

Evidentiary Issues (HMG Circular No. 3/2015, dated 30 June 2015)

This circular seeks to clarify the Registrar's practice with regard to various evidentiary issues as set out below.

Unless otherwise specified, the rules referred to in this circular are rules from the Trade Marks Rules (Cap 332, 2008 Rev Ed) ("Rules"). The focus of this circular is on trade marks proceedings before the Registrar. However, where relevant, the practice applies to patents and registered designs proceedings before the Registrar as well.

The provisions relating to evidence before the Registrar are provided for under Rules 69 to 71.

Under Rule 69, the default mode of providing evidence before the Registrar is via a statutory declaration ("SD"). This is likewise the case for evidence filed in registered designs proceedings before the Registrar, under Rule 54 of the Registered Designs Rules (Cap 266, 2002 Rev Ed). Evidence filed in respect of patent proceedings before the Registrar of Patents is by way of statutory declaration or affidavit, under Rule 102 of the Patents Rules (Cap 221, 2007 Rev Ed).

A. Statements of Information or Belief

The Registrar is mindful of the need to strike a balance between the desirability of cogent evidence, on the one hand, and costs incurred in procuring such evidence, on the other. In order to manage costs before a low cost administrative tribunal, the Registrar's consistent practice has been to accept evidence that meets the standard set out in O41,r5(2) of the Rules of Court rather than the higher standard set out in O41,r5(1) of the Rules of Court. In other words, an SD need not necessarily contain only such facts as the deponent is able of his own knowledge to prove, but also may contain statements of information or belief with the sources or grounds thereof.

B. Translations

The official language used in proceedings before the Registrar is English. Therefore, any document which is not in the English language should be translated into English.

Translated copies of foreign language documents that form part of an SD are acceptable (i.e. the translator need not file a separate SD). As far as possible, a certified translation is desirable. This is especially so where the contents of the document are of significance to a party's case. Where the content to be translated is short, for example, the meaning of a single

foreign word, extracts from dictionaries (including online ones) may be taken into account. In all cases, the Registrar will give the relevant weight (if any) to the foreign language document accordingly.

For the avoidance of doubt, documents tendered only to show the depiction of a trade mark need not be translated. One example would be advertisements where the sole intention is to show the depiction of the mark as advertised and the actual contents of the advertisement, in a foreign language, are not relevant.

C. Evidence of Sales

Statements of account; or figures given in the main body of SDs as supported by sample invoices in the exhibits, are generally acceptable. However, the weight to be given to such evidence will vary depending on the relevance of the documents. For example, where the sample invoices do not reflect the subject mark in relation to the specification in question, the weight to be given to such invoices, if any, is low. This in turn affects the weight of the assertions on annual sales volume which is purportedly supported by the invoices.

D. Evidence of Advertising Expenditure

Advertising expenditure figures given in the main body of SDs as supported by sample invoices in the exhibits are generally acceptable. However, as with C. above, the weight to be given to such evidence will vary depending on the relevance of the documents. For example, where there is no demonstrable link between the sample invoices, the advertisements themselves and the subject mark in relation to the specification in question, the weight to be given to such invoices, if any, is low. This in turn affects the weight of the assertions on the amount of advertising expenditure which is purportedly supported by evidence over the years.

E. Newspapers and Other Articles/Publications

Newspapers and other articles/publications are generally acceptable. However, the weight to be given to such evidence will vary depending on its relevance, including whether it refers to the mark in relation to the specification in question.

Should such sample articles be in a foreign language, these should be translated (see details at B. above).

For the avoidance of doubt, the Registrar draws a distinction between copies of published documents and printouts from official websites versus printouts from other pages on the internet.

For the former, the Registrar may, depending on the circumstances of the case, accept the contents of the copies or printouts for the truth of the statements made. However, any printouts from other pages on the internet will generally *not* be accepted for the truth of the statements made but only for the fact that such statements have been made.

This distinction is drawn as published documents or printouts from official websites (e.g. online annual reports from company websites) are generally accounted for by the publisher. This is in contrast to, for example, forum discussions where the contributor of the comments can hide behind a pseudonym and thus cannot be held accountable for the comments made.

An exception to the above is where the website, while not being “official” in the sense that there is an entity accountable for its contents, has nevertheless been recognised by users to be a reasonably reliable source of information. One such example is *Wikipedia*, an extract from which the High Court in ***Formula One Licensing BV v Idea Marketing SA*** [2015] 5 SLR 1349 had taken into consideration. Even in such an example, the Registrar has the discretion on the weight to be accorded to evidence from such sources.

F. Trade Mark Certificates

Evidence comprising trade mark certificates will be given the relevant weight depending on the purpose for which they have been adduced, the marks themselves, the classes in which the marks are registered, the jurisdiction of registration, and so on.

Should such certificates be in a foreign language, these should be translated (see details at B. above).

G. Decisions in Other Proceedings

Decisions in other proceedings (whether in Singapore or in other jurisdictions) will be given the relevant weight depending on the purpose for their reliance, the subject matter of the decisions, the jurisdiction of the decision, and so on. There is a distinction between the fact of the decisions and the fact of their specific findings, which is generally acknowledged by the Registrar on the one hand; and the veracity of the facts set out in the decisions on the other hand. In the latter case, the facts should be proven by way of SD in the proceedings before the Registrar with very limited exceptions (e.g. confidentiality obligations bind a party from disclosing terms of a settlement agreement but a court decision refers to some of its contents).

Should such decisions be in a foreign language, these should be translated (see details at B. above).

H. Evidence Filed in Related Proceedings

Where a party wishes to rely on an SD, affidavit or witness statement filed in related proceedings, as far as possible, the same evidence should be redeclared (that is, to declare a fresh SD with the same content) by the same deponent for the purposes of the proceedings before the Registrar.

The Registrar *may* accept the SD, affidavit or witness statement appended as an exhibit to an SD filed for the purposes of proceedings before the Registrar, but will give the appropriate weight to that exhibit.

I. Private Investigator's (PI) Report

Ideally, a PI report should be adduced by way of an SD (as an exhibit) declared by the PI. However, the Registrar will also accept a PI report adduced as an exhibit to the SD of a parties' deponent.

Under Section 71 of the Trade Marks Act (Cap 332, 2005 Rev Ed), the Registrar also has the power to summon witnesses, including any yet-to-be identified PI who conducted the ground investigations.

J. Survey Evidence

Survey evidence will be given the relevant weight depending on its relevance and credence. Survey evidence in itself is not conclusive of the propositions a party makes as the Registrar still has a duty to interpret the survey results and draw the relevant inferences. Parties should take note of the Courts' latest guidance on such surveys. The Registrar's current practice, which is subject to the Courts' latest guidance, is as follows:

1. the interviewees in the survey must be selected so as to represent the relevant cross-section of the public;
2. the size of the survey must be statistically significant;
3. the survey must be conducted fairly;
4. all the surveys carried out must be disclosed, including the number of surveys carried out, how they were conducted and the totality of the persons involved;
5. the totality of the answers given must be disclosed and made available to the defendant;
6. the questions must neither be leading, nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put;

7. the exact answers and not some abbreviated form should be recorded;
8. the instructions to the interviewers as to how to carry out the survey must be disclosed; and
9. where the answers are coded for computer input, the coding instructions must be disclosed.

Parties should note that survey evidence, which is regarded as a major disbursement item, is subject to the non-compensatory principle. For more information, please refer to HMG Circular 1/2015 in relation to Costs.