

**IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE**

**[2017] SGHC 232**

Suit No 1229 of 2016  
(Registrar's Appeal No 135 of 2017)

Between

**SUN ELECTRIC PTE LTD**

*... Plaintiff*

And

**(1) SUNSEAP GROUP PTE LTD**

**(2) SUNSEAP ENERGY PTE LTD**

**(3) SUNSEAP LEASING PTE LTD**

*... Defendants*

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**JUDGMENT**

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[Patents and Inventions] — [Revocation]  
[Patents and Inventions] — [Validity]  
[Civil Procedure] — [Appeals] — [Notice]

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**Sun Electric Pte Ltd**  
**v**  
**Sunseap Group Pte Ltd and others**

**[2017] SGHC 232**

High Court — Suit No 1229 of 2016 (Registrar's Appeal No 135 of 2017)  
George Wei J  
30 June 2017

28 September 2017

Judgment reserved.

**George Wei J:**

**Introduction**

1 In this patent infringement action, the plaintiff, Sun Electric Pte Ltd (“the Plaintiff”), made an application under O 18 r 19 of the Rules of Court (Cap 322, R 5, 2014 Rev Ed) (“ROC”) to strike out certain parts of the amended defence and counterclaim dated 17 February 2017 (“the Defence and Counterclaim”) and the particulars of objection dated 5 January 2017 (“the Particulars of Objection”). Although the learned Assistant Registrar Justin Yeo (“the AR”) agreed with the Plaintiff on two out of the three issues raised at the hearing below, the outcome for practical purposes was that the defendants’ counterclaim was substantially allowed to remain as it was.

2 The Plaintiff has appealed against the AR’s decision. In Registrar’s Appeal No 135 of 2017, the main substantive question before me was this: can

patent revocation proceedings be properly brought before the High Court at first instance, by way of a counterclaim in infringement proceedings before the court? Although the defendants cited a number of cases in which the court had, in previous cases, heard revocation proceedings at first instance, it does not seem that this specific question has ever been expressly raised or examined by the courts. After considering the relevant provisions of the Patents Act (Cap 221, 2005 Rev Ed), the legislative intention behind these provisions and the relevant academic commentary on this issue, I find that the High Court does not have the jurisdiction to hear revocation proceedings or to grant an order for revocation by counterclaim. Accordingly, I allow the Plaintiff's appeal and now give my reasons. Given the significance of this issue, a more extensive review of the patent landscape and patent system in Singapore may be helpful.

### **Background facts**

3 The Plaintiff is a Singapore-incorporated company which retails solar energy to consumers in Singapore. It is the registered proprietor of a Singapore patent based on Singapore Patent Application No 10201405341Y ("the Patent"), filed on 29 August 2014 and granted on 8 June 2016. This patent is in respect of a power grid system and a method of determining power consumption at building connections in the system.<sup>1</sup>

4 The first defendant, Sunseap Group Pte Ltd, is the parent and holding company of the second and third defendants. The second defendant, Sunseap Energy Pte Ltd, is a licensed electricity retailer, while the third defendant, Sunseap Leasing Pte Ltd, develops and manages rooftop solar photovoltaic systems. The defendants are all Singapore-incorporated companies, and I will refer to them collectively as "the Defendants".<sup>2</sup>

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<sup>1</sup> Amended Statement of Claim ("SOC"), [2]-[3].

**The patent infringement action and the striking-out application**

5 On 18 November 2016, the Plaintiff brought Suit No 1229 of 2016 against the Defendants for alleged infringement of the Patent. Out of the twelve claims subsisting in the Patent, the Plaintiff asserted that the Defendants jointly or severally infringed eight of the claims: claims 1, 3, 4, 5, 7, 9, 10 and 11 (“the asserted claims”).<sup>3</sup>

6 In the Defence and Counterclaim, the Defendants denied all allegations of infringement and counterclaimed for the following relief:<sup>4</sup>

- (a) a declaration that all of the twelve claims in the Patent, including claims 2, 6, 8 and 12 (“the unasserted claims”), are and have always been invalid;
- (b) an order that the Patent be revoked;
- (c) a declaration that the acts complained of by the Plaintiff do not constitute an infringement of the Patent;
- (d) remedies under s 77 of the Patents Act for groundless threats made by the Plaintiff, namely:
  - (i) a declaration that the threats are unjustifiable;
  - (ii) an injunction to restrain the Plaintiff from continuing to make any such further threats; and
  - (iii) damages in respect of losses sustained because of the threats; and

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<sup>2</sup> SOC, [4]; amended Defence and Counterclaim (“D&CC”), [5]-[6].

<sup>3</sup> *Sun Electric Pte Ltd v Sunseap Group Pte Ltd and others* [2017] SGHCR 6 (“the AR’s Judgment”), [4].

<sup>4</sup> D&CC, pp 20-21.

- (e) costs, interest and any other appropriate relief.

7 The Defendants filed the Particulars of Objection setting out its grounds for the attack on validity. It is to be noted that the objections grounded on the prior art, lack of novelty and inventive step were made in respect of all of the claims comprised in the Patent and not just the asserted claims. That said, a separate objection based on insufficiency was only made in respect of two of the asserted claims.

8 In response, the Plaintiff took the view that the Defendants had improperly put the unasserted claims in issue, whether by way of a defence or a counterclaim. The Plaintiff thus filed the present application under O 18 r 19 of the ROC to strike out the following paragraphs of the Defence and Counterclaim and the Particulars of Objection, to the extent that the validity of the unasserted claims was put in issue:<sup>5</sup>

- (a) paras 4 and 14 of the Defence and Counterclaim, which state:

4. ... The Defendants aver that the Patent is and has at all material times been invalid for the reasons set out in the Defendants' Particular of Objection.

...

14. Without prejudice to the generality of the foregoing, the Defendants seek to rely on the invalidity of the Patent as set out in the Particulars of Objection filed herein as a defence to the Plaintiff's allegations of infringement.

- (b) para 16 of the Defence and Counterclaim, which states:

16. The Defendants aver that the Patent has always been invalid for the reasons set out in the Particulars of Objection served herewith.

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<sup>5</sup> SUM 1221/2017.

(c) and para 1 of the Particulars of Objection, which states:

1. The alleged invention, which is the subject of the Patent is not a patentable invention, is invalid, and ought to be revoked by reason of Section 80(1)(a) of the Patents Act (Cap 221)...

9 At the hearing before the AR on 5 April 2017, leave was granted for the Plaintiff to amend the summons for striking out such that it now sought to strike out para 16 in its entirety, and not merely in respect of the unasserted claims.<sup>6</sup>

10 I note at the outset that the effect of the amendment to the striking-out summons was that the Plaintiff was not taking the position that the Patents Act prevents the Defendant from putting in issue unasserted claims subsisting in the Patent by way of a counterclaim for revocation.<sup>7</sup> Instead, the Plaintiff was now asserting that the Defendants could not put in issue *any* claims in the Patent by way of a counterclaim for revocation. The Plaintiff's case was that the right to institute revocation proceedings is confined to proceedings by way of an application to the Registrar of Patents ("the Registrar"), and the Defendants could not commence revocation proceedings in the High Court, not even by way of a counterclaim.<sup>8</sup>

### **The AR's decision**

11 At the end of the first hearing of the striking-out application, the AR directed counsel to make further submissions on prior case law, *inter alia*, on counterclaims for revocation before the courts. Thereafter, the AR invited response to questions on (i) the distinction between claims for revocation and

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<sup>6</sup> Notes of Evidence ("NE") of hearing before the AR (SUM 1221/2017) on 5 April 2017, p 1.

<sup>7</sup> The AR's Judgment, [35].

<sup>8</sup> The AR's Judgment, [35]-[36].



for a declaration of invalidity; and (ii) the relationship between ss 80 and 82(7) of the Patents Act and whether the right to seek revocation under s 80 is confined to proceedings before the Registrar.<sup>9</sup> Subsequently, on 4 May 2017, the AR delivered his decision. The full written grounds of the AR’s decision are recorded at *Sun Electric Pte Ltd v Sunseap Group Pte Ltd and others* [2017] SGHCR 6 (“the AR’s Judgment”).

12 The learned AR first held that the unasserted claims could not be put in issue by the Defendants by way of a *defence* against the Plaintiff’s infringement claim pursuant to s 82(1)(a) of the Patents Act. A defendant may only challenge claims that have been asserted by the plaintiff to have been infringed, and the defendant does not have *carte blanche* to put in issue the validity of the entire patent in its defence: see *Astrazeneca AB v Ranbaxy (Malaysia) Sdn Bhd* [2012] SGHC 7 at [8]-[9].<sup>10</sup> The AR thus ordered the Defendants to amend paras 4 and 14, which were contained within the “Defence” portion of the Defence and Counterclaim, as follows:<sup>11</sup>

4. ...The Defendants aver that claims 1, 3, 4, 5, 7, 9, 10 and 11 of the Patent is are and ~~has~~ have at all material times been invalid for the reasons set out in the defendants’ particulars of Objection.

...

14. Without prejudice to the generality of the foregoing, the Defendants seek to rely on the invalidity of claims 1, 3, 4, 5, 7, 9, 10 and 11 of the Patent as set out in the Particulars of Objection filed herein as a defence to the Plaintiff’s allegations of infringement.

13 Secondly, the AR also agreed with the Plaintiff that the unasserted claims could not be put in issue by way of *counterclaim for groundless threats*

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<sup>9</sup> By letter from Supreme Court Registry dated 27 April 2017.

<sup>10</sup> The AR’s Judgment, [17]

<sup>11</sup> The AR’s Judgment, [50].

of infringement proceedings under s 82(1)(b) of the Patents Act. Section 77(2)(b) of the Patents Act requires a plaintiff in groundless threat proceedings to show that the patent is invalid “in a relevant respect” in order to be entitled to the relief claimed. The AR found that s 77(2)(b) should be read to limit an aggrieved party to putting only asserted claims in issue, especially considering that it would be futile for that party to assert the invalidity of unasserted claims in groundless threat proceedings.<sup>12</sup>

14 However, the AR decided in favour of the Defendants on the last issue and found it proper for the Defendants to have commenced revocation proceedings in the High Court at first instance. The AR added that this was particularly appropriate where infringement proceedings were already before the High Court, and revocation proceedings were brought by way of a counterclaim.

15 In reaching his decision, the AR considered numerous High Court precedents in which revocation proceedings were brought by way of a counterclaim, relevant provisions of the Patent Act such as ss 82(7) and 91(1), and academic opinion.<sup>13</sup> The term “revocation proceedings” appears to refer to counterclaims that include a general averment of invalidity followed by a prayer for an order for revocation. I will also discuss these points in greater detail at [19]-[22] and [26] below, when I outline the parties’ arguments. For now, it suffices to state that the AR declined to strike out para 16 of the Defence and Counterclaim and para 1 of the Particulars of Objection, and instead ordered the Defendants to make the following amendment to para 16 of the Defence and Counterclaim in the interests of clarity:<sup>14</sup>

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<sup>12</sup> The AR’s Judgment, [24]-[30].

<sup>13</sup> The AR’s Judgment, [40]-[49].

<sup>14</sup> The AR’s Judgment, [50].

16. The Defendants aver that all the claims of the Patent ~~has~~ have always been invalid for the reasons set out in the Particulars of Objection served herewith.

16 Although the Plaintiff succeeded on two out of the three issues canvassed, the AR's decision effectively meant that the Defendants were entitled to put both the asserted and unasserted claims in issue, by way of a counterclaim before the High Court for the revocation of the Patent. Dissatisfied, the Plaintiff has appealed against the AR's decision allowing the Defendants to do so. It is upon this issue which the present Registrar's Appeal turns. To be clear, there is no appeal against the AR's decision in respect of his finding that the validity of unasserted claims cannot be challenged by way of a defence to infringement or a counterclaim for groundless threats of suit. Nevertheless, it will be necessary to refer to the distinction between the asserted and unasserted claims in respect of some points in connection with revocation.

### **The legal principles on striking out**

17 As the legal principles applicable to the striking out of pleadings are well-settled and were not disputed by the parties, I will set them out succinctly. The grounds for striking out are set out in the four limbs of O 18 r 19(1) of the ROC. Under r 19(1), the court may strike out or amend any pleading on the ground that it:

- (a) discloses no reasonable cause of action or defence;
- (b) is scandalous, frivolous or vexatious;
- (c) may prejudice, embarrass or delay the fair trial of the action; or
- (d) is otherwise an abuse of the process of the Court.

18 If it is indeed found that the High Court has no jurisdiction or power to hear the Defendants' counterclaim for revocation of the patent, then in my view, any prayers for an order for revocation in the pleadings will be amenable to be struck out under any of the four limbs of O 18 r 19. The Defendants' plea for revocation would "disclose no reasonable cause of action" and amount to an abuse of process under O 18 r 19(1)(a) and (d). Having the court determine the validity of the unasserted claims (which would only be before the court by virtue of the revocation counterclaim) may cause unnecessary delay to the trial (see O 18 r 19(1)(c)). Most of all, the counterclaim for revocation would be "plainly or obviously unsustainable" as a matter of law if the court has no jurisdiction to hear it, and therefore "frivolous or vexatious" within the meaning of O 18 r 19(1)(b) (see *The Bunga Melati 5* [2012] 4 SLR 546 at [32] and [39]).

### **The parties' arguments**

#### ***The Plaintiff's arguments***

19 On appeal, the Plaintiff argued that the AR had erred in finding that revocation proceedings may be commenced in the High Court at first instance. The Plaintiff submitted that the AR's decision did not take into consideration the plain meaning of s 80(1) of the Patents Act, or the manifest intention of Parliament in restricting revocation proceedings to the Registrar. Section 72(1) of the UK Patents Act 1977 (c 37) ("the UK Patents Act"), upon which s 80(1) of our Patents Act was based, provides that "the court or the comptroller" (the latter referring to the Comptroller-General of Patents, Designs and Trade Marks, the British analogue to the Registrar in Singapore's context) may revoke a patent on certain specified grounds. In contrast, s 80(1) of our Patents Act omits any reference to the court, and only provides that *the Registrar* may revoke a patent on the specified grounds. The Plaintiff contended that this omission is

clearly indicative of Parliament’s intention that the High Court should not hear revocation proceedings under s 80(1) at first instance.<sup>15</sup>

20 The Plaintiff further sought to show that the aforesaid omission in s 80(1) was deliberate and not accidental, on the basis of other relevant omissions in the Patents Act. Much like s 80(1), s 82(1)(d) of our Patents Act only refers to “proceedings before *the Registrar* under section 80 for the revocation of the patent” [emphasis added], whereas its sister provision, s 74(1)(d) of the UK Patents Act, refers to “proceedings before *the court or the comptroller* under section 72 above for the revocation of the patent” [emphasis added].<sup>16</sup>

21 In addition, the Plaintiff pointed to ss 72(6) and 72(7) of the UK Patents Act, and the fact that s 80 of our Patents Act contains no equivalent subsections. Section 72(6) of the UK Patents Act provides that where the comptroller has refused to grant any revocation application under s 72, leave of court is generally required before the dissatisfied party may make an application to the court. Section 72(7) provides that barring certain exceptions, a party may not apply to court where the comptroller has not disposed of a revocation application under s 72. The Plaintiff contended that the omission of equivalent provisions from our Patents Act must have been due to the fact that they would be otiose in the local context where only the Registrar may hear revocation proceedings.<sup>17</sup>

22 The Plaintiff submitted that the AR’s reliance on s 91(1) of the Patents Act was inapposite, because s 91(1) only grants the High Court the *power* – and

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<sup>15</sup> Plaintiff’s submissions, [8]-[15]; [33]-[35].

<sup>16</sup> Plaintiff’s submissions, [16]-[20].

<sup>17</sup> Plaintiff’s submissions, [21]-[23].

not the *jurisdiction* – that the Registrar has under the Patents Act.<sup>18</sup> On a related note, the Plaintiff also contended that the AR could not rely on s 82(7) of the Patents Act, which provides that where patent proceedings in which validity has been put in issue are pending before the court, leave of court is required before any proceedings under ss 67(3), 76, 78 or 80 may be instituted before the Registrar. The Plaintiff described s 82(7) as simply a “house-keeping provision” which cannot be taken to grant jurisdiction to the High Court. Otherwise, this would run into conflict with the plain meaning of s 80(1), which the Plaintiff characterised as the sole provision in the Patents Act granting jurisdiction for revocation proceedings in Singapore.<sup>19</sup>

***The Defendants’ arguments***

23 Before responding to the Plaintiff’s submissions on the substantive merits, the Defendants first raised a procedural objection with respect to the notice of appeal filed by the Plaintiff on 18 May 2017 (“the Notice of Appeal”).

24 To summarise, the Defendants submitted that the Notice of Appeal is fatally defective as it fails to identify:

- (a) which of the AR’s orders or decisions the Plaintiff is disputing;
- (b) what the Plaintiff is seeking to have the court determine on appeal, and
- (c) the grounds for the appeal.

25 Further or in the alternative, the Defendants contended that the Notice of Appeal should be dismissed on the grounds of being ambiguous,

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<sup>18</sup> Plaintiff’s submissions, [36]-[44].

<sup>19</sup> Plaintiff’s submissions, [45]-[48].

embarrassing and prejudicial to the Defendants, who have been left to guess and speculate as to which issue(s) the Plaintiff would be raising on appeal. Accordingly the Defendants sought for the Notice of Appeal to be dismissed or struck out pursuant to the court's inherent discretion under O 92 r 4 of the ROC. I will consider the Defendants' contentions with respect to the Notice of Appeal in greater detail below.

26 On the substantive merits of the case, the Defendants submitted that revocation proceedings may be brought by way of a counterclaim in infringement proceedings commenced in the High Court, even in respect of unasserted claims. The Defendants put forward several arguments in support of this proposition:

(a) First, the Defendants contended that s 80(1) must be read alongside other provisions of the Patents Act, such as ss 82(7) and 91. As infringement proceedings have already commenced with respect to the Patent, the Defendants are required to first obtain leave of court under s 82(7) if they wish to commence revocation proceedings before the Registrar. According to the Defendants, this indicates that they are entitled to bring revocation proceedings before the High Court by way of a counterclaim. Otherwise, the Defendants might be left without a remedy if leave is not granted. The Defendants also argued that the High Court has identical powers as the Registrar pursuant to s 91, and may thus adjudicate on the revocation of the Patent at first instance.

(b) Next, the Defendants sought to establish that such a reading of the relevant provisions of the Patents Act would give effect to the legislative intention of reducing the cost of patent litigation, which was a key motivation for Parliament's enactment of the Patents Act in 1994.

As the issues concerning the invalidity of the claims would already be brought before the court by way of defence and counterclaim for groundless threats, there would be a risk of inconsistent decisions and unnecessary costs if revocation of the claims were to be heard by the Registrar instead. This would contravene public policy and could not have been the intention of Parliament.

(c) Further, the Defendants provided me with a table of 13 cases in which patent revocation proceedings were brought in the High Court by counterclaim. I will examine these cases more closely at [111] below. According to the Defendants, these cases and the existing practice makes clear that the High Court may hear revocation proceedings at first instance. The Defendants also cited academic opinion for the proposition that revocation proceedings in Singapore may be brought in the High Court at first instance.

(d) Finally, as the Patents Act contains no restrictions preventing unasserted claims from being put in issue in revocation proceedings under s 80(1), the Defendants submitted that no distinction should be made between asserted and unasserted claims in this regard. In other words, the court may determine the validity of *all* claims of the Patent in revocation proceedings.

### **Issues to be determined**

27 For the purposes of the present Registrar's Appeal, there are two main issues to be determined:



(a) First, there is the procedural issue of whether the Notice of Appeal was so fundamentally defective that the appeal must be dismissed at the outset.

(b) Second, there is the substantive issue of whether this court may hear the Defendants’ counterclaim for revocation under s 80(1) of the Patents Act. If the Plaintiff is indeed correct and the High Court does not possess the jurisdiction or power to hear revocation proceedings, the appeal must be allowed, and para 16 of the Defence and Counterclaim and para 1 of the Notice of Objection should be struck out or amended accordingly. In that eventuality, the prayer for revocation must be struck out.

## **Decision and reasons**

### ***Whether the Notice of Appeal was fatally defective***

#### *The procedure for filing a notice of appeal from the decision of an AR to the High Court*

28 I will address the procedural issue concerning the Notice of Appeal first, and I start by briefly outlining the procedure involved in appealing a decision of an AR to the High Court. This right of appeal is set out in O 56 r 1(1) of the ROC, which provides that “[a]n appeal shall lie to a Judge in Chambers from any judgment, order or decision of the [AR].” Order 56 rr 1(2) and (3) then requires the appeal to be brought by issuing a notice of appeal in Form 112 within 14 days after the AR’s judgment, order or decision, and serving the notice of appeal on all other parties within seven days of it being issued. Form 112 serves as a common form used throughout the State Courts and Supreme Court in Singapore, and can be found at Appendix A of the ROC.

29 As described by Jeffrey Pinsler SC in *Singapore Court Practice 2017*, Vol II (LexisNexis, 2017) (“*Singapore Court Practice*”) at para 55D/3/2, the notice of appeal “is the court document which a party uses in order to communicate his intention to appeal against the judgment or order of the court and to record the grounds on which he bases his challenge.” However, “it is only at the stage of filing the appellant’s case that the appellant is required to set out (i) his grounds for impugning the decision or the part thereof under appeal; and (ii) the order he seeks in the appeal”: *Singapore Court Practice* at para 55D/3/3, quoting the Court of Appeal’s decision in *Leong Mei Chuan v Chan Teck Hock David* [2001] 1 SLR(R) 261 at [9]. Form 112 itself states that the appellant must “specify the whole or part of the decision” it is appealing against. In other words, the notice of appeal must properly record the decision (or the part of the decision) the appellant is challenging, and may set out brief grounds where appropriate in order to communicate the broad thrust of the appeal.

30 The Defendants cited several Malaysian decisions in which the notice of appeal in each case was struck out for being defective. In *Berjaya Development Sdn Bhd v Keretapi Tanah Melayu Bhd* [2014] 4 MLJ 606, the notice of appeal was defective for failing to identify which of three decisions made by the lower court was being appealed against. The Court of Appeal of Malaysia remarked at [18] that the court was “in the dark” as to which decision the appellant was challenging, and dismissed the appeal at the outset. In *Public Prosecutor v Hwong Yu Hee & ors* [2015] 11 MLJ 138, the High Court of Malaysia struck out the notice of appeal which failed to set out which three charges (out of five) the Prosecution was appealing against. Whilst these decisions are not binding, the underlying principle that arises from these Malaysian cases is that the respondent must be made aware of the decision and issues being challenged so that he may have a fair opportunity to respond and address them during the

appeal. There is much sense in this. Indeed, this ties in with the very purpose of the notice of appeal as described at para 55D/3/2 of *Singapore Court Practice* (see above at [29]).

31 It is clear the court may, in its discretion, dismiss the appeal at the outset if it finds that the respondent has been prejudiced by a defective notice of appeal. The Defendant cited another Malaysian case, *Dato' Wong Gek Meng v Pathmanathan a/l Mylvaganam & Ors* [1998] 5 MLJ 560, as an example of a case where the notice of appeal filed was struck out for failing to comply with the prescribed form. *Singapore Civil Procedure 2017* vol 1 (Foo Chee Hock gen ed) (Sweet & Maxwell, 2017) (“the White Book”) however comments at para 56/1/2 that this decision was perhaps “exceptional” and was to be seen in the context that counsel’s use of the form – which he appeared to have developed entirely on his own – was described by the Malaysian High Court as “a complete change which was unknown to the law.” The White Book notes that in yet another Malaysian case, *Hong Kim Sui & anor v Malaysian Banking Bhd* [1971] 1 MLJ 289, the failure to adhere to the prescribed form was treated as a mere irregularity which did not render the proceedings void. I will return to the question of the effect of any non-compliance below.

*Whether the Notice of Appeal identified any order or decision of the AR being appealed against*

32 I first turn to the contents of the Notice of Appeal filed by the Plaintiff, the relevant portion of which stated:

The appeal is against part of the decision of Assistant Registrar Justin Yeo given on 4 May 2017 in HC/SUM 1221/2017, as follows:

(a) In relation to paragraphs 31 to 50, and in particular that unasserted claims of a patent can be put in issue under section 82(1)(d) of the Patents Act (Cap 221, Rev Ed 2005) by way of a

claim or counterclaim brought before the High Court for revocation of the patent; and

(b) In relation to an order of costs of S\$2,500.00 in favour of the Defendants.

33 The Defendants’ foremost contention was that the Notice of Appeal failed to identify any particular decision or order in respect of which the present appeal has been brought.<sup>20</sup> In other words, the Defendant submitted that the Plaintiff did not adequately “specify the whole or part of the decision” of the AR’s decision that it is appealing against: see Form 112, Appendix A, ROC.

34 To the contrary, it is clear to me that the Plaintiff did in fact expressly set out the part of the AR’s decision it is appealing against, by stating in the Notice of Appeal that “[t]he appeal is against part of the decision of the [AR]... [i]n relation to paragraphs 31 to 50 [of the AR’s Judgment]”. Here, the Plaintiff explicitly identified the part of the AR’s Judgment which is in contention on appeal.

35 These paragraphs in the AR’s Judgment are headed “Section 82(1)(d) of the Patents Act – counterclaim for revocation”. Paragraphs 32 to 38 of the AR’s Judgment set out a summary of the parties’ arguments. Paragraphs 39 to 49 go on to set out the AR’s decision and reasons. Paragraph 50 sets out the AR’s overall conclusion covering: (i) the limitation of the defence of invalidity to the asserted claims only; (ii) the limitation of the counterclaim for groundless threats of proceedings to the asserted claims only; and (iii) the right of the Defendants to put in issue the validity of all claims of the Patent by counterclaim in respect of the prayer for revocation.

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<sup>20</sup> Defendants’ submissions, [30].

36 In response to this, the Defendants argued that the reference in the Notice of Appeal to [31]-[50] of the AR's Judgment was "misconceived", in that most of the contents of these cited paragraphs do not amount to any order, decision or finding.<sup>21</sup> Yet at the same time, the Defendants contended that the only decision or finding in the AR's Judgment was at [50] where the AR declined to strike out any of the paragraphs in the Defence and Counterclaim and the Particulars of Objection.<sup>22</sup>

37 I do not agree with the Defendants that the Notice of Appeal failed to identify any order, decision or finding, or that the Plaintiff's reference to [31]-[50] of the AR's Judgment was confusing or improper. As the Defendants themselves acknowledged, [50] of the AR's Judgment amounted to a decision not to strike out certain parts of the pleadings, and it was apparent to me that [31]-[49] (which preceded the decision) elucidated the grounds upon which the decision at [50] was based. The Notice of Appeal therefore adequately identified the decision of the AR on appeal, and by the reference to [31]-[49] of the AR's Judgment, briefly referenced the grounds which the Plaintiff would be contesting. I find this to be sufficient for the present appeal.

38 I note that the Defendants also took issue with the fact that the Notice of Appeal failed to expressly state that the Plaintiff is seeking to set aside para 1 of Order of Court No 3094 of 2017 which dismissed the Plaintiff's striking-out application. This somehow suggested to the Defendants that the Plaintiff was not appealing the AR's decision declining to strike out or amend para 16 of the Defence and Counterclaim and para 1 of the Notice of Objection. I find that this argument holds little force. There is no strict rule that requires an appellant to make express reference to the relevant Order of Court in the Notice of Appeal.

<sup>21</sup> Defendants' submissions, [28].

<sup>22</sup> Defendants' submissions, [28].

In this case, there was no other order made by the AR which the Plaintiff could have appealed, and it was clear as to what decision the Plaintiff was appealing.

*Whether the Notice of Appeal clearly identified the issue(s) raised on appeal*

39 The Defendants also claimed that they were unsure about which of three potential issues the Plaintiff was raising on appeal. I set out the three possibilities identified by the Defendants, in their own words:<sup>23</sup>

**Possible Issue 1:** Whether the Defendants are entitled to seek revocation of the **Asserted Claims** but not the **Unasserted Claims** under s80 of the Patents Act...

**Possible Issue 2:** Whether the Defendants are entitled to seek revocation of the Unasserted Claims of the Patent “*by way of a claim or counterclaim*”, as opposed to merely putting the Unasserted Claims in issue by way of a **defence** only.

**Possible Issue 3:** Whether the Defendants are entitled to seek revocation of the Unasserted Claims before the High Court by way of a counterclaim, or must such a revocation application be brought only before the **IPOS Registrar**.

[emphasis in original]

The Defendants further contended that *if* the Plaintiff was raising “Possible Issue 1” and making a distinction between asserted and unasserted claims for the purpose of revocation proceedings, this would be another reason for the dismissal of the appeal as this issue was already abandoned by the Plaintiff at the hearing before the AR on 5 April 2017 and clearly did not form the basis of the AR’s order or decision appealed against.<sup>24</sup>

40 Of the three potential issues identified by the Defendants, I cannot see how the Notice of Appeal might be interpreted to give rise to “Possible Issue 2”. Since the Defendants did not elect to file a cross-appeal, this Registrar’s

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<sup>23</sup> Defendants’ submissions, [35].

<sup>24</sup> Defendants’ submissions, [38]-[47].

Appeal undoubtedly does not engage the issues that were decided by the AR in the Plaintiff's favour, *ie*, whether the Defendants could put the unasserted claims of the Patent either by way of a defence or by way of a counterclaim for groundless threats. This is supported by the reference in the Notice of Appeal to [31]-[50] of the AR's Judgment. Hence, the present appeal must relate to a counterclaim for revocation. This in turn means that the Notice of Appeal can really only give rise to *two* possible interpretations when read on its own:

(a) The first possible issue is whether the Defendants are entitled to challenge the validity of *unasserted* claims in revocation proceedings at the High Court brought by way of a counterclaim. This seems to accord with what the Defendants are describing in "Possible Issue 1".

(b) The second possible issue is whether the High Court may hear revocation proceedings brought by way of a counterclaim, regardless of whether this is in respect of asserted or unasserted claims in the infringement action. This appears to be what the Defendants are describing in "Possible Issue 3".

41 Once the Notice of Appeal is read in the surrounding context of the striking-out application and the AR's Judgment, the real issue becomes apparent. As the Defendants themselves pointed out, "Possible Issue 1" was already abandoned by the Plaintiff when it amended its prayers to strike out para 16 of the Defence and Counterclaim in its entirety, rather than only with regard to the unasserted claims. At [35] of the AR's Judgment, the AR noted that counsel for the Plaintiff had "agreed that under ss 82(1)(d) read with 80 of the Patents Act, a party is entitled to put in issue *all* claims of a patent because, in his view, s 80 of the Patents Act 'does not contain any express limitation'." Again, at [39] of the same, the AR reiterated that it was "undisputed that in

revocation proceedings, a party is entitled to put the validity of *all* claims, including asserted claims, in issue” [emphasis in original]. It is therefore clear from the context that the Plaintiff is not seeking to draw a distinction between asserted and unasserted claims for the purposes of revocation proceedings. “Possible Issue 1” cannot stand.

42 I note the Defendants’ contention that the phrase in the Notice of Appeal which reads, “in particular that *unasserted claims* of a patent can be put in issue under section 82(1)(d) of the Patents Act” [emphasis added], is particularly confusing. I agree that this phrase appears, at least at first blush, to intend for a distinction to be drawn between the asserted and unasserted claims, when the Plaintiff was not in fact doing so as a matter of law. After all, the Plaintiff had accepted that revocation proceedings under s 80 may relate to the patent as a whole, as I have just explained.

43 The phrase in the Notice of Appeal said to be unclear must be read in the context of the proceedings below, including the decision of the AR. It will be recalled that at the start of the hearing below, the AR heard and allowed an amendment to the striking-out summons. At the time the amendment application was made, the AR had not yet heard arguments in respect of the three issues before him in the original striking out summons, *viz* (i) the unasserted claims and the defence; (ii) the unasserted claims and the counterclaim for groundless threats; and (iii) the unasserted claims and the counterclaim for revocation.

44 Paragraph 16 of the Defence and Counterclaim, which is to be found at the start of the counterclaim, sets out the general averment that the Patent is invalid. Paragraphs 17 to 26 set out the averments and pleading in relation to the counterclaim for groundless threats of proceedings. This is followed immediately by the pleading of the claim for relief by way of nine prayers which



include (i) a declaration that the Patent is and always has been invalid; and (ii) an order for revocation of the Patent.

45 The key prayer in the striking-out summons before the amendment was directed towards para 16 of the Defence and Counterclaim which pleaded invalidity of the Patent as a whole. This prayer initially objected to para 16 to the extent that it included the unasserted claims. As mentioned above, this prayer was amended at the start of the hearing below to simply read: “To strike out paragraph 16 of the Defence and Counterclaim (Amendment No.1) [as a whole]”.

46 The Plaintiff’s position in respect of the counterclaim for groundless threats of proceedings has always been that only the validity of the asserted claims may be put in issue. The Plaintiff succeeded below on this point and there has been no appeal by the Defendants. As I have explained at [41] and [43] above, context is everything.

47 In my view, the position of the Plaintiff after the amendment in respect of the counterclaim for revocation was simply that the High Court does not have the jurisdiction to hear revocation applications/proceedings and to grant a revocation order under s 80 of the Patents Act. This was exactly the issue canvassed by the parties at the hearing before the AR, and the issue which the AR focused on in [31]-[50] of the AR’s Judgment as referred to in the Notice of Appeal. The Plaintiff must thus be understood as raising “Possible Issue 3”, or in other words, whether the High Court can hear revocation proceedings brought by way of a counterclaim.

48 In any event, even if there was some ambiguity, my view is that no substantial prejudice was caused to the Defendants for the reasons below.

*Whether the Defendants were prejudiced by ambiguities in the Notice of Appeal*

49 The overarching question for my consideration is whether any ambiguities in the Notice of Appeal have prejudiced the Defendants’ ability to effectively resist the Plaintiff’s appeal. It is clear to me that this has not been the case. The substantive arguments put forward by the Defendants addressed the merits of the issue on appeal head-on. In fact, after counsel for the Plaintiff clarified its position at the hearing before me, the Defendants maintained the stance that they took in their written submissions. I am thus of the view that the Defendants fully understood what the issues in appeal were all along. Any ambiguities in the Notice of Appeal would only have been minor and could have been resolved with reference to the overall context of the case. I therefore find that no substantial prejudice has been caused to the Defendants by any defect in the Notice of Appeal.

50 For these reasons, I see no reason to either set aside the Notice of Appeal or dismiss the Plaintiff’s appeal at the outset. As such, I shall proceed to consider the Plaintiff’s appeal on its substantive merits.

***Whether the High Court may hear revocation proceedings brought by the Defendants by way of a counterclaim***

*A brief history of the patent system in Singapore*

51 As this case involves questions of statutory interpretation and detailed consideration of Parliamentary intention at the time the Patents Act 1994 (Act 21 of 1994) (“Patents Act 1994”) was enacted, it is appropriate to begin by briefly setting out the history of the patent system in Singapore.

(1) Patent protection in Singapore under the RUKPA

52 Prior to the Patents Act 1994 coming into force in February 1995, patent protection in Singapore was only accorded to UK-registered patents. A person seeking to register a new patent which had not been granted in the UK would first have to apply for and obtain a patent in the UK before registering it in Singapore. This regime of patent registration in Singapore at the time was governed by the Registration of United Kingdom Patents Act (Cap 271, 1985 Rev Ed) (“RUKPA”), which conferred upon holders of UK-registered patents the same privileges and rights in Singapore by virtue of registration (s 6).

53 The privileges and rights so granted would continue in force as long as the patent remained in force in the UK (s 7). This system has been described as a “patent by importation system” or a “re-registration system” whereby the grantee of a patent in the UK can apply to register the patent in Singapore under the RUKPA (see, generally, *Biogen Inc v Scitech Medical Products Pte Ltd and another* [1994] SGHC 188).

54 Once a UK patent had been registered in Singapore under the RUKPA, the only way for a party to challenge the validity of such a patent in Singapore was to obtain a declaration from the High Court that the exclusive privileges and rights in the UK patent had not been acquired in Singapore “upon any of the grounds *mutatis mutandis* upon which the United Kingdom patent might be revoked under [UK law]” (s 9).<sup>25</sup>

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<sup>25</sup> The relevant provisions of the RUKPA can be found in *A Guide to Patent Law in Singapore* (Alban Kang gen ed) (Sweet & Maxwell, 2nd Ed, 2009) at p 32; *Solite Impex Pte Ltd v Ang Lay See trading as Beng Poh Heng Trading and Others* [1997] SGHC 135 at [14]; and digested at 10 *Mallal’s Digest* (4th ed) at 1188.

55 The only other alternative was to commence proceedings in the UK to revoke the underlying UK patent (see *Ang Lay See and others v Solite Impex Pte Ltd* [1998] 1 SLR(R) 421 at [12] and [17]). Apart from the RUKPA, the only other patent-specific primary legislation which existed before 1995 was the Patent (Compulsory Licensing) Act (Cap 221, 1985 Rev Ed) (“PCLA”), which related to the grant of compulsory licenses in respect of specific classes of patents.

(2) Enactment of the Patents Act 1994

56 The RUKPA and the PCLA were repealed and the Patents Act 1994 established a new patent system. Transitional provisions aside, patent protection in Singapore thereafter could only be obtained by way of application and grant in Singapore pursuant to the procedural and substantive requirements set out in the Patents Act 1994.

57 The provisions of the Patents Act 1994, whilst not identical to those of the UK Patents Act, were modelled closely after the latter. The UK Patents Act is in turn based on the Convention on the Grant of European Patents (European Patent Convention) (5 October 1973) (entered into force 7 October 1977) (“EPC”) (see generally Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Ed, 2014) (“*Law of IP*”) at para 29.3.5). I note that the patent system set up by the EPC and implemented by the UK Patents Act is especially complex. In brief, a patent can be secured by application to and grant by the UK Patent Office. It can also be (and frequently is) obtained by application to and grant by the European Patent Office (“EPO”) with a designation that includes the UK: “European Patent (UK)”. A European Patent (UK) is treated as if it was a patent granted under the UK Patents Act. Complex provisions were necessary to deal with application, grant, invalidity,

opposition and revocation, given the nexus between the UK Patents Act and the UK Patent Office on the one hand, and the EPC and the EPO on the other. This might provide some useful context for understanding the UK Supreme Court’s decision in *Virgin Atlantic Airways Ltd v Zodiac Seats UK Ltd (formerly known as Contour Aerospace Ltd)* [2013] UKSC 46 (“*Virgin Atlantic*”), which will be discussed at [71] below.

58 At the second reading of the Patents Bill (No 4/94/A) in Parliament on 21 March 1994, then-Minister for Law Prof S Jayakumar (“Prof Jayakumar”) described the Bill as introducing a new system of patent registration which would be “vastly different” from the current re-registration system. Prof Jayakumar further explained that this new system was one which would have a “wide-ranging impact” (*Singapore Parliamentary Debates, Official Report* (21 March 1994, vol 6, col 1445) (“*Singapore Parliamentary Debates* 21 March 1994”) (Prof S Jayakumar, Minister for Law)).

59 Given the magnitude of the changes and the highly technical and complicated provisions that a new patent system would require, the Patents Bill was sent to a Select Committee of Parliament (“the Select Committee”) for deliberation together with views from relevant experts and interested parties. After hearing representations on a broad range of issues, the Select Committee finalised its report which was presented to Parliament on 22 August 1994 (*Report of the Select Committee on the Patents Bill (Bill No 4/94/A)* (Parl 8 of 1994, 22 August 1994)).

60 Among other things, the Patents Act 1994 allowed for patent applications to be filed directly in Singapore without applicants having to obtain a UK patent first. This also meant that patents could now be challenged and revoked in Singapore directly. Indeed, under the new system, the grant of a UK

patent became irrelevant to the acquisition of patent rights in Singapore. From that point onwards, patent rights in Singapore became dependent on an application to and grant by the Registrar under the Patents Act. A patent granted under the Patents Act can only be revoked by an application made in Singapore.

61 The issue that has arisen in the present appeal is basically concerned with the question of whether it is the Registrar or the court – or, indeed, both – that is seised with jurisdiction under the Patents Act to hear claims for revocation of a granted patent. I pause to acknowledge at the outset the difficulty which the terms “jurisdiction”, “inherent jurisdiction”, “powers” and “inherent powers” have caused in many areas of the law. This will be considered in greater detail later in this judgment.

62 Returning to the statements made in Parliament during the second reading of the Patents Bill, I note that Prof Jayakumar expressed the following remarks about other significant changes to the patent regime in Singapore:

Other important matters covered by the Bill include disputes concerning the validity of patents. Under the present system, these disputes are heard in the High Court. Under the new system, the disputes will be decided by the Singapore Registry, thus reducing litigation costs... Any appeal against the Registrar’s decision will be to the High Court.

(*Singapore Parliamentary Debates* 21 March 1994, col 1447) (Prof S Jayakumar, Minister for Law)).

63 The statement of the Minister for Law underscores the intention of Parliament to reduce litigation costs by shifting disputes concerning the validity of patents from the High Court to the Registry of Patents (“the Registry”). I note in passing that issues regarding the validity of the patent can arise in several types of disputes and proceedings under the Patents Act, not just in revocation

proceedings (see s 82(1) of the Patents Act). I will elaborate on this further in my overview of the relevant statutory provisions at [84] below.

64 Another observation I make is that under the old RUKPA, a party who wished to raise issues of invalidity (for example, because of a lack of novelty) against a re-registered UK patent before the Singapore court could only do so by seeking a declaration from the court under s 9 of the RUKPA (see [54] above). He could not bring proceedings in Singapore under the RUKPA, whether by way of an application or a counterclaim in Singapore for revocation of the UK Patent. If he wished to attack the UK Patent directly, the only way was to bring proceedings in the UK for revocation under the UK Patents Act. The comments of the Minister for Law on issues of validity and the reduction of litigation costs should be read in the light of the old system under the RUKPA. I will return to Prof Jayakumar's comments later in my analysis of the legislative intention behind s 80 and other relevant provisions of the Patents Act.

(3) Introduction of the self-assessment system and shift to the positive grant system

65 Another feature introduced by the Patents Act 1994 was the self-assessment system, under which the examiner at the Registry could grant a patent as long as the formal requirements for the application had been complied with, even if the examination report revealed that the invention did not meet all of the substantive criteria for patentability (see s 30 of the Patents Act 1994). However, patent holders would risk having their patents invalidated when challenged by another party, if their patents did not in fact satisfy the substantive patentability criteria.

66 The self-assessment system under the Patents Act 1994 subsisted until the 2012 legislative amendments to the Patents Act came into effect on

14 February 2014. Under the new positive grant system, only patent applications with fully positive examination reports are granted (see s 30 read with ss 29A and 29B of the current Patents Act). This shift to a positive grant system was premised upon an impetus to increase the quality of patents granted in Singapore while bringing our patent regime into closer alignment with those of other major patent jurisdictions.

67 Prof Ng-Loy SC comments in *Law of IP* at para 29.4.8 that the premise of the self-assessment system was that patent applicants would exercise “good judgment” and to proceed to request for a grant only if a positive examination report was received. Prof Ng-Loy SC remarks that the premise unfortunately proved false, as a survey conducted by the Intellectual Property Office of Singapore (“IPOS”) in 2008 revealed that there was a minority of cases in which applicants proceeded to grant even though the examination report was unfavourable (see *Consultation Paper on the Proposed Changes to the Patents System 2009* issued by IPOS on 3 July 2009 at para 2.1.4; see also Susanna H S Leong, *Intellectual Property Law of Singapore* (Academy Publishing, 2013), para 16.010 which notes that 13% of patents were granted on mixed or negative examination reports under the self-assessment system).

68 The point is that under the self-assessment system, there was an obvious risk that the patent register would include patents of somewhat “dubious” validity. Indeed, even patents granted on the back of positive examination reports might prove susceptible to a subsequent validity attack. But the risk must nonetheless have been greater under the self-assessment system, since an applicant might have chosen to proceed to grant even in the face of a negative preliminary report. It is also worth pointing out there is no *pre-grant* opposition procedure under the current Patents Act 1994. The need for a clear and efficient procedure by which the validity of a patent could be challenged *post-grant*,



especially in revocation proceedings, was rightly regarded as an important matter to be catered for in the new patent system. In the case of invalidity and revocation, it made sense to vest the Registrar with an authority to hear and determine applications for revocation, rather than to require all applications for revocation to be heard by the High Court. However, it does not necessarily follow that the High Court should not also have some form of concurrent jurisdiction and power to order revocation of a patent in appropriate circumstances. Whether this is in fact the position according to the Patents Act is the question to be decided.

*The in rem nature of an order for patent revocation*

69 Before turning to deal with the specific issue of jurisdiction and power of the High Court, it will be helpful to undertake an analysis of the conceptual nature of patent rights, proceedings and orders, in the context of infringement, validity and most importantly, revocation.

70 I begin with the trite principle that a granted patent is a right *in rem*. The public at large is bound by a granted patent. On the other side of the coin, an order revoking a patent also has an effect *in rem*: the patent ceases to be a granted patent and is removed from the patent register.

71 The interface between an *in personam* action, the principle of *res judicata* and revocation was discussed at length by the UK Supreme Court in *Virgin Atlantic*. I summarise this case here for background:

- (a) *Virgin Atlantic* concerned a European patent which enjoyed the same rights and privileges in the UK pursuant to provisions in the EPC and the UK Patents Act. It will be recalled that a European patent is a patent granted by the EPO. The EPC provides for post-grant opposition

proceedings before the EPO, whereby a European patent can be revoked if found invalid or amended so as to meet the requirements of the EPC. The EPC and the UK Patents Act also provide for the English courts to have jurisdiction to determine the validity and infringement of European patents (see *Virgin Atlantic* at [5]-[7]; s 77(2) of the UK Patents Act and Art 64 of the EPC). Lord Sumption further explained at [7] that “the English courts have the same jurisdiction to determine questions of validity and infringement in the case of European patents as they have for domestic patents” granted by the UK Patent Office. The jurisdiction of the English courts over the validity of European Patents, however, is concurrent with that of the EPO, albeit “purely national” in that a decision of invalidity or revocation will have effect in the UK only, whereas a corresponding decision of the EPO will have effect in all the states in which the patent was granted.

(b) In earlier proceedings, the English Court of Appeal found that the claims of a European patent were valid, and that the defendant, Zodiac Seats UK Ltd (“Zodiac”), had infringed certain claims of the patent (see [11]). An order was made for damages to be assessed (see [39]). The English Court of Appeal’s judgment on infringement was final, and leave for further appeal to the UK Supreme Court was denied (see [11]). Before the hearing for an assessment of damages, the claims of the patent were amended in opposition proceedings brought by Zodiac before the EPO. The Technical Board of Appeal of the EPO (“TBA”) found that in the form in which the patent was originally granted, the relevant claims were invalid because of anticipation by the prior art. The European patent was thus amended by removing all of the claims found to be invalid. The amendment ordered by the TBA had retrospective effect to the date of grant. The relevant claims were the

same claims in respect of which Zodiac had earlier been found to have infringed (see [2]).

(c) The English court which subsequently heard the proceedings for assessment of damages had to deal with the fact that the TBA had removed the infringed claims with retrospective effect, and how this impacted the court's assessment of damages. Prior to the UK Supreme Court's decision, the position in the UK was that the doctrine of *res judicata* – specifically, cause of action estoppel – applied (see [28]-[35]). On this view, as the question of infringement had been conclusively decided by the English Court of Appeal, validity could not be re-opened by Zodiac, and the patentee would be entitled to damages.

(d) However, Zodiac was not challenging the conclusions reached in the earlier proceedings on the validity of the unamended claims (that is, the claims subsisting prior to the amendments ordered by the TBA). Instead, its contention was that damages should be assessed at nil (or nominal) because the effect of the subsequent amendment (with retrospective effect) is that the patentee suffered no damage (at [53]).

(e) The UK Supreme Court allowed Zodiac's appeal. In brief, it held that cause of action estoppel did not apply to issues that were not and could not have been raised in the earlier proceedings. The fact that the claims of the European patent in suit (on which the patentee had succeeded before the English courts) were subsequently removed (because of invalidity) by the EPO was something that Zodiac could not have raised in the earlier proceedings. *Res judicata* did prevent Zodiac from re-litigating the English Court of Appeal's decision on the validity of the original pre-amendment patent. Nevertheless, Zodiac was entitled to rely on the amendment by the TBA (which had effect in the UK under

the EPC and UK Patents Act) as a matter which was relevant to the assessment of the loss and damage suffered by the patentee (see [27]).

72 Leaving aside the problems that arise in the UK and Europe from the parallel jurisdiction over validity established by the EPC (which were expressly acknowledged by Lord Sumption at [3]), what is important for present purposes are the comments made by the UK Supreme Court on the effects of a finding of invalidity, an order for revocation, and an order for a patent to be amended.

73 In the case of revocation, Lord Sumption at [32] described the revocation of a patent as an act *in rem* which determines the status of a patent as against the world. A patent revoked by the authority which granted it must be treated as never having existed. The ground of invalidity is irrelevant. Revocation is decisive regardless of the ground(s) on which it was ordered. In a similar vein, Lord Neuberger remarked at [49] that revocation deprives the patentee of the rights which the patent had bestowed on him against the world. I agree that an order of revocation has an effect *in rem*.

74 Lord Sumption further stated at [7] that a decision on *invalidity* is also a decision *in rem*. By this, what was meant was that the decision determines the validity of the patent (or claims in issue) not only as between the parties to the proceedings, but generally. Lord Neuberger at [57] similarly commented that a decision on infringement is a decision *in personam* which binds only the parties to the action and their privies, and that this is to be contrasted with “a decision that a patent is invalid (or must be amended) is *in rem*, so it binds the world, just as the patent, as long as it is in force, can be enforced against the world.”

75 Bearing in mind the decision in *Virgin Atlantic* (which is of course not binding on this court) and the statements by Lord Neuberger and Lord

Sumption, what is the position of a party who is already being sued for patent infringement? He can certainly defend himself by raising invalidity against the patent. But if the matter stops there (for example, because there is no claim or order for revocation), even if he succeeds in the defence, his win seems to be “*in personam*”, in the sense that the patent is not revoked even though the court has made a finding of invalidity by way of defence in the infringement action. In that vein, there is in theory nothing to prevent the patent owner from asserting the same patent against another person. Validity may well be raised again as a defence in that suit. In that eventuality, the question arises: what is the effect of the finding of invalidity in the earlier proceedings on a second suit in which a different defendant raises invalidity as a defence? Given the *in personam* nature of infringement actions, it might be thought that cause of action estoppel would not apply because the parties to the two suits are not the same. But against this, there is the statement of Lord Sumption at [7] that a decision on invalidity is also a decision *in rem* which determines the validity of the patent (or claims in issue) “not only as between the parties to the proceedings but generally.”

76 I note that special provisions are set out in s 72 of the Patents Act on the grant of a certificate of contested validity of a patent in proceedings before the court or the Registrar. In brief, when a patent has been found to be *valid* (in whole or in part), the court or the Registrar may certify such a finding and the fact that the validity of the patent was so contested. Section 72(2) goes on to provide that:

Where a certificate is granted under this section, then, if in any subsequent proceedings before the court or the Registrar for infringement of the patent or for revocation of the patent, a final order or judgment is made or given in favour of the party relying on the validity of the patent as found in the earlier proceedings, that party shall, unless the court or the Registrar otherwise directs, be entitled to his costs or expenses as between solicitor and own client other than the costs or expenses of any appeal in the subsequent proceedings.

This provision essentially creates cost consequences for parties who seek to re-litigate issues of validity where the court or the Registrar has already found that the patent is *valid*. Although there is no equivalent provision providing for the grant of a certificate of *invalidity* in a case where the defendant succeeds in defending the infringement suit on grounds of invalidity, it is clear that the court can grant a declaration of invalidity (where appropriate) in connection with proceedings for infringement and groundless threats of suit.

77 The interface between *res judicata*, *in personam* infringement claims and the effect of a finding of invalidity was not addressed in parties’ arguments and submissions. Understandably, the arguments before me focused on the specific question of whether the court enjoys the jurisdiction to hear revocation proceedings and grant revocation orders. Indeed, the question whether a finding of invalidity takes effect *in rem* is not a matter that must be decided. I discuss this issue simply as part of the backdrop against which the question of jurisdiction over revocation proceedings is to be decided. I say no more, save to make a few observations:

(a) *Virgin Atlantic* is strong UK authority that invalidity decisions are *in rem*, but I recognise that there are differences between the patent system set up by the UK Patents Act and the EPC as compared to our Patents Act.

(b) It does not appear that there is any requirement under the UK Patents Act that a defendant must couple a defence based on invalidity with a claim for revocation. Indeed, this was implicitly recognised by Lord Sumption in *Virgin Atlantic* at [7] where he remarked that “[a] decision of an English court declaring a patent invalid, or (*which will*

*normally follow*) revoking it, will have effect in the United Kingdom only” [emphasis added].

(c) But under the UK Patents Act, given the express provision that the *court* may order revocation, it is not surprising that a defendant who pleads invalidity as a defence will often (but is not obliged to) include a claim for revocation. The close connection between a finding of invalidity by a UK court and the court’s express power under s 72 of the UK Patents Act to order revocation is consistent with and supports the view that a decision on invalidity has effect *in rem*. And as will be seen from the cases set out at [112] below, the “practice” in Singapore is also to bring a claim for revocation by way of counterclaim in infringement proceedings where validity has been raised.

(d) On a separate note, a decision that the patent is invalid, even if it is made only by way of a defence to infringement, is a decision made in respect of the status of the patent which is a property right *in rem*. The judgment of the court and the finding on invalidity, whilst arising in an *in personam* action, will be published and available to the world at large. Clearly, that finding will be of interest to the general public.

(e) Finally, as I noted at [75] above, it appears that there is nothing in theory to prevent a patent proprietor from asserting the same patent against another person notwithstanding it has been found invalid (but not revoked). But even if this is correct, the patent proprietor may nonetheless be unlikely to do so in practice. He runs at the very least the obvious risk of another finding of invalidity and serious cost consequences under general principles of civil procedure. The practical effect of a finding of invalidity may therefore well be that the patent proprietor will not assert the patent again and may even allow the patent

to lapse at the next renewal date or seek to amend the claims (to the extent permitted) to respond to the finding of invalidity.

78 In any event, it suffices to note for the present case at hand that a revocation order, unlike a finding on infringement, has an effect *in rem*. I will return to the significance of this principle later on in the judgment, when discussing the central issue of whether the court has jurisdiction to make a revocation order.

*Overview of the relevant statutory provisions*

79 Next, I set out an overview of the statutory provisions which touch on the patent register, infringement, validity and revocation, so as to provide the general context surrounding the main issue on appeal. This is necessary because whilst there are several – indeed, numerous – previous decisions which appear to accept that the court enjoys the jurisdiction to hear revocation proceedings and grant revocation orders by way of counterclaim, it appears that this is the first time the issue has actually been raised and contested before the court (see [112]-[115] below).

(1) Provisions and rules on the patent register

80 I begin with the patent register, an aspect of the patent system that will arise in the course of the later discussion on patent grant and revocation. Section 42(1) of the Patents Act requires the Registrar to maintain a register of patents in accordance with the Patents Rules (Cap 221, R 1, 2007 Ed). Section 42(5) provides the public with a right to inspect the register.

81 Rule 55 of the Patents Rules sets out the Registrar’s obligations in respect of the register in detail. Rule 55(3) requires the Registrar to enter



information including (i) the date of grant; (ii) the date of any renewal; (iii) the cessation or restoration of the patent, if any; (iv) particulars of any decision to revoke the patent; and (v) particulars of any court order in relation to the patent.

82 In regard to entries concerning orders or directions by the court, r 64 goes on to provide that:

(1) Where any order or direction has been made or given by any court or other competent authority in any matter under the Act, the person, or one of the persons, in whose favour the order is made or the direction is given —

(a) shall file an application to record the order or direction, accompanied by a copy of the order or direction; and

(b) if the Registrar so requires and within such period as the Registrar may specify, shall file a specification as amended (prepared in accordance with rules 19, 21 and 23).

(2) Upon a filing under paragraph (1), the specification shall be amended or the register rectified or altered, as the case may require.

83 Several points regarding the register and the relevant rules are worth underscoring:

(a) First, s 35(1)(a) of the Patents Act requires the Registrar to, as soon as practicable after the grant of the patent, send to the patent proprietor a certificate stating that the patent has been granted to the proprietor. Section 36(1) then provides that the grant of a patent “shall take effect, on the date of issue of the certificate of grant and... shall continue in force until the end of the period of 20 years beginning with the date of filing the application for the patent or with such other date as may be prescribed.” It follows that the patent takes effect in Singapore from the date of issue of the certificate of grant and not the date when the grant is entered into the register.

(b) Secondly, under r 55(3)(j) of the Patents Rules, the particulars of any decision to revoke the patent are required to be entered in the register (see [81] above). However, as will be discussed below at [102], revocation of a patent takes effect from the date of *grant* (ie, *ab initio*), rather than from the date of the revocation order.

(c) Last but not least, I note in particular that rr 55(3)(k) and 64 require that any orders and directions made by the court in relation to the patent be entered into the register. The person in whose favour an order or direction is made is required to make the application to enter a record of the order or direction. I shall return to the Patent Rules later in the judgment.

(2) Provisions on how the issue of validity can arise

84 Next, I reiterate that the issue of patent validity can arise in many types of proceedings under the Patents Act. It is not confined to revocation proceedings. Section 82(1) of the Patents Act sets out the various proceedings in which the validity of a patent can be put in issue. These include:

- (a) by way of defence in proceedings for infringement under s 67 (s 82(1)(a));
- (b) in proceedings under s 77 for a remedy for groundless threats of infringement proceedings (s 82(1)(b)); and
- (c) in proceedings before the Registrar under s 80 for revocation (s 82(1)(d)).

85 Section 82(2) provides that the validity of a patent may not be put in issue in any other proceedings. It goes on to state that no proceedings may be instituted seeking only a declaration of validity or invalidity. A declaration of

invalidity must therefore be sought as a relief or remedy in connection with other proceedings such as infringement.

(3) Provisions on the substantive requirements of a valid patentable invention

86 Irrespective of the type of proceeding under s 82(1) in which validity is raised, the grounds of invalidity are the same. Section 82(3) provides that the only grounds on which validity can be put in issue are the grounds on which the patent may be revoked under s 80.

87 Under s 80(1), the Registrar may on application revoke a patent on several grounds, including: (a) the invention is not a patentable invention; and (b) the patent was granted to a person who was not entitled to be granted that patent. Other subsections of s 80(1) set out grounds which deal with the insufficiency of specifications, conflicts between the matter disclosed in the specification and the application, impermissible amendments made to the specification, and fraud, misrepresentation or non-disclosure or inaccurate disclosure of material information.

88 “Patentable invention” is defined in s 13. The most basic requirements are that the invention is new, inventive and capable of industrial application. In the present case, the grounds of invalidity relied on as set out in the Particulars of Objection are the alleged lack of novelty, inventive step and insufficiency (the last ground in respect of two claims of the Patent only).

89 It follows that when an individual has been threatened and/or sued for patent infringement, he has the right to defend the action by contesting the validity of the patent, at least in respect of the claims that have been asserted. Often, as in the present case, the basis for the attack on validity will be the lack

of novelty or inventive step. Insufficiency is also frequently raised in attacks on validity.

(4) Provisions on validity in the context of infringement proceedings

90 A very common defence in patent infringement proceedings is that the patent claims asserted to have been infringed by the defendant are invalid.

91 The Patents Act makes clear the High Court and the Registrar both have the jurisdiction to hear infringement proceedings. Section 67(3) expressly states that infringement proceedings “may be brought *in the court*” [emphasis added]. When read with ss 67(1)(c) and (e), s 67(3) further provides that the proprietor of a patent and any other person can, by agreement, refer to the Registrar the question as to whether the proprietor can make a claim for damages and a declaration of validity and infringement.

92 Where the plaintiff succeeds in an infringement action, s 67(1)(e) of the Patents Act makes provision for the grant of a declaration that the patent is valid and infringed. There are also detailed provisions in s 70 of the Patents Act touching on relief for infringement of a partially valid patent.

93 But as touched on above, even if the defendant succeeds in mounting a defence on grounds of invalidity, the patent remains as a granted patent until it is revoked. If a second infringement suit is brought by the patentee against a different person, that person will have to raise the issue of validity (by way of defence). As mentioned earlier, the question might arise as to whether the defendant in the second suit can rely on the finding of invalidity in the earlier action to which he was not a party. Even if he is successful in raising the defence of *invalidity*, the special provision on costs in s 72(2) will not apply, as s 72(2) is only applicable where there was a previous finding of *validity* of the patent.

In such a situation, however, the question as to whether the court can award indemnity costs against the proprietor under general principles of civil procedure might also arise.

94 Finally, I add that as in UK there is no requirement that the defendant must couple an invalidity defence with any application or claim for revocation.

(5) Provisions on validity in the context of groundless threat proceedings

95 Whilst it is apparent from the present case that a counterclaim for groundless threats of suit may be brought in infringement proceedings, the issue of validity can also arise in a standalone action brought by an individual for groundless threats of suit. A person who has been threatened with groundless threats of suit does not need to wait for an infringement action to be brought before raising the invalidity of the asserted claims of the patent under the Patents Act (see s 77 generally). He may instead choose to initiate proceedings seeking a remedy for groundless threats under s 77.

96 Again, I note that there is no requirement that a person claiming for a remedy for groundless threats must also claim for revocation of the patent.

(6) Provisions on revocation proceedings

97 Turning to proceedings for revocation of a patent, it is also not necessary to wait for an infringement action to be commenced before starting revocation proceedings. Section 80(1) states that “any person” may apply for an order to revoke a patent. He does not have to be a defendant in infringement proceedings or even a person who is aggrieved by being on the receiving end of a threat of suit (see also *A Guide to Patent Law in Singapore* (Alban Kang gen ed) (Sweet

& Maxwell, 2nd Ed, 2009) (“*A Guide to Patent Law in Singapore*”) at para 8.1.2).

98 There is good reason for this. A granted patent is a right *in rem*. The public is bound by a granted patent. As noted earlier at [83(a)], the grant takes effect from the date on which the certificate of grant is issued. On the other side of the coin, an order revoking a patent has an effect *in rem*: the revocation order when made has effect from the date of the grant.

99 Further, under r 55(3)(j) of the Patent Rules, the particulars of any decision revoking the patent is to be entered in the patent register. A decision revoking a patent is obviously a matter of interest to the public at large. Indeed, it appears that a revocation order takes effect from the date it becomes effective, which may be before the decision of revocation is entered into the register.

100 The procedure for making an application for revocation under s 80 is set out in s 80(9). This provides that the application shall be (a) made in the prescribed form and filed at the Registry in the prescribed manner and (b) accompanied by the prescribed fee. The prescribed form (Form 35) and manner are set out in the Patent Rules. The Rules include provisions on (i) the procedure for applying for revocation (r 80); (ii) the material information to be provided (r 80A); (iii) the procedure for preparation of re-examination report (r 81); (iv) copies and conclusions of the re-examination report (r 82); (v) award of costs on surrender of patent (r 83); and (vi) notification of an opportunity to amend (r 84).

101 The material information to be provided under r 80A is essentially concerned with the documents provided in respect of the search and examination. It is noted that s 80(2) of the Patents Act provides that the

Registrar may “cause the patent to be re-examined by an Examiner so as to determine whether the patent should be revoked”. In such a case, the applicant is required to pay the prescribed re-examination fee (s 80(2)). Given the *in rem* effect of a revocation order, the power to order re-examination by an Examiner is understandable and important.

102 In the event that the revocation application *succeeds*, s 80(5) provides that the order may be:

- (a) an order for the unconditional revocation of the patent;  
or
- (b) where one of the grounds [for revocation] has been established, but only so as to invalidate the patent to a limited extent, an order that the patent should be revoked unless within a specified time the specification is amended under section 83 to the satisfaction of the Registrar.

Section 80(7) of the Patents Act further provides that the revocation takes effect from the date of grant of the patent and not the date of the order. Difficult questions may well arise as to the rights and liabilities of the former patent proprietor, and obligations or transactions that took place prior to the grant of the revocation order. Revocation of a patent may carry consequences for other persons who have dealt with the patent owner prior to the revocation. This is not a matter that arises for resolution in the present case. Nevertheless, it is part of the general context to bear in mind in approaching and deciding the issue that has arisen.

103 In the event that the revocation application *fails*, it is still possible to challenge the validity of the patent in future proceedings, notwithstanding the earlier decision by the Registrar (or by the court on appeal from the Registrar) refusing revocation. Section 80(6) provides that the decision under s 80 “shall not estop any party to any civil proceedings in which infringement of a patent

is in issue from alleging invalidity of the patent on any of the grounds referred to in subsection (1), whether or not any of the issues involved were decided in the decision.” It follows that a decision of the Registrar or the court in an appeal from the Registrar under s 80 against the application to revoke because of a finding of validity does not result in *res judicata* or estoppel against any party to civil proceedings who wishes to raise invalidity.

104 To put all of these statutory provisions on infringement, groundless threats, invalidity and revocation into context, I use the facts of the present case as an example. I refer again to the Defendants’ general averment in para 16 of the Defence and Counterclaim that the Patent has always been invalid. The Defence and Counterclaim concludes with prayers, *inter alia*, for (i) a declaration that the Patent is and always has been invalid; (ii) an order that the Patent be revoked; and (iii) a declaration that the acts complained of do not amount to infringement of the Patent. The claim by the Defendants for a declaration of invalidity was sought in respect of proceedings for infringement (by way of defence), groundless threats of suit (by counterclaim) and the prayer for revocation. The Defendants did not counterclaim for a declaration of invalidity on its own. As noted above at [12]-[13], the AR below held that when validity is raised by way of defence or in respect of a claim for groundless threats of suit, it is only the asserted claims whose validity is brought into issue. Whilst this aspect of the AR’s decision has not been appealed and is not before me, I see no reason to disagree with the AR. It follows that since the Defendants’ prayer for a declaration of invalidity relates to the whole Patent, this can only be supported if the court has the right to hear revocation proceedings and to grant a revocation order. I shall return to this later.

105 For now, I simply observe that the question of whether a defendant can counterclaim for a revocation order or bring a free-standing claim for revocation



in the court is a matter of considerable importance. If the defendant cannot bring a counterclaim in infringement proceedings for revocation because the court does not have the jurisdiction and/or power to make the revocation order, the consequence is that until someone (whether himself or some other person) takes the initiative of applying to the Registrar for revocation and succeeds, the patent will remain on the patent register as a granted patent. No record of a decision on revocation will have been entered, only a finding of invalidity by the court in respect of the asserted claims in the infringement action. The confusion or nuisance value of such a patent is readily apparent, and perhaps especially so, considering that the Registrar only has a very limited power to revoke on his own initiative under s 81.

106 It is true that the defendant who succeeds in defending an infringement suit on the grounds of invalidity of the asserted claims can at least take comfort in the fact that the plaintiff has failed in the action against him on those claims. And if that comfort is not enough, the provisions outlined here show that he may make a separate application to the Registrar under s 80 for revocation.

(7) Provisions on amendment of patent specifications

107 For completeness, I will also briefly cover the provisions on amendment of patent specifications. A patent owner may be able to save the patent from revocation by amending the specification of the patent so as to get around the objection (s 80(5)(b)). For example, it may be that only some of the claims set out in the specification are affected by matters in the prior art or some other ground of invalidity.

108 The provisions set out in Part XV of the Patents Act on the right to seek amendments expressly apply to “any proceedings before the court or the

Registrar in which the validity of a patent is put in issue” (s 83(1)). Of especial importance in Part XV are the requirements that the amendment must not include “additional matter” (ss 84(1) and 84(1A)) or result in an extension of the protection conferred by the patent (s 84(2)). The question as to what amounts to additional matter and an extension of protection has given rise to frequent disputes. Fortunately, it is not necessary to delve into these issues in the present case.

109 Section 83(4) states that where an application is made to the court for amendment, the applicant must notify the Registrar and provides that the Registrar is entitled to appear and be heard and shall appear if so directed by the court. Bearing in mind the *in rem* nature of a granted patent and the *in rem* consequence of an amendment to the patent specifications, the requirement that notice be given to the Registrar when an application is made to the court to amend is perfectly understandable. I note that an amendment of a patent specification under s 83 has effect and is deemed always to have had effect from the grant of the patent (see s 83(3)). It is also worth noting that under r 64 of the Patent Rules, provision is made for the recording in the register of orders and directions made by the court and amended patent specifications.

110 The fact that Part XV of the Patents Act confers express power on the court to allow amendment in proceedings before the court in which validity is in issue, does not mean that the court necessarily enjoys original jurisdiction to hear and determine revocation proceedings. It is the latter which is the central issue to be resolved in this appeal.

*Current practice in Singapore*

111 Having set out a brief history of the patent system in Singapore, undertaken an analysis of the *in rem* nature of a patent revocation order, and provided a general overview of the relevant statutory provisions, I turn back to the question at hand as to whether the court may properly hear patent revocation proceedings brought by way of a counterclaim to an infringement claim, in the exercise of its original jurisdiction.

112 I start with an overview of the current practice as discerned from cases heard by the High Court. The Defendants presented me with a table of 13 cases which involved counterclaims for revocation arising from infringement proceedings, three of which were further decided by the Court of Appeal. I summarise these 13 cases here:

(a) Several of the decisions cited to me were not directly on the issues of infringement or revocation, and instead turned on ancillary issues arising in the course of litigation such the amendment of patent specifications under s 83(1) of the Patents Act (see *Warner-Lambert Co LLC v Novartis (Singapore) Pte Ltd* [2016] 4 SLR 252 (“*Warner-Lambert*”), discussed in more detail below at [114]; *Ship’s Equipment Centre Bremen GmbH v Fuji Trading (Singapore) Pte Ltd and others and another suit* [2015] 4 SLR 781) and service of a writ out of the jurisdiction under O 11 r 1 of the ROC (see *Bradley Lomas Electroluk Ltd and another v Colt Ventilation East Asia Pte Ltd and others* [1999] 2 SLR(R) 983), or a separate question of law altogether (see *Attorney-General v Ting Choon Meng and another appeal* [2017] 1 SLR 373 (“*Ting Choon Meng*”). With that said, each of these cases involved facts where a party was sued for infringement and subsequently brought a

counterclaim for revocation.<sup>26</sup> Apart from *Ting Choon Meng*, the alleged infringements in these cases were in respect of *all* claims of each patent. In the patent infringement suit underlying *Ting Choon Meng*, the plaintiff only alleged infringement of some claims of the patent, but the defendant counterclaimed to revoke the entire patent.<sup>27</sup> However, this suit was discontinued.

(b) It appears from the written grounds of decision for five out of the nine remaining cases that the respective plaintiffs each claimed for infringement in respect of the *entire* patent, and revocation was similarly sought by each defendant for all claims of the patent. *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd* [2008] 1 SLR(R) 335 and *Peng Lian Trading Co v Contour Optik Inc and others* [2003] 2 SLR(R) 560 were decisions of the Court of Appeal in respect of the High Court's findings at first instance, whereas *Dextra Asia Co Ltd and another v Mariwu Industrial Co (S) Pte Ltd and another suit* [2006] 2 SLR(R) 154, *Main-Line Corporate Holdings Ltd v DBS Bank Ltd* [2012] 4 SLR 147 and *Ng Kok Cheng v Chua Say Tiong* [2001] 2 SLR(R) 326 ("*Ng Kok Cheng*") were decided by the High Court at first instance. I note that in *Ng Kok Cheng*, Judith Prakash J (as she then was) remarked at [75] that:

Once the patent has been granted, it remains valid for its legal term unless revoked by the Registrar of Patents *or the court*. The grounds on which such revocation may be made are set out exclusively in s 80 of the [Patents] Act.

[emphasis added]

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<sup>26</sup> S 390/2015, Statement of Claim and Defence & Counterclaim; S 315/2010, Particulars and Defence & Counterclaim; *Bradley Lomas Electroluk Ltd and another v Colt Ventilation East Asia Pte Ltd and others* [1999] 2 SLR(R) 983 at [4].

<sup>27</sup> S 619/2011, Particulars and Defence & Counterclaim.

(c) In the four remaining cases, only *some* claims of the patents were alleged to have been infringed:

(i) In *Merck & Co, Inc v Pharmaforte Singapore Pte Ltd* [2000] 2 SLR(R) 708 (“*Merck*”), the Court of Appeal upheld the High Court’s decision allowing the defendant’s counterclaim for revocation. Only certain claims of the patent were alleged to have been infringed, and the counterclaim for revocation was only brought in respect of the asserted claims (see [6]-[7]).

(ii) *Lee Tat Cheng v Maka GPS Technologies Pte Ltd* [2017] SGHC 48 (“*Lee Tat Cheng*”), a case this court recently decided, was similarly one in which the counterclaim for revocation was only in respect of those asserted claims (see [4]). *Lee Tat Cheng* also involved a counterclaim for groundless threats in respect of the asserted claims. In the end, the patent claims were held to be valid but not infringed.<sup>28</sup>

(iii) In *V-Pile Technology (Luxembourg) SA v Peck Brothers Construction Pte Ltd* [1997] 3 SLR(R) 981, the counterclaim for revocation was in respect of all except one of the asserted claims (see [95] and [103]).

(iv) Finally, in *ASM Assembly Automation Pte Ltd v Aurigin Technology Pte Ltd and others* [2010] 1 SLR 1 (“*ASM*”), only certain claims of the patent were asserted to have been infringed, but the defendants counterclaimed to revoke the *entire* patent as well as for remedies for groundless threats. These facts are therefore the closest to those in the present case, out of all of the

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<sup>28</sup> At the time of preparation of this judgment, the decision in *Lee Tat Cheng* was on appeal.

cases cited to me. But I note that while Tan Lee Meng J made clear findings on the validity of each of the asserted claims individually (see [55]-[62]), he did not expressly deal with the unasserted claims. Nonetheless, Tan J “ordered that the patent be revoked” (at [64]).

113 It may be argued that these cases implicitly suggest that the High Court may at first instance hear revocation proceedings brought by way of a counterclaim. However, it does not appear that this question was ever directly raised, contested or ruled upon in any of the cases. It follows that these decisions cannot be treated as precedents to determine the question of law at hand.

114 In *Warner-Lambert*, for example, another case which this court heard, the plaintiff commenced patent infringement proceedings against the defendant. Shortly thereafter, the plaintiff applied to amend the patent. The defendant subsequently filed a defence and counterclaim in which it sought revocation on the ground the claims related to subject matter that was not patentable. The amendments applied for were essentially intended to meet any claim that there was no patentable subject matter. The main issue was whether leave should be granted to amend the patent under s 83(1) of the Patents Act. At first instance, leave was refused, *inter alia*, because the proposed amendments involved an extension of protection. The decision was affirmed on appeal in *Warner-Lambert Company LLC v Novartis (Singapore) Pte Ltd* [2017] SGCA 45. Whilst the Court of Appeal made reference to the fact that the defendant was challenging the validity of the claims and had counterclaimed for revocation (at [18]), the question as to whether the court had the jurisdiction and power to order revocation was not raised or determined.

115 The revocation order made by the Tan J in *ASM* is especially pertinent in that the counterclaim for revocation was made in respect of the whole patent, when only some of the patent claims had been asserted in the infringement action. After a detailed review of the facts and law, the learned judge found that there was nothing novel or inventive in the patent and ordered the patent to be revoked. However, there is nothing in the reported judgment which indicates that the court’s jurisdiction or power to revoke the patent was contested.

116 I accept that the cases do at the very least establish the current practice in Singapore, in so far that revocation orders have been made by the High Court in the exercise of its original jurisdiction when hearing counterclaims for revocation in infringement proceedings. The revocation order in *Merck* was also affirmed by the Court of Appeal and concerned the asserted claims in the infringement suit.

117 Whilst our courts have never directly ruled on the specific question of whether the High Court may hear revocation proceedings, the Defendants cited two academic texts that have considered this question. In *Law of IP* at para 30.0.6, Prof Ng-Loy SC states that “[a]n application for revocation under s 80(1) may be made to the Registrar of Patents or to the High Court.” In a footnote (n 5 to para 30.0.6), Prof Ng-Loy SC adds that “[t]he power of the High Court to hear revocation proceedings is found in s 91(1)”. Likewise, *A Guide to Patent Law in Singapore* states at paras 8.2.1 to 8.2.2:

8.2.1 Any person may, under s 80, apply to revoke a patent before the Registrar of Patents. Section 91 grants to the court powers which the Registrar could have made or exercised under the Patents Act...

8.2.2 Section 82(1) sets out the circumstances under which the validity of a patent may be put into issue. One such circumstance is by way of a defence in an infringement action. In these proceedings, e.g. infringement proceedings, the issues

relating to the validity of the patent are heard before the Singapore High Court, as part of the infringement proceedings. Where no infringement action has been commenced, an interested person would have to commence revocation proceedings before the Registrar. Thus, more often than not, issues relating to the revocation of a patent are heard in the courts rather than before the Registrar.

118 The Plaintiff now has the somewhat invidious task of showing that the learned academic commentators are wrong. That said, the above-cited academic texts do not delve much further to consider the precise jurisdictional basis upon which the court’s purported original jurisdiction over revocation proceedings is founded. The learned commentators’ observations may simply be declaratory of the existing practice, in the light of the aforementioned judicial decisions granting or upholding revocation orders made by the High Court.

119 At the same time, I note that the “practice” is for standalone revocation proceedings (*ie*, revocation not brought by way of a counterclaim in infringement proceedings) to be commenced at the Registry (see, *eg*, *Cambrian Engineering Corporation Pte Ltd v FOSTA Pte Ltd* [2016] SGIPOS 13; *Lonza Biologics Tuas Pte Ltd v Genpharm International Inc* [2015] SGIPOS 13; *Cargill International Trading Pte Ltd v Martek Biosciences Corporation* [2009] SGIPOS 12) rather than in the High Court.

120 The fact that there are many decisions which appear to have accepted without adverse comment the right of a defendant in infringement proceedings to bring a counterclaim for relief which includes a prayer for revocation on the back of a pleaded assertion of invalidity is a matter that has caused me concern. Nevertheless, and with due respect and deference to those cases, the fact that there is a practice does not provide a basis to establish jurisdiction as a matter of law. Nor can practice trump law.



121 In *Re Nalpon Zero Geraldo Mario* [2013] 3 SLR 258 (“*Re Nalpon*”), the Court of Appeal held at [25] in response to an argument for “jurisdiction by estoppel” that the court cannot assume or confer jurisdiction upon itself “regardless of how it may have acted”. Instead, the court’s jurisdiction must be statutorily conferred. Similarly, I emphasise here that “jurisdiction is a question of law [to] be determined by reference to the relevant legislation” (*Re Nalpon* at [25]). But before looking more closely at the legislation relevant to the court’s jurisdiction to hear revocation proceedings, I first consider the general legislative intention in enacting the Patents Act 1994, which may be helpful in guiding the court’s exercise in statutory interpretation.

*The intention of Parliament*

122 Both parties agreed that the interpretation of the relevant statutory provisions in the Patents Act must be in accordance with the legislative intention at the time they were enacted. However, each side presented a different characterisation of Parliament’s intention based on certain statements made during the Parliamentary Debates. Prof Jayakumar’s remarks at the second reading of the Patents Bill (see [62] above) are especially pertinent to this issue, as his statements evince Parliament’s intention in 1994 to shift disputes concerning the validity of patents from the High Court to the Registrar. This was relied upon by the Plaintiff to account for omission of any reference to “the court” in s 80, and to substantiate its position that only the Registrar may hear revocation proceedings in Singapore.

123 The Defendants’ argument rests on the point that Parliament’s *broad intention* in moving disputes from the courts to the Registry was to save costs in patent litigation. Prof Jayakumar specifically mentioned that “[u]nder the new system, the disputes will be decided by the Singapore Registry, *thus reducing*

*litigation costs*” [emphasis added] (see [62] above). If the overall objective was to save litigation costs, the Defendants assert that this goal would be subverted should the court be unable to hear revocation proceedings even by way of counterclaim when infringement proceedings in respect of the same patent are already before the court.<sup>29</sup>

124 The Defendants further submitted that in cases such as the present where the validity of the asserted claims have already been properly put in issue before the court by way of defence in infringement proceedings as well as by a counterclaim for groundless threats, litigation costs would be doubled or at least substantially increased if revocation proceedings could only be heard before the Registrar. It was argued that as a matter of principle, if a defendant in infringement proceedings wishes to revoke the patent in addition to defending the claim and claiming a remedy for groundless threats, he should not be required to bring parallel or separate proceedings before the Registrar for revocation. Since the court would already be hearing evidence from the parties on the issue of validity, the Defendants argued that it could not have been Parliament’s intention to require the defendant to expend even more time and money in mounting a separate application for revocation before the Registrar. Not only would costs increase, uncertainty may arise if the Registrar in the revocation proceedings comes to a different view on the validity of the patent based on the material available or placed before the Registrar.

125 Whilst the overarching objective behind the new patent system and laws in 1994 was to create a favourable climate for innovation and technological innovation, Parliament was also cognisant of the costs involved in setting up its

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<sup>29</sup> Defendants’ oral submissions at the hearing on 30 June 2017.

own registration system as well as litigation costs, particularly in respect of validity disputes.

126 I observe that cost issues in a patent system are complex and concern many components including: (i) costs to the public in setting up new patent infrastructure such as procedures to assess and determine compliance with patentability requirements as part of the patent application process; (ii) costs to the applicant for a patent who seeks the grant of a patent; (iii) costs to the patent proprietor in defending post-grant attacks on validity of the registration; and (iv) costs to the parties in respect of infringement claims whether or not issues of validity are raised by way of defence. The decision as to where the cost balance lies will likely need to take account of the *in personam* nature of infringement proceedings, as well as the *in rem* nature of a patent and the *in rem* consequence of an order for revocation.

127 In coming to my decision, I acknowledge the seriousness of the points raised by the Defendants. But I have some concerns as to whether the Defendants' stated concerns about costs and parallel proceedings may be overstated. Parliament must have been aware of the possibility that an application for revocation under s 80 to the Registrar might be made after infringement proceedings have commenced in court, and in circumstances where the defendant in those proceedings has mounted a defence that raises invalidity. This explains why leave of court is required in such cases under s 82(7). I will elaborate on this provision later in my judgment. At this juncture, I simply make the observation that s 82(7) serves as a housekeeping provision to mitigate any unnecessary costs and confusion that could arise from parallel proceedings on validity in different fora.

128 Even if a finding of invalidity has already been made by the court, I do not think that the filing of an additional application for revocation with the Registrar can be deemed unnecessary or costly. Whilst some additional costs will arise, the Registrar hearing the revocation application may rely on or at least refer to the findings on invalidity made by the court in respect of the asserted claims.

129 Looking at the provisions in the Patents Act on the patent application procedure and requirements, amendment procedure, infringement, defences, invalidity and revocation as a whole, and the circumstances prevailing at the time when the Patents Bill was being considered by Parliament in 1994, I am of the view that Prof Jayakumar likely did not have the specific question in mind as to whether the High Court should also possess the jurisdiction to hear and decide revocation proceedings by way of counterclaim where proceedings are already properly before the court when he made his general statements on litigation costs at the second reading of the Patents Bill (see [62] above). In respect of invalidity and revocation, Prof Jayakumar was likely only referring to the desirability of having standalone revocation proceedings commenced at the Registry. As such, I do not consider Prof Jayakumar’s statements to be dispositive or indicative either way on how the present issue on appeal ought to be decided.

130 I look further to consider statements made in later sessions of Parliament that enacted amendments to the Patents Act. During the second reading of the Patents (Amendment) Bill (No 13/2012), Senior Parliamentary Secretary to the Minister for Law, Ms Sim Ann, in expressing the importance of having a system which reduces the occurrence of weak patents, referred to the *ASM* decision as an example of a case where the defendant succeeded in defending an infringement action “and even managed to successfully revoke the *ASM* patent”

(*Singapore Parliamentary Debates, Official Report* (10 July 2012, vol 89) (Ms Sim Ann, Senior Parliamentary Secretary to the Minister for Law)). Her comments were made in the context of the change to a positive grant system. It does not, in my view, assist in determining the question of whether the Patents Act was intended to confer jurisdiction on the High Court to hear revocation applications or to grant an order for revocation in the exercise of its original jurisdiction. Given that the Parliamentary Debates do not shed much light on the question, I turn to the provisions of the Patents Act itself.

*Section 80(1) of the Patents Act*

131 The Plaintiff's core argument rests upon the interpretation of s 80(1) of the Patents Act. Section 80(1) reads:

Subject to the provisions of this Act, *the Registrar* may, on the application of any person, by order revoke a patent for an invention on (but only on) any of the following grounds...

[emphasis added]

132 On a literal and black-letter interpretation of s 80(1), the provision only provides that *the Registrar* may revoke a patent. Section 80(1) is entirely silent as to whether *the court* may do so. The Plaintiff argued that the wording of s 80(1) manifests Parliament's clear intention to restrict revocation proceedings to the Registrar.

133 It is clear that s 80(1) of the Patents Act was based on s 72(1) of the UK Patents Act. The key difference is that s 72(1) of the UK Patents Act expressly provides that the power to revoke a patent on application is enjoyed by both the court *and the comptroller* (the equivalent of the Registrar). The question naturally arises as to why Parliament omitted any reference to the court in s 80(1).

134 The Plaintiff’s submissions highlighted other relevant differences in the Patents Act as compared with the UK Patents Act. It will be recalled that s 82 sets out the proceedings in which validity of a patent may be put in issue. The only reference in s 82 to revocation proceedings is to be found in s 82(1)(d) which only refers to “proceedings before *the Registrar* under section 80 for the revocation of the patent” [emphasis added]. There is no reference at all to revocation proceedings before the court. The UK Patents Act, on the other hand, makes multiple references to revocation before the court or the comptroller. These include ss 72(6) and 72(7) of the UK Patents Act which deal with the situation where an application is made to the court for revocation in circumstances where the comptroller has refused to grant an application or where the comptroller has yet to dispose of the application before him. The Plaintiff’s position is that the absence of any provision in the Patents Act (equivalent to ss 72(6) and 72(7) of the UK Patents Act) touching on the relationship between the court and the Registrar’s power to revoke a patent on application supports the view our Parliament intended for only the Registrar to be able to revoke a patent on application.

135 Nonetheless, it may be argued that s 80(1) by itself simply empowers the Registrar to revoke a patent upon application, but does not necessarily *exclude* the High Court from granting revocation orders on the basis of invalidity. Indeed, I note that s 80(1) is expressly made “[s]ubject to the [other] provisions of this Act”. I therefore look to the other provisions in the Patents Act to consider whether any of these provisions provide a source of the court’s jurisdiction to hear revocation proceedings or to grant a revocation order. The difficulty for the Defendants, however, is that the statutory provisions on applications for revocation in the Patents Act are set out exclusively in s 80. Indeed, there are no other provisions which explicitly mention or refer to the

making of revocation orders by the court in the exercise of its original jurisdiction.

*Section 82(7) of the Patents Act*

136 Section 82(7) of the Patents Act provides that:

Where proceedings with respect to a patent are pending in the court under any provision of this Act mentioned in subsection (1), no proceedings may be instituted without the leave of the court before the Registrar with respect to that patent under section 67(3), 76, 78 or 80.

This provision essentially means that in a case such as the present one where there are already, *inter alia*, infringement proceedings before the court, leave of court is required before revocation proceedings can be commenced before the Registrar in respect of the same patent.

137 The Defendants’ position is that s 82(7) shows that Parliament intended for both the High Court and the Registrar to hear revocation proceedings. Learned counsel for the Plaintiff conceded in written submissions that the inclusion of a provision like s 82(7) “makes sense” in a system where both the court and the comptroller can hear revocation proceedings (see s 74(7) of the UK Patents Act, which is the UK equivalent to s 82(7) of our Patents Act). Where the court and the Registrar both enjoy jurisdiction to hear applications for revocation, provisions would be needed to avoid duplicative proceedings in the two fora.<sup>30</sup> However, the Plaintiff characterised s 82(7) as “a house-keeping provision” which did not assist with the question as to whether the court enjoys a jurisdiction to revoke patents.

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<sup>30</sup> Plaintiff’s submissions, [47].

138 The learned AR’s view was that s 82(7) suggests that where revocation proceedings have been brought as a counterclaim, they should ordinarily be heard by the High Court, unless for some reason the court finds it appropriate that leave should be granted for the Registrar to hear the matter instead (see [44] of the AR’s Judgment). This, it was held, makes practical sense and lends additional support to the view that the High Court may hear revocation proceedings at first instance.

139 In my view, however, s 82(7) still makes sense as a housekeeping provision even if the court does *not* have the jurisdiction to hear revocation applications and grant revocation orders. As issues of validity can arise outside of revocation proceedings, the effect of s 82(7) in preventing or controlling “duplicative” proceedings applies in other situations as well. For instance, where the court is dealing with the issue of validity arising either by way of defence in infringement proceedings or in groundless threat proceedings, it may well be preferable to prevent the defendant from commencing parallel proceedings before the Registrar to revoke the patent until the resolution of the proceedings before the court. I therefore do not read s 82(7) to suggest that Parliament had envisioned that both the court and the Registrar should have original jurisdiction over revocation proceedings.

140 Moreover, as the Plaintiff pointed out, our Patents Act does not contain any provisions akin to s 72(7) of the UK Patents Act which deals with the possibility of parallel proceedings before the court and the Registrar specifically in the context of *revocation*. It will be recalled that s 72(7) provides that a party generally may not make an application to court when there are pending revocation proceedings before the comptroller. This provision may be seen as a counterpart to s 82(7) of our Patents Act, except that it covers situations where proceedings are first commenced before the comptroller rather than the court,



and applies only to revocation proceedings. Viewed this way, the inclusion of s 82(7) in our Patents Act, while omitting any provision similar to s 72(7) of the UK Patents Act, in fact makes it even more likely that Parliament did not intend to vest the court with original jurisdiction to hear and determine revocation applications.

141 It makes eminent sense that s 82(7) requires the leave of the court if an application is to be made to the Registrar under s 80 for revocation. It may frequently be preferable for the court to make its decision on the validity of the asserted claims in the infringement proceedings before an application is made to the Registrar to revoke the patent under s 80. The considerations of the Registrar in revocation proceedings are similar to those which arise when the court is asked to determine whether a defence to infringement based on invalidity can succeed. After all, the grounds of invalidity are the same whether the issue arises by way of a defence to infringement proceedings or in revocation proceedings. In the subsequent revocation proceedings, the Registrar may rely on or at least refer to the court's earlier findings of validity or invalidity, as the case may be. The extent to which the earlier finding is relevant or dispositive will of course depend on the nature (*eg*, validity or invalidity) and scope (*eg*, which claims) of the earlier finding and the specific issues arising in the revocation proceedings. Further, as discussed earlier at [75] to [77] above, the question as to whether the earlier finding by the court on validity has an *in rem* effect may arise.

142 During oral submissions, the Defendants raised the concern that a party may be potentially left without a remedy if the court cannot hear revocation applications and yet denies leave under s 82(7), such that he cannot make a revocation application to the Registrar either. The Defendants argued that it

cannot be the case that the court will always be compelled to grant leave, as this would render s 82(7) otiose.

143 However, I find these concerns to be unfounded. Section 82(7) only applies when proceedings are pending before the court. It will not prevent a party from pursuing revocation in proceedings before the Registrar once the court proceedings are over. Moreover, as I noted at [81]-[83] above, a party who succeeds in obtaining a declaration of invalidity can (and must) always apply to register that order in the patent register to give the public notice of the court's decision. In my view, this would greatly reduce any mischief arising from the court not having the jurisdiction or power to revoke a patent.

144 I note that whether the court should grant leave under s 82(7) will depend on the prevailing facts and circumstances. Whilst this issue is not before this court, I venture to suggest that some factors relevant to the court's discretion include:

- (a) whether the applicant seeking leave to bring s 80 proceedings is the defendant;
- (b) whether the ground of invalidity relied on in the infringement proceedings overlaps with the ground relied on in the proposed application for revocation; and
- (c) the extent to which the claims whose validity has been placed in issue in the existing proceedings before the court overlap with or are co-extensive with the claims in the patent as a whole.

The last factor may be especially significant given the finding of the AR (not appealed) that only the asserted claims can be put before the court in deciding

whether a defence has been made out and whether a claim for groundless threats succeeds.

145 Returning to the main issue at hand, I am of the view that s 82(7) is not conclusive on the question of jurisdiction and provides little assistance to the Defendants. Indeed, when read in the light of the other provisions touching on invalidity as a defence to infringement proceedings, including the absence of any provision equivalent to ss 72(6) and 72(7) of the UK Patents Act, s 82(7) is equally consistent with the view that the court was not intended to and does not enjoy the jurisdiction to hear applications for revocation by way of an exercise of original jurisdiction.

*Section 91(1) of the Patents Act*

146 I next turn to consider whether s 91(1) of the Patents Act supports the Defendants' position that that the High Court possesses original jurisdiction to hear and decide applications for revocation. Section 91, which is titled "General powers of the court", provides that:

(1) The court may, for the purpose of determining any question in the exercise of its original or appellate jurisdiction under this Act, make any order or exercise any other power which the Registrar could have made or exercised for the purpose of determining that question.

147 Prof Ng-Loy SC's view, as set out in her footnote n 5 to para 30.0.6 of *Law of IP*, is that "[t]he power of the High Court to hear revocation proceedings is found in s 91(1)."

148 The Defendants submitted that s 91(1) confers upon the High Court the right to make any order or exercise any power which the Registrar enjoys in determining a question in the exercise of its original or appellate jurisdiction,

including the Registrar’s power to revoke a patent on any of the grounds stipulated in s 80(1). The Defendants argued that this presents a plausible explanation for why Parliament decided to omit the reference to the court in s 80(1). The reference would have been unnecessary considering the High Court’s general powers provided for in s 91(1).

149 The Plaintiff’s position is that s 91(1) only confers upon the High Court the *powers* that the Registrar would have in determining any issue, and not the *jurisdiction* to hear any matter over which the Registrar has jurisdiction.

150 In this regard, the Plaintiff cited *Re Nalpon* at [31] for the proposition that the jurisdiction of a court is to be distinguished from its powers. Even though *Re Nalpon* dealt with the jurisdiction of the Court of Appeal to entertain an appeal against a decision refusing leave for an investigation to be made into a complaint of misconduct against a legal service officer, the principles discussed are of general application. The Court of Appeal at [14] confirmed as settled law the principle that the jurisdiction of a court must be conferred by the statute constituting it.

151 It follows that it is only after jurisdiction is established that the court’s power can be exercised (*Re Nalpon* at [45]). In coming to this conclusion, the Court of Appeal discussed at length the distinction between jurisdiction and powers. The Court of Appeal also examined the concept of “inherent jurisdiction” and “inherent powers” as set out in O 92 r 4 of the ROC (at [39]-[40]). The key point made by V K Rajah JA at [41] after a detailed review of the authorities was that for conceptual clarity, it was “preferable to refer to the exercise of [the] right to regulate matters properly before the court as the exercise of the court’s inherent powers rather its inherent jurisdiction”.

152 The Plaintiff’s case is that the High Court does not have jurisdiction under s 80 to hear and decide applications at first instance for revocation. Revocation is not a “matter” that is “properly before the court”. In coming to my decision, I reiterate that the only statutory provision in the Patents Act dealing with revocation is s 80, which is titled “Power to revoke patents on application”. Section 91(1) goes on to deal with the general powers of the court in respect of any question in the exercise of its original or appellate jurisdiction under the Patents Act. It is true that the High Court has been provided with right to make any order or exercise any power which the Registrar possessed for determining the *same* question. But this does not address the even more fundamental question of what the original and appellate jurisdiction conferred on the court under the Patents Act is. Is revocation a matter that is properly before the court in the first place?

153 The Patents Act, as discussed earlier, contains complicated and often interlocking provisions on the types of proceedings which may be brought under the Act and what might loosely be described as the “roles” of the court and Registrar. The issues concerning the original and appellate jurisdiction of the High Court under the Patents Act and whether revocation proceedings fall within the High Court’s original jurisdiction demand careful consideration in the light of the principles confirmed or established by *Re Nalpon*.

154 For avoidance of doubt, it is clear that the High Court can determine questions on revocation under s 80 in the exercise of its *appellate* jurisdiction over decisions of the Registrar. Where the High Court hears an appeal against a Registrar’s decision under s 80 there is no doubt that the High Court has the power to make any order and to exercise any power that the Registrar possesses under s 80.

155 The basis for the High Court’s appellate jurisdiction is straightforward. As pointed out above, *Re Nalpon* at [14] states that “[i]t is settled law that the jurisdiction of a court must be statutorily conferred *by the statute constituting it*” [emphasis added]. In this regard, the Court of Appeal was referring to Supreme Court of Judicature Act (Cap 322, 2007 Rev Ed) (“SCJA”), which established the jurisdiction of the High Court (at [25]). Section 20 of the SCJA sets out the High Court’s appellate civil jurisdiction, which includes “(c) the hearing of appeals from other tribunals as may from time to time be prescribed by any written law”. This includes the court’s appellate jurisdiction over decisions made by the Registrar at first instance under the Patents Act. Indeed, s 90(1) of the Patents Act expressly provides for the right of appeal of decisions of the Registrar to the High Court. But the much trickier question is what the *original* jurisdiction of the High Court encompasses in respect of the various matters and proceedings dealt with under the Patents Act.

156 It is clear that the High Court is seised of jurisdiction under s 16 of the SCJA which provides for the court’s general civil jurisdiction to hear actions *in personam*. Yeo Tiong Min SC, “Jurisdiction of the Singapore Courts” in *The Singapore Legal System* (Kevin YL Tan ed) (Singapore University Press, 2nd Ed, 1999) at p 257 further explains that s 16 of the SCJA confers both *in personam* jurisdiction and unlimited subject matter jurisdiction on the High Court.

157 It will be recalled that an action for infringement is a claim by the proprietor of the patent against the defendant *in personam* (see [75] above). The patent in issue would of course be a Singapore patent secured by grant in Singapore. Where infringement proceedings have been brought, the patent would already be before the High Court. It follows that the defendant would

have the express right to defend the proceedings by raising the issue of validity of the *res*, the rights in which would be relied upon in the action.

158 A claim for patent revocation goes beyond a defence to an *in personam* claim for infringement. It involves the determination of the status of a *res* or thing, for the very purpose of removing it from the register and depriving the patentee of the rights *in rem* bestowed on him as against the world. As Lord Neuberger stated at [49] in *Virgin Atlantic*, the effect of revocation is that everyone is entitled to conduct their affairs as if the patent had never existed. That being so, jurisdiction *in rem* is necessary.

159 There is thus a distinction between raising invalidity as a defence in an infringement action (and likewise, in a claim for groundless threats) and in proceedings to revoke the patent. The fact that the High Court has jurisdiction to hear a claim concerning infringement of the exclusive rights conferred by the patent or a claim against the proprietor of the patent, in circumstances where the validity of the patent is raised as a defence, does not necessarily mean that the High Court has the jurisdiction or power to hear *all* proceedings, disputes and issues arising under the Patents Act including those which seek the revocation of the patent.

160 Returning to the SCJA, s 16(2) provides that “[w]ithout prejudice to the generality of subsection (1), the High Court shall have such jurisdiction as is vested in it by any other written law.”

161 As discussed above, the Patents Act confers original jurisdiction on the High Court to hear certain proceedings. These include, for example, proceedings: (i) for infringement (s 67); (ii) for groundless threats of suit (s 77(1)); (iii) on disputes as to Government use (s 58); (iv) in respect of

compulsory licences (s 55); and (v) for the rectification of entries in the patent register (s 44).

162 Reference has already been made to the complex web of provisions in the Patents Act, many of which are concerned with the procedure for applying and obtaining grant of a patent in Singapore. These are necessarily detailed and deal with a broad range of matters such as those relating to state of art, examination reports, patentability as well as provisions on the procedural interface between international applications and entry into national phases of examination and grant. Other provisions deal with property rights and the requirement to register certain transactions in the patent register. There are also detailed provisions on matters pertaining to the amendment of patent applications and patent specifications whether before or after grant, revocation of patents and, of course, proceedings for infringement and remedies.

163 It is no surprise that disputes under the Patents Act cover a vast range of issues. Some disputes may be between the applicant for a patent and the Registrar. Other disputes will concern issues that arise between the patent proprietor and/or his exclusive licensee and third parties, such as actions for infringement and applications under s 80 for revocation. In many of the disputes, the question of validity will be in issue.

164 The fact that the Patents Act contains numerous, complex and sometimes overlapping substantive provisions on validity in respect of a range of different proceedings is a reflection of the complex nature of a patent system which needs to meet and serve numerous interests and concerns. Parliament, in enacting Patents Act, was clearly cognisant of the need to demarcate and to set out the roles of the Registrar and the High Court in respect of the different issues, disputes and proceedings which can arise under the Act. As pointed out



above, this includes providing clear and efficient procedures by which the validity of a registered patent can be put in issue and challenged post-grant including by means of an application to revoke a patent.

165 The result is to be found in s 80, which is framed to cover revocation proceedings by way of application *to the Registrar*. As explained, the fact that Parliament expressly conferred the right to hear revocation applications on the Registrar is not surprising. The Patents Act, as discussed, replaced the old re-registration system under the RUKPA with a brand-new system dependent upon application, examination and grant in Singapore. It would be surprising if Parliament had decided to vest the right to hear and decide revocation applications in the High Court to the exclusion of the Registrar. That is, of course, not the position under Patents Act. The statutory provisions and procedure on revocation, as we have seen, are directed towards the Registrar. These include important provisions on re-examination by patent examiners. The application is to the Registrar and must be in the prescribed form. There is no prescribed form covering an application to the court. Indeed, the Registrar also has an independent power (not dependent on any application) under s 81 to revoke a granted patent, albeit only on the limited ground that the invention forms part of the state of art by reference to matter contained in another patent application that was published after the priority date of the invention in issue.

166 The Patents Act expressly provides the High Court with an appellate jurisdiction over many decisions of the Registrar, including decisions made by the Registrar under s 80. This is a good reason for providing that the High Court in exercising its appellate jurisdiction has the same *powers* as the Registrar. This does not, however, mean that the High Court enjoys *original jurisdiction* to hear applications under s 80 or power to grant an order for revocation by way of a counterclaim in an infringement suit.

167 In the absence of any express statutory provision conferring original jurisdiction upon the court to hear revocation proceedings (by application) or grant a prayer for revocation whether or not by way of counterclaim in infringement proceedings, I find that the High Court has no such jurisdiction to do so. Accordingly, no powers of the Registrar in respect of application for patent revocation under s 80 are vested in the court by virtue of s 91(1).

168 In coming to this decision, I have noted that the Defendants were not making an application to the court under s 80 as such. Instead, what was pleaded in the counterclaim was (i) a general averment of invalidity; and (ii) a consequential prayer for an order that the patent be revoked. Would it make any difference if the order of the court is simply an order that the patent is to be revoked by the Registrar? Might it be said that the court is not purporting to revoke the patent, but instead merely ordering that steps be taken to secure the revocation? In any case, it begs the question: against whom is the order being made and who is to take the necessary steps? It might be argued that an order against the patentee to take steps to secure the revocation of the patent in suit would operate only *in personam* rather than *in rem*. But such an order seems to me to be rather strained, and strikes me as an artificial way for the court to circumvent its lack of jurisdiction to make an order that is indisputably of an *in rem* nature.

169 An order that a patent is to be revoked is clearly one that is made *in rem* and good against the world. Given the differences between the nature of proceedings for infringement and groundless threats on the one hand, and that of revocation proceedings on the other, it follows that the court must have original jurisdiction to hear and determine revocation proceedings if an order for revocation is to be made. The decision I have come to, with some difficulty, is that the court does not have such original jurisdiction.

*Procedural requirements under the Patents Act and Patent Rules*

170 Further, as mentioned at [100]-[101] above, s 80(9) of the Patents Act sets out the procedure for making an application for revocation under s 80. In particular, s 80(9)(a) requires the application to be made in the prescribed form and filed at the Registry in the prescribed manner as specified under the Patent Rules. In my view, these required forms and procedures, as well as the power of the Registrar to require the patent to be sent for re-examination by patent examiners (see s 80(2)), do not sit comfortably with the assertion that the court may order revocation simply on the back of a plea of invalidity in the counterclaim.

171 On a different note related to procedure under the Patents Rules, the point has been made above at [81]-[83] that the Rules require the entry into the register of orders and directions made by the court in relation to the patent. The person in whose favour the court's order or direction is made has the task of making the application to enter a record of the order or direction (r 64(1)(a)). This certainly does not mean that the court must be taken to have the jurisdiction or power to make revocation orders. It will be recalled that r 55(3)(j) which requires the entry in the register of a *decision* revoking the patent is separate from r 55(3)(k) which requires the entry of any *court order* in relation to the patent. It is clear that when the court makes a finding of invalidity in respect of the asserted claims (whether by way of defence in infringement proceedings or proceedings for groundless threats) and grants a declaration of invalidity, the order (*ie*, the declaration of invalidity) shall be entered in the register against the patent. An order declaring the asserted claims invalid is, of course, not the same as an order for the revocation of the patent.

*Comparisons to the statutory regimes on registered designs and trade marks*

172 Finally, I look beyond the patent system to draw some comparisons between the Patents Act and legislation protecting other intellectual property rights such as registered designs and trademarks.

173 The Registered Designs Act (Cap 266, 2005 Rev Ed) (“RDA”) provides for the registration system for protecting industrial designs. Prior to the RDA, the principal law on industrial designs in Singapore was to be found in the UK Designs (Protection) Act (Cap 339) (“UKDPA”). The system of industrial protection under the UKDPA was similar to the re-registration system for patent under the RUKPA. Designs registered in the UK would acquire the corresponding rights and privileges in Singapore. But unlike with the RUKPA, there was no need to even formally re-register the design in Singapore. The original enactment of the RDA in 2000 repealed the UKDPA and set up Singapore’s first national registration system to protect industrial designs.

174 Under the RDA, there is no substantive pre-grant examination requirement. The provisions on revocation are different than those found in Patents Act. Section 27 of the RDA provides:

(1) At any time after a design has been registered, any interested person may apply to the Registrar or the Court for the revocation of the registration of the design on the ground that the design was not, at the date of its registration, new, or on any other ground on which the Registrar could have refused to register the design; and the Registrar may make such order on the application as he thinks fit.

(2) At any time after a design has been registered, any interested person may apply to the Registrar or the Court for the revocation of the registration... and the Registrar may make such order on the application as he thinks fit.

(3) If proceedings concerning a design are pending in the Court, an application for the revocation of its registration must be made to the Court.

(4) If an application for the revocation of the registration of a design is made to the Registrar, he may at any time refer the application to the Court.

(5) An application to the Registrar for the revocation of the registration of a design shall be made in the prescribed manner and be accompanied by the prescribed fee.

175 It is not necessary to engage in a detailed discussion of the grant procedure and revocation applications set out in the RDA. Fuller treatment of the grant and revocation procedures may be found in the monograph written extra-judicially: George Wei Sze Shun, *Industrial Design Law in Singapore* (Academy Publishing, 2012) at paras 2.246 and 6.47 to 6.62. The point of interest is that s 27(2) of the RDA makes it expressly clear that revocation applications may be brought before “the Registrar *or the Court*” [emphasis added], unlike s 80(1) of the Patents Act. The provisions also leave no room for any doubt that where proceedings concerning a design are pending before the court, an application for revocation can only be made to the court (s 27(3)). It is further made clear that it is only when the application is made to the Registrar for revocation that the application is to be made in the prescribed manner (s 27(5)).

176 The provisions set out in s 27 of the RDA are not decisive or directly relevant to the matter before me. But a comparison between these provisions and s 80 of the Patents Act provides some support for the decision that the High Court does not have the original jurisdiction under the Patents Act to hear revocation applications or to make an order for revocation, given the absence of equivalent provisions in the Patents Act.

177 Further, s 27(2) of the RDA recognises that applications for revocation made be made either to the Registrar or the High Court, but only provides that “*the Registrar* may make such order on the application as he thinks fit”

[emphasis added]. Although this issue is certainly not before me, the omission of any reference to the courts in this regard might suggest that revocation orders are to be made by the Registrar only. On the issue, I merely make the observation that such a position would align with the outcome of the present case in the context of the patent system, in that any revocation order must ultimately be made by the Registrar rather than by the court.

178 Next, I note that the Trade Marks Act (Cap 332, 2005 Rev Ed) (“TMA”) contains detailed provisions on (i) pre-grant opposition; (ii) declaration of invalidity of registration; and (iii) revocation. The short observation is that ss 22(5) and 23(5) of the TMA, like s 27(2) of the RDA, expressly provide that applications for declaration of invalidity and for revocation may be made “either to the Registrar *or to the Court*” [emphasis added]. Again, I note that there is no equivalent provision in the Patents Act. Opposition proceedings under s 13 of the TMA, however, are before the Registrar or appointed person with an appeal to the High Court. The High Court does not have original jurisdiction over opposition proceedings.

*Further remarks and observations*

179 Finally, for the sake of completeness, I note several further issues that may have arisen from counsel’s oral arguments and written submissions. Whilst the Plaintiff has succeeded on appeal in this challenge to jurisdiction, I take this opportunity to set out some general observations on patent claims.

180 First, as a matter of civil procedure, there is no distinction between the court’s jurisdiction over claims and counterclaims. Both are proceedings which involve the exercise of the court’s original jurisdiction. The subject matter and relief sought by way of counterclaim could well have been brought as a claim

in proceedings instituted by the defendant. It has been suggested that a distinction might be drawn under the Patents Act between (i) the High Court having jurisdiction to hear revocation proceedings by way of counterclaim in an infringement action; and (ii) the High Court having and exercising jurisdiction to hear revocation proceedings on a standalone basis (see [43] of the AR's Judgment). Even if the High Court possesses original jurisdiction to hear revocation proceedings, the practice has been for standalone applications to be heard first by the Registrar. Whilst this may well have been the practice, there is no need to consider this point any further given the decision that I have reached on the High Court's jurisdiction.

181 My second set of observations relates to the fact that patent specifications will frequently comprise numerous claims.

182 The proprietor of a patent may only choose to assert some of the claims granted in respect of the patent in suit. This is the distinction made between the asserted and unasserted claims. It will be recalled that the learned AR below held that where validity has been put in issue by way of a defence or in connection with a claim for groundless threats of proceedings, it is only the validity of the asserted claims that is properly before the court.

183 It will also be recalled that the Plaintiff amended its striking-out application in respect of para 16 of the Defence and Counterclaim. The Plaintiff accepted that where revocation proceedings have been properly instituted before the Registrar, the whole patent (*ie*, all claims) can be put in issue.

184 Where revocation proceedings are brought under s 80 of the Patents Act, there is the possibility that a ground of invalidity will be found to only invalidate the patent to a limited extent. In such cases, as mentioned above, provisions

such as s 80(5)(b) are important in that the Registrar is to provide the patent proprietor with an opportunity to amend the specification to the Registrar's satisfaction in order to prevent the revocation of the patent.

185 It is worth making the general point that the Patents Act requires that the claims must be related (see s 25(5)(d) which provides that claims must “relate to one invention or to a group of inventions which are so linked as to form a single inventive concept”). Rule 25(1) of the Patents Rules titled “Unity of invention” states that “where 2 or more inventions are claimed (whether in separate claims or as alternatives within a single claim), such inventions shall be treated as being so linked as to form a single inventive concept only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features”. “Special technical features” are defined in r 25(2) as meaning “those technical features which define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.”

186 The point rightly made by counsel in oral arguments and written submissions is that each claim is independent and the validity of each claim must be considered in its own right.

187 For example, just because the validity of a claim has been successfully challenged or found wanting, it does not follow that the other claims must also be wanting and invalid. Each claim must be assessed on its own and in light of the patent as a whole. Further, just because the patent specification does not disclose the invention set out in a particular claim clearly and completely (such as to enable the person skilled in the art to perform the claimed invention) does not mean that the same must be true of another claim which relates to the same



inventive concept but which is framed in terms which sufficiently disclose the invention in the specification.

188 Indeed, even when a claim is invalid because it falls within the prior art and lacks novelty, or is so close to the prior art that it lacks an inventive step, this does not necessarily mean that another claim, perhaps framed in narrower terms, will suffer the same fate. That claim, whilst it may relate to the same inventive concept, might be framed in a sufficiently distinct manner such as to take it out of or further away from the prior art. For example, the invention as set out in another claim may include a different or extra integer or includes certain parameters sufficient to take the claimed invention out of the prior art.

189 Of course, not all additions or changes that are sufficient to avoid a finding of anticipation will avoid a finding of obviousness (*ie*, lack of inventive step). Novelty and inventive step are distinct requirements. A slight change, perhaps to a single element, may or may not be sufficient to support a finding of inventive step. Nonetheless, the closeness or proximity of a claimed invention to the prior art will undoubtedly focus the mind even more sharply on the question of obviousness.

190 The general observation is that care is needed whenever issues of invalidity are raised whether in the court or before the Registrar. What are the grounds of invalidity relied on and in respect of which patent claims and in what type of proceedings? What is the question or matter in the proceedings which requires an assessment of validity? This is the backdrop against which the various statutory provisions in issue were construed in reaching my decision on the original jurisdiction of the High Court to hear revocation proceedings. This backdrop is important since revocation and validity issues concern the patent as a whole, whereas validity issues by way of defence or groundless threats of suit

are limited to the asserted claims only – although, of course, in some cases the patent owner may be asserting all the claims in the infringement action.

## **Conclusion**

191 For the foregoing reasons, the Plaintiff succeeds in the appeal.

192 I find that the High Court does not possess original jurisdiction under the Patents Act to revoke a patent by way of a counterclaim in infringement proceedings.

193 It also follows that the Defendants’ prayer for a declaration that the patent as a whole is invalid, is too broad and must be limited to the asserted claims the validity of which has been put in issue by way of the defence and the counterclaim for groundless threats of suit.

194 I, therefore, make the following orders:

(a) Paragraph 16 of the Defence and Counterclaim shall be amended to read:

16. The Defendants aver that claims 1, 3, 4, 5, 7, 9, 10 and 11 of the Patent ~~has~~ have always been invalid for the reasons set out in the Particulars of Objection served herewith.

(b) Prayer 2 in the Defence and Counterclaim for “[a]n order that the Patent be revoked” shall be struck out.

(c) Para 1 of the Particulars of Objection shall be amended to remove all references to the invalidity of the unasserted claims and revocation.

(d) The Plaintiff is entitled to costs. Unless the parties reach an agreement, I will hear the parties on costs.

195 In the light of my decision and the orders I have made together with the decision below by the AR on the asserted claims in the context of the defence of invalidity and the counterclaim for groundless threats of proceedings, the Defendants may well consider what amendments (if any) are needed to the Defence and Counterclaim so that the pleadings are consistent with the decisions below and before me.

196 I acknowledge and thank learned counsel for their assistance on an important and complex issue of jurisdiction under the Patents Act which has not previously been raised or argued before the Singapore courts.

197 The decision will be of concern to all who are interested in Singapore's patent system and procedures and the public at large. Indeed, there is much to be said for consideration anew, at the appropriate time, of the court's jurisdiction and the patent procedures in this regard by the relevant law reform body and by Parliament.

George Wei  
Judge

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