer was unable to get a response from the client who was not in Singapore.)

18 In the present case, the Registrant's failure to comply with the deadline to file evidence was attributed primarily to misfiled documents by a receiving clerk in the employ of S K Kumar Law Practice LLP. And, for whatever reason, the paralegal, Mr Roy, did not act upon the Registrar's letter (see [14] above) despite having seen it. On the other hand, the Applicant had done all that was necessary to comply with the relevant timelines. It had a legitimate expectation that the Registrant should also be required to play by the same set of rules. In the premises, this was, in my judgment, not an appropriate case in which to exercise the Registrar's power under rule 83 TMR to correct irregularities.

Opposition action discontinued

19 At this juncture it is convenient to mention that in addition to the invalidation proceedings against the Subject Marks, the Applicant also launched a third action at the same time: a trade



mark opposition against the Registrant's application to register "SHREE GOLD" (Trade Mark No. 40201701747V) in Classes 1, 3 and 4 ("47V"), filed on 1 February 2017, for the following goods:

Class 01

Borneol.

Class 03

Incense; Incense cones; Incense sticks; Perfume water; Perfume oils; Perfumed powder; Bath oil; Rose oil for cosmetic purposes; Incense sachets; Fumigating incenses (Kunko); Incense sachets.

Class 04

Lamp oil; Lamp oils; Lamp wicks; Wicks for oil lamps; Wicks.

20 Initially, all three actions were consolidated. This meant, among other things, that parties needed to only file one set of evidence (instead of three), and comply with only one set of timelines. (For this reason, some of the Applicant's evidence concerned goods in other classes bearing the SHREE or SHREE GOLD marks e.g. sambrani or incense in Class 03.)

21 However, the Registrant's failure to file evidence (in respect of all three actions) and my subsequent interlocutory decision (wherein I refused to allow the Registrant to file evidence out-of-time) meant that the Registrant was treated as having withdrawn the application for 47V (see rule 31A(9) TMR). Correspondingly, the opposition action was discontinued.

Pre-hearing review and the hearing

22 After I issued my interlocutory decision, the parties were directed to attend a further pre-hearing review (PHR) in respect of the consolidated invalidation actions. Mr Radakrishnan appeared for the Applicant, but none of the Registrant’s representatives attended. The further PHR proceeded in the Registrant’s absence. It was necessarily brief: since the Registrant was not present and the Applicant had no real alternative but to proceed with the hearing, I informed Mr Radakrishnan that the Registrar would proceed to fix a date in due course.

23 After the further PHR, a Registrar’s Notice was issued informing the parties of the hearing date as well as the date on which written submissions were to be filed. The Applicant duly filed its written submissions by the deadline, but the Registrant did not. Initially, it was unclear whether the Registrant’s legal representatives would be attending the hearing. However, a few days before the hearing was scheduled to be heard, the Registrant filed its written submissions (late), and requested for an adjournment of the hearing on the basis that Mr Dhanwant Singh would be unavailable due to bereavement reasons. Mr Radakrishnan agreed. The hearing was deferred by a week.

24 At the final hearing, Mr Kumar explained that Mr Singh was still unable to attend the hearing, and so he would be arguing the case instead. Mr Radakrishnan raised a number of objections, chief among them the fact that the Registrant’s written submissions contained and referred to documents of an evidential nature. I assured Mr Radakrishnan that I would not take into account the improperly introduced documents and statements.

25 When Mr Radakrishnan had finished making his oral submissions, I asked Mr Kumar whether he had any arguments to make given that his client had filed no evidence in the proceedings. Quite understandably, he struggled to do so: the lack of evidence meant that his hands were tied. Ultimately, he fell back on the general submission that the Applicant had not proved its pleaded grounds.

26 After consideration, I have arrived at the conclusion that the Subject Marks ought to be declared invalid. My detailed reasons are set out below.

MAIN DECISION

Section 23(1) read with 7(6) TMA

The law

27 The leading case on the Section 7(6) TMA ground is the Court of Appeal’s decision in *Valentino Globe BV v Pacific Rim Industries Inc* [2010] 2 SLR 1203 (“*Valentino*”). A restatement of the key principles in *Valentino* is set out below.

- a. Once bad faith is established, the application for registration of a mark must be refused (or in this context: the application for invalidation must be allowed) even though the mark would not cause any confusion. (*Valentino* at [20] referring to *Rothmans of Pall Mall Ltd v Maycolson International Ltd* [2006] 2 SLR(R) 551 at [29] and *Tan Tee Jim SC, Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell Asia, 2nd Ed, 2005) at para 5.71.)

- b. The legal burden of proof needed to substantiate an action on this ground lies on the party bringing the application (here: Applicant). (*Valentino* at [21] referring to *Wing Joo Loong Ginseng Hong (Singapore) Co Pte Ltd v Qinghai Xinyuan Foreign Trade Co Ltd* [2009] 2 SLR(R) 814 (“*Wing Joo Loong*”) at [33].) (See also *Montford Services Sdn Bhd v USA Pro IP Limited* [2018] SGIPOS 3 at [13] which makes it clear that the applicable standard of proof is the civil standard—i.e. on a balance of probabilities.)
- c. Bad faith embraces not only actual dishonesty but also dealings which would be considered as commercially unacceptable by reasonable and experienced persons in a particular trade, even though such dealings may otherwise involve no breach of any duty, obligation, prohibition or requirement that is legally binding upon the registrant of the trade mark. (*Valentino* at [28] referring to *Weir Warman Ltd v Research & Development Pty Ltd* [2007] 2 SLR(R) 1073 at [48].)
- d. The test for determining the presence of bad faith is a “combined” one, in that it contains both a subjective element (*viz.*, what the particular applicant knows) and an objective element (*viz.*, what ordinary persons adopting proper standards would think). Bad faith as a concept is context-dependent. In the final analysis, whether bad faith exists or not hinges on the specific factual matrix of each case. (*Valentino* at [29] referring to *Wing Joo Long* at [105] – [117].)
- e. An allegation of bad faith is a serious claim to make and it must be sufficiently supported by the evidence, which will rarely be possible by a process of inference. (*Valentino* at [30] referring to *Nautical Concept Pte Ltd v Jeffery Mark Richard and anor* [2007] 1 SLR(R) 1071 at [15].) (However, as observed in Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Second Edition) Sweet & Maxwell 2014 at [21.4.1] (“*Law of Intellectual Property of Singapore*”), footnote 109, this does not mean that there is an absolute prohibition against drawing inferences. In support of this observation, Professor Ng-Loy cited the decision in *Festina Lotus SA v Romanson Co Ltd* [2010] 4 SLR 552 (“*Festina*”) at [115], where the High Court pointed out that a finding of bad faith was largely, if not invariably, based on circumstantial evidence.)

28 The general rule that bad faith can exist even where there is no likelihood of confusion does not mean that the issue of resemblance between the two competing trade marks is completely irrelevant to the bad faith inquiry. Resemblance between the marks has some relevance because the notion of bad faith cannot be decided in a vacuum; it has to be decided in the context of some link or nexus between the parties in dispute. (*Law of Intellectual Property of Singapore* at [21.4.7] citing *Festina* at [115].)

29 A relevant factor when determining whether there was bad faith is whether there has been a failure by the trade mark applicant (here: Registrant) to address the allegation of bad faith. (*Tan Tee Jim SC, Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell, Third Edition, Vol. 1, 2014) at para. 7.194, point (14).) For an example of a case where this factor, *inter alia*, was taken into account, see *PT Swakarya Indah Busana v Dhan International Exim Pte Ltd* [2010] 2 SLR 109 (“*PT Swakarya*”) at [90].

30 It is well established that the relevant time for determining whether there is bad faith is the time of filing the application for registration. (See *Leonid Kovalkov v Tan Siew Keng Angeline* [2016] SGIPOS 10 at [29], wherein the learned IP Adjudicator cited *Kerly's Law of Trade Marks and Trade Names* (15th Ed) (Sweet & Maxwell, 2011) at [8-263], which referred in turn to the decision of the European Court of Justice in *Chocoladefabriken Lindt & Sprungli AG v Franx Hauswirth GmbH* (C-529/07) for this proposition.)

31 However, the rule that bad faith must be assessed as at the time of filing the application for registration does not exclude the consideration of matters which occurred after the date of application; they may assist in determining the applicant's state of mind at the date of registration. (*PT Swakarya* at [91] citing *Ferrero SpA's Trade Marks* [2004] RPC 29 and *Tesco Stores Ltd's Trade Mark Applications* [2005] RPC 17.)

Relevant facts

32 Since the Registrant did not file any evidence, the facts set out below are based on the Applicant's SDs on which the deponents have not been cross-examined.

33 The Applicant's business was registered in Malaysia in 1995. The Applicant owns the following registered trade marks in Malaysia:

<u>S/N</u>	<u>Mark</u>	<u>Class / Specification</u>	<u>Reg. Date</u>
1	 Reg. No. 09021327	Class 30 Coffee, tea, rice flour, atta flour, muruku flour, omapodi flour, gram dhal flour, instant cake flour, green pea flour, black pea flour, meat curry powder, fish curry powder, vegetable curry powder, kuruma curry powder, sambar powder, rasam powder, chilli powder, coriander powder, turmeric powder, fennel seed powder, cumin powder, pepper, various spice powders, tomato sauce, chilly and rice crispy, pastry, sweets; spices; all included in class 30	3 Dec 2009
2	 Reg. No. 09021324	Class 29 Cooking oil; pulses-toor dhal; urid dhal; pickles; coconut oil; corn oil; ghee; preserved dried and cooked fruits and vegetables; edible oils and fats; fruit sauces; canned fruits; canned vegetables; meat eggs canned meat; butter; all included in class 29	3 Dec 2009
3	 Reg. No. 09021326	Class 03 Incense sticks, incense, incense oil; scented oil, scented wood; cosmetics; cleansing creams and lotions for the skin and face, astringent lotions, moisturisers, face and body emulsions, skin care preparations, skin creams and lotions, massage creams, make-up preparations; beauty preparations, perfumes, perfumery, essential oils, shampoos, soaps;	3 Dec 2009

		preparations for the hair and teeth, dentifrices; hair oil, hair sprays, hair lotions; bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations; all included in class 3	
4	SHREE Reg. No. 08008141	Class 35 The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail outlet, wholesale outlet, departmental store and internet website; advertising; business management; business administration; retailing services connected to praying items, cigars, cosmetics and spices; direct product marketing, marketing agency services, marketing consultancy, recruitment services for sales and marketing personnel, research services relating to marketing, distribution of advertising brochures and leaflets, distribution of prospector, distribution of sample materials; all included in class 35.	28 Apr 2008

34 In its early days, the Applicant sold goods bearing the trade marks “SHREE” and “SHREE GOLD” (usually in stylised form, but sometimes appearing in block letters) in various states in Malaysia. These goods were, in essence, Indian provision goods and prayer items. They included the following: (a) edible or cooking oils (e.g. coconut oil) and other foodstuff such as pickles and dates (that is, Class 29 goods); (b) honey, flour, spices and powders (that is, Class 30 goods); and (c) incense, non-medicated oils, cosmetics, face powders and skin care preparations, prayer oils and prayer goods (that is, Class 03 goods). To prove that it had used these marks long before the relevant date, the Applicant tendered, among other things, copies of invoices and delivery orders (dated from November 2013 to January 2014) from Lian Ting Sdn Bhd in Johor, Malaysia. These documents showed that the Applicant had ordered product labels which were to bear the marks “SHREE” and “SHREE GOLD”.

35 Later on, the Applicant also started selling its goods to Singapore. The “SHREE” goods sold in Singapore were primarily fragrances and incense (including sambirani), mouth freshener, and herbal powders (i.e. Class 03 goods) and vanaspathi or vegetable oil (i.e. Class 29 goods). As for “SHREE GOLD”, this mark was used mainly in relation to coconut oil (i.e. Class 29 goods) and turmeric powder (i.e. Class 30 goods). These goods were purchased by locals or expatriates in the Indian community, primarily in or around Tekka market.

36 According to the Applicant, its “SHREE” and “SHREE GOLD” goods were distributed and sold in Singapore to end-consumers through various middlemen such as: (a) Mohamed Mustafa & Samsuddin Co Pte Ltd; (b) Sri Murugan Manufacturing Pte Ltd; (c) Selvi Store; (d) Selvi Store Trading; (e) Sri Ambal Provision Store; (f) Thandapani & Co; (g) Vasu Bangles Store; and (h) Komala Vegetable Mart. The Applicant’s evidence was buttressed by SD evidence from two individuals, namely: Mr Arumugam Veeramani and Mr Kalai Meyappan Ramalingam (see [7] above). Exhibited to Mr Arumugam Veeramani’s SD were invoices that proved that Selvi Store had purchased “SHREE” sambirani as far back as 8 April 2010 and “SHREE GOLD” coconut oil as far back as 30 August 2012. Exhibited to Mr Kalai Meyappan Ramalingam’s SD were invoices showing that Sri Murugan Manufacturing or its related

companies had purchased “SHREE” or “SHREE GOLD” goods originating from the Applicant as far back as 24 May 2012. In other words, these products were on the market some years before the Registrant applied to register the Subject Marks in Singapore.

37 Given the relatively inexpensive nature of the goods and their nature (being aimed at a very specific clientele), the Applicant did not advertise directly. Instead, it relied primarily on custom and word of mouth for its sales. All things considered, the Applicant had a respectable, if modest, business in Singapore selling goods under the “SHREE” and “SHREE GOLD” marks. Its sales figures in Singapore from 2013 to 2017 (supported by a random sampling of invoices) were as follows (older figures were not available):

Year	Sales (in SGD) for “SHREE” products	Sales (in SGD) for “SHREE GOLD” products
2013	54 732	22 577
2014	55 159	27 435
2015	42 688	44 520
2016	25 686	37 939
2017 (up to Nov)	32 458	36 827

38 However, due to stiff competition, the Applicant did (and does not) sell its full range of “SHREE” and “SHREE GOLD” products in Singapore although its intention was to do so sometime in the future.

39 Enter the Registrant. Based on records extracted from the register maintained by the Accounting and Corporate Regulatory Authority, the Registrant was incorporated in Singapore on 31 March 2016, four days before it applied to register the Subject Marks. The Registrant has two directors who are also shareholders. The registered address of the Registrant is also the residential address of its two director-shareholders (who appear to be related by family).

40 One of the Registrant’s director-shareholders, Mr R Subaschandra Boss (“Boss”), was no stranger to the Applicant’s “SHREE” and “SHREE GOLD” products. According to Mr Kalai Meyappan Ramalingam, prior to the incorporation of the Registrant, Boss used to be employed as a sales manager by his company from 2012 to February 2016. The former also testified to the fact that in the course of Boss’ work, Boss would have arranged for the purchase of “SHREE” and “SHREE GOLD” products from the Applicant.

41 Notably, Boss knew Mr Mahendra Naidu A/L R. Manogaran (“Mahendra”) personally. The former used to contact the latter directly to place orders for the Applicant’s goods, including “SHREE” and “SHREE GOLD” products. Mahendra even had Boss’ mobile phone number. It is clear that prior to the registration of the Subject Marks, Boss knew of the Applicant’s business, the goods it sold in Singapore, and its trade marks (including “SHREE” and “SHREE GOLD”).

42 Sometime before 4 April 2016, Boss contacted Mahendra and asked the latter to send him photographs of the Applicant's products. Boss said that he would help promote these products in Singapore. On 4 April 2016, at 12.28pm, Mahendra sent Boss pictures of some of the Applicant's products via WhatsApp, including the Applicant's "SHREE GOLD" cooking oil. Unknown to Mahendra at that time, on that very same day, the Registrant applied to register the Subject Marks in Singapore.

43 On 11 July 2016, Boss requested to meet with Mahendra. Subsequently, a meeting was arranged and the two met in Johor sometime in July 2016. They discussed business and Boss stated, among other things, that he wanted to start a business of his own in Singapore which entailed selling his own goods as well as the Applicant's "SHREE" and "SHREE GOLD" products. Boss also asked for help in designing the packaging of his goods. Mahendra gave Boss the contact number of the Applicant's designer and asked him to contact the designer directly. During this same visit, Boss also revealed to Mahendra that he had registered "SHRI GOLD", a different mark from "SHREE GOLD", in Singapore. Mahendra was troubled, but did not take issue at the time. (During the hearing, Mr Radakrishnan submitted that in considering this, I should bear in mind that Mahendra is a layperson who may not have fully appreciated the significance of what he had just been told. The point is a fair one, and I do not think that anything turns on the fact that no objections were raised then.)

44 In late 2016, Mahendra discovered that the Registrant was selling sambirani (incense) bearing the mark . He later found out that the Registrant was Boss' company. Understandably, Mahendra was upset about this.

45 In January 2017, Mahendra called Boss to ask why he had registered "SHREE GOLD" in Singapore. According to Mahendra, Boss' reply was that since the Applicant did not register the trade mark in Singapore and since it was he who had the registration, the trade mark belonged to him.



46 On 1 February 2017, the Registrant applied to register  in respect of even more goods. This application (47V), filed on 1 February 2017, was for goods in Classes 01, 03 and 04. (This was the mark that was later treated as withdrawn: see [19] – [21] above.)

47 On 16 February 2017, the Applicant applied to register the following trade marks in Singapore. Ostensibly, this decision was triggered by the conversation between Mahendra and Boss in January 2017:

<u>S/N</u>	<u>Application Mark</u>	<u>Class / Specification</u>
1	SHREE GOLD App. No. 40201702568Y	Class 03 incense; incense sticks; incense cones; non-medicated oils; cosmetics; face powders; skin care preparations. Class 29

		cooking oils; dhals; pickles; dates; ghee; vegetable oils; sunflower oil; coconut oil; soya oil; sesame oil. Class 30 honey; rice flour; wheat flour; atta flour; spices; spice mixes; spice powders; flour.
2	SHREE App. No. 40201702567W	[Same as above]

The above applications remain pending.

48 On 4 July 2017, Mahendra asked one of the Applicant’s employees, Vinoth, to call Boss in relation to certain unpaid invoices. A recording was made and the conversation was transcribed and exhibited in evidence. In the course of their conversation, the topic of trade marks came up. Vinoth expressed disappointment that despite their previous close business

relationship, Boss was using a design (which I understood to be a reference to “”) that was similar to the Applicant’s. In response, Boss said: “*You can be right, if I did this in Malaysia*”. To this, Vinoth countered: “*We are exporting to Singapore also. I can understand if you did it unwittingly. I am telling you honestly, if you did it by mistake, it is okay, but you know very well, this is our brand. When you worked in our place, I have shown you*”. Boss then asked: “*What do you claim as your brand?*”, to which Vinoth replied: “*SREE GOLD*”. Boss then issued the following challenge in response: “*Do you have a registered trade mark for SREE GOLD? Let me tell you one thing, even if you file a case against me, they would ask if it is your trade mark. Did you go for it?*”. Vinoth replied that “*I don’t know about that. I am talking to you because you are brother’s friend*”. (The transcriber recorded “SHREE” as “SREE” but this only served to illustrate the Applicant’s point: the difference is insignificant.)

49 On 5 April 2017, about a month prior to the commencement of the invalidation actions (and the opposition action), the Applicant’s solicitors wrote to the Registrant demanding that it voluntarily cancel the Subject Marks and withdraw the application mark 47V. In that letter, the Applicant alleged, among other things, that the Subject Marks had been registered in bad faith. No response was received.

Evaluation

50 To my mind, it is quite clear that the Subject Marks were registered in bad faith. The key points in the constellation of facts were these.

- a. First, the Applicant has used its trade marks “SHREE” and “SHREE GOLD” (in both block letters and stylised form) in Singapore since 2010 and 2012 respectively, in relation to various Indian provision goods (e.g. oil and spices) and prayer items (e.g. incense). The goods were then sold to ultimate consumers through various middlemen. The point of this is that the Applicant had *first use* of “SHREE” and “SHREE GOLD” (in both block letters and stylised form), at least in relation to some of the goods claimed under the Subject Marks.

- b. Second, the Subject Marks were registered with full knowledge of the Applicant's trade marks "SHREE" and "SHREE GOLD". Boss, a director of the Registrant, used to work for one of these middlemen from 2010 to February 2016. After Boss left, the Registrant was incorporated (on 31 March 2016). In the course of his work, Boss purchased the Applicant's goods including "SHREE" and "SHREE GOLD" products. Boss was in direct contact with Mahendra, sole proprietor of the Applicant. Boss even asked Mahendra to send him pictures of the Applicant's products and represented that he would help promote them in Singapore. On 4 April 2016, Mahendra sent Boss the photographs (which included a picture of "SHREE GOLD" cooking oil). On the very same day, the Registrant filed to register the Subject Marks. Below, I reproduce the representations of the Subject Marks, followed by the picture of "SHREE GOLD" cooking oil (the "SHREE" in this instance is stylised) that Mahendra sent to Boss via WhatsApp.



i.



ii.

- c. Third, Boss' actions after the fact suggested that he knew that his actions were not "above board", so to speak. Boss met Mahendra in Johor in July 2016 (about three months after applying to register the Subject Marks). It was then that Boss informed Mahendra that he had registered "SHRI GOLD" in Singapore. Obviously, this was untrue because the essential component of the Subject Marks is "SHREE" (62U) and "SREE" (64Y). Neither is spelt "SHRI". Mahendra said that he was troubled at that time by the "SHRI" registration, but did not object. I very much doubt that if Mahendra had been told the truth, he would have stayed

silent. If Boss thought that he had done nothing wrong, why did he mislead Mahendra as to the true state of affairs? Although these events took place after the filing of the trade mark application, they were indicative of Boss' state of mind at the time.

- d. Fourth, there is an obvious resemblance between the marks that the Applicant used in Singapore ("SHREE" and "SHREE GOLD") and the Subject Marks. The other elements present in the Subject Marks are decorative and in any event do not serve to distinguish the Subject Marks from the Applicant's trade marks ("SHREE" and "SHREE GOLD"). I do not think that the fact that 64Y is spelt as "SREE" makes any difference: they sound and look very similar. Further, many of the goods claimed by the Registrant under the Subject Marks directly correspond to the Applicant's goods of interest under the "SHREE" and "SHREE GOLD" trade marks. The Registrant even later applied for still more of the Applicant's goods of interest under the 47V application (which was later treated as withdrawn). All of this could not have been mere coincidence.
- e. Fifth, leaving aside the fact that the Registrant did not file evidence in these proceedings, it could very well have replied to the pre-action demand letter sent by the Applicant's solicitors to Boss' residential address (which was also the Registrant's registered address). The Registrant's silence, in the face of the Applicant's allegations, was damning.

51 I have no trouble finding that the Registrant's actions fell far below what reasonable and experienced traders would regard as commercially acceptable. For the reasons above, I would make a declaration of invalidity in respect of the Subject Marks under Section 23(1) read with Section 7(6) TMA.

Section 23(3)(b) read with 8(7)(a) TMA

52 My decision that the Subject Marks were registered in bad faith makes it unnecessary for me to decide whether the ground of passing off under Section 23(3)(b) read with 8(7)(a) TMA has been made out.

Section 23(4) TMA

53 My decision that the Subject Marks were registered in bad faith makes it similarly unnecessary for me to decide whether the registrations should be declared invalid on the ground of fraud or misrepresentation under Section 23(4) TMA.

Conclusion

54 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the invalidation actions against the Subject Marks succeed under Section 23(1) read with 7(6) TMA. I therefore declare Trade Mark No. 40201606062U and Trade Mark No. 40201606064Y invalid. The Applicant is entitled to the costs of this action.

Date of Issue: 8 February 2019