

Full Hearings: Cross-Examination, Filing Requirements (IP²SG), Attendance and Tendering of Additional Submissions (HMG Circular No. 4/2015 dated 30 June 2015) (Amended 22 July 2016)

This Circular shall come into effect on 30 July 2015 and shall apply to all actions pending before the Registrar as from 30 July 2015 onwards. The amendments made on 22 July 2016 are inserted for clarification purposes only.

The focus of this circular is on trade marks proceedings before the Registrar. However, in general, the practice in this circular also applies to patents and registered designs proceedings before the Registrar, respectively under the Patents Rules (Cap 221, 2007 Rev Ed) and Registered Designs Rules (Cap 266, 2002 Rev Ed).

This circular deals with certain changes in light of amendments to the Trade Marks Rules (Cap 332, 2008 Rev Ed) (“Trade Marks Rules”) that came into effect on 13 November 2014, as well as changes arising from the *Trade Mark Dispute Resolution Regime for Disputes Before IPOS Review* in 2014. References to rules in this circular refer to the post-amendment Trade Marks Rules.

A. Cross-Examination

Cross-examination in IPOS proceedings is allowed under Rule 69(3). Typically, the Registrar will confirm with the parties at the Pre-Hearing Review (“PHR”) whether they will be seeking cross-examination of the deponent(s) of Statutory Declarations (“SDs”) already filed with IPOS.

Request for Cross-Examination

With effect from the date of commencement of this circular, a party that wishes to cross-examine any witness on his SD, must make a request to do so at the earliest opportunity in writing (preferably, prior to the PHR) to ensure that reasonable notice is given. This request should include the following details:

1. Name(s) of the witness(es) the party wishes to cross-examine
2. Reasons why cross-examination of each of these witnesses is requested
3. Specific issues to which cross-examination would, if allowed, be directed.
For the avoidance of doubt, the Registrar does not expect parties to provide a list of questions to be asked
4. Explanation of the relevance of those issues to the matters to be decided
5. Estimate of the time any cross-examination is expected to take.

The request must be copied to any other party to the proceedings.

If the request is received, the Registrar will need to be satisfied that cross-examination will facilitate the just, expeditious and economical disposal of the proceedings (Rule 36A(1)). The Registrar will issue directions indicating whether cross-examination is to be permitted and if so set out the scope for such cross-examination. This issue may also be discussed and determined at the PHR.

A request for cross-examination is likely to be allowed where it is not disproportionate and unnecessarily costly and burdensome. In making this assessment, the Registrar bears in mind that in IPOS trade mark proceedings, the evidence stages are sequential, providing opportunities to deal with points during proceedings. In addition, cross-examination may not be permitted if the truth or otherwise of the challenged statement manifestly has no bearing on the outcome of the case.

Examples where a request for cross-examination will be allowed

1. Where one of the issues raised in the dispute is bad faith, cross-examination as to the particulars of bad faith alleged in the SD(s)
2. Where the party seeking cross-examination has reason to believe that the deponent's SD contains unreliable evidence and these facts are relevant to the issues raised in the dispute
3. Where there is conflicting evidence on the facts relevant to the issues raised in the dispute, and cross-examination would assist in clarifying the situation
4. Where the deponent to be cross-examined is based outside Singapore but it is in the interest of justice to do so e.g. one of the above situations (enumerated at 1-3) apply.

*Examples where a request for cross-examination may **not** be allowed*

1. Where the deponent to be cross-examined is based overseas, and cross-examination is used by the requesting party as a litigation strategy to force the opposite party to incur unnecessary costs;
2. Where the issues in question could have been addressed by way of evidence filed by the party instead of cross-examination (given that the evidence stages in IPOS trade mark proceedings are sequential).

If the request is allowed, the Registrar is prepared to consider the use of appropriate video-conferencing options. This should be discussed with and decided by the Registrar at the PHR. The non-exhaustive, non-cumulative factors which the Registrar will consider in deciding whether cross-examination should take place via video-conferencing are: (i) whether the deponent(s) are based outside Singapore; (ii) whether there are sufficient administrative and technical facilities agreed upon by both parties*; (iii) whether any party to the proceedings would be unfairly prejudiced if video-conferencing was allowed / not allowed. Costs of video-conferencing may eventually be reimbursed at taxation stage, subject to the usual principles.

Further, for avoidance of doubt, if the request is allowed, general legal principles of cross-examination will apply.

*Parties should note that IPOS currently does not have video-conferencing facilities.

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| In relation to B. below, this Circular supplements Special IP ² SG Practice Direction No. 2 of 2014 (10 November 2014) ("IP ² SG Circular"). |
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B. Filing of Statutory Declarations, Written Submissions, Bundles of Authorities

Filing Requirements In Light of IP²SG

Parties are encouraged to e-file their forms and documents using IP²SG. The advantage of e-filing is that parties have an automatically confirmed filing date, since receipt of the form or documents is reflected immediately in the system. IPOS staff will be able to access it immediately. Filing forms and documents via the Service Bureau may result in some delay due to the time needed to digitise the documents and upload them into IP²SG.

However, if the form or document is not filed under the correct link in IP²SG, the filing date cannot be automatically confirmed. The following table sets out the correct links for e-filing:

| S/No. | Item to be E-filed | Description of Form in IP ² SG | File Via | Notes |
|-------|--|--|---|--|
| 1. | Statutory Declaration | Evidence by Initiator Evidence by Respondent Evidence in Reply by Initiator | E-file by way of "Online Filing" → "Forms" | Parties with or without an IP ² SG account may file. |
| 2. | Further Statutory Declarations (i.e. "Further evidence" with leave under Rule 35, including re-filed SDs following PHR directions) | [None] | E-file by way of attachment in an ad hoc correspondence | Party without IP ² SG account will have to file via hard copy over the counter. |
| 3. | Written Submissions and Bundle(s) of Authorities | Written Submissions and Bundle(s) of Authorities Note: Documents should match the attachment type description e.g. Written submissions and their annexes should be filed under the label "Written Submissions". | E-file by way of "Online Filing" → "Forms" | Parties with or without an IP ² SG account may file. |
| 4. | Additional or | [None] | E-file by way of | Party without |

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|--|-----------------------------------|--|--|--|
| | Supplementary Written Submissions | | attachment in an ad hoc correspondence | IP ² SG account will have to file via hard copy over the counter. |
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However, the size of a *single submission* (that includes, for example, the main body of a SD *together* with the exhibits, or a party's written submission *together* with the bundle of authorities) that can be transmitted via IP²SG cannot exceed 100 MB.

Written submissions, bundle(s) of authorities, and SDs may be submitted via portable media if the file size exceeds 100MB.

For the avoidance of doubt, any submission which exceeds 100MB should be submitted via a portable media. Thus in the scenario where an SD comprises multiple exhibits, one of which exceeds the maximum file size of 100 MB, the entire SD (together with the accompanying exhibits) should be submitted via portable media.

In the event where the evidence comprises more than 1 item (for example, the evidence comprises of the main SD as well as physical exhibits), regardless of whether such an item is in the form of a portable media or is simply a physical exhibit such as a T-shirt, the filing date which will be accorded for the evidence will be that of the filing date of the last item filed. Parties are therefore encouraged to file their evidence on one day instead, before the deadline expires.

"Portable media" includes recordable compact discs or recordable digital versatile disk. A submission by portable media is treated as received by the Registry in the same manner as the receipt by the Registry of submissions made by way of paper documents as provided in the Patents, Trade Marks and Registered Designs Rules (see IP²SG Circular at paragraph 10(9)). Further practical details as to how to create a compliant portable media submission may be found in the IP²SG Circular at paragraph 10.

For filing of other hearings-related documents in IP²SG, please refer to HMG Circular 5 of 2015, "*E-filing of Other Documents in HMG Proceedings*."

Submission of Hard Copies

In order to balance the transition to electronic filing with the need for ease of reference in preparation for and/or during hearings at HMG, the following distinction is made as regards hard copies:

- (a) ***Filing*** of hard copies for the purpose of securing a filing date

SDs, Written Submissions and Bundles of Authorities ***filed*** in hard copy over the counter, for the purpose of securing a filing date, are subject to Service Bureau charges. The Service Bureau is established to assist a person in the use of the electronic online system for giving, sending to, filing with or serving any document on the Registrar or the Registry (see Rule 78I (Service Bureau)).

Further details on the Service Bureau charges are found in the IP²SG Circular at paragraph 11 and at the IPOS website at:

<http://www.ipos.gov.sg/Services/FilingandRegistration/FormsandFees/TradeMarks.aspx#ServiceBureaucharges>

(b) **Submission** of hard copies for the purposes of hearing

During the PHR, parties should discuss if hard copies of SDs, Written Submissions and Bundles of Authorities are useful for the purpose of a hearing. If it is decided or agreed that hard copies will be useful for the purpose of a hearing, the parties could electronically file their Written Submissions and Bundles of Authorities via IP²SG (to avoid Service Bureau charges) and also **submit** hard copies of the relevant documents to the Registrar by hand or by post. Parties may also submit hard copies of their SDs to the Registrar by hand or by post, if they have filed these earlier on through IP²SG.

In this situation where SDs, Written Submissions and Bundles of Authorities are submitted in hard copies over and above the electronically filed copies, the Service Bureau charges do not apply. This is because the hard copy document is provided to the Registrar for ease of reference in preparation for or during the hearing.

For both (a) and (b), the following should be observed:

1. Documents should be firmly secured together with plastic ring binding or plastic spine thermal binding. The rings or spines should be red for initiators (ie. opponents or applicants for revocation/invalidation) and blue for respondents (i.e. applicants for registration or registered proprietors). Exceptions are allowed on a case by case basis e.g. where the SD is notarised in a foreign jurisdiction and sealed in such a way that it is not possible to ring bind it.
2. The documents should be paginated consecutively at the top right hand corner of each page. Pagination should commence on the first page of the first bundle and run sequentially to the last page of the last bundle. Pagination may not be necessary if it is still possible to conveniently make a reference to a particular page. For example, in the case of published law reports, as long as there are flags, and the published law reports are paginated in the original, there should not be a need to re-paginate.

In particular, the Bundle of Authorities must:

1. Contain all the authorities, cases, statutes, subsidiary legislation and any other materials relied on (e.g. academic articles);
2. Have flags to mark out each authority referred to. Such flags shall bear the appropriate incidium by which the authority is referred to;
3. Contain an index of the authorities in that bundle; and
4. Be legible.

The Registrar may disregard or ask the party to re-file, re-submit and/or re-serve any document not in compliance with the above.

In relation to C., D. and E. below, this circular supersedes HMG Circular 5/2011 dated 26 August 2011 on Attendance at Opposition / Revocation / Invalidation / Rectification Hearings.

C. Attendance at Full Hearings

Rule 37, read with Rule 59, relates to attendance at full hearings, and the Registrar's powers as regards the same.

Form HC 1 not filed by one party: Registrar will usually proceed with hearing

If no Form HC 1 is filed on behalf of a party, he may be treated as not desiring to be heard. Rule 37(4) allows the Registrar to: (i) proceed with the hearing in the absence of that party, (ii) without proceeding with the hearing, give his decision or dismiss the proceedings, or (iii) make such other order as he thinks fit.

Where Form HC 1 is filed by only one party, the Registrar will, under ordinary circumstances, proceed with the hearing in the absence of the party who did not file Form HC 1.

If a party has not filed Form HC 1 but appears at the hearing desiring to be heard before the session formally begins, the Registrar will require the party to file Form HC 1 immediately or extract a solicitor's undertaking, where relevant, from the party's agent that Form HC 1 will be filed by the end of the next working day.

Form HC 1 filed but party does not appear: Registrar will usually ascertain party's intention

Rule 37(5) provides that the Registrar may proceed with the hearing in the absence of the party or may, without proceeding with the hearing, give his decision or dismiss the proceedings, or make such other order as he thinks fit, if a party does not appear after filing Form HC 1.

In practice, the Registrar will contact the absent party/parties as far as reasonably possible to ascertain his/their intention. Where a party has filed Form HC 1 but fails to turn up at the hearing, the Registrar will be slow to move the matter ahead with the other party who is present without hearing further from the absent party who has filed Form HC 1. Likewise where both parties do not attend the hearing, but Form HC 1 has already been filed by both parties, the Registrar will be slow to dismiss the proceedings without verifying their intention. If it is a party's intention to be heard but he cannot be present for legitimate reasons (e.g. medical reasons), the Registrar will, where reasonable, vacate the hearing and refix it for another day.

Form HC 1 not filed by both parties and both parties do not appear: Registrar will usually dismiss the proceedings

Rule 37(7) provides that the Registrar may dismiss the proceedings if neither party appears at the hearing. This would be sparingly exercised in practice, where parties do not demonstrate any interest in continuing the proceedings e.g. both parties are

unresponsive and do not inform the Registrar of their intent. If parties prefer a written decision without a hearing, D. below applies.

D. Where Parties Prefer a Written Decision Without a Hearing

Parties that prefer a written decision without a hearing may opt to do so, as the Registrar "may, without proceeding with the hearing, give his decision or dismiss the proceedings, or make such other order as he thinks fit" under Rule 37(4). In these circumstances, parties need not file Form HC 1, though they can still file written submissions and bundles of authorities for the Registrar's consideration.

This option is best raised and discussed at the PHR. Alternatively, parties may inform the Registrar of their preference for the same in writing any time after the PHR and before the date of the full hearing. However, if one party still wishes to proceed with a hearing, the hearing will continue as scheduled and the other party may choose whether or not to be heard at the hearing.

The date of the hearing shall be taken as the date on which the case was originally set down for hearing, unless otherwise decided at the PHR stage or in writing.

E. Restoration of Proceedings

Rule 37(10) provides that any proceedings that have been *dismissed* (as opposed to proceedings in which a *decision* is made) can be restored on the direction of the Registrar. Such application shall be made within 14 days after the Registrar's notification that the proceedings have been dismissed (Rule 37(11)).

F. Tendering of Additional or Supplementary Written Submissions and Bundle of Authorities on the Day of the Full Hearing

A party who wishes to tender additional or supplementary written submissions and bundle of authorities should, before the date of the full hearing, file and serve the same on the other party at least **2 weeks** prior to the date of the full hearing. This is to prevent the other party from being taken by surprise.

If the above is not complied with, the Registrar will exercise discretion whether to disregard these submissions, or whether to accept them and give the other party time to file reply submissions (e.g. if voluminous case authorities are cited in the additional or supplementary submissions). All written submissions and bundle of authorities will have to be filed, whether in hard copies through the Service Bureau or via IP²SG in addition to any hard copies as directed by the Registrar.

For avoidance of doubt, the 2-week requirement does not apply to basic rebuttal submissions. However, the Registrar still has the discretion to give the other party time beyond the hearing to file reply submissions if appropriate. Further, rebuttal submissions are to be similarly filed, whether in hard copies through the Service Bureau or via IP²SG, in addition to any hard copies provided to the Registrar at the hearing, as soon as possible after the hearing.