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David LLEWELYN

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THE USE OF EXPERTS IN LEGAL PROCEEDINGS IN SINGAPORE INVOLVING INTELLECTUAL PROPERTY RIGHTS

In intellectual property (“IP”) cases decided in recent years in Singapore, the use of expert evidence is commonplace. Weaknesses in that expert evidence are commonplace too; sometimes the weaknesses are such that the evidence should be excluded, on other occasions they render the evidence of little value. However, in all cases the reliance on expert evidence will have increased the cost of the litigation for both sides (and rarely does the costs award make that increase good for the successful party). Aside from the more general policy concerns regarding expert evidence, this is an important reason why the courts must always be vigilant in ensuring in IP cases that expert evidence is allowed only when it is clearly of assistance to them in their role as the ultimate arbiter on questions of law.

David LLEWELYN

*Professor (Practice) and Deputy Dean, School of Law,
Singapore Management University;
Professor of Intellectual Property Law, King’s College London.*

I. Introduction

1 The use of expert evidence in legal proceedings in Singapore involving intellectual property (“IP”) rights is so common that it rarely gives advisers much cause for thought, even though as a matter of law there is no entitlement to adduce such evidence unless, under the new but still relatively limited wording of s 47 of the Evidence Act,¹ the court is likely to derive assistance from an opinion upon a point of scientific, technical or other specialised knowledge, in which case the opinions of experts upon that point are relevant facts. Although some IP cases require expert evidence in those areas, a not insignificant number does not and yet expert evidence is still adduced on matters which are within the judge’s knowledge and experience to decide without that so-called expert evidence. Inevitably, this has a knock-on effect on the cost of litigating IP disputes: once one side decides to use an expert witness, the

1 Cap 97, 1997 Rev Ed, as amended by s 8 of the Evidence (Amendment) Act 2012 (Act 4 of 2012) with effect from 1 August 2012. On the previous wording of s 47 and the recommendation that it be amended to broaden its scope, see Law Reform Committee, Singapore Academy of Law, *Report of the Law Reform Committee on Opinion Evidence* (October 2011) at paras 10–11.

other will follow suit for fear of being criticised by either its client or the court for not doing so. This issue is worthy of particular focus now as there is increasing concern that the cost of IP litigation effectively excludes from the litigation process, both as willing plaintiffs and unwilling defendants,² many of the small and medium-sized enterprises (“SMEs”) on which much of Singapore’s future growth is likely to depend. It is noteworthy also that in England, with effect from 1 April 2013, the overriding objective of the Civil Procedure Rules 1998³ has been reframed to be “dealing with cases justly *and at proportionate cost*” [emphasis added].⁴

2 At the outset, it is important to recognise, as the Law Reform Committee explained in its 2011 Report on Opinion Evidence (“LRC Report”),⁵ that the Evidence Act’s exclusionary approach to the admissibility of evidence (“[e]verything that’s not in is out”,⁶ exemplified by the wording in s 5 to the effect that evidence of facts in issue and other relevant facts is admissible but “of no others”) is the opposite of modern evidence law in other jurisdictions where evidence is admitted unless specifically excluded.⁷

2 One of the comments received by the author while writing this article was that parties to High Court litigation are prepared to spend money, so the cost of unnecessary expert evidence is not a significant issue; however, it is perhaps worth bearing in mind that (a) plaintiffs choose whether to litigate in the High Court, defendants do not; and (b) some parties who would like to litigate in the High Court do not because of the cost. In his Response at the Opening of the Legal Year on 4 January 2013, Sundaresh Menon CJ concluded:

This brings me to the close of this morning’s proceedings. I return at this stage to the quest I have mentioned, to persist in the effort to make things even better than they already are. This is a quest that must unite all of us in the legal community. If the law is foundational to society, then we, who are the servants of the law, must constantly reflect on how we can make it more responsive to the needs of our evolving society. We must ensure that we do not price the law out of the reach of the average Singaporean; that we are guided by our care and concern for those whose lot it is to come face to face with the law; and that we do not allow the law to become the preserve of the rarefied few as a result of systems, processes and outputs that seem obscure or even confounding to the reasonably informed lay person.

3 SI 1998/3132.

4 Civil Procedure Rules 1998 (SI 1998/3132) r 1.1. In *Marks & Spencer plc v Interflora Inc (No 2)* [2013] EWCA Civ 319, Lewison LJ commented (at [30]) of this change: “This will make it all the more important for judges to exercise their power to limit or exclude technically admissible evidence which is not of real value.”

5 Law Reform Committee, Singapore Academy of Law, *Report of the Law Reform Committee on Opinion Evidence* (October 2011).

6 See Law Reform Committee, Singapore Academy of Law, *Report of the Law Reform Committee on Opinion Evidence* (October 2011) paragraph heading to para 30.

7 See Law Reform Committee, Singapore Academy of Law, *Report of the Law Reform Committee on Opinion Evidence* (October 2011) at paras 13–36.

3 There are numerous areas in which parties to IP disputes in Singapore have relied on expert witnesses over recent years.

4 In patent infringement proceedings, experts are almost always called to give evidence on the meaning of technical words and phrases in the patent specification and the “common general knowledge” that the notional skilled person would have had at the relevant time,⁸ in assisting the court to determine the scope of the claims in the patent. Likewise in patent invalidity or revocation proceedings, the experts will help the court (or alternatively, in the latter case, the Registrar)⁹ in coming to its conclusions on whether the invention was not patentable (that is, it was not new, did not involve an inventive step and/or was not capable of industrial application, as required by s 13(1) of the Patents Act),¹⁰ whether the patent specification disclosed the invention sufficiently for it be performed by a person skilled in the art,¹¹ and/or whether matter was added to the specification in the course of its prosecution that went beyond that originally filed.¹²

5 In registered design infringement cases, which also involve monopoly rights so that knowledge and intention are irrelevant, expert

8 *Lubrizol v Esso Petroleum* [1998] RPC 727 (CA) at 738, *per* Aldous LJ.

9 Section 80 of the Patents Act (Cap 221, 2005 Rev Ed).

10 Cap 221, 2005 Rev Ed.

11 Section 25(4) of the Patents Act (Cap 221, 2005 Rev Ed) provides that the specification must be sufficiently “clear and complete” for the invention to be performed by the person skilled in the art and s 80(1) provides this as a ground for revocation.

12 Also, and more esoterically (the author is indebted to George Wei JC for pointing this out), in *Plant Genetic Systems/Glutamine Synthetase Inhibitors* [1995] EPOR 357 (genetically modified plants possessing a gene conferring protection against certain herbicides) it was contended before the European Patent Office Technical Board of Appeal that the invention was contrary to *ordre public* or morality (environmental risks, *etc*) and was therefore not patentable. The opponents (Greenpeace) had commissioned a survey of Swedish farmers that purported to demonstrate that 82% were against genetic engineering of plants. An opinion poll was also commissioned in Switzerland that showed 69% were against the patentability of plants and animals. Unsurprisingly, the Board found, at 373, that the survey and opinion poll were not decisive, partly because of the size of the surveys and also because they could not be said to be representative of Europe as a whole. In Singapore, see s 13 of the Patents Act (Cap 221, 2005 Rev Ed):

(2) An invention the publication or exploitation of which would be generally expected to encourage offensive, immoral or anti-social behaviour is not a patentable invention.

(3) For the purposes of subsection (2), behaviour shall not be regarded as offensive, immoral or anti-social only because it is prohibited by any law in force in Singapore.

Were such an issue to come before the courts in Singapore, there seems little doubt that expert evidence would be adduced, although to what effect must be questioned.

evidence may be required to help the court decide the question of the validity of a particular design.

6 In trade mark infringement and passing off proceedings, experts are often called to give evidence on the essential legal issue for the court of whether or not there is a likelihood of confusion or actual (or likely) deception, respectively, between the plaintiff's mark (or, strictly, the trade indicia the use of which has generated goodwill, in a passing off action) and the sign or trade indicia used by the defendant.¹³ That evidence often takes the form of survey evidence (introduced by way of the expert evidence of the person who devised the survey), especially if the alleged infringement or passing off has commenced only recently and there is therefore no actual evidence of confusion or deception.

7 In copyright infringement proceedings, experts are called to give evidence on the similarity between the plaintiff's copyright work and the allegedly infringing work produced by the defendant and also on design practices in the field in question (that may go to the question of whether there has been sufficient copying of original work of the plaintiff).

8 Finally, experts are occasionally used to help with complicated technology in breach of confidence cases (which some characterise as IP).¹⁴

II. The basis for admission of expert evidence

9 As the expert is giving opinion evidence, the admissibility of that evidence depends on its falling within a permitted exception to the rule against hearsay testimony. In the words of the Law Reform Committee,¹⁵ "these rules were created to minimise the inherent danger

13 Expert evidence may also be relevant (in a legal sense) if it is contended that a trade mark application is for a shape that is exclusively one that is needed to achieve a technical effect and is therefore unregistrable under s 7(3)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed). Conversely, by analogy to the patent issue referred to in n 12 above, it is unlikely that such evidence would assist on the issue of whether an application is for a mark that is contrary to public policy or morality under s 7(4).

14 On breach of confidence generally, see William Cornish, David Llewelyn & Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* (Sweet & Maxwell, 8th Ed, 2013) ch 8, and on the nature of the liability, paras 8-01–8-09. In *Coogan v News Group Newspapers Ltd* [2012] EWCA Civ 48, Lord Neuberger MR (after referring to the cited passages from the 7th Ed of Cornish, Llewelyn & Aplin) concluded at [39] that "while the prevailing current view is that confidential information is not strictly property, it is not inappropriate to include it as an aspect of intellectual property".

15 Law Reform Committee, Singapore Academy of Law, *Report of the Law Reform Committee on Opinion Evidence* (October 2011) at para 2. On the traditional
(cont'd on the next page)

that tribunals of fact, in most cases juries, will place undue emphasis on expert opinions and abdicate their ultimate responsibility to draw their own conclusions on all the relevant facts in dispute.”

10 In Singapore, the position is now regulated by the recently amended s 47(1) of the Evidence Act:¹⁶

When the court is likely to derive assistance from an opinion upon a point of scientific, technical or other specialised knowledge, the opinions of experts on that point are relevant facts.

11 The amendment to section 47(1) was made in response to a recommendation in the LRC Report.¹⁷

rationale for the rule that expert evidence should not be given on the ultimate issue for decision by the court, that it may unduly influence the jury or usurp the role of the court, Jeffrey Pinsler in *Evidence and the Litigation Process* (LexisNexis, 3rd Ed, 2010) at para 8.32 cites *Director of Public Prosecutions v A and BC Chewing Gum* [1968] QB 159 to indicate that the “rule has lost its force” and submits this is particularly so where the trier of fact is a judge “as he is very much more likely than a jury to be able to appreciate the subtleties involved in relying on such testimony.” However, in relation to juries (which sit in IP cases in the US but no longer elsewhere), surely the recent, somewhat tawdry pronouncements of the patent-owning foreman of the jury after the jury’s finding of liability in the Apple-Samsung case in California highlight well the dangers referred to by the Law Reform Committee.

16 Cap 97, 1997 Rev Ed, as amended by s 8 of the Evidence (Amendment) Act 2012 (Act 4 of 2012). For a recent commentary on the changes, see Chen Siyuan, “The 2012 Amendments to Singapore’s Evidence Act: More Questions than Answers as Regards Expert Opinion Evidence” [2013] *Statute Law Review* <<http://slr.oxfordjournals.org/content/early/2013/03/11/slr.hmt003.abstract>> (last accessed 19 August 2013).

17 Law Reform Committee, Singapore Academy of Law, *Report of the Law Reform Committee on Opinion Evidence* (October 2011) at para 10. In the following paragraph, the Law Reform Committee explains its recommendation: to change the basis of admissibility of expert evidence from one of “necessity” to that of “assistance” as long as the court thinks it likely to derive “substantial” assistance (the Law Reform Committee suggested this would avoid too much or marginally helpful expert evidence being adduced but the word “substantial” was not included in the amending legislation) and to broaden the types of evidence which may be admitted under the provision, provided there remains an overriding discretion for the court “to exclude otherwise admissible evidence if it is unfairly prejudicial, misleading or confusing or will lead to an undue waste of judicial time” (although it does not suggest the wording for such an exclusionary discretion, that would apply to all forms of evidence and not just expert evidence, at para 11(d)). It is respectfully submitted that through its more general wording, the recommended amendment would make a welcome move away from the somewhat surprising notion suggested by the current wording that it is the court that has to form an opinion: what the court has to do is make findings of law on the basis of the (admissible) evidence.

12 The LRC Report highlights¹⁸ that the “idiosyncratic sense” of the word “relevant” in s 47 (in its pre-amendment and current form) is “admissible”, rather than “rationally probative”, which is the sense in which it is used in what the LRC Report labels as “modern evidence law” elsewhere.¹⁹ By way of example, the LRC Report refers to s 55(1) of the Australian Evidence Act 1995²⁰ which defines “relevant evidence” as that which “if it were accepted, could rationally affect (directly or indirectly) the assessment of the probability of the existence of a fact in issue in the proceedings”.²¹ In view of this idiosyncratic sense, the LRC Report cautions that it is important to “never lose sight of this fundamental difference between our evidence law and that of most other foreign jurisdictions ... [and] to bear this essential difference in mind when translating into the local context principles drawn from cases, articles and law reform reports from foreign jurisdictions which adopt the modern approach to the law of evidence”.²²

13 Even though he or she may be called as an expert by one of the parties to a dispute, and paid by them for doing so, an expert’s primary duty under O 40A, r 2 of the Rules of Court²³ is to assist the court and this duty overrides whatever obligation is owed to the party calling the expert.²⁴ In addition, it is clear from the judgment of the Court of Appeal in *HSBC Institutional Trust Services (Singapore) Ltd v Toshin Development Singapore Pte Ltd*,²⁵ involving valuation expert evidence,

18 Law Reform Committee, Singapore Academy of Law, *Report of the Law Reform Committee on Opinion Evidence* (October 2011) at para 17.

19 Law Reform Committee, Singapore Academy of Law, *Report of the Law Reform Committee on Opinion Evidence* (October 2011) at para 19.

20 Act 2 of 1995.

21 Law Reform Committee, Singapore Academy of Law, *Report of the Law Reform Committee on Opinion Evidence* (October 2011) at para 22.

22 Law Reform Committee, Singapore Academy of Law, *Report of the Law Reform Committee on Opinion Evidence* (October 2011) at para 36.

23 Cap 322, R 5, 2006 Rev Ed.

24 However, in *Jones v Kaney* [2011] 2 AC 398; [2011] UKSC 13, as one of the majority of the Supreme Court which decided to abolish the longstanding immunity against suit for professional negligence of expert witnesses, Lord Dyson held (at [122]) that, notwithstanding his duty to the court, “an expert engaged for reward does owe a duty of care to his client”. It is respectfully submitted that a Singapore court deciding the same issue should give particular weight to the views of the minority, Lord Hope and Lady Hale, the latter who emphasised at [189] that: [t]he major concern ... is not about the effect of making the exception [to the general rule of immunity for witnesses] upon expert witnesses. If they are truly expert professionals, they should not allow any of this to affect their behaviour. The major concern is about the effect upon disappointed litigants. I agree with Lord Hope that the object of the rule is to protect all witnesses, the great majority of whom are trying to do a professional job and are well aware of their duties to the court, against the understandable but usually unjustifiable desire of a disappointed litigant to blame someone else for his lack of success in court.

25 [2012] 4 SLR 738.

that experts should as a matter of legal principle disclose “without any prompting” any existing or recent relationship with any of the parties.²⁶ “A failure to make proper disclosure in a timely manner may raise serious concerns about apparent or actual bias on the part of the expert”²⁷ that could lead to the evidence being discounted.

III. Procedure for the admission of expert evidence

14 Order 40A of the Rules of Court²⁸ sets out the requirements for the form in which expert evidence may be submitted:

- (1) Unless the Court otherwise directs, expert evidence is to be given in a written report signed by the expert and exhibited in an affidavit sworn to or affirmed by him testifying that the report exhibited is his and that he accepts full responsibility for the report.
- (2) An expert’s report must —
 - (a) give details of the expert’s qualifications;
 - (b) give details of any literature or other material which the expert witness has relied on in making the report;
 - (c) contain a statement setting out the issues which he has been asked to consider and the basis upon which the evidence was given;
 - (d) if applicable, state the name and qualifications of the person who carried out any test or experiment which the expert has used for the report and whether or not such test or experiment has been carried out under the expert’s supervision;
 - (e) where there is a range of opinion on the matters dealt with in the report —

26 In England, see also on this issue, *Gallaher International Ltd v Tlais Enterprises Ltd* [2007] EWHC 464 (Comm), a case in which it was proposed that an employee should give expert evidence. In ruling that to do so was not improper in that particular case, Aikens J was impressed by the steps that had been taken to ensure independence – the employee had had the benefit of independent legal advice on his role, there was an open declaration of his position, there was an undertaking by the employer not to influence him (paraphrasing slightly), he was aware of his duty to the court and keen to perform it, and experts in the area were scarce. It was, however, noted by Mann J in *Meat Corp of Namibia Ltd v Dawn Meats (UK) Ltd* [2011] EWHC 474 (Ch) at [58] that “[i]t does not follow that those steps are necessary in any other case ...”.

27 *HSBC Institutional Trust Services (Singapore) Ltd v Toshin Development Singapore Pte Ltd* [2012] 4 SLR 738 at [71]. See also generally Jeffrey Pinsler, “Expert’s Duty to be Truthful in the light of the Rules of Court” (2004) 16 SAclJ 407.

28 Cap 322, R 5, 2006 Rev Ed.

- (i) summarise the range of opinion; and
- (ii) give reasons for his opinion;
- (f) contain a summary of the conclusions reached;
- (g) contain a statement of belief of correctness of the expert's opinion; and
- (h) contain a statement that the expert understands that in giving his report, his duty is to the Court and that he complies with that duty.^[29]

15 In England, the Civil Procedure Rules 1998 (“CPR”)³⁰ provide that the starting point in relation to expert evidence is that it “be restricted to that which is reasonably required to resolve the proceedings” (r 35.1). Additionally, the court’s permission must be obtained before expert evidence may be adduced:

35.4

- (1) No party may call an expert or put in evidence an expert’s report without the court’s permission.
- (2) When a party applies for permission under this rule he must identify –
 - (a) the field in which he wishes to rely on expert evidence; and
 - (b) where practicable the expert in that field on whose evidence he wishes to rely.
- (3) If permission is granted under this rule it shall be in relation only to the expert named or the field identified under paragraph (2).
- (4) The court may limit the amount of the expert’s fees and expenses that the party who wishes to rely on the expert may recover from any other party.

16 In a copyright case in England that preceded the Woolf reforms and the CPR, *Cala Homes (South) Ltd v Alfred McAlpine Homes East Ltd* (“*Cala Homes*”),³¹ Laddie J criticised trenchantly the views expressed in “The Expert Witness: Partisan with a Conscience”, an article in the August 1990 *Journal of the Chartered Institute of Arbitrators* by Francis Goodall, a distinguished expert (and Fellow of the Chartered Institute). He had suggested that it was appropriate for an expert to act as a “hired

29 Jeffrey Pinsler, “Expert’s Duty to be Truthful in the light of the Rules of Court” (2004) 16 SAclJ 407 at 422 suggests that “[t]he distinction between a ‘court expert’ [appointed very rarely under O 40] and a ‘party’s expert’ [appointed under O 40A] ... gives the unintended impression that one is independent and the other is not. It foments an improper view of the nature of expert testimony”.

30 SI 1998/3132.

31 [1995] FSR 818.

gun” unless and until he found himself in court (which he noted “happens more rarely than is acknowledged in much of the comment on expert witness work”) where “the earlier pragmatic flexibility is brought under a sharp curb, whether of conscience, or fear of perjury, or fear of losing professional credibility. It is no longer enough for the expert like the ‘virtuous youth’ in the Mikado to ‘tell the truth whenever he finds it pays’: shades of moral and other constraints begin to close up on him.”

17 Laddie J’s response was that:³²

The judge is not a rustic who has chosen to play a game of Three Card Trick [Goodall had suggested that such a man is not cheating, nor does he incur any moral approbrium, when he uses sleight of hand to deceive the eye of the innocent rustic]. He is not fair game. Nor is the truth.

18 With respect to the judge’s view, which is obviously incontrovertible, it is by no means clear that Goodall was suggesting otherwise: his point appears to have been the more subtle one that in most cases, because they do not reach trial, the use of experts is limited to the early, pre-trial stages of litigation that usually lead to a settlement of one form or another (or abandonment of the claim before trial) and that the expert should be free to perform as a hired gun (deceiving the eyes of the innocent rustics on the other side) in those stages without prejudice to his or her obligations *vis-à-vis* evidence to be adduced at trial. However, it is very difficult to see how a line can sensibly be drawn between evidence used in the pre-trial stages of litigation and that used and cross-examined at trial.

19 In *Jones v Kaney*,³³ a road traffic accident case, in which by a majority of 5:2 the former absolute immunity from suit for professional negligence of (“friendly” rather than adverse)³⁴ expert witnesses was abolished by the UK Supreme Court, Lord Phillips commented that Laddie J in *Cala Homes* had been:³⁵

rightly critical of the approach of this expert. There is no longer any scope, if indeed there ever was, for contrasting the duty owed by an expert to his client with a different duty to the court, which replaces the former, once the witness gets into court. In response to Lord Woolf’s recommendations on access to justice the CPR now spell

32 *Cala Homes (South) Ltd v Alfred McAlpine Homes East Ltd* [1995] FSR 818 at 842–843. The judge proceeded to remind those preparing expert reports of the importance of independence and objectivity, citing from the judgment of Cresswell J in *The Ikarian Reefer* [1993] FSR 563 at 565.

33 [2011] UKSC 13.

34 *Jones v Kaney* [2011] 2 AC 398; [2011] UKSC 13 at [71]–[73], *per* Lord Collins.

35 *Jones v Kaney* [2011] 2 AC 398; [2011] UKSC 13 at [49]–[50].

out in detail the duties to which expert witnesses are subject including, where so directed, a duty to meet and, where possible, reach agreement with the expert on the other side. At the end of every expert's report the writer has to state that he understands and has complied with his duty to the court. Where an expert witness is retained, it is likely to be, as it was in the present case, on terms that the expert will perform the functions specified in the CPR. The expert agrees with his client that he will perform the duties that he owes to the court. Thus there is no conflict between the duty that the expert owes to his client and the duty that he owes to the court. Furthermore, a term is implied into the contract under section 13 of the Supply of Goods and Services Act 1982, that the expert will exercise reasonable skill and care in carrying out the contractual services.

Thus the expert witness has this in common with the advocate. Each undertakes a duty to provide services to the client. In each case those services include a paramount duty to the court and the public, which may require the advocate or the witness to act in a way which does not advance the client's case. The advocate must disclose to the court authorities that are unfavourable to his client. The expert witness must give his evidence honestly, even if this involves concessions that are contrary to his client's interests. The expert witness has far more in common with the advocate than he does with the witness of fact.

20 In practice, expert evidence primarily adduced for the purpose of setting out the expert's opinion will often include factual evidence that may be drawn from the expert's general experience.³⁶ Strictly, such evidence should not be admitted as it is hearsay, although in England the rule against the admission of hearsay evidence was abolished for civil cases (although not for criminal) by s 5 of the Civil Evidence Act 1995.³⁷ However, the LRC Report notes that a more liberal attitude tends to be adopted as "different considerations arise in cases of expert evidence where some reference to hearsay materials should be allowed as opposed to evidence of fact where the hearsay rule should be strictly observed."³⁸ In *Gema Metal Ceilings (Far East) v Iwatani Techno*

36 See, for example, the comments of Megarry J in *English Exporters (London) Ltd v Eldonwall Ltd* [1973] 1 Ch 415, a valuation case cited by the Law Reform Committee, Singapore Academy of Law, *Report of the Law Reform Committee on Opinion Evidence* (October 2011) at paras 254 and 257, accepting the admissibility of such evidence but going on to say "it seems to me quite another matter [and it should be excluded as inadmissible hearsay] when it is asserted that a valuer may give factual evidence of transactions of which he has no direct knowledge": this could well apply to trade mark infringement and passing off cases in which there is a tendency to hear retail experts in relation to, for example, the likelihood of confusion.

37 c 38.

38 Law Reform Committee, Singapore Academy of Law, *Report of the Law Reform Committee on Opinion Evidence* (October 2011) at para 258.

Construction (M) Sdn Bhd,³⁹ Chan Seng Onn JC (as his Honour then was) noted:⁴⁰

I recognise that most experts frequently employ hearsay to some degree in forming their views. In fact, as a matter of convenience, courts have sometimes tended not to insist upon proof of the extrinsic materials customarily employed by experts to perform their work, namely understanding obtained from use of professional libraries and knowledge acquired in the discharge of professional duties.

21 Where relying on such general experience and extrinsic materials, the expert is required by O 40A r 3(2)(a) of the Rules of Court⁴¹ to indicate this is so.

IV. Patent cases

22 By their very nature, practically all patent cases involve technical issues on which the judge will expect assistance from expert witnesses, on both sides.⁴² In Singapore, the danger of not providing such assistance was made clear in an application to revoke a patent, where the judge noted that a failure by the party making the attack to adduce expert evidence on how the person skilled in the art would have viewed the claims “does not mean that a court ... will simply substitute its own judgment” rather than rely on the views of the patentee’s expert witness.⁴³

23 However, it must always be borne in mind that expert witnesses can only assist the court; it is for the tribunal to decide the questions of law and it should not delegate that task to the expert witnesses, however eminent or persuasive. In the words of Jacob LJ in the English Court of Appeal:⁴⁴

Their primary function is to educate the court in the technology – they come as teachers, as makers of the mantle for the court to don. For that purpose it does not matter whether they do or do not

39 [2000] SGHC 37.

40 *Gema Metal Ceilings (Far East) v Iwatani Techno Construction (M) Sdn Bhd* [2000] SGHC 37 at [74].

41 Cap 322, R 5, 2006 Rev Ed.

42 In England, this will often include a “primer” in the technology concerned, agreed between the parties’ experts.

43 In *Martek Biosciences Corp v Cargill International Trading Pte Ltd* [2012] 2 SLR 482 at [56], *per* Tay Yong Kwang J, when overturning the decision of a patents tribunal of the IP Office of Singapore to revoke a claim on the ground that it lacked inventive step, despite the absence of expert evidence adduced by the applicant for revocation on whether it would have been obvious to the person skilled in the art to “mosaic” (or read together) two different documents in the prior art.

44 *Technip France SA’s Patent* [2004] RPC 46 at [43], *per* Jacob LJ (CA).

approximate to the skilled man. What matters is that they are good at explaining things.

24 Drawing an analogy with the test applied to expert evidence in relation to professional negligence – what matters is not what the individual expert witness says he personally would have done, but whether the conduct said to be negligent falls short of what a reasonable professional would have done⁴⁵ – the same judge noted in relation to the question (not one of law but of fact) as to what would have been “obvious” to the person skilled in the art:⁴⁶

... it is not so much the expert’s personal view but his reasons for that view – these the court can examine against the standard of the notional unimagined skilled man.^[47]

25 In that context, he cautioned:⁴⁸

... a judge should be careful to distinguish his views on the experts as to whether they are good witnesses or good teachers – good at answering the questions asked and not others, not argumentative and so on, from the more fundamental reasons for their opinions. Ultimately it is the latter which matter – are they reasons which would be perceived by the skilled man?

26 Thus, the expert’s role is to assist the court in its task of viewing the patent claims through the eyes of the person skilled in the art at the time the patent was applied for.⁴⁹ The expert need not himself be skilled in the art in question, although he usually is. Likewise, he need not be independent⁵⁰ (he could be an employee in appropriate circumstances)⁵¹

45 As laid down by McNair J in *Bolam v Friern Hospital Management Committee* [1957] 1 WLR 582.

46 *Pfizer Ltd’s Patent* [2001] FSR 201 at [62], per Laddie J:
This is not a real person. He is a legal creation. He is supposed to offer an objective test of whether a particular development can be protected by a patent. He is deemed to have looked at and read publicly available documents and to know of public uses in the prior art. He understands all languages and dialects. He never misses the obvious nor stumbles on the inventive. He has no private idiosyncratic preferences or dislikes. He never thinks laterally. He differs from all real people in one or more of these characteristics.

47 *SmithKline Beecham PLC v Apotex Europe Ltd* [2005] FSR 23 at [52].

48 *SmithKline Beecham PLC v Apotex Europe Ltd* [2005] FSR 23 at [53].

49 The task as described by Lord Hoffmann in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9, adopted by the Singapore Court of Appeal in *FE Global Electronics Pte Ltd v Trek Technology (Singapore) Pte Ltd* [2006] 1 SLR 874 at [14].

50 It was noted by Tay Yong Kwang J in *Martek Biosciences Corp v Cargill International Trading Pte Ltd* [2012] 2 SLR 482 at [46] that in cases involving very specific technology, it is “not surprising if only a limited number of experts are available, such that pre-eminent experts may have certain work experience which might at first sight appear to threaten their independence”.

51 In *Mühlbauer AG v Manufacturing Integration Technology Ltd* [2010] 2 SLR 724, the expert witness was one of the inventors of a patent relied on by the defendant
(cont’d on the next page)

although he usually is in order to avoid accusations of bias.⁵² Indeed, in the words of Andrew Phang JA in *Mühlbauer AG v Manufacturing Integration Technology Ltd*,⁵³ “[t]he difficulties engendered by the issue of *bias* with regard to experts for the respective parties are, unfortunately, perennial in nature”.⁵⁴ It was noted by the judge that it had been suggested by counsel for the patentee that a new system involving impartial assessors should be considered because “possible (or even probable) bias of experts is an especially significant one in patent cases”.⁵⁵ Whilst expressing no firm view (“it might well be the case ... [but] it is obviously also significant with respect to all other areas of the law as well”) on whether the latter contention is correct, the judge referred to the possibility of the parties applying to the court to appoint an impartial and objective expert under the powers already contained in O 40 r 1 and remarked that “it may well be wise and prudent ... in future cases (especially of this nature)”.⁵⁶ However, this remark does not seem to have been acted upon by parties in subsequent patent cases.

27 Above all, the expert must realise that he is not an advocate for the position adopted by the party retaining him: “his advocacy is limited

in its counterclaim for invalidity and his evidence was relied on heavily by the trial judge, who found the patent in issue to be invalid, but did not find such favour in the Court of Appeal, which reversed the trial judge’s finding of invalidity. In *Forensic Telecommunications Services Ltd v Chief Constable of West Yorkshire Police* [2012] FSR 15 at [7], a copyright infringement and breach of confidence case, Arnold J confirmed that “the mere fact that [the witness] is employed by [the plaintiff] does not debar him from giving expert evidence on its behalf”, although he emphasised that the fact “made it all the more important” to adhere to the requirements of CPR r 35.10 and the Practice Direction Pt 35 – Experts and Assessors and the Protocol for the Instruction of Experts to Give Evidence in Civil Cases.

52 In *Asia Hotel Investments Ltd v Starwood Asia Pacific Management Pte Ltd* [2007] SGHC 50 at [206]–[207], it was observed that in deciding whether an expert’s evidence should be discounted, the test is *actual* partiality rather than an *appearance* of partiality.

53 [2010] 2 SLR 724 at [44].

54 The learned judge referred to his own detailed comments on the subject in the earlier case of *Khoo Bee Keong v Ang Chun Hong* [2005] SGHC 128 at [68] and [82]–[87]. In that case, the judge noted at [84] that “one cannot be faulted for taking the views just expressed, with respect to the expert’s duty to the court and to justice, with the proverbial pinch of salt, especially when one views this proposition through the lenses of practical reality”. In the UK Supreme Court case of *Jones v Kaney* [2011] 2 AC 398; [2011] UKSC 13, see n 24 above, Lord Collins said at [81]: “[t]he reality is that an expert retained by one party is not an unbiased witness, and the threat of liability for negligence may encourage more careful and reliable evaluation of the case by the expert.”

55 *Mühlbauer AG v Manufacturing Integration Technology Ltd* [2010] 2 SLR 724 at [45].

56 *Mühlbauer AG v Manufacturing Integration Technology Ltd* [2010] 2 SLR 724 at [45]. The learned judge also noted at [45] that the same rule permits the court to appoint one or more independent experts of its own motion, although he considered “this particular avenue will probably prove less than practical”.

to supporting his independent views and not his client's cause".⁵⁷ This is an important distinction that some experts fail to grasp.⁵⁸ Nor is the expert there to offer his opinion on whether or not there is infringement: his role is to guide the court as to the meaning of technical terms or what exactly is disclosed by the prior art.⁵⁹ It is a question of law for the judge whether there is infringement. (In this context, it is respectfully submitted that when V K Rajah JA stated in *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd*⁶⁰ that "[t]here was clear evidence from the respondent's expert witness ... that the FCC system infringed the Patent",⁶¹ what he meant was that there was clear evidence on which the trial judge could find infringement; likewise, when the learned judge proceeded to characterise the issue of infringement as a question of fact, he must be taken to have meant that the *legal* question of what constitutes infringement is one that is answered on the basis of the facts.)

28 In *Pfizer Ltd's Patent*,⁶² Laddie J addressed the problem of choosing an expert who is too expert:⁶³

In most substantial patent cases the technology at issue is sophisticated and the witnesses called are experts in their fields. In most cases, of which this is a good example, they are either renowned academics or researchers who have been immersed in the research and development departments of major companies. In either case they come to the issues not only with profound understanding of the technology but also frequently with knowledge of additional private and relevant information which is not deemed to be known to the notional addressee [*ie*, the person skilled in the art].

57 *Vita Health Laboratories Pte Ltd v Pang Seng Meng* [2004] SLR(R) 162 at [83], *per* V K Rajah J (as he then was), in a case which involved tangentially the exploitation of IP rights.

58 In his Foreword to *The Expert Witness Institute's Experts in the Civil Courts* (Sir Louis Blom-Cooper QC ed) (Oxford University Press, 2006), Sir Anthony Clarke MR goes further and comments that "[partisanship] seems to me to be inevitable. It is inevitable because it is human nature".

59 The principle that unless the trial judge has erred in principle, an appellate court should be slow to interfere with findings of fact in relation to obviousness, known as the *Biogen* principle [1997] RPC 1 (HL), also applies to a trial judge's preference for one expert over another if there is a conflict of expert testimony on the meaning of a technical term or what has been disclosed by the prior art: *per* Jacob LJ in *SmithKline Beecham plc v Apotex Europe Ltd* [2005] FSR 23 at [36].

60 [2007] SGCA 50.

61 [2007] SGCA 50 at [82].

62 [2001] FSR 201.

63 *Pfizer Ltd's Patent* [2001] FSR 201 at [64]. Later in his judgment, Laddie J came to the conclusion that the evidence given by Ignarro, a Nobel Laureate expert witness called by Pfizer, resulted from the witness's scepticism as a result of his personal experience (at [146]) and did not represent the approach of "the skilled non-inventive addressee" of the patent (at [145]).

29 As the role of the expert witness in a particular case may be to assist the court in seeing the patent specification and particularly the claims through the eyes of the notional skilled person at the time of the patent application, including assisting in explaining what was common general knowledge at that time, the judge cautioned that it can be dangerous to rely on the evidence of a witness who may have fixed and perhaps unrepresentative views by reason of their very brilliance and eminence in the technical field in question.⁶⁴

If a genius in a field misses a particular development over a piece of prior art, it could be because he missed the obvious, as clever people sometimes do, or because it was inventive. Similarly credible evidence from him that he saw or would have seen the development may be attributable to the fact that it is obvious or that it was inventive and he is clever enough to have seen it. So evidence from him does not *prove* that the development is obvious or not. It may be valuable in that it will help the court to understand the technology and how it could or might lead to the development.

30 On similar lines, Andrew Phang JA in *Mühlbauer AG v Manufacturing Integration Technology Ltd*⁶⁵ warned that “many experts would *not themselves* fall within this particular category of persons ‘skilled in the art’ as they would possess *extraordinary* knowledge as well as expertise” and cautioned counsel and, if necessary, the court to remind experts of this danger.

31 After all, it is not only expert witnesses who sometimes lose sight of common sense or the opposite and perhaps more sensible view of the non-specialist. By way of example, cited here is the patent case of *Nichia Corp v Argos Ltd*⁶⁶ in the English Court of Appeal, in which the two non-specialist judges, Rix and Pill LJ, disagreed, respectfully but firmly, with their IP-specialist brother judge, Jacob LJ, whose judgment proposed curtailed disclosure (discovery) on what the inventor had actually done.

32 In an explanation redolent of a Charles Dickens lament about the 19th century English legal (and patent) system,⁶⁷ Jacob LJ had this to

64 *Pfizer Ltd's Patent* [2001] FSR 201 at [63].

65 [2010] 2 SLR 724 at [48].

66 [2007] FSR 38.

67 Not only did Dickens' description of Chancery in *Bleak House* put the English legal system in a very bad light, but so did his less well-known work, *A Poor Man's Tale of a Patent*, which tells of the trials and tribulations of a 56-year-old patent applicant, who concludes, “Is it reasonable to make a man feel as if, in inventing an ingenious improvement meant to do good, he had done something wrong? How else can a man feel, when he is met by such difficulties at every turn? All inventors taking out a Patent MUST feel so. And look at the expense. How hard on me, and how hard on the country if there's any merit in me (and my invention is took up

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say about why disclosure (discovery) in this area results inevitably in significant expense for both plaintiff and defendant:⁶⁸

Following *SKM*, disclosure of inventor's records became routine. No one doubts that it has very considerably increased the expense of patent actions. Consider what is involved. First the documents have to be searched for and identified. This will involve reading them not only by the lawyers but also perhaps by an expert or experts whose assistance in understanding may be needed. The expert may come from within the client, or may be an outside expert. Both sorts of expert may be involved. The inventor may be called in if available to explain his documents. Normally several lawyers and a patent agent may be required. The relevant may be sifted from the irrelevant. Often translation will be involved. When all this has been done the documents are disclosed. The other side's lawyers aided by their experts crawl all over them. As is usual they look for references to documents mentioned but not disclosed. This leads to enquiries about missing documents and disputes about that. Not infrequently there are disputes about confidentiality and the formation of complicated 'confidentiality clubs' of designated lawyers, patent agents and independent experts, not to mention painfully detailed work on redaction of material said to be irrelevant. On both sides many, many hours are spent and many pages are involved. Not infrequently the whole lot ends up being copied for trial.

And all for what? Only 'secondary evidence' which must be kept 'firmly in its place' [in the words of Sir Donald Nicholls VC in *Mölnlycke* [1994] RPC 49 (CA) at 113].

33 However, the two non-specialists were, with the "greatest diffidence and reluctance" (*per* Rix LJ), unable to accept that there needed to be a special rule for patent cases, although they agreed wholeheartedly with him on the importance of seeking to avoid unnecessary and disproportionate expense. In the words of Pill LJ:⁶⁹

Patent infringement disputes obviously have features of their own but they are but one species of a very wide range of commercial disputes which come before the courts. It would not inspire confidence if businesses and their advisers were met with different standards of disclosure depending on the type of dispute involved ...

now, I am thankful to say, and doing well), to put me to all that expense before I can move a finger!"

68 *Nichia Corp v Argos Ltd* [2007] FSR 38 at [36].

69 *Nichia Corp v Argos Ltd* [2007] FSR 38 at [83] and [88], respectively. Retired English High Court judge Sir Oliver Popplewell has commented of the role of the judge in medical negligence cases, in *Hallmark: A Judge's life at Oxford* (IB Tauris & Co, 2009) at p 88: "Sometimes the views of two equally distinguished experts conflicted and in this case it was never an easy task for the layman, which is what the judge is, to determine not where the truth lay (because the experts were both honest witnesses) but where the line should be drawn."

...

I obviously express views on experts in this field with diffidence, in light of Jacob L.J.'s experience, but the need to scrutinise their evidence in the interests of justice and to have the appropriate tools with which to do so, appears to me to be no different in this field from that in the many other fields, with which most members of this court have wide experience, in which expert evidence is called.

V. Registered design cases

34 Despite the fact that both patents and registered designs are monopoly rights issued by a granting authority under a detailed statutory regime, compared with cases involving patents, there ought to be relatively less scope for adducing expert evidence in a registered design infringement case, accompanied though it may be by the usual counterclaim for invalidity.

35 According to Jacob LJ, in a registered design case in England, all that the court has to do is compare the registered design with the allegedly infringing product and decide if there is any relevant prior art, “[a]nd the most important thing about each of these is what they look like”.⁷⁰

36 Thus:⁷¹

[i]t follows that a place for evidence is very limited indeed. By and large it should be possible to decide a registered design case in a few hours ... The evidence of experts, particularly about consumer products, is unlikely to be of much assistance: anyone can point out similarities and differences, though an educated eye can sometimes help a bit. Sometimes there may be a piece of technical evidence which is relevant – eg, that design freedom is limited by certain constraints. But even so that is usually more or less self-evident and certainly unlikely to be controversial to the point of a need for cross-examination, still less substantial cross-examination.

37 Although today the law of registered designs is different in material respects in Singapore,⁷² there is no reason why this approach

70 *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2008] FSR 8 (CA) at [3].

71 *Procter & Gamble Co v Reckitt Benckiser (UK) Ltd* [2008] FSR 8 (CA) at [4], per Jacob LJ. The judge proceeded to cite *Thermos Ltd v Aladdin Sales & Marketing Ltd* [2000] FSR 402 at 404, in which he had expressed the view that “the court should take care before allowing any expert evidence [in registered design cases]”, as “[i]f blanket permission is given, each side feels compelled to get an expert who then has to say something. What is then said has to be read by the other side. Thereby time and cost to no particular use is expended”.

72 See the magisterial work by George Wei, *Industrial Design Law in Singapore* (Academy Publishing, 2012) and particularly his treatment of the fact that the first

would not be followed here in cases concerning designs registered under the Registered Designs Act.⁷³

38 By way of example, in *Nagasima Electronic Engineering Pte Ltd v APH Trading Pte Ltd*,⁷⁴ the first case decided under the new Singapore registered design law, Lai Kew Chai J did not need expert evidence to assist in his consideration of the novelty of the registered design for an electrical isolator, mostly installed in HDB flats, although he did:⁷⁵

... take judicial notice of the fact that connectors of all shapes, including right-angled shapes, have been in existence for a very long time, not just in the electrical field but in other fields such as plumbing. The connectors are right-angled to connect two items where a direct or straight connection is not possible.

VI. Passing off and trade mark cases

39 In *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide Inc*,⁷⁶ which concerned the trade mark “St Regis” registered in relation to, *inter alia*, hotel services and a subsequent application to register “Park Regis” for the same services, Judith Prakash J refused permission to adduce in evidence letters from travel agents who stated they had not witnessed any confusion between the two marks, applying the rule against hearsay evidence and relying on *Soon Peck Wah v Woon Che Chye*.⁷⁷

Singapore statute for the registration of designs in Singapore, the Registered Designs Act (Cap 266, 2005 Rev Ed) (“RDA”), does not, unlike the earlier UK Acts which were extended to Singapore (a process described by the then Minister of State for Law, Professor Ho Peng Kee, as “circuitous, time-consuming and costly”, cited by Wei (at para 2.3)), contain the requirement that the design have eye appeal. Wei concludes (at para 2.41) that “[t]here is no doubt that under the Singapore RDA, features of design are still concerned with visual appearance”, while emphasising at para 2.51 the greater importance than hitherto of the exclusion from registrability of functional features contained in s 2(1) of the RDA; indeed, he notes (at para 2.42) that the exclusion could be extended beyond “features of shape or configuration” to include “patterns (dictated solely by function)”.

73 Cap 266, 2005 Rev Ed.

74 [2005] 2 SLR(R) 641; Registered Designs Act (Cap 266, 2005 Rev Ed): although it concerned a design registered in the UK under the previous legislation, the Registered Designs Act’s transitional provisions deemed it to be a registered design under the Registered Designs Act.

75 *Nagasima Electronic Engineering Pte Ltd v APH Trading Pte Ltd* [2005] 2 SLR(R) 641 at [20].

76 [2013] 1 SLR 489.

77 [1997] 3 SLR(R) 430, although it should be noted that Jeffrey Pinsler, in *Evidence and the Litigation Process* (LexisNexis, 3rd Ed, 2010), suggests that the Court of Appeal in that case was in error when it stated, at [27], that “[i]n Singapore, the rule against hearsay is reflected in s 62 of the Evidence Act”. He notes (at para 4.06) that the section does not formulate the rule against hearsay as it “omits the
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40 Given that the test for infringement of a trade mark “has to be looked at globally taking into account all the circumstances”⁷⁸ through the eyes of the average consumer of the goods or services in question,⁷⁹ it can be questioned how much expert witnesses can and should assist the court in that assessment, particularly in cases where the goods or services are ones that are come across frequently in daily life. Thus, in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd*,⁸⁰ the Singapore Court of Appeal made it clear that while evidence of actual confusion “can be very helpful [in answering the question for the court of whether there is likely to be confusion], its absence should not be accorded undue significance”⁸¹ and was certainly not “fatal to the claim [of trade mark infringement]”,⁸² which the court upheld. Nevertheless, in both Singapore and England, expert evidence is admitted not infrequently even in such cases.

41 For example, in the English High Court in *D Jacobson & Sons Ltd v Globe Ltd*,⁸³ Etherton J heard the evidence of the plaintiff’s expert, Tom Blackett,⁸⁴ that “typical buyers of trainers would be likely to take the [plaintiff’s] Wing Flash logo as the manufacturer’s brand rather than serving a mere decorative purpose”.⁸⁵ In turn, the defendant relied heavily on another expert whose opinion was that “unless educated otherwise, consumers are likely to consider stripes on the side of trainers as being nothing more than design features rather than brand logos; and that, in order to make design features themselves a recognised brand, an organisation would have to work on branding and marketing.”⁸⁶ It is surely difficult for any objective observer to understand why it requires experts to give such blinding glimpses of the obvious. However, the judge concluded that “the weight of the [other] evidence supports Blackett’s views”;⁸⁷ a conclusion that raises the interesting question, was it necessary then? While the plaintiff in that case had a turnover of

distinction between assertions tendered as evidence of the facts referred to and statements which are relevant by virtue of having been made”. Obviously, the evidence in *Staywell Hospitality Group Pty Ltd v Starwood Hotels & Resorts Worldwide Inc* [2013] 1 SLR 489 fell within the former category and therefore was properly excluded by Judith Prakash J under the rule.

78 *The Polo/Lauren Co, LP v Shop In Department Store Pte Ltd* [2006] 2 SLR(R) 690 at [28].

79 In some ways, the trade mark law equivalent of the patent system’s “person skilled in the art”.

80 [2013] 2 SLR 941.

81 *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 at [100].

82 *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 at [106].

83 [2008] FSR 21.

84 Who appears regularly as an expert witness in trade mark and passing off cases in England.

85 [2008] FSR 21 at [133].

86 [2008] FSR 21 at [110].

87 [2008] FSR 21 at [134].

approximately £70m and the defendant was a subsidiary of a company listed on the Australian Stock Exchange, so presumably both could easily afford the increased costs, it is a legitimate concern whether a less pecunious defendant, or even plaintiff, would have been able to and would therefore have settled early or foresworn resort to legal proceedings, respectively.

42 As observed by Tan Tee Jim in *Law of Trade Marks and Passing Off in Singapore*⁸⁸ in relation to survey evidence but equally applicable here, “the absence or inadequacy of such evidence only means that the court will have to examine any other evidence adduced, and rely on its own examination of the marks, to determine if there is a likelihood of confusion.”⁸⁹

43 At this juncture, it is also worthwhile recalling the words of Millett LJ in *The European Ltd v The Economist Newspaper Ltd*:⁹⁰

It is legitimate to call evidence from persons skilled in a particular market to explain any special features of that market of which the judge may otherwise be ignorant and which may be relevant to the likelihood of confusion. It is not legitimate to call such witnesses merely in order to give their opinions whether the two signs are confusingly similar. They are experts in the market, not on confusing similarity.

44 In *Law of Trade Marks and Passing Off in Singapore*, Tan cites the above and suggests that, despite the warning, “there is merit in admitting evidence from trade witnesses and allowing the judge to decide from the totality of the evidence presented to him”.⁹¹ It is respectfully submitted in response that it is also in the interests both of speedy and cost-effective justice and of keeping the doors of the courts open to the not very wealthy as well as the deep-pocketed that judges do not allow the admission of expert evidence in areas where they are perfectly capable of relying on their own experience. As Rothstein J said when giving the judgment of the Supreme Court of Canada in *Masterpiece Inc v Alavida Lifestyles Inc*:⁹²

In light of the relatively extensive expert evidence in this case, and the difficulties with the evidence that I discuss below, I think it is timely to recall that litigation is costly. Courts must fulfil their gatekeeper role to ensure that unnecessary, irrelevant and potentially distracting expert and survey evidence is not allowed to extend and complicate court

88 Sweet & Maxwell Asia, 2nd Ed, 2005.

89 Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell Asia, 2nd Ed, 2005) at para 6.44.

90 [1998] FSR 89 (CA) at 291.

91 Tan Tee Jim, *Law of Trade Marks and Passing Off in Singapore* (Sweet & Maxwell Asia, 2nd Ed, 2005) at para 6.43.

92 [2011] 2 SCR 387 at [76].

proceedings. While this observation applies generally, I focus particularly on trade-mark confusion cases.^{93]}

45 Litigation is costly not only in Canada, it is also costly in England and Singapore. The cost is increased further when the parties are permitted by the court to engage in a battle of experts without serious consideration of whether, or to what extent, it is necessary or just to do so.

46 After more than 25 years' practice in the IP field in England, the author is confident in asserting without empirical evidence that expert evidence for use in IP proceedings there is both expensive to obtain and expensive for the other party to argue against, thus, its relevance and probative value should always be scrutinised carefully.

47 In England, such cost concerns have led recently to careful consideration of the need for a particular form of expert evidence, namely survey evidence, in the closely related fields of passing off and trade marks. In the former, it is for the court and the court alone to decide whether deception and thereby harm to the plaintiff's goodwill has been caused by the defendant's activities, in the latter it is for the court to decide whether there is a likelihood of confusion between the registered mark and the defendant's sign.

A. *Survey evidence*

48 Expert evidence adduced in support of a claim of trade mark infringement and/or passing off often takes the form of a survey (the results of which are exhibited to the statement of the expert witness who has devised and supervised the carrying out of the survey) and it has become almost standard practice to have such surveys carried out. Despite this, reviewing the authorities in both Singapore and England, it is difficult to escape the conclusion that few cases turn on the weight given to survey evidence. When the survey evidence supports the judge's view on deception or the likelihood of confusion gleaned from all the other evidence, it is referred to in support; when it does not, it is disregarded or accorded little weight. By way of example only, from an English case:⁹⁴

93 Rothstein J continued in the following paragraph:

If a trial judge concludes that proposed expert evidence is unnecessary or irrelevant or will distract from the issues to be decided, he or she should disallow such evidence from being introduced. I will also suggest that proposed expert and survey evidence be a matter for consideration at the case management stage of proceedings so that if such evidence would not be admissible at trial, much of the cost of engaging experts and conducting surveys may be avoided.

94 *Associated Newspapers Ltd v Express Newspapers* [2003] FSR 51 at [43], *per* Laddie J.

Notwithstanding the defendant's criticisms, the [plaintiff's] survey does give a feel for the reaction of members of the public to the defendant's proposed newspaper ... The outcome of the survey accords with one's expectations.

49 And a Singapore case:

[in the High Court] The survey by Sinclair merely confirms what the witnesses before me are all saying, that 'Millenia' and 'Millennium' are visually and phonetically similar and that the public might think that there is a relationship or connection between RCMS and say Millennium Orchard.⁹⁵

[in the Court of Appeal] This evidence merely corroborates the learned judge's finding that there was confusion.⁹⁶

50 In England, the leading practitioners' text, *Kerly's Law of Trade Marks and Trade Names*,⁹⁷ summarises the net effect of the rules for the admission of survey evidence:⁹⁸

[I]t is very difficult to design a survey which will pass muster in court, and their design has become a very specialised art. One technique which improves the chances of useful evidence being obtained is to begin with a very open question, such as 'what can you tell me about this product?' and to move on to ones which are gradually more specific, such as 'can you tell me who makes this product?' The evidence of respondents who give useful answers to the very broad question is then untainted, while leaving an opportunity still to get evidence from persons who misunderstand what the interest of the interviewer is.

51 Even this cautious view of surveys is now outmoded after the judgment of Lewison LJ in *Marks & Spencer plc v Interflora Inc*,⁹⁹ which would permit only "a statistically reliable and well conducted poll".¹⁰⁰

52 On the other hand, the Singapore courts have adopted a robust attitude to objections to the admissibility of survey evidence in trade mark infringement and passing off cases. In *CDL Hotels International Ltd v Pontiac Marina Pte Ltd*, L P Thean JA said of the survey evidence

95 *Pontiac Marina Pte Ltd v CDL Hotels International Ltd* [1997] 1 SLR(R) 422 at [104], per Chao Hick Tin J; affirmed by the Court of Appeal in *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 at [76].

96 *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 at [79], per L P Thean JA.

97 Sweet & Maxwell, 15th Ed, 2011.

98 *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell, 15th Ed, 2011) at para 21-026.

99 [2013] ETMR 11 at [62].

100 *Marks & Spencer plc v Interflora Inc* [2013] FSR 21 at [54]; in the following paragraph, he emphasised that the surveys be "statistically significant", which in turn will increase the cost.

adduced by the plaintiffs to show the opinion of the members of the public surveyed that the two words, “Millenia” and “Millennium”, were similar visually and phonetically:¹⁰¹

It was to show that such belief or opinion exists among a certain number of people; it was not admitted to prove the truth or merits of such belief or opinion so held. In *Saga Foodstuffs Manufacturing (Pte) Ltd v Best Food Pte Ltd* [1994] 3 SLR(R) 1013, one of the issues raised was whether the survey report tendered by the plaintiffs was admissible, and Warren L H Khoo J held as follows at [11]:

I should therefore start by saying a word about the rule of hearsay and in what circumstances it may be said to be offended. It is simply this. When evidence is sought to be given of what someone said to the testifying witness, whether such evidence offends the rule against hearsay depends on the purpose for which the evidence is sought to be tendered. If it is sought to be tendered for the purpose of establishing the truth of what was said to the testifying witness, its introduction will offend the rule. On the other hand, if the purpose of tendering the evidence is merely to show that such a statement was made, and not that the statement is true, then the rule is not offended.

The learned judge then turned to certain authorities and came to the following conclusion at [16]:

It seems to me that evidence of the results of a market survey research of the kind in question in this suit is evidence of the existence of the belief or opinion held by the respondents to the survey. The purpose of tendering such evidence is to show that such belief or opinion exists; there is no question of tendering it for the purpose of proving the truth or merits of the belief or opinion so held. In my view, evidence as to whether and the extent to which a certain belief or opinion is held by a person or a group of persons, when that is in issue, is evidence of a fact in issue, and its admission falls within the general provision of s 5 of the Evidence Act for the reception of evidence of the existence or non-existence of every fact in issue.^[102]

53 Obviously, one of the merits of a survey is to avoid having to take direct evidence from a large number of witnesses, many of them

101 *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 at [76], per L P Thean JA.

102 *Cf Doctor's Associates Inc v Lim Eng Wah* [2012] 3 SLR 193 at [48], in which Judith Prakash J adopted the more conventional view when she characterised surveys as expert evidence, which presumably therefore falls within s 47 rather than s 5 of the Evidence Act (Cap 97, 1997 Rev Ed).

saying the same thing, and L P Thean JA proceeded¹⁰³ to refer with approval to a New Zealand judgment, *Customglass Boats Ltd v Salthouse Bros Ltd*,¹⁰⁴ on the practical advantages of allowing such evidence. In that case, Mahon J said:¹⁰⁵

A properly drawn market research questionnaire, carefully framed so as to elicit opinions or beliefs held by persons adequately informed, can only reveal in my opinion the existence or otherwise in a defined proportion of the persons interviewed, of the relevant opinion or belief, and I do not think it can be right in cases involving trade mark infringement or passing off where evidence of reputation is relevant, and especially in a passing off action where affidavit evidence is not receivable, to compel a party to produce in the courtroom an interminable parade of witnesses to depose individually as to their knowledge and understanding of the trade association involved in a particular trade mark or design, so long as there are followed the cautionary procedures recommended in the article in the New York University Law Review above cited [RC Sorensen & TC Sorensen, *The Admissibility and Use of Opinion Evidence Research* (1953) NYULR 1213]. The evidence obtained by research survey is in my view legitimate proof of the fact the opinions obtained had in fact existed, whether rightly held or not, and on that view of the matter it is my opinion that such evidence is not hearsay at all and that, even if it did fall within the technical concept of hearsay or representing a collation of individual statements made out of court, then the evidence would still be admissible by way of exception to the hearsay rule because it exhibits the existence of a state of mind shared in common by a designated class of persons.

54 Where it is intended to carry out a survey, it is advisable to have it done by an independent organisation experienced in devising and carrying out surveys.¹⁰⁶ The lead person from that organisation should present the survey results in an expert report, which should also contain full details of the instructions given to the individual interviewers. It is important to emphasise to the surveying team the need to record everything that is said, and even not said, by both the interviewers and interviewees involved, including prompting remarks that may indicate a less certain response than may be recorded. Leaving aside the common problem of surveys that contain leading questions,¹⁰⁷ a failure to record

103 *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 at [77], per L P Thean JA.

104 [1976] RPC 589.

105 *Customglass Boats Ltd v Salthouse Bros Ltd* [1976] RPC 589 at 595–596, per Mahon J.

106 In *Novelty Pte Ltd v Amanresorts Ltd* [2009] 3 SLR(R) 216 at [58], V K Rajah JA noted that a survey of visitors to the defendant's show flat was "rather unscientific and [we] do not attach much weight on the results obtained", emphasising that "if evidence based on surveys is to be relied on, it should be adduced in the form of expert evidence".

107 For a recent example of a survey that fell into this category, see *Ferrero SPA v Sarika Connoisseur Café Pte Ltd* [2011] SGHC 176 at [109].

responses and other reactions in full will often provide opposing counsel fertile ground on which to build an attack on the weight and credence to be given to the survey evidence. Thus, this type of expert evidence differs from that adduced otherwise in IP cases in that it is not opinion evidence as such that is given by the expert but rather the results of an independent survey, on the methodology and conduct of which he or she may be cross-examined.

55 So prevalent have surveys become in trade mark infringement and passing off cases in Singapore that Judith Prakash J expressed some surprise in *Doctor's Associates Inc v Lim Eng Wah*¹⁰⁸ that survey evidence had not been adduced,¹⁰⁹ but emphasised:¹¹⁰

The issue of likelihood of confusion may be determined without the assistance of direct survey evidence (as was the case in *City Chain* at [57]). In fact, surveys come with their own problems: most recently, Chan Seng Onn J in *Ferrero* expressed doubt as to the 'probative value' of market surveys and implied that the accuracy of the surveys *viz* evidence of confusion would depend on the design (sample size, phrasing) of said surveys. In any case, neither survey evidence nor affidavit evidence is conclusive on its own.

56 On similar lines, the English Court of Appeal in *esure Insurance Ltd v Direct Line Insurance plc*¹¹¹ noted:¹¹²

There is much to be said for the practice initiated by the late Pumfrey J (as he then was) in *O2 Ltd v Hutchison 3G Ltd* [2005] ETMR 61, and subsequently followed by Rimer J in *U K Channel Management Ltd v E! Entertainment Television Inc* [2008] FSR 5. Under this practice, case management directions are given at an interim stage requiring the parties to seek the directions of the court as to the scope or methodology of any proposed consumer survey that the parties may desire to put in evidence at trial. Those directions can then be given in advance of the trial.

108 [2012] 3 SLR 193.

109 *Doctor's Associates Inc v Lim Eng Wah* [2012] 3 SLR 193 at [48].

110 *Doctor's Associates Inc v Lim Eng Wah* [2012] 3 SLR 193 at [50].

111 [2008] EWCA Civ 842.

112 *esure Insurance Ltd v Direct Line Insurance plc* [2008] ETMR 77 at [62]–[63], *per* Arden LJ. In *Marks & Spencer plc v Interflora Inc* [2013] ETMR 11 at [149], Lewison LJ held that the standard form of order for case management should now make it clear that (a) a party could conduct a pilot survey without prior permission but at its own risk as to costs, (b) no further survey could be conducted without court permission, and (c) no evidence can be adduced from respondents to a survey without permission.

B. Other witness evidence

57 Whilst it can be seen clearly from the recent *Marks & Spencer plc v Interflora Inc*¹¹³ judgment of the English Court of Appeal that the attitude to survey evidence in England is one of cautious acceptance (as long as it is statistically significant), the same case also considered the admissibility of evidence from witnesses identified by means of a “witness gathering exercise” carried out by a market research firm, sometimes called a “pilot survey”, although Lewison LJ noted that that term “is apt to cause confusion”.¹¹⁴ The court held that evidence from those witnesses could not be adduced as “they will have been led towards a particular mindset which no longer represents the unstimulated evidence of people in the real world”.¹¹⁵ Importantly, the court also raised serious questions as to the value of much of the evidence usually adduced in trade mark infringement cases, as it rarely assists the judge in deciding the legal question whether there is a likelihood of confusion on the part of the *average* consumer. Lewison LJ concluded:¹¹⁶

That is not to say there can never be evidence called in a case of trade mark infringement. The court may need to be informed of shopping habits; of the market in which certain goods or services are supplied; the means by which goods or services are marketed and so on. In addition I must make it clear ... that different considerations may come into play where:

- (i) Evidence is called consisting of the spontaneous reactions of members of the relevant public to the allegedly infringing sign or advertisement;
- (ii) Evidence of consumers is called in order to amplify the results of a reliable survey;

113 [2013] ETMR 11.

114 *Marks & Spencer plc v Interflora Inc* [2013] ETMR 11 at [19]. A “witness gathering exercise” or “pilot survey” is where a series of questions in relation to the plaintiff’s and defendant’s products or marks is asked of a number of people, usually by a market research company, who have been pre-screened, again by questioning, in order to find the people who may become witnesses of confusion, although there is no intention to adduce the survey in evidence.

115 *Marks & Spencer plc v Interflora Inc* [2013] ETMR 11 at [136]. On conducting questionnaires in order to try and find witnesses who will give evidence of “real world confusion”, Lewison LJ stated firmly in a later visit of this case to the Court of Appeal on a different issue (*Interflora Inc v Marks & Spencer plc* [2013] EWCA Civ 319 at [26]): “With the benefit of hindsight, perhaps I did not make my message clear enough in *Interflora I*. Let me say it again, but more loudly. A judge should not let in evidence of this kind unless the party seeking to call that evidence satisfies him (a) that it is likely to be of **REAL** value; and (b) that the likely value of the evidence justifies the cost” [emphasis in bold and capital letters as in original].

116 *Marks & Spencer plc v Interflora Inc* [2013] ETMR 11 at [137], *per* Lewison LJ.

- (iii) The goods or services in question are not goods or services supplied to ordinary consumers and are unlikely to be within the judge's experience;
- (iv) The issue is whether a registered trade mark has acquired distinctiveness; or
- (v) Where the cause of action is passing off, which requires a different legal question to be answered.

58 In relation to application hearings before the UK Trade Marks Registry (where an issue of, for example, "likelihood of confusion" under s 5(2) of the Trade Marks Act 1994 or "prior rights capable of being protected in a passing off action" under s 5(4) may arise), Kay LJ has commented:¹¹⁷

Where litigation is commenced in the ordinary courts, the calling of expert evidence is now controlled by CPR 35.1. As I understand it, that does not apply to proceedings before a hearing officer in the Trade Marks Registry. Perhaps it should. However, even without its express application, it must be open to the Trade Marks Registry to control the nature and quality of evidence sought to be adduced before it as expert evidence. It should be encouraged to ensure that the sort of evidence that has attracted the disapproval of all three members of this court is excluded. In a case such as this, neither a hearing officer nor a judge in the Chancery Division requires the assistance of an 'expert' when evaluating the likelihood of confusion from the standpoint of the average consumer.

59 As a result of Kay LJ's comments, the UK IP Office issued (Trade Marks) Tribunal Practice Note 2/2012, which came into effect on 16 July 2012, and states:

If a party wishes to adduce survey evidence it must seek the permission of the hearing officer. In seeking the permission of the hearing officer it must advise the hearing officer of all details of how it is intended for the survey to be conducted ...

The hearing officer will consider whether the proposed survey is likely to have any determinative effect upon the proceedings.

If the hearing officer gives permission for survey evidence to be adduced, it will be necessary for it to conform to the criteria set out in the head note to *Imperial Group plc v Philip Morris Ltd* [1984] RPC 293:

If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were

117 *esure Insurance Ltd v Direct Line Insurance plc* [2008] ETMR 77 at [82].

conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (g) the exact answers and not some abbreviated form must be recorded, (h) the instructions to the interviewers as to how to carry out the survey must be disclosed and (i) where the answers are coded for computer input, the coding instructions must be disclosed.^[118]

60 It is important also to bear in mind that the results of any witness-gathering exercise or survey, even one that does not produce the result wished by the party conducting or commissioning it, must be disclosed to the other side as part of the disclosure (discovery) process.

61 In closing this section on trade mark infringement and passing off in England and Singapore, it is noteworthy that at the European level, the Court of Justice of the European Union held in *Gut Springenheide GmbH v Oberkreisdirektor des Kreises Steinfurt*¹¹⁹ that both it and national courts will generally not require the assistance of surveys or other expert evidence to make decisions as to the state of mind of the “average consumer”, although surveys could be adduced in difficult cases. In the Community Trade Marks Office (or, to give it its correct name, the Office for the Harmonisation of the Internal Market (“OHIM”)), it is recognised that surveys may be useful if they are “impeccably conducted”.¹²⁰

VII. Copyright cases

62 The role of the expert in copyright infringement cases is not to provide an opinion either on whether there has been copying or copying of a substantial part of the plaintiff’s work; obviously, those are decisions for the judge only. However:¹²¹

[S]ometimes the court will benefit from tutoring from experts to appreciate the similarities and differences between the claimant’s and defendant’s work and to appreciate better how those in the art design

118 In *Marks & Spencer plc v Interflora Inc* [2013] ETMR 11, before a thorough review of the authorities, Lewison LJ characterises *Imperial Group plc v Philip Morris Ltd* [1984] RPC 293 as the “watershed case on the admission of survey evidence” (at [77]), and one which “dealt a body blow to the reception of survey evidence” (at [61]).

119 [1998] ECR I-04657 at [30]–[32].

120 See Anne Niedermann, *Surveys as Evidence in Proceedings Before OHIM* (2006) 37 IIC 260.

121 *IPC Media Ltd v Highbury-Leisure Publishing Ltd* [2005] FSR 434 (HC) at [40], per Laddie J.

the type of works with which the action is concerned. They can also provide valuable evidence of what are common design techniques in the trade. The latter, in particular, may help the court to decide for itself whether the alleged similarities are likely to have been arrived at independently.

63 In the same case, which involved allegations of copyright infringement by a competing magazine, Laddie J commented of the defendant's expert witness:¹²² "it appears to me that he started his examination of the complaints in this action with the firm view that no one in this trade, save for malicious big companies, ever copies".

64 On the other hand, the judge considered the plaintiff's expert evidence "even worse" and "[i]t appears that he thought part of his remit to consider whether copying had taken place".¹²³ However, notwithstanding these criticisms, the judge emphasised that the experts' reports were not "of no value. Both gave evidence as to what were common design techniques and ideas in this field."

65 This case illustrates well the importance of the expert being able to justify his opinions, rather than display preconceived notions and prejudices.

66 In relation to copyright cases involving software, George Wei (now a Judicial Commissioner) notes that "expert testimony on the similarities and differences may be crucial in establishing objective similarity between the defendant's work and a substantial part of the plaintiff's work."¹²⁴

67 However, it is not permissible to adduce expert evidence on whether the defendant's work is a copy of a substantial part of the plaintiff's: that is a question for the court.¹²⁵

122 *IPC Media Ltd v Highbury-Leisure Publishing Ltd* [2005] FSR 434 at [41].

123 *IPC Media Ltd v Highbury-Leisure Publishing Ltd* [2005] FSR 434 at [42].

124 George Wei, *The Law of Copyright in Singapore* (SNP Editions, 2nd Ed, 2000) at para 8.14, referring to *Aztech Systems Pte Ltd v Creative Technology Ltd* [1995] 3 SLR(R) 568 (HC) and *Creative Technology Ltd v Aztech Systems Pte Ltd* [1996] 3 SLR(R) 673 (CA), by way of example.

125 George Wei refers to the first instance judgment of Lawrence Collins QC in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [1998] FSR 803 at 811, in which it was noted that the traditional view that expert evidence is not admissible on the "ultimate or real issue" was altered in England by s 3(1) of the Civil Evidence Act 1972 (c 30), that allows expert evidence on any relevant matter. However, notwithstanding s 3(1), the Court of Appeal, [2000] FSR 121 at [24], made it quite clear that although all "material and helpful" evidence would be admitted, it was "not the function of the expert to decide the question of substantiality" (at [22], *per* Morritt LJ) (the House of Lords made no comment on this issue when overruling the Court of Appeal and restoring the decision of the trial judge.) What Lawrence Collins QC described as "the traditional view" must

(*cont'd on the next page*)

VIII. Breach of confidence cases

68 In an English breach of confidence case in which there were competing expert reports, the judge warned against merely submitting conflicting expert witness reports and leaving it to the judge to come to his own view:¹²⁶

A judge is very rarely helped by competing expert reports, which express opinions, which are not tested or not maintainable by reference to supporting material. It is not useful to leave the judge to find his own analysis of the reports of experts without the experts being put to the test by cross examination.

69 As a general matter, the patent cases referred to above are of direct relevance to issues that may arise from the use of expert witnesses in cases of alleged breach of confidence.

IX. Conclusion

70 As can be seen from this review of only a few of the many IP cases decided in recent years both in Singapore and England, the use of expert evidence is commonplace. Weaknesses in expert evidence are commonplace too; sometimes the weaknesses are such that the evidence should be excluded, on other occasions they render the evidence of little value, but in all cases, the reliance on expert evidence and particularly on survey evidence will have increased the cost of the litigation for both sides (and rarely does the costs award make that increase good for the successful party).¹²⁷ Aside from the more general policy concerns regarding expert evidence, this is an important reason why the courts must always be vigilant in ensuring in IP cases that expert evidence is allowed only when it is clearly of assistance to them in their role as the ultimate arbiter on questions of law.

remain the position in Singapore in view of the exclusionary basis of the Evidence Act (Cap 97, 1997 Rev Ed) explained above, see nn 6–7 and 17 above.

126 *EPI Environmental Technologies Inc v Symphony Plastic Technologies plc* [2005] FSR 22 (HC) at [76], *per* Peter Smith J.

127 See, however, Jeffrey Pinsler, “Proportionality in Costs” (2011) 23 SAclJ 125, on the changes made by the Rules of Court (Amendment No 3) Rules 2010 (S 504/2010), which concludes at para 32 with the wish that “through the proper application of the proportionality principle, costs will become a vital consideration in the series of processes which constitute civil litigation”.