

**Intellectual Property Office of Singapore
Hearings & Mediation Department**

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AMP¹ Mediation Success

Fun Toast Pte. Ltd.
&
Fun Tea Pte. Ltd.
[2024] AMP MED 2

	Party A	Party B
Name	Fun Toast Pte. Ltd.	Fun Tea Pte. Ltd.
Nationality / Country of Incorporation	Singapore	Singapore
Representation	Rajah & Tann Singapore LLP	Nanyang Law LLC
Lawyers	Mr Lionel Tan, Ms Victoria Tan & Mr Ian Ng	Mr Ng Kim Tean, Mr Ng Yi Neng & Ms Tay Yu Shan

Mediation Institution	WIPO Arbitration and Mediation Center (“WIPO Center”)
Mediator	Ms Joyce A. Tan, Director, Joyce A Tan & Partners LLC (“Mediator”), and Mr Lakshmanan Anbarazan ²
Shadow Mediator³	Ms Divya Shanaz Kolandai, IPOS Young IP Mediator ⁴
Date of Mediation	9 July 2024
Mode of Mediation	In person

Background

Fun Toast Pte Ltd (“Party A”) is a company incorporated in Singapore that operates several establishments selling food and beverages. Fun Tea Pte Ltd (“Party B”) is a company incorporated in Singapore that sells food and beverages. Party B was a joint venture pursuant to an agreement in 2012, that included both directors and shareholders of Party A.

Party A is the registered proprietor of the following trade marks, which it uses in the course of its business (“Fun Marks”):

		
(“Fun Toast Mark”)	(“Fun Tea Mark”)	(“Red Fun Mark”)

¹ The WIPO-Singapore ASEAN Mediation Programme (AMP) is part of the collaboration between the Government of Singapore and WIPO, under which funding for mediation is available under certain conditions.

² Mr Anbarazan was assisting Ms Tan in the Mediation. Consent was received from all parties.

³ It is a condition of funding under AMP that parties allow a “shadow” mediator to attend and observe the mediation.

⁴ The IPOS Young IP Mediator initiative was launched with the objective to give more exposure and build up experience among those who may mediate or represent parties in IP mediations in future.

The dispute arose on 22 November 2022 relating to the use of the Fun Tea Mark and Red Fun Mark and the ownership of the Fun Marks.

As they were unable to resolve their issues, the parties mutually agreed to mediate this dispute under the WIPO-Singapore ASEAN Mediation Programme (AMP). Under AMP, the parties in a mediation case can receive reimbursement of mediation costs, up to S\$8,000.⁵

Pre-Mediation Discussions

Prior to the mediation, parties submitted their respective case statements which comprised their versions of events coupled with possible solutions to the dispute. The Mediator held separate online meetings with each party to better understand their perspectives and the parameters of their proposed solutions. These meetings allowed the Mediator to outline key root issues and gain insight into the parties' personalities, setting the stage for a more productive mediation session.

Mediation Session

The venue was kindly provided by Party A's law firm, Rajah and Tann Singapore LLP. It began in the morning at 9.40 am on 9 July 2024 and concluded in the wee hours of the following morning at 12.28 am on 10 July 2024 with the signing of the settlement agreement.

The mediation began with all the parties present in the main meeting room where each participant briefly introduced themselves. The Mediator gratefully acknowledged the hospitality of Party A's lawyers in providing a comfortable venue. This gesture highlighted her observation and validation skills, which are crucial in mediation. The Mediator also acknowledged that both parties were saddled with difficulties and encouraged them to move forward. Further, she expressed her gratitude to both parties for adopting a more rehabilitative stance in attending the mediation that day. This not only fostered an open and welcoming tone but served as a tool to build an environment that facilitated communication.

The tone of the mediation was set as she reminded the parties of the importance of mediation and established some ground rules. This was a key step in setting a conducive environment for parties to express themselves.

To let parties form their agenda for the mediation, she encouraged both parties to share their sentiments through opening statements. The Mediator then skillfully extracted their common intentions which allowed the parties to appreciate their perspectives and how they could culminate into an effective resolution for both of them. At this juncture, she reminded parties of the grave alternative they would face if the mediation were not successful. Highlighting the commonalities allowed parties to shift their perspectives towards the fact that there was a common ground between them, contrary to what they may have initially thought.

At this juncture, the Mediator called for a private caucus. This is a confidential, private meeting between each party, their lawyers, and the Mediator. In these sessions, the Mediator tactfully got parties to partake in a visualization exercise. The exercise involved parties imagining themselves adopting solutions they seemed hesitant to consider. This hands-on approach helped reframe the other party's solutions, encouraging greater consideration of alternative possibilities and even the potential success of alternative solutions. It was also an effective way of easing parties into something new in bite-sized pieces.

⁵ It is a condition of funding under AMP that parties agree to named publicity, without the need to disclose specific details of the settlement agreement; hence this article.

With that as a starting point, parties were able to work with the Mediator in modifying the new solutions to meet their needs. The privacy of the sessions allowed parties to freely express their emotions while dabbling with the possibility of adopting new solutions. This further enabled the parties to brainstorm and refine the solutions, facilitating the creative process and advancing the mediation. Additionally, the Mediator challenged parties in their current positions and prompted them to consider being flexible and reasonable.

The Mediator adeptly redirected parties to the issue at hand and encouraged them toward a middle ground instead of dwelling on the past contentious issues. This was skillfully done by reminding them about the benefits of a settlement versus the uncertainty and potential drawbacks of prolonged litigation.

Challenges

There was a point in the mediation where parties remained fixated on their diametrically opposing viewpoints. Recognizing the impasse, the Mediator felt it appropriate to outline the various grievances that might have led to the dispute. The Mediator tactfully leveraged their experiences to remind parties about how the settlement agreement would prevent parties from finding themselves in a similar predicament.

Further, due to the high emotions, the Mediator introduced moral philosophies; like the benefit of distancing from commercial realities and reflecting on the broader value of life. Shifting the discussion away from pure commercial concerns led parties to consider more holistic and meaningful solutions. Ultimately, this culminated in a settlement agreement.

Another challenge was the rigour of the mediation. Due to the nature of the dispute, the parties were fixated on their legal position. Noting this, the Mediator decided to privately converse with the lawyers. With the Mediator's expertise on the subject matter, she reminded lawyers about the uncertainty of navigating the litigation terrain. The lawyers also provided further insight on where the parties stood which allowed her to communicate more effectively with the parties and reframe solutions in a manner that made better sense to them. The private conversation with the lawyers also ensured that the legal representatives, who communicated directly with the clients, were aligned with the objectives of the mediation process. This alignment helped direct their clients toward the goal of a settlement.

Reflections

The Mediator commented:

Interestingly, the huge divide between the disputants in this case masked a shared commercial goal, that could have been easily sidelined by each party's focus and arguments on the merit of legal technicalities and factual interpretations in its favour. Due to each party's strong belief in such merit, the threat of parties slugging it out in the courts was ever-present and looming. Mediation presented parties with the holy grail of dispute resolution to prioritise and build on the shared goal, while defocusing each party's belief in the legal merit of its disparate position. In the face of a dispute having direct adverse impact on the conduct of a business as in this case, seeking its resolution is better served by formulating a carefully calibrated solution that balances competing interests, and is practically meaningful and helpful to the business over the longer term, rather than in a gamble of "winner taking all". Despite the great metaphorical distance between them, the parties in this case managed to

mine the golden nuggets of mediation, to resolve an old festering dispute that had plagued them both for too many long years.

Party A commented that they were greatly satisfied with the mediation process, particularly highlighting its efficiency and the professionalism of all parties involved. The confidential and cost-effective resolution of the dispute was highly valued, as it aligned perfectly with their commitment to maintaining harmonious business relationships with their partners while upholding their commercial interests ethically and responsibly. Party A concluded that their positive experience underscores the benefits of mediation as a preferred method for dispute resolution, one that fosters collaboration and preserves business relationships.

The lawyers for Party A remarked:

The mediation process itself was smooth, despite its duration extending late into the night, finally concluding at around 1.00 am. Throughout the sessions, numerous critical points were raised by the parties that had not previously been canvassed in earlier correspondence which contributed to the ultimate resolution of the dispute. The mediator demonstrated a high level of persistence and was well-versed in the IP issues at hand. Her thorough preparation was evident, as she effectively navigated the complexities of the case, ensuring that all perspectives were adequately considered. Notably, the mediator held a preparatory session with the parties before the actual mediation, which was extremely helpful in identifying each party's objectives. This preparatory work was instrumental in shortening the mediation process itself, making it more efficient and focused. Her diligent approach and in-depth knowledge significantly contributed to the successful outcome of the mediation.

Party B remarked:

We wish to convey our gratitude for the mediator going the extra mile to bring both parties to a middle ground and facilitate the eventual amicable settlement.

Party B's lawyer commented:

We are glad that mediation was able to resolve the deadlock between the parties that threatened to escalate into full-blown litigation. At the mediation, parties were able to air their concerns, and, through the mediator, bridge their differences to address each other's concerns.

As for myself, firstly, I appreciated the intricacies of reframing. The Mediator took the art of reframing beyond mere paraphrasing and broke down proposed solutions into smaller, manageable parts. Based on her understanding of the parties, the Mediator was able to map parts of the solutions to the parties' needs so that they would be more receptive to considering alternative possibilities. I was particularly amazed at the Mediator's ability to navigate the fine line between being candid and neutral. The Mediator did this by affirming parties when they were being benevolent and making progress but also highlighted whenever the session was not progressing. This provided parties with an objective perspective without the cloud of emotions. Further, it allowed the Mediator to advance the mediation when parties remained fixated on contentious issues.

My favourite reframe of the session was when the Mediator asked parties to redefine what "winning" would mean. Recognizing that the parties were often fixated on their legal positions, the Mediator posed guiding questions that prompted parties to consider their true losses and gains that went beyond the strength of their cases. It was certainly crucial to the mediation's success.

Secondly, I admired how the Mediator toggled between private caucuses and private sessions with the lawyers. Observing the tenor of the parties, the Mediator was able to spot moments of resistance and struck the balance between validating the parties' emotions and promulgating a forward-looking spirit. At the same time, I was amazed at the Mediator's skillful decision-making to speak with the lawyers alone to further understand these moments of resistance that caused the mediation to come to a standstill. These sessions also provided the opportunity for the Mediator to discuss each party's best possible outcome without a negotiated agreement ("BATNA") and the worst possible outcome without a negotiated agreement ("WATNA"). I realised the importance of reminding parties of both BATNA and WATNA which gave them a more holistic view of their situation.

Lastly, I was impressed at the Mediator's ability to conclude each private caucus with a positive parting thought that encouraged parties to work on their current solutions instead of looking back. A combination of these tactics certainly advanced the mediation and promoted a conducive environment for parties to work towards a common goal.

Conclusion

In total, the mediation lasted for about 15 hours and resulted in a settlement agreement that addressed both parties' interests. This was a preferable outcome as opposed to the unpredictable and arduous process of litigation which would have incurred substantial time and costs.

Written by Divya Shanaz Kolandai, Young IP Mediator
12 August 2024

AMP¹ Mediation Success

**Captain K F&B Management Pte. Ltd
&
En Dining Bar Holdings Pte. Ltd.
[2024] AMP MED 1**

	Party A	Party B
Name	En Dining Bar Holdings Pte. Ltd.	Captain K F&B Management Pte. Ltd
Nationality / Country of Incorporation	Singapore	Singapore
Representation	Mirandah Law LLP	Invictus Law Corporation
Lawyers	Mr Suhaimi Bin Lazim, Mr Jin Wen Rui	Mr Darren Tan, Mr Silas Siew

Mediation Institution	WIPO Arbitration and Mediation Center (“WIPO Center”)
Mediator	Mr George Lim, Senior Counsel (“Mediator”)
Shadow Mediator²	Ms Jean Chai, IPOS Young IP Mediator ³
Date of Mediation	15 December 2023
Mode of Mediation	In person

Background

Party A is En Dining Bar Holdings Pte. Ltd., a company registered in Singapore that operates several Japanese food and beverage establishments. Party A is the registered proprietor of the following trade marks, which it uses in the course of its business (“Party A’s Marks”):

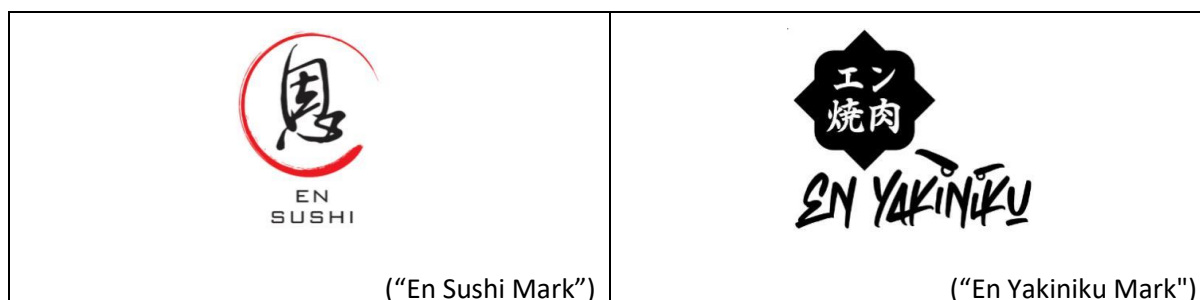


¹ The WIPO-Singapore ASEAN Mediation Programme (AMP) is part of the collaboration between the Government of Singapore and WIPO, under which funding for mediation is available under certain conditions.

² It is a condition of funding under AMP that parties allow a “shadow” mediator to attend and observe the mediation.

³ The IPOS Young IP Mediator initiative was launched with the objective to give more exposure and build up experience among those who may mediate or represent parties in IP mediations in future.

Party B is Captain K F&B Management Pte. Ltd, a company registered in Singapore that operates several food and beverage establishments offering Japanese, Korean, and Chinese cuisines. Among these establishments, Party B operates Japanese restaurants by the names of “En Sushi” and “En Yakiniku”, using the following marks (“Party B’s Marks”):



The dispute arose out of proceedings commenced by Party A against Party B on 30 June 2023, alleging that Party B had infringed Party A’s Marks under the Trade Marks Act 1998. Specifically, Party A alleged that Party B’s use of the word “En” in both of Party B’s Marks and the use of a brushed red circle around a Sino-Japanese character in the En Sushi mark attracted a likelihood of confusion.

Following a case conference conducted by the Registrar of the Supreme Court on 22 September 2023, the parties were strongly encouraged to attempt mediation. The parties therefore mutually agreed to mediate this dispute under the WIPO-Singapore ASEAN Mediation Programme (AMP). Under AMP, the parties in a mediation case can receive reimbursement of mediation costs, up to S\$8,000.⁴

Pre-Mediation

Prior to the mediation, the Mediator had received each party’s mediation case statement and had spoken to the respective legal representatives. This preliminary step was crucial in helping the Mediator understand the dispute’s legal history, the potential roadblocks to resolution and the Parties’ respective positions, therefore setting the stage for a highly productive session on 15 December 2023.

Mediation Process

The morning began with the Mediator meeting and welcoming the parties privately. At 10am, the joint session commenced with the Mediator inviting the parties to introduce themselves, brainstorm words associated with mediation, and collaboratively list out the benefits of mediation. Notably, the words that parties chose to associate with mediation included “openness”, “peace” and “compromise”. From the outset, it was clear that the parties were knowledgeable about the advantages of mediation, demonstrating a positive attitude to the process by actively contributing at this initial stage. Additionally, to help parties appreciate their alternatives to a negotiated settlement, the Mediator used a paper board to draw out an approximate timeline of legal proceedings, which were estimated to take two and a half to three years to reach a conclusion. In doing so, the Mediator helped the parties to visualise the drawbacks of reverting to litigation, which is a far lengthier and costlier alternative to mediation. This exercise proved to be a salient reminder to the parties that there was much to be gained from the session ahead.

Following this, the Mediator invited the parties to give their opening remarks. The parties were forthcoming in sharing about their perspectives on the present dispute, including personal details on

⁴ It is a condition of funding under AMP that parties agree to named publicity, without the need to disclose specific details of the settlement agreement; hence this article.

how their respective businesses came to be and the key concerns which they sought to address in this session.

Throughout the remainder of the mediation process, the Mediator was sensitive to the tenor of the conversation, judiciously giving the parties space to speak directly to each other, and stepping in at appropriate points to either suggest a caucus or to otherwise guide the conversation. Through the use of multiple caucuses, the Mediator was able to gain clarity on the parties' desired outcomes and thus was able to help them explore potential solutions and compromises that were amenable to each party's needs and interests.

After approximately five hours, the parties successfully reached an agreement, during which parties managed to break for lunch before returning to finalise the settlement terms. During the finalisation of terms, parties were also highly cooperative in exchanging edits. Few difficulties were faced in this stage, with legal representatives expertly leading the drafting process. Upon completion, copies of the final settlement document were printed and circulated for signing. The mediation concluded with closing remarks from the parties and the Mediator, with each expressing gratitude and satisfaction with the process.

Challenge

Within the first hour of the joint session, significant progress was achieved concerning the En Yakiniku Mark. However, challenges emerged when addressing the En Sushi Mark. Each party held strong views on the issue of possible variation, making it initially difficult to find a middle ground between their distinct positions.

In overcoming this roadblock, private sessions were of crucial importance. These confidential discussions enabled the parties to express their concerns openly, creating a secure space for them to seek the Mediator's guidance and to explore potential strategies for resolution. Most importantly, the parties were forthcoming with creative ideas on how to potentially resolve tension points, thus setting a positive, forward-looking tone to the conversation. Indeed, this resolution-focused attitude was crucial in allowing the parties to move past disagreements, towards a mutually satisfactory outcome.

Reflections

The Mediator commented:

The outcome of this mediated settlement was truly win-win. Both parties negotiated in good faith and made significant accommodations. This was possible because the process allowed the parties to talk openly and frankly, and share their stories as to how they each started their respective businesses. It turned out that both were professional engineers who got into the food business due to certain circumstances. At one point, with the permission of counsel, I got the parties to talk directly in my presence, and that helped to move them much closer to a deal. After the settlement agreement was signed, we held a closing session. The older party told the other: "I saw a little of myself in you." This was the magic of mediation at work; allowing parties to understand and see each other's perspective, and move towards a resolution of the dispute.

Party A commented:

We are likely to consider mediation to resolve future disputes, given the efficiency of the process that we enjoyed during this mediation.

Mediation allows for much more cordial and friendly exchanges as opposed to litigation. We got to directly engage with the counterparty as well, something which would be unlikely to be possible in formal proceedings.

Party B summarised its experience below:

I thank WIPO and the appointed mediator for assisting to resolve the dispute through WIPO-Singapore ASEAN Mediation Programme, so that I can put the dispute to rest and focus on my business.

When asked how likely they would use mediation again if there was no funding, both parties thought that they were likely to do so. Party B added that the prospect of time-consuming and costly litigation as an alternative to mediation was a reason for it to consider mediation in future.

The lawyers for Party A remarked:

We are heartened to see that parties were willing to work together to resolve the dispute from the get-go, and we admire the grace with which both parties conducted themselves as they talked their way into an eventual settlement and made compromises on both their ends. Most saliently, we felt that during the mediation, we were not bound tightly by our roles as disputing parties and their counsel. Rather, we were all working towards a common solution that would be in the parties' best interests. It was especially helpful that both parties' directors could empathise well with each other due to the commonalities in how they both started out in their respective businesses.

The lawyers for Party B remarked:

We are very satisfied with the mediator and the mediation process under the auspices of WIPO Arbitration and Mediation Center, and grateful for the funding under the WIPO-Singapore ASEAN Mediation Programme, which contributed in no small way to our client's eventual decision to refer the dispute to mediation.

As a Young IP Mediator shadowing the Mediator, I had the pleasure of witnessing first-hand the tangible benefits of mediation. Observing how the parties were able to craft mutually satisfactory solutions, in a personalised and expeditious manner, has reaffirmed my belief in the efficacy and transformative potential of mediation. Most of all, I am in admiration of how the Mediator skilfully facilitated the conversation and how both parties continuously championed the cooperative spirit of mediation. This session was a testament to mediation's profound ability to foster genuine connections and resolve conflicts at their root.

From this session, two observations stand out to me as key contributors to its success.

Firstly, the deliberate efforts by the Mediator to create a comfortable and conducive environment for the parties were pivotal to the mediation's positive outcome. By initiating one-on-one conversations with the parties before the joint session, the Mediator aimed to put them at ease and establish a foundation of trust. Furthermore, by emphasising the confidential and without-prejudice nature of mediation, the Mediator gave parties the confidence to express themselves openly.

Secondly, the session's success was underscored by the parties' willingness to actively listen and empathise with each other on a personal level. A crucial moment that moved the needle towards resolution was when the two parties, without their respective counsel, stepped away from the main

room to have a private conversation in the presence of the Mediator. This direct and sincere communication proved instrumental in helping the parties understand each other and bridging the final gap towards resolution.

Conclusion

The mediation, spanning approximately five hours, culminated in a successful settlement that adeptly addressed the interests of both parties. The unanimous satisfaction expressed by all participants attests to the efficacy of the process, marking the conclusion of another productive and mutually beneficial mediation.

Written by Jean Chai, Young IP Mediator
12 January 2024

AMP¹ Mediation Success

**Chew's Optics
&
Chew's Optics (Bishan), Chew's Optics (Kovan)
[2023] AMP MED 1**

	Party A	Party B
Name	Chew's Optics	1. Chew's Optics (Bishan) 2. Chew's Optics (Kovan)
Nationality / Country of Incorporation	Singapore	Singapore
Representation	CHP Law LLC	Netto & Magin LLC
Lawyers	Mr Dixon Soh, Singapore Mediation Centre (SMC) IP Certified Mediator ² Mr Lenon Ong	Mr Luke Anton Netto Mr Nicholas Leow

Mediation Institution	WIPO Arbitration and Mediation Center ("WIPO Center")
Mediator	Ms Vivienne Sandhu, SMC IP Certified Mediator ("Mediator")
Shadow Mediator³	Ms Shannen Chua, IPOS Young IP Mediator ⁴
Date of Mediation	13 October 2023
Mode of Mediation	In person

Background

This mediation revolved around three Singapore businesses, Chew's Optics on the one hand, and Chew's Optics (Bishan) with Chew's Optics (Kovan) on the other.

Both parties' principal activity involves the business of optometry, where a range of eyecare services is provided and spectacle frames, lenses and contact lenses sold.

The dispute involves the use of Party A's Class 35 Trade Mark Nos. 40202200147S and 40202200146Q (collectively, the "Trade Marks") as respectively depicted below:

CHEW'S OPTICS 周眼镜公司

¹ The WIPO-Singapore ASEAN Mediation Programme (AMP) is part of the collaboration between the Government of Singapore and WIPO, under which funding for mediation is available under certain conditions.

² The IP Mediation Certification programme is a joint initiative of SMC and the Intellectual Property Office of Singapore. The programme is designed to enhance a mediator's skills in mediating IP disputes.

³ It is a condition of funding under AMP that parties allow a "shadow" mediator to attend and observe the mediation.

⁴ The IPOS Young IP Mediator initiative was launched with the objective to give more exposure and build up experience among those who may mediate or represent parties in IP mediations in future.

Party A has been using the Trade Marks in the course of his business since 1988 as a common law mark prior to its registration in 2022. In 2000, Party A licensed the Trade Marks to Chew's Optics (Bishan). The expiration of this license was contested. In 2021, Chew's Optics (Bishan) created Chew's Optics (Kovan) and allegedly used the Trade Marks without obtaining the requisite licenses from Party A.

From the outset, parties were forthcoming with the prospect of attempting mediation to resolve this IP dispute under the WIPO-Singapore ASEAN Mediation Programme (AMP). Under AMP, the parties in a mediation case can receive reimbursement of mediation costs, up to S\$8,000.⁵

Mediation Process

Pre-Mediation Discussions

Prior to the mediation, parties submitted an agreed statement of facts; and their respective case statements furnishing further details about their perspectives and proposed solutions to the Mediator, which they decided not to exchange. During separate calls between the Mediator and lawyers for the respective parties before the mediation, the Mediator sought not only to better understand the perspectives of parties, but also the potential roadblocks that might arise and resolutions that might be amenable to parties. Through asking incisive questions, the Mediator was able to sieve out parties' interests and pre-empt potential (avoidable) conflict points.

In Person Mediation

The mediation took place at the office of CHP Law LLC. Whilst the mediation was originally scheduled for half a day in the morning, it was only successfully concluded in the evening, making it a full day mediation.

Prior to all parties meeting at the discussion table, the Mediator went into each of the holding rooms to introduce herself, explain how the mediation would be conducted, and checked how parties were feeling and if there was anything specific that she should be aware of. This helped to set expectations, dispel any concerns regarding uncertainties, and create a conducive environment for parties to express themselves. This also afforded the Mediator a first glimpse into the personalities of parties and understand some of the challenges parties might face when speaking up in the discussion room.

The Mediator also encouraged parties to share their opening statements in the room for their counterpart to appreciate their perspectives, and for parties to gain a better understanding of the challenges the other party had experienced. In requesting parties to speak up in a confidential environment, the Mediator allowed them to regain their power in sharing their viewpoints and freely express their views. With parties' views laid out, the Mediator could reframe them to pave the way for a conducive discussion. Throughout the discussion, the Mediator stepped in to reframe parties' perspectives and either inject commercial realism or invite the lawyers to do the same, for parties to better appreciate the landscape of their dispute and the alternatives available. This led to a beneficial and targeted discussion where each party's points were heard and dealt with before parties moved to the next point. It also gave parties the opportunity to add their thoughts at various junctures, knowing that their views would be respected and their queries dealt with.

During the mediation, there were points where discussions slowed to almost a standstill. At such points, the Mediator asked parties questions about the difficulties that they were facing and their hesitation with certain proposals raised, in a bid for parties to gain a common understanding and move the conversation forward.

⁵ It is a condition of funding under AMP that parties agree to named publicity, without the need to disclose specific details of the settlement agreement; hence this article.

Use of Technology

The Mediator made use of the projector available to show the Trade Marks and Party B's new proposed mark together for a side by side comparison to be made. This allowed parties the opportunity to clearly visualize the differences in the marks.

Multiple Private Caucuses and Shuttled Discussions

The Mediator also held private sessions, otherwise known as caucuses, with each of the parties. Through the use of these caucuses, parties were able to further share their concerns with the Mediator without the presence of their counterpart, and, together with the Mediator, brainstorm certain solutions that they were willing to consider. In each brainstorming session, the Mediator was quick to use the whiteboard to note down the solutions that the party thought of. This enabled the party to visualize what he/she was saying and proved to be an effective reality check as the party could see the effect of its various options. This in turn helped to streamline the options that the party would later grant the Mediator consent to share with its counterpart.

Based on the situation, the Mediator opted to have multiple private sessions which proved to be an effective use of time as parties were more willing to be flexible and share their concerns in such sessions. When leaving each caucus, the Mediator made sure to give the party some "food for thought" so that it would centre the following discussions around a particular topic. This helped focus the discussions, and allowed the issues to be dealt with systematically. In doing so, this created a constant flow of shuttled discussions, which enabled parties to topically come to multiple agreements.

Working with Lawyers

Further, the Mediator worked well with the lawyers, constantly giving them space to have discussions with clients both in the joint discussion and in caucuses, while stepping in during impasses to re-centre discussions and ensure that conversations remained constructive. Party B's lawyers acknowledged that "there were extensive preparations done by counsel on both sides in the lead-up to the mediation. This was extremely crucial in setting expectations and focusing parties on the issues. This is important to making mediation effective – that the span of possible solutions be increased as large as possible. During the mediation itself, counsel and mediator consistently worked to find avenues of consensus and compromise to pull parties closer together".

Challenge

The need for commercial realism proved to be a challenge.

From the get-go, parties each had solutions that they felt strongly about, and each believed that their legal position was strong. This stalled discussions as neither party was willing to be flexible and explore other solutions.

To mitigate this, the Mediator called for caucuses to speak to parties privately about their concerns and share with parties the commercial realities. The Mediator also used the opportunity to explore alternatives with parties, and understand their priorities. The use of tools like whiteboards for visualisation and internet searches to paint the commercial landscape ultimately helped to nudge parties forward as they started to ask more questions. Hints of flexibility then started to emerge.

The lawyers were instrumental in working with the Mediator whilst ensuring their client's interests remained protected. They also played a significant role in advising their clients on the legal realities and the recourses that would be available with each solution. With a clear understanding of their alternatives, and with the prioritisation exercise, parties were ultimately willing to be flexible to achieve a common goal, and an agreement was arrived at.

Reflections

The Mediator commented:

Parties were very positional in the beginning as this was more like a family property dispute with so many players. After many rounds of reality checking and BATNA/WATNA⁶, the parties were worn down and they could see that if there were no compromises, the impasse would continue. This dispute would continue to affect them. So each side agreed to compromise, as both sides wanted closure, to carry on their own businesses, and make their own money.

I remain firmly convinced of the incomparable superiority of a mediated resolution in comparison with the time, expense and anxiety associated with litigation, which is particularly true for quasi family/IP related matters like this case.

Party B summarised its experience below:

The mediation process was a positive experience. The mediator maintained a neutral and respectful atmosphere, allowing open communication. We are pleased with the outcome and the cooperative approach that was fostered throughout the session.

When asked how likely it was to use mediation again if there was no funding, Party B thought that it was likely to do so for its effectiveness.

The lawyers for Party B remarked:

The mediation was certainly a fruitful one which not only resolved the overt legal disputes but also included related commitments from parties that were strictly speaking out of the scope of the legal issues. This was made possible only with mediation, and is not achievable with litigation. The disputing parties were ultimately family members and it was desirable to assist them resolve all issues within a day than be put through long-drawn and acrimonious litigation proceedings.

The lawyers for Party A reflected as follows:

We had a couple of difficult hours during the mediation, but it is indeed heartening to see counsels working together to advance our respective client's interests and resolve the dispute as best as we can. We had a fantastic mediator, which ultimately helped to conclude the mediation with a positive result! (Dixon Soh)

While this matter presented its challenges, it was truly uplifting to have witnessed the parties diligently hearing one another's perspectives and achieving a mutually beneficial outcome, without having to go through the litigation route. (Lenon Ong)

As a Young IP Mediator shadowing the Mediator, I felt extremely privileged to be given the opportunity to be a part of a successful IP mediation.

⁶ BATNA and WATNA are two key concepts in mediation and negotiation. "BATNA" is an acronym for "Best Alternative to a Negotiated Agreement." "WATNA" is an acronym for "Worst Alternative to a Negotiated Agreement." They are useful tools for evaluating and comparing different possible options for settlement.

Since my mediation exposure has only been limited to hypothetical practices in school and during competitions, I drew parallels between mediations in a controlled environment and in a commercial context where parties' livelihoods are on the line.

One of my biggest takeaways was the **power of emotions** in a mediation. While hypothetical problems in school do sometimes involve emotions as an undercurrent, parties (role played by fellow students) were almost always willing to put emotions aside to focus on the task at hand. I now understand how emotions, whilst not necessarily at the forefront, had a significant impact in the way parties view the matter differently. Also, in an actual commercial mediation, compartmentalisation of various matters and feelings become significantly and understandably a lot more difficult. In such situations, I realised the importance of focusing first on unpacking those emotions to understand the root cause of the dispute, before working towards a solution. I also learnt the importance of building with a solid foundation, as otherwise, any additional storeys ("proposals to resolve the dispute"), no matter how reasonable, may still be viewed with suspicion and collapse.

Another takeaway I had was the importance of **building rapport** between the Mediator and parties. In this mediation, right from the outset, the Mediator was conscious to make parties feel comfortable through personal introductions in holding rooms and detailed explanations about the processes. The Mediator also made parties feel comfortable by striking a delicate balance between appropriately summarizing, for parties to feel heard; and giving them the opportunity to express themselves. The Mediator in skilfully deciding when to interject, when to call for caucuses, and when to allow parties to communicate their opinions to one another, created a conducive environment for discussions. Together with the lawyers, the parties were ultimately able to effectively convey their opinions and emotions to their counterpart, which promoted an open and transparent sharing. Through this, I realized how effective seemingly small acts by the Mediator can be to create a comfortable environment for parties to share their perspectives and work towards a common goal.

Conclusion

The mediation lasted for about eight hours and a settlement agreement was ultimately achieved. I am grateful for this opportunity to learn from a highly skilled Mediator, and to witness how the lawyers were able to effectively protect the interests of their clients whilst moving the discussion forward. This experience has offered new perspectives on how mediations are conducted, and I look forward to more opportunities in the future.

Written by Shannen Chua, Young IP Mediator
8 November 2023

Mediation Success at IPOS

**Kibbles Pte. Ltd.
&
Mr Kibbles Pte. Ltd.
[2023] SGIPOS MED 2**

	Party A	Party B
Name	Kibbles Pte. Ltd. (“Applicant”)	Mr Kibbles Pte. Ltd. (“Opponent”)
Nationality / Country of Incorporation	Singapore	Singapore
Representation	Withers KhattarWong LLP (“Applicant’s Agent”)	Gateway Law Corporation (“Opponent’s Agent”)
Lawyers	Mr Valen Lim	Mr Max Ng Ms Claire Tan

Mediation Institution	Singapore Mediation Centre (“SMC”)
Mediator	Mr Lim Tat (“Mediator”)
Shadow Mediator¹	Ms Jasmine Teo, IPOS Young IP Mediator ²
Date of Mediation	21 July 2023
Mode of Mediation	In person

Introduction

This case involves the opposition of Trade Mark No. 40202131426X:



(“Application Mark”)

in relation to various business-related services in Class 35.

The Parties

The Applicant was first founded as a partnership on 13 October 2019, trading under the name of “KIBBLES”. Its principal activities include the retail sale of pet birds, pet animals, as well as animal feed and accessories.

The Applicant began trading under the Application Mark some time in or around 1 December 2020. The Application Mark and / or its components were then, amongst others, printed onto the Applicant’s name cards and uniforms / shirts, as well as affixed to signage at the Applicant’s retail premises.

On 3 December 2021, the Applicant was incorporated.

¹ It is a condition of funding under the IPOS Revised Enhanced Mediation Promotion Scheme (“REMPS”) that parties allow a “shadow” mediator to sit in and observe the mediation.

² The IPOS Young IP Mediator initiative was launched with the objective to give more exposure and build up experience among those who may mediate or represent parties in IP mediation in future.

Founded in August 2021, the Opponent operates an e-commerce platform which allows customers to purchase pet supplies. The Opponent prides itself in its branding and social media marketing activities, which it believes has helped it establish a reputation in its e-commerce website.

Examples of the Opponent's unregistered marks include:



The Dispute

The Applicant became aware of the Opponent's business and engaged the Opponent in communications in relation to their respective marks some time in December 2021.

On 27 December 2021, in the midst of negotiations, the Applicant applied to register the Application Mark without prior notice to the Opponent.

To the Opponent, the Applicant's behaviour appeared to take advantage of the Opponent's good intentions and willingness to settle the matter amicably, and that by applying to register the Application Mark while undergoing negotiations, the Applicant demonstrated behaviour which was seemingly intended to prevent the Opponent from registering its own mark. Thus, the Opponent alleged bad faith under section 7(6) of the Trade Marks Act 1998 in its opposition.

The Applicant disputed this. To the Applicant, there was no bad faith as its use of the Application Mark preceded incorporation of the Opponent's company, and that it was merely protecting its pre-existing rights regarding the mark.

IPOS Revised Enhanced Mediation Promotion Scheme (REMPS)

Under REMPS, the parties in a mediation case can receive reimbursement of mediation costs of up to S\$10,000 (where only Singapore IP rights are involved) or S\$14,000 (where both Singapore and foreign IP rights are involved).³

Mediation Process

The mediation session started in the morning, at the Supreme Court building.

Firstly, the lawyers were brought in. The Mediator sought their views on how the mediation should proceed and asked that they help identify underlying issues. He also sought their assistance to think creatively to facilitate the mediation process. The Mediator also informed the lawyers that there would be a hard-stop at 6 p.m.

Secondly, parties too were brought in. Here, the Mediator set the stage for the mediation, informing parties that a mediation, unlike a court judgment, works towards a win-win situation (or interestingly, a lose-lose situation, i.e. a compromise on both parties). He forewarned that hard work and creative thinking would be necessary, and there may be a need for parties to confront issues which may cause

³ It is a condition of funding under REMPS that parties agree to named publicity, without the need to disclose specific details of the settlement agreement and thus, this article was written with the parties' consent.

them some discomfort. Everyone was then allowed the opportunity to introduce themselves. The Mediator also informed parties regarding the general mediation process and sought confirmation that parties had authority to sign off on a settlement. The Mediator reminded parties that it may be necessary to move away from a positional standpoint and asked parties to commit to doing their best for a possible mediation success, to which the parties agreed. The Mediator proceeded to ask parties questions on the case, which enabled important issues to be filtered out and helped parties reflect on the matter. He also informed parties that the mediation process is better suited for finding commercial solutions compared to a court process.

Thirdly, the Mediator conducted private caucuses with parties and their respective lawyers. During these caucuses, the Mediator emphasised that such conversations were confidential and would not be revealed to the other party without permission. He took the opportunity to ask parties to reflect on their case. He questioned the parties on their views to help them think through the issues more clearly and see things from the point of view of the other party. Together with the parties, the Mediator brainstormed for solutions with a view to finding out what parties viewed as essential to them.

Fourthly, the Mediator conducted private sessions with the lawyers, both separately and jointly. It was through these sessions that more concrete solutions began to materialise, and parties' respective stand on possible solutions was obtained. The Mediator also sought assistance from the lawyers to emphasize what would happen if the case proceeded to a full hearing, and reminded the lawyers that outcomes are not certain in the adversarial process. The Mediator also challenged the positions of the parties, asking them to reflect on whether their positions were reasonable. With assistance from the lawyers, parties' positions on the solution generated drew closer, and eventually culminated in a settlement agreement. The lawyers then began negotiations on their own on the granularity of the eventual agreement.

The mediation settlement agreement was ultimately finalised and the parties signed off, ending an approximately 8-hour long mediation. The Mediator intervened when there was a possible impasse to the agreement, but otherwise provided space for the lawyers to carry out their own discussions.

Challenges

The mediation got off to a somewhat emotional start. It was apparent that one party felt strongly about the brand / trade mark as a reflection of its blood, sweat and tears toiled for the business. Managing strong emotions is not easy, but the Mediator remained attentive and assured the party that there would be opportunities to discuss the context of the matter. He did not interrupt or dismiss the concerns conveyed. These emotions, too, turned out to help the other party realise that it was necessary to be more realistic in its proposals if it desired a successful mediation.

Another challenge was that for the first half of the mediation, parties were quite binary in their approach. They spoke of co-existing but were not able to generate plausible solutions that would allow this. To help overcome this challenge, the Mediator reminded the lawyers to provide assistance, see things from the other parties' point of view and be fair to both sides. The Mediator also pressed parties to provide a firm position to solutions generated, rather than to just expect the other side to make the first move.

Reflections

The Opponent reflected:

... I realised the value of open communication and a neutral third-party perspective in resolving disputes. The mediator's ability to guide the conversation and maintain impartiality was crucial in creating a respectful and productive environment ... Initially skeptical, I found mediation to be an invaluable tool for complex business settings, leading to a mutually beneficial resolution. The process encouraged creative problem-solving, fostering cooperation rather than adversarial attitudes. It enabled us to move past animosity and focus on shared interests, building a more constructive business relationship.

The Opponent's Agent commented:

[We are] happy that [we were] able to play a part in facilitating the amicable resolution of this matter, through the mediation process, thus resulting in a "win-win" situation for the parties. In such cases, members of the public may often have strong views on their rights and positions, and may often overlook the potential benefits of mediation, insisting instead to have their rights vindicated through the judicial process...

The face-to-face mediation process allowed both parties the opportunity to hear out each other, and highlighted the importance of being able to evaluate each individual party's position and interest for them to determine whether they could reach any common ground. This was assisted by the Mediator's efforts acting as a bridge between the parties, and assisting to evaluate practically each proposed solution, and guiding the parties toward the various possible options to finally resolve the matter...

The provision of this mediation scheme and support provided by IPOS and the SMC, is therefore greatly appreciated.

The Applicant's Agent observed:

We were grateful for the kind assistance and practical guidance provided by the [Mediator] during the proceedings. The [Mediator] raised realistic and pragmatic considerations which helped parties move towards a settlement. [He was] also very understanding to both parties' concerns, feelings and passion for pets. We are glad that the dispute, which had been brewing for over a year, could be finally and fully resolved in a manner that works for parties.

The Mediator remarked:

Mediation is a process that enables parties to resolve issues, concerns and disputes in an amicable and non-adversarial setting. Within an appropriate mediation framework and with the involvement of an experienced mediator, the large majority of parties in mediation have been able to achieve closure of their issues, concerns and disputes on their own terms in a cost-effective and timely manner. Even in cases where the substantive matter is not resolved completely during mediation, parties have expressed satisfaction with mediation having addressed their psychological needs and concerns through their participation in a process that is fairly facilitated by an impartial neutral third party.

As for myself, in classes, I learnt the importance of rapport building. Through this experience, I watched such skill being put in action. First, “introduction”, though seemingly procedural, is actually an opportunity for all in attendance to build rapport with each other. During the introductions, initiated by the Mediator, everyone made reference to their affinity (or lack thereof) with pets. With smiles going all around, this helped to bridge the gap between parties and set the stage for an easier mediation. Even where the “introduction” became somewhat emotionally charged, it allowed parties to see where the other party was coming from. Second, the Mediator would “rephrase” what was said in a manner that showed to the parties that they have been heard and their points of view acknowledged and respected. From this, I learnt better the real purpose of “rephrasing”.

I learnt that perseverance (and creativity) is important for a good mediator. During the mediation, neither party wanted to make the first move. Parties were afraid of losing out. I learnt from the Mediator how to press on in such circumstances. First, fairness – both parties were taught to see that it would only be fair that *both* parties come up with and work towards a proposal for settlement. Second, assertiveness – the Mediator caught on to a proposal raised by parties and asked if he could hold them to it. I found that rather insightful.

All in all, I enjoyed watching how the mediation was skilfully conducted. The Mediator was able to anticipate and navigate parties away from potential pitfalls the mediation could fall into. For instance, from the outset, the Mediator alerted parties that the process required hard work, creativity and facing discomfort. This, I believe, helped prepare parties for the mediation process. I also learnt that it is less about what is said, and more about *how* matters are said. During the first half of the mediation, when parties’ views seemed rather far apart, the Mediator conveyed news in a positive manner. This, I believe, helped the lawyers remain optimistic. The Mediator did not shy away from delivering negative news, but he did it at the right time.

Conclusion

I learnt so much from this mediation and look forward to further opportunities to learn and conduct my own mediations.

Written by Jasmine Teo, Young IP Mediator
20 September 2023

Mediation Success at IPOS

Gan Eng Joo Onassis & SG Mr Kopi Private Limited [2023] SGIPOS MED 1

	Party A	Party B
Name	Gan Eng Joo Onassis (“Mr Gan”)	SG Mr Kopi Private Limited
Nationality / Country of Incorporation	Singapore	Singapore
Representation	NIL ¹	Mahmood Gaznavi Chambers LLC
Lawyers	NIL ²	Rezza Gaznavi (“Mr Gaznavi”)

Mediation Institution	World Intellectual Property Organization Arbitration and Mediation Center (“WIPO Center”) ³
Mediator	Zechariah J H Chan of Lee & Lee (“Mr Chan”)
Shadow Mediator ⁴	Tan Pei Han, IPOS Young IP Mediator ⁵
Date of Mediation	12 April 2023
Mode of Mediation	Online via Webex

Background

The Mediation revolved around two Singapore entities, Mr Kopi (UEN No. 53453746D) of which Mr Gan is the sole proprietor (“Opponent”) and SG Mr Kopi Pte Ltd (UEN No. 202200170Z) (“Applicant”).

The Opponent’s principal activity involves the wholesale of coffee, cocoa and tea; while the Applicant’s principal activity relates to food kiosks, mainly for takeaway and delivery.

On 8 February 2022, the Applicant applied for the registration of Trade Mark No. 40202202795Q in Class 30 (“Application Mark”) with the Intellectual Property Office of Singapore (“IPOS”) as follows:



¹ The Opponent was not represented for the mediation.

² As above.

³ The World Intellectual Property Organization Arbitration and Mediation Center’s only office outside Geneva, Switzerland, is in Singapore.

⁴ It is a condition of funding under the IPOS Revised Enhanced Mediation Promotion Scheme (“REMPS”) that parties allow a “shadow” mediator to sit in and observe the mediation.

⁵ The IPOS Young IP Mediator initiative was launched with the objective to give more exposure and build up experience among those who may mediate or represent parties in IP mediation in future.

On 14 April 2022, the Opponent filed an opposition to the registration of the Application Mark on the basis that when it is viewed as a whole, it will *not* be perceived as imaginative, such that it will *not* be easily remembered by the relevant public in relation to coffee products. It is therefore devoid of any distinctive character.

The Opponent had also stated in its opening statement that it had been using the sign, “Mr Kopi”, since 16 October 2021 in Singapore. The Opponent also mentioned that sometime in or about 2021, it had engaged an independent designer to create and design its logo, which also consists of an animated coffee bean.

After the parties exchanged their pleadings in the opposition proceedings, they were invited to consider mediation as an option to resolve the dispute. The parties agreed to attempt mediation administered by WIPO Center.

Under IPOS’ Revised Enhanced Mediation Promotion Scheme (REMPS), the parties in a mediation case can receive reimbursement of mediation costs, up to S\$10,000 (where only Singapore IP rights are involved) or S\$14,000 (where both Singapore and foreign IP rights are involved).⁶

Pre-Mediation Opening Statements

Prior to the mediation on 12 April 2023, the parties submitted their respective opening statements to the mediator, Mr Chan. These opening statements provided a glimpse into the parties’ legal positions as well as a brief timeline of events. Through the parties’ respective assertions, we were afforded a small window to identify the parties’ possible interests and motivations. However, there were still many gaps which were only eventually filled at the actual mediation.

Mediation Process

The mediation was conducted online via Webex, hosted by the WIPO Center. This was conducive to the mediation as the parties had to contemplate many different classes of goods and services in relation to the mark/sign⁷ in light of their future plans for expansion. By sharing his screen, Mr Chan could ensure that the parties were on the same page and walk them through the different classes of goods and services on the IPOS Digital Hub⁸ that were or may be applicable.

With the list of industry-specific classes in front of them, the parties could better identify what their interests are, be it now or in the future. This helped parties to assess if there was any possible room for compromise and aided the parties in their cost-benefit analysis in coming to a settlement agreement (“Agreement”).

Challenges

There were two main challenges during this mediation.

Firstly, while the parties entered the mediation with open minds and were willing to find a mutually-beneficial solution, they had differing ideas of what “co-existence” looked like. Mr Chan invited each

⁶ It is a condition of funding under the REMPS that parties agree to named publicity, without the need to disclose specific details of the settlement agreement and thus this article.

⁷ The Application Mark as well as “Mr Kopi”. Marks/signs are registered/used in relation to goods or services. In Singapore, goods or services are classified in accordance with the Nice Agreement.

⁸ This is IPOS’ electronic platform for its digital services.

party to consider how co-existence might look like from a legal and a practical perspective. The parties were then able to come to a better understanding of the matter.

Additionally, Mr Chan also walked parties through their alternatives. This aided the progress of the mediation as parties had a better appreciation of the benefits of working together during the mediation instead of proceeding for a hearing. The parties were businessmen and understood the need for their principles and positions to be anchored in numerical reality.

Secondly, the parties had some issues when finalising the Agreement. The Opponent and the Applicant had concerns about the wording of an obligation and could not come to terms with how it should be reflected in the Agreement. The Opponent preferred to keep the Agreement simple and straightforward, while the Applicant preferred to ensure that the Agreement was comprehensive. Although the parties were in concurrence on the final outcome of the mediation, they were stuck at an impasse in relation to this issue. Mr Chan then suggested reframing the specific obligation as a declaration to be set out in the preamble of the Agreement instead. The parties were comfortable with this approach, which was adopted in the Agreement, leading to a satisfactory conclusion of the matter at the end of the day.

Reflections

The Applicant commented that “[t]he case was settled amicably between [the parties]” and that “[t]he mediation process was quick, effective and resulted in a mutually acceptable resolution”.

Similarly, the Applicant’s lawyer, Mr Gaznavi, remarked that “[t]he mediation process was highly successful and constructive...[both parties came] to a friendly resolution”.

Mr Chan, the mediator, shared that parties “had quite a difficult start” but that he was very happy when the parties started to problem solve and implement the solution together. In this case, by addressing the interests of the respective parties and reaching an amicable settlement, parties were able to avert a hearing, thereby “saving time and costs”.

On mediation in general, Mr Chan opined that “[b]usinesses should seriously consider mediation as a way to resolve their differences as [mediation allows parties] to look at a dispute from [their respective different] viewpoints...and apply a problem-solving lens to the dispute”.

On a personal note, as a shadow mediator, I am grateful for the opportunity to be part of an IP mediation.

In school, I only had the experience of role-playing in hypothetical mediations. In these hypothetical mediations, the mediators’ brief often had more context and information about the parties’ respective backgrounds and at times, their longstanding relationship. Here, however, information about the parties’ relationship, interests, alternatives and options were limited. As such, before going into the mediation, I felt that the success of the mediation would depend on many factors, such as the parties’ willingness to collaborate and be open about their concerns, as well as the mediator’s experience and commercial sensitivity.

During the mediation, the parties had plenty of opportunities to speak with Mr Chan privately without the other side’s presence. As a result, the parties were comfortable and introduced new information that was previously not in their pre-mediation opening statements. This helped us get a better grasp on where the parties were coming from, and Mr Chan was able to build some rapport with the parties.

It was also very instructive to watch Mr Chan guide the parties towards a fairer assessment of their own positions, be it through asking pointed questions or explaining how trade mark proceedings are carried out. He was patient but firm with both parties. He struck a fine balance between listening to each party's reasoning and testing the practicality and sustainability of their positions.

Conclusion

The mediation lasted close to 8 hours and culminated in the Agreement that addressed both parties' interests. The parties were also able to fulfill their respective obligations according to the Agreement within the same day. Had the parties elected to proceed with the opposition proceedings, the parties would have had to incur substantial time and costs.

Disclaimer

The views expressed in this article, save for the parties' and mediator's comments, are the author's own.

Written by Tan Pei Han, Young IP Mediator
16 May 2023

Mediation Success at IPOS

Worldwide Bible Society (Singapore) & The Bible Society of Singapore [2022] SGIPOS MED 3

	Party A	Party B
Name	Worldwide Bible Society (Singapore)	The Bible Society of Singapore
Nationality / Country of Incorporation	Singapore	Singapore
Representation	Goodwins Law Corporation	Rajah & Tann Singapore LLP
Lawyers	Tan Teck Hian Wilson	Gregory Vijayendran, Senior Counsel Edina Lim Tomoyuki Lewis Ban

Mediation Institution	World Intellectual Property Organization Arbitration and Mediation Center ¹
Co-Mediators	Reverend Terry Kee Buck Hwa (“Rev Kee”) ² Professor Ng-Loy Wee Loon, Senior Counsel (Honoris Causa) (“Prof Ng-Loy”) ³
Shadow Mediator ⁴	Benedict Koh Yen Hin, IPOS Young IP Mediator ⁵
Date of Mediation	12 January 2022 ⁶

Background of the Parties

The Worldwide Bible Society (Singapore) (“Applicant”) is an organization which is a part of an international group of organizations whose mission is to translate Bibles into modern-day Chinese and to promote God’s Word.

The Bible Society of Singapore (“Opponent / Registered Proprietor”) is a registered society in Singapore since 1837 and also a part of a global movement whose mission is to spread the Word of God and is the largest supplier of all kinds of Bibles and Scriptures in all kinds of language to churches and Christian bookshops. The Opponent / Registered Proprietor also equips churches in Singapore and other parts of the world to share the Bible, and acts as an integrated Bible agency that helps people

¹ The World Intellectual Property Organization Arbitration and Mediation Center’s only office outside Geneva, Switzerland is in Singapore.

² Rev Kee is a pastor of Jurong Christian Church (Chinese). He has been a pastor of the Lutheran Church in Singapore since 1982. He was elected Bishop of the Lutheran Church in Singapore in 2009 and stepped down in 2021 after completing 3 terms of service as Bishop. He has also served as President of the National Council of Churches from 2012-2014 and 2018-2020.

³ Prof Ng-Loy teaches at the National University of Singapore, Faculty of Law and is an expert in the field of Intellectual Property (“IP”) Law.

⁴ It is a condition of funding under the IPOS Enhanced Mediation Promotion Scheme (“EMPS”) that parties allow a “shadow” mediator to sit in and observe the mediation; or have a co-mediator to assist in the mediation.

⁵ The IPOS Young IP Mediator initiative was launched with the objective to give more exposure and build up experience among those who may mediate or represent parties in IP mediation in future.

⁶ Parties reached an in-principle agreement at the end of the mediation session on 12 January 2022. Thereafter, IPOS was informed on 9 May 2022 that parties have entered into a Deed of Settlement.

to understand its message, through proper Bible translation, publishing, and distribution, literacy programmes, and other engagement and advocacy events.

Background to the Dispute⁷

The Applicant applied to register a trade mark in Class 16 as a series of 8 marks:⁸



(“Application Mark”). The Opponent / Registered Proprietor opposed the registration of the Application Mark. The Applicant proceeded to apply to invalidate and/or revoke two of the marks registered earlier by the Opponent / Registered Proprietor:

BIBLE SOCIETY ;⁹and

圣经公会 .^{10 11}

The parties’ primary concerns included, among others, the confusion which could arise from the use of the term “Bible Society”, such that third parties could deem the Applicant and Opponent / Registered Proprietor to be the same entity or related entities.

⁷ It is a condition of funding under the EMPS that parties agree to named publicity, without the need to disclose specific details of the settlement agreement.

⁸ Trade Mark No. 40202014164X. The Chinese characters in the marks translate into “Worldwide Bible Society” and their transliteration is “Huan Qiu Sheng Jing Gong Hui”.

⁹ Trade Mark No. T1402310Z.

¹⁰ Trade Mark No. T1402313D.

¹¹ The Chinese characters translate into “Bible Society” and their transliteration is “Sheng Jing Gong Hui”.

In this vein, the parties went for mediation, with a view towards resolving their dispute amicably. The co-mediators appointed matched the Christian-centric and IP-focused nature of the dispute, bringing in a wealth of experience from their years of deep involvement in the Christian community and IP respectively.

Putting Theory into Practice – the Mediation Process

This was my first time experiencing an actual mediation from the perspective of a mediator. My prior experience in mediation primarily came from hypothetical exercises in mediator accreditation training and mediation-related competitions. In these prior endeavours, there was a stronger impetus for me to follow a standard method of demonstrating important theoretical mediation-related skills – including rapport-building, reality-testing, active listening, caucuses, etc.

While these skills are just as applicable in actual mediations, my experience shadowing this mediation cast the flexibility and practical nature of these skills into even greater light. In this piece, I will focus on two specific aspects of the mediation – (1) rapport-building and (2) option generation & reality-testing. These were crucial in guiding the parties towards amicably resolving their dispute.

Firstly, I was struck by the efforts taken in building rapport between the parties. The rapport-building in this mediation took place even from before the mediation session. Building on the parties' selection of the mediators, the mediators selected Jurong Christian Church as the mediation venue, to reinforce the common Christian-centric nature of both organizations' work. Building on this, the mediators reinforced the fundamental commonality between the parties at the opening of the mediation session, by reminding the parties of their common identity as Christian-based organizations, and that both parties have a common purpose of serving God.

These efforts set a firm and cohesive tone for the session, in no small part due to the commitment from the Applicant and Opponent / Registered Proprietor themselves. Both parties were forthcoming with their underlying concerns – both religious and commercial – and were mutually respectful to each other. They also both emphasized the importance of co-operation in contrast to competing against one another.

From this, the mediators gradually skilfully elucidated the parties' respective interests, and guided them past merely recognizing their common ground, towards collaborating to fulfil both their underlying interests. The mediators also took additional care to ensure that both parties felt heard whilst channelling their emotions in a healthy and productive manner. I was impressed with how the mediators actively opted to not intervene at certain junctures of the mediation session. This allowed parties to engage with each other more seamlessly. At appropriate junctures after the parties were given the space to articulate their emotions and concerns, the mediators then stepped in to reframe the parties' words, calling for private sessions at appropriate points, among other efforts.

Secondly, building on the rapport, the mediators also guided the parties in generating options for resolution, whilst reality-testing these options to ensure the viability and sustainability of the parties' eventual agreements.

For instance, the mediators facilitated the parties' rigorous reality-testing of options raised. One example of this came from the testing of the suggestion that the Applicant change its name. To this, the parties questioned whether the Applicant could even change its name unilaterally, given that it was a part of a wider international organization (the Worldwide Bible Society), and there could be

consequent cross-border implications stemming from a unilateral change of name of the Applicant organization.

The parties also worked towards generating creative options beyond the corners of the law. Among others, the parties discussed the possibilities of joint marketing and publicity initiatives as well as educational efforts, and the packaging of such undertakings together into alternatives which are satisfactory for both parties.

Takeaways and Reflections

The parties eventually reached an amicable settlement.¹²

One of the co-mediators, Prof Ng-Loy observed:

The dispute in this case was somewhat akin to a family dispute because the parties are, ultimately, members of the same family (the Christian community) and their dispute is over the use of words/terms that have special meaning to the family as a whole. For this reason, I am particularly gratified that the parties were able to reach an amicable resolution of their dispute. In my view, there are two vital factors that contributed to the successful outcome in this mediation. First, the respect that the parties showed to each other in spite of their divergent views in the matter, and they should really be commended for this. Second, the wisdom of both sets of lawyers as they guided their respective clients to explore solutions to the dispute. The important role that lawyers play in mediation cannot be overstated.

The lawyers for the Opponent / Registered Proprietor commented:

Having this mediation framework in place and the [Enhanced Mediation Promotion Scheme ("EMPS")]¹³ scheme proved an appropriate dispute resolution avenue, and sufficient incentivization,¹⁴ for parties to mediate the dispute. The mediation forum was an excellent port of call for parties to better understand each other's concerns and interests as well as providing a conciliatory, conducive and conclusive problem solving platform for parties. The mediators played a vital role in facilitating parties to move towards an optimal, win-win resolution with a relational approach, excellent temperament and expert perspectives. Without them, we would not have arrived at such a solution so fast or at all. In short, we are very pleased that the issues between parties have been resolved in a creative and cost-efficient manner.

On a personal note, I was heartened that the parties were able to arrive at an amicable resolution through the mediation. The mediation process provided the parties with a safe platform to articulate their concerns and reach mutually beneficial solutions beyond the corners of the law. As both a Christian and a budding mediator, I am immensely grateful that I could witness first-hand the practical application of the mediation skills I had learnt in my prior training, and in a religious context which I hold close to my heart. I sincerely look forward to applying these takeaways into my future practice

¹² As indicated above, parties reached an in principle agreement after the mediation session ended on 12 January 2022 and IPOS was informed that parties entered into a Deed of Settlement on 9 May 2022.

¹³ Parties received funding under the EMPS scheme as the mediation session was conducted on 12 January 2022. With effect from 1 April 2022, the Revised Enhanced Promotion Scheme ("REMPS") was launched. Under REMPS, parties could claim up to S\$14,000 (compared to S\$12,000 under EMPS) where foreign IP rights are involved or S\$10,000 where local IP rights are involved.

¹⁴ Under EMPS, parties are claiming S\$10,000 (this case only involves Singapore trade mark rights) between themselves to offset mediation related fees.

as a mediation advocate and a mediator, in turn paying forward the opportunities I have received, so as to continue working for the good of others.

Written by Benedict Koh Yen Hin, Young IP Mediator
19 July 2022

Mediation Success at IPOS

**Spiral Foods Pty Ltd
&
Nature's Glory Pte Ltd
[2022] SGIPOS MED 2**

	Party A	Party B
Name	Spiral Foods Pty Ltd	Nature's Glory Pte Ltd
Nationality / Country of Incorporation	Australia	Singapore
Representation	Donaldson & Burkinshaw LLP	One Legal LLC
Lawyers	Chua Shang Li Michelle Eadie	Regina Quek Genevieve Chia Dillon Marc Tan

Mediation institution	World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) ¹
Mediator	Zechariah Chan, of Lee & Lee
Shadow Mediator²	Keith Wong, Young IP Mediator
Date of Mediation	25 February 2021

Backdrop to the Dispute

The humble soybean is the most economically important bean in the world³ and is enjoyed by consumers in various forms. This ubiquitous bean forms the backdrop to the present dispute between Nature's Glory Pte Ltd (the "Applicant") and Spiral Foods Pty Ltd (the "Opponent"), two successful family-run businesses with a longstanding presence.⁴

The Opponent is an Australian organic food wholesaler and current proprietor of the "BONSOY" trademark in multiple jurisdictions including Singapore. "BONSOY" soymilk is manufactured and supplied internationally by Muso Co Ltd. ("Muso"), a Japanese Company.

The Applicant was founded in 1991 and is a retailer and distributor in Singapore offering a range of products from fresh produce to foodstuff and related goods. From 1991 to 2007, the Applicant entered into an agreement with Muso to be the exclusive distributor of "BONSOY" soymilk in selected territories. During this period, the Applicant registered the "BONSOY" mark in Singapore in 2004. The registration of this mark was disputed by the Opponent in 2007.

In resolving this earlier dispute, the Applicant transferred its rights in the Singapore trademark registration to the Opponent under a formal deed with the Opponent and Muso ("BONSOY Deed"),

¹ The WIPO Center's only office outside Geneva, Switzerland is in Singapore.

² It is a condition of funding under the IPOS Enhanced Mediation Promotion Scheme (EMPS) that parties allow a "shadow" mediator to sit in and observe the mediation; or have a co-mediator to assist in the mediation. The objective is to give more exposure on how mediation can resolve IP disputes and build up experience among those who may mediate or represent parties in IP mediation in future.

³ <https://www.britannica.com/plant/soybean>

⁴ It is a condition of funding under the IPOS EMPS that parties agree to named publicity.

conferring the Applicant with exclusive rights to distribute Muso's "BONSOY" products in selected territories. This was to be renewed automatically on an annual basis, unless terminated upon agreement by all the parties.

In 2016, the Opponent terminated the BONSOY Deed, which the Applicant disputes. This served as an impetus for the Applicant to develop its own independent brand of soymilk for market to the world without any restrictions by the Applicant.

The Applicant's own "BeoSoy" Brand and the Present Dispute



In Singapore, the Applicant applied to register its independent brand (the "Application Mark") in Class 29, for the use of soybean in edible food and drink. Noticeably, the Opponent has also opposed the Applicant's applications to register the Application Mark in Malaysia, Indonesia, Australia, the European Union and the United States of America. The mediation process was commenced due to the opposition against the Singapore application, which forms the present dispute.

Since 2019, both parties attempted to resolve the present dispute through a series of offers and counterproposals. Having reached an impasse, parties submitted the matter to mediation administered by the WIPO Center. While the dispute qualified for the Enhanced Mediation Promotion Scheme ("EMPS")⁵, EMPS funding did not need to be applied to the mediator's fees as parties had the benefit of complimentary mediation services offered by the WIPO Center. In light of the global economic difficulties from COVID-19, WIPO Center offered mediation services at no charge for mediation requests filed within the period 12 June to 31 August 2020. As part of the EMPS, Keith Wong, a IPOS Young IP Mediator was invited to shadow the mediation with the appointed mediator, Mr. Zechariah Chan, a renown intellectual property Partner at Lee & Lee.

The Mediation Process

Given the cross-border nature of the dispute, parties met virtually via Zoom videoconferencing. The session commenced with a pre-mediation conference where counsel was engaged to help identify certain challenges that might arise during the mediation. This was useful in promoting a positive and professional approach towards resolving the dispute. Once the mediation commenced proper, the family representatives of both parties entered the virtual room. Initially, it appeared that the long-standing business relationship between parties could form a common point of reference to work from. However, it was soon apparent that any assumed trust and mutual understanding which might have existed in 1991, no longer applied in the same form today. Despite their differences, it was nevertheless a valuable forum for the family representatives to speak directly to one another and better understand each other's perspective of the situation.

Moving from the joint session involving all parties, the mediator commenced a series of private sessions with each family representative and their counsel. As parties were willing to re-evaluate their earlier offers to one another, the mediation continued in this mode where proposals were continuously assessed and revised. This was possible because of the non-prejudicial and confidential nature of private sessions which resulted in candid and thoughtful discussion.

⁵ It is a condition of funding under the IPOS EMPS that parties' mediation-related lawyer fees and disbursements are only funded up to 50%, regardless of the total funding potentially available (\$10,000 where only Singapore IP rights are involved / \$12,000 where Singapore and foreign IP rights are involved).

Due to time zone differences between Australia and Singapore, the Opponent sought leave from the mediation. Nevertheless, close to 7 hours of constructive engagement resulted in a revised offer made by the Applicant to the Opponent. Overall, the mediation provided a more concrete path for parties to evaluate their progress and work constructively towards a commercially sensible resolution in a good faith approach.

Reflections

To gain a deeper perspective on the value of mediation for IP disputes, IPOS was privileged to hear from all parties involved, namely:

- The mediator, Mr. Zechariah Chan (“**ZC**”);
- Counsel for the Opponent, Mr. Chua Shang Li (“**CSL**”);
- Counsel for the Applicant, One Legal LLC (“**OL**”);
- The Marketing Manager of the Opponent, Ms. Raphaelle Wilson (“**RW**”); and
- The Director of the Applicant, Mr. Christopher Lim (“**CL**”).

Q1: In your view, how was this mediation helpful to this particular IP matter?

ZC: Whilst the mediation was commenced due to the Singapore opposition, it was quickly apparent that the parties faced similar issues in other territories as there were ongoing opposition matters in Malaysia, Indonesia, Australia, the European Union and the United States of America, at various stages of progress. This presented the parties with an opportunity to resolve the issues by adopting a “whole of dispute” mindset to bring all the differences to bear, rather than tackle each opposition on a piece-meal, territory by territory basis. As such, parties were able to discuss matters beyond the Singapore opposition, sharing ideas and potential options for settlement on a global basis. It also meant that the settlement proposals took into account the parties’ interests and concerns.

CSL: I felt that the mediation was useful as it allowed parties to expedite the ongoing negotiations. It was good that parties had an opportunity to have a face-to-face (albeit online) meeting so that they could share and express their positions on the matter.

RW: The mediation did allow us to make some significant progress in negotiations that had stalled, allowing a resolution to be reached.

CL: The mediation was well-organised. Additionally, the mediator was impartial, patient, and took the time to understand the background and interests of both parties.

Q2: Compared to in-person mediations, what do you think are some benefits of mediations conducted virtually?

ZC: Despite the fact that the parties were based in different countries, mediation over an online platform meant that parties did not need to travel in the midst of the COVID-19 pandemic. This made the mediation a safer and more economical way to meet, discuss and negotiate with each other. It also allowed counsel to celebrate the birthday of a family member, something that would not have been possible if there was travel, particularly international travel, involved for the purposes of the mediation.

OL: As not all parties were located in Singapore, the mediation was conducted online over Zoom. The mediation provided the parties with the opportunity to speak face-to-face and to make further

progress in ongoing negotiations. We are likely to use and/or recommend mediation again for future IP disputes.

Written by Keith Wong, Young IP Mediator
24 March 2022

Mediation at IPOS

**Leonid Kovalkov
&
JNBK Group Private Limited
[2022] SGIPOS MED 1**

	Party A	Party B
Name	Leonid Kovalkov	JNBK Group Private Limited / Tan Siew Keng Angeline
Nationality / Country of Incorporation	Singapore	Singapore
Representation	Tito Isaac & Co LLP	Ignatius J & Associates
Lawyers	Adly Rizal	Ignatius Joseph

Mediation institution	Singapore Mediation Centre
Mediator	Assoc Prof Lum Kit-Wye
Shadow Mediator	Mr Tok Boon Leong
Date of Mediation	15 October 2019

The parties in this mediation had been embroiled in several disputes before IPOS since 2012, including several which proceeded to full hearings and resulted in three full grounds of decision¹ issued by the Registrar. While the parties were unable to conclude a mediation settlement agreement, the two proceedings which were the subject of the mediation were withdrawn.² As at 21 December 2021, there are no other pending disputes between the parties. This case showcases the value of mediation even when no final settlement agreement is reached.

Background and Dispute

Mr Leonid Kovalkov (the “Applicant”)³ is in the business of dealing with motor vehicles spare parts. JNBK Group Private Limited (Ms Tan Siew Keng Angeline is the sole director and shareholder of the same) (the “Registered Proprietor”) is in the business of the sale and distribution of brake related components for vehicles including, brake pads. The parties were originally business partners but the relationship deteriorated.

The Dispute



The Registered Proprietor owned the following registered trade marks:

¹ They are:

- (i) *Leonid Kovalkov v Tan Siew Keng, Angeline* [2016] SGIPOS 10;
- (ii) *Leonid Kovalkov v Tan Siew Keng, Angeline* [2012] SGIPOS 5; and
- (iii) *Tan Siew Keng, Angeline v Leonid Kovalkov* [2012] SGIPOS 6.

² Party A’s letter of 10 August 2021.

³ For both the Invalidation and Revocation proceedings (see below).

40201706066P ("Mark 1")	T0312074E ("Mark 2")
	
<p>Class 12 Vehicles; apparatus for locomotion by land, air or water; Vehicle brake pads; Brake components for vehicles; Vehicle brake discs; Wheel brakes; Vehicle brake shoes; Brake linings for vehicles; Brake drums for vehicles; Brake levers for vehicles; Vehicle suspensions; Automobile engines; Actuators for land vehicles.</p>	<p>Class 12 Brake pads for vehicles; brake shoes for vehicles; brake lining land vehicles; suspension parts for vehicles.</p>

The mediation stemmed from two disputes:

- (i) An application to invalidate Mark 1 on the basis that it should not have been registered as a trade mark; and
- (ii) An application to revoke Mark 2 on the basis that has not been used for a period of at least five years.

The effect of a successful invalidation differs from that of a successful revocation. Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.⁴ In contrast, where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from the date of the application for revocation.⁵

At the Pre-Hearing Review ("PHR") for Mark 1,⁶ the Registrar broached the option of mediation to resolve the dispute. Thereafter, the parties agreed to submit the dispute to mediation under the auspices of the Singapore Mediation Centre ("SMC").⁷ Similarly, the parties notified the Registrar at the PHR for Mark 2⁸ that they wished to mediate the dispute together with Mark 1.

The Mediation

Under IPOS' EMPS, the parties could receive funding of S\$12,000 for the mediation as the subject matter of mediation involved both Singapore and foreign IP rights.⁹

⁴ Although this shall not affect transactions past and closed (Section 23(10) of the Trade Marks Act (Cap 332, 2020 Rev Ed).

⁵ This is the default position and the parties can claim for an earlier revocation date (see Section 22(7) of the Trade Marks Act (Cap 332, 2020 Rev Ed).

⁶ On 13 June 2019.

⁷ As per IPOS letter of 2 Aug 2019, via the Applicant's letter of 23 July 2019.

⁸ 10 July 2019.

⁹ However, given that the parties were unable to reach any settlement, there was no resolution with respect to these either.

The parties indicated in their Request for Mediation that the quantum of dispute was not monetarily quantifiable and they deferred to SMC for the appointment of suitable mediators. Based on the above information as well as the nature of the dispute, SMC then appointed a mediator from its Principal Mediator Panel who had a background in Intellectual Property laws/disputes. The shadow mediator was appointed from SMC's Associate Mediator Panel.

The mediation¹⁰ took place on 15 October 2019.¹¹ As mentioned above, while the parties were unable to reach a settlement agreement then, the proceedings before IPOS were ultimately withdrawn. Had the parties decided to continue fight it out in an adversarial setting, it would have taken much more time and both parties would have incurred substantial costs. It is also notable that, after close to 10 years, there are now no more pending disputes between the parties.

Mr Tok, the shadow mediator, commented that mediation allows for flexibility, in contrast to court proceedings. Mediation procedures are also simple to understand. Mediation is confidential, so that the parties can prevent any negative publicity of their dispute / leakage of sensitive commercial information to their competitors. Last but certainly not least, the informal process of mediation translates into time and costs savings for the parties.

One significant advantage of the mediation process is that the mediator assists the parties to communicate with one another, such that they *understand their differences and aspirations*. Crucially, the parties can actively engage one another so as to reach *win-win solutions which are mutually acceptable*.

Mr Tok commented that at the end of the mediation session, the parties were light hearted and remarked that the mediation has enabled them to *move forward*, which is significant, in light of the differences the parties have accumulated over the *past 17 years* of their business relationship.

In this regard, the Applicant agreed that the process of mediation has allowed both parties to *openly air their views*, which is extremely helpful in light of the fact that there has been a lot of history between the parties.

14 January 2022

¹⁰ At the mediation, the parties were able to come to an agreement with respect to **Mark 1** such that the dispute then solely focused on **Mark 2** which was also the subject matter of a previous action by the **Applicant**.

¹¹ IPOS letter of 21 October 2019.

Mediation Success at IPOS

K & Q Brothers Electrical Engineering Co. Pte. Ltd.
&
K&Q Fatt Pte Ltd, Quek Jia Ling, Quek Hong Peng, Quek Jia Hao
[2021] SGIPOS MED 2

	Party	Party
Name	K & Q Brothers Electrical Engineering Co. Pte. Ltd.	1. K&Q Fatt Pte Ltd 2. Quek Jia Ling 3. Quek Hong Peng 4. Quek Jia Hao
Nationality / Country of Incorporation	Singapore	Singapore
Representation	Kalco Law LLC	Ravindran Associates
Lawyers	Xhuanelado Owen	Alvin Lim

Mediation institution	World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) ¹
Mediator	Jonathan Agmon, of Soroker Agmon Nordman
Shadow Mediator	Jocelyn Toh, of Soroker Agmon Nordman
Date of Mediation	18 November 2020

Background to the Dispute

The dispute involved two Singapore registered companies, K & Q Brothers Electrical Engineering Co. Pte. Ltd. (the Opponents) and K&Q Fatt Pte Ltd (the 1st Applicants). Both companies are in the business of manufacture, repair and wholesale of a variety of goods including refrigerators, air conditioning and ventilating machinery.

The Opponents have been registered in Singapore since 1989 and had successfully obtained registration of the trade mark “YODA” since 18 May 1994. “YODA” was registered in Class 11 in respect of refrigerators, food and drink chillers, freezers and ice machines. The Applicants have more recently attempted to register a trade mark called “YUDA”, similarly in Class 11, in the same trade and for the same purposes of utilisation as “YODA”.

The Opponents therefore opposed the registration of the Applicants’ trade mark “YUDA” on the alleged grounds of confusing similarity with the Opponents’ earlier trade mark, “YODA”.

Bridging the Divide

Parties had already filed their evidence and the dispute would have proceeded to a hearing had it not been settled. The Principal Assistant Registrar suggested, at the Pre-Hearing Review, that parties

¹ The WIPO Center’s only office outside Geneva, Switzerland is in Singapore.

consider WIPO's offer of free mediation² and attempt to resolve their dispute amicably. In the event that they could not settle, it was still open to parties to have a hearing.

Reaching a settlement was by no means an easy feat. The mediation ran parallel with ongoing shareholder dispute litigation between the parties and they were initially not on speaking terms. This was also essentially a family dispute. Parties have shared history, with the 1st Applicants' founder being a former director of the Opponents, and tensions were understandably high.

Ever the skilful and tactful mediator, Mr Jonathan Agmon managed to get both parties to resolve this trade mark dispute amicably.

The Mediation Process

Prior to the mediation on 18 November 2020, Mr Agmon made extensive preparations, including encouraging parties' mediation advocates to prepare comprehensive mediation statements. This was crucial in allowing Mr Agmon to visualise all angles for the co-existence of the two trade marks and businesses.

Mr Agmon graciously offered the office of Soroker Agmon Nordman as mediation venue. The mediation took place in person and comprised a combination of joint sessions, held in the firm's meeting room; and break-out caucus sessions, held in the rooms of the senior partners. It was a quiet and spacious office which provided a conducive environment for the mediation.

The first joint session was particularly helpful in bringing parties together. This allowed them to discuss and hear each other's positions. The caucuses were important for parties to consider and reflect on each other's positions and offers for settlement. Mr Agmon effectively used these private caucuses to persuade parties to compromise. Another joint session was used towards the end of the mediation to draft the settlement agreement and iron out the final details of the settlement before parties signed the co-existence agreement. All of this was achieved within a day.

Mr Agmon was friendly and kept a cheerful spirit which helped pave the way for parties to open up to each other. At the same time, he was firm and professional and dictated the pace of the mediation with great control. As the neutral mediator, his constant reality testing of the matter allowed parties to focus on commercial sensibilities and put their family dispute aside.

The constant emphasis on facilitating a resolution to the trade mark dispute allowed parties and their mediation advocates to focus on discussing ways of avoiding confusion for customers with the use of the respective marks, which allowed parties to see a possible reality for their respective brands and businesses to co-exist.

Had the parties decided to fight it out in an adversarial setting, it would have taken much more time and they would have incurred substantial costs. Mediation was thus a much more suitable platform for their dispute. The 1st Applicants' Business Development Director, Ms Janelle Quek, found the mediation "beneficial and fruitful" because it provided "a more effective and efficient means to resolve the dispute". She also said that the Applicants are "extremely grateful that the environment provided by the mediator was a very peaceful and pleasant one", which aided the negotiation process.

Mediation for IP Disputes

² In light of the global economic difficulties due to COVID-19, WIPO Center offered mediation services at no charge for mediation requests filed within the period 12 June to 31 August 2020.

With the conclusion of this successful mediation, Mr Agmon shared his views on the suitability of mediation for IP disputes:

“I consider IP disputes to be particularly suited for mediation not only because the process allows the parties to discuss freely and confidentially their interests but also because unlike court or tribunal proceedings, the process allows for out-of-the box solutions. Such solutions could in many cases bring the parties to an agreement where both parties benefit without the need to reach a judicial resolution and the costs involved.”

EMPS Funding

As the subject matter of mediation involved only Singapore IP rights, funding under the IPOS EMPS was capped at S\$10,000 in total (for the entire case involving two parties). The funding was applied to 50% of the parties’ mediation-related lawyer fees and disbursements³. In this regard, the Opponents received funding of S\$5,000 and the Applicants S\$2,675.

Written by Chloe Chua, Young IP Mediator
20 April 2021

Conditions of the Enhanced Mediation Promotion Scheme (EMPS)

The following conditions must be satisfied in order to qualify for funding under the EMPS:

- (i) Parties have an existing dispute before IPOS which is the subject-matter of a mediation on or after 1 April 2019, in any event, no later than 31 March 2022 or until the available funding is drawn down, whichever is earlier.
- (ii) The mediation takes place in Singapore. This may include the use of video-conferencing to involve party representatives who are not able to be present in Singapore during the mediation, as long as the mediator is physically in Singapore during the mediation, and is a Singaporean or is based in Singapore.
- (iii) Parties allow a “shadow” mediator to sit in and observe the mediation; or have a co-mediator to assist in the mediation.
- (iv) Parties disclose their lawyer / agent fees incurred from the start to the end of the IPOS proceedings.

³ EMPS funding did not need to be applied to the mediator’s fees as parties had the benefit of the complimentary mediation service offered by the WIPO Center.

- (v) Parties give feedback on their mediation experience.
- (vi) Parties agree to named publicity, excluding details of the settlement terms (such as the quantum of the settlement). The purpose of the named publicity is to give concrete, relatable examples to other businesses and individuals and thus encourage them to consider mediation. The amount of detail in the publicity is not expected to disclose much more than the identity of the parties, the nature of their disputes, the countries spanned by their disputes, the duration of their disputes, the parties' comments on the mediation process, any advice they have for others facing disputes etc.
- (vii) Parties co-pay at least 50% of their lawyer / agent fees relating to mediation (and mediation-related disbursements charged by the party's lawyer / agent).

Reflection on an IP Mediation by a Young IP Mediator

Stratech Systems Limited, The Stratech Group Limited & Chew Rong-Qi Phoebe, Chew Rong-Jie David [2021] SGIPOS MED 1

	Party	Party
Name	(i) Stratech Systems Limited (In Liquidation) (ii) The Stratech Group Limited (In Liquidation)	(i) Chew Rong-Qi Phoebe (ii) Chew Rong-Jie David
Nationality / Country of Incorporation	Singapore	Singapore
Representation	Rajah & Tann Singapore LLP	Ravindran Associates LLP
Lawyers	Nicholas Lauw	(i) Paul Teo (ii) Alvin Tan

Mediation Institution	World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) ¹
Mediator	Alban Kang, accompanied by Just Wang, both of Bird & Bird ATMD LLP
Shadow Mediator²	Levin Lin, IPOS Young IP Mediator
Date of Mediation	18 August 2020

Background³

To provide some context to this mediation, the parties involved were, on the one hand, individuals who sought to register the trade marks in issue (“the applicants”) and on the other hand, a company that opposed the registration of these marks (“the opponents”). The applicants were the children of the opponents’ ex-directors.

Application of Mediation Theory in the Mediation

As a shadow mediator at the mediation, it was my first opportunity to be part of an IP mediation and from the perspective of a mediator. Prior to the mediation, I had only experienced the application of mediation skills in the hypotheticals and roleplays that were given to me as part of my learning and training. The mediation was an enlightening experience, allowing me to observe the mediation theory and skills that I have learnt being applied in a commercial dispute.

¹ The WIPO Center’s only office outside Geneva, Switzerland is in Singapore.

² It is a condition of funding under the IPOS Enhanced Mediation Promotion Scheme (EMPS) that parties allow a “shadow” mediator to sit in and observe the mediation; or have a co-mediator to assist in the mediation. The objective is to give more exposure on how mediation can resolve IP disputes and build up experience among those who may mediate or represent parties in IP mediation in future.

³ It is a condition of funding under the IPOS EMPS that parties agree to named publicity, without the need to disclose specific details of the settlement agreement.

One thing that struck me right from the beginning of the mediation was the mediator's ability to build rapport with the parties and the respective counsel. Building rapport was always emphasised in training as a key component in any mediation as it helped to facilitate communication and build trust. This time, I was able to observe the effects of having good rapport and quickly came to the realisation that there is no one correct way to go about doing so. The mediator was able to communicate with the parties in a manner which allowed them to feel understood and heard. This was obvious through the occasions when the parties and counsel expressed that the mediator knows how they feel about certain issues and trust that the mediator would communicate their concerns to the other party. Having good rapport not only smoothed the communication between the parties and the mediator, it also enabled the mediator to reality test the parties when necessary. The mediator was able to ask questions and suggest limitations in a frank and honest manner while appearing to the parties that this was done trying to bring them to a solution together. It quickly helped the parties to realise the realities of their positions and how they had to manoeuvre through various other alternatives if they wanted to come to an agreement.

Online Mediation Process

A relevant point to building rapport and the application of mediation skills was the online nature of the mediation. With everyone in different locations for health and safety reasons, it led to me wonder how this has influenced the mediation process. For example, there were instances where the internet was not stable, causing parties to drop out of the joint meeting on the WebEx⁴ platform. Separately, there were also times when computer glitches led to parties' audio or visual dropping. While these were not frequent in the mediation that took place, it may have become distracting if major internet or audio issues had occurred. At the same time, I noticed that such instances actually provided the parties with the opportunity to make small talk.

Another thought that crossed my mind was the lack of a 'whiteboard' or 'paper' which allowed the mediator to present the options that were being discussed or to pen down ideas that were suggested by the parties. I find that visual presentation in face-to-face mediation helps parties to recognise where they are at with their discussion and how much more they need to traverse. Having the benefit of observing an online mediation, it allowed me to think more about how to best carry out the mediation process online and how to manage situations that would not have occurred in a face-to-face mediation.

Suitability of IP Matters Being Resolved by Mediation

Lastly, in my observation of the mediation, it stood out to me that the heart of the dispute was not simply commercial. One side had sentimental ties to the marks. This was a very human and emotional issue that is very suited to be resolved by mediation. I watched how the mediator navigated the emotions of the individuals by taking it step by step: listening to the applicants share about what the mark means to them, asking the applicants questions to understand and subsequently reframing their emotions to better explain it to the opponents.

The mediation process gave the applicants the time and space to talk about how they felt and to explore the various options before them. After hours of expressing what and how much the mark means to them, the applicants were more open and ready to move from their original position. The flexibility of the process and presence of a safe space vis-à-vis the parties and the mediator allowed the applicants to feel heard and understood. This was what I thought to have moved the mediation forward despite it being very much a commercial issue.

⁴ Parties separately arranged their respective private sessions with the mediator, on the Zoom platform.

Ending Thoughts

Although no resolution was arrived at during the mediation, the mediation provided the parties with the opportunity to clarify their concerns with each other and the presence of the mediator had influenced the way in which they approached the dispute as well. The mediation helped the parties to navigate the limits of what was acceptable to them and to address emotional issues that would have otherwise never been shared. It was an illuminating experience for a young mediator like me and it has taken me one step forward in my understanding and skills as a mediator.

Written by Levin Lin, Young IP Mediator
5 March 2021

Mediation Success at IPOS

Gromark Consumers Enterprise Pte. Ltd. & GK Laboratory (Asia) Pte. Ltd. [2020] SGIPOS MED 2

	Party	Party
Name	Gromark Consumers Enterprise Pte. Ltd.	GK Laboratory (Asia) Pte. Ltd.
Nationality / Country of Incorporation	Singapore	Singapore
Representation	Harry Elias Partnership LLP	Chow Ng Partnership
Lawyers	(i) Brian Law (ii) Tan Weiyi (iii) Esther Wee	Patrick Chow

Mediation institution	World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) ¹
Mediator	Andy Leck, of Baker McKenzie Wong & Leow LLC
Shadow Mediator²	Utsav Rakshit, IPOS Young IP Mediator
Date of Mediation	30 October 2020

Note: *This is the first successfully mediated case where a Young IP Mediator had a first hand experience of witnessing how a mediation was steered to success within a day. IPOS is grateful to the WIPO Center, Mediator Andy Leck, the parties and their lawyers for giving Mr Utsav Rakshit this invaluable opportunity. For more information about the Young IP Mediators initiative and Utsav's experiences in this case, see Annex A below. Please see the accompanying [media release](#).*

Gromark Consumers Enterprise Pte Ltd (the Opponent) is a beauty and supplement manufacturer, exporter and distributor in the cosmetic and cosmeceutical industry. Its products are sold in Singapore and various countries overseas, including China and Japan. Over the years, the Opponent has established its "Crystal Tomato" brand of products and has also registered numerous trade marks in Singapore and overseas.

GK Laboratory (Asia) Pte Ltd (the Applicant) is in the business of health supplements and aesthetic, beauty products and has sales both in the local and overseas market, particularly in China.

The Applicant applied to register "timeless tomato" in Classes 3, 5 and 35 (the goods mainly pertain to cosmetic preparations, nutritional supplements as well as retail / wholesale services relating to the

¹ The WIPO Center's only office outside Geneva, Switzerland is in Singapore.

² It is a condition of funding under the IPOS Enhanced Mediation Promotion Scheme (EMPS) that parties allow a "shadow" mediator to sit in and observe the mediation; or have a co-mediator to assist in the mediation. The objective is to give more exposure on how mediation can resolve IP disputes and build up experience among those who may mediate or represent parties in IP mediation in future.



same) (the Application Mark) as well as the logo in Classes 3 and 5 (similarly, the goods mainly pertain to cosmetic preparations and nutritional supplements).

The Opponent opposed the registration of the Application Mark³ on the basis that it would cause confusion in the market and adversely affect the “Crystal Tomato” brand.

After parties exchanged their initial pleadings in the opposition proceedings, they were invited to consider mediation as an option to resolve the dispute. Parties received information from IPOS on the Enhanced Mediation Promotion Scheme (EMPS), and agreed to try and resolve their dispute through mediation administered by the WIPO Center.

Under IPOS’ EMPS⁴, the parties could receive funding of S\$12,000 for the mediation as the subject matter of mediation involved both Singapore and foreign IP rights. Further, as parties applied for the complimentary mediation service offered by the WIPO Center,⁵ the full amount of the subsidy can be applied towards up to 50% of the parties’ mediation-related lawyer fees and disbursements.

The WIPO Center provided the parties with 3 proposed candidates for appointment as mediator. Parties agreed to appoint one of the candidates, Mr Andy Leck, who is a principal at Baker McKenzie Wong & Leow LLC, as the mediator.

Parties met in person on the day of the mediation and the session lasted about 8 hours. After a series of discussions, some of which took place in the presence of the mediator and some of which were amongst parties themselves, parties were able to resolve the disputed issues and finalise the terms of the settlement agreement. The outcome of the mediation was positive and met the commercial concerns and objectives of both parties, not only in respect of their businesses in Singapore, but also overseas.

Had the parties decided to fight it out in an adversarial setting, it would have taken much more time and both parties would have incurred substantial costs.

Both parties were satisfied with the mediation process.

The Opponent’s Managing Director, Ms Catherine Tan, said, “We are grateful to the mediator for helping to facilitate the negotiations between the parties. It means a lot to us and our business that this mediation was successful. We not only managed to resolve the underlying disputes to reach an amicable resolution, but we also took a step forward in safeguarding the reputation of our brand and business in Singapore and overseas.”

³ The mediation additionally included the logo mark, which was not opposed.

⁴ It is a condition of funding under the IPOS EMPS that parties agree to named publicity, without the need to disclose specific details of the settlement agreement.

⁵ In light of the global economic difficulties due to COVID-19, WIPO Center offered mediation services at no charge for mediation requests filed within the period 12 June – 31 August 2020.

The Applicant's Director, Mr Stanley Siu, indicated that it is likely to use mediation again and commented that mediation is "[l]ess stressful and quicker in result. Parties have the opportunity to understand each other's case and to negotiate in a more business-like manner with less animosity".

The Opponent's agent, Ms Tan Weiyi, Partner at Harry Elias Partnership LLP added, "[a]s solicitors for our client, we are pleased that parties were able to resolve the dispute through the mediation process and reach a resolution that addressed the commercial concerns and objectives of both parties."

7 December 2020

Annex A

Young IP Mediators Initiative – Student Mediator Participates in his First Mediation Success Case

1 The Young IP Mediators initiative (YIPMI) was launched by Second Minister for Law Edwin Tong on 26 August 2020 during the annual IPOS flagship event, IP Week@SG. The initiative seeks to nurture and build up IP mediation experience among our youth by giving them an opportunity to be involved in mediation.

2 This is the first successfully mediated case where a Young IP Mediator had a first hand experience of witnessing how a mediation was steered to success within a day. Under the lead of experienced mediator, Mr Andy Leck, Mr Utsav Rakshit, a final year student at the National University School of Law (NUS), participated in a mediation involving a multi-jurisdictional trademark dispute.

3 About the YIPMI, Professor Joel Lee from NUS opined, “The YIPMI allows for the nurturing of the next generation by giving them an opportunity to be involved in mediation, and specifically in Intellectual Property mediations. This will grow a generation of mediation-friendly IP mediators and advocates which will then feed into the mediation ecosystem.”

4 Similarly, Professor Nadja Alexander, from the Singapore Management University School of Law (SMU), commented, “The [YIPMI] is a wonderful initiative that allows students and young mediators to get their teeth into real life mediation cases by shadowing an experienced mediator in an actual case. Students learn practical skills and mediation theory at courses we teach...The [YIPMI] allows them the opportunity to complete the practical experience by seeing how a real-life dispute is mediated. This is a precious opportunity for our students, especially since they are also given the opportunity to interact with a seasoned mediator and to learn from his/her experiences.”

5 Indeed, Mr Rakshit has found this experience extremely meaningful. He reflects, “I had thoroughly enjoyed the process and had the chance to learn a lot just from observing Mr Leck in terms of his demeanour, how he reframed matters, his choice of words, and how he kept the parties on track and assisted in generating options.” Commenting on the Young IP Mediator, Mr Leck shared “I hope [Utsav], as a shadow mediator, managed to experience first-hand how a mediation is conducted from the perspective of the mediator. This initiative may hopefully spark interest in mediation and IP in the future generation of young lawyers.”

6 Ms Chiara Accornero, representative of the World Intellectual Property Organisation (WIPO) Arbitration and Mediation Center in Singapore (the only office outside Geneva), commented, “ As effective mediation proceedings depend to a large extent on the quality of the mediator, we fully support IPOS new [YIPMI] to offer hands-on training and exposure to real mediation practice to motivated law graduates interested in mediation. We are delighted that a number of IPOS Young IP Mediators were able to shadow some WIPO mediations and we hope that this will contribute to further build IP mediation experience and awareness.”

7 Commenting on the early success of the YIPMI, Mr Mark Lim, Chief Legal Counsel, and the Director of the Hearings and Mediation Department of IPOS, which played an integral role in the genesis of this initiative, stated, “We are delighted that our appointed Young IP Mediators have been offered hands-on induction and exposure to real mediation practice. This move is part of our continuous capability building effort to raise the next generation of IP mediation expertise, and it complements Singapore’s drive towards becoming a global IP dispute resolution hub.”

Mediation Success at IPOS

Eley Trading Sdn Bhd & Kwek Soo Chuan [2020] SGIPOS MED 1

	Party	Party
Name	Eley Trading Sdn Bhd	Kwek Soo Chuan
Nationality / Country of Incorporation	Malaysia	Singapore
Representation	Ravindran Associates LLP	Bird & Bird ATMD LLP
Lawyers	Paul Teo	(i) Alban Kang (ii) Just Wang

Mediation Institution	World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) ¹
Mediator	Joyce A. Tan, of Joyce A. Tan & Partners LLC
Shadow Mediator²	Cheryl Lim, of Joyce A. Tan & Partners LLC
Date of Mediation	17 September 2020

Background to the Dispute³

This dispute revolves around the Singapore registered trade mark 菩提 (“Bodhi” in English) in Class 4. Mr Kwek Soo Chuan owns this trade mark and was the sole proprietor of Bodhi Buddhist Products in Singapore, which is in the business of distributing Buddhist religious products. The other party, Eley Trading Sdn Bhd (Eley) is a Malaysian manufacturer and distributor of Buddhist religious goods in Malaysia, Thailand, Indonesia, Hong Kong and Singapore.

The parties had an earlier dispute over the same mark in Class 3. Subsequently, Eley commenced 3 other invalidation proceedings against Mr Kwek in 2018, of which 2 were settled, leaving only the invalidation proceedings against the 菩提 mark in Class 4. This was the subject of the present mediation.

The Seemingly Unbridgeable Gap

The parties had already filed their pleadings and evidence and were on the brink of another hearing. The only thing standing in between was mediation. The parties were strongly encouraged by the Registrar of Trade Marks to mediate since there was only one outstanding dispute after their own negotiations settled the 2 other invalidation actions.

¹ The WIPO Center’s only office outside Geneva, Switzerland is in Singapore.

² It is a condition of funding under the IPOS Enhanced Mediation Promotion Scheme (EMPS) that parties allow a “shadow” mediator to sit in and observe the mediation; or have a co-mediator to assist in the mediation. The objective is to give more exposure on how mediation can resolve IP disputes and build up experience among those who may mediate or represent parties in IP mediation in future.

³ It is a condition of funding under the IPOS EMPS that parties agree to named publicity, without the need to disclose specific details of the settlement agreement.

Once the parties submitted their dispute to mediation under the World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center), Ms Chiara Accornero, the WIPO Center's representative in Singapore, rendered strong support and timely guidance to the parties. The appointment procedure followed Article 7(a) of the WIPO Mediation Rules. The WIPO Center prepared a shortlist of three possible mediators, taking note of the subject matter of the case and the preference of the parties for a mediator specialised in IP law and of one party for a Mandarin-speaking mediator⁴. The parties ranked the shortlisted names by preference and, based on both parties' rankings, Singaporean mediator, Ms Joyce A. Tan of Joyce A. Tan & Partners LLC, was appointed.

Prior to the mediation, Ms Tan, the mediator, held separate preparatory sessions with each party. Having heard from both sides, she realized that it would be a difficult mediation as there was "a great and apparently unbridgeable distance between them".

The Mediation Process

The mediation was entirely conducted online on the WebEx platform, hosted by the WIPO Center. There were certain challenges associated with the mediation process. First, Ms Tan was acutely sensitive to the possibility of online fatigue from showing up in an all-day online engagement. Accordingly, to address this, she let the parties take turns to come online.

A unique feature of WIPO's online service is a virtual private room, with extended duration availability, which promoted the use of multiple private sessions with the relevant parties. Even though both parties were present throughout the session, the mediation was largely conducted via multiple private sessions with each party, without the presence of the other. The only exceptions were during the opening and closing sessions.

Second, there was a language barrier. The mediation was held in English whilst the parties were more comfortable speaking in Mandarin. The most significant of those barriers were the impasses at pivotal moments which seemed unsurmountable and at one point it appeared that a settlement was out of reach. However, it all boiled down to trusting the mediation process. For Ms Tan, it simply became a matter of not giving up, and "letting hope spring eternal and ceaselessly deploying the imagination to convey an empathetic rhetoric to each party, in eventually finding solutions for a settlement that both sides would be happy with".

The Settlement Agreement

True enough, at 8.30 p.m., after 10 ½ hours of mediation (and a lunch break), both parties came to an amicable solution and signed off on the settlement agreement. Mr Kwek was satisfied with the mediation process, and the support provided by the mediator and the WIPO Center. Notwithstanding the language barrier, the mediation was able to proceed effectively with translation support from parties' counsel. Eley found the pre-mediation session very useful as it saved time at the actual mediation. This was the first time Eley used mediation to resolve a dispute, and it was likely to both use mediation again and recommend it to others.

Mediation as the Way Forward

At the conclusion of yet another successful mediation, we had an opportunity to chat with Ms Tan.

⁴ Before the shortlist is prepared, parties are able to state their preferences or requirements for a mediator e.g. qualifications, expertise, nationality, languages spoken etc.

Q: How is mediation an appropriate way to address IP disputes?

A: I find that mediation is particularly suited to the resolution of cross-border IP disputes, whether involving parties from different jurisdictions and/or IP existing under the laws of different jurisdictions, as these require the handling of potentially complex legal technicalities, formalities and/or boundaries. Mediation can liberate the parties from having to navigate these commercially artificial barriers and allow them to focus on business-oriented considerations in finding solutions which are meaningful to them in relation to the IP concerned and the marketplace involved.

Q: Are there any particular trends you notice in IP mediation?

A: Anecdotally, I sense a growing amiability towards mediation for the resolution of such disputes, perhaps due to the documented positive experiences of others and the widening awareness and better understanding of mediation for what it is, what it can do and how it works. In a nutshell, mediation can dissolve barriers, be they of a legal, geographical, technical, financial, commercial or formal nature, that can otherwise keep disputants apart or a dispute alive.

Written by Utsav Rakshit, Young IP Mediator
7 December 2020


Mediation Success at IPOS

Suravit Kongmebhol & Aftershokz, LLC [2019] SGIPOS MED 1


	Party	Party
Name	Suravit Kongmebhol	Aftershokz, LLC
Nationality / Country of Incorporation	Thailand	United States of America
Representation	That.Legal LLC	(i) Foo & Quek LLC (ii) NLC Law Asia LLC
Lawyers	(i) Mark Teng (ii) Lim Tianjun	(iii) Ng Lip Chih (iv) Alex Goh

Mediation institution	World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) ¹
Mediator	Joyce A. Tan, of Joyce A. Tan & Partners LLC
Shadow Mediator²	Cheryl Lim, of Joyce A. Tan & Partners LLC
Date of Mediation	30 August 2019 to 31 August 2019

Bone conduction technology allows the deaf to hear and swimmers to listen to music underwater. It works by conducting sound through the hearer’s bones to the inner ear, in contrast to conventional technology which conducts sound through air. With this promising technology as the backdrop, in 2012, Aftershokz, LLC, a New York company, saw its “AfterShokz” headphones win the Consumer Electronics category in the Wall Street Journal Technology Innovation Awards. In Singapore, however, Mr Suravit Kongmebhol, a Thai citizen and serial businessman, had, in 2017, already registered the

mark  in respect of headphones, loudspeakers and headsets.

Aftershokz, LLC and Mr Kongmebhol became embroiled in cross-actions at the Intellectual Property Office of Singapore (IPOS). Aftershokz, LLC sought to invalidate Mr Kongmebhol’s 2017 registration; while Mr Kongmebhol opposed four trade mark applications involving the marks SHOKZ, OPTISHOKZ

and  filed by Aftershokz, LLC in 2018.

Mr Kongmebhol, represented by Mr Mark Teng and Mr Lim Tianjun of That.Legal LLC, submitted a unilateral request for mediation to the WIPO Center. This process allows a party to submit a request for mediation while the other party has yet to agree to mediation, and WIPO Center may assist the

¹ The WIPO Center’s only office outside Geneva, Switzerland is in Singapore.

² It is a condition of funding under the IPOS Enhanced Mediation Promotion Scheme (EMPS) that parties allow a “shadow” mediator to sit in and observe the mediation; or have a co-mediator to assist in the mediation. The objective is to give more exposure on how mediation can resolve IP disputes and build up experience among those who may mediate or represent parties in IP mediation in future.

other party in its consideration of the request for mediation. Aftershokz, LLC, represented by Mr Ng Lip Chih of Foo & Quek LLC and Mr Alex Goh of NLC Law Asia LLC, agreed to mediation.

In accordance with the appointment procedure under Article 7 of the WIPO Mediation Rules, the WIPO Center prepared a shortlist of five possible mediators, taking note of the subject matter of the case and the location of the mediation³. In this case, the parties did not exercise their right to rank the shortlisted names by preference⁴ and instead requested the WIPO Center to select the mediator. Singaporean mediator, Ms Joyce A. Tan of Joyce A. Tan & Partners LLC, was thus appointed. The parties agreed to extend the scope of the mediation to foreign IP rights as they also had an opposition in Vietnam; and as Mr Kongmebhol and another person also filed trade mark applications for



, and for variants of ASHOKZ and SHOKZ in Indonesia, the Philippines, Malaysia and Thailand.

The mediation took place in Singapore on 30 August 2019 at the mediator's office. Mr Kongmebhol and Aftershokz, LLC's representatives flew to Singapore to take part in the mediation. The session started in the morning and the parties reached a win-win outcome after 19.5 hours, ending with a settlement agreement after midnight into the next day. Had the parties decided to fight it out in an adversarial setting, it could have taken about two more years and several-fold costs to file evidence and submissions in five sets of proceedings, and obtain the Registrar's decisions after hearings. This could take even longer in other jurisdictions, and may have resulted in uneven global outcomes in relation to the same or similar marks.

Under IPOS' Enhanced Mediation Promotion Scheme (EMPS)⁵, the parties received funding of S\$12,000 for this mediation case where the subject matter of mediation additionally involved foreign IP rights. This fully subsidised WIPO Center's administration fee and the mediator's fees and expenses, and partially defrayed the parties' mediation-related lawyer fees and disbursements.

Both parties were very satisfied with the mediation process, and thought that the mediation was effective in resolving their disputes. They were likely to use mediation again, and to recommend mediation to others. Mr Kongmebhol said, "I am very glad that mediation in Singapore has helped us resolve the existing disputes and achieved a win-win outcome for all parties". Aftershokz, LLC's Mr Wan Jingchun, IP Manager and Ms Daisy Gong, IP Consultant commented, "The success of the mediation is very significant to us. Apart from settling existing disputes, the settlement ensured the protection of our company's brand image and the rapid development of our business in Southeast Asia."

This case is only one of others worldwide, where parties with IP issues were able to amicably resolve their differences through mediation. Consider mediation for your IP disputes. Especially with the availability of funding under EMPS, there is little to lose and much to gain.

12 November 2019

³ Before the shortlist is prepared, parties are generally able to state their preferences or requirements for a mediator e.g. qualifications, expertise, nationality, languages spoken etc. In this case, the parties did not specify any particular preferences.

⁴ Nor to delete any candidate's name to whose appointment they object.

⁵ It is a condition of funding under the IPOS EMPS that parties agree to named publicity, without the need to disclose specific details of the settlement agreement.