

IN THE COURT OF APPEAL OF THE REPUBLIC OF SINGAPORE

[1998] SGCA 8

CA 131/1997

Between

Ang Lay See

... Appellant

And

Solite Impex Pte Ltd

... Respondent

GROUND OF DECISION

Patents and Inventions — Ownership; Statutory Interpretation — Construction
of statute

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Ang Lay See and Others v Solite Impex Pte Ltd

[1998] SGCA 8

CA 131/1997

Karthigesu JA; L P Thean JA; Yong Pung How CJ

06 February 1998

1 **YONG PUNG HOW CJ**

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(delivering the grounds of judgment of the court): This appeal concerned the United Kingdom Registered Designs Act 1949 (the UK Act) and the United Kingdom Designs (Protection) Act (Cap 339) (the local Act). We allowed the appeal and now give our reasons for doing so.

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2. The facts

4 At present, a design may not be registered in Singapore. A proprietor must register his design in the United Kingdom (the UK). Once registered, the proprietor enjoys a 25-year monopoly in the registered design, and, pursuant to the local Act, he is automatically accorded, for same period, the exclusive rights and privileges in the registered design in Singapore. Under s 4 of the local Act, nevertheless, the High Court may, on any of the grounds upon which a

registration may be cancelled in the UK, deny him exclusive rights in the design in Singapore.

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3.The respondents were and still are the registered proprietors of Registered Design No 2043962 (the design) in respect of frames and corner pieces under the UK Act. On 18 November 1995, they commenced an action against the appellants for the infringement of their registered design. On the same day, they obtained an Anton Pillar order and an interlocutory injunction against the appellants. The appellants applied for the discharge of the two orders but were unsuccessful. In their statement of claim filed on 11 December 1995, the respondents prayed for an injunction, delivery up of all infringing products, an inquiry into damages, payment of all sums found due and costs. By way of counterclaim filed on 31 January 1996, the appellants sought, inter alia, a declaration under s 4 of the local Act that the respondents had not acquired exclusive privileges and rights in the design in Singapore. In the appellants' particulars of objection filed on the same day, the appellants' main grounds of objection were that, first, the design was not novel in Singapore; and secondly, that the design differed from other designs published in Singapore before the date of its UK registration only in immaterial details or in features which were variants commonly used in the trade.

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4.During the course of the trial in the court below, certain facts previously in issue were agreed upon by both parties. The appellants admitted that their corner piece was not substantially different from the respondents' registered design. The respondents, for their part, admitted that their design had been published in

Singapore and applied to corner pieces prior to 19 December 1994, the date of the application for registration in the UK. Parties also agreed on the reliefs. In the event the respondents were to succeed, it was agreed that the respondents would be granted the injunction as sought, delivery up as claimed, damages agreed at \$5,000 and costs at two-thirds of the taxed costs. The appellants' counterclaim was to be dismissed with two-thirds of the taxed costs awarded to the respondents. If the appellants were to succeed, the respondents' claim would be dismissed with costs, the appellants would be granted the declaration prayed for, damages to be assessed, interest thereon and costs.

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5. The learned judge was therefore concerned only with the following two questions: (i). Whether the prior publication of the corner pieces in Singapore is sufficient ground for the High Court to declare under s 4 of the local Act that exclusive privileges and rights in the registered design have not been acquired in Singapore; and

8 (ii). Whether the photographic evidence shows that the registered design differs from designs published in Singapore only in immaterial details or features which are variants commonly used in the trade and accordingly, whether this is sufficient ground for the High Court to declare under s 4 of the local Act that exclusive privileges and rights in the registered design have not been acquired in Singapore.

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6. The learned judge answered both questions in the negative. On the appeal, the appellants and respondents agreed that a ruling on the first issue would obviate

the necessity of arguing the second issue, and accordingly, only the first issue was canvassed before us.

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7. The relevant statutory context

11 It would be appropriate, at this juncture, to set out the three statutory provisions which were fundamental to the issue at hand.

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8. Section 4 of the local Act provides:

The High Court shall have the power upon the application of any person who alleges that his interests have been prejudicially affected to declare that exclusive privileges and rights in a design have not been acquired in Singapore under the provisions of this Act upon any of the grounds upon which the United Kingdom registration might be cancelled under the law for the time being in force in the United Kingdom.

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9. In respect of the grounds for cancellation mentioned in s 4 of the local Act, s 11(2) of the UK Act provides:

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

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10. The s 11(2) requirement that the design be `new` is amplified by s 1(4) of the UK Act, which provides:

A design shall not be regarded as new for the purposes of this Act if it is the same design - (a) registered in respect of the same or any other article in pursuance of a prior application, or (b) published in the United Kingdom in respect of the same or any other article before the date of the application,

or if it differs from such a design only in immaterial details or in features which are variants commonly used in the trade.

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11. The decision of the learned judge in the court below

16 In deciding that prior use in Singapore was not a valid ground for the exercise of the High Court's power under s 4 of the local Act, the learned judge premised his judgment on the words of s 1(4) of the UK Act, which only specify prior publication in the UK, and the UK Interpretation Act 1978, which does not include Singapore within its definition of the `United Kingdom`. He concluded from this that `the wording of s 4 of our Act and s 1(4) of the UK Act, as amended is clear and unambiguous.`

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12. At the same time, the learned judge referred to other legislation to show that `the meaning of clear words has not been displaced`. This was because the Registration of United Kingdom Patents Act (Cap 271), now repealed, contained a clause similar to s 4 of the local Act, but it also went on to provide that such grounds `shall be deemed to include the manufacture, use or sale of the invention in Singapore`. This type of clause, which the learned judge termed

an `express deeming provision`, is also present in the design legislation of Nigeria and Hong Kong. In addition, he found support in the case of **Mem Co Inc v Cussons (International) Ltd** [1974] RPC 7 in which Sedgwick J considered the Bermuda Patents, Designs and Trade Marks Act. This Act contained a `deeming provision` which specifically mentioned that the use of the trade mark in Bermuda prior to its registration in the UK was valid as a ground for the cancellation of a trade mark in Bermuda. The learned judge read the case thus: `The learned judge was of the view that but for the deeming provision in the subsection all matters affecting the validity of the mark had to be judged according to the position in UK under UK law.`

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13. In the course of his judgment, the learned judge opined that, in all probability, the purpose behind the local Act was merely to confer upon British manufacturers who registered their designs in the United Kingdom the convenience of design protection in the British colonies and dependencies without re-registration.

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14. In coming to his decision, the learned judge admitted that the situation was `unsatisfactory` but he felt that he was `reluctantly constrained by the plain words of ss 1(4) of the UK 1949 Act, as amended`.

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15. The appeal

21 On the appeal before us, the appellants advanced five arguments: first, that there is no single plain and literal interpretation of s 4 of the local Act; secondly, that a tracing of the legislative history of design legislation in Singapore shows a legislative intent to include prior publication in Singapore as a ground upon which the High Court could declare that exclusive rights and privileges were not acquired in Singapore; thirdly, that the interpretation taken by the learned judge would lead to bizarre results; fourthly, a purposive interpretation should be preferred and that if necessary, the court should imply the phrase *mutatis mutandis* to s 4 of the local Act after the word `grounds` in the fifth line; and finally, pursuant to the provisions of the Constitution and the Republic of Singapore Independence Act 1965, all laws existing at that date ought to be interpreted with such necessary modifications and changes in recognition of Singapore`s independent status.

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16. Whether the statutory provisions are ambiguous

23 Our first task was to consider the natural and ordinary meaning of s 4 of the local Act, and ss 11 and 1(4) of the UK Act. Upon a careful consideration of the three statutory provisions, we were unable, with respect, to agree with the learned judge that the import of these provisions are `plain and unambiguous`. As mentioned above, s 4 of the local Act specifies that a registration may be ignored on `any of the grounds upon which the United Kingdom registration might be cancelled under the law for the time being in force in the United Kingdom`. One of the grounds introduced by s 11 of the UK Act is that the design is not `new` and for this purpose, s 1(4) of the UK Act only explains that which `shall not be regarded as new`. From s 11 and s 1(4) of the UK Act it is plain that s 1(4) is not exhaustive: it only isolates that for which it is mandatory

for the registrar to regard as not new, it does not specify that a design must be new in all other circumstances. It follows from this that the fact that Singapore is not part of the UK does not conclude the debate. It must be open, both to the local court as well as a UK court, to decide other instances in which the design is not to be regarded as new.

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17. In our view, the key to the interpretation of the three provisions is found in s 4 of the local Act, not s 1(4) of the UK Act. The crucial question is whether the High Court should merely act as if it were a UK court or registrar or whether it may adapt causes for cancellation in the UK to local circumstances. If its only scope is to act as a UK court, then the lack of novelty in Singapore must be ignored, primarily because the registration ought still to be effective in the UK as it is novel in the UK. Nevertheless, it is not plain from s 4 of the local Act that the High Court should act merely as a UK court. It is important to note that the High Court does not have any power to cancel the registration in the UK, it merely grants a declaration that `exclusive privileges and rights in a design have not been acquired in Singapore`. It is certainly open to argument that this may imply that the High Court is to adapt the principles recognised in the UK to the appropriate local equivalents.

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18. There were two other main reasons given by the learned judge for the statutory interpretation he adopted. The first was the presence of a `deeming provision` - that is, provisions which specifically mention that local usage should be a ground for the denial of exclusive design rights within a territory - in other statutes, and its concurrent absence in the local Act. With respect, we

do not agree that the presence of a deeming provision in other legislation could be determinative of the issue. In reaching his conclusion, the learned judge may have had in mind the maxim *expressio unius est exclusio alterius*, that is, to express one thing is impliedly to exclude another. Of this maxim, Cross has said (*Statutory Interpretation*, 3rd Ed): `it is doubtful whether the maxim does any more than draw attention to a fairly obvious linguistic point, viz that in many contexts the mention of some matters warrants an inference that other cognate matters were intentionally excluded`. In each case, the context in which a clause is included or excluded ought to be examined and weighed against other interpretive factors. In the present case, the deeming provisions were found not within the local Act itself, but in the the Registration of United Kingdom Patents Act (Cap 271), now repealed, and the legislation of Nigeria and Hong Kong. In our opinion, caution ought to be exercised where it is sought to apply this maxim to different statutes. Not all drafters take the same view in respect of whether a matter ought to be specified or to be left to implication. In **Re Wilson** [1985] AC 750, for example, the House of Lords overruled a previous decision of the divisional court, **R v Clerkenwell Stipendiary Magistrate, ex p Mays** [1975] 1 WLR 52, where Lord Bridge decided - in view of an express power contained in the Maintenance Orders Act 1958 - that the same power could not be implied into the Magistrates` Courts Act 1952, because the divisional court had overlooked a general power conferred by the Interpretation Act 1889. A matter could be specified in one statute but not another through a mere abundance of caution. Moreover, where the statute containing the *expressio* is found in another jurisdiction altogether, we doubt any implication may be inferred at all from its absence in local legislation.

19. We turn next to *Mem Co Inc v Cussons (International) Ltd*. In that case, there followed after a subsection which is in pari materia with s 4 of the local Act (referred to in the extract below as `sub-s 1`), the following `deeming provision`: `such grounds shall be deemed to include the use of the trade mark in these islands prior to the date of registration in the United Kingdom` (referred to in the extract below as `sub-s 2`). Sedgwick J read the subsection in pari materia with s 4 of the local Act to mean that all matters affecting the validity of the mark had to be judged according to the position in the UK under UK law. His remarks were made, however, in the context of the presence of the deeming provision, and not its absence. He in fact stated that in the absence of that provision, he would have interpreted the subsection which is in pari materia with s 4 of the local Act to mean that one merely adapted the legal causes available in the UK to like circumstances in Bermuda. This was made clear at p 18 of his judgment:

*What does this section mean? At the trial, counsel for both sides (and unhappily myself) proceeded on the assumption that `any of the grounds upon which the United Kingdom registration might be cancelled under the law for the time being in force in the United Kingdom` meant that one simply listed the various legal causes upon which a United Kingdom registration might be attacked and using those causes, attacked the certificate of registration in the same way as one might attack an ordinary Bermudian registration, **in other words one took the date of application for Bermudian registration of the United Kingdom mark as the applicable date for attack on the registration on grounds of non-distinctiveness, non-user and so forth and one adduced in support of those grounds Bermudian evidence of non-distinctiveness, non-user and so forth in Bermuda.** I am now persuaded that this construction is erroneous.*

*Why did the legislature, in 1935, consider it necessary to enact sub-s (2)? **If the construction I have outlined above is correct the insertion of sub-s (2) was quite unnecessary.** Prior user, being a ground of attack by English law, would, where there was prior user in Bermuda, if that construction is correct, have been open under sub-s (1). [Emphasis added.]*

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And it was only after highlighting the purpose of sub-s (2) that he concluded:

In truth, the answer must be that the proper construction of sub-s (1) is that a declaration under that section can only be obtained if it is shown that the United Kingdom mark in the United Kingdom might by United Kingdom law be cancelled there.

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20. We concluded, therefore, that s 4 of the local Act is ambiguous, and went on to consider the appellants' other arguments, which concerned the proper construction to be given to the section.

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21. The argument premised on the Constitution and the Republic of Singapore Independence Act

30 Counsel for the appellants referred us to art 162 of the Constitution and s 13(1) of the Republic of Singapore Independence Act. Article 162 of the Constitution provides as follows:

Subject to this Article, all existing laws shall continue in force on and after the commencement of this Constitution and all laws which have not been brought into force by the date of the commencement of this Constitution may, subject as aforesaid, be brought into force on or after its commencement, but all such laws shall, subject to this Article, be construed as from the commencement of this Constitution, with such modifications, adaptations, qualifications and exceptions as may be necessary to bring them into conformity with this Constitution.

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22. Section 13(1) of the Republic of Singapore Independence Act states:

Subject to the provisions of this section, all existing laws shall continue in force on and after Singapore Day, but all such laws shall be construed as from Singapore Day with such modifications, adaptations, qualifications and exceptions as may be necessary to bring them into conformity with this Act and with the independent status of Singapore upon separation from Malaysia.

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23. Counsel for the appellants submitted, on the basis of these two provisions, that s 4 of the local Act ought to be read with such modifications as necessary to protect local designers and manufacturers, and to give regard to local circumstances.

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24. We are unable to agree with such a wide reading of art 162 of the Constitution and s 13(1) of the Republic of Singapore Independence Act. Article 162 of the Constitution and s 13 of the Republic of Singapore Independence Act only allow modifications to ensure conformity with the Constitution, the Republic of Singapore Independence Act or the independent status of Singapore. A narrow reading of s 4 of the local Act to exclude prior local use would offend neither the two statutes nor the independent status of Singapore.

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25. The argument premised on legislative intent

35 Counsel for the appellants pointed out that the first design statute was the Registration of United Kingdom Designs Ordinance 1932. Pursuant to this ordinance, designs registered in the UK could be re-registered in Singapore within three years of the initial registration. Significantly, in 1933, a new subsection was added by the Registration of United Kingdom Designs (Amendment) Ordinance 1933 (the 1933 Ordinance) which deemed prior publication of a design to include publication of the design in Singapore. Later, when the Registration of United Kingdom Patents Ordinance 1937 was passed, this ordinance followed the scheme of the 1933 Ordinance and also contained a similar deeming provision. However, when the Designs Ordinance 1938 (the 1938 Ordinance) was introduced by a subsequent Attorney General to obviate the inconvenience of re-registration and to accord automatic recognition to UK-registered designs, the deeming provision was omitted. The 1938 Ordinance is almost identical with the local Act.

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26.From the above, counsel for the appellants argued that the legislature possessed the intent to include a deeming provision, but omitted to do so in the later 1938 Ordinance through a pure administrative slip-up. For their part, the respondents used the same historical facts to argue that the legislature must have intended to leave out the deeming provision when the 1938 Ordinance was passed without it.

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27.The evidence as to legislative intent, in our judgment, must be viewed as ambivalent. The notes of proceedings do not indicate an intent one way or the other; or even that the mind of the legislature was directed to the question. All

that can fairly be drawn from the 1933 Ordinance is that the legislature had, at one time, possessed the intent to include lack of novelty in Singapore as one of the grounds on which the High Court could exercise its powers. It must be uncertain whether, as the appellants contended, this intent was still there at the time of the 1938 legislation, or whether, as the respondents alleged, the contrary intent had materialised.

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28. The argument in favour of a purposive construction

39 Counsel for the appellants contended that a purposive construction ought to be adopted, and that the words *mutatis mutandis* ought to be read into s 4 of the local Act. In support, he furnished many examples of cases where courts had adopted such construction. He did not suggest anything, however, from which the court could deduce that one of the purposes of passing the local Act was to exclude from protection designs which were not novel in Singapore prior to their registration in the UK. In a sense, counsel's argument here followed upon his argument on legislative intent: as it was the intent of Parliament that local user ought to be included, the court ought to adopt a construction to comply with that intent. As we did not agree with counsel for the appellants' arguments on legislative intent, we could not draw the necessary purpose therefrom. We could not find any other clue, either, that implied that one of the purposes behind the local Act included the prevention of commonplace Singapore designs from being granted a design monopoly. As pointed out by the learned judge and the respondents, the parliamentary debates and the explanatory note to the Act imply that the immediate purpose of the Act was merely to accord automatic protection in Singapore of designs registered in the UK and to avoid the need for re-registration. To the extent that counsel's

comments could have been taken to be advocating a construction that promoted, rather than detracted from, the underlying object of design legislation, our views are more appropriately set out in the next section.

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29. The argument in favour of a construction to prevent absurdity

41 The appellants' counsel advanced what he termed as 'bizarre consequences' that would result from the learned judge's interpretation of the statute. These were various, but may be conveniently summarised into two broad categories. The first was that it would lead to the registration and subsequent protection in Singapore of commonplace local designs which happen to be novel in the UK. The second was that it would lead to inconsistency with the treatment of other branches of intellectual property law in Singapore. He argued that such consequences could not have been intended by Parliament.

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30. We agreed with counsel for the appellants that both these consequences clearly could not have been intended by Parliament. In so holding, we had regard to the rationale of design protection and its effect. At present, design registration accords the proprietor of a registered design a 25-year monopoly. This monopoly is granted to encourage innovation and to nurture inventiveness. For this reason, novelty of design is central to the registration process. It has been included as a requirement in every English Designs Act. A statement of novelty must be filed prior to the registration of a design; and any design so registered may be attacked throughout its period of registration for the lack of

novelty. Indeed, it has been held by the House of Lords that it is the duty of the court to ascertain novelty of design even in cases where novelty has been admitted. In **Gramophone Co Ltd v Magazine Holder** [1911] 28 RPC 221, the defendant in infringement proceedings admitted novelty, but the House of Lords considered the issue and held that the design was not novel. Lord Loreburn LC, at p 225, explained the reason as follows:

*The objection to such a course is most striking when the parties agree to admit as true something which lies at the root of the jurisdiction, and any judgment obtained upon the footing of its truth may be held **in terrorem** against persons not parties to the admission.*

43

Lord Shaw, too, stated at p 227:

with regard to the novelty and originality of the design, I think that the duty of a court of law is to protect an honest tradesman who in the expertness and cleverness of his trade - such expertness and cleverness distinguish a good tradesman from a bad tradesman - made an article of commerce; but it is only if it goes beyond that into the region - and not until it goes into the region - of novelty and originality that protection should be awarded. But here, notwithstanding the admission - and it must be remembered that abuses may enter into admissions - I end as I started with the conviction that there is not novelty and originality, and that the protection of the statute granting the monopoly cannot accordingly be claimed.

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31. In the circumstances, it would be extraordinary if run-of-the-mill local designs could secure a 25-year monopoly in Singapore through registration in the UK. In such a case, the monopoly would no longer be a just reward for inventiveness over and above that which is considered usual in the trade. To exclude, accordingly, the lack of novelty in Singapore as a ground pursuant to

which the High Court could act under s 4 of the local Act would strike at the core object of design legislation, a result which Parliament could not have intended.

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32. Furthermore, we were also persuaded that a narrow construction of s 4 of the local Act would be anomalous in view of the present law relating to the other branches of intellectual property law. In his submissions, counsel for the appellants pointed out that to ignore local publication for designs would run against the scheme of the Copyright Act (Cap 63, 1988 Ed). This is because, to prevent dual protection, copyright protection is not available for any designs which are registrable. To this end, s 74 of the Copyright Act puts the onus of registering a registrable design on the owner of that design prior to its industrial application. Once a design is registered, s 74(1) denies it copyright protection. If a design is registrable but is not registered, once it has been applied industrially, pursuant to ss 74(2), 74(3) and 74(4), no copyright protection will be accorded to it either. If novelty in Singapore is disregarded, any person could register a design in the UK even after it has been industrially applied here, so long as no publication is made there. The burden intended by the legislature to lie upon the owner of a design to register his design prior to its industrial application would no longer exist, for he may register it at any time prior to its use in the UK or before a competitor registers the same design. Counsel for the appellants also invited us to consider the other branches of intellectual property law in Singapore. He pointed out that novelty in Singapore is relevant to determine whether an invention is patentable, local goodwill is necessary for passing off protection and local usage is relevant for the purposes of establishing the distinctiveness of a trade mark. We agreed with the respondents that not all

categories of intellectual property law can or should be uniform, but, in our judgment, it would be an odd result if intellectual property rights were accorded within a jurisdiction with scant regard to whether the property exists within the territorial limits for which that property is recognised and protection is given.

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33. Accordingly, we concluded that the High Court must have the power to make the necessary declaration under s 4 of the local Act on the ground that the design lacked novelty in Singapore. In our view, it is not necessary, as suggested by counsel for the appellants, that the words *mutatis mutandis* be imported into s 4 of the local Act. We think that s 4 of the local Act is ambiguous and we construe it to include the appropriate local equivalents of grounds that give rise to the cancellation of registrations in the UK.

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34. Conclusion

48 In the present appeal the sole issue before us was whether the lack of novelty of a design in Singapore, as opposed to the lack of novelty of the same design in the UK, would be sufficient ground for the High Court to declare under s 4 of the local Act that exclusive privileges and rights in the registered design have not been acquired in Singapore. On this issue, s 4 of the local Act is ambiguous. While it may be suspect whether the legislature could have intended or possessed the purpose to include the lack of local novelty as a ground for cancellation, Parliament could not possibly have intended the registration and subsequent protection in Singapore, through registration in the UK, of designs commonplace in Singapore. Such a result would strike at the core object of

design legislation and introduce undesirable counter-mischiefs. The grounds, therefore, upon which the High Court's powers pursuant to s 4 of the local Act are to be exercised must be read to include the local equivalents of the grounds applicable to the cancellation of registrations in the UK.

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35. In the circumstances, we allowed the appeal. The judgment of the court below was set aside, the declaration prayed for in the counterclaim was granted, damages were ordered to be assessed, with interest thereon at 6% per annum from the date of the issue of the counterclaim. Costs, both here and below, were awarded to the appellant. The security deposit was released to the appellant.

Karthigesu JA
L P Thean JA
Yong Pung How CJ

Jimmy Yim and Kelvin Tan (Drew & Napier) for the appellants
Toh Kok Seng and Mark Lim (Lee & Lee) for the respondents
