

## **Service Requirements in Contentious Proceedings before the Registrar (HMG Circular No. 1/2017, dated 31 January 2017)**

This HMG Circular addresses the Registrar's practice in relation to service of documents. It supersedes HMG Circulars 4/2009, 5/2009 and 4/2011.

The sections referred to in this Circular are sections from the Trade Marks Act (Cap 332, 2005 Rev Ed) ("Act"). The rules referred to in this Circular are rules from the Trade Marks Rules (Cap 332, 2008 Rev Ed) ("Rules") or the Trade Marks (International Registration) Rules (Cap 332, 2002 Rev Ed) ("IR Rules")<sup>1</sup>. The principles apply to equivalent provisions and concepts in the Patents Rules (Cap 221, 2007 Rev Ed), Plant Varieties Protection Rules (Cap 232A, 2006 Rev Ed) and Registered Designs Rules (Cap 266, 2002 Rev Ed).

This Circular addresses the following:

- A. Address for Service
- B. Duty to Serve on Counter-Party
- C. Sufficiency of Service
- D. When Service is Effected
- E. Proof of Service
- F. Service of Documents Where There is Invalid or Unoccupied AFS
- G. Refusal to Accept Service
- H. Service of Form TM 48 Where There is no AFS (for International Registration Designating Singapore and Protected International Trade Mark (Singapore))

### **A. Address for Service ("AFS")**

1 Rule 9(1) of the Rules provides that for the purposes of any proceedings before the Registrar, an AFS in Singapore shall be filed accordingly. In particular, an AFS shall be filed by or on behalf of:

- (i) every applicant for the registration of a trade mark
- (ii) every opponent<sup>2</sup>
- (iii) every person applying to the Registrar under section 22 of the Act for the revocation of the registration of a trade mark, under section 23 of the Act for a declaration of invalidity of the registration of a trade mark, or under section 67 of the Act for the rectification of the register
- (iv) every person granted leave to intervene under rule 60
- (v) every proprietor of a registered trade mark which is the subject of an application to the Registrar for the revocation of the registration of the trade mark, for a declaration of invalidity of the registration, or for a rectification of the register
- (vi) every other party to any proceedings before the Registrar.

2 Further, under Rule 9(4)(o), the Registrar may treat the *trade or business address* in Singapore of a person as his address for service<sup>3</sup>.

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<sup>1</sup> After the Trade Marks (Amendment) Rules 2017 and Trade Marks (International Registration) (Amendment) Rules 2017 (collectively "Amendment Rules") take effect from 31 January 2017, certain provisions of the pre-amended legislation will only apply in certain situations. For more information, please refer to the relevant saving and transitional provisions of the Amendment Rules.

<sup>2</sup> There are opposition actions available for many types of proceedings. Please refer to Rule 9(1)(b) for more details.

<sup>3</sup> This is so unless a different address for service is provided under Rule 9(1) or (7) or Rule 44.

3 The consequences of a failure to provide an AFS are provided in Rule 9(6).<sup>4</sup> Where an AFS is not filed as required of:

- (i) an applicant for registration or for the revocation of the registration of the trade mark, the declaration of invalidity of the registration, or the rectification of the register (Rule 9(1)(a) and (c)), the application shall be treated as withdrawn
- (ii) an opponent (Rule 9(1)(b)) and every person granted leave to intervene under Rule 60, the person shall be treated as having withdrawn the opposition or intervention (as the case may be)
- (iii) a proprietor referred to in Rule 9(1)(e), the proprietor shall not be permitted to take part in any proceedings relating to the application for the revocation of the registration of the trade mark, the declaration of invalidity of the registration, or the rectification of the register, as the case may be
- (iv) every other party to any proceedings before the Registrar referred to in paragraph (1)(k), the party shall not be permitted to take part in the proceedings in question.

## **B. Duty to Serve on Counter-Party**

4 Where the Rules and IR Rules require filing and serving at the same time, the party who is seeking to file and serve the relevant document<sup>5</sup> (Filing Party) is to indicate clearly, on the cover letter enclosing the relevant document to the Registrar, that a copy of the relevant document has been served on the opposite party (Counter-Party). If e-filing, in the e-form, the Filing Party will have to check against the statement that a copy of the document will be served on the other party at the same time.

5 The Registrar will treat the failure to do so as no proper service of the relevant document and consequences of non-service will follow, unless the Filing Party proves otherwise (see **E.** below).

6 The consequence will depend on the type of document in question. In the example of non-service of Form TM 11, the notice of opposition shall be treated as not having been filed (Rule 29(2A)). The Filing Party will have to re-file the relevant form and re-serve the same on the Counter-Party if it is still possible to do so within the statutory deadline.

7 To ensure proper service, parties are reminded to check the Register to confirm the name of the Counter-Party, the name of the Counter-Party's agent (as appropriate) and the Counter-Party's latest address for service before filing and serving any documents. This is because the Register may have been updated due to records being filed in the interim e.g. assignments, changes in name, changes in AFS, changes in agents etc.

## **C. Sufficiency of Service**

8 For avoidance of doubt, the Registrar clarifies that the phrase "at the same time" will *not* be construed literally to mean that the document reaches the Registrar and the Counter-Party at the same moment in time.

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<sup>4</sup> Where an AFS is not filed as required, the Registrar may send to the person concerned notice to file an AFS within 2 months after the date of the notice, and if that person fails to do so, the consequences provided in Rule 9(6) will apply.

<sup>5</sup> These include forms and statutory declarations etc.

9 The Filing Party would have served the relevant document “at the same time” if he has taken the necessary action (for example, addressing, prepaying and posting a copy of the document to the Counter-Party’s AFS) as soon as practicably possible.

10 In terms of what is practicably possible, the Registrar envisages that service should take place (i.e. a copy of the filed document should be despatched) within the same day as filing, though if a document is e-filed after office hours, a copy of that document would be expected to be despatched to the Counter-Party the next working day.

11 The above practice will be adopted closely in relation to documents served or required to be served on or after 31 January 2017.

#### **D. When Service is Effected**

12 The time at which service is effected or deemed to have been effected (i.e. the date the Counter-Party receives the document), is important as it has a bearing on the calculation of the deadline to file the document which is due thereafter.

13 Generally, the Registrar will take the date that he receives the document as the default date from which to calculate the deadline to file the document which is due thereafter. For example, the deadline to file a counter-statement will be calculated from the date the Registrar receives the notice of opposition.

14 However, this default position is rebuttable and can be subject to proof. Thus, if the Counter-Party can show that, for example, he received the notice of opposition at a date later than the date indicated on the cover letter, this later date will be taken as the date for the calculation of the deadline for the counter-statement. In such a case, the Counter-Party should promptly inform the Registrar and the Filing Party in writing of the actual date of receipt of the relevant document so that the deadline for the counter-statement due can be correctly calculated.

15 Specifically in relation to service via post, Rule 7(4) provides as follows:

Where any notice or other document is sent by post under paragraph (2) or (3), the giving, sending or service, as the case may be, of the notice or other document shall, until the contrary is proved, be treated as having been effected at the time at which the notice or document would have been delivered in the ordinary course of post.

Therefore, if the modality of service is ordinary post and the Counter-Party cannot pinpoint a specific date of receipt, to calculate the deadline for the next document, the Registrar can be guided by SingPost’s service standards at <http://www.singpost.com/send-receive/send-withinsingapore> (where there is an AFS or trade address or business address in Singapore) and at <http://www.singpost.com/send-receive/send-overseas> (for overseas addresses e.g. International Registration holder with no AFS being served Form TM48) as updated from time to time.

16 The above practice will be adopted closely in relation to documents served or required to be served on or after 31 January 2017.

## **E. Proof of Service**

### 17 Modalities of Proof

17.1 If the Counter-Party claims that he did not receive the relevant document, the Filing Party is required to show proof of service.

17.2 To show proof of service, the following modalities will be acceptable:

- (i) a courier receipt or invoice
- (ii) if by normal post, a Statutory Declaration that the relevant document has been posted, with relevant details
- (iii) if the attempted service is in person, a Statutory Declaration with relevant details.

### 18 Consequences

18.1 If the Registrar is persuaded that the Filing Party despatched a copy of the document as soon as practicably possible, the Filing Party may be directed to re-serve the document on the Counter-Party at the AFS. Alternatively, if there is evidence that the document reached the Counter-Party's AFS (e.g. as demonstrated by a courier receipt, or by a signed acknowledgement if delivery is by hand), and if the deadline for the Counter-Party to file the subsequent document has expired, the Registrar may simply allow the consequences of not filing the latter to apply. In either case, what is required of the Filing Party is that he must prove that his document had been *originally* served within the deadline. As to what constitutes sufficient service, please see above at **C**.

18.2 For the avoidance of doubt, if the Registrar directs the Filing Party to re-serve the document, the deadline for the Counter-Party to file his subsequent document will be X months from the date of receipt of the relevant document that was *re-served* (see **D**.) on the Counter-Party. For example, if the subsequent document is the counter-statement, the Counter-Party will have 2 months from the date of receipt of Form TM 11 to file his counter-statement.

## **F. Service of Documents Where There is an Invalid or Unoccupied AFS**

19 This scenario occurs where, for example, a party has moved out of its premises and thus the AFS is no longer valid or occupied. The Counter-Party would not have received a copy of the document the Filing Party served at the invalid or unoccupied AFS. In such a situation, the Filing Party should inform the Registrar in writing with proof of service (see **E**. above) and where appropriate, the Registrar will confirm that the Filing Party has discharged his duty to serve the document.

## **G. Refusal to Accept Service**

20 Rule 9(8) provides:

Anything sent to or served on a person at his address for service shall be taken to have been duly sent to or served on the person.

Therefore, even if an occupant at the AFS refuses to accept service, the Filing Party may provide proof of attempted service to demonstrate that he has discharged his duty to serve the document. As to the acceptable modalities of proof of service, see **E**. above.

**H. Service of Form TM 48 or Form TM 28 Where There is No AFS (for International Registration Designating Singapore and Protected International Trade Mark (Singapore))**

21 The Filing Party should, when filing the relevant form with the Registrar, send a copy of the form to the Counter-Party's overseas address indicated on the Register, where there is no AFS on record. If the Counter-Party alleges that he did not receive the form from the Filing Party, the latter is required to show proof of service (see **E.** above).

22 There is no obligation to check whether the Counter-Party may have a trade or business address in Singapore to be treated as the AFS in accordance with Rule 9(4)(o). However, it would be a good practice because this will save costs as there is no need to send the document overseas.