

Mediation Success at IPOS

Restoran India Gate Sdn. Bhd. & KRBL LTD. [2024] SGIPOS MED 1

	Applicant	Opponent
Name	Restoran India Gate Sdn. Bhd. ("Applicant")	KRBL LTD. ("Opponent")
Nationality / Country of Incorporation	Malaysia	India
Representation	EXY IP Pte Ltd ("Applicant's Agent") ¹	Amica Law LLC ("Opponent's Agent")
Lawyers		Mr Aaron Thng Mr Tan Wei Ming

Mediation Institution	WIPO Arbitration and Mediation Center ("WIPO Center")
Mediator	Mr Jonathan Choo ("Mediator")
Shadow Mediator ²	Mr Caleb Goh, IPOS Young IP Mediator ³
Date of Mediation	22 July 2024
Mode of Mediation	Hybrid (in person and via video-link)

Introduction

This mediation arose out of an opposition to Trade Mark No. 40202123814R:



("Application Mark") in relation to various food and beverage ("F&B") services in Class 43.

The Parties

The Applicant is a Malaysian F&B business that today has ten Indian restaurants all around Malaysia. Over the years, the Applicant has built up a reputation on social media and by word of mouth that has made it a successful F&B business in Malaysia, going on to win several business and consumer awards in Malaysia. Having such success in Malaysia, the Applicant's founder had intentions to enter the Singapore market and thus attempted to register the Application Mark in Singapore.

The Opponent is an Indian company with a history of over 130 years. It processes and exports rice. It is best known for its "India Gate" brand of basmati rice, one of the best selling rice brands in India,


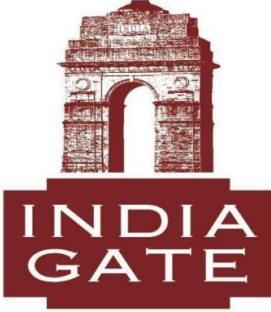
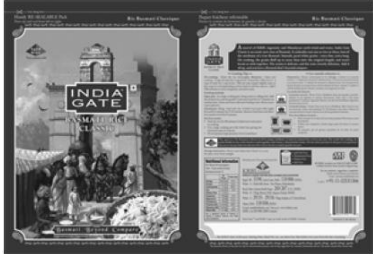
¹ The Applicant's Agent indicated that they do not wish for any individuals who appeared on their behalf at the mediation to be named.

² 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.

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 mediation in future.

with exports to 82 different countries worldwide, including Singapore. Its business extends to seed development, contact farming, procurement of paddy storage, processing, packaging, branding, and marketing of various types of grains.

The Opponent is the proprietor of the following registered word and device marks in Singapore (collectively, the “INDIA GATE Marks”):

	INDIA GATE word and device marks		INDIA GATE classic mark
Mark			
Trade Mark No.	T0501977D	40201905893S	40201505460R
Goods	Class 30: Rice	Class 29: Seeds for human consumption; processed chia seeds; processed flax seeds; processed Amaranth seeds; Edible oil. Class 30: Processed Quinoa; Processed seeds for use as a seasoning; Flax seeds for use as seasoning; Chia seeds for use as seasoning. Class 31: Unprocessed Millets.	Class 30: Rice

The Dispute

On 7 January 2021, the Applicant applied to register the Application Mark in Singapore. Subsequently, on 21 March 2022, the Opponent filed its Notice of Opposition to the registration of the Application Mark with the Intellectual Property Office of Singapore (“IPOS”). The Opponent opposed the registration of the Application Mark on the following grounds under the Trade Marks Act 1998 (“TMA”):

1. **Section 8(2)(b):** the Application Mark is similar to the INDIA GATE Marks and is intended for identical or similar goods or services, leading to a likelihood of confusion;
2. **Section 8(4)(b)(i):** the Application Mark is similar to the well known INDIA GATE Marks in Singapore. Its use would suggest a connection with the Opponent and likely damage their interests;
3. **Section 8(4)(b)(ii):** the Application Mark is similar to the widely well known INDIA GATE Marks in Singapore. Its use would unfairly dilute or take advantage of the distinctive character of the INDIA GATE Marks; and
4. **Section 8(7)(a):** the Application Mark is liable to be prevented from use by virtue of the law of passing off.

In response, the Applicant's case is that the Application Mark was filed in respect of services related to catering, provision of F&B, as well as restaurant services, and that the INDIA GATE Marks are filed primarily for the sale and processing of rice-related products. Thus, the Applicant was of the view that since both parties were of a completely different business nature, the general public would be able to distinguish between the "India Gate" in relation to a restaurant versus "India Gate" as a rice brand.

After their pleadings were exchanged and evidence submitted, the parties agreed to submit the dispute to mediation.

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).⁴

Mediation Process

Prior to the mediation, the Mediator had separate without prejudice conversations with the parties and their agents in order to get a clearer sense of the parties' positions and sentiments towards the mediation.

The mediation took a hybrid set-up, with the Opponent's Agent attending physically while the Applicant's representative, the Applicant's Agent and the Opponent's representative attending via Zoom.

The mediation began at 10.00am at the WIPO Singapore Office with the Mediator setting ground rules and inviting parties' representatives to say a few words to introduce themselves.

After a brief introduction from the parties' representatives, the Mediator guided the parties through setting an agenda, based primarily around the features of the Application Mark.

Subsequently, the parties' representatives took over to lead the conversation by highlighting the main points of contention. After the parties shared their interests, it became clear that the parties' interests could be addressed in a win-win manner, including by making key changes to the Application Mark.

The Applicant's representative spontaneously proposed an option for an alternative to the Application Mark, which he sketched out by hand. This sketch was warmly welcomed by the Opponent's representative, and provided parties with a crucial foundation upon which to negotiate.

After about one and a half hours of discussion, the design of the alternative mark was agreed upon, coupled with an agreement on other key terms. Parties were then ready to put the terms of their discussion to a settlement agreement.

The Opponent's Agent was quick to prepare a draft settlement agreement, which the parties were ready to put pen to paper on by the five-hour mark of the mediation.

The Mediator thanked the parties for their constructive and collaborative dialogue, as well as their agents for their readiness to advise on a constructive settlement.

⁴ 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.

Challenges

It was thought at the outset of the mediation that there might have been difficulties arising from the asymmetrical hybrid set-up. However, the video-link facilities provided at the WIPO Singapore Office made the entire mediation unequivocally seamless. Furthermore, the Mediator's deliberate exaggeration of speech and movement enabled his energy to translate perfectly across cyberspace.

Reflections

The Mediator commented:

I am glad that the parties agreed to mediate because they ended up achieving a fantastic win-win outcome. I made it a point to have separate pre-hearing discussions with each party and their respective lawyers in order to get to know them and for them to feel comfortable and engaged in the mediation process. I was also able to assess what issues in dispute they felt strongly about and what issues they might be willing to compromise on. This proved to be very useful because it meant that when we met at the hearing, I already had some friendly rapport with the parties and their respective counsel and that helped to set the tone for the rest of the hearing. I also had a better sense for what approach to take with the parties and what issues to begin discussing with them. The parties were deeply aware that it was in their best interest to reach a settlement which would allow them to co-exist not only in Singapore, but also elsewhere.

At the hearing, they spoke from the heart and with a lot of respect for each other. They were also proactive in discussing options and making concessions in order to achieve a win-win outcome. When it became very clear that a settlement was in reach, one of the parties very generously offered to host the other party for a meal at his restaurant and the other party graciously accepted! I find it extremely fulfilling that mediation not only helps to resolve disputes – it can also restore and build relationships that will outlive the dispute.

The Opponent remarked:

We are happy to share that our experience with mediation in Singapore was very positive. Choosing to go through mediation turned out to be an excellent decision for our case.

The process, led by a highly skilled mediator and supported by our counsel, was key to reaching a solution that worked for everyone. The mediator's approach was spot-on — through private discussions and a framework that encouraged open communication, we were able to understand both our own interests and those of the other party. This deep understanding was crucial for finding common ground and coming up with creative solutions.

The mediator's role in guiding the discussions and highlighting key issues was especially helpful. With visual aids and a clear breakdown of details, the mediator made the negotiation process much clearer. This not only made discussions more productive but also created a collaborative environment where both sides could work towards a compromise.

In the end, the mediation led to a fair and well-organised settlement agreement that showed both parties were keen to resolve the dispute amicably. The mediator's knack for pinpointing areas for compromise and steering the conversation towards a workable solution was crucial to the successful outcome.

We are confident that this mediation process has set a great example for resolving similar disputes in the future. We fully support the REMPS initiative and recommend considering mediation, especially for commercial disputes.

The Opponent's Agent commented:

...we echo the sentiments expressed by our client regarding the overwhelmingly positive experience we had with mediation. The mediator Jonathan Choo's clear expertise in facilitating open and honest discussions and fostering a collaborative environment was instrumental in helping us reach a mutually agreeable resolution. The confidentiality of the process also allowed both sides to communicate without fear of repercussions, which was crucial in de-escalating existing tensions.

A week before the mediation, Mr Choo took the initiative to sit down with each party separately for a preparatory chat. This proved to be invaluable in setting the stage for a productive mediation. By addressing the parties' concerns and anxieties and providing a clear overview of the process, Mr Choo put both parties in the right mindset for a collaborative, solution-oriented discussion.

During the mediation, we were particularly impressed by the mediator's ability to guide the parties through a structured process that encouraged a deeper understanding of each other's perspectives and underlying interests. The mediator's clear articulation of key issues facilitated productive negotiations and helped us identify areas of potential compromise, even in areas where the dispute at first seemed intractable. The mediation process ultimately resulted in a fair and comprehensive coexistence agreement that was in the best interests of our client.

We commend IPOS and the WIPO Center for their commitment to promoting mediation as an effective alternative to litigation. Based on our positive experience, we wholeheartedly recommend mediation as a viable option for resolving commercial disputes.

The Applicant's Agent commented:

Opting for mediation was an excellent decision, as the process went very smoothly and efficiently. The mediator, Mr Choo, was extremely helpful and easy-going, making the experience comfortable for all parties involved. During the mediation, Mr Choo carefully listed out all the issues, allowing both sides to discuss and address them effectively. As a result, we reached a conclusion quite quickly. The opposing party was also highly cooperative in resolving the matter at hand. Our client is pleased with the outcome, as the mediation provided a seamless process and an immediate solution.

As for myself, this mediation was a masterclass in collaborative interest-based negotiation and mediation.

The Mediator played a pivotal role in bridging the gap between the parties' positions and skilfully elucidated their interests. By calling on the parties' representatives to share first, instead of their agents, the Mediator allowed the parties to share candidly about the circumstances surrounding the founding of their businesses and the significance of the brand name to them. For example, knowing how important the India Gate monument was as a symbol to both parties enabled them to work constructively and collaboratively around the centrality of the emblem. Similarly, the Mediator noted

that Indian food was a unifying topic for parties' representatives, which he then casually raised at several points to introduce some light-hearted humour and brighten the atmosphere.

In doing so, both parties became acutely aware of the potential commercially acceptable solutions to the dispute that would address the interests of each party. This was in no small part due to the Mediator's expert reframing of issues and reinforcement of positive momentum. Due to his skill in reframing issues, it seemed that parties never stopped nodding throughout the mediation. This mutual understanding facilitated a shift in perspective, transforming the mediation from a zero-sum game to a collaborative discussion. Furthermore, where before, parties had no pre-existing relationship, they seemed, at the end of the mediation, to have formed a level of strategic trust in each other.

Both parties' agents were also extremely influential in enabling the parties to come to a settlement. It was clear from the outset of the mediation that the parties' representatives had been briefed and were clear about how to approach the mediation, such that the representatives could lead the discussion without having agents chiming in too much. This created a safe space for parties' representatives to be candid and to discuss options. The parties' agents were also ready and confident to advise on the viability of options, which sped up the process tremendously.

Lastly, it proved extremely valuable for the parties' and their representatives to have some degree of visual-artistic ability. One of the parties' representatives was able to illustrate, using pen and paper, a draft of a proposed alternative mark. By the end of the lunch break, the same party's graphic designer was able to quickly render a vectorised draft image mark based on the representative's rudimentary sketch. Not only did this provide laser-sharp clarity to the discussion, it also gave parties peace of mind about what they were agreeing to.

Conclusion

Mediation advocates have a duty to prepare their clients well for mediation. In particular, they should equip their clients with the necessary tools to enter the mediation with as collaborative a mindset as possible in order to make the most out of the mediation. When parties can see eye-to-eye and identify that they are not in a zero-sum game, parties stand to not only save time and costs, but also to create potential business partnerships and relationships.

Written by Caleb Goh, Young IP Mediator
24 September 2024