

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

Trade Mark No. T0700270D  
Hearing Date: 18 July 2016  
(Further Written Submissions: 15 August 2016)

**APPLICATION FOR CROSS-EXAMINATION  
BY FMTM DISTRIBUTION LTD  
("APPLICANT")**

**AND**

**OBJECTION THERETO  
BY TAN JEE LIANG TRADING AS YONG YEW TRADING COMPANY  
("RESPONDENT")**

Principal Assistant Registrar Mark Lim Fung Chian  
Decision date: 17 October 2016

*Interlocutory hearing – application by Applicant in revocation proceedings to cross-examine deponents of statutory declarations filed by Respondent – objection by Respondent – Registrar’s approach to dealing with interlocutory applications – applicability of Evidence Act and Rules of Court to proceedings before the Registrar – whether cross-examination should be allowed under Rule 69(3) of the Trade Marks Rules as read with IPOS HMG Circular No. 4/2015 dated 30 June 2015, and if so, the issues to which cross examination should be limited.*

## I. INTRODUCTION

1. This decision is in respect of an interlocutory application by the Applicant to cross-examine three deponents: Mr Tan Jee Liang (i.e. the Respondent himself), Mr Subramaniam s/o Sinnathamby, and Mr Tan Jee Peng (collectively “**the Witnesses**”), each of whom gave evidence in support of the Respondent by way of statutory declaration (“**SD**”). By way of background, the Respondent seeks to show, through the evidence of the Witnesses, that he has made genuine use, in the course of trade, of his registered trade mark TM No. T0700270D in respect of the goods for which it is registered. In brief, I allow the Applicant’s application to cross-examine the Witnesses, subject to certain restrictions, but award costs to the Respondent. For a summary of the hearing outcome, and my formal directions to the parties, please see [21] – [24] below.

## II. EVENTS LEADING UP TO THIS INTERLOCUTORY APPLICATION

2. In the main proceedings out of which this interlocutory application arises, the Applicant is seeking the non-use revocation of the Respondent’s following registered mark:

<b>Registered Trade Mark</b>	<b>Class / Specification of Goods</b>	<b>Registration Completion Date</b>
Casa Blanca CASA BLANCA TM No. T0700270D  Filing Date: 05/01/2007  (“ <b>the Mark</b> ”)	Class 14  <i>L.C.D watch, analog quartz watch, automatic watch, watch buckle, watch straps and stainless steel watch band</i>	28/11/2008

3. On 21 July 2014, the Applicant filed for non-use revocation of the Mark under Section 22(1)(a) of the Trade Marks Act (Cap. 332) (“**TMA**”). In its Statement of Grounds, the Applicant pleads that the Mark “*has not been put to genuine use in respect of the specified goods in the course of trade in Singapore within the period of 5 years following the date of completion of the registration procedure*”<sup>1</sup>.

### **The Parties’ SDs**

4. In defending against a non-use revocation action, the registered proprietor of the challenged mark (here the Respondent) must file evidence of use together with his Counter Statement (see Rule 58(3) of the Trade Marks Rules (Cap. 332, R 1) (“**TMR**”) and HMG Circular No. 2/2011). On 21 November 2014, the Respondent complied with

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<sup>1</sup> Statement of Grounds at [2].

this requirement by filing his Counter-Statement together with the SD of Tan Jee Liang dated 20 November 2014 (the “**Respondent’s First SD**”).

5. On 20 April 2015, the Applicant filed the SD of its Legal Counsel, Gwenaelle Vache, dated 8 April 2015 (being its evidence in support of the non-use revocation action).
6. On 17 September 2015, the Respondent filed his evidence, which consisted of the Second SD of Tan Jee Liang dated 16 September 2015 (the “**Respondent’s Second SD**”) as well as SDs from the following individuals:
  - a. Ho Yeok Sun, Director of Nokato (M) Sdn Bhd (SD dated 15 September 2015). In the deponent’s SD at [5], it is stated that Nokato (M) Sdn Bhd is “*one of the dealers in Malaysia to whom the Respondent exports goods bearing the Mark*”.
  - b. Subramaniam s/o Sinnathamby, Sales Manager of BSD Management & Services (SD dated 16 September 2015). In the deponent’s SD at [5], it is stated that BSD Management & Services “*has been purchasing goods bearing the Mark from the Respondent and selling such goods to customers since 2013*”.
  - c. Tan Jee Peng, Director of Niva Time Watch (SD dated 16 September 2015). In the deponent’s SD at [6], it is stated that “*Since the year 2007, Niva Time Watch has been purchasing goods bearing the Mark from the Respondent and selling such goods to customers*”.
7. The Applicant was directed to file its evidence in reply, if any, by 17 December 2015. However, no further SDs were filed by the Applicant.

#### **The Applicant’s written request for leave to cross-examine**

8. A pre-hearing review (“**PHR**”) was held on 12 January 2016. During the PHR, the parties were directed, *inter alia*, to make any requests for cross-examination by 26 January 2016.
  - a. On 26 January 2016, the Applicant wrote in requesting for leave to cross-examine the Witnesses “*for the purpose of determining if there has in fact been genuine use of [the Mark] in Singapore in the course of trade and for the reason that there appears to be conflicting and inconsistency in the evidence submitted*”. The Applicant also estimated that “*a day*” would be required for cross-examination.
  - b. The Respondent did not make any request for cross-examination.

9. On 3 February 2016, Assistant Registrar Ms Diyanah Binte Baharudin (“**the Learned AR**”) from the Intellectual Property Office of Singapore (“**IPOS**”) issued directions to the parties by way of letter. The relevant portion of the said letter stated as follows:

“2 *The Applicants’ request for cross examination of [the Witnesses] is allowed on the basis that it is undertaken to “expose conflict(s) and inconsistency in the evidence submitted”.*

3 *However, it should be noted that “determining if there has in fact been genuine use of the [Mark] in Singapore in the course of trade” is a legal issue for the Registrar to decide at the end of the entire case and is not suitable for cross-examination...*

4 *We also note that the Applicants indicate “a day” for cross-examination alone. In consideration of IPOS’ value proposition as a low-cost tribunal and the IPOS practice that hearings typically last for half a day or one day at most, we will be limiting the time taken for cross-examination to a maximum of 3 hours for 3 witnesses. It should be borne in mind that the maximum costs recoverable for attendance at hearing are S\$800 (Fourth Schedule of the Trade Marks Rules, Item 8).*

...

6 *Unless there is any objection to the directions given above, the matter is now ready for a hearing...”*

10. On 17 February 2016, the Respondent wrote in to IPOS by way of letter to object to the Applicant’s request for cross examination. The Respondent submitted, in essence, that it was insufficient for the Applicant to simply state that the Respondent’s Witnesses had made conflicting and inconsistent statements “*without any further details on the alleged inconsistency*”. According to the Respondent, the Applicant had failed to, and should have provided, “*specific reasons as to why cross-examination of each of the three Witnesses is requested and the specific issues to which the cross-examination... would be directed*”. The Respondent further contended that the Applicant “*had the opportunity to address issues of any alleged conflicts or inconsistencies in the evidence by filing a Statutory Declaration in Reply*” but did not do so.

11. After receiving the Respondent’s objections, the Learned AR issued a letter on 18 February 2016, the material part of which stated as follows:

“2 *In view of the [Respondent’s] objection to the Applicants’ cross-examination of the witnesses, the matter is not ready for a hearing and thus hearing dates are likely to be further postponed until the issue is resolved.*

3        *The Applicants are directed to respond to the [Respondent's] letter within 2 weeks from the date of this letter... Alternatively, parties may prefer to discuss the issue privately and come to agreement as to how to proceed.*

4        *Should there be no agreement, we will consider the Applicants' response before making further directions on cross-examination. If parties are not satisfied with these further directions, the matter will proceed on to an interlocutory hearing, with written submissions and an oral hearing, if necessary."*

12.      On 3 March 2016, the Applicant wrote to IPOS urging the Learned AR to "*maintain her decision to allow cross-examination of the Witnesses*".

13.      On 10 March 2016, the Learned AR wrote to parties by way of letter stating that:

"2        ... *we are inclined to allow the cross- examination of all the Witnesses on the terms mentioned at paragraph 4 of our letter dated 3 February 2016, subject to the Applicants' particularisation of the specific issues on which cross-examination is sought and the relevance of such issues to the present case. To clarify, a list of questions is not necessary.*"

In that same letter, the Applicant was directed to submit the further particulars by 24 March 2016. Parties were also directed to write in in the event they did not agree with the above directions.

14.      On 11 March 2016, the Applicant wrote in to IPOS by way of letter stating, *inter alia*, that:

"... *The Registrar will benefit from having cross-examination of certain parts of the witnesses' Statutory Declarations undertaken as it will show forth whether the witnesses (including what the relationship is between them), the claims they have made, and evidence they have submitted are credible and can be relied upon. All of this is relevant to the Registrar's assessment of whether the [Respondent's] claim of genuine use in the course of trade in Singapore of the subject trade mark (within the meaning of the Trade Marks Act) and their evidence can be supported...*"

(emphasis original)

15.      On 18 March 2016, the Learned AR wrote to parties with reference to the Applicant's letter of 11 March 2016. The relevant portion of the letter stated as follows:

"2        *The reference to "whether the witnesses (including what the relationship is between them), the claims they have made, and evidence they have submitted are credible and can be relied upon" is not sufficient particularisation of the specific issues on which cross-examination is sought.*

3 Although there is no fixed format for providing these particulars at present, the following example below might be illustrative. The contents are taken from the Applicants' Statutory Declaration...and are used **strictly for illustrative purposes only**:

Witness Name: Tan Jee Liang (NRIC No. [redacted])

<b>Issue(s)</b>	<b>Relevance</b>
<i>Whether the tax invoices as stated at paragraph 8 of 1st Vache may have been created for the purpose of these proceedings</i>	<i>To determine the credibility of the Proprietor's evidence"</i>

4 We trust that the example above is of assistance and look forward to having the particularization of the specific issues on which cross-examination is sought and the relevance of such issues to the present case by the original due date of 24 March 2016.”  
(emphasis original)

16. On 23 March 2016, the Applicant replied to the Learned AR's letter, stating *inter alia* that “we do not agree that your request for further particularisation of specific issues is necessitated or supported by the HMG Circular No. 4/2015” and that “Requiring [the Applicant] to identify the specific issues in advance of the hearing, in the manner set out in your letter, extends an unfair advantage to the witnesses and nullifies the whole point of cross-examination. We do not see any legal basis for what you are requiring of [the Applicant].” The Applicant's letter concluded with a request for an interlocutory hearing.
17. An oral interlocutory hearing was held on 18 July 2016. After hearing oral arguments from both sides, it became clear that the dispute between the parties centred on the issue of how Rule 69(3) TMR<sup>2</sup>, as read with HMG Circular No. 4/2015 (the “**Circular**”), should be properly interpreted and applied to the present facts.
  - a. The Applicant clarified that its objection was not to the Circular itself, but rather to how it should be applied. The thrust of the Applicant's submissions was that it should not be required to provide detailed particulars of the issues on which the Witnesses were to be cross-examined, for to do so would defeat the whole purpose of cross-examination. In this connection, the Applicant took objection to the illustration set out in IPOS' letter of 18 March 2016 (see [15] above) (which it considered to set a higher standard than what was required by the TMR and the Circular).

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<sup>2</sup> Rule 69(3) TMR provides as follows: “The Registrar may, in any particular case, take oral evidence in lieu of or in addition to a statutory declaration and shall, unless the Registrar otherwise directs, allow any witness to be cross-examined on his statutory declaration or oral evidence”.

- b. The Respondent's two main contentions were: (i) that the reasons given by the Applicant (as to why cross-examination should be allowed) were too broad and general and did not meet the requirements in Rule 69(3) TMR as read with the Circular; and (ii) that the Applicant's assertion that the Respondent's evidence was internally conflicting and inconsistent could have been addressed by way of SD (which the Applicant could have filed, but did not).
18. During the course of the interlocutory hearing, an issue arose as to the applicability of the Evidence Act (Cap. 97) ("EA") to the current proceedings. Both parties requested additional time to file written submissions to address me on the issue. The Applicant suggested a timeline of 4 weeks and the Respondent agreed. Thus I directed parties to file further written submissions by 15 August 2016.
19. I also gave the Applicant another opportunity to provide a revised list of issues for cross-examination in line with the format set out in the Circular, together with any additional case authorities it wished to tender which may shed light on the current practice of the UK Intellectual Property Office ("UK IPO") in dealing with requests for cross-examination. The Respondent was given 2 weeks to respond if he had any objections thereto. I further directed that if either party wanted a further oral hearing, they should write in within 1 week thereafter (*i.e.* by 5 September 2016).
20. On 15 August 2016, the parties filed further submissions. In accordance with my directions, the Applicant's further submissions also contained a list of issues for cross-examination<sup>3</sup> which it considered to be material and to have a direct bearing on the outcome of the proceedings. I reproduce the said list below (the "**Applicant's List of Issues for Cross-Examination**"):
- a. Where was the Mark applied?
  - b. Was the alleged use of the Mark in Singapore?
  - c. Was the alleged use within the relevant period of time?
  - d. Was the alleged use in the course of trade?
  - e. How was the Mark allegedly used (nature of the purported use and sales)?
  - f. Is the Respondent's evidence and that of its witnesses reliable?
  - g. Does the evidence submitted support the Respondent's claim of genuine use of the Mark in the course of trade in Singapore within the relevant term?

Although the Respondent had 2 weeks to object to the Applicant's List of Issues for Cross-Examination if he wished to do so, no objections were received. In addition, neither party requested for a further oral hearing.

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<sup>3</sup> See Applicant's Further Written Submissions at p 9.

### III. SUMMARY OF HEARING OUTCOME AND DIRECTIONS

21. I find the Applicant's List of Issues for Cross-Examination to be satisfactorily particularised and in compliance with the Circular. As framed, the issues provide adequate focus, while allowing sufficient room for cross-examination. I therefore allow cross-examination in respect of the Applicant's List of Issues for Cross-Examination.
22. On the issue of costs, it is regrettable that the Applicant replied to the Learned AR's letter of 18 March 2016 by requesting for a hearing without providing a revised particularised list of issues or attempting to resolve the issue via further correspondence. If it had done so, there may not have been a need for this interlocutory hearing. I thus award costs to the Respondent. Under the Scale of Costs in the Fourth Schedule of the TMR, the range of costs that may be awarded for interlocutory proceedings are: S\$50 – S\$500 for "*preparing for*" the interlocutory proceedings and S\$50 – S\$500 for "*attendance*" at the interlocutory hearing. Having regard to all of the circumstances, I fix costs in respect of this interlocutory application at S\$1,000 (including disbursements), to be paid by the Applicant to the Respondent by 17 November 2016.
23. As regards the time for cross-examination, I note that reasonable latitude should be given to a party to conduct cross-examination, having regard to the nature and complexity of issues and number of witnesses. That said, I am also mindful of IPOS' value proposition as a low cost tribunal, and the fact that hearings at IPOS typically last half a day, or a full day at most. I will allow 1 hour for cross-examination per witness and so I will allow 3 hours in total for cross-examination. However, if it appears during the full hearing that additional time for cross examination is required, the Applicant may apply to the Hearing Officer presiding over the main hearing to exercise his/her discretion to allow such additional time as may be fair, just and reasonable in the circumstances.
24. I direct as follows.
  - a. The Applicant's application for leave to cross-examine the Witnesses is allowed provided that the scope of cross-examination is limited to the issues set out in the Applicant's List of Issues for Cross-Examination.
  - b. The time allotted for cross-examination of the Witnesses will be fixed at 3 hours, which may be extended at the Hearing Officer's discretion.
  - c. The Applicant is to pay the Respondent's costs of this interlocutory application, fixed at S\$1,000 (inclusive of disbursements) by 17 November 2016.

My detailed reasons are set out in Part VI below.



#### IV. IPOS CASE MANAGEMENT PROCEDURE: OBSERVATIONS AND SOME GUIDELINES

25. I note that there may have been some misunderstanding regarding interlocutory case management procedure at IPOS. This case presents an opportunity to set out some general observations and guidelines which may assist parties to disputes before the Registrar<sup>4</sup> at IPOS. (Although the statements below relate to trade marks proceedings at IPOS, they may, in the appropriate case, be equally applicable to other types of disputes at IPOS as well.)
26. Broadly speaking, there are two categories into which interlocutory disputes at IPOS may fall.
- a. First Category: applications for extensions of time made within the relevant prescribed period. There are a number of provisions in the TMR which relate to extensions of time.<sup>5</sup> Since the instant case is not one which concerns an application for an extension of time, it is unnecessary to undertake a detailed examination of the relevant rules. It suffices, for present purposes, to stress that by nature, extension of time applications brook no delay. This is why, after receiving an application for extension of time made within the relevant prescribed period<sup>6</sup>, the Registrar may, for example, proceed to issue, by way of written correspondence to the parties, a final decision in accordance with the applicable rule(s) informing the parties that the extension is granted. (The term ‘final’ decision is used in contradistinction to the ‘tentative’ or ‘proposed’ decisions or directions (hereinafter referred to as a “**Preliminary View**”) which the Registrar may give: a point elaborated in the discussion on the Second Category below.) For the avoidance of doubt, applications for extensions of time made out-of-time (*i.e.* after the relevant prescribed period has elapsed) are not included in this First Category.
  - b. Second Category: all other interlocutory disputes which do not fall within the ambit of the First Category. Unlike for cases in the First Category, the Registrar generally does not, at the outset, issue final decisions in respect of interlocutory disputes in the Second Category, unless parties mutually agree to a certain outcome. Instead, a multiple-step process is employed.

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<sup>4</sup> The term “Registrar” includes all Principal Assistant Registrars and Assistant Registrars, who may exercise the powers of the Registrar under Section 62(2) TMA. The Principal Assistant Registrar or Assistant Registrar presiding over an interlocutory application or full hearing is the “**Hearing Officer**”.

<sup>5</sup> Examples include, but are not limited to, Rules 29(3), 31(4), 32(4), and 33(4) TMR.

<sup>6</sup> The phrase “applications for extensions of time made within the relevant prescribed period” in this Grounds of Decision refers to two possible situations. First, where a specific rule in the TMR specifically prescribes a time period within which an application for an extension of time shall be made. Non-exhaustive examples include: the 2 month period referred to in Rules 29(3) and 31(4) TMR, and the 3 month period referred to in Rules 32(4), 33(4) and 34(4) TMR. Second, where the TMR does not specifically prescribe a time period, and the Registrar prescribes a time period upon a request for an extension of time.

- i. First Step – explore possibility of resolution via consent: Under the first step, the Registrar adopts a facilitative role, with a view to having parties resolve the procedural issue via consensus. Therefore, the Registrar does not make any final decision or give any final directions at the outset. Parties are usually encouraged to engage with each other with a view to resolving the interlocutory dispute, and a reasonable timeline will be given for parties to do so. The Registrar may also fix a case management conference to discuss the issue if it appears to be more expedient or appropriate to do so.
- ii. Second Step – Registrar puts forward a Preliminary View: If parties are unable to resolve their differences by the end of the stipulated timeline, or at any appropriate juncture, the Registrar will put forward a Preliminary View and parties will be given an opportunity to respond by way of letter. If no objections are received to the Preliminary View by the stipulated date, the tentative decision or directions set out in the Preliminary View become final and parties are to abide by them.
- iii. Third Step – In the event objections are received to the Preliminary View: If one or both parties write in to object to the Registrar's Preliminary View, the Registrar may adopt one of the following approaches:
  - (A) Issue a fresh Preliminary View and give parties a further opportunity to respond. The Registrar may adopt this approach in cases where there is new information that was not previously considered and/or after due consideration of the parties' submissions.
  - (B) Indicate that notwithstanding the objections the Registrar is not inclined to deviate from the earlier Preliminary View and at the request of a party or on his own initiative, allow the parties to be heard either (at their election) by way of a formal oral interlocutory hearing or only by further written submissions (if any) in lieu of an in-person interlocutory hearing. Regardless of whether there is to be an oral hearing, the Registrar will usually give directions as to the timelines for parties to tender written submissions and a bundle of authorities and reply submissions, if any.

The Registrar will either issue a final decision at the conclusion of, or after, the interlocutory hearing or after receiving the parties' written submissions in lieu of an in-person interlocutory hearing (as the case

may be). In certain cases (such as this), leave may be granted to tender further written submissions to address the Registrar on specific points.

27. The two main reasons for this multiple-step approach (to cases falling within the Second Category) are as follows.
- a. The purpose of an interlocutory hearing is for parties to resolve procedural issues leading up to the final hearing. Inevitably however, every interlocutory hearing causes parties to incur additional costs. IPOS is a low cost tribunal and costs awarded “*are not intended to compensate the parties for the expense to which they may have been put*” (see Rule 75(2) TMR). And, in general, costs awards for trade marks disputes at IPOS are much lower than party-and-party cost awards in the Supreme Court (see the Scale of Costs in the Fourth Schedule of the TMR as compared to the Costs Guidelines in Appendix G of the Supreme Court Practice Directions). To take security for costs as one example, the Supreme Court Costs Guidelines provide that costs awards for such applications are likely to range within \$2,000 – S\$6,000. Moreover, the judicial officer hearing the matter is permitted to depart from these amounts in the appropriate case. On the other hand, costs for security for costs, like all interlocutory proceedings at IPOS, are subject to a fixed range of \$50 – \$500 for work done in preparation for the interlocutory proceedings and an additional \$50 – \$500 for attending the interlocutory hearing. Importantly, the Registrar has no discretion to depart from these amounts.
  - b. There are no appeals against interlocutory decisions of the Registrar under the TMA *except* under Section 75(3) TMA which provides as follows: “*Where the Registrar makes a decision in any interlocutory proceedings between 2 or more parties, and the decision terminates any matter concerning a trade mark or an application for a trade mark, any of those parties who is adversely affected by the termination of the matter may appeal to the Court from the decision of the Registrar*”<sup>7</sup>.
28. In the present case, the interlocutory dispute between the parties is not one which relates to a request for an extension of time. It falls firmly in the Second Category. Therefore (and for the avoidance of doubt), prior to the instant decision herein, no final interlocutory decision was made by the Registrar, and nothing in IPOS’ letters should have been construed as such.

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<sup>7</sup> Also see [45] below.

## V. CROSS-EXAMINATION AT IPOS

29. Cross-examination is not an automatic right in trade marks proceedings before IPOS. In each case, the Registrar retains the discretion as to whether to (dis)allow cross-examination. This is patently clear from Rule 69(3) TMR, which provides as follows:

*“(3) The Registrar may, in any particular case, take oral evidence in lieu of or in addition to a statutory declaration and shall, unless the Registrar otherwise directs, allow any witness to be cross-examined on his statutory declaration or oral evidence.”*  
(emphasis added)

30. The Circular provides guidance as to how a request for cross-examination (hereinafter “**Request**”) may be made, the formal requirements which the Request should comply with, and the circumstances which the Registrar takes into account in deciding whether to allow the Request (and if so on the scope on which cross-examination is to take place). For convenience I reproduce the relevant portion of the Circular below:

### ***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...*

*... 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.”*

**Preliminary Question: Are proceedings before the Registrar at IPOS subject to the Evidence Act and/or Rules of Court?**

31. The Applicant sought to persuade me, by reference to various provisions in the EA and the Rules of Court (Cap. 322, R 5) (“**ROC**”), that it should be granted leave to cross-examine the Witnesses. A preliminary issue that arises is whether the EA and/or ROC apply to proceedings at IPOS in the first place.
32. In light of my decision to allow cross-examination in respect of the Applicant’s List of Issues for Cross-Examination, it is unnecessary for me to decide on whether the EA and/or ROC apply to hearings at IPOS. Given the potential implications of such a decision, I would leave the matter open for consideration in a future case. That said, since parties have addressed me on the issue, I set out my provisional views below.

Whether the Rules of Court apply to IPOS hearings

33. The Applicant contends that the ROC apply to IPOS proceedings. In support, the Applicant points towards the fact that Order 1 rule 2 ROC provides for “*an exclusion of the application of the Rules of Court specifically to bankruptcy proceedings, proceedings relating to the winding up of companies, proceedings under the Parliamentary Act (Cap. 218), family proceedings, criminal proceedings, and proceedings relating to the winding up of limited liability partnerships*”. According to the Applicant, “*the legislator specifically provides to which proceedings the Rules of Court do not apply. Ergo ipso facto, they apply otherwise*”. The Applicant concludes by submitting that in IPOS proceedings, the ROC supplement “*those areas that are not covered*” by the TMA or TMR.<sup>8</sup> With respect, I am unable to agree with these submissions.
34. As the Respondent correctly points out, Order 1 rule 2(1) ROC provides that “*... these Rules shall have effect in relation to all proceedings in the Supreme Court and the State Courts, in so far as the matters to which these Rules relate are within the jurisdiction of those Courts...*” Therefore, the ROC apply to judicial proceedings before the Supreme Court and the State Courts, but not otherwise. The exclusions that follow (e.g. to bankruptcy proceedings, criminal proceedings and so on, which are all heard before the Supreme Court and/or the State Courts) must be read in this context as being carve-out exceptions to the aforesaid rule. Since IPOS is a separate tribunal which is not part of the Supreme Court or the State Courts, the issue of a carve-out provision for IPOS proceedings does not even arise. Hence the ROC should not be applicable to IPOS proceedings.

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<sup>8</sup> See Applicant’s Further Written Submissions at p 5.

35. I am fortified in my view by the fact that Rule 69(1A) TMR expressly imports Order 41 ROC to evidence in trade mark proceedings before the Registrar. It provides that:

*(1A) Subject to the provisions of the Oaths and Declarations Act (Cap. 211) and these Rules, Order 41 of the Rules of Court (Cap. 322, R 5) shall, with the necessary modifications, apply in relation to a statutory declaration filed or used in any proceedings before the Registrar as it applies to an affidavit filed or used in any proceedings before the Court.*

If the ROC were of general application to IPOS proceedings, there would have been no need to expressly import Order 41 ROC by way of Rule 69(1A) TMR.

36. Notwithstanding the above, it is always open to parties to mutually agree to apply certain provisions in the ROC to their dispute at IPOS before the Registrar (see for instance: *Lonza Biologics Tuas Pte Ltd v Genpharm International Inc* [2015] SGIPOS 13 (“*Lonza*”). If parties are mutually willing to hold themselves to the standards which apply to civil proceedings in the Supreme Court and the State Courts, IPOS will generally not interfere. But, parties should bear in mind four general points.
- a. One: the Registrar’s powers are circumscribed by the TMA and are far more limited than that of Judges and Judicial Officers in the Supreme Court and State Courts. The Registrar cannot make any order or hear any dispute that it does not have the power to. (Similarly for patents cases under the Patents Act (Cap. 221) (“**PA**”) and registered designs cases under the Registered Designs Act (Cap. 266) (“**RDA**”).)
  - b. Two: as a corollary to point one, in the event of any conflict between the ROC and the relevant parent legislation (e.g. the TMA, PA or RDA) it is the latter that must necessarily take precedence.
  - c. Three: as discussed in [27(b)] above, there is no avenue of appeal from a decision of the Registrar in interlocutory proceedings except as provided for under Section 75(3) TMA.
  - d. Four: IPOS is a low-cost tribunal and therefore there are limits on the costs that it can award. This is also discussed in some detail at [27(a)] above.
37. For the avoidance of doubt, the views expressed in [33] to [36] above are provisional in nature and do not represent a final decision on the issue of whether the ROC apply to IPOS proceedings generally.

## Whether the Evidence Act applies to IPOS proceedings

### *Lonza v Genpharm*

38. In *Lonza* the learned IP Adjudicator, Mr Yeong Zee Kin, stated (in the context of a patent revocation action) that the EA applies to “*judicial proceedings before the courts but not otherwise*” (at [25]).
39. The Respondent relies on *Lonza* to support its argument that the EA does not apply because IPOS proceedings are not “*judicial proceedings before the courts*”<sup>9</sup>. The Applicant disagrees, and submits that a “*close look at section 2(1) of the Evidence Act would show*” that it “*cannot be used to reach the determination that the Evidence Act does not apply to judicial proceedings outside the court*”<sup>10</sup>.
40. An earlier IPOS decision is persuasive, but not binding on a later IPOS tribunal. Although there is no need for me to decide on the issue, with respect, I am inclined to the view that *Lonza* is not persuasive authority for the proposition that the EA does not apply to IPOS proceedings. There are two reasons for this.
- a. First, the EA applicability issue was not fully argued before the learned IP Adjudicator. This was because the proprietor of the patent (in respect of which revocation was sought) elected to withdraw from the hearing (see *Lonza* at [11] – [14]) and so only the applicant was heard.
  - b. Second, the applicant had proposed to the proprietor that the EA should apply to the proceedings and it was found on the facts of that case that “*the proprietor had accepted by acquiescence and conduct the applicant’s proposal*” (at [31]). In other words, there was no need for the tribunal to decide on the issue, because parties had already agreed to the application of the EA (and by extension, the ROC).

Therefore, all that was required of the tribunal in *Lonza* was to apply the EA and ROC following the approach in *Martek Biosciences Corp v Cargill International Trading Pte Ltd* [2011] 4 SLR 429 (“*Martek*”) at [39]. (I would also add that the issue of whether the EA applies to IPOS proceedings by default was also not considered in *Martek* for that same reason *i.e.* parties consented to its application.)

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<sup>9</sup> See Respondent’s Further Written Submissions at [4].

<sup>10</sup> See Applicant’s Further Written Submissions at p 4.

*Section 2(1) of the Evidence Act*

41. I now approach the issue afresh having regard to the relevant legal principles. As always, the starting point in statutory interpretation is the language of the statute itself. Section 2(1) of the EA provides that:

***Application of Parts I, II and III***

2.—(1) *Parts I, II and III shall apply to all judicial proceedings in or before any court, but not to affidavits presented to any court or officer nor to proceedings before an arbitrator.*

(emphasis added)

42. In unpacking the meaning of the section I need to consider its relevant constituent parts. The first part of the section sets out the rule: *i.e.* that the EA applies to “*all judicial proceedings in or before any court*”. The second part sets out the exception: “*but not to affidavits presented to any court or officer*”. (For present purposes the exception for “*proceedings before an arbitrator*” is irrelevant and I will disregard it.)
43. What does the phrase “*judicial proceedings*” mean? Although the term is not defined in the EA, in the portion of Mr Jeffrey Pinsler SC’s text, ***Evidence and the Litigation Process (5<sup>th</sup> Ed), (Lexis Nexis 2015) (“Pinsler”)***<sup>11</sup>, which discusses this section (*i.e.* Section 2(1) EA), there is a footnote<sup>12</sup> which may offer some guidance: “*It has been said that judicial proceedings involve the ‘power to give a decision or a definitive judgment which should have finality and authoritativeness’ lis inter partes (See Re Derek Shelby, deceased [1971] 2 MLJ 277)*”.
44. The term “*court*” is defined in Section 3(1) EA as including “*all Judges and Magistrates and, except arbitrators, all persons legally authorised to take evidence*”. Under Section 71 TMA, the Registrar is empowered to, “*for the purposes of any proceedings before him under this Act*”, “*summon witnesses*”, “*receive evidence on oath, whether orally or otherwise*”, and “*require the production of documents or articles*”. (Similar powers are conferred upon the Registrar under Section 8 PA and Section 58 RDA.)
45. Taking the above together, a persuasive argument can be made that since the Registrar is “*legally authorised to take evidence*” and proceedings at IPOS may result in a “*decision or definitive judgment*” which has “*finality and authoritativeness*” as between parties to a legal dispute, the EA should be applicable to IPOS proceedings by virtue of s 2(1) EA. (One might also argue that it is for this very reason that Section 75 TMA, Section 90 PA, and Section 62 RDA set out the circumstances in which decisions of the Registrar under those respective Acts are appealable to the High Court.)

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<sup>11</sup> See ***Pinsler*** at [1.045] at pp 24 - 25

<sup>12</sup> See ***Pinsler*** at [1.045] at pp 24, footnote 63



46. Although there are (as far as I am aware) no decisions from the Court of Appeal or the High Court on the specific issue of the applicability of the EA to IPOS proceedings (and none have been cited before me by the parties), there is a decision of the High Court which touches on the applicability of the EA to another tribunal, the Strata Titles Board: *Yap Sing Lee v MCST Plan No 1267* [2011] SGHC 24 (“*Yap Sing Lee*”). It appears from [60] of *Yap Sing Lee* that the High Court was open to the “*distinct possibility*” that the EA applied to proceedings before the Strata Titles Board (which had the power to take evidence for the purposes of certain proceedings under the Building Maintenance and Strata Management Act (Cap. 30C)). However, there was no need for a definitive ruling on the issue and none was made in that case. Since *Yap Sing Lee* was not cited before me in argument, I will say no more about it.
47. I move on to consider the second portion of Section 2(1) EA, which contains an exclusion for “*affidavits presented to any court or officer*”. *Pinsler* at [1.046] explains that this means that “*affidavits presented in interlocutory proceedings or for the purpose of a specific order are not subject to those provisions*” (and in the corresponding footnote no. 74 on p 25 it is stated that “*Therefore an interlocutory affidavit may make reference to hearsay evidence*”). In this connection, it appears that affidavits filed in respect of originating summonses are also not subject to Parts I, II and III of the EA: see the decision of the High Court in *HSBC Trustee (Singapore) Ltd v Lucky Realty Co Pte Ltd* [2015] 3 SLR 885. (I note that the aforesaid decision was reversed by the Court of Appeal on the facts, but the Court of Appeal did not disagree with the ruling on the non-applicability of the EA to proceedings commenced by way of originating summons.)<sup>13</sup>
48. The primary mode of giving evidence in proceedings before the Registrar at IPOS is by way of SD. SDs filed for the purposes of IPOS proceedings are held to standards which are similar to that of affidavits in the High Court. This can be seen from Rule 69(1A) TMR which provides that Order 41 ROC “*shall, with the necessary modifications, apply in relation to a statutory declaration filed or used in any proceedings before the Registrar as it applies to an affidavit filed or used in any proceedings before the Court*”. Order 41 rule 5 ROC provides as follows.

***Contents of affidavits*** [read: SDs] (***O. 41, r. 5***)

5. — (1) *Subject to the other provisions of these Rules, an affidavit* [read: SD] *may contain only such facts as the deponent is able of his own knowledge to prove.*
- (2) *An affidavit* [read: SD] *sworn for the purpose of being used in interlocutory proceedings may contain statements of information or belief with the sources and grounds thereof.*

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<sup>13</sup> See *Lucky Realty Co Pte Ltd v HSBC Trustee (Singapore) Ltd* [2016] 1 SLR 1069

In the same vein, Rule 69(2) TMR provides that any such SD “*may, in the case of an appeal to the Court, be used before the Court in lieu of evidence by affidavit, and if so used, shall have all the incidents and consequences of evidence by affidavit*”.

49. HMG Circular No. 3/2015 dated 30 June 2015 provides that the practice before the Registrar is to “*accept evidence that meets the standard set out in O 41, r 5(2) of the Rules of Court rather than the higher standard set out in O 41, r 5(1) of the Rules of Court. In other words, an SD need not necessarily contain only such facts as the deponent is able of his own knowledge to prove, but also may contain statements of information or belief with the sources or grounds thereof*”. In effect therefore, the evidence tendered by way of SD for the purposes of full hearings before the Registrar at IPOS approximates that of the interlocutory standard in the High Court.
50. For the reasons above, I am inclined towards the conclusion that the exclusion in Section 2(1) EA for “*affidavits presented to any court or officer*” applies, *mutatis mutandis*, to SDs presented to the Registrar for the purposes of IPOS proceedings.
51. However, SDs are not the only mode of evidence in IPOS proceedings. The Registrar is also empowered to “*take oral evidence in lieu of or in addition to a statutory declaration*” as well as “*allow any witness to be cross-examined on his statutory declaration or oral evidence*” (Rule 69 TMR). (Such power is provided for under Section 71 TMA.) Since oral evidence (whether elicited during cross-examination or otherwise) is not part of an SD, the exception in Section 2(1) EA for “*affidavits [or SDs] presented to any court or officer*” does not apply. Hence, Parts I, II and III of the EA should apply to oral evidence given in lieu of or in addition to an SD as well as oral evidence elicited during cross-examination.
52. In summary, my provisional views are as follows:
  - a. SDs filed for the purposes of IPOS proceedings are not subject to Parts I, II and III of the EA. (See [41] – [50] above.)
  - b. However, oral evidence given in lieu of or in addition to an SD, as well as oral evidence elicited during cross-examination, is subject to Parts I, II and III of the EA, which applies generally to proceedings before the Registrar at IPOS. (See [51] above.) I note that the foregoing is not inconsistent with the statement in p 2 of the Circular which states that “*for avoidance of doubt, if the request is allowed, general legal principles of cross-examination will apply*”.

*Interplay between the EA and the TMA / TMR*

53. Assuming I am correct in my view that the EA applies to cross-examination at IPOS, how then should I read Section 140(1) EA<sup>14</sup>, which gives the adverse party the right to cross-examine the other side's witnesses, in light of Rule 69(3) TMR<sup>15</sup> which gives the Registrar the discretion to (dis)allow cross-examination? There are two possible responses to this.
54. The first is that to the extent that there is any inconsistency, I should apply the maxim *lex specialis derogat legi generali* (that is to say, a specific law prevails over a general law). Therefore, insofar as there is any conflict between the provisions of the TMA / TMR and the EA, I should prefer the specific (*i.e.* the TMA / TMR) over the general (the EA).
55. The second is that on a proper construction, Section 140(1) EA does not in fact apply to IPOS proceedings at all. I elaborate:-
- a. The procedure for evidence at High Court trials is dictated, *inter alia*, by Order 38 ROC (which I consider to be inapplicable to IPOS proceedings) wherein the default mode of proving the evidence of witnesses is by examination of the witnesses in open Court (see Order 38 rule 1 ROC). It is against the backdrop of the aforesaid rule that Order 38 rule 2(1) ROC provides: "... *the evidence-in-chief of a witness shall be given by way of affidavit and, unless the Court otherwise orders or the parties to the action otherwise agree, such a witness shall attend trial for cross-examination and, in default of his attendance, his affidavit shall not be received in evidence except with the leave of the Court*".
  - b. But, Order 38 rule 2(1) ROC does *not* apply to originating summonses or applications made by summons. In such cases there is no examination-in-chief. Instead, it is Order 38 rule 2(2) ROC which governs, and which provides that the default mode is that "*evidence shall be given by affidavit unless in the case of any such cause, matter or application any provision of these Rules otherwise provides or the Court otherwise directs, but the Court may, on the application of any party, order the attendance for cross-examination of the person making any such affidavit, and where, after such an order has been made, the person in question does not attend, his affidavit shall not be used as evidence without the leave of the Court*" (emphasis added). The underlined portion is very similar to the procedure at IPOS wherein the default mode of giving evidence is by SD and the deponent of an SD need not attend the hearing unless required by the

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<sup>14</sup> Section 140(1) EA provides that: "*Witnesses shall first be examined-in-chief, then, if the adverse party so desires, cross-examined, then, if the party call them so desires, re-examined*".

<sup>15</sup> Rule 69(3) TMR provides that: "*The Registrar may, in any particular case, take oral evidence in lieu of or in addition to a statutory declaration and shall, unless the Registrar otherwise directs, allow any witness to be cross-examined on his statutory declaration or oral evidence.*"

Registrar to give oral evidence, or where the Registrar has granted leave to the other side to cross-examine.

- c. Since the procedure in Section 140(1) EA (which provides that witnesses shall first be examined-in-chief) does not arise in originating summonses or applications made by summons, the issue of automatic right of cross-examination does not arise. By extension, there is arguably no automatic right of cross-examination in relation to SDs filed for the purposes of proceedings at IPOS.

56. For the avoidance of doubt, the views expressed in [41] to [55] above are provisional in nature and do not represent a final decision on the issue of whether the EA applies to IPOS generally.

## VI. THE REGISTRAR'S APPROACH TO REQUESTS FOR CROSS-EXAMINATION IN LIGHT OF THE CIRCULAR

57. In the paragraphs that follow I set out the Registrar's approach to requests for cross-examination having regard to the guidance in the Circular, as applied to this case.

### (A) The Circular supersedes the earlier IPOS decisions

58. The Circular was issued on 30 June 2015, came into effect on 30 July 2015 in relation to "*all actions pending before the Registrar*", and was amended for clarification on 22 July 2016. In a case decided before the issuance of the Circular, *Application for Cross-Examination by PT Eigerindo Multi Produk Industri and Objection Thereto by Sports Connection Pte Ltd* [2014] SGIPOS 2, the learned Hearing Officer stated at [2] that "... *the use of the word 'shall' in Rule 69(3) of the TMR suggests that more often than not, the Registrar will allow such cross-examination*". The Applicant relies on this passage to support its submission that the starting point should be to allow cross-examination more often than not<sup>16</sup>. However, as the Respondent rightly submitted during oral argument, the decision pre-dates the Circular. To the extent that the decision is inconsistent with the Circular, I do not regard it as persuasive.

### (B) A SD plays a different role from that of cross-examination in IPOS proceedings

59. The Circular, under the heading '*Examples where a request for cross-examination may not be allowed*', contains the following example:

"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).*"

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<sup>16</sup> See Applicant's Written Submissions at p 11.

60. In the present case, the Applicant was given the opportunity to file an SD in reply, but did not do so<sup>17</sup>. The Respondent relies on the part of the Circular set out in the paragraph above for its submission that leave to cross-examine should not be given. According to the Respondent, if the Applicant had wanted to raise allegations of evidential inconsistencies in the Respondents' SDs, it could have done so via an SD in reply instead of cross-examination. The Respondent points towards his own conduct (of addressing alleged evidential inconsistencies via the Respondent's 2<sup>nd</sup> SD) as an example of what the Applicant should have done.<sup>18</sup>
61. The Applicant, on the other hand, argues that the Respondent has "*confused the purpose of a Statutory Declaration in Reply*", which is a "*vehicle for presenting further evidence to the tribunal*", with cross-examination, which is a "*vehicle for challenging evidence*"<sup>19</sup>.
62. I agree with the Applicant's submission that the purpose of an SD is to present evidence. (I have discussed the relevant rules relating to SDs in some detail in [48] and [49] above.)
- a. To briefly recapitulate, the starting point is Rule 69(1) TMR, which provides that "*In any proceedings before the Registrar under the Act or these Rules, evidence shall be given by way of a statutory declaration, unless otherwise provided by the Act or these Rules or directed by the Registrar*". Rule 69(1A) TMR goes on to state that "*Subject to the provisions of the Oaths and Declarations Act (Cap. 211) and these Rules, Order 41 of the Rules of Court (Cap. 322, R 5) shall, with the necessary modifications, apply in relation to a statutory declaration filed or used in any proceedings before the Registrar as it applies to an affidavit filed or used in any proceedings before the Court*". The material part of Order 41 rule 5(1) ROC provides that "*an affidavit [here: SD] may contain only such facts as the deponent is able of his own knowledge to prove*". However, under Order 41 rule 5(2) ROC, "*An affidavit [here: SD] sworn for the purpose of being used in interlocutory proceedings may contain statements of information or belief with the sources and grounds thereof*". HMG Circular No. 3/2015 dated 30 June 2015 states that the Registrar's consistent practice is to "*accept evidence that meets the standard set out in O 41, r 5(2) of the Rules of Court rather than the higher standard set out in O41, r5(1) of the Rules of Court. In other words, an SD need not necessarily contain only such facts as the deponent is able of his own knowledge to prove, but also may contain statements of information or belief with the sources or grounds thereof*".

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<sup>17</sup> See Part II above and in particular [7].

<sup>18</sup> See Respondent's Written Submissions at [18].

<sup>19</sup> See Applicant's Written Submissions at p 9.

- b. In addition to the rules discussed above, the evidence set out in an SD *in reply* for revocation proceedings is further subject to Rule 59(1A)(e)(ii) TMR which provides that the evidence in reply has to be “*confined to matters strictly in reply to the proprietor’s statutory declaration*”. (A similar rule applies to opposition proceedings: see Rule 34(3) TMR.) A deponent of an SD in reply is, of course, free to contradict the statements set out in the SD (that he or she is replying to) by stating what he or she knows or believes to be the true factual position. Or, the deponent may adduce some other documents which may have the effect of demonstrating that the factual position is otherwise from that which is stated by the deponent of the earlier SD. But the deponent of an SD in reply cannot, for instance, use it as a medium for legal submissions, or for challenging testimony in the way that counsel might during cross-examination.
63. In cases of non-use revocation (such as the present), the central issue is whether the subject mark has been put into genuine use. And the burden is on the proprietor to show that it has. This is provided for in Section 105 TMA which states that: “*If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it*”. The rationale for the reversal of the burden of proof is that it is difficult to prove a negative fact (see *MCI Group Holding SA v Secondment Pty Ltd* [2014] SGIPOS 15 at [24] – [25]).
64. At times, where a respondent (proprietor) has filed an SD with a view to proving the alleged use of the mark, the applicant (for revocation) may not have direct evidence which has the effect of contradicting the respondent’s evidence. In such circumstances (and I am by no means suggesting that it is the case here), the applicant may choose not to file an SD in reply. Cross-examination may be a more appropriate mechanism for challenging the respondent/proprietor’s evidence.
65. For the reasons above, the fact that the Applicant did not file any evidence in reply (although it could have done so), is not a factor that I consider to be relevant in assessing whether to allow cross-examination. My decision is not inconsistent with the Circular because the ‘*Examples where a request of cross-examination may not be allowed*’ is meant for illustrative purposes only. (The words used are “*may not*” as opposed to ‘will not’.)
- (C) The Registrar will allow cross-examination for cases falling under the heading ‘*Examples where a request for cross-examination will be allowed*’ in page 2 of the Circular
66. As touched on in [29] above, cross-examination is not an automatic right in trade marks proceedings before IPOS. The phrase “*unless the Registrar otherwise directs*” in Rule 69(3) TMR makes it clear that the Registrar retains the discretion as to whether to (dis)allow cross-examination. When should this discretion be exercised? The Circular

provides that for each request “*The Registrar will need to be satisfied that cross-examination will facilitate the just, expeditious and economical disposal of the proceeding (Rule 36A(1))*”.

67. The above notwithstanding, the Circular sets out ‘*Examples where a request for cross-examination will be allowed*’. They are:

- “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 [statutory declaration(s)]*
2. *Where the party seeking cross-examination has reason to believe that the deponent’s [statutory declaration] 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”*

(emphasis added)

Although the heading indicates that cross-examination “*will be allowed*” for cases falling within the scenarios identified above, the Registrar must ultimately be satisfied that the requirements set out in the portions underlined above have been met. Since the Registrar cannot decide *in vacuo*, it is important for the party (or parties) seeking cross-examination to put forth the requisite particulars to enable the Registrar to come to a conclusion as to whether the requirements have been met, having regard to the overarching principle that cross-examination on the issues “*will facilitate the just, expeditious and economical disposal of the proceedings*”.

68. For instance, in example 2, it is not sufficient for the applicant seeking cross-examination to allege that the deponent’s SD contains unreliable evidence. The applicant must provide sufficient particulars so as to enable the Registrar to decide whether the allegedly unreliable evidence is relevant to the issues in dispute. If the allegedly unreliable part of the deponent’s evidence is immaterial to the issues in dispute (e.g. the evidence relates to a ground of opposition that has been abandoned), then cross-examination will not be allowed.
69. So too, in example 3, the applicant seeking cross-examination must give particulars so as to enable the Registrar to assess whether cross-examination would assist in clarifying the situation. Consider the following illustration: X’s SD contains a statement to the effect that the respective parties’ marks are dissimilar. Y’s SD contains a statement to the effect that the respective parties’ marks are similar. X and Y both apply to cross examine each other on the issue of similarity of marks. Cross-examination will not be allowed, because similarity of marks is an issue for the Registrar to decide and allowing cross examination would not assist in clarifying the issue. But unless the parties specify

that the part of the evidence in conflict is the issue of ‘similarity of marks’, the Registrar would not be able to make a decision.

70. I should also add that the examples given in the Circular for when cross-examination “*will be allowed*” are not meant to be exhaustive in nature. Equally, the examples in the Circular for when a request for cross examination “*may not be allowed*” are non-exhaustive. There are likely to be some cases in which none of the illustrations apply. Or, there may be cases which fall on the borderline. Ultimately, the onus is on the party seeking cross-examination to put forth sufficient information (e.g. by adequately particularising the issues on which cross-examination is sought) to enable the Registrar to decide one way or the other, having regard to the guidance in the Circular. In approaching each case, the Registrar will be mindful of, *inter alia*, the part of the Circular<sup>20</sup> which states that: a “*request for cross-examination is likely to be allowed where it is not disproportionate and unnecessarily costly and burdensome*”<sup>21</sup>; and “*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*”.
71. With that, I now return to the present case.
72. In the course of tendering further written submissions, the Applicant helpfully referred me to a case from the UK IPO, *Salzer Electronics Ltd v Yueqing Electric* (O-008-16), wherein one formulation of the test was whether the issue on which cross-examination is sought “*is likely to be material and affect the outcome of these proceedings*” (The Circular is closely modelled on the UK IPO’s Trade Marks Manual at 6.8.3 and I consider the decisions and observations of the UK IPO Hearing Officer on this point to be of guidance.)
73. In the Applicant’s Further Written Submissions, it provided the following reasons for requesting cross-examination:
- “(a) *The witnesses are direct and/or rebuttal witnesses and have put forward evidence purporting to show genuine use of [the Mark] in Singapore during the relevant period.*
- “(b) *We wish to question the witnesses on their statements and to test the credibility of their claims and purported evidence that watches bearing the Mark were sold to customers in Singapore during the relevant period.*
- “(c) *There is genuine concern as to the credibility, authenticity, relevance, and weight of the evidence as there are apparent contradictions, gaps, additions, changes,*

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<sup>20</sup> See Circular at p 2.

<sup>21</sup> These factors (*i.e.* “*disproportionate*”, “*unnecessarily costly*” and/or “*burdensome*”) can also be managed by the Registrar through limiting the issues on which a witness may be cross-examined as well as the time permitted for cross-examination.



*irregularities, unclear markings, and other inconsistencies which can only be addressed through cross-examination of the evidence.*

*(d) The Respondent has the burden of proof (per Section 105, Trade Marks Act). A decision in its favour cannot be made solely on the basis of alleged evidence of use where such evidence is in dispute. The witnesses should be able and willing to cooperate in verifying facts which are solely within their personal knowledge.”*

74. I consider the above to be valid reasons for the request, having regard to the guidance provided by the Circular (in particular examples 2 and 3) and also the test of whether the issue on which cross-examination is sought “*is likely to be material and affect the outcome of these proceedings*”<sup>22</sup>. The central issue in dispute is whether there has in fact been genuine use of the Mark and now that the Respondent has put forth evidence in support of its position through its Witnesses, the Applicant should not be deprived of the opportunity of challenging the evidence of the Witnesses directly, via cross-examination. In this regard, and as stated in [65] above, the fact that the Applicant did not file an SD in reply should not prejudice its application to cross-examine.
75. I stress that in arriving at this conclusion, I make no finding on the reliability of the evidence set out in the Witnesses’ SDs, or on whether the evidence is conflicting; such issues are not before me for the purposes of this interlocutory application. All that I need to satisfy myself is that allowing cross-examination will facilitate the just, expeditious and economical disposal of the proceedings and I am satisfied that that threshold has been crossed.

(D) The level of specificity required by the Registrar

76. Having regard to the nature of IPOS as a low-cost tribunal, even if cross-examination is allowed, untrammelled latitude to cross-examine a witness will *not* be granted. In deciding how cross-examination should be limited (or delineated) the principle that “*the Registrar will need to be satisfied that cross-examination will facilitate the just, expeditious and economical disposal of the proceedings (Rule 36A(1))*” will also apply. In order to arrive at a decision, a party seeking cross-examination has to provide the Registrar with sufficient details and/or particulars regarding the areas or issues on which cross-examination is sought to be conducted.
77. In the present case, the Applicant provided the following statement at first instance<sup>23</sup>:

*“... The Registrar will benefit from having cross-examination of certain parts of the witnesses’ Statutory Declarations undertaken as it will show forth whether the witnesses (including what the relationship is between them), the claims they have made,*

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<sup>22</sup> See [72] above.

<sup>23</sup> See [14] above and Applicant’s letter dated 11 March 2016.

*and evidence they have submitted are credible and can be relied upon. All of this is relevant to the Registrar’s assessment of whether the [Respondent’s] claim of genuine use in the course of trade in Singapore of the subject trade mark (within the meaning of the Trade Marks Act) and their evidence can be supported...”*

In effect, all the Applicant has said is that cross-examination will touch on the evidence of the witnesses, their relationship, and their credibility. Such a statement is, with respect, so broad that it does not assist the Registrar. It is not sufficient to simply say that the foregoing “*is relevant to the Registrar’s assessment*” without explaining *how* or *why* it is relevant.

78. That being said, I accept that parties should *not* be required to particularise their requests in the form set out in IPOS’ letter to the parties dated 18 March 2016 (which was meant for illustrative purposes only):

*Witness Name: Tan Jee Liang (NRIC No. [redacted])*

<b><i>Issue(s)</i></b>	<b><i>Relevance</i></b>
<i>Whether the tax invoices as stated at paragraph 8 of 1st Vache may have been created for the purpose of these proceedings</i>	<i>To determine the credibility of the Proprietor’s evidence”</i>

For the avoidance of doubt, the Registrar does not require a specific list of questions that will be asked during cross-examination.

79. What then is the standard that should be applied? How specific must one be in applying for leave to cross-examine? As the Applicant rightly points out, too much, and the witness becomes forewarned and cross-examination is unlikely to serve its intended purpose. On the other hand, if too few details are provided, the Registrar may face difficulty in deciding whether or not to allow cross-examination in the first place (and if so, on what scope).
80. To my mind, the answer is contained in items 3 and 4 on page 1 of the Circular. In brief, a party seeking cross-examination must not only list the specific issues to which cross-examination is sought, but also explain why those issues are relevant to the matters being decided on. Put another way, the extent of specificity that is required is that which enables the Registrar to make a decision on whether the issue on which cross-examination is sought is relevant (and if so, to what extent).
81. In the UK IPO’s decision in ***eBay Inc. v Dotcom Retail Limited*** (O/347/14), eBay sought to invalidate Dotcom’s registrations for BEAUTY BAY and BEAUTYBAY (in a series of two marks), and BEAUTYBAY.COM. Dotcom’s founder was cross-

examined in relation to the issues of: his “*reasons and intentions in adopting the BEAUTYBAY mark*”; his “*subsequent use of the marks*”; “*whether he had due cause to use the marks*”; “*whether the marks are linked with eBay’s mark*”; and “*whether there is unfair advantage of, or detriment to, eBay’s mark*”. Although I express no view as to whether I would have allowed cross-examination on all of those issues, I consider that framing the issues along those lines would indeed be helpful in allowing me to make a decision one way or the other.

82. In the UK IPO’s decision in *Ecotrade Europe Ltd v Kyle Martin (LA WEAVE)* (O-280-16) (“*LA WEAVE*”), a trade mark opposition case, an issue arose as to the use of the mark LA WEAVE. The Hearing Officer limited the scope of cross-examination of the opponent’s witnesses to the specific issue of “... *when the witnesses first became aware of use of LA Weave and whether and when they first used that term themselves in relation to which goods/services*”. The Hearing Officer also limited the scope of cross-examination of the trade mark applicant’s witness to the specific issues of “(a) *whether LA Weave was already in common use at the date it was adopted by the applicant (and, if so, in relation to what), and (b) the nature of the applicant’s licences*”. This shows, *inter alia*, that the scope of cross-examination may be very restricted to very specific issues only.

83. In the Applicant’s Further Written Submissions, it reiterates that the essence of non-use revocation proceedings is the question of whether the mark has been used. The Applicant cited *Cheaney Shoes Limited v Widdy Trading Pte Ltd* [2015] SGIPOS 12 (“*Cheaney Shoes*”) wherein the learned Hearing Officer adopted the following approach to the question of non-use (at [16]):

What: Did the use relate to the mark?

Where: Did the use take place in Singapore?

When: Did the use take place within the relevant time?

Which: Was the use in relation to the goods/services for which the mark is registered?

How: Was the use in the course of trade?

Who: Was the use by the proprietor or with his consent?

84. Having regard to those questions ‘what’, ‘where’, ‘when’, ‘which’, ‘how’ and ‘who’, the Applicant formulated a fresh list of issues (*i.e.* the Applicant’s List of Issues for Cross-Examination), as follows.

- a. Where was the Mark applied?
- b. Was the alleged use of the Mark in Singapore?
- c. Was the alleged use within the relevant period of time?
- d. Was the alleged use in the course of trade?
- e. How was the Mark allegedly used (nature of the purported use and sales)?
- f. Is the Respondent’s evidence and that of its witnesses reliable?

g. Does the evidence submitted support the Respondent's claim of genuine use of the Mark in the course of trade in Singapore within the relevant term?

85. I accept that the 'what', 'where', 'when', 'which', 'how' and 'who' questions in *Cheaney Shoes* are relevant and useful to the key material issue of non-use. I find the Applicant's List of Issues for Cross-Examination to be satisfactorily particularised and in compliance with the Circular. As framed, the issues provide adequate focus, while allowing sufficient room for cross-examination.
86. I also note that although the Respondent had 2 weeks to object to the Applicant's List of Issues for Cross-Examination if he wished to do so, no objections were received. In the Respondent's Further Written Submissions (filed at the same time as the Applicant's Further Written Submissions), he urged me not to allow the Applicant yet another opportunity "*to cure its failure to provide sufficient particularisation*", especially since it had multiple opportunities to do so beforehand (including when formal directions were issued by way of a letter from IPOS dated 18 March 2016 asking that the Applicant provide particulars).
87. While I am sympathetic to the Respondent's position, as noted below at [95] – [96], the circumstances in the present case are exceptional. I am of the view that disallowing cross-examination altogether would not be in the interests of a just, expeditious and economical disposal of the proceedings. After all, the overarching issue which the Hearing Officer will have to decide at the main hearing is whether there has been genuine use of the Mark and the Applicant should not be deprived outright of the opportunity to challenge the Respondent's evidence in cross-examination. And, the Hearing Officer is also likely to benefit from the oral evidence of the Witnesses elicited during cross-examination. Balancing the considerations, I allow cross-examination in respect of the Applicant's List of Issues for Cross-Examination, but award costs to the Respondent.

(E) Quantum of costs to be awarded to the Respondent

88. I have reviewed the correspondence leading up to the instant interlocutory decision. To put it bluntly, the interlocutory application appears to have been triggered by a series of unfortunate misunderstandings. It seems that one (or both) of the parties may have misconstrued one (or more) of the Learned AR's letters of 3 February 2016, 18 February 2016, 10 March 2016 and 18 March 2016 as containing a final decision or directions. (I have explained at [25] – [28] above why this was not the case.) In particular, it appears that the Applicant misinterpreted the Learned AR's letter of 18 March 2016 as setting a standard of specificity (of issues for cross-examination) which the Applicant had to comply with, when in reality the Learned AR was providing an example of what the Applicant could do (as indicated by, *inter alia*, the words in bold: "*strictly for illustrative purposes*").

89. Regrettably, the Applicant elected to reply to the Learned AR's letter of 18 March 2016 by requesting for a hearing without providing a revised particularised list of issues (despite being invited to do so) or attempting to resolve the issue via further correspondence. If the Applicant had chosen either (or both) of those aforesaid courses of action, there may not have been a need for this interlocutory hearing. The fact that the Respondent *could have* objected to the Applicant's List of Issues for Cross-Examination within 2 weeks, but did not do so, further reinforces my view. Under the Scale of Costs in the Fourth Schedule of the TMR, the range of costs that may be awarded for interlocutory proceedings are: S\$50 – S\$500 for “*preparing for*” the interlocutory proceedings and S\$50 – S\$500 for “*attendance*” at the interlocutory hearing. Having regard to all of the circumstances, I fix costs in respect of this interlocutory application at S\$1,000 (including disbursements), to be paid by the Applicant to the Respondent by 17 November 2016.

(F) Cross-examination is to be limited by time

90. As regards the time for cross-examination, I am mindful that reasonable latitude should be given to a party to conduct cross-examination, having regard to the nature and complexity of issues and number of witnesses.

91. That said, it is important to appreciate that hearings at IPOS are different from full trials for matters commenced by writ in the High Court. Among the differences, one I consider to be relevant to the instant case is the fact that in order to give effect to IPOS' value proposition as a low cost tribunal, under the Scale of Costs in the TMR the maximum possible costs for attendance at a full hearing is S\$ 800 and the Registrar has no discretion to award any higher costs. Consonant with the foregoing is the practice of fixing hearings at IPOS at half a day, or a full day at most. In contrast, under the Supreme Court Costs Guidelines, the ‘Daily Tariff’ for party-and-party costs awards for “Intellectual Property” trials lasting 1 to 5 days is S\$ 20,000 – S\$ 30,000 per day<sup>24</sup>. Although the actual award for High Court trials may vary (e.g. it is arguable that cost awards for complex patent cases should fall on the higher end of the scale as opposed to a relatively straightforward trade mark infringement case), the point remains that costs awards for hearings at IPOS are much smaller in comparison.

92. It is interesting to note that under Order 108 rule 5 ROC, which applies to civil proceedings commenced by writ on or after 1 November 2014 before a Magistrates' Court or a District Court, one of the directions that the court can give is for a ‘simplified trial’ (see Order 108 rule 5(1)(a) ROC). Order 108 rule 5(5) ROC further provides that for simplified trials, there is a time limit of 60 minutes for cross-examination (per witness), although the court has the discretion to extend this time if it deems fit (see Order 108 rule 5(6) ROC). The purpose of Order 108 ROC is stated in rule 3, which is to “*facilitate the fair, expedient and inexpensive determination of all civil proceedings*”

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<sup>24</sup> See in particular, p 3.

to which this Order applies, in a manner which is proportionate to – (a) the amount of the claim; (b) the number of the parties; (c) the complexity of the issues; (d) the amount of costs likely to be incurred by each party; and (e) the nature of the action”. Since IPOS’ adjudicatory function is somewhat similar (albeit limited to the specific disputes which it has the power to hear), I consider it not inappropriate to take guidance from these rules for simplified trials. In my judgment, 60 minutes per witness for cross-examination at IPOS is a fair guideline.

93. I also observe that in the UK IPO the general practice is not to allow lengthy cross-examination. For instance, in *LA WEAVE*, cross-examination was limited to 30 minutes (for the main witness) and 15 minutes (for each of the other witnesses).
94. In the instant case the Applicant has sought 6 hours for cross-examination. It has urged me to take into account “*the number of witnesses, length of the statutory declarations, number of attachments entered into evidence, complexity of the evidence on record, the fact that evidence on record is not self-explanatory, and the fact that the evidence on record is contradictory*”<sup>25</sup>. However, having regard to the principles set out above as applied to the scope of issues for which cross-examination is allowed, I am minded to allow no more than 3 hours for 3 witnesses, a length of time which I consider to be eminently reasonable in the circumstances. This would take about half a day, leaving half a day for oral submissions. Nevertheless, if it appears during the full hearing that additional time for cross examination should be allowed, the Hearing Officer may exercise discretion to allow such additional time as may be fair, just and reasonable in the circumstances.

## VII. CONCLUDING REMARKS

95. I have allowed cross-examination in respect of the Applicant’s List of Issues for Cross-Examination (which at my invitation was) set out in its Further Written Submissions because these are *exceptional circumstances*. To be fair, the Circular is relatively new and the requirement for a party seeking cross-examination to provide details on, *inter alia*, the “*Reasons why cross-examination... is requested*”, the “*Specific issues to which cross-examination would, if allowed, be directed*”, and an “*Explanation of the relevance of those issues to the matters to be decided*” is unique in the sense that there is (as far as I am aware) no equivalent practice whether in the Supreme Court or in the State Courts of Singapore. Moreover, there are no prior IPOS decisions touching on, or giving guidance as to, how a request for cross-examination (and a list of issues and explanation of their relevance) should be framed.
96. Moving forward, absent extenuating circumstances, future IPOS tribunals are unlikely to be so indulgent in giving a party multiple opportunities to cure a failure to comply with the requirements set out in the Circular.

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<sup>25</sup> Applicant’s Further Written Submissions at p 10.

**Legislation referred to:**

Building Maintenance and Strata Management Act (Cap. 30C)  
Evidence Act (Cap. 97), ss 2(1), 3(1), 140(1)  
Patents Act (Cap. 221), s 8  
Registered Designs Act (Cap. 266), s 58  
Rules of Court (Cap. 322, R 5), O 1 r 2, O 38 r 1, O 41 r 5, O 108 r 5  
Trade Marks Act (Cap. 332), ss 22(1)(a), 62(2), 71, 75(3), 105  
Trade Marks Rules (Cap. 332, R 1), rr 36A(1), 58(3), 59(1A)(e)(ii), 69(1), 69(1A), 69(3), 75(2),  
and Fourth Schedule (Scale of Costs)

**Cases referred to:**

*Application for Cross-Examination by PT Eigerindo Multi Produk Industri and Objection Thereto by Sports Connection Pte Ltd* [2014] SGIPOS 2  
*Cheaney Shoes Limited v Widdy Trading Pte Ltd* [2015] SGIPOS 12  
*eBay Inc. v Dotcom Retail Limited* (O/347/14)  
*Ecotrade Europe Ltd v Kyle Martin (LA WEAVE)* (O-280-16)  
*HSBC Trustee (Singapore) Ltd v Lucky Realty Co Pte Ltd* [2015] 3 SLR 885  
*Lucky Realty Co Pte Ltd v HSBC Trustee (Singapore) Ltd* [2016] 1 SLR 1069  
*Lonza Biologics Tuas Pte Ltd v Genpharm International Inc* [2015] SGIPOS 13  
*Martek Biosciences Corp v Cargill International Trading Pte Ltd* [2011] 4 SLR 429  
*MCI Group Holding SA v Secondment Pty Ltd* [2014] SGIPOS 15  
*Salzer Electronics Ltd v Yueqing Electric* (O-008-16)  
*Yap Sing Lee v MCST Plan No 1267* [2011] SGHC 24

**Textbooks referred to:**

Jeffrey Pinsler, S.C., *Evidence and the Litigation Process (5<sup>th</sup> Ed)*, (Lexis Nexis 2015) at [1.045], [1.046]

**Other materials referred to:**

Supreme Court Practice Directions, Appendix G (Costs Guidelines)  
IPOS HMG Circular No. 2/2011  
IPOS HMG Circular No. 3/2015  
IPOS HMG Circular No. 4/2015  
UK IPO Trade Marks Manual, para 6.8.3

**Representation:**

Ms Francine Tan (Francine Tan Law Corporation) for the Applicant  
Ms Denise Loh and Ms Nurul Asyikin (Ella Cheong LLC) for the Respondent