

## **Deadlines to File Evidence and Extensions of Time to File Evidence in Opposition Proceedings (HMG Circular No. 2/2017 dated 31 January 2017)**

This circular is issued to guide users in relation to certain amendments under the Trade Marks (Amendment) Rules 2017 which take effect from 31 January 2017. References in this circular to the rules are references to the amended Trade Marks Rules (Cap 332, 2008 Rev Ed), unless otherwise specified.

### **A. Deadlines to File Evidence**

#### **1 Registrar to Specify Deadlines**

1.1 Under Rules 31A(1) and 59(1A), the Registrar will specify the applicable deadlines, minimally 2 months, for parties to file evidence. This is a change from the previous position governed by (now repealed) Rules 32 to 34 and by (pre-amended) Rule 59(1A) where the deadlines to file evidence are entrenched in legislation. This change will allow the Registrar to specify deadlines according to the circumstances of each case while streamlining the process to improve user-friendliness and user-compliance.

1.2 Before specifying the evidential deadlines, the Registrar will hear parties on the state of play between them and the proposed time periods for filing evidence. This can be done through written or oral representations by parties. Written representations are typically made through a form, the Notification to Registrar, which is sent to parties, after the close of pleadings, for their completion. Oral representations are typically made at case management conferences, which the Registrar convenes if there are issues that are better addressed verbally with parties. Case management conferences may be in-person or take the form of teleconferences.

#### **2 Factors Considered by Registrar**

2.1 The factors considered by the Registrar, when deciding on the duration of the deadlines, include those set out in the non-exhaustive list below:

- (i) Whether parties are negotiating
- (ii) If parties are negotiating, the nature of their negotiations e.g. whether multijurisdictional or only in Singapore
- (iii) If parties are negotiating, the stage of their negotiations e.g. whether preliminary or advanced stage
- (iv) Whether there are pending proceedings in court which have a bearing on the outcome of the case before the Registrar
- (v) The nationality of the parties, in particular, whether Singaporean or foreign

2.2 The above factors, among others, can assist the Registrar in ascertaining the appropriate deadlines for parties to file evidence. Generally, standard deadlines are issued if parties are not negotiating. Non-standard deadlines are issued if parties are negotiating or if there are pending proceedings in court which have a bearing on the outcome of the case before the Registrar.

2.3 This table sets out the typical range of standard and non-standard deadlines the Registrar may specify:

	<b>Standard Deadlines</b>	<b>Non-standard Deadlines</b>
<b>Evidence of initiating party</b>	2 to 5 months from issuance of deadlines by Registrar	Up to 9 months from issuance of deadlines by Registrar
<b>Evidence of responding party</b>	2 to 4 months from evidence of initiating party	Up to 6 months from evidence of initiating party
<b>Evidence in reply of initiating party</b>	2 months from evidence of responding party	Up to 3 months from evidence of responding party

2.4 The above serves as a guide from which the Registrar is free to depart. Under Rules 31A(1) and 59(1A), the Registrar, having heard the parties, has the discretion to direct and specify the statutory time periods as appropriate, depending on the facts of the case.

### 3 Registrar May Extend Subsequent Deadlines

3.1 Rules 31A(4), (5) and 59(1A)(d) and (e)(ii) envisage, and Rules 32(7)(a) and 33(7)(a) provide, that further on in the proceedings, the Registrar may also adjust the specified deadlines by extending them, if this is appropriate under the circumstances. If this is the case, the extended deadlines, rather than the originally specified deadlines would apply to parties.

3.2 For example, an opponent may seek an extension of time to file evidence in support of his opposition because parties have decided to negotiate. While extending the opponent's deadline, the Registrar may also extend the applicant's deadline to file evidence under Rule 32(7)(a).

## **B. Seeking Extensions of Time**

### 4 Requirements

4.1 Rules 32 to 34 set out the new requirements and process involved in seeking extensions of time to file evidence.

4.2 The process is now more streamlined in that the party seeking an extension of time only needs to serve a copy of the request (Form HC3) on the counter-party at the time the request is filed with the Registrar. There is now no need to seek the counter-party's consent before filing Form HC3.

4.3 There is a mandatory field in Form HC3 for the party seeking an extension of time to declare that a copy of the form will be served on the counter-party.

4.4 The failure to serve a copy of Form HC3 on the counter-party opens the requesting party to an application by the counter-party to revoke any extension of time granted (para 7 below). The onus is on the requesting party to ensure that this simple requirement is complied with. He should be prepared to prove service (refer to HMG Circular 1/2017 on Service Requirements in Contentious Proceedings before the Registrar) if required.

4.5 In addition, a party seeking an extension must also:

- (i) State the period of extension requested (mandatory field in Form HC3)
- (ii) State the reason (mandatory field in Form HC3)
- (iii) State the name and address of every person likely to be affected by the extension, if there is such a person (other than the counter-party) e.g. licensees.

4.6 Parties should especially note that the purported reason “Need more time to collate/file evidence” is tautologous to the concept of requesting more time to file evidence (akin to “I need more time because I need more time”) and is not a “good and sufficient reason” under Rules 32(5)(a), 33(5)(a) and 34(5)(a). A “good and sufficient reason” particularises why the evidence could not be filed by the deadline and justifies why an extension of time is in order (para 6 below).

## 5 Objection or Consent of Counter-Party

5.1 The counter-party may object to the extension of time not later than 2 weeks after the receipt of a copy of Form HC3. The Registrar will take this into account when deciding whether to grant the extension of time, and if so, for how long, without having to conduct a hearing.

5.2 The rules do not require the party seeking an extension to obtain the consent of the counter-party. However, if this is forthcoming, he may nonetheless submit the counterparty’s consent in writing in support of his application for an extension of time. This could expedite the grant of an extension of time.

## 6 Factors Considered by Registrar

6.1 The Registrar will generally be slow to grant extensions of time as the circumstances of the case would have been taken into account at the outset when the original deadlines to file evidence were specified.

6.2 In practice, a party seeking an extension of time to file evidence will have to demonstrate how circumstances have changed since the time the original deadlines were specified.

6.3 The Registrar may consider the following non-exhaustive list of reasons favourably in granting extensions of time:

- (i) Parties are awaiting the outcome of relevant court proceedings that has a material bearing on a possible settlement agreement or on how the parties wish to proceed, and this has taken longer than expected at the outset
- (ii) Significant progress has been made in negotiations but parties still require a specific period of additional time to complete the negotiations
- (iii) One party has had a change of agent shortly before the deadline for him to file his evidence
- (iv) A circumstance has arisen that is beyond a party’s control, provided that the party has acted promptly and diligently at all times; for example, corporate changes such as merger and bankruptcy; illness, resignation or change in portfolio of a party’s decision-maker causing a delay in settlement negotiations; civil war; declaration of state of emergency.

6.4 If the Registrar accepts a particular reason for an extension of time, it will generally be an uphill task for the party to rely on the same reason successfully for a further request for extension of time in that specific evidential stage. Parties will need to provide solid justification why the same reason is still “good and sufficient”.

## 7 Application for Revocation of Extension of Time

7.1 If the party seeking an extension of time did not serve a copy of Form HC3 on the counter-party, the counter-party can, not later than 2 weeks after receiving the Registrar's notification of the extension, apply in writing to revoke the extension on the ground that Form HC3 was not served on him.

7.2 The Registrar will give directions on the subsequent procedure. He will give the parties an opportunity to be heard, whether in writing only, or both in writing and in person at an interlocutory hearing.

7.3 If the requesting party cannot prove that he has served a copy of Form HC3 on the counter-party (refer to HMG Circular 1/2017 on Service Requirements in Contentious Proceedings before the Registrar), and if there are no extenuating factors to explain why this was not done, the Registrar will generally allow an application for revocation of the extension of time.