

**IN THE HEARINGS AND MEDIATION DEPARTMENT OF
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
REPUBLIC OF SINGAPORE**

REGISTRAR’S DECISION UNDER TRADE MARKS RULE 37(4)

Introduction

1 Seek Asia Pte Ltd (“the Applicant”), applied to register the trade mark:



(“the Application Mark”) (“Seek Asia Composite Mark”)

in Singapore on 3 March 2017 under Trade Mark No. 40201700430V in Class 35 in respect of:

Information services relating to jobs and career opportunities; Job agency services; Job and personnel placement; Job placement; Job placement services; Online advertising on a computer network; Online advertising via a computer communications network; Online promotion on a computer network; Providing information, including online, about advertising, business management and administration & office functions; Advertising; business management; business administration; office functions.

2 Seek Limited (“the Opponent”) opposed the registration of the Application Mark based on various grounds on 7 August 2017. At the pre-hearing review on 12 December 2018, the Opponent confirmed that it would proceed only on grounds based on Sections 7(6) and 8(7)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“the Act”). Sections 7(6) and 8(7)(b) of the Act deal with allegations of bad faith and copyright infringement respectively.

Background of Parties

3 The Opponent is an Australian-incorporated company listed on the Australian Securities Exchange, where it is a top 100 company with a market capitalisation in excess of AUD 6 billion. Its core business is the provision of job recruitment services.

4 The Opponent’s subsidiaries jobsDB SG and JobStreet SG had employed one Lakshmanan Meenakshi Sundaram (“Meenak”) between 2014 and 2018. Meenak is also the Chief Executive Officer of the Applicant, which was incorporated in 2014, 11 months after the commencement of Meenak’s employment with jobsDB Singapore during which he was exposed to the Opponent’s various permutations of its “Seek Asia” marks, including the Seek Asia Composite Mark.

5 The Applicant’s principal activities listed on its Accounting and Corporate Regulatory Authority business profile were “Accounting and auditing services

(including taxation advisory services)” from 15 December 2014 to at least 18 May 2017. It is noted that such a profile is different from the specification of services claimed in [1] above. This business profile was then amended on or around 29 October 2017, after this opposition was commenced, to “Executive Search Services Online Job Portal for Employers and Employees”, which is more consistent with the specification in [1] above. However, the “job listings” that appeared on the Applicant’s portal were either gibberish or, it seems, copied from job listings elsewhere. The Opponent alleges that the Applicant has no *bona fide* intention to use the Application Mark in relation to the services in the specification. As elaborated at [9] below, the Opponent submits that the Applicant only applied to register the Application Mark as a means to extort money from the Opponent.

Parallel Proceedings in Court

6 The Opponent also took out proceedings in the High Court against the Applicant and sought summary judgment. The details are as follows:

Case No.: HC/S 173/2019
Filed: 11 February 2019
Sub Case No.: HC/SUM 3656/2019
Filed: 19 July 2019
Heard: 19 August 2019

7 Suit 173/2019 was concluded on 19 August 2019 with a summary judgment by Justice Chan Seng Onn (HC/JUD 452/2019). The learned judge held that the Applicant’s use of the Application Mark infringed the Opponent’s copyright in the Seek Asia Composite Mark. He accordingly granted a permanent injunction (see [2] of the judgment following the order of court), “*restraining the [Applicant] whether by itself, its directors, officers, employees, servants or agents or any of them or otherwise howsoever from reproducing, publishing, communicating to the public the Seek Asia Composite Mark ..., or otherwise infringing or dealing with the [Opponent’s] copyright in the Seek Asia Composite Mark, and/or from directing, causing, procuring, instigating, enabling or assisting others to do so.*”

8 The Opponent also commenced a further High Court suit, HC/S 615/2019, and filed a default judgment application, Sub Case No. HC/SUM 3704/2019. Several defendants were named, including VIP Infocomm & Software Pte Ltd (“VIP”), which had common directors and identical shareholders as the Applicant. Chan J heard the application on 12 September 2019 and granted the Opponent’s application for default judgment on all its claims (HC/ORC 6230/2019). The facts of these later proceedings need not be relied on in coming to the decision the Registrar does in this opposition (a finding of copyright infringement) so they are only mentioned for completeness.

Conduct of Applicant

9 It is the Opponent’s submission that the Applicant only applied to register the Application Mark as a means to extort money from the Opponent. On 4 November 2017, the Applicant emailed the Opponent’s Chief Executive Officer threatening to report the Opponent to the Singapore Stock Exchange and the then-Competition Commission of Singapore (“CCS”). The email ended with a statement that the

Opponent should “*solve this dispute in a smart way*”. On 14 November 2017, the Applicant forwarded to the Opponent its email complaint to the CCS. In the complaint, the Applicant alleged that the Opponent was “*trying to suppress our online job portal and try to create monopoly online job portal market (sic) similar like in Australia, SEEK Limited trying to attain monopoly online job portal market (sic) in Singapore also*”. Finally, in a teleconversation on 17 November 2017 between the Applicant and Baker & McKenzie.Wong & Leow (who are the Opponent’s lawyers for this opposition), the Applicant demanded S\$5 million from the Opponent in exchange for withdrawing Trade Mark Application No. 40201700430V. On 29 November 2017, the Opponent rejected the Applicant’s offer as being unreasonable and opportunistic, but remained open to considering another substantially lower figure.

10 Further to the summary judgment by Chan J (HC/JUD 452/2019), the Opponent’s lawyers wrote to the Applicant on 22 August 2019 to demand, among other things, that the Applicant withdraws Trade Mark Application No. 40201700430V, as this followed from the finding of copyright infringement. The Applicant was unresponsive to the Opponent’s demands following the High Court’s orders. (Likewise, VIP, after a default judgment (Suit 615/2019) against it on 12 September 2019, was unresponsive to the Opponents’ demands on 17 September 2019.)

11 In the advanced stage of these opposition proceedings, the Applicant was not responsive to both the Registrar’s and the Opponent’s communication despite having been given multiple opportunities to respond. The Applicant lapsed into silence after its letter to the Registrar on 7 July 2019 and missed deadlines thereafter to respond on various issues. The Applicant did not participate in the last pre-hearing review on 9 October 2019; did not withdraw the opposed application by 23 October 2019 as directed by the Registrar, notwithstanding that this was the most time- and cost-effective way to conclude the proceedings; did not meet the deadline to file written submissions by 30 December 2019; and did not file Form HC1 to attend the hearing fixed on 30 January 2020.

12 The Applicant did write to the Registrar on 27 January 2020 through its director, Lakshmanan Meyyappan (“LM”), to seek a postponement of the hearing on the ground that LM was bankrupt and needed time to obtain approval to appear at the hearing. The Registrar did not vacate and re-fix the hearing date of 30 January 2020 because the Applicant in this opposition is Seek Asia Pte Ltd, a separate legal entity from LM. The Registrar also gave the Applicant a final reminder to withdraw its application to register Trade Mark No. 40201700430V, given the outcomes of the court proceedings, in the interest of saving time and costs all round.

Procedural Provisions

13 The Trade Marks Rules (Cap 332, 2008 Rev Ed) make provision for the procedure relating to hearings. The relevant extract from Rule 37(4) is set out below:

Opposition hearing

37.—(1) Upon completion of the filing of evidence by the parties, the Registrar shall give notice to the parties of a date on which he will hear arguments on the case.

(2) The parties shall file with the Registrar their written submissions and bundles of authorities at least one month before the date of hearing, and shall at the same time exchange with one another their respective written submissions and bundles of authorities.

(3) Any party who intends to appear at the hearing shall file with the Registrar Form HC1 before the hearing.

(4) Any party who does not file with the Registrar Form HC1 before the hearing may be treated as not desiring to be heard, and the Registrar may proceed with the hearing in the absence of that party or may, without proceeding with the hearing, give his decision or dismiss the proceedings, or make such other order as he thinks fit.

14 As seen from Rule 37(3) above, a form called Form HC1 needs to be filed by a party who intends to appear at the hearing. If this is not done, there is a range of possible consequences, as found in Rule 37(4) above.

15 On the day of the hearing, the Applicant did not file Form HC1 and did not attend the hearing. Given the outcomes of the parallel proceedings in the High Court; and given the conduct of the Applicant on the one hand and the public interest in the time- and cost-effective resolution of these proceedings on the other hand; as well as the expense incurred and delay suffered by the Opponent because of the Applicant's dilatory conduct in not withdrawing the opposed application notwithstanding the outcomes of the High Court proceedings, it would be appropriate to conclude this opposition expeditiously and at lower cost by giving a decision without proceeding with a hearing. The Registrar therefore hereby exercises his power under Rule 37(4) of the Trade Marks Rules (Cap 332, 2008 Ed) to give his decision without having proceeded with the hearing.

Opponent's Evidence

16 The Opponent's evidence comprises the following statutory declarations:

No.	Deponent	Designation	Date Made	Place Made
1	Philip Tan See Wei	Managing Partner, Commercial Investigations LLP	2 May 2018	Singapore
2	Paul James Findlay	Creative Director and Founder, Brands to life	27 April 2018	Australia
3	Derek Robert Miller	Group General Counsel, Seek Limited	7 May 2018	Australia
4	Philip Tan See Wei	Managing Partner, Commercial	13 November 2018	Singapore

		Investigations LLP		
5	Derek Robert Miller	Group General Counsel, Seek Limited	15 November 2018	Australia
6	Derek Robert Miller	Group General Counsel, Seek Limited	19 August 2019	Australia
7	Derek Robert Miller	Group General Counsel, Seek Limited	1 November 2019	Australia

Applicant's Evidence

17 The Applicant's evidence comprises a statutory declaration made by Lakshmanan Meyyappan, Founder and Managing Director of the Applicant, on 9 January 2019 in Singapore.

Applicable Law and Burden of Proof

18 As the applicable law is the Act, there is no overall onus on the Applicant either before the Registrar during examination or in opposition proceedings. The burden of proof in the present case falls on the Opponent.

Ground of Opposition under Section 8(7)(b)

19 Section 8(7)(b) of the Act reads:

(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

...

(b) by virtue of an earlier right other than those referred to in subsections (1), (2) and (3) or paragraph (a), in particular by virtue of the law of copyright or any law with regard to the protection of designs.

20 The Opponent's pleading under this ground of opposition is found at [20] of its grounds of opposition:



In addition, the registration and use of the Application Mark without our consent or authorisation would be liable to be prevented by virtue of our earlier and





subsisting copyright in the logo “ ”. Registration of the Application Mark should therefore be refused pursuant to Section 8(7)(b) of the Trade Marks Act.


21 As described above, Chan J has held in Suit 173/2019 that the Applicant's use of the Application Mark infringed the Opponent's copyright in the Seek Asia Composite Mark.

22 Although the subject-matter of copyright relied on by the Opponent in this

opposition (“”) and in Suit 173/2019 (“ seek asia”)

differs, the Registrar notes that the logo “” is wholly subsumed in the

Application Mark. This means that there has been 100% copying of “” on the part of the Applicant, taking into account the context of the High Court's finding of copyright infringement in Suit 173/2019. The use of the Application Mark is therefore

liable to be prevented by virtue of the earlier copyright in the logo “”.

23 The Opponent has therefore made out its case under Section 8(7)(b) of the Act.

Conclusion

24 Having considered all the pleadings and evidence filed and the Opponent's submissions made in writing, the Registrar finds that the opposition succeeds under Section 8(7)(b). It is not necessary for the Registrar to consider the other ground of bad faith under Section 7(6) of the Act.

25 The Opponent is entitled to costs to be taxed, if not agreed.

See Tho Sok Yee
Principal Assistant Registrar of Trade Marks

4 February 2020