

IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[2016] SGHC 127

Originating Summons No 960 of 2015

Between

Axis Law Corp

... Plaintiff

And

Intellectual Property Office of
Singapore

... Defendant

GROUND S OF DECISION

[Administrative law] — [Administrative discretion]
[Administrative law] — [Administrative powers] — [Manner of exercise]
[Administrative law] — [Judicial review] — [Ambit]
[Administrative law] — [Remedies] — [Certiorari]
[Administrative law] — [Remedies] — [Mandamus]
[Civil Procedure] — [Appeals] — [Leave]

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Axis Law Corp
v
Intellectual Property Office of Singapore

[2016] SGHC 127

High Court — Originating Summons No 960 of 2015
Tay Yong Kwang J
16 May 2016

4 July 2016

Tay Yong Kwang J:

Introduction

1 This originating summons (“OS”) is an application by Axis Law Corporation (“the Plaintiff”) for leave to commence judicial review proceedings against the Intellectual Property Office of Singapore (“IPOS”) (“the Defendant”).

2 The Plaintiff has a trademark dispute with Axis Intellectual Capital Pte Ltd (“the Registered Proprietor”). In the proceedings before the Principal Assistant Registrar of Trademarks (“the Registrar”) of IPOS, the Plaintiff sought to amend its Statement of Grounds (“SOG”) which was submitted as part of its application to invalidate and revoke the trade mark “AXIS” (Trademark No. T0106593C) registered and held by the Registered Proprietor. The application to amend was refused by the Registrar. As a result, the

Plaintiff sought leave to apply for the following orders (with “Applicant” referring to the Plaintiff):

(a) A quashing order against the decision of the Registrar on 28 July 2015 in Case No. C010T0106593C, by which the said Registrar refused to allow the Applicant to amend its SOG to add alternative and/or additional grounds in relation to its application for invalidation and revocation of the trade mark “AXIS”, registered as Trademark No. T0106593C; and

(b) A mandatory order directing the Registrar to allow the Applicant to amend its SOG in the manner shown in “Annexure A”, which was annexed to Statement filed in support of OS 960/2015.

[Annexure A is not reproduced here]

3 The OS was opposed by the Defendant, which was represented by the Attorney-General’s Chambers. Dentons Rodyk & Davidson held a watching brief for the Registered Proprietor.

The factual background

The Trade Mark Proceedings

4 On 21 March 2014, the Plaintiff filed an application under s 23 of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“TMA”) to invalidate the “AXIS” trade mark, which was registered and held by the Registered Proprietor. On 17 July 2014, the Registered Proprietor filed its counter statement. By this time, pleadings were deemed to be closed. The Plaintiff filed its evidence in support of the invalidation action on 14 November 2014. The Registered Proprietor filed its evidence on 14 January 2015.

5 On 7 May 2015, the Plaintiff sought leave to amend its SOG to do the following:

- (a) To elaborate on the existing grounds under s 23 read with s 7(5) of the TMA;
- (b) To add a new ground for the invalidation of the trade mark under s 23 read with s 7(1)(c) of the TMA; and
- (c) To add a new ground for the revocation of the trade mark under s 22 of the TMA.

6 As the amendments were sought after pleadings were deemed to be closed, the Registrar directed the Plaintiff on 11 May 2015 to seek the consent of the Registered Proprietor. The Registrar’s practice in this regard is set out in HMG Circular 2/2010 dated 20 August 2010 (“the Circular”).

7 However, the Registered Proprietor refused to consent to the Plaintiff’s proposed amendments. On 29 May 2015, the Registrar directed the parties to file their written submissions on the proposed amendments by 12 June 2015.

8 On 5 June 2015, after the Plaintiff had filed its Evidence in Reply on 21 May 2015 and one week before parties were due to file their written submissions, the Plaintiff filed a revised version of the proposed amendments to its SOG. In this set of proposed amendments, the Plaintiff sought to include an additional ground for invalidation under s 23 read with s 7(6) of the TMA. The parties duly filed their written submissions on the issue of the amendments on 12 June 2015.

9 After considering the parties’ written submissions, the Registrar dismissed the Plaintiff’s application for leave to amend the SOG, issuing her Grounds of Decision on 28 July 2015.

10 On 19 October 2015, the Plaintiff filed the present application for judicial review, seeking the orders as stated above at [1].

The proper party to the application for judicial review

11 The Plaintiff had initially brought this OS for judicial review against the Attorney-General (“AG”) instead of IPOS.

12 At the first pre-trial conference (“PTC”) on 4 November 2015, before the learned Assistant Registrar Karen Tan (“AR Tan”), the AG expressed his objection to being named as a party to the judicial review proceedings. Instead, the AG argued that the proper party to be sued was IPOS because the relief the Plaintiff sought could only be performed by IPOS. IPOS is also a statutory board and a separate legal entity from the Government.

13 On 11 November 2015, the AG wrote to counsel for the Plaintiff to explain its position and to invite the Plaintiff to amend the originating summons accordingly. However, the Plaintiff did not respond to the AG and did not make any amendments to the originating summons.

14 At the second PTC before AR Tan on 26 November 2015, counsel for the Plaintiff maintained that the AG was the appropriate party to the judicial review proceedings. The Plaintiff explained that it had named the AG as the party pursuant to s 19(3) of the Government Proceedings Act (Cap 121, 1985 Rev Ed) (“GPA”), which states as follows:

Civil proceedings against the Government shall be instituted against the appropriate authorised Government department, or, if none of the authorised Government departments is appropriate or the person instituting the proceedings has any reasonable doubt whether any and if so which of those departments is appropriate, against the Attorney-General.

15 In particular, the Plaintiff relied on the second limb of s 19(3) of the GPA which states that proceedings should be commenced against the AG if none of the authorised Government departments is appropriate or if there is any reasonable doubt as to the appropriate Government department against which proceedings should be instituted. Further, the Plaintiff argued that because the application was made *ex parte*, O 53 r 1(3) of the Rules of Court (Cap 322, R 5, 2014 Rev Ed) (“ROC”) required the Plaintiff to serve the cause papers (*ie*, the originating summons, the statement and the supporting affidavit) on the AG. The Plaintiff therefore took the view that the AG should be the party to the present application for leave to commence judicial review proceedings.

16 As the Plaintiff maintained its position before AR Tan that the AG should be named as the party to the present proceedings, the AG informed AR Tan that it would raise this issue at the hearing of the application for leave.

17 The parties subsequently appeared before me at a PTC on 2 March 2016. The AG submitted that the present application for leave should be dismissed on the basis that it was taken out against the wrong party. It maintained its position that s 19(3) of the GPA did not apply in the present case because IPOS is not a Government department within the meaning of s 19(3) of the said Act. Instead, IPOS is a body corporate established under the Intellectual Property Office of Singapore Act (Cap 140, 2002 Rev Ed) (“IPOS Act”) and is capable of suing and being sued in its own name (see s 3(a) of the

IPOS Act). As a statutory board, IPOS is legally separate from the Government in identity and representation.

18 It was further argued that the requirement to serve applications for leave on the AG under O 53 r 1(3) of the ROC does not make the AG a party to all judicial review proceedings. Making reference to *Singapore Civil Procedure 2016* vol 1 (Foo Chee Hock JC gen ed) (Sweet & Maxwell, 2016) at para 53/1/10 and the High Court decision of *Chan Hiang Leng Colin and others v Ministry for Information and the Arts* [1995] 2 SLR(R) 627 at [4] and [5], the AG explained that the purpose of service on the AG was to bring the judicial review proceedings to the notice of the AG to allow him to ascertain if its participation in the proceedings is warranted in order to secure the Government and the public's interests. The cases of *Chai Chwan v Singapore Medical Council* [2009] SGHC 115 (“*Chai Chwan*”), *Lim Mey Lee Susan v Singapore Medical Council* [2011] 4 SLR 156, and *Lim Mey Lee Susan v Singapore Medical Council* [2012] 1 SLR 701 were also cited in support of the AG's position. Notably, in *Chai Chwan*, the High Court dispensed with the attendance of the AG at the hearing on leave (even though the AG was served with the leave application) because “the subject matter of the application did not concern the Government”. As such, the AG was of the view that O 53 r 1(3) of the ROC did not make the AG a party to the judicial review proceedings. Nonetheless, the AG stated that his office would be acting as counsel for IPOS should the judicial review proceedings continue as against IPOS.

19 The Plaintiff, on the other hand, argued that because the application before the court was *ex parte*, no one needed to appear on the originating summons as a party and that it was for the court to determine who the proper party to the application should be. The Plaintiff added that instead of seeking

to dismiss this OS, the AG could and should have made the application for IPOS to be substituted as defendant to the proceedings pursuant to s 19(4) of the GPA. In any case, the joining of the AG was a non-issue because any perceived misjoinder would not be fatal to the proceedings. Section 19(5) of the GPA provides that upon a change of parties, the proceedings shall continue unaffected.

20 After hearing the parties, I agreed with the AG that IPOS was the proper defendant to the proceedings. IPOS is a statutory board that is capable of suing and being sued in its own name (see s 3(a) of the IPOS Act). It is the proper party to be sued in the present judicial review proceedings. As counsel for the Plaintiff indicated that he needed to take further instructions from the Plaintiff as to whether to proceed with the application for judicial review, I adjourned the matter for a further PTC on 14 March 2016. Nonetheless, I informed the parties that if the Plaintiff chose to proceed with the application for judicial review, it was to amend the OS to substitute IPOS as the defendant and serve the amended OS on the AG (as counsel for IPOS), with such service to be treated as service on IPOS.

21 At the PTC on 14 March 2016, the Plaintiff indicated its intention to continue with the judicial review proceedings. However, the Plaintiff also stated that it was in the midst of negotiations with the Registered Proprietor and that there was a possibility of a settlement. I therefore stayed the judicial review proceedings as this OS would be unnecessary should the parties reach a settlement over their trade mark dispute.

22 By way of a letter dated 8 April 2016, the Plaintiff informed the court that its negotiations with the Registered Proprietor were unsuccessful and that it would proceed with the application for leave. At the subsequent PTC on 19

April 2016, the parties agreed that both the application for leave as well as the merits of the judicial review could be dealt with at the hearing of the OS. The Plaintiff also applied for permission for Ms Alina Sim, an advocate and solicitor and the director of the Plaintiff, who had been permitted to attend the PTCs, to attend the hearing and to argue the case on behalf of the Plaintiff as she was more acquainted with the facts of the case. The AG, however, noted that pursuant to O 1 r 9(2) of the ROC, leave of court was required before an officer of a company could act on the company's behalf. I decided that it would be more appropriate for the counsel on record to represent the Plaintiff at the hearing and if any clarification on the facts was needed which was outside the knowledge of the counsel, Ms Alina Sim would be allowed to speak. At the hearing of the OS on 16 May 2016, she was given permission to speak.

The Principal Assistant Registrar's decision

23 I set out such aspects of the Registrar's decision as are necessary for giving the context to the present application. The Registrar's full decision can be found in *Axis Law Corporation v Axis Intellectual Capital Pte Ltd* [2015] SGIPOS 15 ("the Registrar's decision").

24 The Registrar referred to s 25(b) of the TMA, which is as follows:

The Registrar may, at the written request of the person who has made an application (other than an application for the registration of a trade mark), or filed a notice or other document for the purposes of this Act, or at the written request of the person's agent, amend the application, notice or document —

(b) if the Registrar is of the opinion that it is fair and reasonable in all the circumstances of the case to do so.

25 She also referred to Rule 83 of the Trade Mark Rules (Cap 332, R 1, 2008 Rev Ed) (“TMR”), which provides as follows:

Any irregularity in procedure which, in the opinion of the Registrar, is not detrimental to the interests of any person or party may be corrected on such terms as the Registrar may direct.

26 The Registrar also relied on the Circular (see [6] above), which sets out a list of non-exhaustive factors that have to be considered in deciding whether to grant leave for amendments sought after the close of pleadings. The relevant portion of the Circular reads:

B. Amendments After Close of Pleadings

Where amendments are sought after pleadings are deemed to be closed, consent from the other party must first be sought... Where there is no consent, leave of the Registrar must be obtained for any amendment after the close of pleadings. Whether leave would be granted depends on the facts and circumstances of each case. In considering whether to grant leave for the amendments, the Registrar will conduct a balancing exercise, involving a consideration of the public interest that rules relating to procedure are complied with and the need to ensure that there is proper adjudication of a case based on its merits in the interest of justice between the parties. In particular, the Registrar will carefully weigh the following non-exhaustive factors on a case by case basis:

- (i) whether the party seeking the amendment could have claimed the particular ground/defence ... earlier, when filing... Form TM 28...
- (ii) whether the amendment is necessitated by the pleading or evidence filed by the other party
- (iii) whether the other party would suffer any real prejudice which cannot be compensated with costs if the amendment is allowed
- (iv) whether allowing the amendment will facilitate the determination of the real question in controversy between the parties or whether the amendment is only a tactical manoeuvre and allowing the amendment would result in prejudice to the other party

- (v) whether the amendment raises grounds or facts which the Plaintiff need not set out in reply, for example, the ground was not raised by the opponent and is therefore inapplicable to the particular proceedings at hand
- (vi) the substantiality of the amendment
- (vii) the stage of the proceedings the amendment is sought.

27 Citing the case of *Apptitude Pte Ltd v MGG Software Pte Ltd* [2015] SGIPOS 8 (“*MGG*”), which referred to *Asian Aisle Pte Ltd v Ricegrowers Co-operative Limited* [2002] SGIPOS 7 (“*Asian Aisle*”) and *AEA International Holdings Pte Ltd and Another v SOS International A/S* [2011] SGIPOS 10 (“*AEA International*”), the Registrar explained that the mere fact that she was given a discretion under r 83 of the TMR to grant leave for amendment did not justify its exercise in every case or where no good reasons were shown. There was a need for a balancing exercise as stated in the Circular.

28 The Registrar noted (at [8] of Registrar’s decision) that the Plaintiff sought to rely on the case of *Chwee Kin Keong and others v Digilandmall.com Pte Ltd* [2005] 1 SLR(R) 502 (“*Chwee Kin Keong*”) in which the Court of Appeal distinguished between allowing amendments before a trial began and allowing amendments at the end of the trial in order to give an apparently unsuccessful defendant an opportunity to renew the fight on an entirely different defence. At [102] of *Chwee Kin Keong*, the Court held that “it is trite law that an amendment which would enable the real issues between the parties to be tried should be allowed subject to penalties as to costs ... unless the amendment would cause injustice or injury to the opposing party which could not be compensated for by costs or otherwise”. Nonetheless, the Registrar highlighted that the case of *MGG* (at [2]) drew a distinction between court proceedings and proceedings before the Registrar of Trade Marks:

At times, disputants cite authorities from the Singapore courts in support of their application for the Registrar to allow "*overstepping of time limits*". However, there is a basic distinction between court proceedings and proceedings before the Registrar of Trade Marks. In the former, suits are subject to time bars beyond which rights generally cannot be asserted; and non-compliance with deadlines can potentially lead to judgment in default. Hence, court authorities may tend to disclose a more open approach towards allowing the "*overstepping of time limits*". On the other hand, in proceedings before the Registrar, it is generally open to disputants to re-file their application to register a trade mark or to institute fresh action against a trade mark. The consequences of adhering to the prescribed rules relating to time limits are usually not as severe in Registry proceedings as opposed to court proceedings. Hence, as a low-cost administrative tribunal with an interest in transparency and certainty, the Registrar tends to take a more circumspect stance on the issue and has a disposition towards the adherence to time limits. Exceptional circumstances would be needed to justify deviation from these time limits.

[emphasis added by Registrar]

29 In assessing whether there were such exceptional circumstances in the Plaintiff's case, the Registrar considered the factors listed in the Circular. The Registrar was of the view that these factors were not inconsistent with the case of *J.-E Borie SA v MHCS* [2013] SGIPOS 4 ("*The Yellow Label*"), in which the registrar commented that "the Act does not contain any specific provision on the amendment of a notice of opposition" since both s 25 of the TMA and r 83 of the TMR are general provisions. These factors also assisted her in the assessment of whether the amendments were "fair and reasonable" within the meaning of s 25(b) of the TMA.

30 First, in relation to the question of whether the party seeking the amendment could have claimed the particular ground or defence earlier when filing Form TM 28, the Registrar held that the Plaintiff could have claimed those grounds at the point of filing Form TM28 and the SOG. The Plaintiff had admitted that the amendments were due in part to an "oversight earlier in

the proceedings because of haste and insufficient thought”. However, there was no need for “haste” because there was no time constraint to file Form TM28 to commence proceedings. Further, even if the proposed amendments were inadvertently overlooked at the filing of Form TM28 and the SOG, the second version of the proposed amendments was sought only after the evidence had closed and was made to reflect the two sets of evidence filed by the Plaintiff. This reflected “very poor planning” on the part of the Plaintiff in relation to the invalidation and revocation action (see the Registrar’s decision at [12]-[14]).

31 Second, in relation to the question of whether the amendment was necessitated by the pleading or evidence of another party, the Registrar held that the answer was “clearly in the negative”. This was because the Plaintiff realised the insufficiency of its own pleadings as a result of drafting its evidence (see the Registrar’s decision at [15]).

32 Third, in relation to the question of whether the other party would suffer any real prejudice which could not be compensated with costs if the amendments were allowed, the Registrar was of the view that the Registered Proprietor would be prejudiced. The Plaintiff had sought to include the proposed amendments “at a very late stage” and even after the evidence had closed. The Registered Proprietor was prejudiced because it would need to apply for leave to respond and to prepare the necessary rebuttal evidence in light of the substantiality of the proposed evidence (see the Registrar’s decision at [16]-[17]).

33 Fourth, in relation to the question of whether allowing the amendments would facilitate the determination of the real question in controversy between the parties or whether the amendments were only a tactical manoeuvre that

would prejudice the other party if allowed, the Registrar acknowledged that it would be in the interest of justice to enable the real issues between the parties to be tried. Nonetheless, she opined that this was but one of the seven factors that she had to consider and that it was generally open to the Plaintiff to institute a fresh action against the trade mark (see the Registrar's decision at [18]).

34 Fifth, in relation to the question of whether the amendment raised new grounds or facts which the Plaintiff need not set out in reply, the Registrar held that the answer was clearly no in light of the substantiality of the proposed amendments (see the Registrar's decision at [19]).

35 The Registrar took the view that the amendments were substantial as the Plaintiff was seeking the addition of a ground of revocation under s 22 of the TMA and new grounds for the invalidation action (s 23 read with s 7(1)(c) and s 7(6) of the TMA). One of the grounds was s 7(6) of the TMA which involved allegations of bad faith. In the Registrar's view, it was not obvious from the original SOG that the ground of bad faith had been pleaded. Hence, the amendments sought to be made to the SOG were substantial (see the Registrar's decision at [21]).

36 Turning to the final factor listed in the Circular, the Registrar disagreed with the Plaintiff's submissions that the amendments were sought at an early stage of the proceedings (see the Registrar's decision at [23]). The Plaintiff sought to amend the proposed SOG on 7 May 2015. This was after the Registered Proprietor had filed its evidence. The Plaintiff sought to further revise the SOG on 5 June 2015, after the filing of the Plaintiff's Evidence in Reply on 21 May 2015.

The Plaintiff's arguments

37 For the present application for judicial review, the Plaintiff submitted a statement as well as two sets of written submissions (dated 19 October 2015, 24 February 2016 and 28 April 2016 respectively). The basis upon which the Plaintiff sought relief could be categorised into two broad grounds of judicial review, namely, illegality and irrationality.

38 The Plaintiff argued that the Registrar, having been directed to correct procedural errors under r 83 of the TMR, did not do so. She acted in excess of jurisdiction when she disallowed the proposed amendments. She acted ultra vires the statute and committed illegality. This was so for the following reasons:

- (a) The Registrar took into account irrelevant, incorrect or wrong considerations in that she:
 - (i) failed to properly address her mind to other considerations that she was duty bound to consider as expressed in the Circular.
 - (ii) failed to consider that no prejudice would be suffered by the Registered Proprietor which could not be compensated by costs.
 - (iii) failed to consider the substantial prejudice the Plaintiff would suffer if the amendments were not allowed as it would be deprived of substantial grounds in its claim. As such, the Registrar failed to properly balance facts relating to the serious and severe prejudice that the Plaintiff would suffer if the proposed amendments were refused as against the prejudice

that the Registered Proprietor would suffer by reason of the proposed amendments. The Registrar misapplied r 83 of the TMR and took into account incorrect considerations which resulted in extreme unfairness to the Plaintiff.

(iv) failed to consider that most of the evidence for the proposed amendments had already been raised in the statutory declarations filed by the Plaintiff.

(v) decided the amendments were sought too late into the proceedings even though the hearing for the matter had not commenced.

(vi) decided that the Plaintiff could institute a fresh action if the amendments were disallowed, without considering the substantial costs and time which would be wasted as a result.

(b) The Registrar was incorrect in law as she relied on incorrect decisions (in the form of *MGG*, *Asian Aisle*, and *AEA International*) and disregarded the decisions (*The Yellow Label* and *Chwee Kin Keong*) that would have allowed the amendments. The decision was reached in bad faith and smacked of bias.

(c) The Registrar failed to exercise her discretion as she did not apply her mind to the correct law, facts and circumstances fully when she cursorily dismissed the Plaintiff's application for amendments by applying the incorrect law.

(d) The Registrar fettered her discretion and misdirected herself when she refused to take into account the Plaintiff's circumstances and to apply the correct law to the facts.

(e) The Registrar committed an error on the face of the record when she applied the incorrect law.

(f) The Registrar erred on the facts in holding that the proposed amendments to the SOG were a deliberate act and that the amendments came about only after the filing of reply evidence of the Plaintiff, which was unreasonable and unfair.

39 On the issue of irrationality, the Plaintiff argued that the Registrar had reached a decision which no reasonable person would have come to. The Plaintiff also placed particular emphasis on the case of *Attorney-General v Venice-Simplon Orient Express Inc Ltd* [1995] 1 SLR(R) 533 (“*Venice-Simplon*”). In that case, the Court of Appeal upheld the High Court’s decision to quash a decision made by the Registrar of Trade Marks to refuse Venice-Simplon’s application for an extension of time to file applications to register a trade mark or to restore the Defendant’s trade mark applications. The court held at [22] that the registrar’s discretion was improperly exercised and that her decision was in that sense irrational. This was because the registrar was influenced by irrelevant considerations and failed to recognise and give due consideration to the grave prejudice that would be suffered by Venice-Simplon and the fact that no prejudice would be suffered by the other party to the trade mark proceedings.

40 The Plaintiff submitted that the Registrar’s decision in the present case was irrational for the same reasons. She failed to consider that substantial prejudice would be suffered by the Plaintiff and that no prejudice would be suffered by the Registered Proprietor.

The Defendant's arguments

41 Although the Defendant accepted that the Registrar's decision was amenable to judicial review, it argued that leave should not be granted for judicial review. Even if leave were granted, the Defendant argued that the application should be dismissed on the merits because there was no legal and/or factual basis to find that any of the traditional grounds of judicial review (*ie*, illegality, irrationality or procedural impropriety) was satisfied.

42 The Defendant argued that leave should not be granted because the application amounted to a backdoor appeal against the Registrar's decision. This was seen from the Plaintiff's formulation of its written submissions in terms of the Registrar having acted in a way that was "wrong in law" or that she had "erred on the facts". The OS was essentially an appeal on the merits and was incongruous with the court's supervisory role in judicial review proceedings. The Defendant claimed that this was an attempt by the Plaintiff to circumvent s 75 of the TMA which prohibits the Plaintiff from appealing to the High Court against the Registrar's decision to refuse the amendments to the SOG.

43 The Defendant added that the High Court did not have the power to grant the mandatory order sought by the Plaintiff. This is because the High Court cannot direct the Registrar to exercise her discretion in a particular fashion (see *Borissik Svetlana v Urban Redevelopment Authority* [2009] 4 SLR(R) 92 at [21]).

44 Even if leave were granted, the Defendant submitted that there was no legal and/or factual basis to find illegality, irrationality or procedural impropriety in the Registrar's decision. There was no illegality because the

Registrar had exercised her discretion within the scope of her authority in good faith and had taken into consideration relevant considerations. The Registrar was aware of the statutory provisions (*ie*, s 25 of the TMA, r 83 of the TMR) as well as the principles and factors stated in the Circular.

45 The Defendant argued that the Registrar had acted in good faith. According to *Cannock Chase District Council v Kelly* [1978] 1 WLR 1 at 6D-6F, the court should not consider the Plaintiff's belated assertion that the Registrar had acted in bad faith. The Plaintiff did not allude to bad faith in the OS, the statement, its affidavit or its earlier submissions. Even if the court were willing to consider the Plaintiff's assertion of bad faith, the Defendant argued that the Plaintiff could not establish bad faith. The onus to prove bad faith was a heavy one. "Bad faith" went beyond unlawful or illegal acts. It connoted intentional wrongdoing and also included circumstances where power was exercised for extraneous or improper purposes or when there was an abuse of power (see Jonathan Auburn, Jonathan Moffett & Andrew Sharland, *Judicial Review: Principles and Procedure* (Oxford University Press, 2013) at [16.12], *Muhammad Ridzuan bin Mohd Ali v Attorney-General* [2014] 4 SLR 773 at [57]-[58], and *Teng Fuh Holdings Pte Ltd v Collector of Land Revenue* [2006] 3 SLR(R) 507 at [36]). The Plaintiff's allegation of bad faith should be rejected as it was merely an unsubstantiated assertion.

46 The Defendant also disputed the Plaintiff's allegation that the Registrar had acted in bad faith when she failed to apply the principles in *Chwee Kin Keong*. The factual circumstances of the present case clearly differed from those of *Chwee Kin Keong* such that the principles in *Chwee Kin Keong* were inoperable on the facts here. The Plaintiff could not transpose the whole decision in *Chwee Kin Keong* to trade mark proceedings in IPOS as there were

distinctions between these and court proceedings. In support of this position, the Defendant cited *MGG* at [2] for the rationale behind drawing such a distinction (see above at [28]).

47 The Defendant argued that the Registrar had acted in good faith as her decision accorded with the statutory purpose of s 25 of the TMA. The Plaintiff's second set of proposed amendments contained new grounds for revocation and invalidation. These were material additions that were introduced late in the proceedings. The Registrar decided in accordance with the statutory purpose of s 25 of the TMA that it was not "fair and reasonable in all the circumstances" to allow the amendments.

48 The Defendant submitted that the Registrar's decision also accorded with IPOS's role in the administration of trade marks in Singapore. Citing *MGG* at [2], the Defendant argued that there was a distinction to be drawn between court proceedings and proceedings before the Registrar of Trade Marks. IPOS is intended to be a low-cost administrative tribunal and would therefore be more circumspect in its approach towards procedural deviations.

49 The Defendant submitted further that the Registrar had taken into account only relevant considerations. The Registrar considered all the factors set out in the Circular as well as the issue of prejudice as between the Plaintiff and the Registered Proprietor in the context of the trade mark proceedings. For the same reasons, there was also no room for the Plaintiff to argue that Registrar had fettered her discretion.

50 Instead, the Plaintiff's complaints revealed that it was actually dissatisfied with the weight accorded by the Registrar to the relevant considerations, which led to an outcome unfavourable to the Plaintiff.

However, the weight to be attached to each consideration ought only to be a matter for the decision-maker. The court could only interfere if the decision-maker had acted unreasonably in attaching the weight that it did (see *Regina (Sainsbury's Supermarkets Ltd) v Wolverhampton City Council* [2011] 1 AC 437 at [70]).

51 Turning to the issue of irrationality, the Defendant argued that the Registrar's decision was not irrational as it fell within the legally possible range of answers. The Plaintiff's case revealed that it admitted only one "correct" view, which was that the proposed amendments ought to have been allowed by the Registrar. However, following *Chee Siok Chin and others v Minister for Home Affairs and another* [2006] 1 SLR(R) 582 at [95], the Defendant emphasised that reasonableness did not entail a single inevitable approach or determination in any given matter. The Registrar was entitled to refuse or to grant the Plaintiff leave to make the amendments.

52 The Defendant submitted that *Venice-Simplon* was mischaracterised by the Plaintiff. The Defendant argued that the registrar's decision in *Venice-Simplon* was quashed because of procedural impropriety and not irrationality. The Court of Appeal held at [20] that the registrar had adopted the wrong procedure and therefore acted with procedural impropriety when she acted under r 29 of the TMR and refused Venice-Simplon's applications for extension of time and deemed its applications for trade mark registration as withdrawn. However, there was nothing in the present case to suggest that the Registrar's decision was procedurally improper. Unlike in *Venice-Simplon*, the Plaintiff did not show that the Registrar applied a wrong rule.

53 The Defendant also addressed the Plaintiff's allegations that the Registrar's decision was "extremely prejudicial" or "resulted in extreme

unfairness”. It acknowledged that unduly harsh results could imply that the decision was irrational. However, that was not the case here. The Defendant argued that while the Registrar had reached an outcome that was unfavourable to the Plaintiff, this was part and parcel of dispute resolution. Unlike the case of *Aldridge, Appellant v Mayor, Aldermen, and Councillors of the Metropolitan Borough of Islington, Defendants* [1909] 2 KB 127, the Plaintiff was not placed in a legally impossible position as it was entirely open to the Plaintiff to decide whether to proceed with the trade mark proceedings with its original SOG or to commence fresh trade mark proceedings. The unfavourable outcome therefore did not amount to extreme prejudice or unfairness to the extent that it was irrational.

The court’s decision

54 After hearing the parties, I dismissed the Plaintiff’s application for leave as well as on the merits.

Leave to commence judicial review proceedings

55 In determining whether to grant leave to commence judicial review proceedings, the court has to consider whether the material before it discloses an arguable and *prima facie* case of reasonable suspicion (see *Public Service Commission v Lai Swee Lin Linda* [2001] 1 SLR(R) 133 at [20]-[22]). This is in addition to questions of the Plaintiff’s *locus standi* to commence judicial review proceedings, the justiciability of the subject matter, as well as the amenability of the administrative body, and the acts complained of, to judicial review. As these issues were not contested by the Defendant, the only issue before the court was whether the Plaintiff had established an arguable and *prima facie* case of reasonable suspicion in favour of granting leave. This has

been described as “a very low threshold” (see *Vellama d/o Marie Muthu v Attorney-General* [2012] 2 SLR 1033 at [10]).

56 The Plaintiff sought two forms of relief, namely, a quashing order against the Registrar’s decision to refuse the amendments to the Plaintiff’s SOG and a mandatory order directing the Registrar to allow the Plaintiff to amend its SOG in accordance with its proposed amendments. In respect of the mandatory order sought by the Plaintiff, I agreed with the Defendant that leave should not be granted because the High Court does not have the power to direct the Registrar to exercise her discretion in a particular manner (*ie*, to grant leave to the Plaintiff to amend its SOG). The High Court in *Borissik* at [21], citing the cases of *R v Justices of Kingston* 86 LTR 589 and *Re San Development Co’s Application* [1971-1973] SLR(R) 203, stated that “the court does not by mandamus direct any public body or anybody else upon whom a duty is cast how and in what manner they are to perform their duty”. Indeed, s 25 of the TMA provides that the Registrar “may”, pursuant to a written request, amend the application if it is fair and reasonable in all the circumstances of the case to do so. Parliament has clearly given the Registrar the discretion to decide whether to grant applications for amendments.

57 The Plaintiff did not satisfy the threshold required for leave to be granted to apply for a quashing order. Several of the Plaintiff’s claims were incorrect and the rest were insufficient in establishing an arguable and *prima facie* case of reasonable suspicion that the Registrar’s decision suffered from illegality or irrationality.

Illegality

58 As set out above, the Plaintiff made various claims in support of its position that the Registrar’s decision was tainted by illegality. The claims fell broadly within the following categories:

- (a) Failing to take into account relevant considerations;
- (b) Taking into account irrelevant considerations;
- (c) Error of law;
- (d) Error of fact;
- (e) Bad faith; and
- (f) Fettering of discretion.

59 The Plaintiff’s claims at [38(a)(i)-(iv)] were made on the basis that the Registrar had failed to take into account relevant considerations in her decision-making. However, these claims were completely unsupported by the facts. I have summarised the Registrar’s decision earlier and it showed clearly that she addressed the considerations set out in the Circular and articulated her reasoning in respect of each of the seven factors listed.

60 The Plaintiff’s claims at [38(a)(v) and (vi)] were made on the basis that the Registrar had taken into account irrelevant considerations. The Plaintiff has acknowledged in its own written submissions that the Registrar was “duty bound” to consider the factors expressed in the Circular. The Registrar did so. The Plaintiff failed to explain why the fact that the Plaintiff could institute fresh proceedings against the trade mark was an irrelevant consideration. Although this factor was not listed in the Circular, the Circular expressly states

that the list is non-exhaustive, thus allowing the Registrar to take into account other considerations that may be relevant in any particular case. This factor would be relevant in the Registrar's balancing exercise between "the public interest that rules relating to procedure are complied with" and "the need to ensure that there is proper adjudication of the case based on its merits in the interest of justice between the parties" in accordance with the Circular. The fact that the Plaintiff has the option of instituting fresh proceedings would mean that it still had the opportunity to proceed on its new grounds of invalidation and revocation.

61 The Plaintiff's claims at [3838(b)-(e)] were made on the basis that the Registrar was "incorrect/wrong in law" and had "applied the incorrect law" as she had relied on the "incorrect decisions" of *MGG*, *Asian Aisle* and *AEA International* and disregarded the decisions of *The Yellow Label* and *Chwee Kin Keong*. Errors of law include the misinterpretation of a rule of the common law and the exercising of discretion based on incorrect legal principles (see *Ng Eng Ghee and others v Mamata Kapildev Dave and others (Horizon Partners Pte Ltd, intervener) and another appeal* [2009] 3 SLR(R) 109 at [90] which listed various types of errors of law). There was nothing to suggest that the Registrar had misinterpreted the cases of *MGG*, *Asian Aisle*, and *AEA International*, which the Registrar had referred to for the purpose of setting out certain principles of law. The portions of these decisions which were relied on were cited in full in the Registrar's decision and they stood for the propositions stated. There was no suggestion that the Registrar misinterpreted those decisions in any way.

62 The Plaintiff also failed to show that the Registrar had relied on incorrect legal principles. Although the Plaintiff submitted that these decisions were "incorrect decisions", it was unable to explain how this was so. These

decisions, whether they were rendered by the courts or the Registrar, have not been overturned on appeal or quashed by higher courts. In any case, it is not the role of the court in judicial review to assess the legal “correctness” of these decisions, which can only be determined by an appeal on the merits.

63 Further, it could not be said that the Registrar disregarded the decisions of *The Yellow Label* and *Chwee Kin Keong*. These cases were cited several times in the Registrar’s decision (see for example [6], [8], and [10] of the Registrar’s decision). The Registrar was guided by the principles in *The Yellow Label* in her decision, although she eventually reached a different result as she did not allow the amendments. She also had regard to the case of *Chwee Kin Keong* but chose to place less reliance on it as it was decided in the context of court proceedings instead of proceedings before the Registrar of Trade Marks (see [8]-[9] of the Registrar’s decision).

64 The Plaintiff argued that the Registrar was “wrong in fact” or had “erred on the facts” (see above at [38(c) and (f)]). In administrative law, however, errors of fact are generally not reviewable, subject to certain exceptions, such as when there is manifestly insufficient evidence or none at all, or when there is an error as to precedent fact or a material fact (see *Doherty v Birmingham City Council (Secretary of State for Communities and Local Government intervening)* [2009] 1 AC 367 at [68], Anson Groves, *Judicial Review of Administrative Action* (Thomson Reuters, 5th Ed, 2013) at [4.10], Harry Woolf *et al*, and *De Smith’s Judicial Review* (Sweet & Maxwell, 7th Ed, 2013) at [4-052]). It also did not raise any of these exceptions in its submissions. In any event, the Plaintiff could not show, even at this preliminary stage, that there were factual errors. The Registrar was entitled, in the circumstances of the present case, to hold the views that she did.

65 Accordingly, all of the Plaintiff’s claims failed. However, within these claims, the Plaintiff also alluded to issues of bad faith and the fettering of discretion, both of which may stand as grounds for judicial review.

66 I agreed with the Defendant that the Plaintiff should be barred from making any assertion on bad faith. This allegation was made for the first time in the Plaintiff’s second set of written submissions dated 28 April 2016. The Plaintiff alleged that the Registrar acted in bad faith essentially because she applied the incorrect law. No elaboration was made in the Plaintiff’s written and oral submissions to explain how bad faith could possibly be established on the facts. As the Court of Appeal stated in *Muhammad Ridzuan bin Mohd Ali v Attorney-General* [2015] 5 SLR 1222, “the touchstone of bad faith in the administrative law context is dishonesty”. In all its submissions, the Plaintiff did not suggest in any way that the Registrar had acted dishonestly. The Plaintiff’s assertion on bad faith should therefore be disregarded completely.

67 The Plaintiff also alleged that the Registrar had fettered her discretion. A public body fetters its discretion if it adheres too strictly to a policy or takes orders from another person or body (e.g. another statutory board) when it is not under a legal duty to do so (see *Lines International Holding (S) Pte Ltd v Singapore Tourist Promotion Board and another* [1997] 1 SLR(R) 52 at [97]-[99]). There was no evidence that the Registrar had adhered to a policy of refusing applications to amend. The facts showed that the Registrar weighed all relevant factors, exercised her discretion and arrived at her decision based on the circumstances of the case before her. There was therefore no cause to even suggest that the Registrar had fettered her discretion.

Irrationality

68 In order to justify the court’s intervention, the Registrar’s decision had to be “so outrageously defiant of logic and propriety that it can be plainly seen that no reasonable person would or could come to that decision” (see *Chee Siok Chin* at [94]). In other words, the Registrar’s decision to refuse the amendments had to be so absurd that “no sensible person could ever dream that it lay within [her] powers” to do so (see *Chee Siok Chin* at [94]). In *Chee Siok Chin*, the court also said at [95]:

Reasonableness in arriving at a determination does not, however, mean that there should be a single inevitable approach or determination in any given matter. The essence of reasonableness is that decision makers can in good faith arrive at quite different decisions based on the same facts: there is an inherent measure of latitude in assessing reasonableness.

69 In my view, the Registrar’s decision to refuse the Plaintiff’s amendments could hardly be described as being so absurd that a reasonable decision-maker could not have come to it. It could not be said that allowing the proposed amendments was the only decision that a reasonable and rational decision-maker could have made. After analysing all the factors listed in the Circular as well as the circumstances of the case, it was completely open to reasonable and rational decision-makers to grant or to refuse the amendments.

70 Although the Plaintiff described the Registrar’s decision as being “extremely prejudicial”, I agreed with the Defendant that the Registrar’s decision was not so unduly harsh that it became “irrational”. Although the Plaintiff received an unfavourable outcome and would have to incur cost and inconvenience should it choose to begin fresh proceedings, such consequences are not uncommon in any litigation. In any case, the Plaintiff could not blame anyone for the situation it is now in as it has admitted that the need for the

amendments to the original SOG was a result of its own “oversight”, “haste”, and “insufficiency of thought” (see above at [30]).

71 At the hearing on 16 May 2016, the Plaintiff placed particular emphasis on the case of *Venice-Simplon* and argued that the Registrar’s decision was irrational because she had failed to consider that substantial prejudice would be caused to the Plaintiff should the amendments be refused and that no prejudice would be caused to the Registered Proprietor should the amendments be granted. In *Venice-Simplon*, the Court of Appeal upheld the quashing order on the grounds of both procedural impropriety and irrationality (see [20]-[23] of *Venice-Simplon*). The Registrar acted with procedural impropriety when she applied r 29 of the TMR when it was not the applicable rule. She also acted irrationally when she, in the exercise of her discretion, “failed to recognise and give due consideration” to the grave prejudice that would be suffered by Venice-Simplon and to the fact that no prejudice would be suffered by the other party (see [22] of *Venice-Simplon*).

72 However, the case of *Venice-Simplon* can be distinguished from the present case. The Registrar here did recognise and give due consideration to the prejudice that would be suffered by the Registered Proprietor and the Plaintiff should she decide to allow or refuse the amendments. This was unlike in *Venice-Simplon* where the registrar did not address her mind to the issue of prejudice as between the parties but instead was influenced by irrelevant considerations.

73 In any case, it could not be argued that the Registered Proprietor would suffer no prejudice should the amendments be allowed. The Plaintiff sought to add new grounds of invalidation and revocation after both parties had submitted their evidence. Should the amendments be allowed, the Registered

Proprietor would have to supplement its evidence. The question of whether this prejudice could be compensated by costs and whether it would outweigh any prejudice that the Plaintiff might suffer was a matter that lay within the discretion of the Registrar. It could not be said that the Registrar acted irrationally when, after having considered the issue of prejudice as between the parties, she decided that the Registered Proprietor would suffer greater or equal prejudice should the amendments be allowed and that this was a factor that would weigh against granting the amendments.

74 The Plaintiff's OS, far from raising an arguable and *prima facie* case of reasonable suspicion of illegality and irrationality in the Registrar's decision, was nothing more than a disguised appeal on the merits of the decision. Although the Plaintiff used terminology such as "relevant/irrelevant considerations", "fettered her discretion", and "error of law on the face of the record", these labels did not change the substance of the Plaintiff's submissions, which was to invite the court to examine the merits or correctness of the Registrar's decision and to substitute its own judgment for that of the Registrar. It is not the court's role in judicial review proceedings to determine the merits of decisions made by public authorities. Therefore, even if I held the view that the amendments would have been allowed if I were hearing the application to amend, I should not interfere with the Registrar's decision on the facts.

Merits of the judicial review

75 The fact that the Plaintiff could not even meet the low threshold required for leave to commence judicial review meant that it must fail on the merits. Accordingly, I dismissed the Plaintiff's OS.

Costs

76 The Defendant argued that it should be entitled to costs amounting to \$5,000 as well as reasonable disbursements of \$1,000. The Supreme Court Practice Directions (1 January 2013 release) at Appendix G (“the Costs Guidelines”) provide a cost estimate of \$12,000 per day for a contentious OS before the High Court where cross-examination does not take place. As the matter was scheduled for a half-day hearing, the Defendant took the view that \$5,000 in costs would be reasonable. The amount of \$1,000 in disbursements included the disbursements of IPOS as well as the AG when the AG was initially named as the Defendant in this OS.

77 The Plaintiff, on the other hand, submitted that \$1,000 would be sufficient for the entire hearing given that the hearing was concluded in less than half a day. It did not object to the Defendant’s claim of \$1,000 in disbursements.

78 Bearing in mind the PTCs that were conducted as well as the arguments as to the proper defendant in this case, the amount of \$5,000 in costs for the entire proceedings was more than fair. I therefore ordered the Plaintiff to pay \$5,000 in costs and \$1,000 in disbursements to the Defendant.

Events after the hearing of the OS

79 On 23 May 2016, the Plaintiff filed an application (“SUM 2527 of 2016”) for the following orders:

- (1) a declaration that leave to appeal to the Court of Appeal is not required or necessary and that appeal is as of right to the Court of Appeal for this action or matter against the decision of the Honourable

Justice Tay Yong Kwang made on the 16th day of May 2016 dismissing the abovenamed Plaintiff's application for Judicial Review of the decision of the Registrar of Trademarks refusing leave to amend the abovenamed Plaintiff's Statement of Grounds;

(2) in the alternative, that the Plaintiff be given leave to appeal to the Court of Appeal under Paragraph (a) of the Fifth Schedule to Section 34(2)(d) of the Supreme Court of Judicature Act (Cap 322) or otherwise, against the decision of the Honourable Justice Tay Yong Kwang made on the 16th day of May 2016 dismissing the application of the abovenamed Plaintiff for a Judicial Review of the decision of the Registrar of Trademarks refusing leave to amend the abovenamed Plaintiff's Statement of Grounds;

(3) the costs of this application be provided for.

At the same time, the Plaintiff also filed an affidavit by Ms Alina Sim in support of SUM 2527 of 2016.

80 SUM 2527 of 2016 was originally scheduled for hearing on 28 July 2016. On 30 May 2016, the Plaintiff requested the Registry of the Supreme Court to bring the hearing date forward because the time limit to file a notice of appeal would be 15 June 2016 if appeal was as of right. The hearing date was then rescheduled to 28 June 2016.

81 On 3 June 2016, the Defendant invited the Plaintiff to withdraw SUM 2527 of 2016 on the basis that the said paragraph (a) of the Fifth Schedule had no application to this OS and also in the light of recent authorities such as *OpenNet Pte Ltd v Info-communications Development Authority of Singapore*

[2013] 2 SLR 880 (“*OpenNet*”). An exchange of correspondence then took place between the parties.

82 In the Plaintiff’s letter of 13 June 2016, it stated that it did not agree that SUM 2527 of 2016 was unnecessary and that, in view of the legal position taken by the Defendant, it would ask the Court to grant an order in terms of prayer (1) of SUM 2527 of 2016 at the coming hearing. It also disagreed with the Defendant’s assertion that the application was frivolous and vexatious because there was genuine doubt whether the judicial review proceedings in this case finally disposed of or determined the substantive rights of the parties as the trade mark proceedings before the Registrar were still pending. The Plaintiff believed that it was an “open issue, full of doubt” that “could only be resolved by a declaratory order or otherwise”.

83 On 14 June 2016, before SUM 2527 of 2016 was heard, the Plaintiff filed a notice of appeal (Civil Appeal 79 of 2016) against my decision in the OS. This was followed by another affidavit by Ms Alina Sim on 16 June 2016 in which she explained the same “genuine doubt” as set out above which raised the question whether leave to appeal was necessary in this case. She went on to state that since the Defendant had expressed that an appeal here was as of right, there ought to be an order in terms of prayer (1) of SUM 2527 of 2016.

84 On Tuesday, 28 June 2016, SUM 2527 of 2016 came before me for hearing. By that time, it was academic as the Plaintiff had filed its notice of appeal. However, counsel for the Plaintiff informed me that the Plaintiff was looking for a new counsel to take over the case from him, including SUM 2527 of 2016. If the Plaintiff was unsuccessful, Ms Alina Sim would apply under O 1 r 9 of the ROC for her to represent the Plaintiff. The Plaintiff

therefore requested a 6-week adjournment of SUM 2527 of 2016. However, the Defendant was only willing to agree to a 3-week adjournment.

85 In order not to delay SUM 2527 of 2016 and thereby the appeal to the Court of Appeal and, consequently, the trade mark proceedings as well, I suggested to the parties that I could hear SUM 2527 of 2016 on Friday, 1 July 2016 and that since the Plaintiff was not likely to have new counsel by then, I would grant leave forthwith for Ms Alina Sim to represent the Plaintiff since she is an advocate and solicitor and the written submissions from both parties had already been filed. I told Ms Alina Sim (who, as before, was permitted to attend the hearing and to speak) that I was also prepared to hear her on SUM 2527 of 2016 immediately if she was ready to present the arguments. She agreed with the proposed course of action but requested that the hearing be in the afternoon of Friday, 1 July 2016. I acceded to her request. Immediately after the hearing on 28 June 2016, the hearing date of Friday, 1 July 2016 was brought forward by me to 10am on Thursday, 30 June 2016 with the agreement of both parties.

86 On 30 June 2016, Ms Alina Sim argued on behalf of the Plaintiff. The Plaintiff maintained its position that it was not withdrawing SUM 2527 of 2016 but was asking for an order in terms of prayer (1) therein. Its position was that leave to appeal was not necessary but because of the uncertainty in the law and out of abundance of caution, it wanted the Court to declare that leave to appeal was indeed not necessary. The Plaintiff also submitted that since it was successful in its application, it should be awarded costs against the Defendant. Alternatively, the Plaintiff would leave the issue of costs to the Court.

87 The Defendant objected to SUM 2527 of 2016 as a matter of principle. In its view, the law was clear from the Court of Appeal’s decision in *OpenNet*. It acknowledged that the Court of Appeal in *The Chem Orchid and other appeals and another matter* [2016] 2 SLR 50 suggested that where there was uncertainty over whether leave to appeal was required, the proper approach would be for the appellant to seek a declaration from the High Court that such leave was not required. However, Steven Chong J in the very recent case of *The “Xin Chang Shu”* [2016] SGHC 93 at [9] has cautioned that:

Such an application should only be made if there is *genuine* uncertainty. This guidance should not be taken as a licence for litigants to rush to court for such rulings as a matter of course. After all, the duty remains on the lawyers to advise the client, based on the governing principles, whether leave of court is required.

(italics in original)

The Defendant submitted that, based on the authorities, there was no uncertainty in this case because my order dismissing the OS was final.

88 The Defendant further submitted that as the Plaintiff was maintaining its stand that there was uncertainty, the Plaintiff was guilty of unreasonable or irrational conduct. It therefore asked that SUM 2527 of 2016 be dismissed with costs on the indemnity basis to be paid by the Plaintiff to the Defendant. Referring again to the Costs Guidelines (see [76] above), the Defendant suggested that the present application, which was fixed for hearing for one morning, would attract costs in the range of \$4,000 to \$15,000 on the standard basis. Accepting that there would not be much difference between costs on the standard basis and costs on the indemnity basis in the circumstances here, the

Defendant submitted that \$4,500 be awarded on the indemnity basis. In addition, it asked for payment of its disbursements of \$324.

89 In reply, the Plaintiff argued that *OpenNet* concerned paragraph (e), and not paragraph (a), of the Fifth Schedule of the Supreme Court of Judicature Act (Cap 322, 2007 Rev Ed). There was also the test of whether an order was interlocutory or final discussed in the English Court of Appeal's decision in *Salter Rex & Co. v Ghosh* [1971] 2 QB 597 which was not discussed in our local decisions. Further, as our Court of Appeal has declared that it could depart from its previous decisions, a subsequent Court of Appeal may depart from the decision in *OpenNet*. On the issue of costs, the Plaintiff submitted that its application was not frivolous or vexatious. It had tried to get the Defendant to agree to a consent order with no costs order. In any case, it took less than 45 minutes for the Court to hear SUM 2527 of 2016.

The Court's decision in SUM 2527 of 2016

90 I agreed that the Plaintiff's application was quite unnecessary in the circumstances of this OS. There could be no uncertainty that my order dismissing the OS was a final order disposing of all issues in the OS. The Plaintiff's confusion appeared to have arisen because it did not segregate the trade mark proceedings from the judicial review proceedings. The trade mark proceedings may still be pending but they are pending between the Plaintiff and the Registered Proprietor. The judicial review proceedings, on the other hand, are between the Plaintiff and the Defendant. Nothing that happens in the future in the trade mark proceedings will affect my order in this OS.

91 However, since the application was before me and Ms Alina Sim needed the comfort of an order declaring that leave to appeal was not

necessary, I decided to grant an order in terms of prayer (1) of SUM 2527 of 2016. While I accepted that the application was unnecessary and that the Plaintiff's sense of uncertainty was unfounded, I did not think there was any intention to abuse the process of the Court in any way. There was therefore no cause to order costs on an indemnity basis against the Plaintiff. Nevertheless, the Plaintiff should pay costs on the standard basis to the Defendant for taking out an unnecessary application and maintaining its stand of uncertainty throughout the hearing. Accordingly, I ordered the Plaintiff to pay costs of \$4,000 and disbursements amounting to \$324 to the Defendant.

Tay Yong Kwang
Judge

Daniel Ho (Summit Law Corporation) for the Plaintiff;
David Chong, SC, Adrian Loo, Elaine Liew, and Ho Jiayun
(Attorney-General's Chambers) for the Defendant;
Sandeep Menon (Dentons Rodyk & Davidson) (on watching brief)
for the Registered Proprietor