

**Compendium of Hearings & Mediation Department Circulars
Amendment No. 1 of 2021
15 October 2021**

HMD Circular 2.1

2.1 Filing of documents

B. Why e-file using IP²SG? References

~~Parties are encouraged to e-file their forms and documents using IP²SG. The advantage of e-filing is that parties have an automatically confirmed filing date, since receipt of the form or documents is reflected immediately in the system. IPOS staff will be able to access it immediately. Filing forms and documents via the Service Bureau may result in some delay due to the time needed to digitise the documents and upload them into IP²SG. 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. How to e-file using IP²SG?

If a form or document is not filed under the correct link in IP²SG, the filing date cannot be automatically confirmed. The following table sets out the correct links for e-filing:

S/No.	Item to be E-filed	Description of Form in IP²SG	File Via
1.	Notice of Attendance at Hearing	Form HC1	E-file by way of "Online Filing" → "Forms"
2.	Request to Extract the Registrar's Certificate of Taxation (for award of costs made before 1 October 2021)	Form HC2	
...			
24.	Bill of Costs	Bill of Cost	E-file by way of "Online Filing" → "Forms"
25.	Marked Bill of Costs	Marked Bill of Cost	

~~**Notes:** Party without IP²SG account will have to file via hard copy over the counter.~~

...

E. Filing or Submission of hard copies for the purposes of hearing

Filing of hard copies for the purpose of securing a filing date

~~SDs, Written Submissions and Bundles of Authorities **filed** in hard copy over the counter, for the purpose of securing a filing date, are subject to Service Bureau charges. The Service Bureau is established to assist a person in the use of the electronic online system for giving, sending to, filing with or serving any document on the Registrar or the Registry (see Rule 78I (Service Bureau) TMR).~~

~~Further details on the Service Bureau charges are found in the IP²SG Circular at paragraph 11 and at the IPOS website at:~~

~~<https://www.ipos.gov.sg/manage-ip/resolve-ip-disputes/forms-fees>~~

Submission of hard copies for the purposes of hearing

~~During the PHR, parties should discuss if The Registrar may direct parties to submit hard copies of SDs, Written Submissions and Bundles of Authorities **are useful** for the purposes of a hearing. If ~~it is decided or agreed that hard copies will be useful for the purpose of a hearing~~, so, the parties ~~could~~ would electronically file their Written Submissions and Bundles of Authorities via IP²SG ~~(to avoid Service Bureau charges)~~ and also **submit** hard copies of the relevant documents to the Registrar by hand or by post. ~~Parties may also submit hard copies of their SDs to the Registrar by hand or by post, if they have filed these earlier on through IP²SG.~~~~

~~In this situation where SDs, Written Submissions and Bundles of Authorities are submitted in hard copies over and above the electronically filed copies, the Service Bureau charges do not apply. This is because the hard copy document is provided to the Registrar for ease of reference in preparation for or during the hearing.~~

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 ~~at the top right hand corner of each page~~. 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, cases², ~~statutes, subsidiary legislation~~ 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 or ask the party to ~~re-file~~, re-submit and/or re-serve any document not in compliance with the above.

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.

HMD Circular 2.3

2.3 Filing of Geographical Indication documents

C. How may GI documents be filed with the Registrar?

Rule 9 GIR lists the modes to file documents with the Registrar. They are:

- (a) By post
- (b) By hand

The Registrar has also permitted the filing of documents via FormSG (see Registries Practice Direction No. ~~3 of 2020~~ 1 of 2021).

The electronic online system is **not** available for filing GI documents.

HMD Circular 3.2

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

E. Application for revocation of extension of time¹⁷

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. **He 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.¹⁸

G. Registrar may extend subsequent deadlines

The applicable rules envisage¹⁹ and provide²⁰ 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 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 envisage²¹ and provide²² 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

¹⁷ Rules 32(8), 33(8), 34(8) TMR

¹⁸ Rules 32(6), 33(6), 34(6) TMR

¹⁹ Rules 31A(4), (5) and 59(1A)(df) and (eg)(ii) TMR

²⁰ Rules 32(7)(a) and 33(7)(a) TMR

²¹ 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

²² Rules 31A(1A), (1B) and 59(1A)(aa), (ab) TMR

representations, upon which the Registrar may exercise the power under Rule 31A(1A) TMR and shorten the deadlines.

HMD Circular 5.1

5.1 Pre-Hearing Review

B. Timing and purpose of PHR

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

HMD Circular 5.2

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

A. Introduction

~~The focus of this circular is on the Pre-Hearing Review (“PHR”) in trade marks proceedings before the Registrar. However, in general, the practice in this circular also applies to patents and registered designs proceedings before the Registrar, respectively under Rule 88B of the Patents Rules (Cap 221, 2007 Rev Ed), where the term “case management conference” instead of “PHR” is used, and under Rule 47A of the Registered Designs Rules (Cap 266, 2002 Rev Ed). This Circular explains what a full hearing entails and gives guidance on matters relating to a full hearing.~~

B. Cross-Examination

...

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 ~~decides~~ **directs**.

...

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 ~~such~~ **the counter**-parties have legal representation.

This is intended to ~~help parties~~ save costs ~~where their lawyers already have access to the case authorities~~. 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.

...

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, ~~whether in hard copies through the Service Bureau or~~ via IP²SG 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, ~~whether in hard copies through the Service Bureau or~~ via IP²SG, in addition to any hard copies provided to the Registrar at the hearing, as soon as possible after the hearing.

HMD Circular 6.1

6.1 Award of costs and taxation

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 17(16) Trade Marks (Amendment) Rules 2017~~

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.

...

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.³⁴

In exceptional cases, for example, where a party’s behaviour is unreasonable³⁵, 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.

³⁴ 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.

³⁵ 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...”

Fourth Schedule

Item	Matter	Amount
...		
TAXATION		
10	Drawing bill of costs <i>Amount allowed according to the number of folios in bill of costs³⁸</i>	\$6.50 per folio ³⁷
11	Attending taxation and obtaining the Registrar's certificate or order <i>The factor to be considered for attending taxation is the time taken for the taxation proceeding.</i> <ul style="list-style-type: none"> • 1 hour or less: \$130 to \$200 • More than 1 hour: \$200 to \$390 <p><i>For obtaining the Registrar's certificate or order in "paper" taxations (where there is no attendance): Fixed quantum of \$130 for obtaining the Registrar's certificate or order, including subsequently applying for the certificate of taxation</i></p>	\$130-\$390

...

G. Disbursements

...

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 ~~is found~~ are not ~~to be~~ 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.

³⁷ Defined as 100 words, each figure being counted as one word, in Rule 2(1)

³⁸ 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.