

Intellectual Property Office of Singapore Case Summary: Consolidated Artists B.V. v The Faceshop Co., Ltd [2016] SGIPOS 7

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The Opponents (Respondents), Consolidated Artists B.V., objected to the Applicants' (The Faceshop Co., Ltd) evidence on the basis that:

- (i) the Applicants' 1st Evidence is invalid and inadmissible as it was not in compliance with Rule 69(1A) of the Trade Marks Rules (Cap 332, 2008 Rev. Ed) ("TMR") which renders Order 41 rule 1(7) and Order 41 rule 11(2) of the Rules of Court ("ROC") applicable (with the necessary modifications);
- (ii) the Applicants' subsequent evidence (the Applicants' 2nd and 3rd Evidence as directed by the Registrar to be re-filed to rectify the above irregularity) were not identical in content to the Applicants' 1st Evidence as directed by the Registrar.

The Registrar allowed the irregularity in relation to the evidence filed by the Applicants to be cured on the following basis.

Rule 83 of the TMR 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.

The Applicants' 1st Evidence was filed with the following irregularities in relation to form:

- (i) The Applicants' 1st 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 (in breach of Rule 69(1A) TMR read with Order 41 rule 1(7) ROC).
- (ii) The exhibits to the Applicants' 1st Evidence were not identified by a certificate of the person before whom the affidavit is sworn (in breach of Rule 69(1A) TMR read with Order 41 rule 11(2) ROC).

As directed by the Registrar, the Applicants' 2nd Evidence was duly notarized in accordance with Rule 69(1A) read with Order 41 rule 1(7) and rule 11(2) such that the original procedural irregularities have been *cured*. However the contents of the Applicants' 2nd Evidence (and thereafter Applicants' 3rd Evidence) were not identical to the Applicants' 1st Evidence as directed by the Registrar.

The Applicants submitted that the discrepancies were entirely due to inadvertent clerical errors. that there is no bad faith or dishonest conduct on their part, and that there was no intention on the Applicants' part to disregard the Registrar's directions.

To illustrate, the discrepancies between the Applicants' 1st Evidence and the Applicants' 3rd Evidence are as follows:

- (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;

According to the Applications, the addition/exclusion of pages was the result of scanning errors; 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.

Importantly, these errors do not substantially affect, in particular, the Opponents' Evidence in Reply. The points and rebuttals made in the Opponents' Evidence in Reply can similarly apply to the Applicants' 3rd Evidence, subject to the need for a supplementary statutory declaration to clarify that the Opponents' Evidence in Reply is applicable to the Applicants' 3rd Evidence rather than the Applicants' 1st Evidence.

Thus, 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. In light of the above, 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 is also prepared to award costs for the preparation of the supplementary statutory declaration.

By drawing the above conclusions, the Registrar is not condoning the Applicants' conduct (of inadvertence) nor is the Registrar belittling the Opponents' effort. 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.

In light of the above, the Registrar directs that:

- (i) the Applicants' 3rd Evidence be accepted for the purposes of the current opposition proceedings;
- (ii) the Opponents be directed to file a supplementary evidence to clarify that the Opponents' Evidence in Reply also addresses the Applicants' 3rd Evidence and
- (iii) costs in the total amount of **\$3,400** are awarded to the Opponents for
 - a. Reviewing the Applicants' 1st, 2nd and 3rd 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' 3rd Evidence.

Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <https://www.ipos.gov.sg/resources/hearing-mediation>.