

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	Rezva 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 Mediator⁴	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