

Martek Biosciences Corp v Cargill International Trading Pte Ltd
[2010] SGHC 135

Case Number : Originating Summons No 1418 of 2009/E; Summons No 234 of 2010/Q
Decision Date : 03 May 2010
Tribunal/Court : High Court
Coram : Tay Yong Kwang J
Counsel Name(s) : Lai Tze Chang Stanley SC, Vignesh Vaerhn and Lim Ming Hui Eunice (Allen & Gledhill LLP) for the applicant; Daniel Koh (briefed) (Eldan Law LLP) and Wendy Low Wei Ling (Rajah & Tann LLP) for the respondent.
Parties : Martek Biosciences Corp — Cargill International Trading Pte Ltd

Civil Procedure – Appeal – Leave – Admission of Further Evidence

3 May 2010

Tay Yong Kwang J:

Background Facts

1 Both Martek Biosciences Corporation (the “Applicant”) and Cargill International Trading Pte Ltd (the “Respondent”) are in the infant formula business. The Respondent commenced proceedings to revoke the Applicant’s Singapore Patent P-No. 42669 (“the Patent”) under section 80(1)(a) and (c) of the Patents Act (Cap 221, 2005 Rev Ed). After a four-day hearing, Deputy Registrar of Patents Danielle Yeow and Principal Assistant Registrar of Patents Isabel Chng (“the Tribunal”) in *Cargill International Trading Pte Ltd v Martek Biosciences Corporation* SGIPOS 12 (the “grounds of decision”) granted the Respondent’s application to revoke the Applicant’s patent. In this Originating Summons (“the Appeal”), the Applicant is appealing against the decision of the Tribunal. The Appeal has not been heard yet. What is presently in issue is an interlocutory application by the Applicant for leave to adduce further evidence at the Appeal.

2 The Patent was entitled “Arachidonic Acid and Methods for the production and use thereof” and the published abstract reads as follow:

The present invention relates to processes for the production of arachidonic acid containing oils, which preferably are free of eicosapentaneic acid. This invention also relates to compositions containing oils of very high amounts of arachidonic acid in triglyceride form, and to uses of such oils. In a preferred embodiment, *Mortierella alpina* is cultivated using conditions which yield triglyceride oil having particularly high levels of arachidonic acid residues, biomass is harvested and the oil is extracted, recovered, and used as an additive for infant formula.

3 The Patent further explained the nature and functions of arachidonic acid: that it serves a primary role as a structural lipid and acts as the direct precursor for a number of circulating eicosenoids [eg, Prostaglandin E₂ (PGE₂), prostacyclin I₂ (PGI₂), thromboxane A₂ (TxA₂), leukotrienes B₄ (LTB₄) and leukotrienes C₄ (LTC₄)] which exhibit regulatory effects on lipoprotein metabolism, blood theology, vascular tone, leucocyte function and platelet activation.

4 Despite its importance to human metabolism, arachidonic acid cannot be synthesized in humans

de novo. Thus, it must be provided in the diet and this is especially important during times of very rapid body growth such as infancy. Human breast milk contains high levels of arachidonic acid. However, many mothers do not breast feed their infants or do not breast feed for the entire period of rapid infant growth, choosing instead to utilize an infant formula.

5 The Patent stated that no commercial infant formula known to the Applicant contained arachidonic acid in triglyceride form and it also cited some unsuccessful attempts made in the quest for obtaining arachidonic acid.

6 The Respondent, in its application to revoke the Patent, cited ten prior art enumerated D1 to D10 respectively. The Respondent alleged that the Applicant's patent claims were not patentable and that the patent specification did not disclose the invention clearly and completely for it to be performed by a person skilled in the art.

7 Pleadings to the revocation proceedings commenced on 20 January 2006. The revocation hearing was conducted before the Tribunal from 9 to 12 February 2009. The Tribunal rendered its grounds of decision on 3 November 2009.

8 In the Appeal, the Applicant will be contending that the Tribunal erred in law and in fact in finding, *inter alia*, that:

- (a) Claim 1 was not inventive over D4a read with either D7 or D10;
- (b) Claim 2 was not inventive over D4a read with either D5a or D7;
- (c) The dependent claims 3-11, 26-34 and 36-44 lacked an inventive step on the basis that the independent claims 1 and 2 lacked an inventive step;
- (d) Claims 3, 26 and 36 were not novel and/or inventive over D1, D2 and D4a;
- (e) Claims 4, 27 and 37 were not novel and/or not inventive over D4a and D7;
- (f) Claim 13 was not novel over D4a;
- (g) Claim 24 was not novel and/or inventive over D4a or D7; and
- (h) Claim 35 was not inventive over D4a read with D5a or D4a read with D7.

9 Pending the hearing of the Appeal, the Applicant took out Summons No 234 of 2010/Q ("the application") pursuant to Order 55 rule 6(2) and/or Order 87A rule 13(2) of the Rules of Court

(Cap 322, R 5, 2006 Rev. Ed.) ("ROC") to apply for leave to conduct the experiment described in prior art reference D4a and to adduce evidence of and relating to the same ("the fresh evidence").

10 D4 (D4a being the English translation of D4, the original Japanese text) was a document cited by the Respondent as one of the prior art references before the Tribunal. During cross-examination before the Tribunal, it transpired that the Respondent's witness, Dr. William R. Barclay ("Dr. Barclay"), had not personally conducted the experiment described in D4a.

The adduction of further evidence

11 As this was the first case in Singapore which involved an application to adduce further evidence for a patents revocation appeal against a Tribunal's decision, counsels for the Applicant and the Respondent sought to draw analogies with adduction of further evidence:

- (a) In an appeal from a lower court, tribunal or person to the High Court pursuant to O 55 r 6(2) ROC;
- (b) In an appeal from the High Court to the Court of Appeal pursuant to O 57 r 13(2) ROC and s 37(3) Supreme Court of Judicature Act (Cap 322, 2007 Rev. Ed.) ("SCJA");
- (c) In an appeal from the Registrar of Trade Marks to the High Court pursuant to O 87 r 4(2) ROC;
- (d) In a trade marks or patents appeal in the UK.

12 The principles governing the adduction of further evidence appear to differ according to the nature of appeal from a lower adjudicating body to an appellate body. Hence, an analysis of the nature of an appeal from the Registrar of Patents (*ie*, the Tribunal) to the High Court is useful.

Nature of Appeal

13 O 87A r 13(2) ROC which governs the nature of an appeal from a decision of the Registrar of Patents (*ie*, the Tribunal) to the High Court applies to the present application:

Order 87A rule 13

13. – (2) An Appeal shall be *by way of rehearing* and the evidence used on appeal shall be the same as that used before the Registrar and, *except with the leave of the Court, no further evidence shall be given.* (emphasis added)

An Appeal from a Lower Court, Tribunal or Person to the High Court

14 The wording of O 87A r 13(2) ROC should be compared and contrasted with O 55 r 2(1) ROC:

Order 55 rule 2

2. - (1) An Appeal to which this Order applies shall be *by way of rehearing* and must be brought by originating summons. (emphasis added)

15 The High Court hearing an appeal from a lower court, tribunal or person is vested with powers to require further evidence on questions of fact and the evidence may be given in such manner as the Court may direct, either by oral examination in Court, by affidavit, by deposition taken before an examiner or in some other manner (see O 55 r 6(2) ROC).

An Appeal from the High Court to the Court of Appeal

16 O 57 r 13(2) ROC stipulates that the Court of Appeal has the power to receive further evidence on questions of fact by oral examination in court, by affidavit, or by deposition taken before an examiner. However, in the case of an appeal from a *judgment after trial or hearing of any cause or matter on the merits*, no such further evidence (other than evidence as to matters which have occurred after the date of trial or hearing) shall be admitted except on *special grounds*. Appeals to the Court of Appeal shall be by way of rehearing (see s 37(1) SCJA).

17 The principles governing the granting of leave to adduce further evidence before the Court of Appeal were stated in *Ladd v Marshall* [1954] 1 WLR 1489 ("*Ladd v Marshall*"), which has been applied in Singapore:

- (a) Evidence could not have been obtained with reasonable diligence for use at the trial;
- (b) Evidence is such that, if given, it would probably have an important influence on the result of the case, though it need not be decisive; and
- (c) Evidence must be apparently credible, though it need not be incontrovertible.

An Appeal from the Registrar of Trade Marks to the High Court

18 O 87 r 4(2) ROC which governs the nature of appeal from the Registrar of Trade Marks to the High Court states as follows:

Order 87 rule 4

4. - (2) An Appeal shall be *by way of rehearing* and the evidence used on appeal shall be the same as that used before the Registrar, *except with leave of the Court, no further evidence shall be given*. (emphasis added)

19 The Singapore Court Practice 2009, in commenting on O 87A r 13(2) ROC, states that the term "rehearing" in relation to O 87 ROC concerning trade marks was not to be understood as referring to a full *de novo* rehearing of evidence and that the court does not hear the case again from the start but merely reviews the decision under appeal under its supervisory jurisdiction; it further suggests that the same approach be adopted for O 87A r 13(2) ROC.

Applicant's case

20 The Applicant submitted that it should be granted leave to adduce the fresh evidence for the following reasons:

(a) The principles in *Ladd v Marshall* did not apply to the application;

(b) No prejudice to the Respondent would be occasioned by the admission of the fresh evidence.

Nature of appeal under O 87A is akin to that under O 55 ROC

21 The Applicant submitted that in “rehearing” the Appeal, this court is entitled to revisit the totality of the evidence tendered before the Tribunal below. In other words, the Applicant pitched its case as such: an appeal from the Patents Registrars to the High Court under O 87A r 13(2) ROC is analogous to that of an appeal from a tribunal to the High Court under O 55 r 2(1) ROC.

22 Following this logic, when hearing the Appeal, this court is not fettered by any principle limiting its discretion and is free to come to conclusions which differ from the conclusions of the Tribunal. As the Court of Appeal in *Teo Chee Yeow Aloysius and another v Tan Harry and another* [2004] 3 SLR(R) 588 at [15] (“*Teo Chee Yeow*”) held:

[W]hen a judge in chambers hears an appeal from a decision of the Registrar, the judge is not exercising an appellate jurisdiction but a confirmatory jurisdiction. In such an appeal, there is a rehearing and the judge is entitled to exercise an unfettered discretion of his own.

23 *Teo Chee Yeow* at [16] distinguished between:

(a) An appeal from a Registrar to a judge in chambers; and

(b) An appeal from a decision of the High Court to the Court of Appeal.

In the case of (b) above, it was held that the Court of Appeal could only upset a decision of the High Court if it was shown that the latter had erred on a matter of principle, had taken irrelevant considerations into account or that the decision was plainly wrong (see *The Vishva Apurva* [1992] 1 SLR(R) 912).

24 Thus, the Applicant’s stance was that the nature of the Appeal was akin to one under O 55 r 2(1) ROC in which the *Ladd v Marshall* principles were not of assistance.

Authorities from UK Trade Marks appeals

25 The Applicant also sought to demonstrate, by way of analogy, that a series of UK trade marks cases had held that the restrictive principles expressed in *Ladd v Marshall* did not apply where the question was whether a party should be allowed to file further evidence on a trade mark appeal from the Registrar of Trade Marks to the High Court.

26 It was submitted that the principles enunciated in these UK trade marks cases should apply with equal force to the application as any distinction between the principles applicable to adduction

of further evidence in a trade marks appeal and those relating to a patents appeal to the High Court was illusory insofar as trade marks and patents were both statutorily created intellectual property rights which conferred statutory monopolies on their proprietors.

27 As Lloyd J held in *ELLE Trade Marks* [1997] FSR 529 at 536 ("*ELLE Trade Marks*"):

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

ELLE Trade Marks thus stands for the proposition that the rule in *Ladd v Marshall* applies only to an appeal from the High Court to the Court of Appeal but not to an appeal from the Registrar of Trade Marks to the High Court.

28 The Applicant submitted that the above reason compounded with the identical wording of O 87 r 4(2) ROC (which governs the adduction of evidence in trade marks appeals) and that of O 87A r 13(2) ROC (on patents appeals) warranted an equal application of the principle in *ELLE Trade Marks* to the present application.

29 The case of *Julian Higgins' Trade Mark Application* [2000] RPC 321 ("*Julian Higgins*") lends force to the Applicant's position. As observed by Sir Richard Scott VC at 326, in the UK, the introduction of new evidence on an appeal was governed by s 18(8) Trade Marks Act 1938 which allowed new evidence to be adduced either "in the manner prescribed" or with "by special leave of the court". Since nothing had been prescribed, new material could only be adduced with the leave of the court. Leave, in turn, would be granted according to Order 55 rule 7(2) of the UK Rules of the Supreme Court ("UK RSC") which is now in Schedule I to the UK Civil Procedure Rules.

30 O 55 r 7(2) of the UK RSC read as follow:

The Court shall have the power to receive further evidence on questions of fact, the evidence may be given in such manner as the court may direct either by oral examination in court or by witness statement or affidavit, by deposition taken before an examiner or in some other manner.

Sir Richard Scott VC contrasted the language of O 55 r 7(2) UK RSC with that of O 59 r 10(2) UK RSC which applied to the admission of new evidence in appeals to the Court of Appeal. O 59 r 10(2) of the UK RSC stipulated as such:

The Court of Appeal shall have power to receive further evidence on questions of fact, either by oral examination in court, by affidavit, or by deposition taken before an examiner, but in the case of an appeal from a judgment after trial or hearing of any cause or matter on the merits, *no such further evidence (other than evidence as to matters which have occurred after the date of the trial or hearing) shall be admitted except on special grounds.* (emphasis added)

31 It was held in *Julian Higgins'* (at 327) that since the less restrictive language of O 55 r 7(2) UK RSC was to be applied in that instance (*ie*, an appeal under the Trade Marks Act), *Ladd v Marshall*, which spelt out the manner in which the courts were to approach the exercise of discretion to admit further evidence under O 59 r 10(2) UK RSC, was not thought to be of any assistance. This approach was endorsed by the case of *Club Europe Trade Mark* [2000] RPC 329 at 338 which further emphasised that *Ladd v Marshall* principles only applied to appeals to the Court of Appeal.

32 The Applicant further pointed out that the strict language of O 59 r 10(2) UK RSC (which *Ladd*

v Marshall principles reflected) was closely mirrored by O 57 r 13(2) ROC (*ie*, appeals from High Court to the Court of Appeal) which stipulates as follow:

The Court of Appeal shall have power to receive further evidence on questions of fact, either by oral examination in Court, by affidavit, or by deposition taken before an examiner, but, in the case of an appeal from a judgment after trial or hearing of any cause or matter on the merits, *no such further evidence (other than evidence as to matters which have occurred after the date of trial or hearing) shall be admitted except on special grounds.* (emphasis added)

Thus, the Applicant submitted that the strict language in O 57 r 13(2) ROC should be distinguished from the wider language employed by O 87A r 13(2) ROC (which applied to the application). Moreover, as there was no requirement for "special grounds" under O 87A r 13(2) ROC, the principles of *Ladd v Marshall* were accordingly inapplicable.

33 The Applicant submitted that the test in *Hunt-Wesson Inc's Trade Mark Application* [1996] RPC 233 ("*Hunt-Wesson Inc's case*") was the appropriate one for the application.

34 Laddie J in *Hunt-Wesson Inc's case*, which was an appeal to the High Court of England from an opposition decision of the UK Registrar of Trade Marks, noted that the repercussions of adducing evidence at a later stage in cases of private litigation involving two parties (as was in *Ladd v Marshall*) could be different from those in trade mark opposition.

35 In a case of private litigation between two parties, if one of them failed to produce evidence which was relevant and helpful until too late, only that party would suffer the consequences. However, in a case of opposition of trade mark, refusing permission to an opponent who filed evidence late affected not only him but may also penalise the rest of the trade as a new statutory monopoly would have been created. The possibility of multiplicity of proceedings, as the party who loses as a result of the exclusion of further evidence might return in a separate proceeding to seek rectification of the procedure, would also be avoided by allowing fresh evidence at the appeal stage.

36 The factors enunciated by Laddie J at 242 included:

- (a) Whether the evidence could have been filed earlier and, if so, how much earlier;
- (b) If it could have been, what explanation for the late filing has been offered to explain the delay;
- (c) The nature of the mark;
- (d) The nature of objections to it;
- (e) The potential significance of the new evidence;
- (f) Whether or not the other side will be significantly prejudiced by the admission of the

evidence in a way which cannot be compensated, *eg*, by an order for costs;

(g) The desirability of avoiding multiplicity of proceedings;

(h) The public interest in not admitting onto the register invalid marks.

Notably, Laddie J in *Hunt-Wesson Inc's case* granted leave to the opponent to file further evidence, despite the fact that such an evidence should have been obtained prior to the opposition hearing before the UK Registrar of Trade Marks and the fact that no explanation was offered by the opponent for its failure to rely on the evidence earlier.

37 Taking into account all the relevant factors, including those stated in *Hunt-Wesson Inc's case*, the Applicant submitted that leave should be granted for it to adduce the fresh evidence on the following grounds:

- (a) As the Appeal is by way of rehearing, this court is not fettered by any principle limiting its discretion and is free to come to conclusions which differ from the conclusions of the Tribunal;
- (b) Neither the Applicant nor the Respondent adduced evidence of such nature before the Tribunal;
- (c) The Applicant sought to file the alleged fresh evidence at the earliest possible opportunity after the necessity of doing so arose out of the cross-examination of the Respondent's witness, Dr. Barclay;
- (d) The fresh evidence was highly relevant for the purposes of the Appeal as D4a was a prominent feature in the Tribunal's grounds of decision and is one of the issues in the Appeal;
- (e) The filing of the fresh evidence would probably have an important influence on the outcome of the Appeal as the Tribunal would have arrived at differing findings and conclusions had the fresh evidence been put before them;
- (f) The fresh evidence was purely scientific and/or factual and was not inherently incredible, scandalous, vexatious or embarrassing to either party;
- (g) There was no element of surprise to the Respondent as the Applicant was merely seeking to repeat the experiment described in prior art reference D4a which the Respondent should be fully apprised of;

- (h) The Respondent would not be prejudiced by the admission of the fresh evidence;
- (i) As the outcome of the Appeal would impact on all traders in the relevant trade insofar as the issues to be decided upon in the Appeal would affect the existence and/or extent of the statutory monopoly conferred by the Patent, the Appeal should be based on a thorough consideration of all available evidence.

38 The Applicant submitted that an accurate determination of the issues in the Appeal based on all available evidence, including the fresh evidence, would thus provide greater certainty and finality for both parties. Therefore, taking into account all the relevant *Hunt-Wesson Inc's case* factors, in the absence of any prejudice to the Respondent, the overriding interests of justice, certainty and finality should prevail to warrant the admission of the fresh evidence.

Respondent's case

39 The Respondent, on the other hand, submitted that the *Ladd v Marshall* principles should be taken into account in the court's exercise of its discretion whether or not to grant leave for admission of fresh evidence. The Respondent relied on the following in support of its position:

- (a) Patents and trade marks authorities on the admission of fresh evidence at the hearing of an appeal against a revocation decision made before a Registrar;
- (b) Alternatively, local cases on civil jurisprudence relating to admission of evidence at an appeal hearing before a High Court judge in chambers.

Nature of appeal under O 87A is akin to that under O 57 ROC

40 The Respondent cited *Future Enterprises Pte Ltd v McDonald's Corp* [2007] 2 SLR(R) 845 ("*Future Enterprises*") which alluded to the general reluctance on the part of the appellate court in disturbing a finding made by the Registrar of Trade Marks.

4 1 *Future Enterprises* was an appeal against a decision of the Principal Assistant Registrar of Trade Marks ("PAR") who allowed McDonald's opposition to the appellant's application to register the trademark "MacCoffee". The PAR's findings of visual, aural and conceptual similarities were upheld by the Court of Appeal (at [5]) which endorsed the approach in *S C Prodal 94 SRL v Spiritis International NV* [2003] EWHC 2756 (Ch) where Laddie J said:

It is not the duty of this court to overturn a decision of the Trade Mark Registry simply because it comes to a conclusion that it might have decided the case differently had it, that is to say the High Court, been the court of first instance. It has to be demonstrated that the decision at first instance was wrong in a material way; that is to say that there must be some significant departure from a proper assessment of the law or the facts.

42 Woo Bih Li J in the case of *Ozone Community Corp v Advance Magazine Publishers Inc* [2010] SGHC 16 ("*Ozone Community Corp*") at [32] noted that *Future Enterprises* did not consider the effect of O 87 r 4 ROC which states:

Order 87 rule 4

4. – (2) An appeal shall be *by way of rehearing* and the evidence used on appeal shall be the same as that used before the Registrar and, except with the leave of the Court, no further evidence shall be given.

(emphasis added)

O 87 r 4(2) ROC is the parallel rule for the application (*ie*, patent proceedings) under O 87A r 13(2) ROC.

43 Woo J in *Ozone Community Corp* conducted a review of recent Singapore High Court decisions that attempted to address what a “rehearing” entailed in the context of an appellate review of a decision made before a tribunal, namely, *MediaCorp News Pte Ltd v Astro All Asia Networks Plc* [2009] 4 SLR(R) 496 (“*MediaCorp*”) and *Valentino Globe BV v Pacific Rim Industries Inc* [2009] 4 SLR(R) 577 (“*Valentino*”).

Nature of ‘Rehearing’ under O 87 and O 87A ROC

44 *MediaCorp* was an appeal by MediaCorp pursuant to s 8(2)(b) and s 8(3) of the Trade Marks Act to oppose the registration of the “Astro Mark” in respect of specified Class 16 goods and Class 35 services. Lee Seiu Kin J considered the standard of review applicable to the proceedings and noted that the earlier Court of Appeal case of *Future Enterprises* did not consider the effect of what “rehearing” entailed under O 87 r 4 ROC. Lee J noted at [26]:

Nevertheless, the fact that such proceedings are “by way of rehearing” does not necessarily mean that the appeal court’s decision is unfettered. An appeal from the High Court to the Court of Appeal is similarly by way of rehearing under O 57 r 3(1) of the ROC. However, the Court of Appeal will be slow to upset an exercise of discretion by the trial judge (*Golden Shore Transportation Pte Ltd v UCO Bank* [2004] 1 SLR(R) 6 at [44]).

45 In referring to a “rehearing” in the context of an appeal from the High Court to the Court of Appeal, Lee J at [26] distinguished between two instances:

- (a) A finding of facts where the Court of Appeal is “generally reluctant to interfere because the trial judge is in a better position to assess the veracity and credibility of the witnesses” (*Seah Ting Soon v Indonesian Tractors Co Pte Ltd* [2001] 1 SLR(R) 53 at [22])
- (b) A perception of facts and evaluation of facts where in respect of the latter “an appellate court is in as good a position as the trial court to make an evaluation from primary facts” (*Ho Soo Fong v Standard Chartered Bank* [2007] 2 SLR(R) 181 at [20]).

Thus, Lee J referred to *Future Enterprises* as authority that the law pertaining to trade marks infringement was unique in that the final analysis was “more a matter of feel than science”, *ie*, akin to a matter of subjective assessment of facts.

46 The effect of O 87 r 4(2) ROC was also reviewed by Chan Seng Onn J in *Valentino* (affirmed in Civil Appeal No. 46 of 2009). However, neither *Future Enterprises* nor *MediaCorp* was referred to in *Valentino*. Chan J said at [10] to [11]:

10 On O 55 which governs appeals to the High Court from any court, tribunal or person, para 55/1/2 of *Singapore Civil Procedure* notes that O 55 r 2(1) stipulates that the appeal is by way of rehearing. Order 55, it suggests, confers upon the Court wider powers than those so conferred under O 53 which deals with, *inter alia*, judicial review. Hence, O 55 r 6(5) provides that the appellate court can make any order which should have been made by the tribunal. The appellate court is thus not confined to merely determining whether the decision below was compliant with rules of natural justice or reached honestly (*Ling Uk Choon v Public Accountants Board* [2004] 3 SLR(R) 517 at [32]).

11 "By way of rehearing" in my view means that the Court is not constrained to determine only whether the tribunal's decision was proper and/or contained manifest errors of fact and law. If it wishes to, the Court in its discretion may consider the entire ream of evidence before it and venture beyond determining the propriety of the tribunal's decision or inquiring into whether there had been manifest errors of fact or law. However, I do not think that it places an *irrevocable burden* upon the Courts to hear the matter anew so that the substantive merits fall to be determined afresh. As para 57/3/1 of *Singapore Civil Procedure* observes with regard to the phrase "by way of rehearing", albeit in relation to appeals to the Court of Appeal:

These words do not mean that the witnesses are heard afresh. They indicate the appeal is not limited to a consideration whether the misdirection, misperception of evidence or other alleged defect in the trial has taken place, so that a new trial should be ordered. They indicate that the court considers (so far as may be relevant) the whole of the evidence given in the court below and the whole course of the trial. [emphasis in italics in original]

...

The court's power is therefore discretionary.

47 The Respondent therefore submitted that *MediaCorp* and *Valentino* both represent the view that "rehearing" in relation to an appellate review of a trade marks tribunal's decision under O 87 ROC takes reference from "rehearing" in an appeal from the High Court to the Court of Appeal.

48 As to the dichotomy between the finding of facts and that of evaluation of facts, it was the Respondent's submission that regardless of whether a patents revocation proceeding paralleled a fact finding exercise or one made on evaluation of facts, the appellate court in exercising its discretion was still bound by *Ladd v Marshall* principles in considering whether new evidence should be admitted at a late stage to be reviewed in totality with other evidence presented before the tribunal or court below. In relation to the adduction of evidence under O 87 r 4(3) ROC, the Respondent cited the following passage at 1641 of the Singapore Court Practice 2009:

There is an obligation on the parties to put forward all the evidence on which they intend to rely before the Registrar, and failure to do this does not normally result in indulgence by the court. The court's task on an appeal from the Registrar is to determine whether in all circumstances the overriding objective was furthered by the admission of further evidence. ... *the factors set out in the case of Ladd v Marshall [1954] 2 WLR 1489 are relevant to the exercise of the discretion to admit further evidence.* (emphasis added)

The Respondent submitted that this approach should be followed in relation to adduction of further evidence under O 87A r 13(2) ROC.

Authorities from UK Trade Marks and Patents appeals

49 The Respondent submitted that the approach under O 87 r 4(2) ROC which imported the *Ladd v Marshall* principles to the admissibility of fresh evidence in an appeal from a trade marks tribunal to the High Court should equally apply to that of an appeal from a patents tribunal to the High Court under O 87A r 13(2) ROC. This approach is also supported by UK authorities which dealt with trade marks and patents appeals.

50 In *Allen & Hanburys Limited's (Salbutamol) Patent* [1987] RPC 327 ("*Allen & Hanburys case*"), Dillon LJ at 374 held that an appeal to the Patents Court from the Comptroller was "by way of a rehearing" pursuant to O 104 r 14(14) UK RSC which stated that no further evidence was to be given except with the leave of court. This sub- rule appears to state the same position as O 87A r 13(2) ROC.

51 However, the Respondent submitted that a distinction ought to be drawn between O 104 r 14(14) UK RSC and O 87A r 13(2) ROC as *Allen & Hanburys case* was decided against the backdrop of a statutory framework whereby the Patents Court was empowered by O 104 r 14(18) UK RSC to receive further evidence on questions of fact in such manner as the court may direct and the Patents Court had the power to give any judgment or decision or to make any order which ought to have been given or made by the Comptroller. Hence, Dillon J's holding at 376 that "the hearing in the Patents Court was indeed a re-hearing and not merely a supervisory exercise". A parallel to O 104 r 14(18) UK RSC is notably absent in O 87A ROC.

52 The position stated in *Allen & Hanburys case* may no longer be good law since the UK Civil Procedure Rules 52PD 9.1 now provides that an appeal will not be a re-hearing (as opposed to a review of the decision of the lower court) unless required by any enactment or rule or unless the decision below was reached without a hearing or without consideration of evidence, see *C.I.P.A Guide to the Patents Act* (6th Edition) at [97.08].

53 The Respondent also cited *Gebhardt's Patent* [1992] RPC 1 ("*Gebhardt's Patent case*") which involved an appeal against the Comptroller's decision by the proprietor of patent (relating to a roller train for the conveying and storage of articles) to the Patents Court. This case confirmed the application of *Ladd v Marshall* principles to the adduction of new evidence in an appeal to the Patents Court. Aldous J at 14 also held that the alleged importance of new evidence in itself was not a sufficient ground for its admission.

54 O 104 r 19(14) UK RSC (which the wording of O 87A r 13(2) ROC mirrors) governed the nature of an appeal from the Comptroller to the Patents Court:

(14) An appeal shall be *by way of rehearing* and the evidence used on appeal shall be the same as that used before the Comptroller and *except with the leave of the Court, no further evidence shall be given.* (emphasis added)

55 It was accepted in *Gebhardt's Patent case* that the new evidence was available to the proprietor of the patent and could have been filed before the hearing in the Patent Office. No reason was given why it was not. In refusing to admit the new evidence that should have been filed before the hearing in the Patent Office, Aldous J at 14 explained:

The decision of the superintending examiner was a final decision not akin to Order 14 proceedings. Proceedings before the Comptroller are similar to proceedings before the Registrar of Trade Marks. On an appeal to the High Court from a decision of the Registrar, new evidence can be admitted. However, the general practice of the court on applications to admit new evidence is the same as in the Court of Appeal, namely, to apply the principles laid down in *Ladd v Marshall*

[1954] 3 All ER 743 (see *Oxon Italia SPA's Trade Mark Application* [1981] FSR 408).

56 It was submitted that the application of *Ladd v Marshall* principles in *Gebhardt's Patent case* was consistent with other UK cases dealing with admission of fresh evidence in an appeal hearing before the UK Patents Court (see *Imperial Chemical Industries v Montedison (UK) Ltd & Anor* [1995] RPC 449 at 467) and in UK trade marks appeal proceedings (see *Etat Francaise Representee par la Ministere de L'Agriculture de la Foret v Bernard Matthews plc* [2002] EWHC 868).

Singapore Authorities on Civil Jurisprudence

57 The Respondent further submitted that Singapore cases on civil jurisprudence supported its position that *Ladd v Marshall* principles applied in the case.

58 The Court of Appeal in *WBG Network (S) Pte Ltd v Sunny Daisy Ltd* [2007] 1 SLR(R) 1133 ("*WBG case*") clarified its earlier decision in *Lassiter Ann Masters v To Keng Lam* [2004] 2 SLR(R) 392 ("*Lassiter's case*") which distinguished between the standard to be applied in appeals where:

- (a) There were the characteristics of a full trial or where oral evidence had been recorded (eg, in proceedings of inquiries or in an assessment of damages); and

- (b) Those that were interlocutory in nature.

59 The Court of Appeal in the *WBG case* at [8] recognised that, strictly speaking, *Ladd v Marshall* applied to appeals from the High Court to the Court of Appeal and not to appeals from the Registrar to a judge in chambers. However, the concern in *Lassiter's case* as raised by Chao Hick Tin JA was that a liberal use of wide discretion by a judge in chambers to admit fresh evidence would defeat the very rationale underlying the delegation of matters to the Registrar, ie, to help save judicial time. Such an objective would be lost and could lead to abuse if either party was entitled to freely adduce evidence for the judge at a later hearing.

60 Furthermore, as Prakash J reasoned in *Ang Leng Hock v Leo Ee Ah* [2004] 2 SLR(R) 361 at [15] (affirmed by *WBG case* at [11]):

I think that there is a distinction to be drawn between the adduction of further evidence before the judge in chambers on an appeal from the registrar against a decision on an interlocutory application like an O 14 application, and one that is against a final decision, albeit by a registrar, which has been taken after a full trial on the merits in that discovery has taken place, documents and affidavits of evidence-in-chief have been filed, *viva voce* evidence has been given and the parties have had the opportunity of cross-examining each other's witnesses. In the first case the original evidence would have been only documentary. Any prejudice that might have arisen from allowing further documentary evidence by way of affidavit could have been dealt with easily by giving the other party a right of reply. The second situation is very different. In that case, both parties would have (or should have) prepared for the hearing before the registrar in the same manner as for a trial in the High Court and would have engaged in the discovery exercise and in the cross-examination of witnesses. To allow further evidence to be freely adduced before the judge on appeal could easily lead to abuse of process...

61 It was submitted that *Lassiter's case* at [24] - [26] held that the strict applicability of the second and third conditions of *Ladd v Marshall* principles was confined to cases where the first

instance proceedings contained the hallmarks of a full trial. In contrast, a more liberal judicial discretion for admission of new evidence exists in interlocutory appeals.

62 In this respect, the Court of Appeal in *WBG case* at [14] took the view that a party wishing to adduce further evidence before the judge in chambers in cases where the hearing at first instance did not possess the characteristics of a trial might still have to persuade the judge that he had overcome all three requirements of *Ladd v Marshall* because the judge was entitled, *though not obliged*, to employ the conditions therein in deciding whether to exercise her discretion to admit or reject the further evidence. Hence, in cases where the first instance proceedings did not bear the traits of a full trial, the question of whether *Ladd v Marshall* principles applied to the facts of the case and the extent of application thereof would essentially be left to the court hearing the matter.

63 The Respondent submitted that the present case had been dealt with in a quasi-trial manner as statements and evidence were exchanged and the respective parties' witnesses were examined and cross-examined before the Tribunal. Thus, the second and third conditions of *Ladd v Marshall* should strictly apply even if the Appeal was taken to be a hearing *de novo*.

64 It was the Respondent's submission that the Applicant failed in satisfying (in particular) the second and third conditions of *Ladd v Marshall* as:

- (a) There were ample opportunities in which the Applicant could have conducted the experiment in D4a as it was raised in the Respondent's Notice of Revocation dated 20 January 2006 and had been made available to the Applicant for the last four years to conduct any experiments set out in D4a and submit any evidence therein to the Tribunal during the revocation proceedings;
- (b) The alleged fresh evidence would be of little, if any, value given that the Tribunal had decided that the Applicant's claims were invalid in view of prior art other than that of D4a;
- (c) The Applicant had not shown the credibility of the alleged fresh evidence as the Applicant had not provided any basis in the application for the Respondent's technical experts to verify that the steps and/or procedures to be undertaken in the repeat experiment would be in accordance with the steps and/or procedures set out in D4a.

65 The Respondent also advanced the following factors (apart from the *Ladd v Marshall* principles), which were enumerated in *Wunderkind Trade Mark* [2002] RPC 45 at 937 (approved by *DU PONT Trade Mark* [2004] FSR 15 at [103]), in assisting this court in determining whether it should exercise its discretion in relation to the adduction of fresh evidence in the Appeal:

- (a) Whether or not the Respondent will be significantly prejudiced by the admission of the alleged fresh evidence in a way which cannot be compensated, *eg*, by an order for costs;
- (b) The desirability of avoiding multiplicity of proceedings; and
- (c) Public interest.

The decision of the court

Nature of Appeal under O 87A r 13(2) ROC

66 The fact that a patents revocation appeal under O87A ROC is made from a Tribunal does not necessarily warrant the conclusion that it is identical or analogous to an appeal made under O 55 ROC. A plain reading of the wording of O 87A ROC which stipulated that “except with the leave of the Court, no further evidence shall be given” suggests that the judge’s discretion under O 87A r 13(2) ROC is not as wide as its counterpart under O 55 r 6(2) ROC.

67 Insofar as O 87 ROC provides assistance in the determination of the nature of an appeal under O 87A ROC, it was noted at 1655 of the Supreme Court Practice 2009 that the approach under O 87 ROC concerning trade marks whereby “rehearing” is *not* to be understood as referring to a full *de novo* rehearing of evidence and that the court merely reviews the decision under appeal under its supervisory jurisdiction should be adopted when deciding under O 87A ROC. This supports the analysis in *MediaCorp* and *Valentino* that a “rehearing” under O 87 r 4 ROC is similar to that under O 57 r 13 ROC (*ie*, an appeal from High Court to the Court of Appeal).

68 Further, it is also important to note that the hearing before the Tribunal differed from normal interlocutory applications before a Registrar of the Supreme Court. The proceedings before the Tribunal were akin to a full trial with oral evidence having been adduced and cross-examination having taken place. *Lassiter’s case* which was an appeal against a Registrar’s assessment of damages would therefore provide a better analogy to the application as opposed to one of an interlocutory nature. The statutory framework of the Patents Act read with O 87A ROC suggests that the Tribunal is the proper forum for the taking of evidence and that the High Court sitting in its appellate capacity does not have unbridled powers to introduce fresh evidence after a decision has been rendered by the Tribunal.

69 Hence, by contrasting the language employed by different rules concerning adduction of further evidence under ROC and taking into account the characteristics of a hearing before the Tribunal, it could be seen that the nature of an appeal under O 87A r 13(2) ROC is akin to that from the High Court to the Court of Appeal under O 57 ROC. Notably, this forms a coherent and parallel framework to the adduction of evidence in the context of trade marks appeals.

Application of the Ladd v Marshall principles

70 The authorities which were cited by the Applicant in support of its position that the principles in *Ladd v Marshall* did not apply to the present application did not purport to detract from *Ladd v Marshall*. Laddie J’s judgment in *Hunt-Wesson Inc’s case* as quoted in the Applicant’s submissions should be given adequate scrutiny in order to fully appreciate the reasoning therein. At 241, Laddie J opined:

[T]he hearing before the High Court is a rehearing. In my view the more appropriate course to adopt now is to look at all the circumstances, *including those factors set out in Ladd v Marshall* and to decide whether on the particular facts the undoubted power of the court to admit fresh evidence should be exercised in favour of doing so. (emphasis added)

Laddie J therefore did not decide that the principles in *Ladd v Marshall* were irrelevant in the context of adduction of further evidence in a trade marks appeal. It is clear that Laddie J contemplated that *Ladd v Marshall* factors were to be taken into account, albeit to be considered with/against other

factors as stated in *Hunt-Wesson Inc's case*.

71 Pumfrey J in *Wunderkind Trade Mark* [2002] RPC 45 at [57] held that:

There is no doubt that in a trade mark appeal other factors outside the *Ladd v Marshall* criteria may well be relevant. Thus in my judgment it is legitimate to take into account such factors as those enumerated by Laddie J in *Hunt Wesson*, *provided always that it is remembered that the factors set out in Ladd v Marshall are basic to the exercise of the discretion to admit fresh evidence and that those factors have peculiar weight when considering whether or not the overriding objective [ie, of dealing with individual cases justly] is to be furthered.* (emphasis added)

This passage was cited with approval by the English Court of Appeal in *E I Dupont v S T Dupont* [2006] 1 WLR 2793.

72 The cases cited by the parties appear to me to be merely variations or different formulations of what essentially were the *Ladd v Marshall* principles. For instance, Jeffery Pinsler SC in Singapore Court Practice 2009 noted at 1641 that some of the eight factors expounded by Laddie J in the "somewhat relaxed approach" in *Hunt-Wesson Inc's case* were similar to those in *Ladd v Marshall* while others were of particular relevance to trade marks.

73 Moreover, Aldous J's observation in respect of O 104 r 19(14) UK RSC in *Gebhardt's Patents case* that the practice of the UK court has been to refuse to admit new evidence, save in exceptional cases, unless the new evidence was not in the possession of the party seeking to introduce it and that such party could not with reasonable diligence have obtained the evidence for use at the hearing in the Patent Office, was also a variation of the first condition of *Ladd v Marshall*. Essentially, the *Ladd v Marshall* principles are "simple and sensible directions" (in *WBG case* [15]) which revolve around one enquiry that goes towards the justice of the case: why did the applicant not adduce the evidence before the Tribunal given its alleged importance.

74 As the Court of Appeal in *WBG case* at [11] noted, the position in *Lassiter's case* should not be construed as any form of unqualified endorsement of any rule that the second and third conditions of *Ladd v Marshall* must necessarily apply in all circumstances, whether they be appeals from an assessment of damages before the Registrar or in respect of interlocutory applications. Given that the Court of Appeal in *WBG case* at [14] also envisaged that even in cases where the first instance proceedings did not manifest the characteristics of a trial, the applicant in an application to adduce further evidence might still have to persuade the judge that he had overcome all three requirements of *Ladd v Marshall*, I am of the view that *Ladd v Marshall* should apply where leave is sought to adduce further evidence, albeit with appropriate modifications if the nature of the appeal and the factual matrix of the case so require.

75 The experiment in D4 ought to have been done before the hearing or applied for during the hearing or, at the very least, between the close of hearing and the decision by the Tribunal (a period of some 8 months). The Applicant's position that the necessity of conducting the experiment only arose during cross-examination did not explain why the application to adduce fresh evidence should only take place at the appeal stage. The Applicant's inaction over the period between 12 February 2009 to 3 November 2009 shows a lack of due diligence in securing all relevant evidence before the Tribunal.

76 After the hearing of the application before me, counsel for the Applicant, by way of a letter dated 19 March 2010 requesting further arguments pursuant to s 34(1)(c) SCJA, informed me that

"After the date of the hearing, we learned that the Applicant had already conducted a repeat of Example 1 in D4 (as referred to in the application) and had obtained the results referred to below". This was surprising as the application had proceeded on the basis that the Applicant *wanted to conduct the experiment* and place the results before the appellate court. If the experiment had been conducted prior to the hearing of the application, the question immediately arises as to why the Applicant did not file any affidavit relating to the experiment and its outcome to support its application to adduce the fresh evidence. This was despite the Respondent having filed an affidavit to oppose the application, alleging that the Applicant had not explained how and in what manner the fresh evidence would be relevant or have an important influence on the outcome of the appeal (see [4] of the affidavit of Kristian J Robinson filed on 1 February 2010). The Applicant's failure to properly instruct its counsel about having conducted the experiment before the application places it in poor light when the court decides whether or not to exercise its discretion to admit the fresh evidence.

77 It was submitted (in the request for further arguments) that the result of the experiment conducted by the Applicant was crucial and highly relevant to the Appeal as the Applicant's findings revealed that the oil produced by following Example 1 in D4 did not meet the requirement of claim 1 of the Patent, *ie*, that the oil must comprise at least 50% arachidonic acid. This would cast doubt on the accuracy of the results in Table 1 of D4 which stated that 72.9% arachidonic acid could be produced. The court was therefore urged not to accept the results stated in D4 at face value.

78 In its response by letter dated 29 March 2010, the Respondent objected to the request for further arguments. The Respondent criticised the Appellant's failure and/or neglect to instruct its counsel about the alleged experiment and asked why, if it was so important, the Applicant did not produce it at the hearing of its application. The Respondent further submitted that the alleged experiment would not have any major or influential bearing upon the Appeal. This was because even if there was an inaccuracy in D4, the Tribunal's decision was that the Patent was also invalid in view of prior art *other than* D4. As illustrated by the Respondent:

- (a) The Applicant alleged that the Tribunal erred in finding that claims 3, 26 and 36 were not novel and inventive over D1, D2 and D4a. The Tribunal's grounds of decision at [152] clearly showed that even if D4a was not considered, the features of claims 3, 26 and 36 that cells of *Mortierella alpina* produce arachidonic acid but not EPA when incubated at 25 °C was disclosed in D1 and D2;
- (b) [156] of the grounds of decision showed that even if D4a was not considered, the feature claims 4, 27 and 37 that the oil was obtainable by submerged fermentation of *Mortierella alpina* was disclosed in D7;
- (c) The Applicant's claim 24 which disclosed the feature of use of hexane as the non-polar solvent was anticipated by both D4a and D7. Hence, in any event, claim 24 would be anticipated by the disclosure in D7;
- (d) Similarly, claim 2 lacked novelty in view of D7 alone whereas claims 1 to 19 and 35 to 44 lacked inventive step in view of any one of prior arts D1, D2, D6 or D7. Even if D4a was not considered, the claims 1 to 19 and 35 to 44 would lack inventiveness in view of the aforementioned prior art references.

Moreover, without enclosing any report or result of the alleged experiment, the Respondent's experts would be in no position to verify the credibility of the alleged result.

79 I agreed with the Respondent and did not accede to the request for further arguments. Apart from causing undue delay to the Appeal proceedings, granting leave to adduce the fresh evidence would entail a re-opening of the revocation hearing and further taking of evidence by a judge of the High Court. This would be inconsistent with the statutory scheme in which the taking of evidence is within the purview of the Tribunal. If I were to direct that the Tribunal to conduct the further hearing in respect of the fresh evidence, the status of the Patent would be in limbo again. All this would be unjustifiable in the light of the Applicant's conduct relating to this application (see [\[75\]](#)).

Conclusion

80 For the foregoing reasons, the application in Summons No 234 of 2010 was dismissed with costs of \$5,500 (inclusive of disbursements) to be paid by the Applicant to the Respondents as costs of this application.

81 The Applicant has appealed to the Court of Appeal against my decision.

Copyright © Government of Singapore.