Evidence

In the Trade Marks Registry, "evidence" is the means by which the Registrar is placed in possession of any fact, either alleged in any statement of case or counter-statement or of factual distinctiveness of a trade mark, upon which he has to adjudicate. Evidence in general is subject to the provisions of the Evidence Ordinance (Cap. 8).

Statutory Provisions

Section 78 provides:

- Except as otherwise provided in this Ordinance, the Registrar is not bound by the rules of evidence in any proceedings before him under this Ordinance and may inform himself of any matter that is before him in any way that he reasonably believes to be appropriate.

Despite the broad terms of section 78, the Registrar will generally apply the rules of evidence as they apply in superior courts. The purpose of section 78 is to prevent the miscarriage of justice occasioned by the strict application of the rules of evidence in circumstances beyond the control of the party filing evidence. As such it will be sparingly applied. It is not to be seen as a licence to disregard the hearsay evidence rules; the giving of evidence except as permitted by rules 79 and 80; or the submission of "evidence" informally.

The reason the section will be sparingly applied is that, should the decision of the Registrar be appealed, the court will have the same evidence before it as was before the Hearing Officer. If part of that evidence would have been inadmissible in court, then the court will not have the same evidence before it.

Section 91(2) provides that :

> The Registrar may make rules –
>
> (2)(k) regulating the mode of giving evidence in any such proceedings, whether orally or in writing and whether by means of the production of documents or articles or otherwise;

Rule 79 provides :

- Where under the Ordinance or these Rules evidence may be admitted by the Registrar in any proceedings before him, the evidence shall be filed by way of a statutory declaration or affidavit.

- The Registrar may in any particular case take oral evidence in addition to any evidence filed by way of a statutory declaration or affidavit.

- The Registrar shall allow any witness to be cross-examined on his statutory declaration, affidavit or oral evidence.

Statutory declarations and affidavits

Rule 80 provides a way a statutory declaration or affidavit may be taken for the purposes of proceedings before the Registrar.

Persons authorised to take statutory declarations and affidavits

A statutory declaration or affidavit may be made and subscribed –

- ***In Hong Kong*** : before any commissioner, notary, or other person authorised by the law of Hong Kong to administer an oath for the purposes of any legal

proceedings (rule 80(1)(a)). Section 7A of the Legal Practitioners Ordinance (Cap. 159) permits any solicitor who holds a current practising certificate to exercise all the powers of a commissioner for oaths.

- ***Outside Hong Kong*** : before any court, judge, justice of the peace, notary, notary public, consul or other person authorised by the law in that country to exercise notarial functions or to administer an oath for any legal proceedings.

The practice, apparently prevalent in Japan, of having a third party confirm the signature of the deponent to the notary, does not comply with this rule. The Registrar may accept any seal or signature purporting to be that of a person authorised under rule 80(1) without further proof (rule 80(3)).

Other formal requirements of statutory declarations and affidavits

Intitulling

Each statutory declaration or affidavit should clearly identify the proceedings for which it is filed. There is no statutory format, but the following requirements constitute good practice. It should :

- correctly state the trade mark application number to which it applies;

- contain the heading IN THE MATTER OF THE TRADE MARKS ORDINANCE (Cap. 559);

- name the parties involved; and

- identify the document, i.e. statutory declaration of ABC or affidavit of XYZ.

Evidence should not be intitulled for more than one set of proceedings unless the two (or more) sets have previously been consolidated.

Capacity

A statutory declaration or affidavit must be in the first person. It cannot be made in the name of a company. If it is made on behalf of a partnership, body corporate or unincorporated body or association of persons within the meaning of rule 118, the capacity in which the declaration (or affidavit) is made must be stated (rule 80(2)). It may be made by two or more persons, but in such a case both names must be included, i.e. "We ABC and XYZ….".

Attestation

Although the witness before whom the statutory declarations or affidavits may be declared or sworn are provided by rule 80, the form of attestation is not. If made in Hong Kong, the form is governed by the Oaths and Declarations Ordinance (Cap. 11). Schedule 1 of the Ordinance provides the following form for a declaration :

> I, AB, of solemnly and sincerely declare that .
>
> And I make this solemn declaration conscientiously believing the same to be true and by virtue of the Oaths and Declarations Ordinance.
>
> (signed) AB
>
> Declared at in Hong Kong this day of
>
> Before me,
>
> [Signature and designation, i.e. Justice of Peace/Notary Public/Commissioner for Oaths.]

No statutory form is provided for an affidavit. Please refer to the aforesaid Schedule for the form of oath for a person not familiar with the English or Chinese language and the declaration or oath of an interpreter.

Where the statutory declaration or affidavit is made overseas and the attestation differs in form from that provided above, the evidence will be admissible if the Registrar is satisfied of the documents' worth as evidence. Normally, if it appears to be a serious statement of the witness' evidence and provided that the evidence is made and subscribed before a notary or other acceptable person, it will be admitted.

Language

A statutory declaration or affidavit may be made and/or sworn in either of the official languages. This power is found in section 23 of Cap. 11. However also see next section on *Translations*.

Translations

Rule 120(2) provides that the Registrar may, in respect of any document or part thereof to be used for the purpose of evidence in proceedings before him (which would include a declaration or affidavit) which is not in the language of the proceedings, give directions as to the filing of that document in the "language of the proceedings" and specify the period within which translations are to be provided. This period can be extended at the Registrar's discretion (rule 94).

A request to extend the time specified under rule 120(7) must be served on every party to the proceedings (rule 94(2)).

Section 76 provides that the language in which an application for registration of a trade mark is filed shall be used as the "language of the proceedings" in all proceedings

before the Registrar. Note that the "language of the proceedings" may, with the consent of the parties, be changed upon such terms as the Registrar directs (rule 119).

Rule 120(1) provides that where any document or part thereof, that is not in one of the official languages, is filed, it shall be accompanied by a translation into the language of the proceedings. Such translation must be verified to the satisfaction of the Registrar as corresponding to the original text. In that connection, it has to be verified by the translator himself/herself or a person who has qualification/knowledge to certify the translation. The certification may be made in the following form and should be duly signed by the certifier and dated:

> "I [name of certifier] of [address of certifier] being fully conversant in both English/Chinese and [the other language], am qualified to translate [description of the attached document] from [the other language] into English/Chinese and I certify that [description of the translated copy] is a true and correct English/Chinese translation of the [description of the attached document].

A notarial certificate in a foreign language must be translated into the language of proceedings.

Signature

Declarations or affidavits must be signed. If not signed they cannot be accepted as "evidence". The signature or seal of the witness must also appear at the end of the document.

Exhibits

A statutory declaration or affidavit may refer to exhibits to support the case. These are usually referenced by the initials of the declarant or deponent and numbered sequentially, i.e. XYZ-1; XYZ-2, etc.

Exhibits consisting of a bundle of papers should have a header sheet. The header sheet should identify the exhibit, e.g. "This is the exhibit marked XYZ-1 referred to in the statutory declaration of XYZ made this …day of ….". The date on the header sheet should be the same as the date shown on the statutory declaration or affidavit. Exceptions may be made where the Registrar is satisfied that the practice in a particular country of state is that the notary will not attest to the exhibits. A notary in another State will need to attest to these.

Unusual exhibits, e.g. sample bottles, need not be filed with the statutory declaration or affidavit provided an adequate photograph of sufficient size and clarity to properly depict the essential features of the exhibit is substituted. The photograph must also be sent to the other party (rule 81(1) and (2)).

A party who files a photograph under rule 81(1) must give a written undertaking to the Registrar at the time of filing the statutory declaration or affidavit that he will produce the original of the exhibit whenever required by the Registrar and will make it available for inspection by the other party to the proceedings (rule 81(3)). The undertaking may be limited in time to expire at the end of the appeal period if no appeal or leave for an extension of time to appeal is lodged.

The original of any exhibit for which a photograph is filed under rule 81(1) shall be produced at the hearing unless the Registrar otherwise directs (rule 81(4)).

Note the section refers to a photograph not a photocopy.

A party seeking directions regarding this requirement pursuant to rule 88 is reminded that the direction cannot be inconsistent with the Rules (rule 88(2)).

Content of statutory declaration or affidavit

The purpose of evidence in *inter partes* matters is to support the pleadings. The evidence should assert the facts relied on and the exhibits filed should prove the fact. Submissions, opinions, speculation and matter which does not assert the fact or support the pleadings have no place in the evidence and may lead to applications to strike out. Unless a party has been put to strict proof on a pleading, consideration should be given as to whether proof of an unchallenged pleading is necessary.

Hearsay evidence

Hearsay evidence is the evidence of an oral statement or a statement in a document of a person other than the witness who is testifying, offered to prove the truth of what is asserted.

The Registrar takes the view that the Evidence Ordinance as amended by 2 of 1999 (Part IV Hearsay Evidence in Civil Proceedings) has no application to proceedings before the Tribunal. The Registrar has reached this conclusion based on the definition of "civil proceedings" contained in section 46 of Cap. 8, namely that it means civil proceedings before any court (or tribunal) in relation to which "strict rules of evidence apply…". By virtue of section 78 that is not the case in proceedings before the Registrar.

Nevertheless the Registrar will be guided by Part IV of Cap. 8 and will generally not exclude any document which would be admissible in the Court.

The fundamental rule is that hearsay evidence, of whatever degree (whether it is double, triple or multiple hearsay), will not be excluded on the grounds that it is hearsay unless :

- a party against whom the evidence is to be adduced objects to the admission of the evidence; and

- the Registrar is satisfied that the exclusion of the evidence is not prejudicial to the interests of justice.

Unless a party intends to adduce *viva voce* evidence and has been granted leave to do so under rule 79(3), there is no requirement for the party adducing hearsay evidence to give prior notice of his intention.

In estimating the weight, if any, to be given to hearsay evidence, the Registrar shall take into consideration any inference that can reasonably be drawn as to the reliability of that evidence and whether:

- it would have been reasonable and practicable for the person who made the statement to have made a declaration or affidavit;

- it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

- the statement was made contemporaneously with the occurrence of the event or existence of the matter stated;

- the evidence contains multiple hearsay;

- the maker of the original statement has a personal interest in the acceptance of the evidence or any motive to conceal or misrepresent matters;

- the original statement was an edited account, or made in collaboration with another; and

- any other circumstances which would suggest an attempt to prevent a proper evaluation of its weight.

Oral evidence

Oral evidence may only be adduced, provided the Registrar has previously granted leave, in addition to evidence filed by statutory declaration or affidavit. There is no longer provision for oral evidence to be given in lieu of a statutory declaration or affidavit.

A party wishing to adduce oral evidence in addition to his statutory declaration should notify the Registrar and the other side as soon as practicable after the date for the hearing of argument is notified to the parties. At the very latest, the matter should be raised at the pre-hearing review. If the other party consents, this will be a factor taken into account by the Registrar in exercising his discretion. If the other party does not consent, an interlocutory hearing should be sought, or the matter argued at the pre-hearing review.

It is important to keep in mind that this is an exceptional procedure and good reasons will need to be advanced before the Registrar. Factors that the Registrar will take into account in exercising his discretion are whether new evidence is intended to be introduced, and if so whether this evidence might reasonably have been available and filed during the appropriate evidence round.

Cross-examination

Any party wishing to cross-examine any person who has filed a statutory declaration should notify the Registrar and the other party as soon as practicable after the date for the hearing of argument is notified to the parties. At the very latest, the matter should be raised at the pre-hearing review. If the other party consents, this will be a factor taken into account by the Registrar in exercising his discretion. If the other party does

not consent, an interlocutory hearing should be sought, or the matter argued at the pre-hearing review.

The Registrar will, within reason, allow a party to test evidence which would be relevant, if true, and which the other party is not prepared to accept, save where to allow cross-examination would be gravely oppressive. There is no necessity to show a direct conflict of evidence on a particular point. Leave to cross-examine will not be granted when there is nothing to test as the evidence in question is irrelevant. See *Alliance & Leicester Plc's Trade Mark Application* [2002] RPC 29 at 583.

In UK there is a trend towards more cross-examinations. This is because the tribunal is the primary finder of fact and appeals from the registrar's decisions are by way of review. In Hong Kong, any appeal is a hearing *de novo* and leave may be granted by the appellant court for the filing of further evidence. The UK trend towards more cross-examination is accordingly not so appropriate in Hong Kong.

Compelling attendance of witnesses

Section 71(1) provides that :

The Registrar may, for the purposes of proceedings before him under this Ordinance –

(a) summon witnesses;

When leave to cross-examine is granted, it will generally be up to the party who filed that deponent's evidence to tender the witness for cross-examination. The provisions of section 71(1) will be regarded as the last resort.

If a party summoned by the Registrar fails to attend the hearing, the Registrar may, after hearing the parties, adjourn the hearing pursuant to rule 76(3), and apply for the leave of the Court of First instance for enforcement of the order pursuant to section 71(3).

Giving oral evidence

There is no provision dictating when, during the course of the proceedings, oral evidence should be taken. The matter is best determined in each case on the balance of convenience.

The statutory declaration of the deponent will be considered to be that witness's evidence-in-chief. The witness should however be asked first whether he is the deponent of the statutory declaration in question. The witness is then cross-examined by the other party's counsel, and if required, the witness may be re-examined by the party tendering him. Re-examination is confined to matters raised in cross-examination. Leading questions may not be put.

If the Registrar has any further questions not relating to matters raised by counsel's questioning, he will put them after re-examination. Each counsel will then be given an opportunity to cross-examine and re-examine on the answers given to those questions only.

The normal rules relating to refreshing of memory, leading questions, new evidence and exclusion of witnesses who have yet to give evidence as applied in the courts shall equally apply before the Registrar.

Oral evidence is to be given on oath or affirmation. The Registrar has the power under section 71(1)(b) to administer such an oath or affirmation. Any particular requirements for the taking of an oath dictated by the deponent's religion should be notified to the Registrar in ample time to make arrangements for the proper holy book to be available.

Evidence not in the language of the proceedings

If a witness wishes to give evidence in a foreign language, or in a language other than the language of the proceedings, the Registrar and the other party must be given at least 10 days written notice. The power to allow this course of action is discretionary. The Registrar, if he allows it, may require the party seeking to call the witness to make provision for interpretation into the language of the proceedings and may give directions as to who should bear the costs (rule 78).

Defects in evidence

Evidence is a legal document. If defects are found in either the heading, content, attestation or exhibits, the matter should be referred back to the filer so that he is given an opportunity to put his evidence in order.

The Hearing Team should not amend any evidence even if the filer gives their permission as this may affect the admissibility of the evidence. The document should be returned to the filer for correction and checked upon its return that the correction has been initialled by the declarant or deponent and the witness.

The Registry cannot dictate how evidence is presented. Defects can be brought to the filer's attention, but if the filer does not wish to amend the document, it must be accepted. Whether it will be taken into account at the hearing is a decision for the Hearing Officer concerned.

Rectification of irregularities

The Registrar has the discretionary power under rule 93 to rectify any irregularity in procedure in, or before, the Registry save that no period of time can be extended under the rule. Without limiting the generality of this provision, it may be invoked to amend errors in the intitulling, exhibit pages, and paragraph numbering. It cannot be used to correct the text of a statutory declaration or omission of exhibits. These errors may be cured by filing subsidiary declarations. The rule cannot be used to correct an omission not obvious on the face of the document i.e. omission of a priority claim.

Striking out evidence

There is no specific provision in the trade marks legislation for the striking out of evidence so the Registrar may follow Order 18 rule 19 of the Rules of the High Court.

The available grounds are :

- The pleadings do not disclose a reasonable cause of action or defence;
- They are scandalous, frivolous or vexatious;
- They may prejudice, embarrass or delay the fair trial of the proceedings; or
- It is otherwise an abuse of the process of the tribunal.

No evidence can be admitted for an application based upon the first ground, the viability of the action or defence must be judged by the pleadings alone (Order 18 rule 19(2)).

This is "a drastic remedy" so "it follows that no court should give effect to it unless it is satisfied that the legal basis of the claim is unarguable or almost incontestably bad…where the legal viability of the cause of action is sensitive to the facts, an order to strike out should not be made." per Litton VP in *Yue Xiu Finance Co. Ltd. v Agnew & Ors* [1996] 2 HKC 122. "The court will be particularly careful in exercising this exceptional jurisdiction when the pleading sought to be struck out is a defence, though it will do so if it is satisfied that the defendant 'has not a shadow of a defence'". *Hutchvision Asia Ltd. v Asia Television Ltd.* [1993] 2 HKC 510.

An interlocutory hearing will be arranged in the event that the filer of evidence challenges the Registrar's intention to strike out any part of his evidence.

Withdrawal of evidence

Any party wishing to withdraw any part of his filed evidence should make the request to the Registrar, copying the request to the other party.

If the other party has no objection to the withdrawal of evidence, the Registrar will generally agree. The evidence will be returned to the filer.

If the other party objects to the withdrawal, the Registrar will give a direction under rule 88 and the procedure set out in that section will be followed.

Further evidence

See separate chapter on Procedure where leave is sought to file further evidence.

Evidence filed in earlier proceedings

Ex parte earlier proceedings

Where evidence has been filed with the Registrar to support acceptance of the mark and the applicant wishes to rely on that evidence, the statutory declaration or affidavit and the supporting evidence must be re-filed in the later proceedings as an exhibit to a further statutory declaration or affidavit. The wording "Evidence was filed in support of the application and there is now produced and shown to me marked XYZ-1 copies of that evidence" would be appropriate.

Inter-partes earlier proceedings

Evidence from other proceedings cannot be "adopted". See the comments in *Tai Lung* (unreported decision of the Registrar under Appln. No. 9539 of 1993 dated 18 August 2000). The evidence must be re-filed by way of an exhibit to a further statutory declaration or affidavit.

Request to keep evidence confidential

Under rule 69, evidence filed in proceedings before the Registrar is not a document which is open to public inspection.

Requests that information contained in statutory declarations or affidavits not be disclosed to the other party will not be entertained. The rules of natural justice require that both parties be in possession of all information that is before the Registrar.

Statutory declarations and affidavits which do not disclose pertinent information, e.g. amounts expended on advertising or sales figures on the grounds of confidentiality can be filed, but the weight which the Hearing Officer will attach to such evidence may be affected.

Requests that confidential information contained in statutory declarations be treated in confidence in the decision will generally be acceded to, as decisions are available on IPD's website.

Inspection of exhibits

Under the Rules, a copy of the evidence filed by any party is to be served upon any other party to the proceedings. There may be situations where an inspection of the

original exhibit is requested by the other party, i.e. where a photograph of an exhibit is exhibited under rule 81, or where the original magazine in which an advertisement appears has been filed with the Registry.

In the former example, the party filing the photograph has undertaken that they will make the exhibit available for inspection by any other party to the proceedings. The party requesting inspection should make arrangements directly with the filing party. If difficulties are encountered with respect to a reasonable request to inspect, the Registrar should be notified. The Registrar will give a direction pursuant to rule 81(3) and the provisions of rule 88 shall apply.

There is nothing to prevent the inspecting party from taking photographs or making a written record. If the party wishes to remove the exhibit however, he must first obtain the written consent from the party filing. Both parties (when the exhibit is in the hands of the party filing) or the Registrar and the party inspecting (when the original is in the hands of the Registrar) should sign a list detailing the exhibits to be removed and the date agreed for their return.

Storage of evidence

Only statutory declarations and affidavits should be kept on the proceedings file and then only when they are not bulky. Bulky exhibits are stored in a separate storage area within the Law & Post Registration Section. Once evidence has been accepted, the evidence should be re-packaged if small enough, in a sealed envelope. Larger exhibits should be placed in a box. The outside of the box should be clearly marked to show the proceedings number to which the contents refer to and the box placed in the bulky storage area. A note should be made on the proceedings file to show that the evidence has been detached. Valuable or delicate exhibits should be placed in a locked cabinet.

Disposal of evidence

As the evidence filed is not open to public inspection, it may be returned to the filer after the expiration of the appeal period. The whole statutory declaration or affidavit should be returned not merely the exhibits. This will facilitate the re-filing of the evidence if it is required for subsequent proceedings before the Registrar.

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