

Evidence in Trade Mark Revocations on the Ground of Non-use (HMD Circular No. 4/2017, dated 19 April 2017)

This circular is to guide users in relation to the filing of evidence in trade mark revocations on the ground of non-use¹. It supercedes HMD Circular 2/2011.

The sections referred to in this Circular are sections from the Trade Marks Act (Cap 332, 2005 Rev Ed). The rules referred to in this Circular are rules from the Trade Marks Rules (Cap 332, 2008 Rev Ed).

A. Proprietor's Evidence to be filed with Counter-Statement

Rule 58(3) requires a proprietor to file and serve evidence of use or evidence supporting proper reasons for non-use together with his counter-statement (Form HC6).

1 Content of statutory declaration to be filed with the counter-statement

1.1 Categories of Evidence

The statutory declaration filed together with the counter-statement should set out, in the alternative:

- (i) evidence of the use by the proprietor of the trade mark during the alleged period of non-use
- (ii) evidence supporting proper reasons for non-use during the alleged period of non-use
- (iii) evidence of commencement or resumption of use of the trade mark on a date which falls after the alleged period of non-use, and before the 3-month period immediately preceding the date of the application for revocation
- (iv) evidence of:
 - (A) commencement or resumption of use of the trade mark on a date which falls after the alleged period of non-use, and within the 3-month period immediately preceding the date of the application; and
 - (B) the fact that the proprietor was unaware that the application might be made when the preparations for the commencement or resumption of use of the trade mark began.

1.2 At the counter-statement stage, a proprietor is only required to show that he has an arguable case. His evidence does not need to comprise his entire defence. More detailed evidence, if any, can be filed later in the proceedings. The requirement in Rule 58(3) for a proprietor to file *prima facie* evidence of use upfront reflects the statutory

¹ Under Sections 22(1)(a) and 22(1)(b) of the Trade Marks Act

burden on the proprietor of a registered mark to show what use has been made of it, under Section 105.

1.3 As a matter of best practice, a proprietor's *prima facie* evidence of use should minimally comprise:

- (i) some material showing the mark in use e.g. catalogues, product labels, advertisements, mark as affixed on the goods in question
- (ii) some indication of sales e.g. invoices, purchase orders.

1.4 However, it is envisaged that a proprietor can generally save some time and costs by filing one set of evidence in the entire proceedings forming his whole defence, at the time he files his counter-statement. If this is the case, then the proprietor does not need to file any evidence after the close of pleadings unless he wishes to respond to the applicant's evidence.

2 Consequence of non-filing or non-service of evidence with the counter-statement²

An application for revocation on the ground of non-use shall be granted where no statutory declaration referred to in Rule 58(3) has been filed with the counter-statement or served on the applicant within the time allowed. This means that the proprietor's registered mark will be revoked.

B. Evidential Rounds After Pleadings

3 After the proprietor's counter-statement and accompanying evidence are filed, Rule 59(1A) makes provision for the evidential rounds³.

4 It is not mandatory for the applicant for revocation to file evidence⁴. This is because the burden is for the proprietor to show what use has been made of it. To expedite matters, if an applicant has decided not to file evidence well before its deadline to do so, he should inform the Registrar and the proprietor in writing so that the proprietor can decide sooner rather than later whether he, in turn, would file evidence.

5 It is also not mandatory for the proprietor to file evidence at this stage⁵. For example, the proprietor could have already filed evidence of use amounting to his entire defence together with his counter-statement and has no other evidence he wishes to file. To expedite matters, if a proprietor has decided not to file evidence well before its deadline to do so, he should inform the Registrar and the applicant in writing so that a Pre-Hearing Review may be convened sooner e.g. shortly after the proprietor's deadline to file evidence at this stage.

² Rule 58(10)

³ See new Rule 59(1A) with effect from 31 January 2017. Refer to the transitional and saving provisions of the Trade Marks (Amendment) Rules 2017 on the applicability of this new provision to your case.

⁴ Rule 59(1A)(c),(e)

⁵ Rule 59(1A)(f),(g)

6 If, however, the proprietor chooses to file evidence at this stage, the applicant can file evidence in reply⁶. Such evidence in reply must be confined to matters strictly in reply to the proprietor's statutory declaration that is additional to the evidence already provided in the statutory declaration filed with the counter-statement⁷.

7 In summary, in a revocation for non-use, the only mandatory evidence is the proprietor's evidence to be filed with his counter-statement.

⁶ Rule 59(1A)(g)(ii)

⁷ Rule 59(1A)(h)