Astrazeneca AB *v* Ranbaxy (Malaysia) Sdn Bhd
[2012] SGHC 7

Case Number : Suit No. 501 of 2011/V-Summons No. 5106 of 2011/Q

Decision Date : 13 January 2012

Tribunal/Court : High Court

Coram : Tan Sze Yao AR

Counsel Name(s) : Gerald Koh and Mohamed Niroze Idroos (Drew & Napier LLC) for the plaintiff; Bryan Ghows (instructed), Prithipal Singh (instructed) and Denise Mirandah (Mirandah Law LLP) for the defendant.

Parties : Astrazeneca AB — Ranbaxy (Malaysia) Sdn Bhd

Patents and Inventions – Validity

Patents and Inventions – Revocation

Civil Procedure – Pleadings – Striking Out

13 January 2012 Judgment reserved.

Tan Sze Yao AR:

Introduction

1 This is an application by the plaintiff to strike out certain references and paragraphs in, *inter alia*, the Defence and Counterclaim pursuant to Order 18 Rule 19(1) of the Rules of Court (Cap 322, R 5, 2006 Rev Ed) ("Rules of Court"). According to the plaintiff, these references and paragraphs put into issue certain claims and patents belonging to the plaintiff for which the plaintiff had not, in the first place, brought any infringement proceedings against the defendant.

Facts

2 The plaintiff filed the present suit against the defendant for, *inter alia*, a declaration that claims 1, 2, 3, 11 and 12 of the plaintiff's Singapore Patent No. 49283 ("SG 49283") would be infringed by the defendant's "intended acts to import and/or keep whether for disposal or otherwise and/or dispose of and/or offer to dispose of and/or make and/or use" certain pharmaceutical products in Singapore, which products the defendant had applied to the Singapore Health Sciences Authority for the grant of product licences pursuant to the Medicines Act (Cap 176, Rev Ed 1985) ("Medicines Act"). Subsequently, the defendant filed its Defence and Counterclaim and Particulars of Objection against Singapore Patent Nos. 49283, 32642 and 32641 ("Particulars of Objection", with the latter two patents referred to henceforth as "SG 32642" and "SG 32641" respectively). In both its Defence and Counterclaim and Particulars of Objection, the defendant put in issue and challenged the validity of SG 32641, SG 32642 and claims 4, 5, 6, 7, 8, 9, 10, 17 and 18 of SG 49283.

3 The plaintiff took exception to the defendant's pleadings and brought this application for striking out the following (collectively referred to as "the disputed pleadings"):

(a) all references to claims 4 to 10 and claims 17 to 18 of SG 49283 in paragraph 12 of the

Defence;

(b) paragraphs 17, 18 and 19 of the Defence, which make reference to SG 32642 and SG 32641 and claim invalidity of the same;

(c) paragraphs 22 and 23 of the Counterclaim, which repeat paragraph 18 of the Defence and claim that SG 32642 and SG 32641 are invalid;

(d) all references to SG 32642 and SG32641 in paragraphs 24 and 25 of the Counterclaim, which claim invalidity of the same;

(e) paragraphs 16 to 23 of the Particulars of Objection, which refer to and claim invalidity of claims 4 to 10 of SG 49283;

(f) all references to claims 13 to 16 of SG 49283 in paragraphs 25 and paragraphs 27 to 33 of the Particulars of Objection; and

(g) paragraphs 34 to 88 of the Particulars of Objection, which refer to and claim invalidity of SG 32642 and SG 32641.

4 The basis for the plaintiff's striking out application appears to be *all four* grounds enumerated under Order 18 Rule 19(1) of the Rules of Court, namely that the disputed pleadings: (a) disclose no reasonable defence and/or cause of action; (b) are frivolous or vexatious; (c) may prejudice, embarrass or delay the fair trial of the action; and/or (d) otherwise comprise an abuse of process of the Court.

Law and Application

Preliminary issue: SG 49283

5 In its submissions, the defendant argues that "the court should allow the [d]efendant's Defence and Counterclaim in respect of claims 4 – 10 of SG 49283 … there is a risk of the [d]efendant being estopped from raising the same grounds of invalidity if the [p]laintiff takes out another infringement action in respect of its other claims in SG 49283 which are not expressly pleaded". Elsewhere in its affidavit evidence, [note: 1] the defendant also contends that:

> [t]he [p]laintiff's application to strike out [c]laims 4, 5, 6, 7, 8, 9, 10, 17 and 18 of SG 49283 in the [d]efendant's invalidation proceedings is misconceived and is an attempt to splinter the [c]laims so as to be able to enable the [p]laintiff to assert infringement of those [c]laims if the [d]efendant is successful in invalidating [c]laims 1, 2, 3, 11 and 12 of SG 49283 … It does not serve justice for the [d]efendant to be potentially at risk of double jeopardy if the [p]laintiff has another opportunity to sue the [d]efendant under the remaining [c]laims in SG 49283 …

6 The plaintiff responds to this argument by reiterating the principle that an action which seeks to litigate points which should have been brought forward (but were not) in previous proceedings may be struck out as being an abuse of process of the court. According to the plaintiff, authority for this comes from the Court of Chancery case of *Henderson v Henderson* [1843] 3 Hare 100 ("*Henderson*"), endorsed by our courts in *Lee Hiok Tng (in his personal capacity) v Lee Hiok Tng (executors and trustees of the estate of Lee Wee Nam, decd)* [2001] 1 SLR(R) 771. In *Henderson*, Vigram VC had stated at 115:

> … where a given matter becomes the subject of litigation in, and of adjudication by, a court of competent jurisdiction, the court requires the parties to that litigation to bring forward their whole case, and will not (except under special circumstances) permit the same parties to open the same subject of litigation in respect of matters which might have been brought forward as part of the subject in contest, but which was not brought forward, only because they have, from negligence, inadvertence, or even accident, omitted part of their case. The plea of *res judicata* applies, except in special cases, not only to points which the court was actually required by the parties to form an opinion and pronounce a judgment, but to every point which properly belonged to the subject of litigation and which the parties, exercising reasonable diligence, might have brought forward at the time.

7 In the present case, the plaintiff asserts that the defendant is premature in seeking to take issue with claims 4, 5, 6, 7, 8, 9, 10, 17 and 18 of SG 49283, which claims the plaintiff never alleged would be infringed by the defendant. It is tempting to agree with the plaintiff's submission that "it does not behoove the [d]efendant to waste the time and resources of the Court and to oblige the [p]laintiff to defend the validity of the said claims which have not been asserted against the [d]efendant", bearing in mind the proper recourse countenanced by the words of Vigram VC above.

8 However, when one reads the language of s 82(1)(a) of the Patents Act (Cap 221, 2005 Rev Ed) ("the Patents Act") carefully, some uncertainty arises. From the provision, it appears that the defendant has every right to put into issue the validity of SG 49283 in its *Defence* vis-à-vis the infringement proceedings instituted against it by the plaintiff:

> **Proceedings in which validity of patent may be put in issue**
>
> **82.** —(1) Subject to this section, the validity of a patent may be put in issue —
>
> (*a*) *by way of defence*, in proceedings for infringement of the patent under section 67 or proceedings under section 76 for infringement of rights conferred by the publication of an application;
>
> …
>
> [emphasis added]

Unfortunately for the defendant, however, the intuitive reading of the statute here cannot be maintained. As is well known by those in the industry, there are two types of claims that might subsist in a single patent: independent claims and dependent claims. Independent claims stand alone and do not have to be read with other claims in order to be properly understood or interpreted. Dependent claims, on the other hand, take as their point of departure another claim (or claims) within the same patent, and include all of the limitations of the claim or claims from which they depend.

9 A brief survey of the *additional* claims in SG 49283 that the defendant is seeking to invalidate reveals some of the claims to be independent and others to be dependent. Regardless, it is trite patent law that *even where an independent claim is rendered invalid, a claim dependent therefrom may still be valid and enforceable*. In other words, *each claim of a patent requires a separate validity analysis.* Accordingly, I am unable to accept to the defendant's reasoning in seeking to put into issue claims 4, 5, 6, 7, 8, 9, 10, 17 and 18 of SG 49283. It is justified in putting into issue the validity of the claims as indicated by the plaintiff in the Statement of Claim, but claims beyond that are barred by the fact that even within a single patent, individual claims have to be assessed separately. By virtue of claim independence and as a matter of logic, the act of putting the validity of claim 4 into

issue, by way of example, cannot in any way function as a defence to any alleged and/or proposed act of infringement with respect to claim 1.

10 Separately, it should be noted that the plaintiff's reservation of right to "assert any other claims of SG 49283 … in the event that more information is obtained regarding the [d]efendant's products which are the subject of this suit" is by no means inconsistent with its own argument that a party should bring forward its whole case in a timely fashion, lest it run the risk of having erstwhile points raised at a later juncture struck out. At present the plaintiff has put into issue all the claims of SG 49283 which it sees the defendant's conduct as potentially infringing; should anything more come to light hereafter, the question of whether the plaintiff may have its subsequent claims under SG 49283 added via court sanction or struck out shall properly be decided in another forum. For now, for this and reasons stated above, the defendant's pre-emptive attempt to invalidate claims 4, 5, 6, 7, 8, 9, 10, 17 and 18 of SG 49283 appears to be out of order. I will deal with the general principle that counterclaims are claims in their own right shortly.

11 Finally, the defendant submits that "Singapore is just one of the many jurisdictions that this case is being litigated in" and that the plaintiff was at all times sufficiently apprised of all the necessary information relating to the defendant's product to enable it to frame its claim comprehensively, at least in respect of SG 49283. While I appreciate the logic behind this sentiment, which agitates for a disavowal of the plaintiff's reservation of right evinced in [10] above, no evidence has been led on this point and I make no finding thereon.

Section 82 of the Patents Act

12 Order 15 Rule 2(1) of the Rules of Court makes clear that "a defendant in any action who alleges that he has any claim or is entitled to any relief or remedy against a plaintiff in the action in respect of any matter *(whenever and however arising)* may, instead of bringing a separate action, make a counterclaim in respect of that matter" (emphasis added). On the face of things, therefore, the defendant appears vindicated in including the disputed pleadings in its Defence and Counterclaim.

13 The statutory regime governing patents, however, employs strict language to bar this. The relevant provisions from the Patents Act are reproduced here:

> **Proceedings in which validity of patent may be put in issue**
>
> **82.** —(1) Subject to this section, the validity of a patent may be put in issue —
>
> (*a*) by way of defence, in proceedings for infringement of the patent under section 67 or proceedings under section 76 for infringement of rights conferred by the publication of an application;
>
> (*b*) in proceedings under section 77;
>
> (*c*) in proceedings in which a declaration in relation to the patent is sought under section 78;
>
> (*d*) in proceedings before the Registrar under section 80 for the revocation of the patent; or
>
> (*e*) in proceedings under section 56 or 58.
>
> (2) The validity of a patent may not be put in issue in any other proceedings and, in particular, no proceedings may be instituted (whether under this Act or otherwise) seeking only a

declaration as to the validity or invalidity of a patent.

(3) The only grounds on which the validity of a patent may be put in issue (whether in proceedings for revocation under section 80 or otherwise) are the grounds on which the patent may be revoked under that section.

…

14 The defendant argues that s 82(1) of the Patents Act "is not exhaustive in setting out all the instances where the invalidity of a patent may be put in issue … [it only] states that 'the validity of a patent *may* be put in issue' … [and] does not exclude the issue of invalidity from being put in issue in other instances". But a straightforward parsing of s 82 as a whole indicates this argument to be untenable. Section 82(2) specifically states that "[t]he validity of a patent may not be put in issue *in any other proceedings* and, in particular, no proceedings may be instituted (whether under this Act or otherwise) seeking only a declaration as to the validity or invalidity of a patent" (emphasis added). The phrase "any other" in s 82(2) has meaning only relative to the list manifested in s 82(1). No other interpretation makes sense.

15 The same approach was taken by Jacob J in *Organon Teknika Limited v F. Hoffmann-La Roche AG* [1996] FSR 383 ("*Organon*"), a case that counsel for both sides are citing to me (selectively, I may add) and which deals with the equivalent provision under English law. In the interests of clarity, I cite the entire relevant passage from pp385-386 of *Organon* here:

> Hoffman-La Roche's point is short and simple. They say section 74(1) [*in pari materia* with our s 82(1)] sets out a list of proceedings in which the validity of a patent may be put in issue and section 74(2) [*in pari materia* with our s 82(2)] says validity may not be put in issue in any other proceedings. *This application for a declaration of non-infringement to the inherent jurisdiction is not in the list in section 74(1). It is another proceeding and the validity may not be put in issue. Accordingly, all references to the validity of the patent in the statement of claim ought to be struck out.*
>
> Organon Teknika say that this leads to an absurd anomaly. The list in section 74(1) consists of a defence to a patent action, a defence to threats action …, the statutory declaration for non-infringement, any proceedings for revocation of a patent and Crown use. All of these, say Organon Teknika, are central to the dispute concerned. It would be quite absurd that one kind of battle should be left out, namely the case where there is a claim under the inherent jurisdiction. Indeed, they say the whole purpose of section 74(1) must be to deal with cases where there is a genuine direct issue as to the validity of a patent and that could arise under the inherent jurisdiction declaration claim.
>
> I think there is a lot of sense in what is asserted by Organon Teknika; in English law validity and infringement are part of the same questions. You cannot infringe an invalid claim, even if you fall within its language. *But I cannot bring myself to read the language used by section 74(2) as allowing questions of validity to arise in a claim for declaration of non-infringement pursuant to the inherent jurisdiction.*
>
> In principle, apart from section 74(2), I see no reason why that should not be done. Mr Watson asserted it could not be done anyway and referred me to a passage in *Terrell* which I do not think supports his assertion. It seems to me section 74(2), probably accidentally, has had the effect of limiting the non-statutory claim for a declaration of non-infringement to simply a dispute about the scope of the claim.

[emphasis added]

Counsel for the plaintiff submit that the holding in *Organon* makes clear that as long as the declaration sought by the defendant is premised on a basis that falls outside the list circumscribed by s 82(1), there should be no other avenue for the defendant to put the validity of the plaintiff's patents into issue. To this, the defendant has two responses: one, it has properly sought a declaration of non-infringement under s 78 of the Patents Act, pursuant to the ground specified in s 82(1)(c); and two, it has sought a declaration for non-infringement under the court's *inherent jurisdiction*, in much the same way that was countenanced in *Organon*.

16 I pause for the moment to note that like Jacob J, I find it difficult to read the language used by s 82(2) as allowing questions of validity to arise in a claim for declaration of non-infringement pursuant to the inherent jurisdiction. The wording in the statute is specific, and there is only so much latitude that judicial innovation permits. Notwithstanding this, it appears to me that declarations of non-infringement pursuant to the inherent jurisdiction and declarations of non-infringement under s 78 of the Patents Act are somewhat different animals. As was held by Lewison J in *Nokia Oyj v IPCom GmbH & Co KG* [2010] EWHC 3249 (Pat) at paragraph 6,

> … section 71 [*in pari materia* with our s 78] enables the court to grant declarations about future hypothetical events. The ability to make a declaration [under s 71] is triggered merely by a proposal to do something. That proposal need not even have got as far as a settled intention.

Accordingly, since a declaration of non-infringement pursuant to the inherent jurisdiction would entail only a declaration vis-à-vis *non-future* and *non-hypothetical* events, that manner of declaration cannot be what the defendant is seeking in its pleadings here, since no explicit act of alleged infringement has actually taken place as yet. Indeed, that the defendant is making arguments based on the court's inherent jurisdiction as only an afterthought is indicated nowhere better than the defendant's doggedness in seeking to avail itself of the s 78 procedure, which procedure I will go into shortly from [21] below. I will only note for now that at paragraph 7 of its submissions, the defendant states unequivocally that they have prayed for "a declaration of non-infringement under s 78 of the Patents Act".

17 Separately, counsel for the defendant further attempt to elude the unequivocal language in s 82(2) by stating that it has included in its pleadings prayers asking for the revocation of the claims and patents contained within the disputed pleadings. By including prayers seeking the *revocation* of SG 32642, SG 32641 and claims 4, 5, 6, 7, 8, 9, 10, 17 and 18 of SG 49283, the defendant appears convinced that it has sidestepped the statutory restriction in s 82(2). The rationale here, at least according to the defendant, is that s 82(2) bars proceedings that *only* seek a declaration of validity or invalidity; proceedings that seek a declaration *along with* revocation fall outside the purview of the limits countenanced by s 82(2). Therefore, by the defendant's reckoning, all that is left for s 82(2) to apply to is a very specific variety of mischief, given the ease with which most litigants may elide the fetters of the provision. According to the defendant, s 82(2) is to apply only in situations where the patent in question is *not yet registered*. In support of this contention, counsel for the defendant cite to me the case of *Arrow Generics Ltd v Merck & Co Inc* [2007] EWHC 1900 (Pat) ("*Arrow*"), which involved the plaintiff seeking a declaration as to its right to make and sell its own product despite the existence of s 74(2) of the United Kingdom Patents Act 1977 ("the UK Patents Act"), which is *in pari materia* with s 82(2) of the Patents Act.

18 At paragraphs 53-55 of his judgment in *Arrow*, Kitchin J stated:

> [Section 74 of the UK Patents Act (which is *in pari materia* with s 82 of the Patents Act)] gave

rise to the following rival submissions. Merck contends that s 74(1) sets out the various proceedings in which the validity of the patent may be put in issue and s 74(2) says that validity may not be put in issue in any other proceedings. These proceedings do not fall within the list in s 74(1) and are therefore prohibited by s 74(2).

Arrow's answer is that a "patent" is defined under s 130 of the [UK Patents Act] as "a patent under [the UK Patents Act]". This ***does not cover declarations relating to an application under the [UK Patents Act]*** let alone an application for a European patent (UK). Although s 69 provides that "patent" shall include an application in relation to certain sections of the [UK Patents Act], those sections do not include s 74. So s 74 does not prohibit a declaration relating to a published application …

Arrow seeks a declaration as to its right to make and sell its own product. In my judgment clear words are required to exclude that right and s 74 should be interpreted no more widely than necessary to give effect to its purpose. ***What then is that purpose? I consider it must be to ensure that patents which are invalid are not merely declared to be invalid but are in fact revoked. But revocation proceedings cannot be commenced until a patent has been granted.*** Had it been intended that s 74 should exclude the right of a person to seek a declaration to his own product, particularly in circumstances where the need to do so arises from the existence of a published application, then it could have said so in express terms. But it does not and in my judgment it should not be so construed.

[emphasis in bold italics added]

19 Accordingly, *Arrow* stands only for the principle that our s 82(2), like s 74(2) of the UK Patents Act, *does not apply* where the patent in question has not yet been properly registered; such a patent application falls outside the scope of the provision, applying as it does only to properly registered patents. *Arrow* does *not* stand for the principle that s 82(2) *applies only to the very specific niche category of yet-to-be-registered patent applications*. The same result in both cases, but reached in importantly different ways. Without this alleged *raison d'être* justifying the existence of s 82(2), therefore, the defendant's reasoning appears to be premised on an otiose statutory provision, which in my view cannot have been Parliament's intention.

20 In any case, by concentrating only on the latter half of s 82(2), the defendant appears to have been misguided from the start. As can be seen from the excerpt at [13] above, the provision may be divided into two halves: a general rule – "[t]he validity of a patent may not be put into issue in any other proceedings …" – and an elaboration, *viz*, "… in particular, no proceedings may be instituted (whether under this Act or otherwise) seeking only a declaration as to the validity or invalidity of a patent". By simply focusing on the elaborative portion of s 82(2), the defendant fails to recognize that the first portion has already decisively disposed of the issue: having put the validity of the plaintiff's unasserted patents in issue on a basis falling *outside* of those enumerated in s 82(1), the defendant has invariably run afoul of the general rule in s 82(2). Without more, this alone is fatal to the defendant's attempt to include the disputed pleadings.

Section 78 of the Patents Act

21 I return now to the outstanding issue of the declaration of non-infringement that the defendant claims that it has properly sought under s 78 of the Patents Act, touched on earlier at [16]. In its Defence and Counterclaim, the defendant sets out prayers in the alternative for declarations that SG 49283, SG 32641 and SG 32642 will not be infringed by the defendant's acts undertaken to procure the issuance of product licenses by the Singapore Health Sciences Authority. The issue of whether

the validity of the plaintiff's patents may be put into issue via a declaration pursuant to the court's inherent jurisdiction having already been dealt with, I now set out s 78 of the Patents Act in full:

> **Declaration as to non-infringement**
>
> **78.** —(1) Without prejudice to the jurisdiction of the court to make a declaration apart from this section, a declaration that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court or the Registrar in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown —
>
> (*a*) that that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration claimed, and has furnished him with full particulars in writing of the act in question; and
>
> (*b*) that the proprietor has refused or failed to give any such acknowledgment.
>
> (2) A declaration made by the Registrar under this section shall have the same effect as a declaration made by the court.

22 From the above, it is easy to appreciate that the defendant must first apply to the plaintiff in writing for a written acknowledgement of the desired declaration of non-infringement, and also furnish the plaintiff with full particulars, in writing, of the defendant's intended (and potentially infringing) acts.

23 In this connection, the defendant submits that the notices it served on the plaintiff pursuant to compliance with s 12A(3)(a) of the Medicines Act are sufficient to satisfy the notice requirements of s 78(1)(a) of the Patents Act. The relevant portions of s 12A of the Medicines Act are reproduced as follows:

> **Whether medicinal product subject to patent**
>
> **12A.** —(1) Subject to the provisions of this Part, in dealing with an application for a product licence, the licensing authority shall consider whether a patent under the Patents Act (Cap. 221) is in force in respect of any medicinal product to which the application relates and, if so —
>
> (a) whether the applicant is the proprietor of the patent;
>
> or
>
> (*b*) if he is not the proprietor of the patent, whether —
>
> (i) the proprietor has given his consent to or has acquiesced in the grant of the licence to the applicant; or
>
> (ii) the patent is invalid or will not be infringed by the doing of the act for which the licence is sought.
>
> (2) Unless the licensing authority otherwise determines, an applicant for a product licence shall, at the time of his application and at such other time as the licensing authority may require, make and furnish to the licensing authority a declaration in the prescribed form —

(*a*) stating whether a patent under the Patents Act is in force in respect of any medicinal product to which the application relates;

(*b*) if he states that there is such a patent, stating whether he is the proprietor of the patent; and

(*c*) if he states that he is not the proprietor of the patent, stating —

(i) the name and other particulars of the proprietor of the patent;

(ii) whether —

(A) the proprietor has consented to or has acquiesced in the grant of the licence to the applicant; or

(B) in his opinion and to the best of his belief, the patent is invalid or will not be infringed by the doing of the act for which the licence is sought; and

(iii) such other information as may be prescribed.

(3) The licensing authority may, *if the applicant has declared that in his opinion and to the best of his belief the patent is invalid or will not be infringed by the doing of the act for which the licence is sought*, or if the licensing authority considers it appropriate in any particular case, require the applicant to do the following within such time as the licensing authority may determine:

(*a*) *serve on the proprietor of the patent a notice in the prescribed form of his application*; and

(*b*) furnish to the licensing authority such evidence of the service as the licensing authority may require.

(4) The licensing authority need not determine the application until the applicant has complied with subsection (2) and, where applicable, subsection (3), to the reasonable satisfaction of the licensing authority.

(5) If the licensing authority is satisfied that a notice referred to in subsection (3)(*a*) has been served on the proprietor of the patent, the licensing authority may grant the licence to the applicant if the proprietor has not, before the expiration of the period prescribed for the purposes of this subsection —

(*a*) applied for the order or declaration by a court or the Registrar of Patents or a Deputy Registrar of Patents holding office under the Patents Act (Cap. 221), as specified in that notice; and

(*b*) given written notice to the licensing authority stating that such application has been made.

(6) The licensing authority may grant the licence to the applicant if —

(*a*) application for the order or declaration referred to in subsection (5)(*a*) has been made; and

(*b*) at the enxpiration [*sic*]of the period prescribed for the purposes of this subsection, the order or declaration has not been obtained.

[emphasis added]

24 Comparing the language of s 78(1)(a) of the Patents Act and s 12A(3)(a) of the Medicines Act, it becomes immediately apparent that the former provision demands substantially more than the latter. Section 78(1)(a) of the Patents Act requires the furnishment of "full particulars in writing of the [defendant's proposed infringing] act in question", whereas s 12A(3)(a) requires only delivery of a "notice in the prescribed form" of the defendant's application. This "prescribed form", detailed at s 12A(2) of the Medicines Act, countenances only information such as the name and particulars of the proprietor of the potentially infringed patent (in this case, the plaintiff) and the defendant's own opinion as to whether or not the potentially infringed patent is invalid and/or likely to be infringed. It does not have as its threshold "full particulars" as set out in s 78(1)(a) of the Patents Act, and in theory cannot be said to fulfil the requirements of that provision.

25 Examining the actual notices received by the plaintiff from the defendant on 13 June 2011, one can see how theory translates into practice. In each of the six notices sent by the defendant to the plaintiff, only the following skeletal details are set out:

(a) application number assigned by the Singapore Health Sciences Authority;

(b) name of defendant's relevant product;

(c) active substance and strength (in mg);

(d) dosage form;

(e) date of the product licence application filing;

(f) patent number of the plaintiff's relevant patent;

(g) expiry date of the plaintiff's relevant patent; and

(h) the defendant's opinion as to the invalidity of the plaintiff's relevant patent and the non-infringing nature of its own product.

26 The above are a far cry from the "full particulars" as required by the language of s 78(1)(a) of the Patents Act. In this connection it is interesting to note that the defendant cites the case of *MMD Design & Consultancy Ltd's Patent* [1989] RPC 131("*MMD* Design") in support of the proposition that the rule in s 71(1)(a) of the UK Patents Act (*in pari materia* with s 78(1)(a) of the Patents Act) should not be interpreted in an "oppressively bureaucratic" way. But the present facts are easily distinguishable from those in *MMD Design*. In that case, the declaration sought was eventually granted because the applicants "had so clearly and unambiguously described their machine so that no machine falling within that description could reasonably be taken to infringe the claims of the patent" (see *MMD Design* at p 132). In the present case, however, requests for samples of the defendant's product to be sent to the plaintiff for inspection appeared to have fallen on deaf ears and the only "full particulars" the plaintiff had to work with were notices issued pursuant to s 12A(3)(a) of the Medicines Act, which notices have already been discussed and found wanting.

27 The explanation for the lack of response to the plaintiff's request for samples appears to be that the defendant had not been given sufficient time, and that counsel for the defendant had been "in the midst of taking instructions". I found this explanation to be somewhat of an afterthought and rather difficult to understand. In the first place, it was the *defendant* that had set in motion the 45-day time period prescribed under the Medicines (Licensing, Standard Provisions and Fees) Regulations (Cap 176, R 6, 2000 Rev Ed) by initiating service of the notices on the plaintiff. If any party should have been hard-pressed for time under this framework, surely it would have been the plaintiff, which had to take out an application for a court order restraining the defendant's proposed acts within this stipulated 45-day period.

Ongoing litigation, "cherry-picking" and the practical way forward

28 The defendant contends consistently that the statutory provisions governing the present issues ought not to be construed in an officious manner, and that the reality is that due to worldwide litigation currently extant, the plaintiff is already intimately familiar with the defendant's product. Consistent with this logic, the defendant contends that the plaintiff should not be permitted to "cherry-pick" its claims as asserted against the defendant – instead, it should be obliged to bring all of its claims at once. Accordingly, the defendant believes that it is justified in seeking to include the disputed pleadings.

29 While this particular argument has already been dealt with to some extent at [10] to [11] above, one final point remains to be made. From the defendant's point of view, it is saving costs and time for all involved by putting into issue, at this juncture, everything that could possibly be put into issue (as far as the plaintiff's patents are concerned). But this is putting the cart before the horse. It may be that subsequently, the plaintiff does not add to its litany of claims against the defendant; in which case, costs and time would be doubly saved for all. It may also be that subsequently, the plaintiff attempts to add to its litany of claims against the defendant, but has that attempt properly struck out as an abuse of process of the court; in which case, costs and time are saved, and the defendant justly receives vindication. Finally, it may be that upon receipt of further information, through discovery or otherwise, the plaintiff legitimately adds to its litany of claims against the defendant; in which case, costs and time are incurred as per normal, but the ends of both procedural and substantive justice are served. All three of the above scenarios are preferable to the defendant's present attempt to pre-empt the plaintiff, heedless not just of procedure but also the possibility of wasted resources. I should also point out that the defendant has neither led any evidence nor developed any serious argument to indicate that the plaintiff had had more than simply the six notices upon which to base its suit against the defendant.

30 In any case, there is at present nothing to stop the defendant from taking out fresh revocation proceedings before the Registrar against the plaintiff, as provided for in s 82(1)(d) of the Patents Act (see above at [13]). Indeed this course of action should arguably have been the one taken by the defendant from the beginning; certainly it would have been preferable to its present attempt to hijack the plaintiff's suit (which it was responsible for precipitating) for its own revocation agenda.

Conclusion

31 In the circumstances, I find that the disputed pleadings in the Defence and Counterclaim disclose no reasonable cause of action or defence and ought to be properly struck out. Accordingly, I grant an order in terms of the plaintiff's application. I will hear parties on costs.

[note: 1] See Affidavit of Jeyabalan Thangarajah filed on 12 December 2011at paragraphs 18-19.

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