

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

Trade Mark Application No. 40201909817Y
11 December 2020

APPLICATION FOR EXTENSION OF TIME
TO FILE EVIDENCE
IN A TRADE MARK OPPOSITION
BY BEABA

AND

OBJECTION THERETO
BY BIBA (ZHEJIANG) NURSING PRODUCTS CO., LTD

Principal Assistant Registrar Sandy Widjaja
27 January 2021

Interlocutory hearing – application to file a late request for an extension of time to file evidence – objection by the applicant / respondent – whether the irregularity can be corrected under Rule 83 of the Trade Marks Rules (Cap. 332, 2008 Rev. Ed.) (Rules)¹

Background

- (i) The main proceeding to which this interlocutory decision relates is the opposition to the Application to Register the Trade Mark No. 40201909817Y:

BEABA

in Class 5 (“*Application Mark*” and “*Opposition*” respectively).

- (ii) *Biba (Zhejiang) Nursing Products Co., Ltd* (the applicant / respondent, thereafter “*Applicant*”) sought to register the *Application Mark* on 5 May 2019. On 11 November 2019, *BEABA* (the opponent / applicant; thereafter “*Opponent*”) filed a notice of opposition to the *Application Mark*.

¹ All references to Rules are to *Trade Marks Rules (Cap. 332, 2008 Rev. Ed.)*.

Evidence and written submissions

- (iii) Parties submitted the following documents:
 - (a) *Opponent*'s written submissions (“**OWS**”);
 - (b) *Opponent*'s evidence which comprises of a statutory declaration made by the director of the *Opponent*'s agent, Ms Francine Tan, dated 26 November 2020 (“**Opponent's SD**”); and
 - (c) Applicant's written submissions (“ **AWS**”).

Brief Facts

- (iv) On 28 February 2020, at a Case Management Conference, the Registrar issued deadlines concerning when parties had to file their respective evidence in the form of statutory declarations.² On 21 May 2020, the *Opponent* filed a request for an extension of time for its deadline for filing evidence in the *Opposition*.³ On 15 June 2020, the Registrar acceded to the *Opponent*'s request and granted a final 4-month extension of time of up to 28 September 2020 for the *Opponent* to file any evidence.⁴ However, on 28 September 2020, no evidence had been filed by the *Opponent*. Also, no further request for any extension of time had been received by the Registrar prior to the expiration of the deadline.⁵
- (v) On 8 October 2020, 8 working days⁶ after the expiration of the deadline, the *Opponent* filed a late request for an extension of time, setting out the reason for the *Opponent*'s failure to file its evidence prior to the expiry of the deadline.⁷ On 12 October 2020 the Registrar wrote to the *Applicant* seeking its views on the request. On 20 October 2020, the *Applicant* responded that it objected to the late request for the extension of time.⁸ An interlocutory hearing was subsequently fixed for 11 December 2020⁹ to hear parties on the issue.¹⁰

Issue and relevant provision

- (vi) The issue for determination in this interlocutory decision is whether the *Opponent*'s late application for an extension of time to file its evidence can be allowed. The applicable provision is Rule 83:

² [1.4] **AWS**.

³ [1.5] **AWS**.

⁴ [1.5] **AWS**.

⁵ [1.6] **AWS**.

⁶ [7] **Opponent's SD**.

⁷ [1.7] **AWS**.

⁸ Following this, the Registrar declined to accept the late request for an extension of time via IPOS letter of 26 Oct 2020 ([1.8] **AWS**). This ultimately led to the Opponent requesting for an interlocutory hearing via its letter of 14 November 2020.

⁹ Via the Registrar's notification of 16 November 2020 ([1.8] **AWS**).

¹⁰ [1.8] **AWS**.

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.

[Emphasis in italics and bold mine]

Held, allowing the late request for an extension of time to file the Opponent's evidence:

1. The term “irregularity in procedure” in Rule 83 includes matters in respect of time.¹¹ Thus, Rule 83 is applicable. The *Opponent* has distilled the relevant factors for consideration from the applicable cases¹² and they include:

- (i) the length of the delay;¹³
- (ii) the reasons for the delay;¹⁴
- (iii) the overall conduct of the applicant for an extension of time;¹⁵
- (iv) the stage of the proceedings;¹⁶
- (v) the degree of prejudice/detriment to the respondent if the application is granted;¹⁷
- (vi) whether there are exceptional circumstances;¹⁸ and
- (vii) the public interests of certainty and transparency versus the need to adjudicate based on the merits of the case in the interest of justice between the parties.¹⁹

2. Applying the above:

- (i) the delay was 8 working days;²⁰
- (ii) there was a default on the part of the solicitor / member of the staff because of an oversight / mistake in noting down the applicable deadline (more below);²¹

¹¹ [13] *OWS*.

¹² See below.

¹³ [18] *OWS*; for example, *Application For An Extension Of Time To File Evidence By SOS International A/S And Objection Thereto By (1) AEA International Holdings Pte Ltd (2) Blue Cross Travel Services B.V.* [2011] SGIPOS 10 (“*SOS*”) at [4].

¹⁴ [18] *OWS*; for example, *Application For Restoration Of Trade Mark Application And Request For Extension Of Time To File Evidence In A Trade Mark Opposition By V Hotel Pte Ltd And Objection Thereto By Jelco Properties Pte Ltd* [2014] SGIPOS 1; although in this case, the opposite conclusion was reached.

¹⁵ [19] *OWS*.

¹⁶ [19] *OWS*.

¹⁷ [18] *OWS*; see also *SOS* at [5].

¹⁸ [16] *OWS*.

¹⁹ [15] *OWS*.

²⁰ [7] of the *Opponent's SD*.

²¹ For more details, see [5] – [12] of the *Opponent's SD*.

- (iii) the late request for the extension of time was filed immediately upon discovery on 8 October 2020²² and this was *before* IPOS issued its notification of the deemed withdrawal of the trademark opposition.²³ The evidence was also subsequently filed by the *Opponent* on 6 November 2020;²⁴
 - (iv) the prejudice to the *Applicant* can be compensated by costs. In this regard, the *Applicant* would have been *well aware* of the *Opponent*'s objections to the registration of the *Application Mark* in view of:
 - (a) the *advanced* stage of the proceedings, that is, the evidence stage;²⁵ and
 - (b) the parties' involvement in related oppositions (more below).²⁶
 - (v) COVID-19 was in the backdrop throughout the incident and was one of the *contributing* factors to the clerical mistake (more below).²⁷
3. There are two related cases to the current case which were consolidated, namely, C010140201909816U and C010140201909820Q (collectively, “*Related Oppositions*”).²⁸ ²⁹ The *Opponent*'s agent's paralegal erroneously recorded the wrong deadline for the filing of the evidence for the *Opposition* due to a confusion with the deadline for the *Related Oppositions*. The *Opponent*'s agent subsequently discovered the error on 7 October 2020 and submitted an application for a late extension of time the next day.³⁰
4. All this while, COVID-19 was in the backdrop, culminating in the Circuit Breaker for the period from 7 April – 1 June 2020 (“*Circuit Breaker*”).³¹ The situation was compounded³² by the *Opponent*'s agent's relocation,³³ change of staff³⁴ and subsequent difficulty in remote supervision of its staff.³⁵ In this regard, the *Opponent* filed evidence detailing the sequence of events in some detail.³⁶ ³⁷

²² [7] of the *Opponent's SD*.

²³ And any query made by the *Applicant* ([35] *OWS*).

²⁴ [14] of the *Opponent's SD*.

²⁵ [55] *OWS*.

²⁶ [46] *OWS*.

²⁷ [17] of the *Opponent's SD*.

²⁸ [4] *OWS*.

²⁹ The *Opponent* deposed that it had requested for the *Opposition* and the *Related Oppositions* to be consolidated but this was refused by the Registrar ([5] *Opponent's SD*).

³⁰ [10] *OWS*.

³¹ Imposed by the Government for the period from 7 April – 1 June 2020 (see Channel News Asia Article: *Singapore's circuit breaker and beyond: Timeline of the COVID-19 reality*, dated 15 Jun 2020).

³² See also [8] – [11] of the *Opponent's SD*.

³³ [32(i)] *OWS*.

³⁴ [32(ii)] and [32(iii)] *OWS*.

³⁵ [32(iii)], [32(iv)] and [32(v)] *OWS*.

³⁶ *Opponent's SD*

³⁷ This is in addition to the *Opponent*'s letter of 27 October 2020, seeking to justify the late request for an extension of time.

5. The *Applicant* resisted the late request for an extension of time:³⁸

[3.5] In exercising its discretionary power under Rule 83, TMR, the Registrar has to perform “*a balancing exercise, between ensuring that rules relating to procedure are followed so that there is certainty for trade mark owners, and between the need to ensure the proper adjudication of the case based on its merits in the interest of justice between both parties. However, the overall consideration of public interest of certainty and transparency of the trade marks application procedure and the need to promote the expeditious disposal of disputes under the Act meant that the Registrar would not allow the overstepping of time limits provided for in legislation under most circumstances*”...

...

[7.1] Essentially, all the various reasons proffered...can be **distilled down** to just one, i.e., that the new paralegal had demonstrated “***carelessness, lack of attention and/or confusion***” and this was allegedly exacerbated by the ongoing Covid-19 and Circuit Breaker events in the background.

...

[7.4]...although Covid-19 and the Circuit Breaker undoubtedly posed difficulties, they **did not give rise** to any exceptional circumstances that caused the deadline to be missed. Such Covid-19 related issues **had largely passed by 19 June 2020 when Singapore entered Phase 2**.

[7.5]...the Applicant has and continues to suffer the prejudice of the uncertainty of whether the Application mark will proceed to registration notwithstanding that the Opposition had been deemed withdrawn.

[Emphasis in italics the *Applicant*’s and in bold mine]

6. I agree with the *Applicant* that in essence it was a clerical error. Nonetheless, I am of the view that this must be viewed in ***context***. In this regard, it is important not only to look at the factual circumstances in the instant case, but also other similar cases.
7. While the ***Circuit Breaker*** had ended on 1 June 2020, at the point in time when the clerical mistake was made (the notification from the Registrar confirming the deadline was dated 15 June 2020)³⁹ until today, COVID-19 **was, has been and is**, still in the backdrop.⁴⁰
8. Of course, the presence of COVID-19, while difficult and unprecedented, is **not** a licence to be careless about deadlines. Nonetheless, it is not disputed that these are

³⁸ [3.5], [7.1], [7.4] and [7.5] AWS.

³⁹ [1.5] AWS.

⁴⁰ Singapore entered Phase 2 on 19 June 2020 and Phase 3 on 28 December 2020.

unusual times, and as such, mistakes which occur during this period should be viewed with some degree of compassion.

9. The ***Opponent*** has admitted that a mistake has been made.⁴¹ The next step is to see if the circumstances are such that it warrants an exercise of the discretion of the Registrar under Rule 83 to grant the late request for an extension of time.
10. As deposed by the ***Opponent***, “[t]he Opponent’s intention was at all material times to file the evidence within the relevant deadlines and ***its action reflects its intention***”.⁴²⁴³
11. Firstly, the ***Opponent itself*** discovered the error and, as alluded to above, the late request for the extension of time was filed ***immediately*** upon discovery on 8 October 2020, which was one day after the discovery.⁴⁴ The significance of this is that the ***Opponent*** was ***sufficiently diligent*** (despite the original lapse) to discover its own mistake and rectify it as soon as possible. In fact, the Opponent has since filed its evidence on 6 November 2020.⁴⁵
12. The above is in contrast to cases where the relevant application was made *after* the Registrar had notified parties of the application of the law as a result of a lapse.⁴⁶ Such a scenario suggests that the defaulting party *remained clueless* as to its own error to the extent that a third party had to bring the mistake to the defaulting party’s attention.
13. Secondly, the late request was also made ***before*** IPOS issued its notification of the deemed withdrawal of the trademark opposition.⁴⁷ The ***Applicant*** submitted that the notification is a mere confirmation of the consequence of the ***Opponent***’s lapse⁴⁸ and “[t]he Applicant had already the expectation that the Application Mark would proceed to registration and suffers the ***prejudice*** of that ***uncertainty***⁴⁹ being inflicted upon it even though the Opposition had been deemed withdrawn under the applicable rules”.⁵⁰
14. I agree with the ***Applicant***’s description of the prejudice it suffered. Nonetheless, this must be distinguished from cases where the relevant request was made *after* the Registrar had provided a written notification *confirming* the application of the law following a lapse.⁵¹

⁴¹ [16] of the ***Opponent’s SD***.

⁴² Emphasis in italics and bold mine.

⁴³ [19(viii)] of the ***Opponent’s SD***.

⁴⁴ [7] of the ***Opponent’s SD***.

⁴⁵ [14] of the ***Opponent’s SD***.

⁴⁶ [21] ***OWS***.

⁴⁷ And any query made by the ***Applicant*** ([35] ***OWS***).

⁴⁸ [6.1] ***AWS***.

⁴⁹ Emphasis in italics and bold mine.

⁵⁰ [6.1] ***AWS***.

⁵¹ [21] ***OWS***.

15. In such cases, the detriment suffered by the respondent is much *greater* (than what the *Applicant* had suffered, above). The uncertainty would have been substituted with a *confirmation* that the opposition has been deemed withdrawn under the applicable rules. In other words, the applicant in a such a case would have had “*relied*”⁵² on the notification and thus had a “*reasonable expectation*”⁵³ that the opposition has been withdrawn.⁵⁴
16. Thirdly, in the current case, the *Opposition* was at an advanced stage of the proceedings, that is, at the evidence stage.⁵⁵ There are also ongoing related cases.⁵⁶ The point is that, as a result, “*both parties [would be] well aware*⁵⁷ *of the ongoing dispute between them*”.⁵⁸
17. Looming over all of the above was / is the COVID-19 pandemic. With COVID-19 reaching our shores,⁵⁹ the Government implemented drastic measures (and rightly so) to curb its spread, culminating with the imposition of the *Circuit Breaker*. As a result, the year 2020 has been an unprecedented year of hardship for many in Singapore.
18. As alluded to above, the Applicant’s argument is that “although Covid-19 and the Circuit Breaker undoubtedly posed difficulties, they did not give rise to any exceptional circumstances...[since] [s]uch Covid-19 related issues had largely passed by 19 June 2020 when Singapore entered Phase 2”.⁶⁰ The significance of 19 June 2020 is that the request for the an extension of time (until 28 September 2020) by the *Opponent* was approved and notified by the Registrar on 15 June 2020.⁶¹
19. I am unable to agree with the *Applicant*. In my view, while “the [*Circuit Breaker*] related issues had largely passed by 19 June 2020 when Singapore entered Phase 2”,⁶² to this day, COVID-19 is still very much a part of, and affect, our daily lives.
20. As I have stressed above, the presence of COVID-19, while arduous and onerous, is *not* a licence to be careless about deadlines. Yet, it would *not* be right to disregard it in assessing situations such as this one. As deposed by the *Opponent*, “[u]nder ordinary circumstances...the error would have been spotted much earlier”.⁶³ If COVID-19 does not qualify as an “exceptional circumstance” which *contributed* to the *Opponent*’s lapse, it is hard to imagine what other events would so qualify.

⁵² [30] *OWS*.

⁵³ [30] *OWS*.

⁵⁴ [30] *OWS*.

⁵⁵ [55] *OWS*.

⁵⁶ [4] *OWS*.

⁵⁷ Emphasis as underlined mine.

⁵⁸ [41] *OWS*.

⁵⁹ Since 23 Jan 2020 (see Channel News Asia Article: *Timeline: How the COVID-19 outbreak has evolved in Singapore so far*, dated 18 Apr 2020).

⁶⁰ [7.4] *AWS*.

⁶¹ [1.5] *AWS*.

⁶² [7.4] *AWS*.

⁶³ [17] *Opponent’s SD*.

21. As submitted by the *Applicant* itself, the prejudice it has suffered is “the expectation that the Application Mark would proceed to registration”⁶⁴ and “the prejudice of that *uncertainty*⁶⁵ being inflicted upon it even though the *Opposition* had been deemed withdrawn under the applicable rules”.⁶⁶ Apart from this, there is no further elaboration. Further, as alluded to above, the *Applicant* would have been *well aware* of the *Opponent*’s objections to the registration of the *Application Mark*.
22. Having regard to *all* of the above, the prejudice suffered by the *Applicant* is one which can be compensated by costs. Therefore, the *Applicant* is awarded costs in the amount S\$ 1,150.00 (the maximum allowed applying the Fourth Schedule of the *Rules*) for preparation and the attendance at the interlocutory hearing (half day),⁶⁷ payable within 2 weeks from the date of this decision.
23. Accordingly, the late request for an extension of time (Form HC3) filed on 8 October 2020 is granted and the evidence filed by the Opponent on 6 November 2020 is accepted. The *Applicant* is directed to file its evidence within 3 months⁶⁸ from the date of this decision, that is, on or before 27 April 2021.

Legislation discussed:

Trade Marks Rules (2009) Rule 83

S/N	Cases referred to
1	<i>Applications For Extension Of Time To File Counter Statements In Trade Mark Application Nos. 20051/00 and 20052/00 By Asian Aisle Pte Ltd And Objection By Ricegrowers Co-operative Limited</i> [2002] SGIPOS 8
2	<i>Application For Extension Of Time To File Evidence In A Trade Mark Opposition By But Fashion Solutions – Comercio E Industria De Artigos Em Pele, Lda And Objection Thereto By Sao Paulo Alpargatas S.A.</i> [2011] SGIPOS 16
3	<i>Application For Restoration Of Trade Mark Application And Request For Extension Of Time To File Evidence In A Trade Mark Opposition By V Hotel Pte Ltd And Objection Thereto By Jelco Properties Pte Ltd</i> [2014] SGIPOS 1
4	<i>Applications For Restoration Of Trade Mark Applications And Extension Of Time To File And Serve Counter-Statements In Trade Mark Applications By Brdg Brilliant Rubber Goods (M) Sdn Bhd And Objection Thereto By The Polo / Lauren Company, L.P.</i> [2014] SGIPOS 4

⁶⁴ [6.1] AWS.

⁶⁵ Emphasis in italics and bold mine.

⁶⁶ [6.1] AWS.

⁶⁷ Applying HMD Circular 6.1 at F at items 5 and 6.

⁶⁸ Rule 31A(3).

5	<i>Application for Acceptance of Late Counter-Statement in a Trade Mark Application by MGG Software Pte Ltd and Objection Thereto by Apptitude Pte Ltd [2015] SGIPOS 8</i>
6	<i>Application For An Extension Of Time To File Evidence By SOS International A/S And Objection Thereto By (1) AEA International Holdings Pte Ltd (2) Blue Cross Travel Services B.V. [2011] SGIPOS 10</i>
7	<i>Application for Restoration of Trademark Applications and Request for Extension of Time to File Evidence in a Trademark Opposition by Tilaknagar Industries Ltd. And Objection Thereto by Distilleerdeij En Likburstokerij Herman Jansen B.V. [2013] SGIPOS 3</i>
8	<i>Application For Extension Of Time To File Counter-Statement In A Trade Mark Application By KPR Singapore Pte Ltd And Objection Thereto By PSE Asia-Pacific Pte Ltd [2010] SGIPOS 13</i>
9	<i>Application to Correct an Irregularity under rule 83 to File Counter-Statement out of time In Trade Marks Application T0805545C By Martin Joseph Peter Myers And Objection By GSM (Operations) Pty Ltd, GSM (Trademarks) Pty Ltd and Billabong International Limited [2009] SGIPOS 8</i>
10	<i>Application For Extension Of Time To File Notice Of Opposition In Trade Mark Application No 11833 Of 2004 By Neutrogena Corporation (Applicant For Extension Of Time) And Objection By Neutrigen Pte Ltd (Respondent In Application For Extension Of Time) [2005] SGIPOS 7</i>
11	<i>Application to Allow Late Form for Extension of Time to Oppose by Seiko Holdings Kabushiki Kaisha and Objection Thereto by Choice Fortune Holdings Limited [2011] SGIPOS 20</i>

Representation:

Mr. Jevon Louis / Ms. Kristen Lim (Shook Lin & Bok LLP) for the *Applicant*

Ms. Francine Tan / Ms. Jocelyn Toh (Francine Tan Law Corporation) for the *Opponent*