Intellectual Property Office of Singapore
Hearings & Mediation Department

Compendium of Hearings & Mediation Department Circulars

(1st Ed: 12 March 2020, Last Revised 10 January 2025)

First Published: 12 March 2020
Last Updated: 15 October 2025

IMPORTANT NOTICE

What is this document?

The Compendium of Hearings & Mediation Department Circulars (or "Compendium" for short) is a compilation of all Hearings & Mediation Department ("HMD") Circulars that are currently in effect.

In other words, the Compendium is not in itself an HMD Circular. Rather, it houses all of the applicable HMD Circulars within a single stand-alone document.

What happened to the previous HMD Circulars?

The Circulars in this document supersede all Circulars (also sometimes referred to as Practice Circulars) issued by the Hearings & Mediation Department (also previously known as the "Hearings and Mediation Group" or "HMG") before 12 March 2020.

For the avoidance of doubt, all HMD Circulars in effect before 12 March 2020 ("Legacy Circulars") have been superseded with effect from 12 March 2020, but remain accessible at the URL https://www.ipos.gov.sg/manage-ip/resolveip-disputes-overview/circulars-and-news.

Effect of HMD Circulars in this Compendium

Unless otherwise stated or the Registrar directs otherwise in the context of any particular dispute, the Circulars in this document apply to all trade mark disputes at IPOS before the Hearings & Mediation Department, including those commenced prior to 12 March 2020.

Structure of Compendium

Part I of the Compendium contains a brief glossary of terms which frequently arise in IPOS disputes.

Part II contains the current HMD Circulars structured into the following 7 Categories: (1) Pleadings Circulars; (2) Filing and Service Circulars; (3) Case Management Conference Circulars; (4) Evidence Circulars; (5) Hearings Circulars; (6) Costs Circulars; and (7) Other Circulars.

Each Category houses one or more HMD Circulars. For example, Category 3 "Case Management Conference Circulars" presently contains 2 HMD Circulars. The first is HMD Circular 3.1 "What is a case management conference?" and the second is HMD Circular 3.2 "Deadlines to file evidence and extensions of time to file evidence".

At the end of the Compendium is a Change Log which records the changes to the Compendium.

What happens if there are updates to HMD Circulars in this Compendium?

Any new HMD Circulars issued by the Registrar will be entered into this Compendium under one of the existing 7 categories and will be assigned a new number. Existing Circulars will always retain their existing numbers even if there are new Circulars or amendments to them.

All relevant changes will be recorded in the Change Log.

Are the HMD Circulars in the 1st Edition of the Compendium different from the pre-12 March 2020 Legacy Circulars?

For the most part, there is no substantive change to the applicable practice and procedure compared to the pre-12 March 2020 position. However, where necessary and appropriate, the Registrar has issued new or updated guidance in relation to certain aspects of practice and procedure. Practitioners should therefore take care to familiarise themselves with the HMD Circulars in this Compendium.

Are HMD Circulars binding?

HMD Circulars supplement the legislation by regulating and providing guidance as to salient facets of practice and procedure. They apply to all matters before the tribunal but do not have legislative force. Although HMD Circulars are not formally binding, parties are expected to comply with the guidance within.

How to make a reference to the HMD Circulars in the Compendium

To make reference to a particular point of practice or procedure within an HMD Circular in this Compendium, the HMD Circular No. and the heading should be cited. Page numbers do not need to be cited. For example, to refer to the practice in relation to the calculation of the period of non-use in a revocation application, please cite **HMD Circular 1.5 at D.** (HMD Circular 1.5 refers to “Relevant dates in revocations on grounds of non-use” and the heading D refers to “Period of Non-Use”).

References to Legislation

Any cited legislation refers to the edition that is currently in force.

Abbreviations Used

- Trade Marks Act 1998 (“TMA”)
- Trade Marks Rules (Cap. 332, R 1) (“TMR”)
- Notice of Opposition (“NO”)
- Counter-statement (“CS”)
- Statutory Declaration (“SD”)
- Geographical Indications (“GI”)
- GI Rules 2019 (“GIR”)

Copyright and Legal Notice

TABLE OF CONTENTS

PART I

Glossary of commonly used identifiers

- **Applicant**: broadly refers to any party making an application to the Registrar. In practice, the meaning of "Applicant" is context dependent:

    - In trade mark opposition proceedings, "Applicant" refers to the party seeking to obtain registration of its trade mark.

    - In invalidation or revocation cases, "Applicant" is synonymous with "Initiator" (see below).

    - In interlocutory proceedings, "Applicant" refers to the party seeking relief and/or the exercise of the Registrar's discretion in its favour.

- **Hearing Officer**: refers to the Principal Assistant Registrars (PAR) and Assistant Registrars (AR) presiding over an interlocutory or final hearing.

- **Initiator**: refers to any party which has commenced legal proceedings at IPOS.

- **IP Adjudicator**: refers to an individual who is appointed to hear IP disputes at IPOS on an *ad hoc* basis. IP Adjudicators are appointed to give parties to disputes the opportunity to have their cases heard by some of the best legal minds in the local IP field.

- **IPOS Digital Hub:** IPOS' one-stop electronic portal for conducting Intellectual Property transactions. It is accessible at the URL https://digitalhub.ipos.gov.sg.

- **Opponent**: broadly refers to any party resisting an application to the Registrar. In trade mark opposition proceedings, "Opponent" refers to the party seeking to oppose another party's application to register a trade mark.

- **Proprietor**: The term 'Proprietor', or 'Registered Proprietor', or 'Registrant', may refer to any party which owns any intellectual property right that is relevant to the dispute.

- **Registrar**: refers to the Registrar of Trade Marks. In practice, the Registrar's authority in contentious proceedings is delegated to Principal Assistant Registrars (PAR) and Assistant Registrars (AR) in the Hearings and Mediation Department (HMD), as well as IP Adjudicators in selected cases (see above).

- **Respondent**: refers to any party which defends or resists an application. For example, Respondent may refer to: (1) the Proprietor of a trade mark that is being attacked for non-use may be referred to as the Respondent; or (2) a party resisting an application to adduce further evidence.

PART II

HMD Circulars

1 PLEADINGS CIRCULARS

HMD Circular 1.1

1.1 Filing of notice of opposition by joint opponents

A. Introduction

Under the provisions relating to oppositions in the TMA and TMR, there is no prohibition against joint opponents opposing a trade mark application.

B. Filing procedure where there are joint opponents

Do I need to file more than one Form TM11?

No. Where there are joint opponents opposing the trade mark application, it is sufficient to file one Form TM11 because there is still only one opposition proceeding.

What should be indicated in Form TM11?

The particulars of the joint opponents opposing the registration of a particular trade mark must be indicated at "1.3 Initiator's Details" section of Form TM11.

What are the fees chargeable for Form TM11?

The applicable fees depend on the number of classes included in Form TM11.

C. How many sets of evidence will be required in an opposition filed by joint opponents?

Only one set of evidence needs to be filed because there is only one opposition proceeding. However, it must be clear from each SD that the deponent has been duly authorised by all the joint opponents to give such evidence on their behalf.

[End of HMD Circular 1.1]

HMD Circular 1.2

1.2 Amendments to Form TM11, Form TM28 and Form HC6

A. Introduction

The guidance in this Circular relates to amendments that may be made to Form TM11, Form TM28 (Application for Revocation or Declaration of Invalidity of Registration of Trade Mark) and Form HC6 (CS) in the course of opposition/ revocation/ invalidation proceedings before the Registrar.

Amendments may be allowed if it is fair and reasonable to do so. Depending on when the request to amend is made, different considerations apply.

B. Amendments before close of pleadings

The Registrar will in appropriate cases generally allow amendments to Form TM11 and Form TM28 before pleadings are deemed to be closed. Where the proposed amendments are allowed, the Registrar may grant an extension of time to the other party to file its CS and/or award such costs as may be just against the party seeking the amendments.

When are pleadings deemed closed?

Pleadings are deemed to be closed immediately upon the filing of Form HC6.

Amendments to CS

For avoidance of doubt, amendments to CS are always made after the close of pleadings. Heading C below applies where amendments of CS are made.

C. Amendments after close of pleadings

Where amendments are sought after pleadings are deemed to be closed, consent from the other party must first be sought. If there is consent from the other party, the Registrar will in appropriate cases generally allow the amendment and if necessary, issue such directions on the subsequent procedure as is deemed fit.

What happens if no consent is forthcoming?

Where there is no consent, leave of the Registrar must be obtained for any amendment after the close of pleadings. Whether leave would be granted depends on the facts and circumstances of each case.

What will be considered before leave is granted for the amendments?

In considering whether to grant leave for the amendments, the Registrar will conduct a balancing exercise, involving a consideration of the public interest that rules relating to procedure are complied with and the need to ensure that there is proper adjudication of a case based on its merits in the interest of justice between the parties.

In particular, the Registrar will carefully weigh the following *non-exhaustive* factors on a case by case basis:

(a) whether the party seeking the amendment could have claimed the particular ground/defence or cited the additional “earlier trade mark” earlier, when filing Form TM11, Form TM28 or Form HC6

(b) whether the amendment is necessitated by the pleading or evidence filed by the other party

(c) whether the other party would suffer any real prejudice which cannot be compensated with costs if the amendment is allowed

(d) whether allowing the amendment will facilitate the determination of the real question in controversy between the parties or whether the amendment is only a tactical manoeuvre and allowing the amendment would result in prejudice to the other party

(e) whether the amendment raises grounds or facts which the Respondent need not set out in reply, for example, the ground was not raised by the Initiator and is therefore inapplicable to the particular proceedings at hand

(f) the substantiality of the amendment

(g) the stage of the proceedings the amendment is sought.

D. Where leave to amend is granted

If leave to amend is granted, the Registrar may issue such necessary directions on the subsequent procedure as is deemed fit, including but not limited to:

(a) adjourning the case

(b) allowing amendments to be made to the CS by the other party

(c) granting extensions of time for the filing of further evidence by both parties

(d) awarding such costs as may be just against the party seeking the amendments.

[End of HMD Circular 1.2]

HMD Circular 1.3

1.3 Compliance with Rule 30(3) TMR: well known trade marks

A. Introduction

This Circular gives guidance where an Opponent relies on an “earlier trade mark which is well known in Singapore” in support of its opposition.

B. References

Section 2(7) TMA states:

> (7) Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into

account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

(a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;

(b) the duration, extent and geographical area of —

(i) any use of the trade mark; or

(ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied; …

Rule 30(3) TMR states:

(3) If registration is opposed on the ground that the mark is identical or similar to an earlier trade mark which is well known in Singapore, the following additional information must be included in the statement for the purpose of determining whether the trade mark is well known in Singapore:

(a) information on the use of the earlier trade mark; and

(b) information on any promotion undertaken for the earlier trade mark.

C. Non-compliance with Rule 30(3) TMR

If Rule 30(3) is not complied with, the Opponent will be directed to amend its grounds of opposition to comply with the requirement.

D. What can be included as additional information under Rule 30(3) TMR?

There are no pre-set requirements on the specific information needed to comply with Rule 30(3). Any relevant information will be accepted as long as the information relates to the use or promotion of the earlier trade mark; and it is "for the purpose of determining if the trade mark is well known in Singapore" as expressed in Rule 30(3). Any information provided under Rule 30(3) must, however, be more than that which is already required of earlier trade marks which are not registered nor pending registration under Rules 30(2)(b)(i)(B), 30(2)(b)(ii)(B), and 30(2)(b)(iii).

Non-exhaustive examples of relevant information

Non-exhaustive examples include:

(a) revenue figures for the earlier trade mark worldwide and in Singapore, if any

(b) promotion figures for the earlier trade mark worldwide and in Singapore, if any

(c) information on the duration of the use and promotion of the earlier trade mark

(d) information on the extent of the use and promotion of the earlier trade mark

(e) information on the geographical area of the use and promotion of the earlier trade mark.

Information can be descriptive

An example of descriptive information is:

> "Our well known mark has been used on clothing and footwear in 20 countries worldwide including the USA, UK, Germany, China and Singapore since 1990"

Information can be quantitative

Actual revenue and promotional figures qualify under this sub-heading.

E. Applicability to applications for declaration of invalidity

Where applicable, headings C and D above will apply to an application for invalidation under Rule 57(2B) TMR based on the ground that the registered trade mark is identical or similar to an earlier trade mark which is well known in Singapore.

[End of HMD Circular 1.3]

HMD Circular 1.4

1.4 Opposition to amendment of trade mark application after publication

A. Introduction

This Circular provides guidance for opposition to amendments made to published trade mark applications.

B. References

Section 14(3) TMA provides for what amendments may be made to an application for registration of a trade mark.

Rule 23 TMR provides for opposition to amendment of a trade mark application for registration which has been published, where the amendment affects the representation of the trade mark or the goods or services covered by the application.

Rules 23(1) and (2) TMR provide that the proposed amendment or a statement of the effect of the amendment shall be published for opposition purposes. The process for such opposition is similar to the process for opposing an application for registration under Rule 29 TMR. The same rules apply to these two types of oppositions (Rule 23(4) TMR).

A Rule 23 action opposes the amendment of an application (which will move on to registration) while a Rule 29 action opposes the registration of the application mark itself.

C. Opposition to a published amendment is not a re-opening of substantive opposition

An opposition under Rule 23 is confined to objections to the proposed amendment of an application. It is not meant to re-open the application to the possibility of opposition.

The publication of the amendment is not intended to extend the time for a prospective opponent to oppose the registration of a mark nor give it two bites of the cherry. Hence, if a prospective opponent had missed the deadline for opposition when the application was first published, and there is subsequently an amendment to the application which is then published, it cannot file an opposition within 2 months of the publication of the amendment.

What if the ground of opposition is directly attributable to the published amendment?

Only under this circumstance may a prospective opponent file an opposition. If, however, its grounds of opposition are levelled against the registration of the application mark, the prospective opponent should instead apply to invalidate the registration after the application mark has been registered.

D. Notice of Opposition (NO) against a published amendment

The NO must contain a statement of the grounds upon which the person opposes the amendment. Such grounds include:

(a) The amendment is contrary to Section 14(3) TMA because it does not correct the name or address of the Applicant or errors of wording or of copying or obvious mistakes

(b) The amendment is contrary to Section 14(3) TMA because it substantially affects the identity of the trade mark

(c) The amendment is contrary to Section 14(3) TMA because it extends the goods or services covered by the application

(d) The amendment to the trade mark will render it contrary to specific absolute or relative grounds under Sections 7 and 8 TMA, to be specified in the statement of grounds.

E. Application of the principle of res judicata

Where the substantive opposition to an application for registration has already been dealt with and results in an amendment which is published, it is not possible to revisit the issues raised in the substantive opposition by filing an opposition under Rule 23

TMR. The principle of *res judicata* applies. This means that a judicial decision is conclusive as between the parties.

The principle of *res judicata* was applied by the Registrar in *Campomar S.L. v Nike International Ltd and Another* [2004] SGIPOS 3. On appeal, the High Court in *Nike International Ltd and Another v Campomar S.L.* [2005] 4 SLR(R) 76 affirmed the application of this principle.

What recourse does an Opponent have if he disagrees with the Registrar's decision?

The Opponent may appeal to the High Court within the deadline to appeal. It is not for the Registrar to sit on appeal or review a decision that has been made by the Registrar on the same issues and between the same parties.

[End of HMD Circular 1.4]

HMD Circular 1.5

1.5 Relevant dates in revocations on grounds of non-use

A. Introduction

This Circular clarifies the relevant dates for an application for the revocation of a trade mark on grounds of non-use. It also sets out the necessary information that an Applicant for revocation should include in the grounds of revocation.

B. References

The periods of non-use and the effective date of revocation are set out in Section 22(1)(a) and (b), and Section 22(7) TMA respectively:

> (1) The registration of a trade mark may be revoked on any of the following grounds:
>
> (a) that, within the period of 5 years following the date of completion of the registration procedure, it has not been put to genuine use in the course of trade in Singapore, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
>
> (b) that such use has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non-use;
>
> …
>
> (7) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –
>
> (a) the date of the application for revocation; or

(b) if the Registrar or the Court is satisfied that the grounds for revocation existed at an earlier date, that date.

C. Grounds of revocation

The grounds of revocation must include the following:

(a) the Section of the TMA under which the application for revocation is filed

(b) the alleged period of non-use

(c) the effective date of revocation.

D. Period of non-use

How is the period of non-use calculated?

The period of non-use will depend on whether the application for revocation is filed under Section 22(1)(a) or (b).

The dates used to calculate the period of non-use are important as the earliest date that an Applicant can file his application for revocation is dependent on these dates.

As a starting point, the Applicant for revocation must identify the date of completion of the registration of the mark that is intended to be revoked.

Where can the date of completion of registration procedure found?

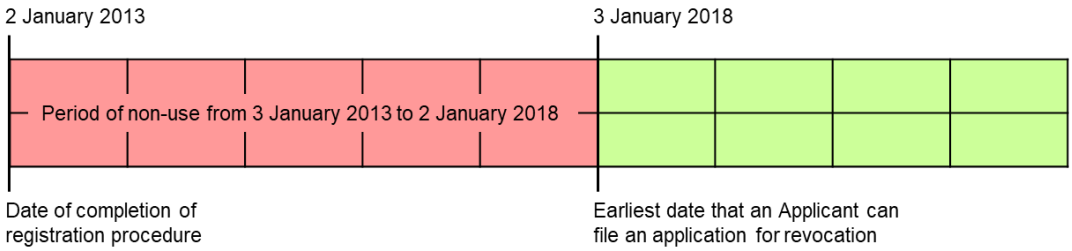
The date of completion of the registration procedure can be found on the e-Register of Trade Marks.

Revocation under Section 22(1)(a)

If an Applicant for revocation relies on Section 22(1)(a), the relevant period of non-use starts from the day immediately following the date of completion of the registration procedure and ends on the fifth anniversary of the date of completion of the registration procedure.

Example:

If the date of completion is 2 January 2013, the relevant period in question under Section 22(1)(a) is from 3 January 2013 to 2 January 2018 inclusive. If it is alleged that a Registered Proprietor has not used its trade mark in the course of trade from 3 January 2013 to 2 January 2018 inclusive, the earliest date that an Applicant can file an application for revocation is 3 January 2018.

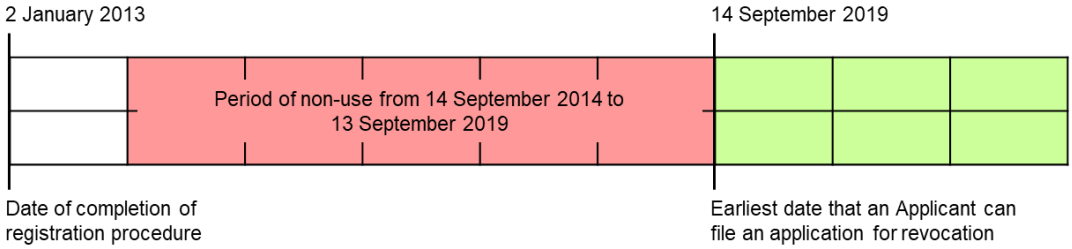


Revocation under Section 22(1)(b)

If an Applicant for revocation relies on Section 22(1)(b), in the grounds of revocation, it will need to specify the relevant period of non-use alleged.

Example:

Using the date of completion of 2 January 2013 in the earlier example, if it is alleged that a Registered Proprietor has not used its trade mark in the course of trade from 14 September 2014 to 13 September 2019 inclusive, the earliest date that an Applicant can file an application for revocation is 14 September 2019.



E. Effective date of revocation

If the revocation is successful, the rights of the Proprietor are deemed to have ceased from the effective date of revocation.

It is therefore important and essential that the Applicant for revocation clearly states the requested effective date of revocation in its application. If no effective date is stated and the revocation is successful, the Registrar will typically apply Section 22(7)(a) to revoke the registered trade mark from the date of the application for revocation.

What is the earliest possible effective date of revocation

An Applicant for revocation usually seeks the earliest possible effective date of revocation which may be earlier than the date of the application for revocation.

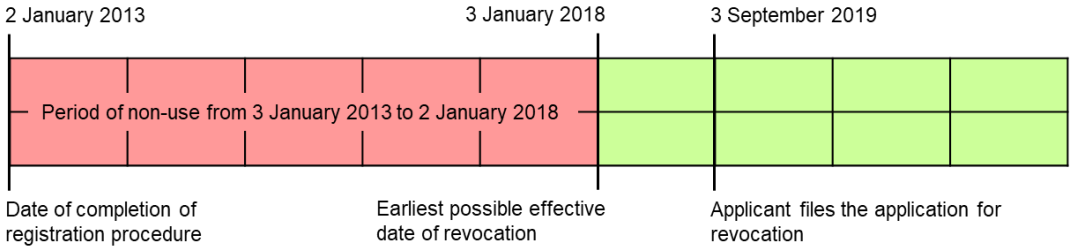
If the registered trade mark has not been used at all since completion of registration, the earliest possible effective date will be the date immediately following the fifth

anniversary of the date of completion of the registration procedure.[1] Alternatively, if the registered trade mark has been used after completion of registration but subsequently was not used for an uninterrupted period of 5 years, the earliest possible effective date will be the date immediately following the end of the 5-year period of non-use.

The date of the application for revocation may or may not coincide with the above two dates.

Example:

An Applicant files the application for revocation on 3 September 2019. It is alleged in the application for revocation that the Registered Proprietor has not used its trade mark in the course of trade since the date of completion of registration on 2 January 2013, that is, from 3 January 2013 to 2 January 2018 inclusive. The earliest possible effective date of revocation that the Applicant for revocation can request in its application is 3 January 2018.



[End of HMD Circular 1.5]

HMD Circular 1.6

1.6 Pleadings issues

A. Introduction

This Circular sets out the Registrar's practice in relation to pleadings issues and the approach that will be taken in relation to the issues. Pleadings issues are usually raised at Case Management Conferences ("CMCs") conducted after the close of pleadings (see Circular 3.1).

B. Approaches adopted by the Registrar

Generally, the Registrar will adopt one of the following three approaches to various pleading issues:

Approach I: Require rectification by necessary amendment of the pleadings

[1] See *New Yorker S.H.K. Jeans Gmbh & Co. KG v Daidoh Limited* [2017] SGIPOS 16 at [7] and [73] – [97].

Approach II: Require clarification, but no need for amendment

Approach III: Raise for parties' information, with a caution on cost implications

These pleadings issues may be addressed in the presence of the parties at the CMC or in writing.

C. Approach I: Pleadings require rectification by necessary amendment

Where certain mandatory requirements specified in legislation are not complied with, the Registrar may require amendment of the pleadings and make the appropriate directions and orders, including orders as to costs.

Examples include but are not limited to the following scenarios:

Rule 30(2) TMR

The Initiator, if relying on an earlier trade mark in its case, must provide the stipulated information on such earlier trade mark.

Rule 30(3) TMR

The Initiator, if relying on an earlier trade mark which is well known, must provide the stipulated information on such well known earlier trade mark.

Information on use and promotion such as information relating to duration, geographical area of the use and promotion of the well known mark; registrations / applications for the well known mark worldwide etc. will be acceptable for compliance with Rule 30(3). (See Circular 1.3)

D. Approach II: Pleadings require clarification, but need not be amended

The Registrar will require clarification from the Initiator in the following situations:

(a) Where the correct section of legislation has been cited but the respective paragraph is not specified; or

(b) Where the correct main section and paragraph have been cited but the respective sub-paragraph is not specified.

Examples include but are not limited to the following scenarios:

Section 8(2) TMA

The Initiator should clarify whether it intends to proceed on Section 8(2)(a) or (b) or both.

Section 8(7) TMA

The Initiator should clarify whether it intends to proceed on Section 8(7)(a) or (b) or both.

Section 8(4) TMA

The Initiator should clarify whether it intends to proceed on Section 8(4)(b)(i), Section 8(4)(b)(ii)(A), Section 8(4)(b)(ii)(B) or a combination of some or all the three limbs under Section 8(4).

Section 22(1) TMA

The Initiator should clarify whether it intends to proceed on Section 22(1)(a), (b), (c) or (d) or a combination of some or all the sub-paragraphs under Section 22(1).

The clarification may be made by the Initiator either verbally at the CMC or in writing after the CMC. Such clarifications will be recorded so that the grounds relied on will be clear to all the parties and the Registrar.

However, if the Initiator were to make amendments to other aspects of the pleadings, the Registrar may suggest that such amendments specifying the paragraph(s) or sub-paragraph(s) of the section on which it relies be made at the same time since other amendments will be made in any case.

E. Approach III: Errors in pleadings raised for parties' information, with a caution on cost implications

Where the Opponent / Applicant for invalidation has pleaded certain grounds erroneously, the Registrar will raise the issue for the parties' information with a general caution on cost implications should a successful Initiator fail on that particular ground, having been alerted to the issue at this early stage.

Amendments to pleadings not required

The Initiator is not required to amend the pleadings. However, the Initiator may on its own accord apply to amend the pleadings by removing or rectifying the pleading.

Examples include but are not limited to the following scenarios:

Example 1: Pleading an absolute ground of objection where the substance of the objection is relative to an earlier right, and not absolute in nature

(a) Section 7(1)(a),(b),(c) TMA

The Initiator pleads that the application mark / registered mark is so similar to its earlier trade mark that it is not capable of distinguishing the Respondent's goods; or is devoid of any distinctive character; or directly describes the Respondent's goods as emanating from the Initiator.

However, Section 7(1)(a),(b),(c) objections are based on absolute grounds and not founded on a claim of similarity of marks nor made with reference to an earlier trade mark.

(b) Section 7(4)(b) TMA

The Initiator pleads that the application mark / registered mark is so similar to his earlier trade mark that it will deceive the public that the Respondent's goods emanate from the Initiator.

However, deceptiveness under Section 7(4)(b) is an absolute ground and not founded on a claim of similarity with an earlier trade mark.

(c) Section 7(5) TMA

The Initiator makes a claim of passing off and cites Section 7(5) instead of or in addition to Section 8(7)(a).

However, Section 7(5) is inapplicable to passing off as it is an absolute ground. Section 8(7)(a) specifically refers to the law of passing off and is the correct ground to plead where passing off is alleged.

Example 2: Pleading an erroneous ground

(a) Section 4(1), Section 5(2)(e) TMA

The Initiator makes a claim of bad faith under Section 4(1) and/or Section 5(2)(e) instead of or in addition to Section 7(6).

However, Section 4(1) and Section 5(2)(e) are not applicable grounds for the purpose of opposition or invalidation. Section 7(6) specifically refers to bad faith and is the correct ground to plead where bad faith is alleged.

(b) Section 55 TMA

The Initiator relies on an earlier well known mark but pleads Section 55 instead of or in addition to Section 8(4).

However, Section 55 can only be invoked before the courts as it relates to the issuance of an injunction against a mark that conflicts with a well known mark and the Registrar has no powers to order an injunction. Section 8(4) governs the registrability of trade marks in relation to earlier well known marks and is the correct ground to plead in this scenario.

(c) Article 6*bis* of Paris Convention

The Initiator relies on an earlier well known mark but pleads Article 6*bis* instead of or in addition to Section 8(4).

However, Article 6*bis* is inapplicable as the Registrar does not have the power to apply an international obligation as such. The Registrar can only apply national legislation that implements Singapore's international obligations. Section 8(4) governs the registrability of trade marks in relation to earlier well known marks and is the correct ground to plead in this scenario.

(d) Section 8(3) TMA

The Initiator pleads Section 8(3) which applies to an application filed before 1 July 2004. However, the opposed application is filed on or after 1 July 2004.

Therefore, Section 8(3) has been erroneously pleaded. Section 8(4) is the correct ground to plead in this scenario.

Example 3: Kitchen Sink Pleading

Rule 30(1) and Rule 57(2) TMR require the Notice of Opposition and Application for Invalidation respectively to contain a statement of the grounds on which the action is proceeding.

A kitchen sink pleading purports to reserve the right to plead all or any other grounds not expressly pleaded. If the statement of grounds contains a kitchen sink pleading, the Registrar will inform parties that such pleading will not be given effect.

[End of HMD Circular 1.6]

HMD Circular 1.7

1.7 Particulars to be specified in bad faith, fraud and misrepresentation allegations

A. Introduction

This Circular sets out the general guidance on particulars to be specified in the statement of grounds where allegations of bad faith, fraud or misrepresentation are made in contentious proceedings before the Registrar.

B. References

Section 7(6) TMA states:

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Section 23(4) TMA states:

> (4) The registration of a trade mark may be declared invalid on the ground of fraud in the registration or that the registration was obtained by misrepresentation.

Rule 30(1) TMR states:

> (1) The notice of opposition shall contain a statement of the grounds upon which the opponent opposes the registration.

Rule 57(2) TMR states:

> (2) The application shall be accompanied by a statement of the grounds on which the application is made.

C. Why is there a need for particularisation?

At the pleadings stage, poorly drafted and elliptically worded statements can lead to a lack of clarity of the issues in dispute and to a waste of time and costs for both the parties and the Registrar later on.

The above concern is amplified in claims of bad faith under Section 7(6) TMA or of fraud or misrepresentation under Section 23(4) TMA, which are serious allegations. The claims must be fully and properly set out in the pleadings and should not be upheld unless they are distinctly proved (through evidence and submissions).

D. How should the statement of grounds be particularised?

The Registrar will expect an allegation of bad faith, fraud or misrepresentation to be particularised in the statement of grounds. The particularisation must be sufficient for the Respondent to know the case it has to answer so that its response to such allegations can be meaningful. Bare allegations or assertions of bad faith, fraud or misrepresentation are not sufficient.

It is not necessary for evidence of bad faith, fraud or misrepresentation to be set out in the grounds of opposition or invalidation. However, indication of the factual basis for the claim should be given beyond merely pleading the fact.

E. Examples of sufficient particularisation

The following are examples where allegations of bad faith / fraud / misrepresentation were sufficiently particularised:

> <u>Example 1: Bad faith</u>
>
> "The applicant is a partnership of which Mr B is a member and uses the Application Mark under licence from Mr B. However, Mr B has not given permission for the application to be made, nor had he any knowledge that it

was being made. The making of the application is therefore an act of bad faith and offends under Section 7(6) TMA."

Example 2: Bad faith

"The application was made in bad faith under Section 7(6) TMA because the Applicants do not have the bona fide intention to use the trade mark in relation to the full range of goods or services, namely [*items within specification for which there is allegedly no intention of use to be specified*]. On the contrary, the Applicants only intended to use the trade mark on [*state goods or services*], as declared in their SD in earlier proceedings."

Example 3: Fraud

"The Registered Proprietors had obtained the trade mark registration by fraud in that they claimed to be the proprietors of the mark when in fact they were simply the sole agents for products sold under the mark and manufactured in [*country*]. The Registrar of Trade Marks had initially objected to the application, whereupon the Registered Proprietor filed an SD which did not accurately state the facts and contained, at best, half-truths designed to portray the picture that the Respondents were the proprietors of the mark. The Registrar registered the mark on the strength of the SD. The registration of the mark should therefore be declared invalid under Section 23(4) TMA."

Example 4: Fraud

"The Applicants for Invalidation aver that there is a serious issue of fraud in relation to the registration of the trade mark (with Chinese characters) because there was an endorsement by the Proprietors that the mark (including the Chinese characters) had no meaning whereas it actually meant "[*meaning*]", which is directly descriptive of the goods claimed. The registration of the mark should accordingly be declared invalid under Section 23(4) TMA."

Example 5: Misrepresentation

"Under Clause [x] of the Contract between the Registered Proprietor and the Applicant, the Registered Proprietor was to refrain from using or registering the Subject Mark in Territory A (which included Singapore) in relation to any and all goods. Despite his contractual obligations, the Registered Proprietor has surreptitiously registered the Subject Mark in his own name in Singapore. The Registered Proprietor had misrepresented to the Registrar that they were entitled to register the Subject Mark when they were prohibited by the Contract from doing so. The registration of the Subject Mark should therefore be declared invalid under Section 23(4) TMA."

F. Examples of insufficient particularisation

The following are examples where allegations of bad faith / fraud / misrepresentation were not sufficiently particularised:

Example 1: Bad faith

"The Application Mark is confusingly similar to our earlier trade marks. As such, the application for registration was made in bad faith and should not be allowed under Section 7(6) TMA."

Example 2: Bad faith and/or fraud or misrepresentation

"For the foregoing reasons, the Registered Proprietor is not entitled to the Registered Mark, which is confusingly similar to our earlier trade marks. As such, the application for registration was made in bad faith and/or there was fraud or misrepresentation in obtaining the registration because the Registered Proprietor held itself out to the Registrar as the rightful owner."

G. Consequences of insufficient particularisation

There may be additional time and costs involved in curing the deficiency. Hence, Opponents and Applicants for Invalidation should ensure that such claims are particularised at the outset, in the statement of grounds, when bad faith, fraud or misrepresentation are alleged.

This deficiency will typically be raised at the pleadings stage, before Form TM11 or Form TM28 is accepted. To cure the deficiency, the Opponent or Applicant for Invalidation will need to amend its statement of grounds to particularise the allegation of bad faith, fraud or misrepresentation. The Respondent (Applicant for Registration or Registered Proprietor) may make consequential amendments to the counter-statement, the costs of which will typically be borne by the Opponent or Applicant for Invalidation.

If the Opponent or Applicant for Invalidation does not act to amend its statement of grounds to particularise the allegation of bad faith, fraud or misrepresentation, Rule 30(1) TMR or Rule 57(2) TMR would not have been complied with; and the Opponent or Applicant for Invalidation cannot rely on Section 7(6) TMA or Section 23(4) TMA in the proceedings.

[End of HMD Circular 1.7]

[This part is intentionally left blank]

2 FILING AND SERVICE CIRCULARS

HMD Circular 2.1

2.1 Filing of documents

A. Introduction

This Circular provides guidance on the use of the electronic online system (IPOS Digital Hub) to file documents in IPOS proceedings.

B. References

The rules referred to in this Circular are rules from the TMR.

The principles apply to equivalent provisions and concepts in the Patent Rules (Cap 221, 2007 Rev Ed), Plant Varieties Protection Rules (Cap 232A, 2006 Rev Ed) and Registered Designs Rules (Cap 266, 2002 Rev Ed).

Rule 7(1) TMR states:

> (1) Where the Act or these Rules authorise or require any document to be given or sent to, filed with or served on the Registrar or the Registry, the giving, sending, filing or service must be effected on the Registrar or the Registry (as the case may be) by sending an electronic communication of the document using the electronic online system.

Rule 78A(2) TMR states:

> (2) Unless the Registrar permits otherwise in a particular case, the electronic online system must be used by any person for giving or sending to, filing with or serving on the Registrar or the Registry any document (other than a notice or document to be served in proceedings in court).

C. Default Filing Modes

In general, a form or document should be filed via IPOS Digital Hub. The following table sets out the links for e-filing with effect from 8 December 2023:

S/No.	Item to be E-filed	Description of Form	E-File Via
1.	Hearing and Decision	Form HC1	IPOS Digital Hub → Forms
2.	Request for Extension of Time to File Documents in Hearings and Mediation Proceedings	Form HC3	

3.	Request for Hearing at which only the Party Making the Request is Present	Form HC4	
4.	Request for Grounds of Decision	Form HC5	
5.	CS	Form HC6	
6.	NO	Form TM11	
7.	Application for Revocation/ Invalidation/ Rectification	Form TM28	
8.	Application for Revocation of a Patent	Form PF35	
9.	NO (Patents)	Form PF58	
10.	Application for Revocation of the Registration of a Design	Form D13	
11.	Notice of Objection or Opposition	Form GI13	
12.	Amended Forms	[None]	IPOS Digital Hub → Correspondence → Attachment File Type: Amended Form
13.	Amended Statement of Grounds	[None]	IPOS Digital Hub → Correspondence → Attachment File Type: Amended Statement of Grounds
14.	Amended CS	[None]	IPOS Digital Hub → Correspondence → Attachment File Type: Amended Counter Statement
15.	Consent of other party	[None]	IPOS Digital Hub → Correspondence → Attachment File Type: Consent or Request for Consent
16.	Notification to Registrar	Notification to Registrar	IPOS Digital Hub → Forms
17.	SD	Evidence by Initiator	IPOS Digital Hub → Forms
		Evidence by Respondent	

		Evidence-In-Reply by Initiator	
18.	Further SDs ("Further evidence" with leave under Rule 35 TMR)	[None]	IPOS Digital Hub → Correspondence → Attachment File Type: • Supplementary Evidence by Initiator • Supplementary Evidence by Respondent • Supplementary Evidence-In-Reply by Initiator
19.	Re-executed SDs, including re-filed SDs following Registrar's directions	[None]	IPOS Digital Hub → Correspondence → Attachment File Type: • Evidence by Initiator re-executed • Evidence by Respondent re-executed • Evidence of Use or Reason for Non-Use by Proprietor re-executed • Evidence-In-Reply by Initiator re-executed • Supplementary Evidence by Initiator re-executed • Supplementary Evidence by Respondent re-executed • Supplementary Evidence-In-Reply by Initiator re-executed
20.	Response to Registrar for Pre-hearing Review	[None]	IPOS Digital Hub → Correspondence → Attachment File Type: Response to Registrar for PHR
21.	Written Submissions and Bundle(s) of Authorities	Written Submissions & Bundle of Authorities	IPOS Digital Hub → Forms
22.	Additional or Supplementary Written Submissions and Bundle(s) of Authorities	[None]	IPOS Digital Hub → Correspondence → Attachment File Type: • Additional/Supplementary Bundle of Authorities by Initiator

			• Additional/Supplementary Bundle of Authorities by Respondent • Additional/Supplementary Written Submissions by Initiator • Additional/Supplementary Written Submissions by Respondent
23.	Rebuttal or Reply Written Submissions and Bundle(s) of Authorities	[None]	IPOS Digital Hub → Correspondence → Attachment File Type: • Rebuttal/Reply Bundle of Authorities by Initiator • Rebuttal/Reply Bundle of Authorities by Respondent • Rebuttal/Reply Written Submissions by Initiator • Rebuttal/Reply Written Submissions by Respondent
24.	Bill of Costs	[None]	IPOS Digital Hub → Correspondence → Attachment File Type: • Bill of costs • Marked bill of costs
25.	Marked Bill of Costs	[None]	

D. E-filing documents which exceed 100 MB

Part II Section 4 of the prevailing IPOS Digital Hub Practice Direction applies.

In the event where the evidence comprises more than 1 item (for example, the evidence comprises the main SD as well as physical exhibits), the filing date to be accorded for the evidence will be the filing date of the last item filed. Parties are therefore encouraged to file their evidence on a single day instead, before the deadline expires.

E. Submission of hard copies for the purposes of hearing

The Registrar may direct parties to submit hard copies of SDs, Written Submissions and Bundles of Authorities for the purposes of a hearing. If so, the parties would electronically file their Written Submissions and Bundles of Authorities via IPOS Digital Hub and also submit hard copies of the relevant documents to the Registrar by hand or by post.

For hard copies, the following should be observed:

(a) Documents should be firmly secured together with plastic ring binding or plastic spine thermal binding. The rings or spines should be red for Initiators (i.e. Opponents or Applicants for revocation/invalidation) and blue for Respondents (i.e. Applicants for registration or Registered Proprietors). Exceptions are allowed on a case by case basis e.g. where the SD is notarised in a foreign jurisdiction and sealed in such a way that it is not possible to ring bind it.

(b) Documents should be paginated consecutively. Pagination should commence on the first page of the first bundle and run sequentially to the last page of the last bundle. Pagination may not be necessary if it is still possible to conveniently make a reference to a particular page. For example, in the case of published law reports, as long as there are flags, and the published law reports are paginated in the original, there should not be a need to re-paginate.

In particular, the Bundle of Authorities must fulfil the following:

(a) Contain all the authorities, cases[2] and any other materials relied on (e.g. academic articles)

(b) Have flags to mark out each authority referred to. Such flags shall bear the appropriate indicium by which the authority is referred to

(c) Contain an index of the authorities in that bundle

(d) Be legible.

The Registrar may disregard any document not in compliance with the above or ask the party to re-submit and/or re-serve a compliant document.

[End of HMD Circular 2.1]

HMD Circular 2.2

2.2 Service requirements

A. Introduction

This Circular addresses the Registrar's practice in relation to service of documents, in particular the following:

(a) Address for Service
(b) Duty to Serve on Counter-Party
(c) Sufficiency of Service

[2] However, see **HMD Circular 5.2 at D**. Case authorities which are on the Registrar's published list on the IPOS website do not need to be included in parties' Bundles of Authorities where such parties have legal representation.

(d) When Service is Effected
(e) Proof of Service
(f) Service of Documents Where There is Invalid or Unoccupied AFS
(g) Refusal to Accept Service
(h) Service of Form HC3 Where There is no AFS (for International Registration Designating Singapore and Protected International Trade Mark (Singapore).

B. References

The sections referred to in this Circular are sections from the TMA. The rules referred to in this Circular are rules from the TMR or the Trade Marks (International Registration) Rules (Cap 332, 2002 Rev Ed) ("IR Rules").

The principles apply to equivalent provisions and concepts in the Patents Rules (Cap 221, 2007 Rev Ed), Plant Varieties Protection Rules (Cap 232A, 2006 Rev Ed) and Registered Designs Rules (Cap 266, 2002 Rev Ed).

C. Address for Service

Rule 9(1) provides that for the purposes of any proceedings before the Registrar, an Address for Service ("AFS") in Singapore shall be filed accordingly. In particular, an AFS shall be filed by or on behalf of:

(a) every applicant for the registration of a trade mark

(b) every opponent[3]

(c) every person applying to the Registrar under Section 22 for the revocation of the registration of a trade mark, under Section 23 for a declaration of invalidity of the registration of a trade mark, or under Section 67 for the rectification of the register

(d) every person granted leave to intervene under Rule 60

(e) every proprietor of a registered trade mark which is the subject of an application to the Registrar for the revocation of the registration of the trade mark, for a declaration of invalidity of the registration, or for a rectification of the register

(f) every other party to any proceedings before the Registrar.

Can a person's trade or business address in Singapore be treated as an AFS?

Unless a different address for service has been provided under Rule 9(1) or (7) or Rule 44, the Registrar may, under Rule 9(6) treat the trade or business address in Singapore of a person as his address for service.

[3] There are opposition actions available for many types of proceedings. Please refer to Rule 9(1)(b) TMR for more details.

What are the consequences of a failure to provide an AFS?

Where an AFS is not filed as required, the Registrar may send to the person concerned notice to file an AFS within 2 months after the date of the notice, and if that person fails to do so, the consequences provided in Rule 9(6B) will apply.

Where an AFS is not filed as required of:

(a) an applicant for registration or for the revocation of the registration of the trade mark, the declaration of invalidity of the registration, or the rectification of the register (Rule 9(1)(a) and (c)), the application shall be treated as withdrawn

(b) an opponent (Rule 9(1)(b)) and every person granted leave to intervene under Rule 60, the person shall be treated as having withdrawn the opposition or intervention (as the case may be)

(c) a proprietor referred to in Rule 9(1)(e), the proprietor shall not be permitted to take part in any proceedings relating to the application for the revocation of the registration of the trade mark, the declaration of invalidity of the registration, or the rectification of the register, as the case may be

(d) every other party to any proceedings before the Registrar referred to in Rule 9(1)(k), the party shall not be permitted to take part in the proceedings in question.

D. Duty to serve on Counter-Party

Where the Rules and IR Rules require filing and serving at the same time, the party who is seeking to file and serve the relevant document (Filing Party) is to indicate clearly, on the cover letter enclosing the relevant document to the Registrar, that a copy of the relevant document has been served on the opposite party (Counter-Party). Relevant documents may include forms, SDs and other documents.

If e-filing, in the e-form, the Filing Party will have to check against the statement that a copy of the document will be served on the other party at the same time. The Registrar will treat the failure to do so as no proper service of the relevant document and consequences of non-service will follow, unless the Filing Party proves otherwise.

If the service is by any electronic means (e.g. email and file-sharing platforms) other than IPOS Digital Hub, the Filing Party must have the consent of the Counter-Party to service by such a mode.

Consequences of non-service

The consequence will depend on the type of document in question. In the example of non-service of Form TM 11, the NO shall be treated as not having been filed (Rule 29(2A)). The Filing Party will have to re-file the relevant form and re-serve the same on the Counter-Party if it is still possible to do so within the statutory deadline.

Ensuring proper service

Parties are reminded to check the Register to confirm the name of the Counter-Party, the name of the Counter-Party's agent (as appropriate) and the Counter-Party's latest address for service before filing and serving any documents. This is because the Register may have been updated due to recordals being filed in the interim e.g. assignments, changes in name, changes in AFS, changes in agents etc.

E. Sufficiency of service

For avoidance of doubt, the Registrar clarifies that the phrase "at the same time" will *not* be construed literally to mean that the document reaches the Registrar and the Counter-Party at the same moment in time.

The Filing Party would have served the relevant document "at the same time" if he has taken the necessary action (for example, addressing, prepaying and posting a copy of the document to the Counter-Party's AFS) as soon as practicably possible.

In terms of what is practicably possible, the Registrar envisages that service should take place (i.e. a copy of the filed document should be despatched) within the same day as filing, though if a document is e-filed after office hours, a copy of that document would be expected to be despatched to the Counter-Party the next working day.

F. When service is effected

The time at which service is effected or deemed to have been effected (i.e. the date the Counter-Party receives the document), is important as it has a bearing on the calculation of the deadline to file the document which is due thereafter.

Generally, the Registrar will take the date that he receives the document as the default date from which to calculate the deadline to file the document which is due thereafter. For example, the deadline to file a CS will be calculated from the date the Registrar receives the NO.

However, this default position is rebuttable and can be subject to proof. Thus, if the Counter-Party can show that, for example, it received the NO at a date later than the date indicated on the cover letter, this later date will be taken as the date for the calculation of the deadline for the CS. In such a case, the Counter-Party should promptly inform the Registrar and the Filing Party in writing of the actual date of receipt of the relevant document so that the deadline for the CS due can be correctly calculated.

Where the modality of service is by post

Specifically in relation to service via post, Rule 7(4) provides as follows:

> (4) Where any notice or other document is sent by post under paragraph (2) or (3), the giving, sending or service, as the case may be, of the notice or

other document shall, until the contrary is proved, be treated as having been effected at the time at which the notice or document would have been delivered in the ordinary course of post.

Guidance on calculation of the next deadline

If the modality of service is ordinary post and the Counter-Party cannot pinpoint a specific date of receipt, to calculate the deadline for the next document, the Registrar can be guided by SingPost's service standards at http://www.singpost.com/send-receive/send-within-singapore (where there is an AFS or trade address or business address in Singapore) and at http://www.singpost.com/send-receive/send-overseas (for overseas addresses e.g. International Registration holder with no AFS being served Form HC3) as updated from time to time.

G. Proof of service

If the Counter-Party claims that it did not receive the relevant document, the Filing Party is required to show proof of service. The non-exhaustive list of modalities is:

(a) a courier receipt or invoice

(b) if by normal post, an SD that the relevant document has been posted, with relevant details

(c) if the attempted service is in person, an SD with relevant details

(d) for service of HMD forms and accompanying attachments by IPOS Digital Hub, a record of transmission issued through IPOS Digital Hub

(e) if by any other electronic means (for example, by email),

(i) a copy of the document that shows the Counter-Party's consent to be served by that electronic means; and

(ii) a copy of the sent electronic communication attaching or linking to the relevant document. Alternatively, a copy of an acknowledgement email or an automated delivery receipt could demonstrate service.

Where it is shown that the Filing Party has served the documents as soon as practicable

If the Registrar is persuaded that the Filing Party despatched a copy of the document as soon as practicably possible, the Filing Party may be directed to re-serve the document on the Counter-Party at the AFS.

For the avoidance of doubt, if the Registrar directs the Filing Party to re-serve the document, the deadline for the Counter-Party to file its subsequent document will be X months from the date of receipt of the relevant document that was *re-served* on the Counter-Party. For example, if the subsequent document is the CS, the Counter-Party will have 2 months from the date of receipt of Form TM 11 to file its CS.

Where there is evidence the document reached the Counter-Party's AFS

If there is evidence that the document reached the Counter-Party's AFS (e.g. as demonstrated by a courier receipt, or by a signed acknowledgement if delivery is by hand), and if the deadline for the Counter-Party to file the subsequent document has expired, the Registrar may simply allow the consequences of not filing the latter to apply.

In either case, what is required of the Filing Party is that it must prove that its document had been originally served within the deadline. As to what constitutes sufficient service, please see heading E above.

H. Service of documents where there is an invalid or unoccupied AFS

This scenario occurs where, for example, a party has moved out of its premises and thus the AFS is no longer valid or occupied. The Counter-Party would not have received a copy of the document the Filing Party served at the invalid or unoccupied AFS. In such a situation, the Filing Party should inform the Registrar in writing with proof of service (see heading G above) and where appropriate, the Registrar will confirm that the Filing Party has discharged its duty to serve the document.

I. Refusal to accept service

Rule 9(8) provides:

> (8) Anything sent to or served on a person at his address for service shall be taken to have been duly sent to or served on the person.

Therefore, even if an occupant at the AFS refuses to accept service, the Filing Party may provide proof of attempted service to demonstrate that it has discharged its duty to serve the document. As to the acceptable modalities of proof of service, see heading G above.

J. Service of Form HC3 or Form TM 28 where there is no AFS (for international registration designating Singapore and protected international trade mark (Singapore))

The Filing Party should, when filing the relevant form with the Registrar, send a copy of the form to the Counter-Party's overseas address indicated on the Register, where there is no AFS on record. If the Counter-Party alleges that it did not receive the form from the Filing Party, the latter is required to show proof of service (see heading G above).

There is no obligation to check whether the Counter-Party may have a trade or business address in Singapore to be treated as the AFS in accordance with Rule 9(6) TMR. However, it would be a good practice because this will save costs as there is no need to send the document overseas.

[End of HMD Circular 2.2]

HMD Circular 2.3 (Removed)

3 CASE MANAGEMENT CONFERENCE CIRCULARS

HMD Circular 3.1

3.1 Case management conference

A. Introduction

This Circular explains what a case management conference ("CMC") is and how to prepare for one.

B. What is a CMC

A CMC is a meeting conducted under Rule 81A TMR, between the parties and the Registrar, at any stage of any application to or proceedings before the Registrar. The primary objective of a CMC is for the Registrar to make orders or give directions for the just, expeditious and economical disposal of the matter at hand.

One example where the Registrar will most likely convene a CMC is after the CS is filed and parties indicate in the Notification to Registrar that they have not communicated with each other. A CMC is convened for parties to communicate with each other and to update the Registrar the state of play between them before the Registrar issues the evidential deadlines.

C. Preparation for CMC

A CMC will be most useful if the parties have prepared themselves adequately before attendance.

If parties are to attend a CMC after the close of pleadings,

(a) before the CMC, parties should contact each other to explore the possibility of settlement

(b) at the CMC, parties should be in a position to advise the Registrar the state of play, in particular whether they wish to negotiate or mediate

(c) at the CMC, parties are to inform the Registrar of relevant circumstances, if any, for example, the matter is one of a series of actions between the same parties before the Registrar.

[End of HMD Circular 3.1]

HMD Circular 3.2

3.2 Deadlines to file evidence and extensions of time to file evidence

A. Introduction

This Circular explains the Registrar's exercise of discretion in specifying the evidential deadlines[4] and in considering applications for extensions of time.

B. Deadlines to file evidence

Before specifying the evidential deadlines, the Registrar will hear parties on the state of play between them and the proposed time periods for filing evidence. This can be done through written[5] or oral representations[6] by parties. During the CMC, the Registrar will specify the applicable deadlines for parties to file evidence.[7] Whatever the case may be, the shortest possible period for a party to file its evidence is 2 months.[8]

Factors considered by Registrar

In deciding on the duration of the deadlines to file evidence, the Registrar will consider all relevant factors, including those set out in the non-exhaustive list below:

(a) Whether parties are negotiating

(b) If parties are negotiating, the nature of their negotiations e.g. whether multi-jurisdictional or only in Singapore

(c) If parties are negotiating, the stage of their negotiations e.g. whether preliminary or advanced stage

(d) Whether there are pending proceedings in court which have a bearing on the outcome of the case before the Registrar

(e) The nationality of the parties, in particular, whether Singaporean or foreign.

Generally, standard deadlines are issued if parties are not negotiating. Non-standard deadlines are issued if parties are negotiating or if there are pending proceedings in court which have a bearing on the outcome of the case before the Registrar. For the ranges of what constitutes "standard" and "non-standard", please see the table below.

[4] Rules 31A(1) and 59(1A) TMR
[5] Written representations are typically made through Notification to Registrar, which is sent to parties, after the close of pleadings, for their completion.
[6] Oral representations are typically made at case management conferences, which the Registrar convenes if there are issues that may be better addressed verbally with parties.
[7] Rules 31A(1) and 59(1A) TMR
[8] Rule 31A(2) TMR

Evidence	Standard Deadlines	Non-standard Deadlines
Initiator's evidence	2 to 5 months from issuance of deadlines by Registrar	Up to 9 months from issuance of deadlines by Registrar
Respondent's evidence	2 to 5 months from Initiator's evidence	Up to 6 months from Initiator's evidence
Initiator's evidence in reply	2 months from Respondent's evidence	Up to 3 months from Respondent's evidence

Ultimately, however, the above is simply a guide and the Registrar has the discretion to specify deadlines other than what is set out in the table, having regard to the facts of each case.[9]

C. Seeking extensions of time to file evidence[10]

Requirements

The party seeking an extension of time must serve a copy of the request (Form HC3) on the counter-party at the same time as the request is filed with the Registrar.[11] If the party seeking an extension of time fails to serve a copy of Form HC3 on the counter-party, the latter may apply to the Registrar to revoke any extension of time granted. In the event of any dispute, the onus is on the requesting party to prove that a copy of Form HC3 has been duly served on the counter-party.

There is no need to seek the counter-party's consent before filing Form HC3. However, if consent has been obtained in writing, the party seeking the extension should provide the Registrar with a copy of the relevant document(s). This could expedite the grant of an extension of time.

Details required

When applying for an extension of time, the party seeking an extension must fulfil the following:

(a) State the period of extension requested

(b) State the reason for the request

(c) State the name and address of every person likely to be affected by the extension, if there is such a person (other than the counter-party) e.g. licensees.

[9] Rules 31A(1) and 59(1A) TMR
[10] Rules 32 to 34 TMR
[11] There is a mandatory field in Form HC3 for the party seeking an extension of time to declare that a copy of the form will be served on the counter-party.

A "good and sufficient reason"

The Registrar may refuse to grant the extension of time sought if the requesting party fails to show a "*good and sufficient reason*" for the extension.[12] Parties should especially note that the purported reason "Need more time to collate/file evidence" is tautologous to the concept of requesting more time to file evidence (akin to "I need more time because I need more time") and is not a "good and sufficient reason".

A "good and sufficient reason" particularises why the evidence could not be filed by the deadline and justifies why an extension of time is in order.

Persuasive reasons in favour of an extension

While everything depends on the facts and circumstances of each case, the following non-exhaustive list of reasons would typically weigh in favour of granting an extension of time:

(a) Parties are awaiting the outcome of relevant court proceedings that has a material bearing on a possible settlement agreement or on how the parties wish to proceed, and this has taken longer than expected at the outset

(b) Significant progress has been made in negotiations but parties still require a specific period of additional time to complete the negotiations

(c) One party has had a change of agent shortly before the deadline for it to file its evidence

(d) A circumstance has arisen that is beyond a party's control, provided that the party has acted promptly and diligently at all times; for example, corporate changes such as merger and bankruptcy; illness, resignation or change in portfolio of a party's decision-maker causing a delay in settlement negotiations; civil war; declaration of state of emergency.

Further extensions of time

If there is a "*good and sufficient reason*", the Registrar may grant a further extension of time beyond an extended deadline following a party's request.

However, if the Registrar had previously granted an extension of time on the basis of a certain set of circumstances, a further extension of time on the basis of the same set of circumstances will generally not be allowed. Therefore, it is incumbent on the party seeking the further extension to show how, if at all, the circumstances have changed such that the request is justified.

D. Objecting to an extension of time to file evidence

The counter-party, or any person likely to be affected by the extension of time, may object to the request for extension of time. The objection must be raised not later than 2 weeks after the receipt of a copy of the request for extension of time.[13]

The Registrar may refuse to grant an extension of time on grounds that the party seeking the extension has failed:

(a) to show a good and sufficient reason for the extension

(b) to show, to the Registrar's satisfaction, that the request has been duly served on the counter-party or each person likely to be affected by the extension.[14]

As such, in practice, objections to a request for an extension of time would be raised in relation to either or both of these grounds.

In deciding whether to grant the extension, and if so, the length of the extension, the Registrar will take into account any objections received before the relevant deadline.

E. Application for revocation of extension of time[15]

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

After receiving the application to revoke the extension of time, the Registrar will give directions on the subsequent procedure. The Registrar will give the parties an opportunity to be heard, whether in writing only, or both in writing and in person at an interlocutory hearing.

If the requesting party cannot prove that it has served a copy of Form HC3 on the counter-party (see **HMD Circular 2.2 at G**), and if there are no extenuating factors to explain why this was not done, the Registrar will generally allow an application for revocation of the extension of time.

F. Registrar may decide without having to conduct a hearing

The Registrar may grant or refuse an extension of time to file evidence without having to conduct a hearing.[16]

G. Registrar may extend subsequent deadlines

The applicable rules envisage[17] and provide[18] that the Registrar may subsequently adjust the specified deadlines by extending them, if appropriate. For example, an Opponent may seek an extension of time to file evidence in support of its opposition because parties have decided to negotiate. While extending the Opponent's

[12] Rules 32(5)(a), 33(5)(a) and 34(5)(a) TMR
[13] Rules 32(4), 33(4), 34(4) TMR
[14] Rules 32(5), 33(5), 34(5) TMR
[15] Rules 32(8), 33(8), 34(8) TMR
[16] Rules 32(6), 33(6), 34(6) TMR
[17] Rules 31A(4), (5) and 59(1A)(f) and (g)(ii) TMR
[18] Rules 32(7)(a) and 33(7)(a) TMR

deadline, the Registrar may also extend the Applicant's deadline to file evidence under Rule 32(7)(a) TMR.

H. Registrar may shorten deadlines

The applicable rules envisage[19] and provide[20] that the Registrar may subsequently adjust the specified deadlines by shortening them, if appropriate, after giving the parties an opportunity to be heard. For example, a party may update the Registrar that negotiations have failed. As such, the longer deadlines given to allow parties time to negotiate may no longer be justified. The Registrar may inform parties of the intention to shorten the deadlines and given them an opportunity to make representations, upon which the Registrar may exercise the power under Rule 31A(1A) TMR and shorten the deadlines.

[End of HMD Circular 3.2]

HMD Circular 3.3

3.3 Page limits on evidence in trade mark opposition, invalidation and revocation proceedings

A. Introduction

This Circular gives guidance on the general page limits the Registrar would expect of parties' evidence in trade mark proceedings such as oppositions, invalidations and revocations. Since IPOS is a low cost tribunal, parties should be mindful of what and how much evidence they file so as to avoid unnecessary costs to proceedings.

This practice takes effect from 2 June 2022.

B. Page limits for parties' evidence

Parties' evidence should fall within the following limits, regardless of the number of deponents at each stage:

Evidence by Initiator: 300 pages
Evidence by Respondent: 300 pages
Evidence in Reply by Initiator: 100 pages

C. How did we decide on 300 pages as the page limit?

Having had the benefit of reviewing parties' evidence filed in many trade mark proceedings, we observed that relevant and useful evidence was generally filed in the range of 150 to 300 pages. After careful consideration, we decided on 300 pages as the page limit for the pilot.

[19] Rules 31A(2), (3)(a), (4)(a), (5)(a), 32(1)(a), 33(1)(a), 34(1)(a) and 59(1A)(b), (c), (f) and (g)(ii) TMR
[20] Rules 31A(1A), (1B) and 59(1A)(aa), (ab) TMR

During the pilot over 2 years, we observed that almost all parties were able to file their concise evidence within the page limits. The feedback from parties was also overwhelmingly in favour of page limits.

D. What are the consequences if a party's evidence exceeds the page limit?

The consequences could pertain to costs.

The Registrar will apply a test based on the relevance and proportionality of the evidence. If the evidence exceeds the page limit and if the Registrar concludes that a significant portion of the evidence is irrelevant or unnecessary, then there could be cost implications. For example, the party may not be awarded costs if the irrelevant or unnecessary evidence is excessive; or even if the party is awarded costs, the quantum could be based on the degree of relevance or necessity of the evidence.

[End of HMD Circular 3.3]

[This part is intentionally left blank]

4 EVIDENCE CIRCULARS

HMD Circular 4.1

4.1 Applications to file further evidence

A. Introduction

The guidance in this Circular relates to applications to file further evidence.

B. Basic procedure

Either party may apply to the Registrar for leave to file further evidence: see Rule 35 TMR.

The requesting party should apply to the Registrar by way of letter, together with a draft SD setting out the further evidence sought to be tendered. The other party must be copied on the request and his consent must be sought.

In addition to setting out the requesting party's reasons why the Registrar should allow the request, the letter should also explain: (a) the relevance of the further evidence sought to be admitted; and (b) why it was not (or could not have been) adduced earlier. If consent from the other party has been sought and obtained, this fact should be stated in the letter.

The Registrar will give further directions after receiving the requesting party's letter.

C. Further evidence with consent

Generally speaking, if the other party has given its consent, the Registrar is likely to allow the introduction of further evidence. In so doing, the Registrar will usually give directions on the subsequent procedure. Such directions may include: adjourning the hearing; allowing the other party to file further evidence in reply where relevant; awarding such costs as may be just.

D. What happens if the other party refuses to consent?

If the other party does not consent to the introduction of the further evidence, the Registrar will consider representations from both sides before deciding whether or not to grant the application. The usual procedure involves the issuance of a preliminary view (or PV), which will become final unless it is objected to. In the event the PV is objected to, there will be an interlocutory hearing, followed by an interlocutory decision. For more information on PVs please see **HMD Circular 7.1**.

In deciding whether to grant leave for the further evidence to be filed, the Registrar will conduct a balancing exercise having regard to, among other things: (a) the public interest that procedural rules are complied with; and (b) the need to ensure proper adjudication of a case based on its merits in the interest of justice between the parties.

In the assessment, the Registrar may consider any or all of the following (non-exhaustive) factors on a case by case basis:

(a) Why the party seeking to file the further evidence did not do so earlier when the main evidence or evidence in reply fell due; it should be shown that the evidence could not have been obtained earlier with reasonable diligence

(b) Whether the further evidence is necessitated by the evidence filed by the other party

(c) Whether the other party would suffer any real prejudice which cannot be compensated with costs if the further evidence is allowed

(e) Whether allowing the further evidence will allow the substantial issues to be satisfactorily and fully considered and determined or whether the application is only a tactical manoeuvre and allowing the further evidence would result in prejudice to the other party

(f) The stage of the proceedings at which leave to file the further evidence is sought (e.g. at the Pre-Hearing Review in contrast to one day before the hearing), considerations of disruption to proceedings and extra costs generated by the delay being relevant.

Although all relevant factors will be taken into consideration, not all factors are of equal weight. In an appropriate case, an important factor may well be outweighed by the totality of the other factors. Everything turns on the facts and circumstances of each case.

If leave to file further evidence is granted, the Registrar will usually give directions on the subsequent procedure. Such directions may include: adjourning the hearing; allowing the other party to file further evidence in reply where relevant; awarding such costs as may be just.

[End of HMD Circular 4.1]

HMD Circular 4.2

4.2 Evidentiary issues

A. Introduction

This Circular provides guidance on the Registrar's practice with regard to evidentiary issues.

Although the focus of this Circular is on contentious trade marks proceedings before the Registrar, the guidance within may with appropriate modifications apply to other types of disputes before the Registrar as well.

B. Nature of evidence

Evidence filed should be relevant. If a document is not relevant to at least one of the issues in dispute, it should not be in evidence.

At the conclusion of the dispute, when the Registrar decides the proportion and/or quantum of costs to be awarded, one factor that he will take into account is the degree of *relevance* of the evidence.[21] As it will be seen in the discussion below, irrelevant documents may attract negative costs consequences.

Content of evidence

IPOS is a low-cost administrative tribunal.[22] Parties are intended to resolve their disputes at IPOS in a cost and time-effective manner.

Thus, when filing evidence to support their case, parties should balance the urge to file as much evidence as possible to assist the tribunal's adjudication on the one hand, with the cost- and time-effectiveness principle above, on the other hand. Specifically, parties should not file voluminous irrelevant evidence which would cause an undue burden to the opposite party (and the tribunal). This may result in an adverse costs order: see *Guccio Gucci S.P.A v Guccitech Industries (Private Ltd)* [2018] SGIPOS 1 at [15] and [96]

> [15] …I wish to put on record that, much as it may be interesting to an historian of brands or an *aficionado* of fashion, a significant number of the 6,852 pages of exhibits submitted by the Opponent in support of its case is irrelevant to the issues to be decided and yet would have needed to be read (at least quickly) by the Applicant's lawyers and was read or looked at carefully and considered by this tribunal. While I am aware from my own experience that clients involved in contentious matters often demand quantity in the belief that it assists their case in some way, I would respectfully suggest that counsel in trade mark opposition proceedings should seek to restrain such an impulse to bury the tribunal and the opposing party in material that is irrelevant or excessive.
>
> …
>
> [96] The parties will have noted my comments concerning the extent and nature of the evidence adduced by the Opponent in this case. I consider it to have been, albeit perhaps unintentionally, a potentially oppressive use of the opposition procedure under the Act. In the circumstances, I consider it correct and fair to depart from the usual order in opposition proceedings under which costs are awarded to the successful opponent, and order that the parties bear their own costs in these proceedings.
>
> [Emphasis in underline added]

Further guidance on some of the common types of evidence filed is set out below.

Evidence of sales

Statements of account, or figures given in the main body of SDs as supported by sample invoices in the exhibits, are generally acceptable. However, the weight to be given to such evidence will vary depending on the relevance of the documents.

For example, where the sample invoices do not reflect the subject mark in relation to the specification in question, the weight to be given to such invoices, if any, is low. This in turn affects the weight of the assertions on annual sales volume which is purportedly supported by the invoices.

Sections 8(2)(b), 8(7)(a), and Section 8(4)(b)(i) TMA may entail evidence that the trade mark relied on has been used in Singapore. Naturally, it would be important to ensure that any such evidence (e.g. of sales revenue) is linked to Singapore in some material way. It is not helpful in this regard to simply provide evidence of global sales revenue, without more.[23] More is required to establish the link to Singapore.

Evidence of advertising and promotional expenditure

Advertising and promotional expenditure figures given in the main body of SDs as supported by sample invoices in the exhibits are generally acceptable. However, the weight to be given to such evidence will vary depending on the relevance of the documents.

For example, where there is no demonstrable link between the sample invoices, the advertisements / promotional material and the subject mark in relation to the specification in question, the weight to be given to such invoices, if any, is low. This in turn affects the weight of the assertions on the amount of advertising expenditure which is purportedly supported by evidence over the years.

Similar to the position for sales revenue (discussed above), for the purposes of Sections 8(2)(b), 8(7)(a), and Section 8(4)(b)(i) TMA, it is important to ensure that any advertising and promotional evidence can be traced to the local market.

Written submissions

Submissions are arguments, not evidence. Attempts to improperly introduce evidence through written submissions will not be allowed. Parties will have the opportunity to make written submissions at the appropriate juncture: at least 1 month before the hearing.[24]

Evidence is evidence. As a general rule, SDs filed in evidence should not contain any legal submissions. Just because such submissions are made under oath or affirmed does not make the arguments made by the deponent more persuasive.[25]

[21] See **HMD Circular 6.1**.
[22] See *Apptitude Pte Ltd v MGG Software Pte Ltd* [2015] SGIPOS 8 at [2].
[23] Unless the party is claiming that a portion of the overseas sales revenue can be traced to the local market.
[24] See for example, Rule 37(2).
[25] This, of course, does not apply to certain types of expert evidence.

Instead, they add to the time and costs. One example in the context of trade marks proceedings is as follows. At times, deponents make extensive arguments in their SD explaining why they consider two marks to be aurally, visually and conceptually similar (or dissimilar, as the case may be). Such statements are ultimately of little to no value because such issues are for the tribunal or the court to decide and not the witnesses.

Newspapers and other articles/publications

It is generally acceptable (and not objectionable on grounds of hearsay) to rely on extracts from newspapers and other articles/publications. However, the weight to be given to such evidence will vary depending on its relevance, including whether it refers to the mark in relation to the specification in question. Should such sample articles be in a foreign language, these should be translated.

For the avoidance of doubt, the Registrar draws a distinction between: (i) copies of published documents and printouts from official websites; and (ii) printouts from other pages on the internet.

For the former, the Registrar may, depending on the circumstances of the case, accept the contents of the copies or printouts for the truth of the statements made. However, any printouts from other pages on the internet will *not* be accepted for the truth of the statements made but only for the fact that such statements have been made.

This distinction is drawn as published documents or printouts from official websites (e.g. online annual reports from company websites) are generally accounted for by the publisher. This is in contrast to, for example, forum discussions where the contributor of the comments can hide behind a pseudonym and thus cannot be held accountable for the comments made. Nevertheless, everything depends on the context and the nature of the evidence. There have been cases in which forum discussions have been taken into account.[26]

Trade mark registration certificates

Trade mark registration certificates will be given the relevant weight depending on the purpose for which they have been adduced, the marks themselves, the classes in which the marks are registered, the jurisdiction of registration, and so on. Should such certificates be in a foreign language, these should be translated.

Evidence in reply

The filing of evidence in reply is optional.[27] It is good practice to inform the Registrar and counter-party in writing earlier, ahead of the deadline, if a party has decided not

[26] *Clarins Fragrance Group f.k.a. Thierry Mugler Parfums S.A.S. v BenQ Materials Corp.* [2018] SGIPOS 2 at [37]; *Inner Mongolia Little Sheep Catering Chain Co. Ltd. v Grassland Xiao Fei Yang Pte Ltd* [2018] SGIPOS 6 at [53]

[27] Rule 31A(5): The opponent *may* file with the Registrar the statutory declaration mentioned in paragraph (1)(c) within —

to file any evidence in reply. If any is filed, the content must be confined to matters strictly in reply to the respondent's evidence.[28]

Evidence filed in related proceedings

Where a party wishes to rely on an SD, affidavit or witness statement filed in related proceedings, as far as possible, the same evidence should be re-declared (that is, the evidence should be set out in a fresh SD with the same content) by the same deponent for the purposes of the proceedings before the Registrar.

The Registrar *may* accept the SD, affidavit or witness statement appended as an exhibit to an SD filed for the purposes of proceedings before the Registrar, but will give the appropriate weight to that exhibit.

Decisions in other proceedings

Decisions in other proceedings (whether in Singapore or in other jurisdictions) will be given the relevant weight depending on the purpose on which they are relied, the subject matter of the decisions, the applicable law in the jurisdiction of the decision, and so on.

There is a distinction between the fact of the decisions and the fact of their specific findings, which is generally acknowledged by the Registrar on the one hand; and the veracity of the facts set out in the decisions on the other hand.

In the latter case, the facts should be proven by way of SD in the proceedings before the Registrar with very limited exceptions (e.g. where confidentiality obligations prevent a party from disclosing terms of a settlement agreement but a court decision refers to some of its contents).

Should such decisions be in a foreign language, these should be translated.

C. Procedural aspects

Below are some guidelines on certain procedural aspects in relation to the filing of evidence.

Statements of information or belief

The Registrar is mindful of the need to strike a balance between the desirability of cogent evidence, on the one hand, and costs incurred in procuring such evidence, on the other.

(a) the period specified by the Registrar under paragraph (1) for that statutory declaration; or
(b) that period as extended under rule 32(7)(a), 33(7)(a) or 34.

[Emphasis in *italics* added]

[28] Rule 31A(10): The opponent's statutory declaration in reply mentioned in paragraph (1)(c) *must be confined to matters strictly in reply to the applicant's statutory declaration* mentioned in paragraph (1)(b). [Emphasis in *italics* added]

In order for parties to manage costs before a low cost administrative tribunal, under Rule 69(1B), the Registrar accepts evidence that meets the standard set out in O41,r5(2) of the Rules of Court ("ROC") rather than the higher standard set out in O41,r5(1) ROC.

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.

Translations

The official language used in proceedings before the Registrar is English. Therefore, if the contents of foreign language documents are important to a party's case, it may wish to file translations via supplementary SD as soon as practicably possible, before the deadline of the counter-party's SD. For avoidance of doubt, the deadline for the counter-party to file its evidence will be X months from the date of receipt of the supplementary SD. Alternatively, it may wish to raise the issue when the Registrar discusses the case with parties at the Pre-Hearing Review.

Translated copies of foreign language documents that form part of an SD are acceptable (i.e. the translator can but need not file a separate SD). As far as possible, a certified translation is desirable.

Where the content to be translated is short, for example, the meaning of a single foreign word, extracts from dictionaries (including online ones) may be taken into account. In all cases, the Registrar will give the relevant weight (if any) to the foreign language document accordingly.

For the avoidance of doubt, documents tendered only to show the depiction of a trade mark need not be translated. One example would be advertisements where the sole intention is to show the depiction of the mark as advertised and the actual contents of the advertisement, in a foreign language, are not relevant.

Private Investigator's (PI) report

With effect from 15 April 2020, a PI report *must* be adduced by way of an SD declared by the relevant PI. The Registrar will no longer accept a PI report adduced as an exhibit to the SD of a party's deponent.

Survey evidence

Similarly, with effect from 15 April 2020, survey evidence must be adduced by way of an SD declared by the appropriate representative from the entity which conducted the survey.

Survey evidence will be given the relevant weight depending on its relevance and credence. Survey evidence in itself is not conclusive of the propositions a party makes as the Registrar still has a duty to interpret the survey results and draw the relevant inferences. Parties should take note of the Courts' latest guidance on such surveys.

The Registrar's current practice, which is subject to the Courts' latest guidance, is as follows:

(a) the interviewees in the survey must be selected so as to represent the relevant cross-section of the public

(b) the size of the survey must be statistically significant

(c) the survey must be conducted fairly

(d) all the surveys carried out must be disclosed, including the number of surveys carried out, how they were conducted and the totality of the persons involved

(e) the totality of the answers given must be disclosed and made available to the defendant

(f) the questions must neither be leading, nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put

(g) the exact answers and not some abbreviated form should be recorded

(h) the instructions to the interviewers as to how to carry out the survey must be disclosed

(i) where the answers are coded for computer input, the coding instructions must be disclosed.

Parties should note that survey evidence, which is regarded as a major disbursement item, is subject to the non-compensatory principle. For more information, please refer to **HMD Circular 6.1**.

[End of HMD Circular 4.2]

HMD Circular 4.3

4.3 Evidence in trade mark revocations on the ground of non-use

A. Introduction

The guidance in this Circular relates to the filing of evidence in trade mark revocations on the basis of non-use.

B. Burden of proof

In trade mark non-use revocation cases, the burden of proving use is on the proprietor. The applicant for revocation does not have to prove non-use. 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.

C. What evidence should the trade mark proprietor file with the CS?

A Proprietor seeking to defend his registered trade mark against an action for non-use revocation is required to provide evidence of use (or of proper reasons for non-use, as the case may be) together with the CS. Such evidence should be filed by way of SD. (See Rule 58(3) TMR and see, in particular, the evidence required.)

At this CS stage, the Proprietor is only required to show that it has an arguable, or *prima facie*, case. As a matter of best practice, *prima facie* evidence of use should minimally comprise:

(a) some material showing the mark in use e.g. catalogues, product labels, advertisements, mark as affixed on the goods in question

(b) some indication of sales e.g. invoices, purchase orders.

Although the Proprietor may file all of its evidence at the CS stage, this is not mandatory. It has the option of also filing evidence at a later stage (i.e. after the close of pleadings during the rounds of evidence). That said, furnishing all of the evidence together with the CS may save some time and costs in certain circumstances.

D. What if the Proprietor fails to file and serve evidence with the CS?

The non-use revocation action will be allowed, and the registered mark in question will be revoked from the effective date of revocation: see Rule 58(10) TMR and **HMD Circular 1.5**.

E. Rounds of evidence (if any) after pleadings

The only mandatory evidence is the Proprietor's evidence to be filed with its CS (see above).

After the pleadings have been filed, the Registrar will, after hearing parties, give timelines within which further evidence may be filed (see Rule 59(1A) TMR).

It is not mandatory for the Applicant for Revocation to file evidence (see Rule 59(1A)(c) TMR). This is consistent with the position that the burden is ultimately on the Proprietor to show what use has been made of the trade mark in issue. To expedite matters, if an Applicant has decided not to file evidence, it should, as soon as possible, inform the Registrar and the Proprietor in writing so that the latter can decide whether it, in turn, will be filing evidence.

Whether or not the Applicant for Revocation files evidence, it is not mandatory for the Proprietor to file evidence at this stage (see Rule 59(1A)(c) TMR). For example,

the Proprietor could already have filed all of its evidence together with its CS and have nothing further to add. To expedite matters, if a Proprietor has decided not to file evidence at this stage, it should, as soon as possible, inform the Registrar and the Applicant (for Revocation) in writing so that a Pre-Hearing Review and full hearing may be convened earlier than originally contemplated.

Assuming the Proprietor does file evidence at this stage, the Applicant may file evidence in reply: see Rule 59(1A)(g)(ii) TMR. Such evidence in reply must be confined to matters strictly in reply to the Proprietor's SD that is additional to the evidence already provided in the SD filed with the CS: see Rule 59(1A)(h) TMR.

[End of HMD Circular 4.3]

[This part is intentionally left blank]

5 HEARINGS CIRCULARS

HMD Circular 5.1

5.1 Pre-Hearing Review

A. Introduction

This Circular explains what a pre-hearing review ("PHR") entails and gives guidance on matters relating to a PHR.

B. Timing and purpose of PHR

After the close of evidence, the Registrar convenes a PHR at which directions may be given for securing the just, expeditious and economical disposal of the proceedings (Rule 36A(1) TMR).

C. Scope of PHR

In essence, at a PHR, the Registrar reviews the case with the parties. This review is fairly wide-ranging, as the Registrar may consider any matter (Rule 36A(2) TMR). In particular, the Registrar will ascertain from the parties whether there is any possibility of settlement or whether they wish to proceed to a full hearing. Where the matters discussed relate to settlement, the discussion is without prejudice to any party.

D. Time to negotiate

If the parties are exploring settlement, the Registrar will give them time to do so. Deadlines will be given to the parties to update the Registrar on the progress in their negotiations periodically in writing. If the resolution of the dispute is delayed by protracted negotiations, the Registrar may require the parties to furnish information to demonstrate the parties' efforts in moving negotiations ahead (Rule 36A(2) and Rule 81B TMR).

E. Preparation for hearing

If the parties wish to proceed to a full hearing, the Registrar will raise any relevant issues which need to be resolved before a full hearing. The parties are also at liberty to raise issues for discussion or for the Registrar's direction e.g. request for leave to file further evidence, request for leave to cross-examine witnesses. The Initiator will also confirm the grounds on which it wishes to proceed, so that both parties have a common basis on which to craft their written submissions. If there are any specific dates on which the parties are not able to attend a hearing, they should also inform the Registrar at the PHR.

F. Preparation for PHR

A PHR will therefore be most effective if the parties have prepared themselves adequately before attendance. By this stage of the proceedings, the parties would

have had the benefit of reviewing all the evidence and be in a good position to assess the strength of their case. The parties should then consider if settlement by negotiation or mediation could be a better alternative than a full hearing and, if so, they should contact each other before the date to explore this option.

In summary, the parties should be prepared to address the Registrar on the following non-exhaustive issues at a PHR:

(a) the state of play, in particular whether they wish to negotiate or mediate, or proceed to a hearing

(b) if parties wish to negotiate, how long they anticipate they would need to settle their dispute

(c) if parties are not negotiating, whether they wish to apply for leave to cross-examine or to file further evidence

(d) (for the Initiator) if parties are not negotiating, the grounds on which to proceed and whether any grounds will be dropped

(e) any other relevant matters, issues or developments

(f) if parties are not negotiating, their unavailable dates for the hearing.

[End of HMD Circular 5.1]

HMD Circular 5.2

5.2 Full hearings: cross-examination, attendance and tendering of additional submissions

A. Introduction

This Circular explains what a full hearing entails and gives guidance on matters relating to a full hearing.

B. Cross-Examination

Cross-examination in IPOS proceedings is allowed under Rule 69(3) TMR. Typically, the Registrar will confirm with the parties at the PHR whether they will seek leave to cross-examine any witness on his SD.

Request for Cross-Examination

A party that wishes to cross-examine any witness on his SD must make a request to do so at the earliest opportunity in writing (preferably, prior to the PHR) to ensure that reasonable notice is given. This request should include the following details:

(a) Name(s) of the witness(es) the party wishes to cross-examine

(b) Reasons why cross-examination of each of these witnesses is requested

(c) 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

(d) Explanation of the relevance of those issues to the matters to be decided

(e) 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) TMR). 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.

If the request is allowed, general legal principles of cross-examination will apply.

Examples where a request for cross-examination may be allowed

(a) Where one of the issues raised in the dispute is bad faith, the cross-examination pertains to the particulars of bad faith alleged in the SD(s)

(b) Where the party seeking cross-examination has reason to believe that the witness' SD contains unreliable evidence and these facts are relevant to the issues raised in the dispute

(c) 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

(d) Despite the witness to be cross-examined being based outside Singapore, it is in the interest of justice to do so e.g. one of the above situations (enumerated at a-c) apply.

Examples where a request for cross-examination may not be allowed

(a) Where the witness to be cross-examined is based outside Singapore, and cross-examination is used by the requesting party as a litigation strategy to force the opposite party to incur unnecessary costs;

(b) 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).

Video-conferencing

If the request is allowed, the Registrar is prepared to consider the use of appropriate video-conferencing options such as platforms on Zoom, Microsoft Teams etc. This should be discussed with the Registrar at the PHR. The non-exhaustive, non-cumulative factors which the Registrar will consider in deciding whether cross-examination should take place via video-conferencing are:

(a) Whether the witness to be cross-examined is based outside Singapore

(b) Whether there are sufficient administrative and technical facilities agreed upon by both parties e.g. at a law office or rented business space

(c) Whether any party to the proceedings would be unfairly prejudiced if video-conferencing was allowed / not allowed.

Recording of witness testimony

The Registrar may record witness testimony with recording devices. Parties are generally permitted to record the witness testimony with their own audio recording devices. Parties may also, with consensus and the permission of the Registrar, arrange for professional transcribers to record witness testimony.

Scheduling

The cross-examination and oral submissions are usually expected to take place on the same day. A typical scenario would be to allocate the morning for cross-examination (and any re-examination) and the afternoon of the same day for oral submissions. If more time is allocated for cross-examination, the oral submissions may be heard on another day as the Registrar directs.

Witness not to communicate with party and party's agents before finishing testimony

After a witness begins giving evidence, he should only communicate with the party who called him (or the party's agents, if represented) in the course of giving evidence from the witness stand. He should not communicate with the party who called him nor the party's agents other than in the course of giving evidence, until he has finished his testimony, including cross-examination and re-examination. Thus, for example, if a witness has not finished giving his testimony, it is inappropriate for his party's agent to coach him during the lunch break on what to say.

Order of proceedings

In an oral hearing involving cross-examination, the order of proceedings may look like this:

(a) The party on whom the onus rests makes its opening statement

(b) If the witness of the party on whom the onus rests is to be cross-examined, that party calls its witness

(c) The same witness makes an oath or affirmation to tell the truth. The witness is asked to confirm that the relevant SD contains his evidence

(d) The same witness is cross-examined by the Respondent

(e) The same witness is re-examined by the party on whom onus lies

(f) The witness stands down

(g) The Respondent makes its opening statement

(h) If the Respondent is to be cross-examined, that party calls its witness

(i) The same witness makes an oath or affirmation to tell the truth. The witness is asked to confirm that the relevant SD contains his evidence

(j) The same witness is cross-examined by the party on whom onus lies

(k) The same witness is re-examined by the Respondent

(l) The witness stands down

(m) The party on whom the onus rests makes its oral submissions

(n) The Respondent makes its oral submissions and rebuttals

(o) The party on whom the onus rests makes its sur-rebuttals, if any, and closing submissions.

C. Written submissions

Filing

Parties are expected to file and exchange their written submissions and bundles of authorities at least one month before the date of hearing (Rule 37(2) TMR). The Registrar has observed that parties comply with this in the overwhelming majority of cases where parties attend their hearings.

In the rare instance where a Respondent who does not bear the burden of proof (i.e. excluding the Registered Proprietor in a revocation for non-use dispute, who bears the burden of proof) refuses to file written submissions but still wishes to be heard at the hearing, consent of the counter-party is required. Otherwise, the Registrar will not allow such a party to make oral submissions. It is only allowed to make rebuttals.

As for a party who bears the burden of proof, it is mandatory for it to file written submissions if it wishes to be heard at the hearing.

Length of written submissions

Parties are encouraged to limit their written submissions to a maximum of 50 pages, excluding annexes.

We have surveyed a sample of written submissions filed for cases before the Registrar, and conclude that written submissions in the range of 20 to 50 pages are usually sufficient for the parties' purposes.

D. Bundles of authorities

The Registrar maintains and, from time to time, updates a list of case authorities on the IPOS website which do not need to be included in parties' bundles of authorities where the counter-parties have legal representation.

This is intended to save costs. Where parties have no legal representation (they act on their own behalf, or they are represented by agents who are not lawyers), all case authorities relied on by the counter-party must be included in the counter-party's bundle of authorities.

E. Attendance at Full Hearings

Rule 37 TMR, read with Rule 59 TMR, relates to attendance at full hearings, and the Registrar's relevant powers.

Form HC1 not filed by one party: Registrar will usually proceed with hearing

If no Form HC1 is filed on behalf of a party, it may be treated as not desiring to be heard. Rule 37(4) allows the Registrar to do any of the following:

(a) proceed with the hearing in the absence of that party

(b) without proceeding with the hearing, give his decision or dismiss the proceedings

(c) make such other order as he thinks fit.

Where Form HC1 is filed by only one party, the Registrar will, under ordinary circumstances, proceed with the hearing in the absence of the party who did not file

Form HC1. In extraordinary circumstances[29], the Registrar may give his decision without proceeding with the hearing.

If a party has not filed Form HC1 but appears at the hearing desiring to be heard before the session formally begins, the Registrar will require the party to file Form HC1 immediately or extract a solicitor's undertaking, where relevant, from the party's agent that Form HC1 will be filed by the end of the next working day.

Form HC1 filed but party does not appear: Registrar will usually ascertain party's intention

Rule 37(5) provides that the Registrar may proceed with the hearing in the absence of the party or may, without proceeding with the hearing, give his decision or dismiss the proceedings, or make such other order as he thinks fit, if a party does not appear after filing Form HC1.

In practice, the Registrar will contact the absent party/parties as far as reasonably possible to ascertain its/their intention. Where a party has filed Form HC1 but fails to turn up at the hearing, the Registrar will be slow to move the matter ahead with the other party who is present without hearing further from the absent party who has filed Form HC1. Likewise where both parties do not attend the hearing, but Form HC1 has already been filed by both parties, the Registrar will be slow to dismiss the proceedings without verifying their intention. If it is a party's intention to be heard but it cannot be present for legitimate reasons (e.g. medical reasons), the Registrar will, where reasonable, vacate the hearing and re-fix it for another day.

Form HC1 not filed by both parties and both parties do not appear: Registrar will usually dismiss the proceedings

Rule 37(7) provides that the Registrar may dismiss the proceedings if neither party appears at the hearing. This would be sparingly exercised in practice, where parties do not demonstrate any interest in continuing the proceedings e.g. both parties are unresponsive and do not inform the Registrar of their intent. If parties prefer a written decision without a hearing, heading F below applies.

F. Where Parties Prefer a Written Decision Without a Hearing

Parties that prefer a written decision without a hearing may make such a request, as the Registrar "may, without proceeding with the hearing, give his decision or dismiss the proceedings, or make such other order as he thinks fit" under Rule 37(4) TMR. In these circumstances, parties need not file Form HC1, though they can still file written submissions and bundles of authorities for the Registrar's consideration.

This option is best raised and discussed at the PHR. The Registrar will consider, for example, whether there are issues and questions which parties would be directed to address at an oral hearing. Alternatively, parties may inform the Registrar of their preference for the same in writing any time after the PHR and before the date of the full hearing. However, if one party still wishes to proceed with a hearing, the hearing

[29] See, for example, *Seek Limited v Seek Asia Pte Ltd* [2020] SGIPOS 2

will continue as scheduled and the other party may choose whether or not to be heard at the hearing.

The date of the hearing shall be taken as the date on which the case was originally set down for hearing, unless otherwise decided at the PHR stage or in writing.

G. Restoration of Proceedings

Rule 37(10) TMR provides that any proceedings that have been *dismissed* can be restored on the direction of the Registrar. Such application shall be made within 14 days after the Registrar's notification that the proceedings have been dismissed (Rule 37(11) TMR).

H. Additional or Supplementary Written Submissions and Bundle of Authorities

A party who wishes to tender additional or supplementary written submissions and bundle of authorities should, at least **2 weeks** before the date of the full hearing, file and serve the same on the other party. This is to prevent the other party from being taken by surprise.

If the above is not complied with, the Registrar will exercise discretion whether to disregard these submissions, or whether to accept them and give the other party time to file reply submissions (e.g. if voluminous case authorities are cited in the additional or supplementary submissions). There are only limited exceptions to the general rule in the preceding paragraph e.g. the Court of Appeal has changed the law in a decision too recent to have been included when the written submissions and bundle of authorities were due.

All additional or supplementary written submissions and bundle of authorities will have to be filed via IPOS Digital Hub in addition to any hard copies as directed by the Registrar.

For avoidance of doubt, the 2-week requirement does not apply to basic rebuttal submissions. However, the Registrar still has the discretion to give the other party time beyond the hearing to file reply submissions if appropriate. Further, rebuttal submissions are to be similarly filed via IPOS Digital Hub, in addition to any hard copies provided to the Registrar at the hearing, as soon as possible after the hearing.

[End of HMD Circular 5.2]

[This part is intentionally left blank]

6 COSTS CIRCULARS

HMD Circular 6.1

6.1 Award and assessment of costs

A. Introduction

This Circular guides users on matters relating to the award and assessment of costs.

B. References

Unless otherwise specified, the sections referred to are sections from the TMA and the rules referred to are rules from the TMR.

Section 69 TMA Costs awarded by Registrar

Rule 40 TMR Costs in uncontested oppositions

Rule 75 Scale of Costs

Rule 75(2) TMR provides that costs awarded in these proceedings are not intended to compensate the parties for the expense to which they may have been put.

C. Liability for costs

The Registrar has the discretion to award costs against any party to proceedings and in the amounts provided for by the Rules. In general, the successful party in contested proceedings (whether substantive or interlocutory) is usually entitled to an award of costs. The parties have the opportunity to be heard in relation to an award on costs. This is useful, especially if it is claimed that costs should not follow the event[30].

Will costs be awarded if the proceedings end before a determination on its merits?

It is possible to seek a cost award where proceedings end before a determination on its merits. For example, where a trade mark applicant withdraws its application upon receipt of Form TM11, the Opponent may seek, and the Registrar may allow, an award of costs against the Applicant. In such a scenario, Rule 40 applies and the Registrar will consider whether proceedings might have been avoided if reasonable notice had been given by the Opponent to the Applicant before the Form TM11 was filed. The Registrar's consideration will be two-fold, whether costs should be awarded to the Opponent at all and if so, the quantum of the award.

[30] In *Ferrero S.P.A. v Dochirnie Pidpryiemstvo "Kondyterska Korporatsiia "ROSHEN"* [2015] SGIPOS 14 there was no order as to costs (see [103]) even though the opposition failed on all grounds as the Registrar found that the Applicants' actions have caused unnecessary complications in the proceedings.

How will costs be awarded where there are joint initiating parties to a successful action?

Where there are joint initiating parties to a successful action, any costs awarded to them are calculated as being for one party only. If the action is not successful, the default position is that the joint initiating parties are jointly and severally liable for costs.

D. Order for costs

Award of costs after full hearings

After a full hearing relating to proceedings with notice, the Registrar may order party and party costs to be assessed if not agreed, or the Registrar may award costs summarily after giving parties the opportunity to make representations.

Even if costs are ordered to be assessed if not agreed, many parties are able to agree on the quantum of costs without the need for assessment. This saves them time and further costs incurred in the assessment, which will not be fully recovered by the party awarded costs.

Award of costs in interlocutory proceedings

In interlocutory proceedings, the Registrar may, in most cases, hear the parties on the award of costs as well as on the quantum thereof at the same time. This is generally more time- and cost-effective.

E. Quantum of costs

Party and party costs refer to such costs as are necessary or proper for the attainment of justice or for enforcing or defending the rights of the party whose costs are being assessed. The party and party costs awarded under an assessment are all that are necessary or proper to enable the party to conduct the proceedings, and no more.

Further, Rule 75(2) provides that costs awarded in these proceedings are not intended to compensate the parties for the expense to which they may have been put.

The Fourth Schedule in the Rules contains the Scale of Costs. Under Section 69, the Registrar retains the ultimate discretion in terms of the quantum to be awarded, subject to the Fourth Schedule.

F. Drafting a Bill of Costs

The following table is intended to be an aid to parties in drafting a Bill of Costs ("BOC") and understanding the Registrar's decision-making process on the quantum of costs.

The table includes some of the factors which the Registrar takes into account in deciding the quantum of costs to be awarded for items provided in the Scale of Costs.[31]

In exceptional cases, for example, where a party's behaviour is unreasonable[32], the Registrar may decide not to award costs, or award costs that are higher than what would ordinarily have been awarded where the party had acted reasonably.

Where parties have agreed on specific items in the BOC

Where parties have agreed on a particular cost item in the BOC, the Registrar will not intervene in relation to that item and will award the quantum as agreed (within the maximum amount under the Scale of Costs). In the event that parties disagree in relation to a particular item, the Registrar will award an amount for the item having regard to the Fourth Schedule as well as to the particular circumstances of the case.

Fourth Schedule

Item	Matter	Amount
	INSTITUTION OF PROCEEDINGS	
1	Drawing and filing notice of opposition, application for revocation of registration of a trade mark, application for declaration of invalidity of registration of a trade mark, or application for rectification of an entry in the register, all including a statement of grounds.	$390
	This is a standard item which will be allowed if work has been done.	
2	Drawing and filing counter-statement	$390
	This is a standard item which will be allowed if work has been done	
3	Preparing and filing evidence for opposition and revocation, invalidation or rectification proceedings	$390-$2,080 per statutory declaration
	(a) Consolidation of proceedings *If the proceedings were consolidated before any evidence had been filed, the cost would normally be awarded for each stage of the evidence as if it was a single set of proceedings. However, if the consolidation had been requested after evidence had been filed, costs would normally be awarded for each set of proceedings separately up to the stage when consolidation was requested, and as though they were one set of proceedings thereafter.*	

[31] The text in standard font is reproduced from the *Fourth Schedule*, while the text in *italics* sets out the Registrar's usual approach when deciding on the quantum of costs to be awarded.

[32] In *Guccio Gucci S.p.A.* v *Guccitech Industries (Private Ltd)* [2018] SGIPOS 1, the IP Adjudicator departed from the usual order in opposition proceedings under which costs are awarded to the successful opponent, and ordered that the parties bear their own costs in the proceedings. This was a result of the IP Adjudicator's finding that the Opponent's exhibits contained "swathes of material that has no relevance to these proceedings or is needlessly excessive and duplicative…"

	(b) Similar / identical marks for several classes of goods / services *In a situation where the actions relate to similar / identical marks for several classes of goods / services, in reality the evidence filed in relation to each class is often similar.* *In such cases, full costs will only be awarded to one set of evidence relating to one class.* *For the subsequent evidence in the other classes, due consideration must be given to the substantiality of the similarity of the evidence and the costs awarded will be reduced accordingly. In a case where the evidence is more than 90% similar, then the minimum costs of $390 may be considered to be an appropriate quantum for each SD respectively in relation to the other classes*. *The number of pages containing statements made by the deponents and the amount and the relevance of the exhibits are factors to be considered.* • *Limited evidence of use in the SD: $390 to $700* • *Some evidence of use in the SD: $700 to $1600* • *Extensive evidence of use, complex facts in the SD: $1600 to $2080*	
4	Reviewing the reply to any document referred to in items 1, 2 and 3 *In a situation where:* *(a) there is consolidation of proceedings;* *(b) the actions relate to similar / identical marks for several classes of goods / services such that the documents filed in relation to each class is highly similar* *the considerations set out in item 3 will apply accordingly.* *The number and complexity of issues raised in fact and law are relevant factors to be considered.* • *1 or 2 grounds raised: $195 to $500* • *3 or more grounds raised: $500 to $800* • *Complex issues of fact and law: $800 to $1040*	$195-$1,040 per document

	INTERLOCUTORY PROCEEDINGS, ETC.	
5	Preparing for all interlocutory proceedings[33], pre-hearing reviews and case management conferences *Factors to be considered are conduct of parties, complexity of issues in fact and law, length of written submissions, and amount of authorities cited if any.* • *Simple procedural matters: $65 to $200* • *Written submissions with no authorities cited (interlocutory proceedings): $200 to $400* • *Written submissions & authorities (interlocutory proceedings): $400 to $650*	$65-$650 per proceeding, review or conference
6	Attending all interlocutory proceedings, pre-hearing reviews and case management conferences *Factors to be considered are conduct of parties, complexity of issues in fact and law, and time taken for hearing.* • *30 min or less: $65 to $200 (pre-hearing reviews and case management conferences)* • *More than 30 min: $200 to $650 (pre-hearing reviews and case management conferences)* • *30 min or less: $65 to $400 (interlocutory proceedings)* • *More than 30 min: $400 to $650 (interlocutory proceedings)*	$65-$650 per proceeding, review or conference
	FULL HEARINGS	
7	Preparing for hearing *Factors to be considered are complexity of issues in fact and law, length of written submissions and amount of authorities cited if any.* • *1 or 2 grounds raised: $650 to $1300* • *3 or more grounds raised: $1000 to $2000* • *Many complex issues of fact and law: $2000 to $2600*	$650-$2,600
8	Attendance at hearing *Factors to be considered are complexity of issues in fact and law, time taken for hearing.* • *Half day hearing: $260 to $700* • *Full day hearing: $700 to $1040*	$260-$1,040
	ASSESSMENT	
9	Drawing bill of costs *Amount allowed according to the number of folios in bill of costs[35]*	$6.50 per folio[34]

[33] See **HMD Circular 6.1 at D**

[34] Defined as 100 words, each figure being counted as one word, in Rule 2(1)

[35] Where a party has filed the form and has also included an attachment, the number of pages for the attachment will only be taken into account where the content is not repetitious and further elaborates on the BOC.

10	Attending assessment	$130-$390
	The factor to be considered for attending assessment is the time taken for the assessment proceeding. • *30 min or less: $130 to $200* • *More than 30 min: $200 to $390*	

How is the award of costs calculated if there is an unrepresented party in the proceedings?

The quantum of costs awarded to an unrepresented party will be 50% of the amounts indicated in the table above, or the minimum amount for the relevant item, whichever is higher. This ensures that the unrepresented party is not overcompensated for the cost of the proceedings.

For example, where the Registrar would have been minded to award $390 for a represented Applicant's review of evidence by the Opponent (item 4 of the Fourth Schedule), applying the principle, only $195 (i.e. 50% of $390) will be awarded to an unrepresented Applicant. However, in the situation where the Registrar is only minded to award $350, instead of awarding $175 (i.e. 50% of $350), the minimum amount of $195 in the range will apply and be awarded.

This "50% discount" does not apply to disbursements. Thus, an unrepresented party is able to claim for disbursement items in full, subject to the Registrar's practices in relation to such claims.

G. Disbursements

Agreement on specific items

Where parties have agreed on a particular disbursement item, the Registrar will not intervene in relation to that item and will award the quantum as agreed between the parties.

Reasonableness and proportionality

In the event that parties disagree in relation to a particular item claimed, the Registrar will apply the twin principles of reasonableness and proportionality in determining the quantum of disbursements allowed.

Generally, common disbursements (e.g. taxi fares, photocopying) will be awarded. The filing fees for Form HC3 will be allowed where the opposite party agrees. The Registrar is mindful that Form HC3 is often filed to maintain the pendency of proceedings while parties negotiate. Because negotiations are generally on a "without prejudice" basis, one party should generally not bear the costs of extensions of time of another party.

Survey evidence disbursement

In recognising disbursements for survey evidence, the Registrar will apply a test based on the relevance, reasonableness and proportionality of the evidence. To

illustrate, if the survey or certain portions thereof are not particularly relevant, then the Registrar may disallow costs, or if costs are allowed, will reduce the reimbursement of the costs for the survey carried out by the winning party.

[End of HMD Circular 6.1]

HMD Circular 6.2

6.2 Security for costs

A. Introduction

The Circular gives guidance on when an application for security of costs may be requested, the mode of security and the circumstances that will be considered before such an application is granted. It also deals with the consequences of non-compliance with the Registrar's grant for security for costs.

B. References

Section 70 TMA provides:

> If a person who neither resides nor carries on business in Singapore —
>
> (a) gives notice of opposition under section 13; or
>
> (b) applies to the Registrar under section 22 or 23 for the registration of a trade mark to be revoked or to be declared invalid, as the case may be,
>
> the Registrar may require the person to give security for the costs for the proceedings and may, if security is not given, dismiss the proceedings.

C. Application for security for costs

There can be 2 stages involved in proceedings related to security for costs:

Stage 1: Application for security for costs

At the first stage, the Registrar has the discretion whether to require one party to give security upon the fulfillment of the criteria.

Stage 2: Application for proceedings to be dismissed

At the second stage, where security is not given, again the Registrar has the discretion whether to dismiss the proceedings.

If the Registrar does grant the application for security for costs, the Registrar will also direct the quantum, mode of payment as well as the period within which such security is to be furnished.

D. What is the condition precedent before the Registrar may exercise his discretion?

The party seeking security for costs must first show that the Initiator[36] neither resides nor carries on business in Singapore. Once this has been shown, the Registrar then has a discretion to require the Initiator to provide security for costs.

E. The Registrar's discretion

The word "may" in Section 70 makes it clear that security cannot be ordered as a matter of course, but only if the Registrar thinks it is just to do so in the circumstances of the case. The Registrar will exercise this discretionary power judiciously and by considering all the circumstances of the case.

Although the wording of Section 70 differs from that of Order 9 Rule 12 of the Rules of Court 2021, the primary purpose is similar. The purpose is to ensure that the Respondent[37] in any action has some security that, in the event that he wins, the Initiator will pay his costs.

Thus, the factors that will be taken into consideration by the Registrar in deciding whether to grant security for costs in an opposition or revocation or declaration of invalidity proceedings are similar to the factors that the courts will take into account in deciding whether to grant security for costs in a civil suit.

F. Factors taken into consideration in deciding whether to grant security for costs

The factors that will be taken into consideration by the Registrar are similar to the factors that the courts will take into account in deciding whether to grant security for costs in a civil suit. Based on a consideration of the factors, the Registrar may then decide whether the application for security for costs should be granted. However, where the circumstances are evenly balanced it would ordinarily be just to order security against a foreign Initiator

The non-exhaustive list of factors includes, amongst others:

(a) Whether granting the security would stifle a genuine claim

Impecuniosity of the Initiator is inextricably linked to this factor. Where the granting of the security would stifle a genuine claim, the application for security may be denied. One of the ways to moderate the concern of stifling a genuine claim is to reduce the quantum of the security allowed.

[36] In this context, "Initiator" refers to the party initiating the main action e.g. an Opposition, and not the application for the security for costs.
[37] In this context, "Respondent" refers to the party defending himself in any action e.g. in an Opposition, Revocation or Invalidation action.

(b) The ease with which a Singapore decision can be enforced overseas

Generally, if the foreign jurisdiction is covered under either the Reciprocal Enforcement of Commonwealth Judgments Act 1921 or the Reciprocal Enforcement of Foreign Judgments Act 1959, then there is a tendency that the application for security may be refused.

(c) The likelihood of the Initiator succeeding

In coming to a view of the probability of success of an action, the Registrar is not required to make a detailed examination of the merits of the case. Indeed, the Registrar would not be in a position to do so, in particular, where the action is still at an early stage. If both parties have an arguable case on the face of it, then this will be a neutral factor.

(d) The stage at which the application for security for costs is made

In general, the case is stronger where the application is made at an early stage of the action. This because where an application is made at a late stage, the Respondent would have already expended much costs. This casts doubt on whether the Respondent is genuinely concerned about recovering costs from the Initiator.

(e) Whether the impecunious Initiator is an individual or a corporate entity

This is relevant as the attitude in relation to impecuniosity differs with regard to companies versus individuals. Where the Initiator is a natural person, public policy leans towards encouraging access to the proceedings and hence, leans away from an order for security for costs.

(f) Where the Initiator is a limited company, whether there is evidence that it is unable to pay costs

There are 2 potential ways this factor may apply:

(i) Where the Initiator is impecunious. When one is dealing with a company rather than a natural person, public policy is in favour of limiting, rather than encouraging, uninhibited access to the proceedings and hence, leans towards an order for security for costs.

(ii) Where the Initiator claims that it is fully able to pay the Respondent 's costs if the latter wins. For example, the Initiator may be a public listed company with many assets. Since the Respondent is not able to show that the Initiator is unable to pay costs, this factor will work against the Respondent seeking security for costs.

G. Mode of the security

The two generally accepted modes for the provision of the security are:

(a) A solicitor's undertaking

(b) A banker's guarantee

If the Initiator's agents are a firm of solicitors, the more common mode for the provision of the security would be by way of a solicitor's undertaking instead of a banker’s guarantee.

A foreign Initiator in particular, would have to open an account with a Singapore bank if it does not already have one, in order to obtain a banker's guarantee. In contrast, where a solicitor's undertaking is given, the foreign Initiator simply needs to make payment to its solicitor agent's account.

Where the Initiator's agents are not a firm of solicitors, then a solicitor's undertaking is not applicable and a banker's guarantee will be required.

H. Stay of proceedings

Once the Registrar has made a grant of security, pending the provision of the security, there may be a need to stay the proceedings.

When will the need for a stay of proceedings arise?

This will depend on the stage of the action when the grant is made. If it is the Respondent's turn to file a document, the proceedings are usually stayed so that the Respondent does not have to incur additional costs. However, if it is the Initiator's turn to file a document, the proceedings are usually not stayed.

I. Application for proceedings to be dismissed

At the second stage, where security is not given, the Registrar has the discretion to dismiss the proceedings. The party to whom security for costs has been granted can then apply, in writing, for the opposition / revocation / declaration for invalidity proceedings to be dismissed.

The Registrar will call for submissions in writing from both parties and exercise his discretion to decide whether the proceedings should be dismissed. If parties request an interlocutory hearing to decide the issue, the Registrar may also fix one to hear the parties in person. Generally, unless there are good and sufficient reasons to justify the default in payment of the security, the Registrar is likely to order that the opposition / revocation / declaration for invalidity proceedings be dismissed.

[End of HMD Circular 6.2]

[This part is intentionally left blank]

7 OTHER CIRCULARS

HMD Circular 7.1

7.1 Preliminary View

A. Introduction

This Circular issues guidance to users on a preliminary view ("PV") issued by the Registrar. It also crystallises the observations made in the case of *Tan Jee Liang Trading as Yong Yew Trading Company v FMTM Distribution Ltd* [2016] SGIPOS 9 ("*Tan Jee Liang*") at [26].

B. What is a PV?

A PV refers to the Registrar's provisional view (as opposed to final decision) in relation to an interlocutory request by an Applicant (e.g. for leave to file further evidence), to resolve procedural issues leading up to the final hearing.

C. Purpose of a PV

What are the main reasons for issuing a PV?

The main reason for a PV is to give parties a sense of the Registrar's inclination whether or not to allow the request for resolution of the procedural issues raised.

The issuance of a PV will save parties from incurring the additional costs of commencing an interlocutory hearing to resolve the procedural issue. Any interlocutory hearing will inevitably add to the total costs of the proceedings. As IPOS is a low cost tribunal, costs awarded are not intended to and, hence, will not compensate the parties for the expense to which they may have been put.[38]

Further, there are no appeals against interlocutory decisions of the Registrar under the TMA except where the decision terminates any matter concerning a trade mark or an application for a trade mark.[39] As such, a PV will allow parties to assess whether it is in their best interest to maintain their positions or accept the Registrar's provisional view and move on.

Basis of a PV

The Registrar's inclination at this point is preliminary and made on the basis of the representations given by the Applicant and the response, if any, by the Respondent.

[38] *Tan Jee Liang* at [27](a) and Rule 75(2) TMR
[39] *Tan Jee Liang* at [27](b) and Section 75(3) TMA

D. Issuance of a PV

What can PVs be issued for?

A PV can be issued for various procedural requests and this paragraph is non-exhaustive.

Two of the more common requests are:

(a) A request for the filing of further evidence

(b) A request for an amendment of pleadings.

When are PVs usually not issued?

For the avoidance of doubt, PVs are usually not issued in applications for extensions of time made in time. These are time-sensitive applications[40] where the Registrar may directly issue a final written decision after giving parties an opportunity to make representations.

E. Mechanism

How the issuance of a PV may arise

When an interlocutory dispute arises, the Registrar will normally first adopt a facilitative role with a view to having parties resolve the issues in the dispute by 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 deadline 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[41].

If parties are unable to resolve their differences by the end of the deadline, or at any appropriate juncture, the Registrar will issue a PV and parties will be given an opportunity to respond in writing by a deadline.

Factors considered in coming to a PV

If there are specific directions that have already been issued to address the interlocutory issue in question (e.g. application for leave to file further evidence / to cross-examine), these specific directions shall apply in priority to the factors set out below.

The Registrar will consider the parties' reasons why the request should / should not be allowed, as well as the following *non-exhaustive* factors:

(a) whether the Request could have been made earlier

(b) whether the Applicant would suffer any real prejudice if the Request is refused

(c) whether the Respondent would suffer any real prejudice which cannot be compensated with costs if the Request is allowed

(d) whether allowing the Request will enable the substantial issues to be satisfactorily considered and determined, or whether the request is only a tactical manoeuvre

(e) the stage of the proceedings when the Request was made, including considerations of disruption to proceedings and extra costs generated by the delay.

F. Objections to the PV

No objections to the PV

If no objections to the PV are received by the deadline, the decision or directions set out in the PV become final.

What happens if one or both parties object to the PV

If one or both parties object to the Registrar's PV, the Registrar may adopt one of the following approaches:

(a) *Issue a fresh PV* 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. The parties will again be given an opportunity to respond the fresh PV in writing by a deadline.

(b) *Maintain the earlier PV* notwithstanding the objections and, at the request of a party, or on the Registrar's own initiative, allow the parties to be heard either (at their election) by way of an oral interlocutory hearing or only by further written submissions in lieu of an oral interlocutory hearing.

G. Opportunity to be Heard

Written submissions and evidence

Regardless whether there will be an oral hearing, the Registrar will give directions for the filing of written submissions, bundles of authorities and reply submissions, if any. Where relevant, the parties may also be given a deadline to file evidence in support.

[40] *Tan Jee Liang* at [26(a)]
[41] *Tan Jee Liang* at [26(b)(i)]

Mode of hearing

The parties may indicate their preference for an oral interlocutory hearing or a determination on the papers.

What if the parties' preferences on the mode of hearing differ?

In the event that the parties' preferences on the mode of hearing differ, the preference of the party adversely affected by the PV will take precedence. This would be the Applicant if the PV is for the request to be refused, and the Respondent if the PV is for the request to be allowed.

Interlocutory decision

The Registrar will give an interlocutory decision after an oral hearing or a determination on the papers. If an award of costs is made, this will be in accordance with the Fourth Schedule (see **HMD Circular 6.1 at D** and **6.1 at F**).

If the decision is to allow the request, the Registrar will give the relevant directions. This includes consequential orders. For example, the Opponent is allowed to file its amended NO by a deadline, and the Applicant may file its amended CS, if any, by another deadline.

Appeal

In accordance with Section 75(3) TMA, any interlocutory decision which terminates any matter can be appealed to the High Court.

[End of HMD Circular 7.1]

HMD Circular 7.2

7.2 Stay of proceedings

A. Introduction

This Circular provides guidance regarding applications for a stay of proceedings.

B. What is a stay of proceedings?

A stay of proceedings is a temporary suspension, or keeping in abeyance, of legal proceedings. For as long as proceedings are stayed, all of the procedural deadlines are frozen and there is also no need to file for extensions of time. When the stay is lifted, unless the Registrar orders otherwise, the default position is that any deadlines will be extended accordingly.

> Illustration: Party X has 7 days to meet a certain deadline to file evidence. On that day, X applies for and is granted a stay of proceedings. The stay is lifted

2 months later. Because timelines are extended accordingly, on the day the stay is lifted, X has 7 days to meet the extended deadline.

C. Where does the Registrar's power to stay proceedings come from?

The Registrar has broad case management powers, which include making appropriate orders or directions for the "*just, expeditious and economical disposal of the matter*": see Rules 36A and 81A TMR. These powers include the power to stay proceedings in the appropriate case. Rule 81C(1) TMR also specifically empowers the Registrar to stay one set of proceedings until another set of proceedings has been determined.

D. How does one apply for a stay of proceedings?

Applications for a stay of proceedings should be made by way of correspondence in IPOS Digital Hub. The requesting party should explain why a stay of proceedings is sought, as well as whether consent from the other side has been obtained.

E. In what situations might a stay be allowed?

Where the parties agree to submit their dispute to mediation, it is likely that the Registrar will grant a stay of proceedings for a 30-, 60- or 90-day period (which may be extended).

Apart from cases where the dispute is submitted to mediation, there are two established categories of cases where a stay of proceedings may be granted. They are:

(a) Concurrent Proceedings: Where there are concurrent proceedings and the outcome of the other proceedings is likely to have a material impact on the proceedings sought to be stayed

(b) Security for Costs: Where the Registrar has made an order for security for costs but such security has not been provided.

That said, the categories of cases where a stay may be granted are not set in stone. Even if a case does not fall into the above categories, the Registrar has the discretion to allow the dispute to be stayed if the circumstances justify it.

F. What if the parties are engaged in negotiations? Will the Registrar grant a stay?

As a general rule, the Registrar will not grant a stay of proceedings if the parties are seeking time to negotiate a resolution to the dispute.

An alternative to seeking a stay of proceedings—where parties are negotiating—is to file for an extension of time coupled with a request for longer deadlines.

G. Stays in concurrent proceedings

The Registrar may allow a stay of proceedings where there are concurrent proceedings the outcome of which is likely to have a material impact on the proceedings sought to be stayed.

Generally speaking, if the concurrent proceedings in question are before any court in Singapore, or at IPOS, and there are good reasons for waiting for the outcome of those other proceedings, a strong argument can be made for a stay of proceedings. However, if the concurrent proceedings are in some other forum e.g. a foreign court, then the Registrar may be slow to allow a stay in the absence of some other facts.

In deciding whether to grant a stay in cases involving concurrent proceedings, the Registrar may take the following non-exhaustive (and often interconnected) factors into account:

(a) Whether there is some common question of law or fact in the proceedings: Rule 81C(1)(a) TMR

(b) Whether the rights to relief claimed are in respect of or arise out of the same factual situation: Rule 81C(1)(b) TMR

(c) The stage at which the present proceedings and/or other proceedings sought to be stayed at IPOS are at

(d) Whether the Registrar should allow longer deadlines or consolidate the proceedings instead of imposing a stay

(e) Whether the outcome of the other proceedings has a material bearing on the dispute before the Registrar at IPOS. When an outcome is expected, whether there is the possibility of an appeal or some other challenge

(f) Whether it is likely that the outcome of the other proceedings would trigger a settlement of the present proceedings

(g) Whether the other party is in support of a stay of proceedings.

[End of HMD Circular 7.2]

[This part is intentionally left blank]

ANNEX A: CHANGE LOG

Amendment	Date	Summary of amendments	Marked-up amendments
No. 1 of 2020	12 June 2020	1. HMD Circular 2.1 at D 2. HMD Circular 2.2 at D and G 3. HMD Circular 2.3 at C and D	Amendment No. 1 of 2020
No. 1 of 2021	15 October 2021	1. HMD Circular 2.1 at B, C and E 2. HMD Circular 2.3 at C 3. HMD Circular 3.2 at E and H 4. HMD Circular 5.1 at B and E 5. HMD Circular 5.2 at A, B, D and H 6. HMD Circular 6.1 at B, F and G	Amendment No. 1 of 2021
No. 1 of 2022	25 May 2022	1. Important notice 2. Glossary of commonly used identifiers 3. HMD Circular 1.1 at B 4. HMD Circular 1.2 at A 5. HMD Circular 1.3 at C 6. HMD Circular 1.4 at C, D and E 7. HMD Circular 1.6 at E 8. HMD Circular 1.7 at D and G 9. HMD Circular 2.1 at A, B, C, D and E 10. HMD Circular 2.2 at A, C, D, F, G and J 11. HMD Circular 2.3 12. HMD Circular 3.3 13. HMD Circular 5.2 at B and H 14. HMD Circular 6.1 at A, C, D, E and F 15. HMD Circular 6.2 at E and F 16. HMD Circular 7.1 at C and D 17. HMD Circular 7.2 at B, C, D, E, F and G	Amendment No. 1 of 2022
No. 1 of 2023	4 August 2023	1. HMD Circular 2.1 at C	Amendment No. 1 of 2023
No. 2 of 2023	23 November 2023	1. HMD Circular 2.1 at C and D	Amendment No. 2 of 2023
No. 1 of 2025	10 January 2025	1. HMD Circular 5.2 at C 2. HMD Circular 6.1 at A, E and F 3. HMD Circular 7.1 at G	Amendment No. 1 of 2025