

**IN THE HEARINGS AND MEDIATION GROUP OF  
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE  
REPUBLIC OF SINGAPORE**

Trade Mark Application Nos. T1300669D  
7 July 2016

**APPLICATION TO CURE IRREGULARITY IN EVIDENCE FILED  
IN A TRADE MARK OPPOSITION  
BY THE FACESHOP CO., LTD**

**AND**

**OBJECTION THERETO  
BY CONSOLIDATED ARTISTS B.V.**

Principal Assistant Registrar Sandy Widjaja  
Decision date: 6 September 2016

*Interlocutory hearing – application to cure irregularity in evidence filed by the Applicants – irregularities pertaining to notarization requirements pursuant to Rule 69(1A) of the Trade Marks Rules read with Order 41 of the Rules of Court – failure to ensure identity of content of subsequent evidence - objection by Respondents – whether such an irregularity can be cured under Rule 83 of the Trade Marks Rules*

***Relevant Facts***

1. The Opponents (“Consolidated Artists B.V.”) filed a Notice of Opposition on 23 April 2014 against T1300669D as follows:

MANGO  
SEED  
**THEFACESHOP** for the following goods in Class 3:

*Cosmetics; skin lotions (cosmetics); moisturizing skin lotions; non-medicated skin astringents for cosmetic purposes; facial creams (cosmetic); facial moisturizers (cosmetic); facial preparations (cosmetic); cleansing emulsions; soap free washing emulsions for the body; after shave lotions; skin conditioners; blusher; perfumes; colognes; skin cleansing creams; make-up foundation in the form of powder; concealers; lipsticks; toilet water; eye shadow; eyebrow pencils; eye liners; nail polish; nail polish remover; beauty mask; sunblock skin creams (cosmetics); hair shampoo; hair rinse; hair spray; toilet soaps; bath soaps; body cleansers; fragrance mist for personal use; tonic mist for personal use (cosmetics); body gel; bath gel; body cream scrub; shampoos, soap; toothpaste.*

(“Application Mark”). The Applicants (“The Faceshop Co., Ltd”) filed their Counter-Statement on 22 August 2014. The Opponents filed the Opponents’ first evidence (Opponents’ 1st Evidence) on 13 April 2015. The Applicants filed their evidence on 13 October 2015 (Applicants’ 1<sup>st</sup> Evidence).

2. On 29 October 2015 the Opponents wrote to the Registry to deem the Applicants’ 1<sup>st</sup> Evidence invalid and inadmissible on the basis that it was not signed by the signatory before a notary public such that it was not executed in accordance with section 12(2) of the Oaths and Declaration Act (Cap 211, 2001 Rev Ed) (“ODA”). In addition, the Opponents submitted that further, the exhibits do not appear to have been duly notarized by the Notary Public. On 13 November 2015 the Applicants wrote to the Registry to state that the Applicants’ 1<sup>st</sup> Evidence has been validly executed in accordance with Korean Law and in support they submitted the evidence of Sung Woo Lee dated 13 November 2015.
3. On 18 November 2015 the Registry directed the Applicants to re-execute and re-file the Applicants’ 1<sup>st</sup> Evidence to comply with Rule 69(1A) of the Trade Marks Rules (Cap 332, 2008 Rev. Ed) (“TMR”). This is due to Rule 69 (1A) rendering Order 41 rule 1(7) and Order 41 rule 11(2) of the Rules of Court (“ROC”) applicable (with the necessary modifications). The Registry also directed that the deadline for the Opponents to file their evidence in reply (Opponents’ Evidence in Reply) remained unchanged on 22 January 2016 since the rectification of the Applicants’ 1<sup>st</sup> Evidence would not affect the substantive contents of the same.
4. The Applicants then re-filed the Applicants’ evidence (Applicants’ 2<sup>nd</sup> Evidence) on 15 January 2016. The Applicants clarified that as Mr Jeong Tae Bae (the Chief Executive Officer (“CEO”) of the Applicants) was not available to re-execute the Applicants’ 2<sup>nd</sup> Evidence, the evidence was executed by one Mr Junsik Han (the General Counsel of the Applicants). The Applicants stated in their letter that other than this, there are no other changes to the contents of the evidence (that is, Applicants’ 2<sup>nd</sup> Evidence) from the one filed on 13 October 2015 (that is, Applicants’ 1<sup>st</sup> Evidence). The Opponents duly filed the Opponents’ Evidence in Reply on 19 January 2016.
5. On 1 February 2016, the Registry wrote to the parties to highlight that a comparison between the Applicants’ 1<sup>st</sup> Evidence and the Applicants’ 2<sup>nd</sup> Evidence shows that there is a difference in the number of pages in a few exhibits. However, in the interest of managing the case economically and expeditiously, the Registry indicated that the Registry was prepared to accept the Applicants’ 2<sup>nd</sup> Evidence and informed that the Opponents are to write in to confirm if they have any objections to the same within 2 weeks from the date of the letter.
6. On 11 February 2016, the Opponents wrote in to inform of their “strong objections and grave concerns” in relation to the matter and submitted that the Applicants’ 2<sup>nd</sup> Evidence should be ruled inadmissible entirely since the Applicants have disregarded the Registrar’s directions to only make technical rectifications without modifications to the contents of the evidence and have also been deceptive by falsely affirming that other than a change in the deponents, there are no other changes to the contents of the evidence (see above). The Opponents also asked for a full award of costs against the Applicants. On 15 February 2016, the Applicants wrote in to request that the Registrar maintain the position as per the letter of 1 February 2016. The Applicants explained that there was no

intention to deceive or disregard the Registrar's directions but that the discrepancy was due to haste. On 18 February 2016, the Opponents wrote in to reiterate that the Applicants' 2<sup>nd</sup> Evidence should be ruled inadmissible and that the Application Mark should be accordingly deemed withdrawn. They also submitted extensive arguments on the facts as well as case law.

7. On 19 February 2016, the Registrar wrote to the parties informing that taking into account both parties' submissions, the mark is not deemed withdrawn as the irregularity (in relation to the Applicants' 1<sup>st</sup> Evidence) is one which can be cured. The Registrar noted that even in Court proceedings which are more formal, there is flexibility with regard to the use of irregular affidavits in evidence (as to form) under Order 41 rule 4. As such, the Registrar directed the Applicants to re-execute and re-file the evidence. The Applicants were reminded to maintain the same content except for the deponent (if different from the original deponent, Mr Jeong Tae Bae) and that the Applicants should also confirm that notwithstanding the requirement in Korea that only the CEO can make the declaration, the evidence by the eventual deponent, for example Mr Junsik Han, would still be in order. On 23 February 2016, the Opponents submitted that the decision was erroneous, reiterated all their arguments and applications previously made, and reserved the right to challenge the evidence at a later stage.
8. On 1 April 2016, the Applicants re-filed their evidence (Applicants' 3<sup>rd</sup> Evidence). They confirmed that the evidence signed by Mr Junsik Han is considered valid under Korean law.
9. On 6 April 2016, the Opponents wrote in again highlighting that there were differences between the Applicants' 3<sup>rd</sup> Evidence and the Applicants' 1<sup>st</sup> Evidence and asked that the Applicants' 3<sup>rd</sup> Evidence be ruled inadmissible entirely and the Application Mark be deemed withdrawn. The Opponents also requested for a full award of costs against the Applicants. On 7 April 2016, the Applicants wrote to explain the discrepancies, in particular, that the discrepancies are not as extensive as the Opponents made them out to be. On 12 April 2016, the Opponents wrote to the Registrar and attached a CD-ROM which contains a side-by-side comparison of the two documents. On 15 April 2016, the Applicants responded to the Applicants' letter above and made further clarifications. On 18 April 2016, the Opponents reiterated that the Applicants' 3<sup>rd</sup> Evidence was not identical to the Applicants' 1<sup>st</sup> Evidence and asked for an award of costs against the Applicants.
10. On 21 April 2016, the Registrar wrote to inform parties that the Registrar was inclined to accept the Applicants' 3<sup>rd</sup> Evidence but also inclined to award costs to the Opponents for reviewing the Applicants' three versions of their evidence. Further, the Registrar indicated that the Opponents may also wish to file a supplementary evidence to clarify that the Opponents' Evidence in Reply also addressed the Applicants' 3<sup>rd</sup> Evidence and if so, the Registrar is also inclined to award costs for this as well.
11. On 27 April 2016, the Opponents wrote that the conclusions reached are flawed and prejudiced the Opponents to a point which cannot be compensated by an award of costs. The Opponents reiterated their request that the Applicants' 3<sup>rd</sup> Evidence be ruled inadmissible and that the Application Mark be deemed withdrawn and asked for an award of costs against the Applicants. The Opponents submitted that should the Registrar rule that the Applicants' 3<sup>rd</sup> Evidence be admissible, the Opponents request for

the issuance of the grounds of decision. Further, without prejudice to the Opponents' position that the Applicants' evidence is inadmissible, the Opponents submitted that the Applicants' 1<sup>st</sup> Evidence should be the relevant evidence for the purposes of the Opponents' Evidence in Reply and the oral hearing.

12. On 11 May 2016, the Applicants informed that they have no objections to an award of costs as well as the filing of a supplementary evidence by the Opponents as proposed by the Registrar (as well as the award of costs in relation to the same). Further, the Applicants argued that if the Applicants' 3<sup>rd</sup> Evidence is accepted by the Registry, then it should be the relevant evidence for the case. On 12 May 2016, the Opponents maintained that the Application Mark must be deemed withdrawn and reiterated their stance that the Applicants' 1<sup>st</sup> Evidence should be the relevant evidence for the purposes of this case.
13. On 18 May 2016, the Registrar informed that the Registrar will issue a written decision for record. The Registrar clarified that this is an interlocutory matter since it is a procedural issue. The Registrar gave parties the option to file further written submissions and authorities and attend an interlocutory hearing. Further the Registrar set out the issues as follows:
  - A. Whether the irregularity in the Applicants' 1<sup>st</sup> Evidence may potentially be cured such that the Application Mark is not deemed withdrawn;
  - B. If yes to (A), whether the Applicants' 2<sup>nd</sup> Evidence and the Applicants' 3<sup>rd</sup> Evidence, not being identical in content to the Applicants' 1<sup>st</sup> Evidence, contrary to the Registrar's directions, change the issue under (A); and
  - C. If no to (B), then what should be the directions moving ahead so as to regularize the irregularity and costs orders, if any.
14. On 1 June 2016, the Applicants wrote that the Registrar has already decided on the first two issues and the only issue left was (C). On 1 June 2016, the Opponents wrote that they would like the Registrar to review the submissions made to date and the evidence before the Registrar and without a hearing make a decision accordingly.
15. On 6 June 2016, the Registrar clarified to the parties that the letter of 19 February 2016 which indicated that the Application Mark was not deemed withdrawn has been overtaken by events. Further, the Registrar's letter of 21 February 2016 as a means to move parties towards a substantive hearing on the merits of the Opposition was couched as an inclination (to accept the Applicants' 3<sup>rd</sup> Evidence) and not a determination. On 10 June 2016, the Applicants informed the Registrar that they would like to file written submissions and legal authorities and that since the Opponents have only requested the Registrar issue a written decision based on written submissions and authorities, without a hearing in person, the Applicants similarly requested for the same. On 17 June 2016, the Registrar directed the Applicants to file their written submissions and bundle of authorities by 1 July 2016. On 7 July 2016, the Opponents wrote that the indisputable fact is that the irregularity of the Applicants' evidence was never properly remedied.

#### ***Relevant Issues to be considered***

16. The relevant issues to be considered have been set out in the letter of the Registrar dated 18 May 2016 as follows:

- A. Whether the irregularity in the Applicants' 1<sup>st</sup> Evidence may potentially be cured such that the Application Mark is not deemed withdrawn;
- B. If yes to (A), whether the Applicants' 2<sup>nd</sup> Evidence and the Applicants' 3<sup>rd</sup> Evidence, not being identical in content to the Applicants' 1<sup>st</sup> Evidence, contrary to the Registrar's directions, change the issue under (A); and
- C. If no to (B), then what should be the directions moving ahead so as to regularize the irregularity and costs orders, if any.

The Registrar has indicated at paragraph 5 of the said letter that parties may wish to add or modify the issues. Since the parties have not indicated as such, the above issues will be deemed to be the pertinent issues to be considered for the purposes of this interlocutory decision.

**Held, allowing the irregularity in relation to the evidence filed by the Applicants to be cured**

*(A) Whether the irregularity in the Applicants' 1<sup>st</sup> Evidence may potentially be cured such that the Application Mark is not deemed withdrawn*

1. The main irregularity is in non-compliance of Rule 69 of the TMR. In particular, Rule 69(1A) provides that subject to the provisions of the ODA and the TMR, Order 41 of the ROC shall apply in relation to a statutory declaration filed or used in any proceedings before the Registrar subject to any necessary modifications, as it applies to an affidavit filed or used in any proceedings before the Court.
2. In particular, Order 41 rule 1(7) provides that every affidavit must be signed by the deponent and the attestation must be completed and signed by the person before whom it is sworn. Further, Order 41 rule 11(2) also provides that any exhibit to an affidavit must be identified by a certificate of the person before whom the affidavit is sworn.
3. In relation to irregularities before the Registrar, the main provision is Rule 83 of the TMR which provides that any irregularity in procedure which in the opinion of the Registrar is not detrimental to the interests of any person or party may be corrected on such terms as the Registrar may direct. It is clear from this provision that there may be some procedural irregularities which may potentially be rectified. This is also the practice in the Courts. In particular, Order 41 rule 4 provides that any affidavit may, with leave of the Court, be filed or used in evidence notwithstanding any irregularity in the *form* thereof. Whether the specific procedural irregularity is one which can be so rectified will very much depend on the factual circumstances of each case.
4. The Applicants' 1<sup>st</sup> Evidence was filed with the following irregularities in relation to form:
  - (i) The Applicants' 1<sup>st</sup> Evidence was signed by the deponent (one Mr Jeong Tae Bae, the CEO of the Applicants), but the attestation was not completed and signed by the person before whom it was sworn.
  - (ii) The exhibits to the Applicants' 1<sup>st</sup> Evidence were not identified by a certificate of the person before whom the affidavit is sworn.

5. As discussed above, Order 41 rule 4 provides that certain types of irregularity as to form in relation to an affidavit may be allowed. This is also reflected in Rule 83 which provides that any irregularity in procedure which in the opinion of the Registrar is not detrimental to the interests of any person or party, may be corrected on such terms as the Registrar may direct.
6. The Registrar via the letter of 18 November 2015 opined that this is such a case, which is why the Registrar directed that the Applicants re-execute their evidence. Further, since it was envisaged that there would be no changes to the content of the Applicants' re-executed evidence (Applicants' 2<sup>nd</sup> Evidence), the Registrar directed that the Opponents' deadline to file the Opponents' Evidence in Reply remain unchanged.
7. It is noted that the Opponents accepted the above direction of the Registrar. The Opponents duly filed the Opponents' Evidence in Reply on 19 January 2016.
8. The Applicants re-filed their evidence on 15 January 2016 (Applicants' 2<sup>nd</sup> Evidence). In the Applicants' letter, the Applicants clarified that as the original deponent, Mr Jeong Tae Bae, was not available to re-execute the evidence, the Applicants' 2<sup>nd</sup> Evidence has been executed by one Mr Junsik Han (the General Counsel of the Applicants). At this juncture, it is noted that the Applicants' 2<sup>nd</sup> Evidence was duly notarized in accordance with Rule 69(1A) read with Order 41 rule 1(7) and Order 41 rule 11(2) such that the original procedural irregularity has been *cured*.
9. The only potential issue is that the deponent, Mr Junsik Han, is the General Counsel of the Applicants, and not the CEO of the Applicants. In this regard, the Applicants have originally provided that one of the difficulties which they experienced which resulted in the deficient Applicants' 2<sup>nd</sup> Evidence was that they were advised that in Korea where the document is in the name of the company, it has to be signed by the CEO before it can be notarized (see Applicants' letter of 15 February 2016). However, the Applicants have subsequently confirmed, via their letter of 1 April 2016, that the evidence signed by Mr Han is considered valid under Korean law.
10. Thus in answer to the first issue above, the irregularity is one which can be cured and it has *in fact been cured* via the re-filing of the Applicants' 2<sup>nd</sup> Evidence such that the Application Mark is not deemed withdrawn

*(B) If the irregularity in the Applicants' 1<sup>st</sup> Evidence may potentially be cured such that the Application Mark is not deemed withdrawn, whether the Applicants' 2<sup>nd</sup> Evidence and the Applicants' 3<sup>rd</sup> Evidence, not being identical in content to the Applicants' 1<sup>st</sup> Evidence, contrary to the Registrar's directions, change the said issue*

11. The start of the Opponents' contention arose after the Registrar's letter of 1 February 2016 where the Registrar informed parties there would appear to be some discrepancies in terms of the number of pages of a few exhibits between the Applicants' 1<sup>st</sup> Evidence and the Applicants' 2<sup>nd</sup> Evidence. However, in the interest of managing the case economically and expeditiously, the Registrar indicated that she was inclined to accept the Applicants' 2<sup>nd</sup> Evidence provided that the Opponents have no objections.

12. Following the above, the Opponents wrote in on 11 February 2016 registering their “strong objections and grave concerns”. The Opponents submitted, in effect, that there was bad faith as the Applicants:

- (i) made a false statement in relation to the Applicants’ 2<sup>nd</sup> Evidence that there was no change to the content from that of the Applicants’ 1<sup>st</sup> Evidence, except for the change in deponents (Applicants’ letter of 15 January 2016); and
- (ii) disregarded the Registrar’s order that there is to be *no* change to the contents of the evidence from the Applicants’ 1<sup>st</sup> Evidence (Registrar’s letter of 18 November 2015).

13. Thus, in light of the above, it is observed that the Opponents’ angst (and understandably so) is not so much in relation to the procedural non-compliance as to form of the evidence (as described above) but rather, to the fact of non-compliance with the Registrar’s directions that there is to be *no* change to the contents of the evidence from the Applicants’ 1<sup>st</sup> Evidence.

14. In support of their case, the Opponents referred to several interlocutory cases before the Registrar via their letter of 18 February 2016. The cases are as follows:

- (i) ***Distilleerderij En Liburstokerij Herman Jansen B V v Tilaknagar Industries Ltd*** [2013] SGIPOS 3 (“*Tilaknagar*”);
- (ii) ***Jelco Properties Pte Ltd v V Hotel Pte Ltd*** [2014] SGIPOS 1 (“*Jelco*”);
- (iii) ***The Polo / Lauren Company, L.P. v BRG Brilliant Rubber Goods (M) Sdn Bhd*** [2014] SGIPOS 4 (“*Polo*”).

15. In this regard, it is noted that the Opponents sought to apply interlocutory decisions of the Registrar to shed light as to the applicability of Rule 83 to the current case. However, Rule 83 is of a wide application. It is noted that thus far, there are no interlocutory decisions which relate to the specific situation at hand. The point is, in light of the above, caution must be exercised in seeking to apply the case law thus far to the current scenario.

16. Both *Tilaknagar* and *Jelco* pertain to non-filing of evidence while *Polo* relates to non-service of the counter-statement. The following points are noted in relation to the cases:

- (i) In *Tilaknagar*, there was a complete non-compliance with Rule 33(3) of the TMR. In fact, the Registrar had already notified the parties that the Application Marks were deemed withdrawn under Rule 33(3). The Applicants only wrote to the Registrar requesting for an extension of time to file their evidence, 67 days *after* the statutory deadline and 11 days *after* the Registrar’s notification.
- (ii) Similarly, in *Jelco*, which relates to Rule 33(3) as well, the Applicants only requested for the extension of time 19 days *after* the statutory deadline and 4 days *after* the Registrar’s notification that the Application Mark was deemed withdrawn.
- (iii) Finally in *Polo*, which pertains to Rule 31(3) of the TMR (amongst others), the Applicants only requested for an extension of time 23 days *after* the statutory deadline and 7 days *after* the Registrar’s notification.

In light of the factual matrix, it is understandable why the Registrar required “exceptional circumstances” before exercising the discretion under Rule 83 of the TMR in these cases (see, for example, xiii of *Jelco* ).

17. The Applicants submitted, at paragraph 13 of their written submissions, that the discrepancies were entirely due to inadvertent clerical errors and that there is no bad faith or dishonest conduct on their part such that there was no intention on the Applicants’ part to disregard the Registrar’s directions.
18. The Applicants submitted at paragraph 14 of their written submissions, that the discrepancies are largely confined to the exhibits and that the Applicants’ 2<sup>nd</sup> Evidence is not an effectively new evidence as alleged in the Opponents’ letter of 18 February 2016. Further, the Applicants argued that the Applicants’ 3<sup>rd</sup> Evidence has largely rectified the discrepancies.
19. In relation to the discrepancies between the Applicants’ 1<sup>st</sup> Evidence and the Applicants’ 3<sup>rd</sup> Evidence, there were pages which were removed / added to the Applicants’ 3<sup>rd</sup> Evidence in comparison to the Applicants’ 1<sup>st</sup> Evidence as follows (see also paragraph 14 of the Applicants’ written submissions):
  - (i) Typographical error in paragraph 24;
  - (ii) Exhibit 5: A total of six pages were inadvertently added / excluded;
  - (iii) Exhibit 6: A total of seven pages were inadvertently added / excluded;
20. The details of the discrepancies are as follows:
  - (i) Applicants explained that the typographical error was due to the fact that the Applicants have used the text of the Applicants’ 2<sup>nd</sup> Evidence rather than the Applicants’ 1<sup>st</sup> Evidence (see the Applicants’ letter of 7 April 2016). In essence, paragraph 24 pertains to examples of the Applicants’ skin care lines to illustrate the fact that the Application Mark is one of the many skin care lines of the Applicants. In that regard, the Applicants submitted that the effect of the errors does not change the meaning and purpose of paragraph 24 (paragraph 16 of the Applicants’ submissions).
  - (ii) In relation to Exhibits 5 and 6, the Applicants submitted at paragraph 16 of their submissions that Exhibit 5 contains copies of registration certificates for “THE FACESHOP” mark around the world while Exhibit 6 pertains to promotional literature showing use of “THE FACESHOP” mark in various jurisdictions.
  - (iii) In relation to the various scanning errors, the Applicants submitted at paragraph 15 of their submissions that in this case, the Applicants’ Exhibits 5 and 6 alone total over 300 pages while the Applicants’ 3<sup>rd</sup> Evidence totals over 800 pages. The Applicants submitted that due to the size of the document, it had to be taken apart for scanning in numerous instalments of 10 pages each which resulted in scanning errors.
21. The Applicants submitted (at paragraph 15 of their written submissions) that while the clerical error which resulted in the difference in the text of paragraph 24 and the scanning errors which resulted to the mistaken inclusion / exclusion of pages are regrettable, the

Applicants submitted that such mistakes are understandable but not gross and reasonably arise having regard to the fact that numerous drafts have been produced, and a large number of pages needed to be copied, scanned, sorted and compiled into a single document.

22. Further, the Applicants submitted, at paragraph 17 of the Applicants' written submissions that the errors as enumerated above in the Applicants' 3<sup>rd</sup> Evidence do not substantially affect, in particular, the Opponents' Evidence in Reply. In this regard, the Applicants referred to the Registrar's letter of 21 April 2016 where the Registrar opined, at paragraph 3 of the same, that it would appear that the points and rebuttals made in the Opponents' Evidence in Reply can similarly apply to the Applicants' 3<sup>rd</sup> Evidence (subject to the need for a supplementary statutory declaration to clarify that the Opponents' Evidence in Reply is applicable to the Applicants' 3<sup>rd</sup> Evidence rather than the Applicants' 1<sup>st</sup> Evidence).
23. I have taken a look at the Opponents' Evidence in Reply and I agree. In short, while the content of the different versions of the Applicants' evidence is not identical, the main thrust of the Applicants' evidence has remained largely intact such that it is not "new evidence" as submitted by the Opponents (Opponents' letter of 18 February 2016).
24. Further, the Applicants also pointed out that the Opponents have not been clear as to how they have been prejudiced except that they had to expend substantial time and ultimately, costs, in bringing the discrepancies to light (paragraph 18 of the Applicants' written submissions). In this regard, reference is made to the following correspondences of the Opponents:
  - (i) Opponents' letter of 11 February 2016;
  - (ii) Opponents' letter of 12 April 2016;
  - (iii) Opponents' letter of 18 April 2016;
  - (iv) Opponents' letter of 27 April 2016; and
  - (v) Opponents' letter of 12 May 2016.
25. Further, the Applicants referred to *Tilaknagar* (at [11]) and submitted that "prejudice" has been described as some form of irreversible or permanent change in position or something which cannot be compensated by an appropriate order of costs. The Applicants submitted that the Opponents have not been prejudiced as the Opponents' position has not changed as a result of the various versions of the evidence of the Applicants since the Opponents' Evidence in Reply could possibly apply to the Applicants' 3<sup>rd</sup> Evidence as well. The Applicants submitted that costs in perusing the various versions of the Applicants' evidence can be compensated by an appropriate order of costs, as suggested by the Registrar's letter of 21 April 2016 (paragraph 19 of the Applicants' submissions). I would only add that, as mentioned above, the specific deficiency in form has been rectified due to the re-filing of the Applicants' 2<sup>nd</sup> Evidence.
26. The following observations are made with regard to the three cases which were relied upon by the Opponents. In those cases, there were:
  - (i) A complete non-compliance with a legislative provision;
  - (ii) The period of delay (before the correct form was filed) in the cases above is rather extensive; and

(iii)The parties were “jolted” into action to file the relevant document (for example, a request for an extension of time under Rule 33 of the TMR) only as a result of the Registrar’s Notification.

In contrast, in the current situation, there has been *no* break in the sequence of events such that the Opponents could have been led to think that the application has been deemed withdrawn.

27. By drawing the above conclusions, the Registrar is *not* condoning the Applicants’ conduct (of inadvertence) *nor* is the Registrar belittling the Opponents’ (agent’s) effort in ensuring that the Opponents’ Evidence in Reply was filed in time over the holiday period (Opponents’ letter of 18 February 2016). In this regard, the Registrar is not attempting to “apply a different set of rules” to the Applicants versus the Opponents (Opponents’ letter of 18 February 2016 refers).
28. However, the Registrar is of the view that the *detriment* that the Opponents have suffered, in reviewing the different versions of the Applicants’ evidence and bringing the discrepancies to light, can be compensated by an appropriate award of costs. The Registrar agrees that the Applicants could have exercised better control over the prosecution of the case, in particular, in ensuring the identity of the content of the subsequent evidence. In this regard, the Applicants are required to pay costs to the Opponents as a result of their inadvertence in monitoring the case. Such inadvertence on the part of the Applicants has been sanctioned. Thus it cannot be said that the Registrar is “apply[ing] a different set of rules” to the Applicants.
29. The Opponents also referred to the case of ***Denko-HLB Sdn Bhd v Fagerdala Singapore Pte Ltd*** [2002] SGCA 30 at ([18]) (see the Opponents’ letter of 18 February 2016):

Some explanation should have been offered to mitigate or excuse the oversight. If, in every case, "oversight" is per se a satisfactory ground, we run the risk of turning the rules prescribing time into dead letters. It would be observed in breach. It would be all too simple for a party to run to a judge to ask for indulgence because of oversight. The need for finality must be borne in mind.

30. However the facts which were peculiar to ***Denko*** must be borne in mind. The Court held at (2) and (3), amongst others, that:

(2) Denko’s application was akin to an application for an extension of time to file an appeal and a stricter approach should be followed in determining whether such an extension should be granted...

(3) Although its application for a stay had merits and Fagerdala did not show any real prejudice which could not be compensated by costs, Denko’s application was dismissed. First, its delay in filing the application was quite substantial given that the prescribed time frame was only seven days...Furthermore, the interlocutory order that Denko sought to have reversed only decided that there would be no stay of the action and was not one that related to the substantive claim in the action: at [17], [18] and [21].

[Emphasis as underlined mine]

31. The Opponents also sought to rely on *Sun Jin Engineering Pte Ltd v Hwang Jae Woo* [2011] 2 SLR 196 at [30] (see the Opponents' letter of 18 February 2016):

...it is the overall picture that emerges to the court as to where the justice of the case lies which will ultimately be decisive.

The Registrar agrees except that as indicated above, the Registrar is of the view that in the current case, the *detriment* that the Opponents have suffered, in reviewing the different versions of the Applicants' evidence to bring the discrepancies to light, can be compensated by an appropriate award of costs.

32. The Applicants also argued extensively at paragraphs 20 – 22 of their written submissions that they have a reasonable defence to the Opponents' allegations in the Notice of Opposition based on the Counter-Statement filed as well as the evidence filed. The Applicants submitted that they have a meritorious case in defending the Opposition and thus depriving the Applicants of the chance to cure the irregularity would result in a failure to hear the Applicants' case on its merits. In this regard, I am of the view that, at this stage, without the Registrar having had an opportunity to have a thorough examination of the case, all that can be said is that the application for the Application Mark is not hopeless.

33. In light of the above, I am of the view that the answer to the second issue is in the *negative*, that is:

If the irregularity in the Applicants' 1<sup>st</sup> Evidence may potentially be cured such that the Application Mark is not deemed withdrawn, the fact that the Applicants' 2<sup>nd</sup> Evidence and the Applicants' 3<sup>rd</sup> Evidence, not being identical in content to the Applicants' 1<sup>st</sup> Evidence, contrary to the Registrar's directions, does *not* change the said issue (A) above for the reasons provided above.

In particular, the *detriment* that the Opponents have suffered, in reviewing the different versions of the Applicants' evidence in order to bring the discrepancies to light, is one which can be compensated by an appropriate award of costs.

*(C) If no, to (B), then what should be the directions moving ahead so as to regularize the irregularity and costs orders, if any.*

34. The Registrar has considered the Opponents' submission (Opponents' letter of 27 April 2016) that the Applicants' 1<sup>st</sup> Evidence be the relevant evidence for the purposes of this case. However, taking into account all the circumstances that have eventuated, the Registrar is of the view that the better way to move forward is to accept the Applicants' 3<sup>rd</sup> Evidence as the relevant evidence for the current case but to award costs to the Opponents for preparing a supplementary statutory declaration to clarify that the Opponents' Evidence in Reply also addresses the Applicants' 3<sup>rd</sup> Evidence.

35. In light of the above, in order to move ahead, the Registrar directs that:

- (i) the Applicants' 3<sup>rd</sup> Evidence be accepted for the purposes of the current opposition proceeding;

- (ii) the Opponents be directed to file a supplementary evidence to clarify that the Opponents' Evidence in Reply also addresses the Applicants' 3<sup>rd</sup> Evidence, such supplementary evidence to be filed within 1 month from the date of this decision;
- (iii) costs are awarded to the Opponents for
  - a. Reviewing the Applicants' 1<sup>st</sup>, 2<sup>nd</sup> and 3<sup>rd</sup> Evidence;
  - b. Preparing for this interlocutory hearing (via the Opponents' correspondences of, in the main, 18 February 2016);
  - c. Preparing the supplemental evidence to clarify that the Opponents' Evidence in Reply also addresses the Applicants' 3<sup>rd</sup> Evidence.

36. In awarding the quantum of costs, having regard to the circumstances, in particular, to the delay caused, and taking into account the Fourth Schedule of the TMR, the costs awarded are as such:

Costs Awarded to the Opponents		
S/N	Description	Amount Awarded
1	Reviewing the Applicants' 1 <sup>st</sup> Evidence	\$800
2	Reviewing the Applicants' 2 <sup>nd</sup> Evidence	\$800
3	Reviewing the Applicants' 3 <sup>rd</sup> Evidence	\$800
4	Preparing for the interlocutory hearing	\$500
5	Preparing the supplemental evidence	\$500
<b>Total</b>		<b>\$3,400</b>

Such costs are to be paid by the Applicants to the Opponents within 1 month from the date of this decision.

#### **Legislation discussed:**

Oaths and Declaration Act (Cap 211, 2001 Rev Ed), section 12(2)

Rules of Court (R 5, Cap 322, Rev Ed 2014) Order 41

Trade Marks Rules (Cap 332, Rev. Ed. 2008), Rule 69, Rule 83, Fourth Schedule

#### **Cases referred to:**

*Distileerderij En Likburstokerij Herman Jansen B V v Tilaknagar Industries Ltd* [2013] SGIPOS 3

*The Polo / Lauren Company, L.P. v BRG Brilliant Rubber Goods (M) Sdn Bhd* [2014] SGIPOS 4

*Denko-HLB Sdn Bhd v Fagerdala Singapore Pte Ltd* [2002] SGCA 30

*Jelco Properties Pte Ltd v V Hotel Pte Ltd* [2014] SGIPOS 1

*Sun Jin Engineering Pte Ltd v Hwang Jae Woo* [2011] 2 SLR 196

**Representation:**

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