

CROSS-EXAMINATION OF WITNESSES IN PROCEEDINGS BEFORE THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE: Some Factors to Consider When Deciding Whether To Apply for Cross-Examination in Trade Mark Proceedings

I. INTRODUCTION

1. The Intellectual Property Office of Singapore (“IPOS”) is a low cost tribunal,¹ and the costs that a party may recover from contentious proceedings before the Hearings and Mediation Group of IPOS tend to be limited. For instance, under IPOS’ **Scale of Costs**,² the amount of costs that would be awarded for the attendance of a hearing would be between S\$200 to S\$800 – this may be said to be substantially less than what would be awarded for the attendance of a similar hearing before the High Court in Singapore.³
2. In light of this, a party (“**Party A**”) involved in IPOS proceedings may be reluctant to adopt other optional procedural steps, such as applying for the **cross-examination of the opposing party’s (“Party B”) witness(es)**, so as to help better manage its costs. For instance, Party A may decide not to incur additional legal costs in applying for and conducting the cross-examination since the majority of such costs are unlikely to be recovered from the Party B even if Party A succeeds in establishing its case.
3. Nevertheless, there will be situations where the incurring of such costs may be preferential / necessary in order for Party A to successfully establish or prove its case.
4. This article therefore discusses some factors relating to an application for cross-examination of witnesses in IPOS proceedings relating to trade marks.

II. SCENARIOS WHERE CROSS-EXAMINATION MAY BE DESIRABLE FOR IPOS PROCEEDINGS RELATING TO TRADE MARKS

5. In general, Party A will need to be able to flesh out all the relevant facts to establish or prove its case. This would in turn generally depend on, *inter alia*, the following:⁴

¹ See Section C of *HMD Circular No. 1/2015 dated 25 May 2015*.

² See the Fourth Schedule of the *Trade Marks Rules* (Cap. 332, r. 1); the Fourth Schedule of the *Registered Designs Rules* (Cap. 266, r. 1); and the Third Schedule of the *Patent Rules* (Cap. 221, r. 1).

³ See Appendix G of the *Supreme Court Practice Directions* which sets out guidelines for party-and-party costs awards in the Supreme Court of Singapore.

⁴ See [05.008] and [09/053] of Eleanor Wong et al., *Modern Advocacy: Perspectives from Singapore* (2008).

- (a) the recollection of witnesses (ie. the evidence of **Party A's or Party B's** witnesses); or
 - (b) documentary evidence.
6. To this end, there may be situations where Party B adduces (or refuses to adduce evidence) that it has access to, and which Party A has no prior knowledge of. In such situations, cross-examination may help Party A challenge **Party B's evidence** by:
- (a) eliciting helpful admissions, concessions or other relevant evidence from **Party B's witness(es)**; and/or
 - (b) discrediting and casting **doubt on the veracity of the evidence of Party B's witness(es)**.⁵
7. The following are some examples where cross-examination may be especially useful to consider:
- (a) Where Party A alleges that Party B has filed a trade mark application in bad faith and seeks to oppose the same under section 7(6) of the *Trade Marks Act* (Cap. 332), Party B may adduce evidence showing that it allegedly **created the trade mark independently and without knowledge of Party A's** trade mark(s) (or other circumstances). In this scenario, Party A may not have any evidence of its own to show how Party B created the trade mark and may wish to resort to cross-examination to test the truth of Party B's evidence. In this regard, it is pertinent to note that in *Arjo Wiggins Fine Paper Limited v. Transasia Fine Papers Pvt Ltd* [2016] SGIPOS 2, IPOS appears to suggest that it would be necessary for there to be a **cross-examination of Party B's witness(es) in cases where Party A's case is based on the sole ground of bad faith**.⁶
 - (b) **Where Party A applies to revoke Party B's trade mark** for non-use under section 22 of the *Trade Marks Act* (Cap. 332), Party B may seek to rely on evidence purporting to show use of the trade mark and it is possible that Party A may not have direct evidence to challenge the same (such as if Party B adduced evidence showing purported use at an earlier date in an obscure location (that no longer exists) which Party A would have no way of investigating or verifying).⁷ In such a case, Party A may wish to resort to

⁵ See [07.012] of Eleanor Wong et al., *Modern Advocacy: Perspectives from Singapore* (2008).

⁶ [5] of *Arjo Wiggins Fine Paper Limited v. Transasia Fine Papers Pvt Ltd* [2016] SGIPOS 2 states: "Neither of the deponents [of the Registered Proprietors' evidence] was called to the stand as witnesses for cross-examination, despite the case being based on the sole ground of bad faith under Section 23(1) read with Section 7(6) of the Act."

⁷ See [64] and [74] of *Tan Jee Liang trading as Yong Yew Trading Company v. FMTM Distribution Ltd* [2016] SGIPOS 09.

cross-examination to try to establish whether Party B had fabricated / concocted the said evidence as a mere afterthought, and in doing so try to persuade IPOS to disregard the said evidence adduced by Party B.

8. Further to the above, IPOS has in *HMD Circular No. 4/2015 dated 30 June 2015 (Amended 22 July 2016)* stated that “a request for cross-examination is likely to be allowed where it is not disproportionate and unnecessarily costly and burdensome” and set out the following non-exhaustive⁸ examples where cross-examination (by Party A) would be allowed:
- (a) Where one of the issues raised in the dispute is bad faith, and cross-examination is to the particulars of **bad faith alleged in Party B’s witness(es)’ evidence**.
 - (b) **Where Party A has reason to believe that Party B’s witness(es)’ evidence** contain unreliable evidence which are relevant to the issues raised in the dispute.
 - (c) Where there is conflicting evidence on the facts that are relevant to the issues raised in the dispute, and cross-examination would assist in clarifying the situation.
9. Accordingly, there will be scenarios / situations where Party A’s own evidence would not be sufficient to establish its case in IPOS proceedings, and where it may need to apply for **cross-examination of Party B’s witness(es) with a view towards** trying to establish its case.
10. Nevertheless, in coming to its decision, Party A must also bear in mind that Party B may as a counter-tactic apply for **cross-examination of Party A’s witnesses** as well. **While Party B’s application is likely to be subject to** the same test / requirements (which is further discussed at Section III below), it may be more difficult for Party A to oppose such an application if Party A has itself applied for cross-examination; this is since **Party A’s application** may be considered as an implicit / implied acceptance that the facts / evidence before IPOS would have to be exposed to the rigours of cross-examination (eg. due to unreliable or conflicting evidence).
- III. **THE PROCEDURE FOR APPLYING FOR CROSS-EXAMINATION IN IPOS PROCEEDINGS RELATING TO TRADE MARKS**
11. As alluded to above, cross-examination is not an automatic right in IPOS proceedings relating to trade marks, and Party A will have to apply for permission

⁸ See [70] of *Tan Jee Liang trading as Yong Yew Trading Company v. FMTM Distribution Ltd* [2016] SGIPOS 09.

to do the same.⁹ Reference is made to Rule 36A(1) of the *Trade Marks Rules* (Cap. 332, r. 1) which states:

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

12. Once Party A has decided to apply for cross-examination, it should be cognisant of the requirements / procedure required by IPOS, which is set out in *HMD Circular No. 4/2015 dated 30 June 2015 (Amended 22 July 2016)*. In particular, Party A should do the following:

- (a) Submit a written request to IPOS (at the earliest opportunity and preferably prior to the Pre-Hearing Review) for leave to cross-examine **Party B’s witness(es)**. The said written request should set out:
 - (i) **The name(s) of Party B’s witness(es) that Party A wishes to cross-examine.**
 - (ii) Reasons why cross-examination of each of the witnesses is requested.
 - (iii) Specific issues to which cross-examination would, if allowed, be directed. The said issues need not be a list of questions, which IPOS recognises may forewarn Party B and defeat the intended purpose of the cross-examination.¹⁰ Instead, a useful starting point would **be to consider “what”, “where”, “when”, “which”, “how” and “who” questions.**¹¹
 - (iv) An explanation of the relevance of the issues in sub-paragraph (iii) above to the matters to be decided in the proceedings. In the event that the issues to be cross-examined on are not relevant or material, it is possible that IPOS may refuse the request.¹²
 - (v) An estimate of the time required for cross-examination, bearing in mind that IPOS is a low cost tribunal and is unlikely to allow

⁹ See [29] of *Tan Jee Liang trading as Yong Yew Trading Company v. FMTM Distribution Ltd* [2016] SGIPOS 09.

¹⁰ See [79] of *Tan Jee Liang trading as Yong Yew Trading Company v. FMTM Distribution Ltd* [2016] SGIPOS 09.

¹¹ See [83] to [85] of *Tan Jee Liang trading as Yong Yew Trading Company v. FMTM Distribution Ltd* [2016] SGIPOS 09.

¹² See [68] and [69] of *Tan Jee Liang trading as Yong Yew Trading Company v. FMTM Distribution Ltd* [2016] SGIPOS 09.

lengthy periods of cross-examination.¹³ In this regard, it would appear from the case of *Tan Jee Liang trading as Yong Yew Trading Company v. FMTM Distribution Ltd* [2016] SGIPOS 09 that a period of 30 minutes to 1 hour per witness would be acceptable.¹⁴

- (b) Extend a copy of the said written request to Party B (or any other parties to the proceedings).
13. After Party A has submitted its written request, Party B would have an opportunity **to respond to Party A's** request by writing to IPOS to set out its objections / position, before IPOS provides an indication / decision on whether to grant Party A permission to **cross-examine Party B's witness(es)**. **Depending on the** circumstances in question, an interlocutory hearing may be required before IPOS makes a decision.
14. Should Party A be granted permission to **cross-examine Party B's** witness(es), it should be mindful to keep within the allowed scope during the actual conduct of the cross-examination. This is particularly **since "untrammelled latitude to cross-examine a witness will not be granted [by IPOS]"**¹⁵ and it is likely that any attempts to go beyond the scope allowed will be objected to by IPOS and/or Party B.

IV. CONCLUDING REMARKS

15. Whether Party A decides to apply for cross-examination will depend on a multitude of factors, and each set of facts and circumstances should be carefully considered on a case-by-case basis.
16. Should Party A be minded to apply for cross-examination, it should ensure that it has a clear understanding and indication of why it wishes to do so and what it intends to achieve from the same. This would in turn have an impact on whether Party A is able to persuade IPOS (and/or Party B) to allow it to cross-examine Party **B's witness(es)**, and whether Party A is able to rely on this to help establish its case.

If you would like to have further information on this write-up, please contact:

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¹³ [90] to [94] of *Tan Jee Liang trading as Yong Yew Trading Company v. FMTM Distribution Ltd* [2016] SGIPOS 09.

¹⁴ See [90] to [94].

¹⁵ See [76] of *Tan Jee Liang trading as Yong Yew Trading Company v. FMTM Distribution Ltd* [2016] SGIPOS 09.