Re Platts-Mills Mark Fortescue QC
[2005] SGCA 57

Case Number : CA 103/2005

Decision Date : 06 December 2005

Tribunal/Court : Court of Appeal

Coram : Andrew Ang J; Chao Hick Tin JA; Yong Pung How CJ

Counsel Name(s) : Tony Yeo, Joanna Koh and Rozalynne Asmali (Drew and Napier LLC) for the appellant; Ponnampalam Sivakumar (Joseph Lopez and Co) for the respondents; Lau Kok Keng for the Law Society of Singapore; Jeffrey Chan and Dominic Zou for the Attorney-General

Parties : —

Legal Profession – Admission – Ad hoc – Queen's Counsel applying for admission to Singapore Bar on ad hoc basis to appear in matter to be heard before Court of Appeal – Whether issues of sufficient difficulty and complexity existing – Whether to allow application – Section 21(1) Legal Profession Act (Cap 161, 2001 Rev Ed)

6 December 2005

Yong Pung How CJ (delivering the judgment of the court):

1 This was an appeal against the decision of Judith Prakash J ("the judge"), wherein she granted the application of Mr Mark Fortescue Platts-Mills QC ("Mr Platts-Mills") to be admitted as an advocate and solicitor of the Singapore Bar for the purpose of appearing as counsel on behalf of FE Global Electronics Pte Ltd, Electec Pte Ltd and M-Systems Flash Disk Pioneers Ltd (collectively "the respondents") in Civil Appeals Nos 127 of 2004 and 70 of 2005. At the conclusion of the hearing before us, we allowed the appeal. We now give our reasons.

Background

2 The respondents commenced an action against Trek Technology (Singapore) Pte Ltd ("the appellant") in Suit No 604 of 2002 for groundless threats of infringement proceedings and for the revocation of the appellant's patent for a portable computer data storage device ("the Patent"). Thereafter, the appellant commenced Suit No 609 of 2002 against the respondents, alleging that the respondents had infringed the Patent. The respondents were the manufacturers and distributors of a similar data storage device.

3 Both actions were consolidated and heard before Lai Kew Chai J between 12 April 2004 and 5 May 2004. The appellant was represented by Mr Davinder Singh SC, Mr Tony Yeo and Ms Joanna Koh, while the respondents were represented by Mr Ponnampalam Sivakumar and Mr Daryl Ong. During the course of the trial, there was an application by the appellant for leave to amend the Patent by reason of the discovery of certain prior art. In addition, the respondents applied for leave to adduce further evidence after the trial had concluded but before Lai J rendered judgment. The latter application was refused.

4 On 12 May 2005, judgment in the consolidated actions was pronounced in favour of the appellant. Lai J found that the Patent was valid and had been infringed by the respondents, and allowed the appellant's application to amend the Patent. The respondents' claim for groundless threats of infringement and for a declaration that the appellant's Patent was invalid were accordingly dismissed.

5 The respondents filed appeals against Lai J's decision. Civil Appeal No 127 of 2004 was their appeal against Lai J's decision to disallow the admission of further evidence, and Civil Appeal No 70 of 2005 was their appeal against Lai J's decision in respect of the Patent. Mr Platts-Mills applied for admission to the Singapore Bar on an *ad hoc* basis under s 21 of the Legal Profession Act (Cap 161, 2001 Rev Ed) ("the LPA") for the purpose of representing the respondents in respect of these appeals.

The decision below

6 The judge held that it was common ground that a three-stage test would be applied in considering applications made under s 21 of the LPA, to wit:

(a) Whether the case contained issues of fact or law of sufficient difficulty and complexity to justify the admission of a Queen's Counsel.

(b) Whether the circumstances of the case warranted the court's exercise of discretion in favour of the applicant.

(c) Whether the applicant was a suitable candidate for admission.

7 In relation to the first stage of the test, the judge pointed out that counsel for the respondents had listed the following issues as being difficult and complex:

(a) How the claims of the Patent should be construed and how the Patent as a whole should be construed in the light of the guidance given by the recent judgment of the House of Lords in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9 ("the first issue").

(b) What factors had to be taken into account by a court in deciding whether to allow a patent to be amended after it had been granted and, in particular, what the correct approach to such an application should be, given that the approach taken by Lai J was inconsistent with the approach hitherto taken by the English Court of Appeal ("the second issue").

(c) What test had to be applied in order to make a foreign manufacturer of a product liable for patent infringement in Singapore as a joint tortfeasor with the local retailer, where the foreign manufacturer did not itself make direct sales of the infringing product within the jurisdiction ("the third issue").

(d) How s 77 of the Patents Act (Cap 221, 2002 Rev Ed) ("the Patents Act") in respect of an action for a groundless threat of patent infringement should be interpreted and, in particular, what statements could be made by a Singapore patentee, when issuing letters to other parties in Singapore regarding the grant of a Singapore patent, without rendering itself liable to an action for damages pursuant to this section ("the fourth issue").

8 The judge also considered a fifth issue brought up by the respondents during oral arguments before her. This was whether the existence of a hyperlink on the website of a foreign manufacturer, which directed interested parties to the website of the Singapore distributor from whom they could buy the products in Singapore, meant that the foreign manufacturer was making an "offer to dispose" of the goods in Singapore within the meaning of s 66 of the Patents Act and could thus be held liable for direct infringement of the Patent ("the fifth issue"). Although the judge did not list this as a separate issue in her Grounds of Decision, she was essentially of the view that the issues delineated by the respondents were of varying degrees of difficulty, the most difficult and complex issues being

the second and the fifth issues. The judge emphasised that the case nevertheless had to be looked at in its full context. The difficulty and complexity of the case as a whole was increased by the fact that counsel would have to deal with all the issues in relation to a complex set of acts arising out of a lengthy trial involving several experts. The judge was therefore satisfied that the issues were of sufficient complexity and difficulty to justify the admission of a Queen's Counsel.

9 Turning to the second stage of the test, the judge found that the circumstances did justify the admission of Mr Platts-Mills. First, she considered the fact that Mr Platts-Mills was already conversant with the issues and the facts of the case, as he had earlier represented the third respondent in contested proceedings to revoke the appellant's UK patent which had been derived from the same patent application as that for the Patent. The judge was of the view that this was an advantage not only to the respondents, but also to the court.

10 The judge also found relevant the circumstance that the invention involved in this case was a type of product that was sold all over the world by different manufacturers, such that there would be international interest in the way in which the Patent was interpreted and in the guidance given by the court on how the actions of manufacturers overseas would be regarded in terms of infringing patents registered in Singapore. Further, the judge considered that since patent law in Singapore was still in a stage of development, foreign counsel could be of great assistance to our courts as they sought to develop this area of the law.

11 The judge also took the view that the occasional admission of a Queen's Counsel in the right case would not damage the development of the local Bar, but would instead enhance its independence and competence.

12 Turning to the third stage of the test, the judge pointed out that it was not disputed that Mr Platts-Mills possessed the special qualifications and the experience required to represent the respondents in their appeals. As the judge found that Mr Platts-Mills had satisfied the three-stage test for admission, she granted the application for admission.

The appeal

13 The relevant legislation in this case is s 21(1) of the LPA as amended by Act No 10 of 1991. Section 21, as amended, reads as follows:

> Notwithstanding anything to the contrary in this Act, the court may, for the purpose of any one case where the court is satisfied that it is of sufficient difficulty and complexity and having regard to the circumstances of the case, admit to practise as an advocate and solicitor any person who —
>
> (*a*) holds Her Majesty's Patent as Queen's Counsel;
>
> (*b*) does not ordinarily reside in Singapore or Malaysia but who has come or intends to come to Singapore for the purpose of appearing in the case; and
>
> (*c*) has special qualifications or experience for the purpose of the case.

Section 21(1) in its original form provided for the admission for the purpose of any one case of any person who held Her Majesty's patent as Queen's Counsel, who did not ordinarily reside in Singapore or Malaysia but who had come or intended to come to Singapore for the purpose of appearing in the case, and who had special qualifications or experience for the purpose of the case. Further

restrictions were therefore added by the amendment: the admission of Queen's Counsel is now allowed only if the court is satisfied that the case is of sufficient difficulty and complexity and having regard to the circumstances of the case.

14 It is clear to us that the object of the amendment to the LPA was to promote the development of the local Bar. Chan Sek Keong J (as he then was) in *Re Oliver David Keightley Rideal QC* [1992] 2 SLR 400 at 402, [8] stated that the object of the amendment was to:

> lay the foundation for the development of a strong local bar by the imposition of more stringent conditions for the admission of Queen's Counsel to appear in our courts, but at the same time, to continue to allow litigants to avail of their services in appropriate cases.

This court had also stated in *Price Arthur Leolin v AG* [1992] 2 SLR 972 at 975, [5] that the objective of the amendment was to "help the development of a strong core of good advocates at the local bar by restricting access to Queen's Counsel only in the more difficult and complex cases". This was reiterated in *Re Howe Martin Russell Thomas QC* [2001] 3 SLR 575 at [4].

15 The difficulty and complexity of a case is not in and of itself decisive of the question whether a Queen's Counsel should be admitted. It has to be weighed against the availability and calibre of local counsel. Hence, the use of the word "sufficient" in s 21 of the LPA. Where there is a dearth of local expertise in any given area, even a moderately difficult or complex case may warrant the admission of a Queen's Counsel. *Per contra*, a Queen's Counsel ought not to be admitted no matter how difficult and complex a case is unless no local counsel is able and willing to take the case. Choo Han Teck JC (as he then was) put it most aptly when he said in *Re Gyles QC* [1996] 2 SLR 695 at 700, [13] that:

> [I]t is … necessary to consider the ability and availability of local counsel when measuring the degree of difficulty and complexity of the case in question. In other words, if local counsel is ready and able to handle the difficulty and complexity of any given case, there would be little justification in admitting a Queen's Counsel to appear instead.

It is our opinion that it will only be in the most exceptional circumstances that a case is so difficult and complex that no local counsel in Singapore is able and willing to take the case.

16 The present case was not such a case. The issues which the judge felt were the most difficult and complex, *viz*, the second and the fifth issues, were issues which local counsel were competent to address. The respondents submitted that the second issue, that of the test to be applied for the amendment of a patent after it had been granted, was an issue that had not been adjudicated upon previously in Singapore. The mere fact that there is no local decision on a particular issue does not, however, *per se* turn that issue into a complex or difficult one: *Re Howe Martin Russell Thomas QC*. In the present context, the issue of amending a patent after it has been granted has been previously decided by the UK courts and there is a whole body of foreign case law in this area. It would therefore be open to local counsel to submit on the relevant foreign case law and for our courts to then decide whether such case law should apply in Singapore. The fact that the determination of the second issue would have a great impact on all patent holders in Singapore also did not in itself mean that the issue was thus one which local counsel could not address competently.

17 As for the fifth issue, that of whether the existence of a hyperlink on the website of a foreign manufacturer meant that he was making an "offer to dispose" of the goods in Singapore, the respondents argued that this was an issue which had never been adjudicated upon anywhere in the world, and that the commercial ramifications of the decision would be enormous as it would impact on

all forms of Internet marketing. Nevertheless, we were of the view that this did not render the case so difficult and complex that no local counsel in Singapore would be able to take it on. We were fortified in our view by the fact that local counsel dealt with this issue at the trial below without the assistance of foreign counsel. We saw no reason why local counsel could not adequately address the same issue when it came on appeal before this court.

18 Ultimately, we were cognizant of the fact that the standard of the local Bar has increased over the years. As Lai Kew Chai J succinctly stated in *Re Flint Charles John Raffles QC* [2001] 2 SLR 276 at [9]:

> After nearly a decade of the working out of s 21(1) of the Act, it is in my view fair to say that the local Bar has matured and is acquitting itself commendably. There has been forged and carefully nurtured, particularly over the last ten years, a body of Senior Counsel, potential senior counsel and an impressive group of young advocates and solicitors, both in the public service and in the private sector, with excellent academic credentials and a right attitude.

There is no reason why these lawyers should not be able to deal with the issues arising in the respondents' appeals, complex though some of them may be. Moreover, this will not be the first time that local counsel have had to deal with complex factual issues concerning patent infringement. We note that the four patent infringement cases which were heard most recently by the Court of Appeal – namely, *Merck & Co Inc v Pharmaforte Singapore Pte Ltd* [2000] 3 SLR 717; *Genelabs Diagnostics Pte Ltd v Institut Pasteur* [2001] 1 SLR 121; *Bean Innovations Pte Ltd v Flexon (Pte) Ltd* [2001] 3 SLR 121 and *Peng Lian Trading Co v Contour Optik Inc* [2003] 2 SLR 560 – were all argued entirely by local counsel.

19 In the present case, we also took into account the fact that the respondents had already sought the assistance of Mr Platts-Mills in drafting the Appellant's Case in the substantive appeals. Our courts have often expressed the view that even if complex issues are raised in any one case, local counsel should be able to address the court adequately on these issues with the assistance of written advice from Queen's Counsel: *Re Oliver David Keightley Rideal QC* ([14] *supra* at 406, [24]); *Re Gyles QC* ([15] *supra* at 698, [5]). In such circumstances, we did not think that it was necessary for Mr Platts-Mills to appear before the Court of Appeal for the purpose of the respondents' appeals.

20 We therefore came to the conclusion that the issues were not of sufficient difficulty and complexity to require the admission of a Queen's Counsel, as local counsel should be well able to handle the case. We felt that it was in fact desirable that local counsel should be offered the opportunity to develop their skills in an area of law which they have hitherto not had much exposure to.

Conclusion

21 In the result, the appeal was allowed with costs here and below. We also ordered the security deposit to be released to the appellant.