

**Compendium of Hearings & Mediation Department Circulars
Amendment No. 1 of 2025
10 January 2025**

HMD Circular 5.2

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

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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.

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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. ~~The Fourth Schedule below reflects the quantum which came into effect on 31 January 2017 ("New Quantum"). The Fourth Schedule to the principal Rules as in force immediately before 31 January 2017 ("Old Quantum") continues to apply to any initiation action filed before 31 January 2017.~~³⁰

~~The indicative costs set out in heading F below should therefore be adjusted accordingly for proceedings arising from any initiation action filed before 31 January 2017. Apart from this, for the avoidance of doubt, the same considerations below are relevant, whether the New Quantum or Old Quantum applies.~~

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 event³¹.

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,

³⁰ ~~Rule 17(16) of the Trade Marks (Amendment) Rules 2017~~

³¹ In *Ferrero S.P.A. v Dochirnie Pidpriemstvo "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.

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.

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 refers 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.³²

In exceptional cases, for example, where a party’s behaviour is unreasonable³³, 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. <i>This is a standard item which will be allowed if work has been done.</i>	\$390
2	Drawing and filing counter-statement <i>This is a standard item which will be allowed if work has been done</i>	\$390
3	Preparing and filing evidence for opposition and revocation, invalidation or rectification proceedings (a) <i>Consolidation of proceedings</i> <i>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.</i>	\$390-\$2,080 per statutory declaration

	<p>(b) <i>Similar / identical marks for several classes of goods / services</i></p> <p><i>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.</i></p> <p><i>In such cases, full costs will only be awarded to one set of evidence relating to one class.</i></p> <p><i>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.</i></p> <p><i>The number of pages containing statements made by the deponents and the amount and the relevance of the exhibits are factors to be considered.</i></p> <ul style="list-style-type: none"> • <i>Limited evidence of use in the SD: \$390 to \$700</i> • <i>Some evidence of use in the SD: \$700 to \$1600</i> • <i>Extensive evidence of use, complex facts in the SD: \$1600 to \$2080</i> 	
4	<p>Reviewing the reply to any document referred to in items 1, 2 and 3</p> <p><i>In a situation where:</i></p> <p>(a) <i>there is consolidation of proceedings;</i> (b) <i>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</i></p> <p><i>the considerations set out in item 3 will apply accordingly.</i></p> <p><i>The number and complexity of issues raised in fact and law are relevant factors to be considered.</i></p> <ul style="list-style-type: none"> • <i>1 or 2 grounds raised: \$195 to \$500</i> • <i>3 or more grounds raised: \$500 to \$800</i> • <i>Complex issues of fact and law: \$800 to \$1040</i> 	\$195-\$1,040 per document

³² 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.

³³ 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..."

INTERLOCUTORY PROCEEDINGS, ETC.		
5	Preparing for all interlocutory proceedings ³⁴ , pre-hearing reviews and case management conferences <i>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.</i> <ul style="list-style-type: none"> • 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 <i>Factors to be considered are conduct of parties, complexity of issues in fact and law, and time taken for hearing.</i> <ul style="list-style-type: none"> • 1-hour 30 min or less: \$65 to \$200 (pre-hearing reviews and case management conferences) • Half day hearing More than 30 min: \$200 to \$500 \$650 (pre-hearing reviews and case management conferences) • Full day hearing: \$500 to \$650 • 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 <i>Factors to be considered are complexity of issues in fact and law, length of written submissions and amount of authorities cited if any.</i> <ul style="list-style-type: none"> • 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 <i>Factors to be considered are complexity of issues in fact and law, time taken for hearing.</i> <ul style="list-style-type: none"> • Half day hearing: \$260 to \$700 • Full day hearing: \$700 to \$1040 	\$260-\$1,040
ASSESSMENT		
9	Drawing bill of costs <i>Amount allowed according to the number of folios in bill of costs³⁶</i>	\$6.50 per folio ³⁵

³⁴ See HMD Circular 6.1 at D

³⁵ Defined as 100 words, each figure being counted as one word, in Rule 2(1)

³⁶ 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 <i>The factor to be considered for attending assessment is the time taken for the assessment proceeding.</i> <ul style="list-style-type: none"> • 1-hour 30 min or less: \$130 to \$200 • More than 1-hour 30 min: \$200 to \$390 	\$130-\$390
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HMD Circular 7.1

7.1 Preliminary View

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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.

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