

## Mediation Success at IPOS

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

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

<b>Mediation Institution</b>	World Intellectual Property Organization Arbitration and Mediation Center (WIPO Center) <sup>1</sup>
<b>Mediator</b>	Joyce A. Tan, of Joyce A. Tan & Partners LLC
<b>Shadow Mediator<sup>2</sup></b>	Cheryl Lim, of Joyce A. Tan & Partners LLC
<b>Date of Mediation</b>	17 September 2020

### Background to the Dispute<sup>3</sup>

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.

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

<sup>2</sup> 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.

<sup>3</sup> 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 mediator<sup>4</sup>. 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.

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<sup>4</sup> 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