

Intellectual Property Office of Singapore Case Summary: *Application for Cross-Examination by FMTM Distribution Ltd and Objection Thereto by Tan Jee Liang trading as Yong Yew Trading Company [2016] SGIPOS 9*

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The Respondent (Tan Jee Liang trading as Yong Yew Trading Company) is the registered proprietor of the following

Casa Blanca

CASA BLANCA

trade mark (TM No. T0700270D) (the “**Mark**”). The Applicant (FMTM Distribution Ltd) applied to revoke the Mark on the basis of non-use.

Four deponents, including the Respondent in person, gave evidence in support of the Respondent by way of statutory declaration (“**SD**”). Out of the four deponents, the Applicant sought to cross-examine three (hereinafter “**the Witnesses**”), asserting among other things that the statements in the Witnesses’ SDs were internally conflicting and inconsistent.

Under HMG Circular No. 4/2015 (the “**Circular**”), which came into effect on 30 July 2015, a party that wishes to cross-examine any witness on his SD must make a request to do so. The Circular also provides guidance as to how a request for cross-examination may be made, the requirements which the request should comply with, and the circumstances which the Registrar takes into account in deciding whether to allow the request.

A dispute arose as to: (a) whether the Applicant’s request met the requirements set out in the Circular; and (b) whether the request should be allowed by the Registrar (and if so, on what conditions).

The Applicant was dissatisfied with certain statements in a letter from the Registrar to the parties dated 18 March 2016. Instead of responding to the Registrar’s request for further particulars regarding the issues on which cross-examination was sought, the Applicant requested for a formal interlocutory hearing.

During the oral hearing, the Respondent argued that cross-examination should not be allowed because: (a) 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) of the Trade Marks Rules (Cap. 332, R 1) (“**TMR**”) as read with the Circular; and (b) that the Applicant’s assertion that the Respondent’s evidence was internally conflicting and inconsistent could have been addressed by way of SD. (The Applicant could have filed a Reply SD but it did not do so.) In addition, a question arose as to the applicability of the Evidence Act (Cap. 97) (“**EA**”) to IPOS proceedings.

The Applicant was given the opportunity to provide a revised list of issues for cross-examination in line with the Circular after the oral hearing. The Respondent was allowed to respond if he had any objections to the Applicant’s revised list of issues.

The Applicant’s revised list of issues for cross-examination were 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? (Collectively, the “**Applicant’s List of Issues for Cross-Examination**”). The Respondent did not object to these questions.

The Registrar’s Grounds of Decision (“**GD**”) was issued on 17 October 2016.

Interlocutory case management procedure at IPOS (see paragraphs [25] to [27])

In the GD, the Registrar first clarified certain aspects of interlocutory case management procedure at IPOS. In brief, there are two categories into which interlocutory disputes at IPOS may fall. The First Category is for applications for extensions of time made within the relevant prescribed period (i.e. where the deadline to apply for an extension is

stipulated by a Rule in the TMR or the Registrar). For this First Category, the Registrar may issue a final decision informing parties that an extension is granted. The Second Category is for all other interlocutory disputes apart from First Category cases. Under the Second Category the Registrar generally does not issue a final decision at the outset unless parties mutually agree to a certain outcome. Instead, a multiple step process is employed. The First Step is to explore the possibility of resolution via consent. The Second Step comes in when parties are unable to resolve their differences by the end of the stipulated timeline for the First Step. Under the Second Step, the Registrar will put forward a Preliminary View (containing a tentative decision or directions) and parties will be given an opportunity to respond. If no objections are received by the stipulated date, the Preliminary View becomes final. If however objections are received to the Preliminary View, the matter moves to the Third Step. Under this Third Step the Registrar may adopt one of the following approaches: (a) issue a fresh Preliminary View and give parties a further opportunity to respond; or (b) indicate that notwithstanding the objections the Registrar is not inclined to deviate from the earlier Preliminary View. The Registrar made it clear that in the instant case the dispute fell into the Second Category and that no final interlocutory decision was made by the Registrar (whether in the letter of 18 March 2016 or in any of the other letters).

Principles applicable to cross-examination at IPOS (see paragraphs [57] to [87] and [90] to [94])

The Registrar observed that an SD plays a different role from that of cross-examination in IPOS proceedings. The purpose of an SD is to present evidence, not as a medium for legal submissions or as a substitute for cross-examination. Thus, the fact that the Applicant did not file evidence in reply (although it could have done so) was not a relevant factor to be taken into account in assessing whether to allow cross-examination.

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, and will need to be satisfied that cross-examination will facilitate the just, expeditious, and economical disposal of the proceedings. 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 in this regard. The examples given in the Circular for when cross-examination will or will not be allowed are not exhaustive in nature. In approaching each case, the Registrar will be mindful of the principles stated in the Circular, including that a “*request for cross-examination is likely to be allowed where it is not disproportionate and unnecessarily costly and burdensome*” and that “*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*”. The test of whether the issue on which cross-examination is sought “*is likely to be material and affect the outcome of these proceedings*” is of guidance. Even if cross-examination is allowed, untrammelled latitude to cross-examination will not be granted. The Registrar will limit or delineate cross-examination by issues as well as by the time allocated for cross-examination.

As regards the issue of specificity required (i.e. the extent to which the issues for cross-examination had to be particularised), the Registrar held that the extent of specificity that is required is that which enables the Registrar to make a decision on whether the issue of whether cross-examination is sought is relevant (and if so, to what extent).

On the facts, the Registrar found that the manner in which the Applicant’s List of Issues for Cross-Examination had been particularised was relevant, satisfactory, and useful to the key material issue of non-use. Thus the Registrar allowed cross-examination in respect of those issues. However, the Registrar limited cross-examination to 1 hour per witness (i.e. 3 hours in total), which may be extended in the Hearing Officer’s discretion. The Registrar also awarded costs to the Respondent, fixed at S\$1,000 (including disbursements), since there may not have been a need for the interlocutory hearing if the Applicant had responded to the Registrar’s request for further particulars and/or sought to resolve the issue through correspondence.

Applicability of the Evidence Act and the Rules of Court (see paragraphs [33] to [56])

Given the Registrar’s decision to allow cross-examination, there was no need to decide on the applicability of the EA or the Rules of Court (Cap. 322, R 5) (“**ROC**”) to IPOS hearings. However, the Registrar was inclined to the provisional view that the ROC is inapplicable to IPOS proceedings, while acknowledging that it is open to parties to mutually agree to apply certain provisions in the ROC to their dispute.

As regards the EA, the Registrar was inclined to the provisional view that SDs filed for the purposes of IPOS proceedings are not subject to Parts I, II and III of the EA. However, in the Registrar’s provisional opinion, 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.

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>.