

Dextra Asia Co Ltd and Another v Mariwu Industrial Co (S) Pte Ltd  
[2005] SGHC 85

**Case Number** : Suit 641/2004, SIC 1509/2005  
**Decision Date** : 28 April 2005  
**Tribunal/Court** : High Court  
**Coram** : Vincent Leow AR  
**Counsel Name(s)** : Cindy Quek Soon Bee (Shook Lin and Bok) for the plaintiffs; Kalaiselvi d/o Singaram (Infinitus Law Corporation) for the defendants  
**Parties** : Dextra Asia Co Ltd; Dextra Manufacturing Co Ltd — Mariwu Industrial Co (S) Pte Ltd

28 April 2005

**Assistant Registrar, Mr Vincent Leow:**

**A. Introduction**

1 The defendants took out an application to re-amend their amended defence to include further instances of prior art in their amended particulars of objections to substantiate their case that the plaintiffs' patent, under which the plaintiffs had sued the defendants on the basis of infringement, was invalid. I granted the amendment and counsel for the plaintiffs then sought an 'Earth Closet' or 'Scott-Paine' order. I granted the order sought. As this order has not been the subject of any locally reported decision, I felt that it would be useful if I released my grounds on this matter.

**B. Facts**

2 The 1<sup>st</sup> plaintiffs were manufacturers of specialised technical steel products related to concrete structures for the construction industry and they were the registered proprietors of Singapore Patent No 21011 ('the patent'). The 2<sup>nd</sup> plaintiffs were similarly manufacturers of specialised technical steel products and were the authorised licensees of the patent.

3 Together, they sued the defendants for infringement of the patent in August 2004. In their defence filed in September 2004, the defendants stated, inter alia, that the plaintiffs' patent was invalid on the basis that it was not new having regard to the state of the art as at the priority date as set out in their particular of objections. In January 2005, the defendants sought to amend the particulars of objections to include additional instances of prior art. That amendment was allowed. The defendants then in March 2005 further applied to re-amend the amended particulars of objections to include additional instances of prior art. It should be noted that trial was fixed for hearing in April 2005. I heard the application, granted it and vacated the trial dates. Counsel for the plaintiffs then applied for the Earth Closet/Scott-Paine order.

**C. The Earth Closet/Scott-Paine order**

4 Before elaborating on the approach to be taken, I should go into some detail into what exactly is an Earth Closet/Scott-Paine order. The genesis of the Earth Closet order is the decision of *Baird v Moule's Patent Earth Closet Company Limited* (Unreported decision of Sir George Jessel MR made on 3 February 1876 A.231) and the form of that order was mentioned in *Edison Telephone Company v India Rubber Company* (1881) 17 Ch.D. 137. At its essence, the Earth Closet order is a form of sanction on wasted costs. Its effect is that where the defendant in a patent infringement

action applies to amend his particulars of objections to include additional instances of prior art, then the plaintiff is given the right to elect within a certain period of time whether he will discontinue his action and allow for his patent to be revoked. If the plaintiff chooses to exercise this right, then the defendant will be liable to the plaintiffs for the costs of the action subsequent to the delivery of the original particulars of objections, although the plaintiff will remain liable to the defendant for the costs of the action from commencement to the delivery.

5 Certain modifications were made to this order over the years. In particular, in *Helbert William Wilson and Wilson Brothers Bobbin Company Ltd v Wilson & Co (Barnsley) Ltd* (1899) 16 RPC 315, the English Court of Appeal ordered that where the defendants successfully apply to re-amend their amended particulars of objections, then the amended particulars of objections and the particulars of objections would be viewed as being the original objections together. Hence, even if the Earth Closet order is given, the plaintiff if he chooses to exercise his right is only entitled to costs subsequent to the delivery of the amended particulars of objection and not the delivery of the particulars of objections: also see *Strachan and Henshaw, Ltd v Pakcel, Ltd (No 3)* [1949] RPC 49.

6 Another modification to this order arose in the case of *See v Scott-Paine* (1933) 50 RPC 56 which gave rise to the Scott-Paine variation of the Earth Closet order. That question in that case was whether a counterclaiming defendant should be entitled to the entire costs of his counterclaim in the event that the plaintiff elects to exercise his right under the Earth Closet order. The answer given by Eve J was that the counterclaiming defendant had to bear the increased costs to the plaintiff in the counterclaim as well as the main action from the date of delivery of the original particulars of objection. Having dealt with the scope of the order, I proceed next to examine its basis.

#### **D. Basis of the Earth Closet/Scott-Paine order**

7 The basis of the Earth Closet/Scott-Paine order was explained by Chitty J in *Enrich v Ihlee* (1887) 4 RPC 115 as being:

The Plaintiff in a patent action suing on his patent, only goes with his suit to meet the objections which are stated when the defence is put in. Discontinuing under [the Earth Closet order]... he is entitled to say "I am ready to meet the Defendant on the objections which he in the first instance put forward... and I will meet him on those, but now this new one is brought to my attention, I think I must fail in the action and therefore I will discontinue it."

8 It should however be noted that such a risk to the plaintiff of the defendant amending his defence is inherent in literally any civil suit. Parties are always at liberty to apply at a later stage to add additional defences subject to the question of prejudice. Why then are patent cases placed on a different footing from other civil cases? The reason is that the preparation of such actions for trial is very likely to be expensive because of the need for experimentation and the employment of independent experts to give evidence: see *Williamson v Moldline Ltd and Others* [1986] 21 RPC 556.

9 Hence, the situation sought to be tackled by the Earth Closet/Scott-Paine order is one where the defendant raises a new objection to the validity of the patent when he has already committed huge sums in preparing for an action where that objection was not raised and where the patent holder had no reason to suspect the existence of this significantly better prior art which forms the launch pad for a renewed attack on the validity of his patent.

10 Consequently, the Earth Closet/Scott-Paine order imposes upon a party attacking the validity of a patent the obligation to take reasonable efforts to ensure that the entire thrust of his attack is clear to the patent holder as soon as possible so as to minimise the costs that would be wasted or

thrown away when the patent holder realises the futility of continuing to assert that his patent is valid. I would add that this purpose is completely consistent with the Court's case management philosophy, which seeks to ensure that cases proceed expeditiously to their conclusion by ensuring that parties have diligently prepared their cases at each stage of the proceedings thereby avoiding any unnecessary expenditure of costs.

11 The Earth Closet/Scott-Paine order further requires the patent holder to consider the attacks that could be made on his patent and to consider with reasonable haste whether or not the attacks on the validity of his patent will succeed: see *Photax (London) Ltd v Lustro Distributors Ltd*. [1951] 68 RPC 176. Thus, the underlying assumption behind the Earth Closet/Scott-Paine order is that the prior art sought to be added was material to the patent holder's decision to revoke his own patent and that if the prior art had been raised earlier, then the patent holder would have been able to decide to revoke his own patent earlier: see *Ehrlich v Ihlee* (supra).

12 The problem with this assumption is that it ignores the practical consequence of such an order – being that the plaintiff may choose for unrelated reasons to exercise his right and the defendant would nonetheless be liable for a substantial portion of the plaintiff's costs. Even worse, the Earth Closet/Scott-Paine order seriously affects the ability of the defendant to run his best possible case because any application to amend the particulars of objection would bring with it the risk that the Earth Closet/Scott-Paine order would be made.

13 In such a scenario, the defendant will have to balance the risk of the Earth Closet/Scott-Paine order against not putting forward additional instances of prior art late in the day. The defendant's solicitors would thus be placed in a difficult position as to how to advise their clients: see *GEC Alsthom Limited's Patent* [1996] FSR 415. Furthermore, this goes against the public interest in that the court would possibly be left to decide the question of the validity of the patent on the basis of insufficient prior art: see *Instance v Denny Bros Printing Ltd and another* (Unreported decision of Aldous J in the Patents Court on 20 April 1993).

14 Such a risk would be greatest where the plaintiff who sues for infringement possesses in reality (and to his mind) a weak patent and one, which he would readily be willing to accept a revocation of, but for commercial advantage, he nonetheless chooses to sue the defendants for infringement. In such a scenario, the plaintiff is able to take advantage of the Earth Closet/Scott-Paine order even though his decision to discontinue did not depend whatsoever upon the newly added prior art.

15 Furthermore, the fear of an Earth Closet/Scott-Paine order may ironically result in the wasting of costs as defendants are forced in all cases to undertake an extensive worldwide search for prior art at an early stage in the proceedings, even though it is common knowledge that the majority of cases never actually proceed to trial as many infringement actions are commenced merely for tactical purposes. However, it should be noted that such a search may not necessarily result entirely in wasted costs as the search for prior art at an early stage will necessarily assist the parties in their negotiations and settlement talks.

16 I would further add that the possibility of injustice must be viewed against the entire spectrum of our civil procedure rules. Hence, it may be difficult for one to be reasonably satisfied that the defendant has had sufficient time, even with the exercise of reasonable diligence, to identify all the relevant prior art by the first filing of the defence and particulars of objections. In particular, it must be noted that the realities of modern patent litigation is that the defendant faces a steep learning curve, both legal and technical, particularly at the commencement of the action, given the world wide searches, often in a variety of languages, necessary under our law (see the definition of

state of the art in s 14(2) of the Patent Act (Cap 221) 2002 Rev. Ed.). However, the same cannot be said midway into the action, where the learning curve has already tapered off. Bearing these considerations in mind, I turned to consider the appropriate approach to be taken.

#### **E. Approach to be taken in deciding whether to grant such an order**

17 The first matter to be dealt with is whether the court has the jurisdiction to make such an order. This is provided under Order 20 rule 5(1) which reads:

Subject to Order 15, Rules 6, 6A, 7 and 8 and this Rules, the Court may at any stage of the proceedings allow the plaintiff to amend his writ or any party to amend his pleadings, on such terms as to costs or otherwise as may be just and in such manner (if any) as it may direct.

18 It is clear that the jurisdiction conferred upon the courts to make ancillary orders in an application for amendment of pleadings is a very wide one and that it would include the jurisdiction to make an Earth Closet/Scott-Paine order. The mere fact that such an order has never been made in Singapore is not, to my mind, a bar to the grant in the appropriate circumstances of such an order. After all, to hold otherwise would mean that our courts' jurisprudential development would lag behind that of other jurisdictions.

19 Further it is also clear that the discretion conferred upon the courts in such an instance is an unfettered one. However, it does not follow that this discretion can be exercised in whatever manner the courts prefers. Instead, this discretion as to whether the Earth Closet/Scott-Paine order should be made must be exercised only after taking into account all the relevant facts presented to the court. In each case, the court must try, as best it can, to make the costs order that most justly fits into the circumstances of the case. Some valuable pointers as to how this is possible can be obtained by examining the approach taken in other jurisdictions.

#### **I. Approach in other jurisdictions**

20 In England, the approach of their Patents Court has been that Earth Closet/Scott-Paine orders were made as a matter of course upon an application to amend the particulars of invalidity. This practice continued until the mid 1990s, when Laddie J in the landmark case of *GEC Alsthom Limited's Patent* [1996] FSR 415 decision reversed the practice and pointed out that such an order can cause injustice in some cases. In particular, Laddie J stated:

It is a matter of common experience amongst those who act in the patent field, and it was certainly my experience at the Bar, that a See v Scott-Paine order could seriously affect the freedom of a party attacking the validity of a patent to run the best possible case. Not infrequently a plaintiff would allege infringement of a patent the validity of which was seriously in doubt. It nevertheless obtained significant commercial advantage by suing its competitor. The patentee could prepare his case at his own speed and then, when thoroughly ready, could serve the writ, statement of claim and particulars of infringement on the competitor. The competitor would then try to put together, within a timetable set by the rules of court, an attack on validity. In a majority of cases this could only be the first stab at mounting an attack. Searching for prior art is frequently time consuming and difficult, not because the prior art is difficult to find, in the sense of being hidden, but because there is now so much material which is available to search through in most areas of technology that it is logistically impossible to do it instantly. ... Furthermore, even if material is found, it cannot, or should not, be pleaded unless the attacking party can show that it was made available to the public prior to the priority date of the patent.

21 As such, Laddie J stated that the proper approach must be

that I am obliged to exercise my discretion in relation to the appropriate order as to costs by taking into account all the relevant facts presented to me. I must not simply approach this on the basis that *See v. Scott-Paine* orders have frequently been made in the past. Furthermore it seems to me that the overwhelming obligation on me is to try to do justice as between the parties on the basis of the evidence available. I must consider, as Slade L.J. indicated, whether there has been unnecessary wastage of cost. Also, for the reasons set out above, I have to bear in mind that *See v. Scott-Paine* orders, unless really justified, may work a considerable injustice

22 This decision was subsequently followed in a number of English decisions even after the 1998 overhaul of their Civil Procedure Rules: see *CIL International Ltd v. Vitrasnop Ltd* [2002] F.S.R. 4 and *Monitoring Technologies Limited v. Bell Group Plc* [2003] EWHC 3136.

23 The approach in Australia is similar. The Federal Court of Australia in the case of *Wimmera Industrial Minerals Pty Ltd v RGC Mineral Sands Ltd* [1999] FCA 421 (also see *A'Van Campers Pty Ltd v Camoflag Pty* [2003] FCA 353) stated that:

Whatever the position might once have been, the order is not made as of course or "almost invariably" when a defendant seeks to raise objections to validity which are not contained in its original particulars. The matter is entirely within the discretion of the court and depends on the facts of the particular case...

In exercising its discretion, the court should be aware that the order is capable of working an injustice to a defendant, by enabling a patentee with what it knows to be a weak patent to discontinue largely at the defendant's cost. The court should bear in mind the possibility that the patent would have been held invalid even on the unamended particulars.

24 Both these positions are also consistent with the position taken in Hong Kong. By way of illustration, reference need only be made to *Re Wing Yick Bamboo Scaffolders Ltd* [2003] HKEC 985 where Chu J noted that:

It used to be that the imposition of a *See v Scott-Paine* order was almost as a matter of course. The current judicial trend, however, recognises that costs is a matter of discretion and *See v Scott-Paine* orders should only be imposed in appropriate case. The authorities also recognise that *See v Scott-Paine* orders can in some circumstances work injustice.

## **II. Approach to be taken locally**

25 Given the above authorities, it is clear to me that the proper approach to be taken is for the court to consider whether to exercise its discretion, having regard to the particular circumstances of the instant case and with due consideration of the possibility of injustice to the defendant if the *Earth Closet/Scott-Paine* order is granted.

26 In particular, the court should consider, inter alia, the following factors:

- (a) Diligence of the defendant in relation to the prior art inquiries;
- (b) Extent to which the patent holder has been surprised;
- (c) Reasons for the amendment; and

(d) The timing of the amendment and the case.

27 I will elaborate on each factor in turn.

(a) *Diligence of the defendant in relation to the prior art inquiries*

28 Given the rationale of the Earth Closet/Scott-Paine order, the principal factor to be considered by the court is whether it can be said that the defendant, despite taking due diligence, could not have reasonably discovered the prior art: see *GEC Alsthom Limited's Patent* (supra). In instances where it can be shown that the defendant has not exercised proper diligence, then the patent holder has complete justification in grumbling about his wasted costs. The onus here is thus on the defendant to demonstrate to the Court that he has been reasonably diligent in his search: see *Williamson v Moldline Ltd and Others* (supra).

29 In my opinion, what the defendant should do to discharge this burden, as a general guide, is to adduce evidence to show that they had commenced well planned and substantial prior art searches at an early stage in the proceedings. This would of course mean that defendants who are contesting validity should keep a good paper trail of their own prior art searches and endeavour to critically analyse whatever prior art they have discovered as well as the prior art disclosed by the patent's holder's at the earliest opportunity for further fields of investigation.

30 Further, the nature of the search that actually turned up the additional prior art is relevant. The law does not require defendants to do things that are out of the ordinary on the off chance that a fortuitous search will unearth the proverbial needle in a haystack: see for example *Josiah Wedgwood & Sons Limited v Stained Glass Systems Limited* (Unreported decision of Jacob J in the Patents Court on 16 October 1996). Neither does it prejudice defendants when they stumble across some prior art through an adventitious or extemporaneous incident: see *La Baigue Magiglo v Multiglow Fires* [1994] RPC 295.

31 However, holistically speaking, this factor of diligence while central is not conclusive. The Court will always have to take into account all other relevant factor in its attempt to do justice between the parties and the circumstances of the case.

(b) *Extent to which the patent holder has been surprised*

32 This is another important factor. Where the amendment seeks to raise an entirely new field of investigation, the considerations are very different from one where an additional instance of prior art is sought to be added when that particular prior art can be said to be obvious given the existing particulars of objections.

33 Similarly, if the prior art sought to be added are already within the knowledge of the patent holder, for example if they are patents owned by the patent holder, then it is most unlikely that the Earth Closet/Scott-Paine order will be made since it cannot be said that the amendments have surprised the patent holder and thereby led him to reconsider his entire position and decide on that basis to discontinue his action.

34 However, the mere fact that the patent holder is aware of the prior art per se is not necessarily fatal to him obtaining the Earth Closet/Scott-Paine order. It must be shown that the patent holder would reasonably have directed his mind to that prior art in relation to the issues in dispute in the current action. After all, the patent holder has no obligation to scan through the existing prior art in an attempt to determine whether his patent is invalid: see *Gill v Chipman*

[1987] RPC 209 and *CIL International Ltd v. Vitrashop Ltd* (supra).

(c) *Reasons for the amendment*

35 The court should further take into consideration the reasons given by the defendant for the amendment. In particular, where the amendments by the defendant is in response to an earlier amendment to the patent by the patent holder, then the court should view the defendant's amendments with greater latitude. After all, the defendant does not have to plead the entire spectrum of prior art in anticipation of any possible amendments by the patent holder. To hold otherwise would be to burden a defendant with an unduly burdensome obligation: see *CQR Security System Ltd's Patent* [1992] FSR 303.

(d) *Timing of the amendment and the case*

36 This is another factor that has to be taken into account. Patent trials by nature are complex. An amendment at any stage of the trial puts a heavy burden on the patent holder. The burden is especially heavy when the defendant seeks at a very late stage to amend their particulars of objections. Hence, where the matter could have been pleaded earlier, such as when the material was already in the possession of the defendants at an earlier stage, but they choose for whatever reason to only make their application much later, then there is a greater likelihood that the Earth Closet/Scott-Paine order will be made. After all, if the amendment was sought earlier, the patent holder would have been put on notice far much earlier which as a matter of common sense would have allowed them to elect whether to proceed far much earlier and thereby lead to a saving of costs: see *Helitune Ltd v. Stewart Hughes Ltd* [1994] F.S.R. 422.

37 However, it must be remembered in such a situation that the purpose of the Earth Closet/Scott-Paine order is not to penalise the defendants, but rather to incentivize them to carry out their searches and amendment of their pleadings with due haste: see *Behr-Thomson Controls Ltd* [1990] RPC 569. Hence, the court before relying upon this factor has to find that the delay was unacceptable in that a reasonable lawyer with possession of the materials would have taken out an earlier application to amend the particulars of objections: see *Brivis Australia Pty Ltd v Seeley International Pty Ltd* [2002] FCA 843 and *Allied Colloids Ltd v American Cyanamid Co and another* (Unreported decision of Aldous J in the Patents Court on 20 January 1995).

38 It also bears mentioning that under Order 18 of the Rules of Court, the defendant has 14 days after the time limited for appearance or the service of the statement of claim, whichever is later, in which to serve their defence (and particulars of objections) on the plaintiff. Given this short timeframe, the severe penalties imposed in the event of a breach of this timeline (i.e. the entering of default judgment under Order 19) and the nature of getting up necessary in a patent action, it would be clear that the strict imposition of a Earth Closet/Scott-Paine order would cause grave injustice on defendants who are forced by virtue of the Rules to serve a defence and yet be penalised in costs when they seek, after a further period of research, to bolster their often bare defences. As such, it should be a rare case where a defendant who, a short period after serving his defence, seeks to amend his particulars of objections is penalised on the basis that he should have included all the new instances of prior art in his original particulars of objections.

39 In contrast, it would be easier to show that an Earth Closet/Scott-Paine order should be imposed where it is the defendant's second or subsequent application to amend the particulars of objections. In any event, the court always retains the discretion to shift around the cutover date to suit the individual circumstances of each case: see for example *La Baigue Magiglo v Multiglow Fires and others* [1994] RPC 295 and *Dimplex (UK) Limited v De'Longhi Limited and others* (Unreported

decision of Laddie J in the Patents Court on 14 February 1996).

(e) *Other factors*

40 I will for the sake of completeness mention two other factors. First, the status of the amending party is relevant. Where the party seeking the amendment is the plaintiff who is suing for revocation of the defendant's patent, then less leeway should be given. This is because in such a matter, the plaintiff must necessarily be assumed to have conducted the necessary and proper enquiries as to prior art before launching his suit: see *Re Wing Yick Bamboo Scaffolders Ltd* (supra).

41 Second, I do not think that the court should at this stage examine the existing prior art pleaded and consider whether there is a prima facie case for the revocation of the patent (and if there is, thereby decide against the grant of the Earth Closet/Scott-Paine order). Such an assessment even in the plainest of cases would not only be unsuitable given the nature of the application, but would usurp the function of the trial court. After all, if the matter was so clear, the defendants are always at liberty to strike out the patent holder's case. Instead, the court should merely bear in mind that it is possible for the patent to be invalid even without the amendments and the Earth Closet/Scott-Paine order would hence allow the plaintiff to discontinue the matter with the defendants covering a substantial portion of their costs: see *Ehrlich v Ihlee* (supra), *Brivis Australia Pty Ltd v Seeley International Pty Ltd* (supra) and *GEC Alsthom Limited's Patent* (supra).

**F. Application to the instant case**

42 In the instant case, there was unfortunately no material in the affidavits before this court, which showed the defendants, had diligently carried out their enquiries and searches. This was despite the fact that I had adjourned the matter for the defendants to file further affidavits. In fact, there was no evidence at all as to the sort of enquiries that the defendants had carried out in search of the prior art. Neither was there any explanation in the affidavits as to why the additional prior art was not included in the first application to amend the particulars of objections.

43 Instead, what the affidavit disclosed was that there were two sets of prior art sought to be added. First, the prior art that the defendants' appointed expert witness had found. This included a number of textbooks, most of which had been in the defendants' possession for a number of months. No explanation was made as to why the defendants did not choose to include these earlier despite it being clearly relevant. Second, the prior art (which included a number of European patents and some texts) that had been referred to in a patent opposition action in Europe on a related patent. In relation to these prior art, the defendants' managing director explained that he had gone to the United Kingdom to meet another of their expert witness and it was this expert witness who had referred them to the patent opposition action. No explanation was made as to how that witness had come across the patent opposition action or why it could not have been discovered earlier.

44 As such, there was simply no evidence to show that the defendants had been reasonably diligent. Hence, I was not satisfied that the defendants had acted with reasonable diligence and yet only just discovered the new prior art and then acted with due haste in placing their best case before the court.

45 I also noted that it could not be said that the amendments did not take the plaintiffs by surprise or cause any prejudice. The application to amend was a substantial one – it sought to expand upon the amended particular of objection, which originally contained 5 instances of prior art to 25 instances of prior art. Even if I were to just consider the first set of prior art sought to be added, the plaintiffs would have been placed in a position where they may have to seriously reconsider



whether to proceed with their patent.

46 Further, I took into account the fact that the defendants had already applied to amend their particulars of objection in January 2005. No reasons were given or evidence adduced to show why these prior art could not have been included in that application. Lastly, the matter can be approached from another perspective – whether the plaintiffs have a weak patent and are seeking to rely upon the Earth Closet/Scott-Paine order for a windfall. This was not such a case. It was not disputed that the plaintiffs had defended this very same patent vigorously and successfully in other jurisdictions such as Europe, Korea and Thailand.

47 At the end of the day, the decision to make an Earth Closet/Scott-Paine order at the amendment stage can never be made with complete precision. Instead, what the court seeks to do on review of all the circumstances is to decide what is the cost order which best suits the circumstances. For the reasons articulated above, I held that the Earth Closet/Scott-Paine order was appropriate in the circumstances and ordered that:

(1) The plaintiffs do by 25 April 2005 elect whether they will discontinue their action and withdraw their defence to the counterclaim and consent to an order for revocation of their patent.

(2) And if the plaintiffs do so elect and give notice thereof to the defendants by the date ordered, then the patent shall be revoked and the defendants shall be entitled to the costs of the action from the commencement of the writ to date of the first amendment to the particulars of objection and the plaintiffs shall be entitled to the costs of the action subsequent to that.

(3) These costs shall be agreed or taxed.

***Directions contingent upon the grant of the order***

48 I should add that generally if the Earth Closet/Scott-Paine order is given, then the defendants should be allowed to decide whether they prefer to withdraw their application to amend instead: see *Helitune Ltd v. Stewart Hughes Ltd* (supra).

49 Furthermore, where the timelines of the case permits, then the amendment to the defence (which would bring with it the incurring of costs incidental to the amendment) should only take place after the deadline given to the plaintiff to so elect expires. In the instant case, the trial dates were too near to allow parties this luxury. As such, I ordered that the amendment of the defence was to take place immediately and gave the necessary directions.

**G. Concluding remarks**

50 In closing, I would mention that while the Earth Closet/Scott-Paine order originally arose in the context of the Patent Court, it has been expanded to registered design cases: see *Morris Wilson & Co v Coventry Machinists Company* [1891] 3 Ch 418 and *Rose & Hubble Ltd v L. Hart (Stockport) Ltd* [1965] FSR 412. However, I see no reason in principle why the Earth Closet/Scott-Paine order should be restricted solely to intellectual property cases only.

51 Generally speaking, if a party is to be penalised for not acting with due speed in amending his pleadings because there has been a large expenditure in relation to research and experimentation, then there is no reason why this penalty should be restricted to cases involving intellectual property only. Instead, it should apply to all complex cases that involve a large expenditure both in terms of

manpower and financial outlay. After all, the principle of requiring parties to diligently prepare their cases to avoid the wastage of time and costs remains the same in all these cases.

52        However, it must be caveated that the amendment to the defence must be one that adds a new defence which the plaintiffs had no reason to suspect the existence of, as opposed to merely adding further particulars to an existing defence (see para 32 – 34 earlier). Further, that new defence must act as a complete defence and not merely a partial one such as contributory negligence. Hence, in my view, an Earth Closet/Scott-Paine order should in the appropriate cases (although it is recognised that such cases are likely to be rare) be given whenever a late amendment is made to the defence such that the plaintiff is impaled on Morton's fork such that he has to either choose to proceed on a case that is now unlikely to be won or to concede the case and pay substantial costs to the defendants.

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