

Towa Corp v ASM Technology Singapore Pte Ltd and another  
[2015] SGHCR 4

**Case Number** : Suit No 359 of 2013 (Summons No 4919 of 2014 and Summons No 5125 of 2014)  
**Decision Date** : 02 February 2015  
**Tribunal/Court** : High Court  
**Coram** : Justin Yeo AR  
**Counsel Name(s)** : Mr Foo Maw Jiun and Mr Ng Chong Yuan (Rodyk & Davidson LLP) for the Plaintiff;  
Mr Daniel Lim (Joyce A Tan & Partners) for the Defendants.  
**Parties** : Towa Corp — ASM Technology Singapore Pte Ltd and another

*Civil Procedure – Discovery*

*Patents and Inventions – Infringement*

2 February 2015

**Justin Yeo AR:**

1 Towa Corporation (“the Plaintiff”) commenced the present suit against ASM Technology Singapore Pte Ltd (“the First Defendant”) and ASM Pacific Technology Ltd (“the Second Defendant”) for infringement of the Plaintiff’s Singapore Patent No SG49740 (“the Patent”). The allegedly infringing machine is known as the IDEALmold machine.

2 The brief background to this suit was set out previously in my earlier decision of *Towa Corporation v ASM Technology Singapore Pte Ltd* [2014] SGHCR 16. The Plaintiff is a company incorporated in Japan and is the proprietor of the Patent (a patent for moulding resin to seal electronic parts such as semiconductor devices). The First Defendant is incorporated in Singapore and carries on the business of providing semiconductor equipment and materials. It is a wholly owned subsidiary of the Second Defendant, a company incorporated in the Cayman Islands that is publicly listed in Hong Kong. The First and Second Defendants are referred to collectively as “the Defendants”.

3 The Defendants applied by way of Summons No 4919 of 2014 seeking specific discovery of 13 categories of documents (“the Defendants’ Application”). The Plaintiff applied by way of Summons No 5125 of 2014 seeking specific discovery of eight categories of documents (“the Plaintiff’s Application”). Both applications were brought under O 24 r 5 of the Rules of Court (Cap 322, R 5, 2006 Rev Ed) (“Rules of Court”), with reference also made to O 87A r 5 of the Rules of Court.

**The Defendants’ Application**

4 The Defendants applied for specific discovery of 13 categories of documents, although two categories (*ie* Categories 4 and 13) did not eventually have to be dealt with (see [32] and [55] below).

**Category 1**

5 Category 1 of the Defendants’ Application related to documents concerning issues of validity of

the Patent:

All documents (including internal discussions and correspondence with external parties) relevant to any ground in which validity of the Patent has been put in issue (novelty, obviousness and insufficiency) that came into existence within the period beginning 2 years before the earliest claimed priority date and ending two years after that date ie., 22 July 1991 – 22 July 1995, namely relating to:

the following words or phrases used in the Patent claims:

- (a) "adjusting the number of molding units";
- (b) "detachably mounting an additional molding unit";
- (c) "molding unit being already provided in an apparatus for molding resin to seal electronic parts";
- (d) "setting a number of said unsealed lead frames having electronic parts mounted thereon in prescribed positions of a lead frame supply unit";
- (e) "being rendered detachably mountable";
- (f) "with respect to the said already provided molding unit"; and
- (g) "thereby freely increasing/decreasing the number";

and any similarity and/or difference between the feature or features in claims 1, 2, 4 or 5 of Patent and any corresponding feature or features disclosed in the following:

- (h) Japanese Patent Publication No. JP61148016 (A) ("*Hitachi*");
- (i) Japanese Patent Publication No. JP59207635 (A) ("*NEC Kyushu*"); and
- (j) the ASA 808K 4-press molding machine ("ASA 808K") inspected by the Plaintiff on 20 August 2014.

6 The Plaintiff contended that the Patent had never been challenged prior to this suit, and therefore, no documents fell within this category. [\[note: 11\]](#) This was premised on a narrow reading of Category 1, in an attempt to limit the category to challenges as to the validity of *the Patent* rather than the grounds on which validity has been put in issue.

7 I disagreed with the Plaintiff's narrow reading of Category 1. While the narrow reading was plausible at first blush, I agreed with the Defendants that Category 1 was not limited to previous challenges to the Patent. Rather, what the Defendants were seeking were documents relevant to the issues of validity (*ie* novelty, obviousness and insufficiency).

8 However, there were difficulties in determining how the documents sought in Category 1 differed from those that potentially fell within Categories 2, 3 and 6. Counsel for the Defendants submitted that "Category 1 is a larger circle" while the other categories were probably overlapping circles. He suggested that examples of possible documents in Category 1 that did not overlap with Categories 2, 3 and 6 were inventors' notes or discussions within the Plaintiff's organisation. I was not

convinced that these were significantly different from what was sought in Categories 2, 3 and 6. Category 2 dealt with documents relating to the Plaintiff's research leading to the invention in the Patent, Category 3 dealt with documents relating to the Plaintiff's opinions expressed in other jurisdictions on the Plaintiff's foreign patents, while Category 6 dealt with documents relating to experimental work up to the date of publication of the Patent. As the Defendants could not pinpoint any types of documents that would not already fall within Categories 2, 3 and 6, I did not grant specific discovery of Category 1.

### **Categories 2 and 6**

9 Categories 2 and 6 of the Defendants' Application can be dealt with together.

(a) Category 2 of the Defendants' Application concerned documents relating to the Plaintiff's research leading to the invention in the Patent:

All documents (including internal discussions and correspondence with external parties) relating to the Plaintiff's research leading to and concerning the alleged invention in the Patent relevant to any ground in which validity of the Patent has been put in issue on the grounds of obviousness or insufficiency, namely relating to:

the following words or phrases used in the Patent claims:

- (a) "adjusting the number of molding units";
- (b) "detachably mounting an additional molding unit";
- (c) "molding unit being already provided in an apparatus for molding resin to seal electronic parts";
- (d) "setting a number of said unsealed lead frames having electronic parts mounted thereon in prescribed positions of a lead frame supply unit";
- (e) "being rendered detachably mountable";
- (f) "with respect to the said already provided molding unit";
- (g) "thereby freely increasing/decreasing the number";

and any similarity and/or difference between the feature or features in claims 1, 2, 4 or 5 of Patent and any corresponding feature or features disclosed in the following:

- (h) *Hitachi*;
- (i) *NEC Kyushu*; and
- (j) the ASA 808K inspected by the Plaintiff on 20 August 2014.

(b) Category 6 of the Defendants' Application concerned documents relating to experimental work up to the date of publication of the Patent:

All documents (including internal discussions and correspondence with external parties) relating to experimental work up to the date of publication of the Patent relating to the

following words or phrases used in the Patent claims:

- (a) "adjusting the number of molding units";
- (b) "detachably mounting an additional molding unit";
- (c) "molding unit being already provided in an apparatus for molding resin to seal electronic parts";
- (d) "setting a number of said unsealed lead frames having electronic parts mounted thereon in prescribed positions of a lead frame supply unit";
- (e) "being rendered detachably mountable";
- (f) "with respect to the said already provided molding unit"; and
- (g) "thereby freely increasing/decreasing the number".

10 Mr Yasushi Ukai ("Mr Ukai"), who filed the relevant affidavits on behalf of the Plaintiff, had confirmed on oath that while the documents in both Categories 2 and 6 were relevant, the documents were no longer in the Plaintiff's possession, custody or power. In this regard, he explained that documents concerning the Plaintiff's research were created 20 years ago, and that at that time, the Plaintiff had no internal rules regulating the retention period of research documents. [\[note: 2\]](#) He has also explained that the research documents were disposed of when the Plaintiff shifted its operations to another building in 1997. [\[note: 3\]](#)

11 Counsel for the Defendants argued that Mr Ukai's explanations were inadequate because Mr Ukai did not state how he attempted to locate the necessary documents, and should therefore be made to explain the basis for his beliefs in greater detail. Counsel for the Defendants also pointed out that Mr Ukai is a Managing Director of the Plaintiff's subsidiary rather than an employee of the Plaintiff, and argued that somebody with personal knowledge of what had happened 20 years ago should be made to depose an affidavit instead.

12 Mr Ukai is authorised by the Plaintiff to file the relevant affidavits in these applications. While Mr Ukai admittedly does not have personal knowledge from two decades ago, he has stated on oath that the facts and matters deposed to are either derived from his personal knowledge or based on instructions or from documents to which he has access. [\[note: 4\]](#) It is neither reasonable nor necessary (for disposing fairly of the cause or matter or for saving costs) to order, for the purposes of this specific discovery application, a company to locate its employees who had personal knowledge of events occurring 20 years ago, particularly when the authorised deponent has already confirmed the Plaintiff's present position on oath. There was also no evidence before me that Mr Ukai's position and explanations ought to be disbelieved. I therefore did not grant discovery of Categories 2 and 6.

### **Category 3**

13 Category 3 of the Defendants' Application concerned documents relating to the Plaintiff's opinions expressed in other jurisdictions on the Plaintiff's foreign patents:

All documents (including internal discussions and correspondence with external parties) relating to the Plaintiff's opinions expressed in other jurisdictions as disclosing the Plaintiff's counter to attacks on validity and the Plaintiff's approach to infringement.

14 This request was made against the backdrop that there were judgments in other jurisdictions where the Plaintiff's foreign patents, which are the equivalent of the Patent, have been challenged on the same issues of validity and infringement. The Plaintiff has agreed to disclose these judgments, but there has been some delay in disclosure because the relevant judgments have to be translated into the English language. [\[note: 5\]](#)

15 Counsel for the Defendants argued that the disclosure of the Plaintiff's opinions and submissions leading up to those decisions "is probably more important than the decision itself". He therefore sought disclosure of the Plaintiff's opinions expressed and submissions made in other jurisdictions. As authority for this request, he cited paragraph 87A/5/3 of *Singapore Civil Procedure 2015* vol 1 (G P Selvam gen ed) (Sweet & Maxwell Asia, 2014) ("*Singapore Civil Procedure*") for the proposition that discovery should be ordered of "opinions expressed in yet other jurisdictions as disclosing the patentee's to attacks on validity and his approach to infringement".

16 The proposition he cited was based on the English decision of *Vickers plc v Horsell Graphic Industries Ltd* [1988] RPC 21 ("*Vickers*"). However, immediately after the cited proposition, the learned authors of *Singapore Civil Procedure* went on to observe that the position in *Vickers* was *not* followed in the subsequent English case of *Glaverbel SA v British Coal Corp (No 2)* [1992] FSR 642 ("*Glaverbel*"). A later part of the same paragraph stated, citing *Glaverbel*, that "[a] patentee's equivalent foreign specifications cannot assist with construction of a United Kingdom patent and discovery of the same will not be ordered". I turn to consider the cases of *Vickers* and *Glaverbel*.

17 *Vickers* concerned a patent infringement action in the UK, in which the plaintiffs sought discovery of documents dealing with the prosecution of comparable patents in the United States. The plaintiffs succeeded in their application. The court held that opinions which may have been expressed "are at the end of the day not necessarily likely to be conclusive and may indeed prove to be of only limited importance", but that these opinions may nonetheless be of some assistance (*Vickers* at 423). For instance, such opinions may disclose "the line which may be taken in connection with the defence to the attack upon the validity" as well as the "approach to the issue of infringement" (*Vickers* at 423).

18 This decision was not followed in the subsequent case of *Glaverbel*. In *Glaverbel*, the defendants applied for, *inter alia*, "[a]ll documents relating to the application abroad for patent protection equivalent to [the patents in suit] and which relate to any issue of these proceedings and in particular to opinions expressed or experiments conducted..." (*Glaverbel* at 643). The court held that on the issues of novelty and obviousness, the patent owner's opinions were not relevant (*Glaverbel* at 645). The court opined that in *Vickers*, relief had been granted "without... analysing what issue in the action such documents would be relevant to", because the court in *Vickers* was of the view that disclosure would have assisted in providing material for cross-examination (*Glaverbel* at 645). However, the court in *Glaverbel* noted that in a situation (such as the case in *Glaverbel* itself) where witness statements would be disclosed before the hearing, and where such statements will set out the nature of the parties' cases and allow the parties to know in advance the basis of any possible cross-examination, the reasoning in *Vickers* would not be applicable (*Glaverbel* at 645-646).

19 *Glaverbel* was cited in the *CIPA Guide to the Patents Act* (7th Ed, Sweet & Maxwell, 2014) for the proposition that:

... it is generally inadmissible to present evidence to a court on the interpretation which a patentee puts on his claims, particularly as regards corresponding foreign patents, because construction is a matter for the court relying only on evidence on the meaning of technical terms

and the background knowledge of the skilled addressee, and this construction is incapable of being altered by evidence of how such persons subsequently acted upon or interpreted it.

20 Analysing *Glaverbel*, the learned author of *Singapore Court Practice 2009* (Jeffrey Pinsler gen ed) (LexisNexis, 2009) stated at paragraph 87A/5/2 that:

Documents relating to the following are not relevant for discovery:

... direct evidence of the subjective intentions, thoughts and opinions of the inventor and his professional advisers and agents, including pre-existing documentary evidence of those intentions and opinions as might be found in correspondence passing between his patent agent and the patents registry or in documents relating to applications for corresponding foreign patents;

....

21 The *Glaverbel* decision is in line with the fundamental understanding in patent law that it is ultimately for the court, and not the patent proprietor or witnesses, to come to conclusions about the construction of a patent claim. This is, however, subject to the exception about technical terms with a special meaning, on which evidence might be admissible (*Qualcomm v Nokia* [2008] EWHC 329 ("*Qualcomm*") at [9]; *Abbott Laboratories Limited v Medinol Limited* [2010] EWHC 1731 (Pat) ("*Abbott*") at [9]).

22 In the context of relevance of submissions made in foreign jurisdictions, *Abbott* is also relevant for two other reasons given by the court for finding that it was not appropriate to order the disclosure sought:

(a) First, the court noted that the proceedings before foreign courts (in *Abbott*, the courts of the United States) must necessarily have involved different infringing products and been decided according to different substantive and procedural laws (*Abbott* at [10]).

(b) Second, the court noted that the party seeking discovery was in fact seeking to examine evidence given in other actions and proceedings "with a view to seeking to identify some inconsistency between that evidence and the evidence they give in this action" (*Abbott* at [11]). However, no such inconsistency had come to light hitherto in *Abbott*.

23 For completeness, the fact that patent construction is an objective exercise to be undertaken by the court means that the patentee's internal documentation, which may provide insight into how he interpreted his claim, is irrelevant as well. In *Qualcomm*, Floyd J observed that there was a sustained attempt by one party to make use of the other party's confidential internal documents on the issue of construction, and unequivocally declared that such an attempt was "both wrong and counterproductive". It was "wrong", because the process of patent construction was intended to "elicit objectively what the patentee's intention is, not to inquire into his subjective intention" (*Qualcomm* at [5]–[6]). Indeed, if the effect of an internal document would result in an interpretation different from that which would be arrived without it, the patent would potentially mean different things to different people at different stages of time (*ibid*). It was "counterproductive", because it would lead to "lengthy and irrelevant satellite arguments as to the meaning and effect of other documents" (*ibid*).

24 In summary, the general position in the UK is that discovery will not usually be ordered relating to how a party has construed expressions in equivalent patents, at least where the relevant expressions are not terms of art (see *Terrell on the Law of Patents* (Sweet & Maxwell, 17th Ed, 2011)

(“*Terrell*”) at paragraph 9–83; see also *Qualcomm* and *Abbott*). It also follows that discovery of opinions expressed or submissions made in other jurisdictions concerning comparable patents will not generally be allowed (see, *eg*, *Glaverbel* and *Abbott*).

25 Disagreeing with the line of English authorities set out above, counsel for the Defendants cited the Singapore Court of Appeal decision of *First Currency Choice Pte Ltd v Main-Line Corporate Holdings Ltd and another appeal* [2008] 1 SLR(R) 335 (“*First Currency*”). He argued that *First Currency* stood for the proposition that it is relevant to review proceedings on comparable patents in other jurisdictions. For this purpose, he surmised, submissions made by counsel in those foreign proceedings were also relevant. In particular, he referred to *First Currency* at [2]:

The present legal skirmish between the principal parties is but part of a wider legal feud now taking place in a number of different jurisdictions. This is not unusual in today’s “flat” world, where businesses have similar interests and rights to protect in several different jurisdictions. A “flat” world is, however, far from being an “ideal” world, where the outcome would be similar regardless of where the legal jousting takes place. In a “flat” world, the outcomes of the parties’ legal differences may not, eventually, be the same in each jurisdiction because of varying statutory matrices and prevailing administrative practices. *Ultimately, it must also be acknowledged that an adjudication on patent rights is predicated upon not only the applicable regulatory framework and practices, but also the evidence presented as well as the submissions made to the tribunal concerned.* Care must therefore be taken by counsel when referring to and/or relying on another apparently similar decision on the “same” issue from another jurisdiction. With this brief preface, we now turn to the facts. [emphasis added]

He further pointed out that the Court of Appeal had in fact gone on to consider in some detail the proceedings in New Zealand (*First Currency* at [56]–[58]) and Australia (*First Currency* at [68]–[74]). He therefore argued that specific discovery of Category 3 should be granted.

26 I did not order specific discovery of the documents in Category 3, for two reasons.

27 First, the general English position on the discovery of opinions expressed and submissions made in other jurisdictions coheres well with the fundamental notion that a court construes a patent objectively, while adopting the mantle of the notional addressee to whom the patent is directed in the light of the common general knowledge with which that addressee is assumed to be imbued (*Dyson v Hoover* (2001) RPC 26 at [48(f)]; cited in *Terrell* at paragraph 9–81). The general position also provides a useful sieve that safeguards against excessive and unnecessary disclosure of secondary evidence (see, in the context of inventors’ notes, *Syntroleum Corp v Neste Oil Singapore Pte Ltd* [2014] SGHCR 18 at [29]).

28 Regarding the Defendants’ arguments on *First Currency*, it must be emphasised that there was no express finding by the Court of Appeal in *First Currency* that opinions expressed in other jurisdictions are relevant and therefore discoverable. Only one paragraph out of 96 in that decision involved any observation on submissions made in foreign jurisdictions, and even so, within that paragraph itself, the Court of Appeal appeared to be emphasising the point that foreign decisions must be looked at with some circumspection. The reason for this, as is evident from [2] of *First Currency*, is because the foreign court, in coming to its decision, might have had to grapple with a different regulatory framework, different practices, different evidence and different submissions from counsel. Even though the Court of Appeal did refer to proceedings in New Zealand and Australia, it did not, at least as far as is evident from the reported decision, call for or examine the submissions of counsel leading to those foreign decisions. In my view, therefore, *First Currency* cannot be relied upon to argue that an established line of English authority on discovery in patent applications is not

applicable in Singapore.

29 The Defendants have therefore not shown that there is any reason to depart from the general English position on discovery of opinions expressed and submissions made in other jurisdictions. Even the limited exception for “terms of art” or “technical terms” did not apply in the present case because the Defendants have not made specific reference to any such terms for the purposes of Category 3. They have also failed to show how the documents sought in Category 3 are relevant towards the meaning of such terms (if such terms exist).

30 Second, as a matter of practicality, it cannot be the case that all legal submissions and opinions expressed in other jurisdictions are relevant and ought to be disclosed as a general principle. Discovery is always subject to the test of necessity, as set out in O 24 r 7 of the Rules of Court:

**Discovery to be ordered only if necessary (O. 24, r. 7)**

On the hearing of an application for an order under Rule 1, 5 or 6, the Court may, *if satisfied that discovery is not necessary, or not necessary at that stage of the cause or matter*, dismiss or, as the case may be, adjourn the application and shall in any case refuse to make such an order if and so far as it is of opinion that *discovery is not necessary either for disposing fairly of the cause or matter or for saving costs*. [emphasis added]

31 Even assuming for the moment that the documents in Category 3 (and in particular, the submissions of counsel in other jurisdictions) are relevant, it is not necessary at the present stage of proceedings to order discovery of the same. The Court of Appeal’s statement in [2] of *First Currency* was premised on a situation where the court already had the relevant foreign decisions before it. In the present case, the Defendants have not even had sight of the foreign judgments (see [14] above). Without an understanding of what precisely is being relied on in the foreign judgments, or if the foreign judgments are going to be relied upon at all, it cannot be necessary, for disposing fairly of the cause or matter or for saving costs, to order discovery of Category 3 documents at this point. In this regard, it should also be noted that the relevant foreign submissions are “primarily in the Japanese language”, and that Mr Ukai has given evidence that the Plaintiff will be put to significant inconvenience and expense should discovery be ordered. [\[note: 6\]](#)

**Category 4**

32 Category 4 of the Defendants’ Application was “deliberately left blank” by the Defendants. It originally concerned documents relating to problems with the prior art. However, the Plaintiff had conceded that this category was relevant and agreed to disclose the documents. The category remained in the Defendants’ Application so as to preserve the numbering of the other categories and minimise confusion between the parties. I made no order on Category 4.

**Category 5**

33 Category 5 of the Defendants’ Application concerned documents relating to licences granted by the Plaintiff, and copies of all such licences, relating to the alleged invention in the Patent, whether in Singapore or elsewhere:

All documents (including internal discussions and correspondence with external parties) relating to all licence(s) granted by the Plaintiff, and copies of all such licences, relating to the alleged invention in the Patent, whether in Singapore or elsewhere.



34 The Defendants pointed out that in a letter issued by the Plaintiff prior to the present suit, the Plaintiff declared that it had “already concluded license agreements individually with four competitors”. [\[note: 7\]](#) At the hearing, counsel for the Defendants argued that Category 5 documents were relevant and should be disclosed as the documents may lead to a train of inquiry on whether the defence in s 51(2) of the Patents Act (Cap 221, Rev Ed 2005) (“the Patents Act”) applies.

35 Section 51(2) of the Patents Act provides:

In proceedings against any person for infringement of a patent, it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent made by or with the consent of the plaintiff or a licence under the patent granted by him or with his consent and containing in either case a condition or term void by virtue of this section.

36 Section 51 of the Patents Act deals with “tie in” contracts and licences entered into or granted by the patent proprietor after 23 February 1995 and prior to 1 December 2008 (s 50A of the Patents Act; see also Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Ed, 2014) (“*Law of Intellectual Property of Singapore*”) at paragraph 34.4.2). The “tie in” situations essentially involve the patent proprietor attempting to:

- (a) Tie his licensee to acquire “anything other than” the patented product from the patent proprietor or his nominee (s 51(1)(b) of the Patents Act); or
- (b) Prohibit or restrict the rights of his licensee to use articles that are not supplied by the him or his nominee (s 51(1)(c) of the Patents Act).

37 In such “tie in” situations, the patent proprietor is seeking to extend his monopoly beyond the market for his invention (*Law of Intellectual Property of Singapore* at paragraph 34.4.2). The penalty for engaging in such anti-competitive practice is severe: the existence of a “tie in” contract provides a defence, under s 51(2) of the Patents Act, to “any person” sued for infringement by the patent proprietor (*ibid*).

38 The Defendants argued that it was suspicious that the Plaintiff would licence competitors in the context of and under the cloud of a threat of infringement, and that this “raises the spectre” that the Plaintiff has engaged in anti-competitive behaviour. This, it is argued, should entitle the Defendants to discovery of the licences. [\[note: 8\]](#) The Defendants also argued that even licences granted overseas might cover the Patent (which is registered in Singapore), and that “the question of whether licenses cover the [Patent] needs to be determined from the licence documents themselves”. [\[note: 9\]](#) The Defendants further contended that if the Plaintiff had granted licences to competitors, it was “not likely that the competitors would only trade in Japan, but would export products to other countries where the Plaintiff received patent rights in the invention claimed”, and that the “licences would be likely to expressly or impliedly cover the import of products into Singapore and the use of the process in Singapore”. [\[note: 10\]](#)

39 I did not grant discovery of Category 5 documents. The Defendants have not pleaded the defence in s 51(2) of the Patents Act, and should not be allowed to seek discovery on issues that are not pleaded (see, eg, *Tan Chin Seng v Raffles Town Club* [2002] 2 SLR(R) 465 at [17]–[19]). Furthermore, s 51(2) of the Patents Act, read with the definition of “patent” under s 2(1) of the Patents Act (“... a patent under this Act ...”), means that the defence in s 51(2) of the Patents Act only applies where the licence is granted with regard to the Singapore patent in question (*ie*, in the present case, the Patent). In this regard, Mr Ukai has also already confirmed on oath that no licences

for the Patent were granted. [\[note: 11\]](#) All that the Defendants could offer was a speculative argument that there *might* be foreign licences that “expressly” or “impliedly” covered the Patent (whether “expressly” or “impliedly”).

### **Category 7**

40 Category 7 of the Defendants’ Application concerned “[a]ll documents (including internal discussions and correspondence with external parties) relating to the Plaintiff’s receipt of, and discussions following such receipt” of certain documents disclosed in the Plaintiff’s list of documents. The documents were:

- (a) Items 3, 4, 5, 9, 10, 14, 18: Copies of documents from the First Defendant;
- (b) Item 13: Document related to a third party re-sale of a particular IDEALmold machine;
- (c) Items 19 and 20: Copies of extracts of the operation manual of prior art; and
- (d) Item 21: Eight photographs of nameplates that are referred to in the pleadings.

41 The Defendants argued that these documents were relevant to their defences of delay, laches and acquiescence. [\[note: 12\]](#) This is because the length of time from the date on which the Plaintiff learnt of the IDEALmold machine (which has been in the market since 1999 or 2000) and the date that the Plaintiff decided to allege infringement would be relevant to such defences. [\[note: 13\]](#) The Defendants’ position was that the Plaintiff had to disclose every document related to *when* it learnt about the Defendants’ product, and *why* it did not commence an action at an earlier time.

42 The Plaintiff contended that:

- (a) First, the Defendants have not (i) provided any particulars of the defences of delay, laches and acquiescence, (ii) alleged that there was any substantial lapse of time connected with the dates of the Plaintiff’s receipt of the documents; and (iii) alleged any circumstances which, together with any substantial lapse of time, are required to invoke the defence (citing *Dynasty Line Ltd (in liquidation) v Sukanto Sia* [2014] 3 SLR 277 at [58]).
- (b) Second, Mr Ukai has stated on oath that the Plaintiff has not kept any records concerning the receipt of items 3, 4, 5, 9, 10, 18, 19, 20 and 21. [\[note: 14\]](#) As for items 13 and 14, Mr Ukai has confirmed that these were simply printouts from webpages in the course of a search on the internet, that the searches were made by the Plaintiff’s solicitors, and that the documents concerning the Plaintiff’s receipt of the documents were therefore privileged. [\[note: 15\]](#)

43 The Defendants counter-argued that it was “not believable” that the Plaintiff had not kept records, since there would be records of receipt in the Plaintiff’s computers, servers, and amongst the employees that had anything to do with any discussion over the documents. [\[note: 16\]](#)

44 I did not grant discovery of Category 7 documents, for two reasons:

- (a) First, Category 7 is phrased in a manner that is much wider than is necessary to discover the dates which the Plaintiff had received the documents. Furthermore, items 3, 4, 5, 9, 10, 14, 18 were documents originating from the First Defendant. The Defendants have not shown that the dates of creation of those documents were such that there was a possibility that these

documents were received by the Plaintiff so early in time that the defences of delay, laches and acquiescence may be applicable.

(b) Second, Mr Ukai has already stated on oath that the Plaintiff has not kept records concerning the receipt of items 3, 4, 5, 9, 10, 18, 19, 20 and 21, and that items 13 and 14 are privileged items. There does not seem to be any reason to disbelieve Mr Ukai's affidavit evidence at this point in time.

### **Categories 8, 9 and 10**

45 Categories 8, 9 and 10 of the Defendants' Application concerned documents relating to the Plaintiff's creation of, compilation and notations on an exhibit ("NCY-3") in the Plaintiff's application for service of process out of jurisdiction. In these categories, the Defendants sought the following:

[Category 8] All documents (including internal discussions and correspondence with external parties) relating to the Plaintiff's creation and compilation of exhibit "NCY-3" in the Plaintiff's affidavit dated 7 May 2013.

[Category 9] All documents (including internal discussions and correspondence with external parties) relating to the Plaintiff's creation and notations made to the 1<sup>st</sup> page of exhibit "NCY-3" in the Plaintiff's affidavit dated 7 May 2013.

[Category 10] All documents (including internal discussions and correspondence with external parties) relating to the Plaintiff's creation and notations made to the 4<sup>th</sup> page of exhibit "NCY-3" in the Plaintiff's affidavit dated 7 May 2013.

46 Counsel for the Plaintiff explained that the documents in NCY-3 were compiled by the Plaintiff to make it easier for the reader of NCY-3 to understand the technical aspects of the IDEALmold machine, and that the annotations were made to emphasise the more pertinent sections. [\[note: 17\]](#)

47 The Defendants contended that because NCY-3 was compiled and annotated with the intention of clarifying and emphasising the pertinent sections of NCY-3, Categories 8, 9 and 10 were therefore relevant. A choice had been made on the selection (and non-selection) of documents, and this choice might be relevant to the issues in the present suit.

48 I did not order discovery of Categories 8, 9 and 10, for three reasons:

(a) First, the Defendants have not identified any pleaded issues that the creation, compilation or annotation of NCY-3 could be relevant to. The fact that NCY-3 might be relevant does not automatically make its creation, compilation or annotations relevant.

(b) Second, pages 1-3 of NCY-3 were extracted from documents which have already been disclosed to the Defendants in the Plaintiff's list of documents, while page 4 of NCY-3 is simply a picture of the adjoining portion of the moulding units of the IDEALmold machine placed together with a drawing of the IDEALmold machine extracted from documents already disclosed. [\[note: 18\]](#) It is not the case that the Defendants have not seen the source documents, or dispute the accuracy of the compilation. It should also be noted that Mr Ukai has confirmed that the Plaintiff has no other documents related to the creation and compilation of NCY-3. [\[note: 19\]](#)

(c) Third, the Defendants were effectively seeking an *explanation* on why certain annotations

were made, or certain documents selected. It therefore appeared that they were trying to elicit the Plaintiff's *opinion* on the IDEALmold machine through Categories 8, 9 and 10. Such an endeavour is not appropriate in the context of a discovery application. On the issue of the relevance of a patent proprietor's opinions, as contained in internal documents, see also [23] above.

### **Category 11**

49 Category 11 of the Defendants' Application concerned a request for all photographs taken on or around the occasions at which the photograph in page 4 of NCY-3 was taken:

All the other photos that were take on or around the occasion(s) at which the photo in the 4<sup>th</sup> page of exhibit "NCY-3" in the Plaintiff's affidavit dated 7 May 2013 was taken; and all related documents thereto (including internal discussions and correspondence with external parties). The photos are to be in original source format with all metadata intact.

50 The Defendants raised four arguments in support of the contention that discovery of documents in Category 11 should be allowed. I disagreed with all of them:

(a) The first argument was that the photographs would help to identify the machines in question. However, there did not appear to be any dispute that the photograph already exhibited was that of an IDEALmold machine.

(b) The second argument was that the photographs were relevant as they related to an affidavit prepared for the Plaintiff's application for service of process out of jurisdiction. I did not agree with this argument for the same reasons set out earlier concerning Categories 8, 9 and 10 (see [48] above).

(c) The third argument was that the non-selection of other photographs in the creation of NCY-3 was a relevant train of inquiry. However, the Defendants could not show *where* the train was headed. Instead, this appeared to be a purely speculative argument as no reason was given for believing that there would be such a train of inquiry. It must be emphasised that a party's obligation to give discovery relates only to *relevant* documents; it does not extend to disclosing *all* documents, whether relevant or otherwise to the issues in the suit.

(d) The fourth argument was that photographs in source format with metadata would help to determine the date the photographs were taken and relevant to the defences of delay, laches and acquiescence. However, Category 11 is phrased in a manner that is much wider than is necessary to discover the dates that the photographs were taken.

51 I therefore did not grant discovery of Category 11 documents.

### **Category 12**

52 Category 12 of the Defendants' Application is a request for the other photographs that were taken around the occasions at which each of the eight photographs of the nameplates were taken, and the documents related to the photographs:

All the other photos that were take on or around the occasion(s) at which each of the photos in LOD item 21 – "Images of nameplates of IDEALmold machine" were taken; and all related documents thereto (including internal discussions and correspondence with external parties). The

photos are to be in original source format with all metadata intact.

53 The Defendants argued that the photographs were relevant to identify the machines captured in the disclosed photographs, and that the non-selection of the other photographs was a relevant train of inquiry.

54 For the same reasons stated with regard to Category 11 (see [50] above), I did not grant discovery of Category 12 documents.

### **Category 13**

55 Category 13 of the Defendants' Application concerned a request that, if any of the documents requested are not in the English language, a certified translation be provided. As I did not order the discovery of any of the 12 foregoing categories, it was not necessary for me to deal with Category 13.

### **The Plaintiff's Application**

56 The Plaintiff applied for specific discovery of eight categories of documents.

### **Category 1**

57 Category 1 of the Plaintiff's Application concerned documents relating to the manufacture and/or keeping of eight IDEALmold machines as identified by their serial numbers.

58 With regard to four of those machines (*ie* the IDEALmold machines bearing the serial numbers "IN 24-02", "IN 48-08C", "IN 49-08C" and "IN 38-01A"), the nameplates on the machines indicated the manufacturer as "ASM Technology Singapore". In view of the First Defendant's admission that it made and kept those IDEALmold machines in Singapore, the Plaintiff dropped the discovery request concerning these machines. [\[note: 20\]](#)

59 However, the Plaintiff continued to seek specific discovery for documentation concerning the other four machines (*ie* the IDEALmold machines bearing the serial numbers "IN 53-10C", "IN 55-10C", "IN 56-01CP" and "IN 63-04C"). The nameplates on these machines indicated the manufacturer as "ASM Pacific Technology", and might be taken to suggest that the manufacturer of these four machines was in fact the Second Defendant, given that the Second Defendant is known as "ASM Pacific Technology Limited". The Plaintiff argued that disclosure of Category 1 documents would be relevant towards determining if the Second Defendant was involved at all in the infringing acts pleaded, given the existence of the nameplates and the fact that the IDEALmold machine was offered to the public on the Second Defendant's website. It would also be relevant to the Defendants' pleaded position that the Second Defendant was *not* the manufacturer of these four IDEALmold machines.

60 The Defendants argued that the documents in Category 1 were irrelevant because:

(a) First, the Defendants have pleaded that the nameplate stipulating "ASM Pacific Technology" merely indicated that the machine originated from the ASM Pacific Technology group of companies, and "was and is not a reference to the 2<sup>nd</sup> Defendant, which is an investment holding company". [\[note: 21\]](#)

(b) Second, the First Defendant had already admitted that it was the manufacturer of all the

IDEALmold machines, and that there was therefore no reason to fix liability on the Second Defendant.

(c) Third, there was an annual report ("the Annual Report") which stated that the Second Defendant acts as an "investment holding company". [\[note: 22\]](#) In a separate part of the same report, the First Defendant is listed as having the principal activity of "manufacture and sale of semiconductor equipment and materials". The Second Defendant's website also states the First Defendant as the contact point in Singapore.

61 In my view, discovery of the documents in Category 1 would be relevant to the issue of whether the Second Defendant was involved in manufacturing and keeping the IDEALmold machines. This is so, particularly in view that the nameplates of the four IDEALmold machines mentioned in [59] above indicated the name of the Second Defendant, and the fact that the machines were offered for sale on the Second Defendant's website. While the Annual Report did indicate that the Second Defendant is an investment holding company, this did not answer the question of whether the Second Defendant was involved in manufacturing and keeping the IDEALmold machines. Furthermore, the fact that the First Defendant had claimed responsibility did not necessarily absolve the Second Defendant of all liability; in this regard, there might subsequently be practical implications on the recoverability of judgment debts (if any). As such, I granted discovery of the documents in Category 1 *vis-à-vis* the four IDEALmold machines mentioned in [59] above.

## **Category 2**

62 Category 2 of the Plaintiff's Application concerned documents relating to the sale of an IDEALmold machine which was shipped from Singapore to International Rectifier Mexico in California in or around January 2010. The Defendants have not denied the *fact* that there was such a sale. Instead, what the Defendants have denied is the legal point that such a sale amounts to disposal of the IDEALmold machine in Singapore. As such, I did not order discovery of Category 2.

## **Category 3**

63 Category 3 of the Plaintiff's Application concerned documents in relation to the stipulation of the Second Defendant's name on the nameplates of the four machines mentioned in [59] above.

All documents (including agreements, internal discussions or other written correspondence) in relation to the stipulation of "ASM Pacific Technology" on the nameplates of the IDEALmold machines (including specifically the IDEALmold machines bearing serial numbers "IN 53-10C", "IN 55-10C", "IN 56-01 CP" and "IN 63-04C").

64 For the reasons stated with regard to Category 1 above (see [61]), I also granted Category 3.

## **Categories 4, 5, 6, 7 and 8**

65 At the hearing, counsel for the Plaintiff dealt with Categories 4, 5, 6, 7 and 8 of the Plaintiff's Application together. These categories were unified by the fact that they related to alleged inadequacies in the Defendants' written product and process description (the "Written Description").

(a) Category 4 concerned documents relating to the "specifications, functions and operations" of the IDEALmold machines.

(b) Category 5 concerned documents relating to the "different models, variations or versions

of the IDEALmold machines”.

(c) Category 6 concerned documents relating to the features of “flexibility of add on / removal or special module @ site”, “add on modules” and “add on presses”, as referred to in the Defendants’ document titled “Advanced Molding Technology IDEALmold 3G Molding System”.

(d) Category 7 concerned documents relating to the feature of “[f]lexible module add-in to fit the output requirement”, as referred to in the Defendants’ document titled “ASM Experience on Singulated FCBGA Package”.

(e) Category 8 concerned documents relating to the features of “IDEALmold System Retrofitting” and “[a]dditional press with machine frame + retrofit kit + field retrofit cost” as referred to in the Defendants’ document titled “Automold 2008 Price Book”.

66 The Plaintiff sought specific discovery under O 87A r 5(4) of the Rules of Court due to the alleged inadequacy of the Written Description. The arguments raised were as follows:

(a) First, with regard to Category 4, critical features of the IDEALmold machine have been omitted from the contents of the Written Description. The Written Description did not allow the Plaintiff’s expert, Mr Selvarajan Murugan, to make a determination on whether the IDEALmold machine had “detachably mountable” moulding units, or “detachably mountable” moulding units which could be “freely increased/decreased”.

(b) Second, with regard to Categories 5 and 6, the Written Description did not address the IDEALmold 3G machine at all.

(c) Third, with regard to Category 7, the document titled “ASM Experience on Singulated FCBGA Package” is a document that originates from the Defendants (“the FCBGA Document”). In referring to the IDEALmold machine as having “[f]lexible module add-in to fit the output requirement”, this document directly impinges on the position taken by the Defendants. However, no mention of such flexible module add-ins was made in the Written Description.

(d) Fourth, with regard to Category 8, the documents disclosed by the Plaintiff show that the IDEALmold machines may be retrofitted and modules and presses added to the IDEALmold machines. However, the Written Description is silent on such features. The capability to be retrofitted is relevant towards determining whether the IDEALmold machines read onto the claims, as well as whether there is any merit to the Defendant’s defences that the IDEALmold machine (i) “[d]oes not have a step of adjusting the number of molding units by detachably mounting an additional molding unit”; (ii) has no “additional molding units being rendered detachably mountable with respect to [an] already provided molding unit”; and (iii) has the feature where the “number of said molding units are not configured to be freely increased/decreased”.

67 I did not grant discovery of documents in Categories 4, 5, 6, 7 and 8, for the following reasons:

(a) First, with regard to Category 4, the Plaintiff did not explain why, in its view, the Written Description did not allow Mr Murugan to make the necessary determinations. The affidavit by Mr Ukai was silent on this point, and there was no additional affidavit from Mr Murugan in support of the present application.

(b) Second, with regard to Categories 5 and 6, the Plaintiff has not pleaded the IDEALmold 3G machines, or any other different models, variations or versions of the IDEALmold machine, as

being infringing machines. While the Plaintiff has referred in its pleadings to the sale of IDEALmold machines from 2010, it does not follow that the IDEALmold 3G machines, or any other variations or versions (which the Plaintiff did not specify) were automatically also included in the basket of infringing machines. It should be noted that the Plaintiff has also pleaded that the infringing IDEALmold machines were offered to the public at a specified website address, and that the IDEALmold 3G machine was *not* listed at that website address. Furthermore, none of the machines specifically pleaded by the Plaintiff was an IDEALmold 3G machine. Based on the existing evidence, it also appears that the IDEALmold 3G machine is a different machine from the IDEALmold machine. [\[note: 23\]](#)

(c) Third, with regard to Category 7, the Plaintiff has not pleaded anything connected to “[f]lexible module add-in to fit the output requirement” to be in issue. Instead, the Plaintiff’s position appears to be premised on a misunderstanding of the FCBGA document. Mr Ukai appears to assume that “module add-in” must refer to an entire “detachably mountable” sub-system (in the form of a “moulding unit”) as described in the Patent. However, the word “module” is actually explained in the FCBGA document itself, and the reference is clearly to “Input Module” and the “Output Handling Modules”. [\[note: 24\]](#) These are references to parts, and not to the whole “moulding unit”. [\[note: 25\]](#) In this regard, the Plaintiff has not alleged that having the ability to include additional input modules and output handling modules reads on the Patent claims in any way.

(d) Fourth, with regard to Category 8, I am unable to see how the ability to retrofit IDEALmold machines reads on Claim 4 of the Patent, *ie*, that the IDEALmold machine has moulding units which are “detachably mountable with respect to already provided molding unit thereby freely increasing / decreasing the number of said molding unit”. [\[note: 26\]](#) As explained by counsel for the Defendants, the fact that a machine can be retrofitted *does not* suggest that it is designed to allow for “freely increasing / decreasing” moulding units.

68 I turn briefly to note that *even if* the requests in Categories 4, 5, 6, 7 and 8 had been relevant, it might perhaps have been more appropriate in the interests of saving costs for the Plaintiff to seek a clarification of the Written Description, instead of plunging fully into an application for specific discovery. Historically, the rules on written descriptions were introduced in the UK because costs for discovery in patent actions “have got out of hand”, and the rules on written descriptions “are working well to curtail some of that cost” (see, *eg*, *Chiron Corporation v Evans Medical Limited and others* (No 2) [1997] FSR 268 at 268). As observed in *Consafe Engineering (UK) Ltd v Emtunga UK Ltd* [1999] RPC 154 (“*Consafe*”) at [23], “[t]he purpose of [providing for written descriptions] is to avoid, if possible, obliging the defendant to give extensive discovery much of which, experience has shown, is rarely if ever referred to” (although it should be noted that the court in *Consafe* emphasised that the written description must “be complete in all relevant areas”).

69 Therefore, as a matter of practice, it would be useful for parties to consider requesting for clarification of the written description, rather than immediately seeking specific discovery in every case. Going for a full-blown specific discovery application might in some cases, to borrow a phrase used by the Court of Appeal albeit in a very different context, be “the forensic equivalent of using a sledgehammer to crack a walnut” (*Mitora Pte Ltd v Agritrade International (Pte) Ltd* [2013] 3 SLR 1179 at [44]).

## Conclusion

70 I therefore dismissed the Defendants’ Application in its entirety. For the Plaintiff’s Application, I



granted specific discovery only Category 1 (limited to the IDEALmold machines bearing serial numbers "IN 53-10C", "IN 55-10C", "IN 56-01CP" and "IN 63-04C") and Category 3.

71 I will hear parties on costs.

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[\[note: 1\]](#) Plaintiff's submissions at 6

[\[note: 2\]](#) 5<sup>th</sup> Affidavit of Yasushi Ukai (31 October 2014) at para 11

[\[note: 3\]](#) 5<sup>th</sup> Affidavit of Yasushi Ukai (31 October 2014) at para 11

[\[note: 4\]](#) 5<sup>th</sup> Affidavit of Yasushi Ukai (31 October 2014) at para 2

[\[note: 5\]](#) Plaintiff's submissions at 6

[\[note: 6\]](#) 5<sup>th</sup> Affidavit of Yasushi Ukai (31 October 2014) at para 13

[\[note: 7\]](#) Document 17 in the Defendants' List of Documents

[\[note: 8\]](#) Defendants' Submissions at para 144

[\[note: 9\]](#) Defendants' Submissions at para 147

[\[note: 10\]](#) Defendants' Submissions at para 148

[\[note: 11\]](#) 5<sup>th</sup> Affidavit of Yasushi Ukai at para 16

[\[note: 12\]](#) Defendants' Submissions at para 160

[\[note: 13\]](#) Defendants' Submissions at para 161

[\[note: 14\]](#) 5<sup>th</sup> Affidavit of Yasushi Ukai (31 October 2014) at para 21

[\[note: 15\]](#) 5<sup>th</sup> Affidavit of Yasushi Ukai (31 October 2014) at para 22

[\[note: 16\]](#) Defendants' Submissions at para 163

[\[note: 17\]](#) 5<sup>th</sup> Affidavit of Yasushi Ukai at para 23

[\[note: 18\]](#) 5<sup>th</sup> Affidavit of Yasushi Ukai at para 24

[\[note: 19\]](#) 5<sup>th</sup> Affidavit of Yasushi Ukai at para 24

[\[note: 20\]](#) Plaintiff's Submissions at 15, 6<sup>th</sup> Affidavit of Kong Choon Jupiter (31 October 2014) at para 18(a).

[\[note: 21\]](#) Defendants' Defence and Counterclaim (Amendment No 1) at para 4

[\[note: 22\]](#) 6<sup>th</sup> Affidavit of Kong Choon Jupiter (31 October 2014) at 17

[\[note: 23\]](#) 4<sup>th</sup> Affidavit of Yasushi Ukai (10 October 2014) at 300

[\[note: 24\]](#) 6<sup>th</sup> Affidavit of Kong Choon Jupiter (31 October 2014) at para 18(f)

[\[note: 25\]](#) 6<sup>th</sup> Affidavit of Kong Choon Jupiter (31 October 2014) at para 18(f)

[\[note: 26\]](#) 6<sup>th</sup> Affidavit of Yasushi Ukai (14 November 2014) at para 32

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