

**Bills Committee on Trade Marks Bill****Extracts on Clause 77-  
Application of Rules of Evidence**

(As at 23 March 2000)

***I Bill*****77. Application of rules of evidence**

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.

***II. Submissions******(A) Deacons' view (CB(1)1970/98-99)******(i)(a) general comments***

The Bill aims to remove the requirement for the Registrar to be bound by the rules of evidence.

This causes us concern as the rules of evidence keep litigants/opponents on an equal footing.

We do not recommend that this clause be retained. The Registrar should be bound by the same rules of evidence as the Court considering matters on appeal from the Registrar.

Since the Civil Evidence Ordinance has recently been amended to make the introduction of hearsay evidence more straightforward, there is no reason why the Registrar should feel concerned that he will not have before him all relevant probative matter.

***(b) detailed comments***

This section states that the Registrar is not to be bound by the rules of evidence when considering contentious matters before him. We are astounded that the Intellectual Property Department has included this section.

The Intellectual Property Department comments that it finds *the St. Trudo*<sup>5</sup> trade mark decision unacceptably inflexible. This is not acceptable. The *St. Trudo* trade mark decision is a decision of the United Kingdom Court under the U.K. Trade Marks Act of 1938 considering whether the Registrar of Trade Marks could consider hearsay evidence when the admission of the evidence did not follow the rules which the Court would normally apply admitting hearsay evidence. The Court in the United Kingdom decided that since Registry matters may be appealed to the Court when those matters are before the Court: the Court should be considering them on the same grounds as the Registrar considered them. The Court is bound by the rules of evidence.

Firstly, the ratio of *St. Trudo* is a very sensible one. If there remains an appeal from decisions of the Registrar to the Court, the Court should be in the same position as the Registrar on evidence when considering an appeal. This is a logical conclusion. If the Registrar does not want to be burdened by the Rules of Evidence then appeals from the Registrar should be to an administrative body on like terms.

Clauses 83 of the Bill provides for appeals to the Court so logically the rules of evidence should apply before the Registrar.

However, more importantly the rules of evidence are there to ensure that both parties to a dispute proceed on like terms. The current position before the Registrar of Trade Marks now is that drafting of documents and the admission of evidence in contentious proceedings is extremely haphazard and often of a very poor quality. This should not be encouraged.

We presume that the Registrar is concerned mostly with hearsay evidence since the old rules of evidence were extremely strict on the admission of this evidence. However, the Civil Evidence Ordinance in Hong Kong has recently been amended to make the introduction of hearsay evidence more straightforward and as such the Registrar's concern in that regard has now been removed.

We do not find the IPD's comments particularly helpful. There is no explanation as to why *St. Trudo* is considered to be inflexible. The decision in *St. Trudo* is a sensible one and if anything should be enshrined in the new Bill.

***(ii) Administration's Response (CB(1)302/99-00(01))***

**29. Deacons would like the Trade Marks Registry to be bound by the strict rules of evidence.**

**30. The Trade Marks Registry has avoided unnecessary formality when conducting contentious proceedings (registrability or opposition hearings). Rigid adherence to the rules of evidence can be counter-productive in such situations. For example, an applicant for the mark may not put all the facts or arguments before the Registrar in a hearing. The Registrar should have the flexibility to seek the relevant facts and arguments. The Registrar also has a duty to protect the public interest.**

**31. We agree with the Australian approach that unnecessary formality should be avoided. The Australia Trade Mark Regulations provide in 21.15(7) and (8) as follows -**

**“(7) A hearing must be conducted with as little formality and technicality, and with as much expedition, as the requirements of the Act and these Regulations and a proper consideration of the matters before the Registrar, allow.**

**(8) The Registrar is not bound by the rules of evidence but may inform himself on any matter that is before him or in any way that the Registrar reasonably believes to be appropriate.”**

**32. It is clear that clause 77 of the Bill does not give the Registrar *carte blanche* to do whatever he likes. Clause 77 is prefaced by the words “Except as otherwise provided in this Ordinance ....”. More importantly, every decision of the Registrar can be appealed to the Court. The Registrar is bound by the rules of natural justice and is charged with acting fairly and reasonably. That, in the final analysis, is the ultimate sanction.**

**33. Although the effect of the recent amendments to the Evidence Ordinance has been to severely limit the effect of the hearsay rule; the admissibility of hearsay evidence has not been totally abolished.**

***(iii) Deacons’ Second Response to the Administration (CB(1) 698/99-00)***

No. 29: Deacons’ submission does not suggest that the Registrar should be prohibited from making enquiries of the parties’ representatives during the course of a hearing. In fact, we fully agree that a “semi-inquisitorial” approach would be appropriate for hearings before the Registrar. We also agree that, in principle, unnecessary formality should be avoided. However, these issues are not relevant to our submission that the Registrar should be bound by the same rules of evidence which will be applied by the Court in any appeal which may be filed from a decision taken by the Registrar.

It is a fundamental contradiction that an appeal can be taken to the Court on a decision which may be based on evidence which the court itself would consider to be inadmissible. Clause 50 of the Bill provides an option for rectification proceedings to be filed either at the Trade Marks Registry or through the Court. This in itself suggests that the scope of the evidence admissible in each forum should be the same. Applicants for rectification will know that a lower standard is applied by the Registry and if they know that their evidence in favour of an opposition or rectification is defective, they will be encouraged file the proceedings at the Registry. It is not in the public interest to establish such incentives for forum shopping.

One of the functions of the Registrar at a hearing is to ensure that the proceedings are determined in a just and transparent manner. This aim can hardly be achieved if one party to a dispute restricts its evidence to that which would be admissible as evidence in a Court, while the other side is permitted to produce evidence of dubious relevance or admissibility.

The present practice of the Registrar is to routinely accept submissions cloaked as evidence. Since applications to strike out evidence filed by the other side are not entertained, we are not confident that the Registrar will be in a position to make appropriate decisions under the new Trade Mark Ordinance. In order to create certainty for both sides and so as to enable a certain degree of self-policing of the admissibility of evidence by the parties themselves, we repeat our submission that the Registrar should be bound by the usual rules of evidence.

It appears from paragraph 30 of the Government's Response that the legislative intention is to avoid excessive formality, provide flexibility and ensure that all relevant facts and arguments are put before the Registrar at a hearing. These are laudable objectives but the fact remains that decisions taken by the Registrar have potentially enormous economic consequences and decisions should not be based upon such paternalistic considerations. Presumably the Government's intention is to make the system more user-friendly for applicants representing themselves at Registry hearings, however lay representatives are

increasingly unlikely to overcome the preliminary hurdles such as the detailed formal rules covering notices of opposition and applications for rectification, the requirement that evidence is given by Statutory Declaration, the strict deadlines imposed by the Registry and the technical nature of the subject matter itself. If lay persons are sufficiently astute to overcome all of these obstacles, there seems to be little justification for the entire system to be compromised to allow them the opportunity to file otherwise inadmissible evidence.

In order to cater for situations where, for instance, one party may not be legally represented, there should obviously be some degree of flexibility to enable a party to rectify or amend otherwise inadmissible evidence. Furthermore, this is a procedural matter and this situation would not arise sufficiently often to justify legislating for the Registrar to make decisions with potentially enormous economic consequences without being bound by any formal rules of evidence.

The fact that Clause 77 of the Bill is prefaced by the words “[e]xcept as otherwise provided in this Ordinance...” obviously does not qualify the clause in any meaningful way since Clause 77 itself is the only clause which directly deals with the issue of evidence at a hearing.

drafting

(iv) **Deacons’ Third Response to the Administration (CB(1)871/99-00)**

I refer to our letters of 1<sup>st</sup> and 14<sup>th</sup> December 1999 concerning the Trade Marks Bill. In paragraph IV on P.6 of the comments enclosed with our letter of 14 December 1999, we made the point that the Registrar should be bound by the same rules of evidence which will be applied by a Court in appeals which may be taken from Trade Mark Registry Decisions.

We now enclose a copy of the Decision of Mr. Justice Laddie of the Chancery Division of the United Kingdom High Court. This case illustrates and confirms that if the parties are aware that the Registry will apply a lower standard than the Courts regarding admissibility of evidence, this will encourage forum-shopping and encourage use of Registry proceedings as a “dry run” to test and perfect their case.

IN THE HIGH COURT OF JUSTICE—CHANCERY DIVISION

*Before:* Mr Justice Laddie

**DUALIT LIMITED v. ROWLETT CATERING APPLIANCES  
LIMITED**

January 19, 1999

*Trade mark—Application—Opposition—Applicant’s appeal from registrar’s refusal to register mark—Application to adduce fresh evidence on appeal—Principles to be applied—Practice—Listing non-assigned matters in the Patents Court—Abuse of system.*

The appellant sought leave to adduce fresh evidence on an appeal from a decision of the registrar refusing to allow the mark to proceed to registration.<sup>1</sup> The opponent objected to the admission of fresh evidence. The application was listed in the Patents Court.

*Held*, refusing leave:

(1) Whether or not evidence should be allowed on an appeal from the Trade Marks registry was not determined as restrictively under the Trade Marks Act 1994 as under the Trade Marks Act 1938.

(2) When a party applied for leave to adduce new evidence on appeal, the onus was on it to justify the exercise of the court’s discretion in its favour.

(3) It was not enough for an appellant to show that the evidence sought to be introduced was relevant. If such a low hurdle was imposed, there was a temptation that the losing party would redesign its evidence, having regard to the adverse decision against it, and start again on appeal.

(4) When considering whether or not to allow fresh evidence, the court should have regard to how important the evidence was, whether it could have been put in earlier and the weight that evidence was likely to have at the appeal.

(5) It was an abuse of the system devised by the Patents Court for the speedy resolution of interlocutory matters for parties to list non-assigned matters in the patents list.

*Observed*

Proceedings before the Registry are not a dry run to test out the evidence to see which parts can be criticised so that the evidence can then be perfected for the purpose of a proper run before the High

<sup>1</sup> *Dualit Ltd’s (Toaster Shapes) Trade Mark Applications [1999] R.P.C. 304.*

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Laddie J., Ch D

Court. It is important for parties to realise that the function of the Registry is to examine applications and to consider oppositions, and that they must put before the Registry the material which is to be relied upon in support of their case.

The following cases were referred to in the judgment:

*BALI Trade Mark [1996] R.P.C. 387.*

*ELLE Trade Mark [1997] F.S.R. 529.*

*Hunt-Wesson Inc's Trade Mark Applications [1996] R.P.C. 233.*

*Ladd v. Marshall [1954] 1 W.L.R. 1489.*

*Amanda Michaels* instructed by *Beachcroft Stanleys* appeared on behalf of the appellant. *Richard Hacon* instructed by *Hewitson, Becke & Shaw* appeared on behalf of the respondent.

**LADDIE J.:** This is the hearing of a summons for directions in an appeal from the Trademark Registry. At issue in the appeal will be the question of whether or not trademark application 2023846 should be allowed on the register.

I will come to the issues arising before me in a moment. However, before doing so I should say something about the fact that I am hearing this case. It is now well known that the Patents Court, in an attempt to dispose of interlocutory matters in a way which will avoid disruption of trials, is prepared to sit from 9.30 a.m. onwards to hear applications. That is a procedure of which heavy use is made, and applications in patents matters are heard by the judges of the Patents Court on most if not all days of the week. The Patents Court, however, is only given peculiar jurisdiction over matters assigned to it. It is not available as a convenient court of first call for Chancery matters in general, even those concerned with intellectual property.

In the present case it appears that one party or the other (although at the moment I am not sure which) asked for this matter to be put before the Patents Court, thereby ensuring that it was dealt with in the early morning slot and thereby limiting the number of judges who would be able to hear this matter. But this is not an assigned matter at all, and it appears to me that all that is happening in this case—and it is not the first—is that the parties are seeking to make use of the Patents Court as a means for side-stepping the necessity of having their applications listed in order of priority in the general Chancery list.

This must stop. Trademark matters are not assigned to the Patents Court under the present rules and statutes, and it is an abuse of the system for parties to try and get their cases heard early or at times convenient to them or by judges of their choosing by putting non-assigned matters in the patents list.

I now turn to the issues which I have been asked to resolve on this application.

The applicant for the registered trademark is Dualit Limited. In fact it applied for a series of trademarks on June 14, 1995. The applications are for trademarks consisting of the shape of toasters, and registration is sought in

class 11. A number of objections were raised but the applications were accepted after a hearing at the Registry. Opposition was lodged by a competitor, Rowlett Catering Appliances Limited, and that opposition was heard by Mr A. James, acting on behalf of the Registrar, on July 15, 1998. By a decision dated September 21, 1998, the applications were refused for various reasons.<sup>2</sup>

An originating Notice of Appeal was lodged on November 20, 1998, and that appeal will no doubt come on for hearing at some time in the not too distant future before a judge in the Chancery Division. The parties have sorted out the various issues arising on the summons for direction, save for one, namely an application by the applicant to file further evidence.

To understand the nature of that application, it is necessary to say something about the evidence which was used in the hearing before Mr James. There were in fact four rounds of evidence before the matter came on for hearing in the Registry. The applicant put in evidence in support of its original applications which it thought supported its contention that the shape of its toasters were well known and recognised by the public and the trade, and had acquired a distinctive reputation. That evidence included sales figures, evidence from members of the trade saying what the shapes of the toasters meant to them, and so on. It appears that some seven statutory declarations were put in by the applicant in support of its applications.

This evidence was used in the opposition and was answered by the opponent. Various criticisms were made of the applicant's case. I should particularly refer to the statutory declaration of Mr Cowan. He responded to the evidence put in by the applicant and in particular to the lead statutory declaration which had been put in on behalf of the applicants by Mr Gort-Barten, who has been the managing director of Dualit since 1980. In Mr Gort-Barten's first declaration, he had claimed that Dualit Limited "has traded in the United Kingdom in toasters of the three dimensional shape shown in the trademark application since 1948". Mr Cowan challenged that statement and said it was misleading. The applicants put in evidence in response, including a second declaration by Mr Gort-Barten which addresses Mr Cowan's evidence, and in particular addresses, at one of its early passages, the suggestion that Mr Gort-Barten's first declaration was misleading.

That ground of evidence put in by the applicants was then responded to by the opponents and in his second declaration Mr Cowan once again comes back to the issue of whether or not Mr Gort-Barten's first declaration was misleading in so far as it is claimed that Dualit Limited had traded in toasters of the design set out in the trademark applications since 1948. It has not been suggested to me that any application was made on behalf of Dualit to put in a further round of evidence.

In finding for the opponents, Mr James decided, amongst other things, that Mr Gort-Barten's evidence was misleading, and he came to the conclusion that that affected the issue of where the burden of proof lay in the

<sup>2</sup>[1999] R.P.C. 304.

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opposition. He also was clearly not impressed by the evidence of reputation put in by Dualit, and in relation to some of the evidence put in by Dualit he noted that the statutory declarations were in standard form.

The evidence which the applicants now wish to adduce on the appeal falls essentially into two categories. First of all, there is evidence which is said to go to the issue of whether or not Mr Gort-Barten's original declaration was misleading and, secondly, there is additional evidence on the question of reputation of the Dualit toasters and history of the trade in them. The application to adduce the new evidence is opposed by Mr Hacon on behalf of the opponents, and Miss Michaels appears on behalf of the applicant. There was a significant difference between counsel as to the correct test that should be applied in deciding whether or not to admit new evidence on an appeal such as this under the provisions of the 1994 Trade Marks Act. Mr Hacon said that, whereas under section 18(8) of the 1938 Act provision was made for the admission of new evidence on appeal on special leave, there was no equivalent section under the 1994 Act, and therefore this should be construed as an indication that the legislature had decided to remove from the parties any possibility of putting in new evidence on appeal.

In my view, that submission is wrong. It appears to me that all that has happened is that the Trade Marks Act now makes no specific provision relating to evidence on appeal, and the question of whether evidence on appeal should be admitted has now to be determined on general principles. I should add that, were Mr Hacon right, it would mean that Lloyd J.'s decision in *ELLE Trade Mark* [1997] F.S.R. 529 (a case I will come to in a moment) was wrongly decided. In my view, the decision of Lloyd J. was not wrongly decided.

So what then are the criteria which must be applied in deciding whether or not to allow in new evidence on appeal? There is no doubt that under the 1938 Act new evidence was allowed in on appeal, but the criteria set out in *Ladd v. Marshall* [1954] 1 W.L.R. 1489 were central to the issue of whether leave should be given. Miss Michaels says that under the 1994 Act it is no longer necessary for *Ladd v. Marshall* principles to be applied in their full rigour, whereas under the 1938 Act new evidence could only be adduced on appeal if "special leave" was given. There is no such requirement of special leave now and the question of admission of new evidence has to be determined in accordance with the provisions of Ord. 55, r.7(2) which gives the court a wide discretion whether to adduce new evidence or not.

In support of this submission, Miss Michaels drew a distinction between two reported cases. The first was *Hunt-Wesson Inc.'s Trade Mark Application* [1996] R.P.C. 233, a decision of mine in relation to an appeal in an opposition brought under the 1938 Act. The second was Lloyd J.'s *ELLE Trade Mark* decision. Whereas in the former *Ladd v. Marshall* was relied upon by me in deciding whether to allow evidence to be adduced, in the latter Lloyd J. said as follows:

It seems to me that *Ladd v. Marshall* does not apply to an appeal from the Registrar to the High Court, although it no doubt would apply if there were a further appeal from this court to the Court of Appeal. I think the circumstances

in which the evidence was not given before the Registrar and is now sought to be given are relevant and so is the degree of substance of the evidence. It seems to me that while this is a somewhat marginal case, and I am quite sure that it would be well within the court's discretion to refuse to admit the evidence, nevertheless, on balance I should allow it in and take it into account in considering whether the case is made out. (page 536)

If I may say so with the greatest of respect, I agree with Lloyd J. Whether or not evidence should be allowed on an appeal from the Registry under the 1994 Act is not looked at as restrictively as it was under the 1938 Act. But that, however, does not determine the issue of what factors the court should take into account into deciding whether leave should be granted.

Miss Michaels said that the criteria are as follows. The court can and should let in any evidence for an appeal which is not going to cause an injustice to the other side. Secondly she said that the court should be provided with some evidence as to why new evidence had not been adduced earlier, if only so as to see that the new evidence is credible and not just, as she put it "picked up along the way". Thirdly, she said that the court needs to be satisfied that the evidence is of some substance and relevance. The weight of the evidence should primarily be left for consideration by the judge who hears the appeal.

I must say that, if those were the only criteria which were to be taken into consideration, then it would be a comparatively rare occurrence for the court to refuse leave to adduce new evidence. Essentially what Miss Michaels is saying is that any relevant material should be allowed in on appeal. In support of this, she reminded me of what was said by Ungeod-Thomas J. in *BALI Trade Mark* [1966] R.P.C. 387:

It is, of course, a question of trying as best one can to do justice to the parties on the merits of the case by weighing up the advantages and disadvantages to both parties and having regard to the desirability of having the issue fully, properly and satisfactorily investigated. (page 390)

And:

In my view, in all the circumstances of this case, with a view to doing substantial justice between the parties, and to having the case decided fully on its merits, without in any way retrying the case on matters which should have been disposed of before the Assistant Controller or prejudicing the Berlei Company unduly by reason of admitting the evidence, it seems to me that the proper course is to attach the main weight to the desirability of having the substantial issue satisfactorily and fully investigated; and I consider that any prejudice that the Berlei Company might suffer can be provided for by other provisions than excluding altogether this evidence which is now sought to be admitted. (page 393)

In my view, it is of course important that the court should be put in a position to adjudicate fairly on the dispute between the parties and that it should not unreasonably refuse to admit new evidence. But there has to be put against this other important considerations. One piece of evidence which is sought to be put before the court by Dualit is new evidence by a Mr Thompson. He gave evidence in the first round and it was used before Mr James. Mr James criticised that evidence because it was in standard

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form—an objection which has been taken numerous times in the past, and can be found referred to in many decided cases. What Dualit proposes now, in the light of Mr James' decision, is to put in a new statutory declaration by Mr Thompson in his own words so as to counter the criticisms of form made by Mr James.

I give that as an example to explain why, in my view, it is not enough simply to allow in any evidence which can be argued to be relevant and in effect to allow in any evidence which is relevant. If such a low hurdle is imposed, other applicants and opponents will no doubt look at the decision adverse to them in the Registry, redesign their evidence and start again on appeal. But proceedings before the Registry are not a dry run to test out the evidence to see which parts can be criticised so that the evidence can then be perfected for the purpose of the proper run before the High Court.

It is important for parties to realise that the function of the Registry is to examine applications and to consider oppositions, and that they must put before the Registry the material which is to be relied upon in support of their cases.

In my view, it is just as important that it is brought home to litigants that they must put the best evidence available to them before the Registry as it is to ensure that the appeal is a fair resolution of the dispute between the parties. It appears to me, therefore, that it is still necessary for the court to consider the issue of how important the evidence is, whether it could have been put in earlier and why it was not and the weight that evidence is likely to have at the appeal.

I can then turn to the evidence sought to be adduced here on the appeal. At the beginning of this judgment I referred to the allegation made by the opponents that Mr Gort-Barten's first statutory declaration was misleading. I explained that that issue was raised squarely by the opponent and answered by Mr Gort-Barten. Dualit are unhappy that Mr James came to the conclusion that Mr Gort-Barten's first declaration was misleading and will argue on the appeal that, even if it was, it has no or no substantial effect on the burden of proof. This is a matter of law, not a matter of evidence.

However, in addition, what Dualit now wishes to do is to adduce evidence from Miss Anne Spence, who is a registered trademark agent, and who has acted on behalf of Dualit. The purpose of this is to show that when Mr Gort-Barten's statutory declaration was originally used at the time of the original applications for registration, the hearing officer who initially allowed the mark to proceed did not appear to pay much attention to the evidence in relation to use since 1948. Therefore the original allowance of the application to proceed was not obtained by reason of misleading the Registry.

First of all, it seems to me that, if this evidence was going to be put in, it always should have been put in once the issue of deception had been raised by the opponents. No explanation for why it was not has been furnished. Secondly, I cannot see that it has any significant weight. That Miss Spence thinks that the Registry originally was not very concerned about Mr Gort-Barten's statement as to when Dualit first started using the designs in issue says nothing about what went through the Registry's mind. In my view,

this is of very little weight and it is material that should have been deployed earlier if it has any relevance at all. I decline to allow it to be produced for use in the appeal.

The second batch of evidence, as I have indicated, deals with the issues of reputation and the extent of sales by the applicant. I think Miss Michaels is very fair when she describes it in this way. She says that it is fuller evidence from two of the same trade witnesses and that part of it is to reiterate and expand upon evidence of long-term use and reputation of the applicant. I have read this evidence. There is no suggestion that this material could not have been put in earlier.

As far as the evidence of Mr Thompson is concerned, as I have already indicated, the purpose of the new evidence is to put it into a different form so as to meet the criticisms of Mr James. I do not consider that to be a legitimate justification for putting in evidence at this stage. Furthermore, the additional evidence appears to me merely to go to show numbers of sales and does not, in my view, significantly add to the weight of the evidence that has already been relied upon by the applicants in this case. It appears to me that when a party applies for leave to adduce new evidence for the purpose of an appeal, even under the 1994 Trade Marks Act the onus is on it to justify the exercise of the court's discretion in its favour.

The applicants have failed, in my view, on this application, and I decline leave to adduce new material.

(v) *Administration's further response (CB(1)874/99-00(02))*

Application of the Rules of Evidence - Clause 77

14. It is not true to say, as Deacons has done, that "The present practice of the Registrar is to routinely accept submissions cloaked as evidence". Two recent decisions of the Registrar will illustrate the cases where evidence has been disregarded because of hearsay (See *Diesel* (TM No. 3200/92, Decision of the Registrar of Trade Marks dated 16 October 1999, at paragraphs 21-22) and *Tiffany* (Application no. 15562/92, Decision of the Registrar of Trade Marks dated 17 December 1999, at paragraph 42)). Other tribunals in Hong Kong have also adopted this approach (please refer to the summary at the annex).

15. The fact that tribunals of law (as opposed to the courts) should have a more informal approach to evidence is well illustrated by the examples of the various tribunals previously quoted. Ultimately the courts will be able to do justice if the Registrar has departed from proper norms.

**Provisions on Evidence in Various Tribunals in Hong Kong**

<b>Tribunal</b>	<b>Legal Basis</b>	<b>Text of provision</b>	<b>Remarks</b>
Small Claims Tribunal	Small Claims Tribunal Ordinance - Section 23(2)	The rules of evidence shall not apply to proceedings in the tribunal, which may receive any evidence which it considers relevant.”	Section 7 of the Ordinance provides that the tribunal may at any stage of proceedings in the tribunal, either of its own motion or upon the application of any party, transfer the proceedings to the Minor Employment Claims Adjudication Board, the Labour Tribunal, the Lands Tribunal, the District Court or the Court of First Instance, whereupon the practice and procedure of such board, tribunal or court, as the case may be, shall apply.  Section 28 provides for appeal to the Court of First Instance.
Labour Tribunal	Labour Tribunal Ordinance - Section 27(2)	The rules of evidence shall not apply to proceedings in the tribunal, which may receive any evidence which it considers relevant.”	Section 32 provides for appeal to the Court of First Instance.
Obscene Articles Tribunal	Control of Obscene and Indecent Articles Ordinance - Section 11(b)(i)	A Tribunal when exercising its jurisdiction under Part III may, subject to that Part and art VIII, determine its own procedure and in particular may receive and consider any material, whether by way of oral evidence, written statements, documents or otherwise, notwithstanding that such material would not	Section 30 provides for appeal to the Court of First Instance.

<b>Tribunal</b>	<b>Legal Basis</b>	<b>Text of provision</b>	<b>Remarks</b>
		be admissible in evidence in civil or criminal proceedings”.	
Insider Dealing Tribunal	Securities (Insider Dealing) Ordinance - Section 17	The Tribunal may, for the purposes of an inquiry under this Ordinance- receive and consider any material whether by way of oral evidence, written statements, documents or otherwise, notwithstanding that such material would be inadmissible in evidence in civil or criminal proceedings in a court of law”.	Section 29 provides that an order of the Tribunal may be registered in the Court of First Instance and shall, on such registration, become for all purposes an order of the Court of First Instance.  Section 31 provides for appeal to the Court of Appeal.
Transport Tribunal	Road Traffic Ordinance - Section 19(2)	A Transport Tribunal may receive such evidence as it thinks fit, and neither the provisions of the Evidence Ordinance (Cap 8) nor any other rule of law relating to the admissibility of evidence shall apply in the proceedings before the Tribunal.”	-

***(B)(i)(a) The Hong Kong Institute of Trade Mark Practitioners (CB(1)1953/98-99)***

The Bill aims to remove the requirement for the Registrar to be bound by the rules of evidence.

This causes us concern as the rules of evidence keep litigants/opponents on an equal footing.

We do not recommend that this section be retained. The Registrar should be bound by the same rules of evidence as the Court considering matters on appeal from the Registrar.

(see further detailed comments attached - Appendix A)

- (b) The Institute believes that the Registrar should be bound by the rules of evidence, particularly in view of the fact that there is a right of appeal to the courts (the U.K. Registrar of Trade Marks is bound by the strict rules of evidence). In addition, the hearsay rules have now been relaxed in the new Evidence Ordinance passed recently (see our detailed comments above).

(c) Appendix A

**Section 77 - Application of Rules of Evidence**

This section states that the Registrar is not to be bound by the rules of evidence when considering contentious matters before him. We are astounded that the Intellectual Property Department has included this section.

The Intellectual Property Department comments that it finds the St. Trudo<sup>2</sup> trade mark decision unacceptably inflexible. This is not acceptable. The St. Trudo trade mark decision is a decision of the United Kingdom Court under the U.K. Trade Marks Act of 1938 considering whether the Registrar of Trade Marks could consider hearsay evidence when the admission of the evidence did not follow the rules which the Court would normally apply admitting hearsay evidence. The Court in the United Kingdom decided that since Registry matters may be appealed to the Court; when those matters are before the Court the Court should be considering them on the same grounds as the Registrar considered them. The Court is bound to by the rules of evidence.

Firstly, the ratio of St. Trudo is a very sensible one. If there remains an appeal from decisions of the Registrar to the Court, the Court should be in the same position as the Registrar on evidence when considering an appeal. This is a logical conclusion. If the Registrar does not want to be burdened by the Rules of Evidence then appeals from the Registrar should be to an administrative body on like terms.

S83 Bill provides for appeals to the Court so logically the rules of evidence should apply before the Registrar.

However, more importantly the rules of evidence are there to ensure that both parties to a dispute proceed on like terms. The current position before the Registrar of Trade Marks now is that drafting of documents and the admission of evidence in contentious proceedings is extremely haphazard and often of a very poor quality. This should not be encouraged.

We presume that the Registrar is concerned mostly with hearsay evidence since the old rules of evidence were extremely strict on the admission of this evidence. However, the Civil Evidence Ordinance in Hong Kong has recently been amended to make the introduction of hearsay evidence more straightforward and as such the Registrar's concern in that regard has now been removed.

We do not find the IPD's comments particularly helpful. There is no explanation as to why St. Trudo is considered to be inflexible. The decision in St. Trudo is a sensible one and if anything should be enshrined in the new Bill.

***(B)(ii) Administration's response to ITMP (CB(1)676/99-00(04))***

8. We consider it important to retain this provision. A detailed analysis is at the Annex to the Deacons paper.

Prepared by

Legal Service Division

Legislative Council Secretariat

23 March 2000