IN THE COURT OF APPEAL OF THE REPUBLIC OF SINGAPORE

[2019] SGCA 04

Civil Appeal No 190 of 2017

Between

(1) SUNSEAP GROUP PTE LTD
(2) SUNSEAP ENERGY PTE LTD
(3) SUNSEAP LEASING PTE LTD

… *Appellants*

And

SUN ELECTRIC PTE LTD

… *Respondent*

In the matter of HC/Suit No 1229 of 2016
(Registrar's Appeal No 135 of 2017)

Between

SUN ELECTRIC PTE LTD

… *Plaintiff*

And

(1) SUNSEAP GROUP PTE LTD
(2) SUNSEAP ENERGY PTE LTD
(3) SUNSEAP LEASING PTE LTD

… *Defendants*

Version No 1: 27 Oct 2020 (22:41 hrs)

JUDGMENT

[Courts and Jurisdiction] — [High Court]
[Courts and Jurisdiction] — [Jurisdiction] — [Original]
[Patents and Inventions] — [Revocation]
[Patents and Inventions] — [Validity]

TABLE OF CONTENTS

INTRODUCTION **1**

THE KEY STATUTORY PROVISIONS **3**

BACKGROUND FACTS AND PROCEDURAL HISTORY **7**

THE PARTIES 7

THE INFRINGEMENT PROCEEDINGS 8

THE STRIKING OUT APPLICATION 9

Proceedings before the Assistant Registrar *10*

Proceedings before the Judge *12*

THE PARTIES' CASES ON APPEAL **21**

The Appellants' case *21*

The Respondent's case *22*

OUR DECISION **24**

ON TERMINOLOGY 25

SECTION 16(1) OF THE SCJA 26

PROVISIONS IN THE PA GOVERNING THE HIGH COURT'S ORIGINAL JURISDICTION TO DETERMINE THE VALIDITY OF A PATENT 26

The first category of cases *27*

The second category of cases *32*

LEGISLATIVE INTENT BEHIND THE PA 36

IN REM JURISDICTION 40

SUMMARY OF LEGAL PRINCIPLES 41

APPLICATION OF LEGAL PRINCIPLES TO THE FACTS **43**

Version No 1: 27 Oct 2020 (22:41 hrs)

CONCLUSION.....45

Version No 1: 27 Oct 2020 (22:41 hrs)

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Sunseap Group Pte Ltd & 2 Ors
v
Sun Electric Pte Ltd

[2019] SGCA 04

Court of Appeal — Civil Appeal No 190 of 2017
Andrew Phang Boon Leong JA, Judith Prakash JA, Tay Yong Kwang JA, Steven Chong JA and Belinda Ang Saw Ean J
21 August 2018

10 January 2019 Judgment reserved.

Tay Yong Kwang JA (delivering the judgment of the court):

Introduction

1 The present appeal raises a single question of law relating to patents: does the High Court have original jurisdiction to hear an application for the revocation of a patent, in particular where such application is by way of a defence and counterclaim? In the High Court, it was held that in the absence of any express statutory provisions conferring original jurisdiction on the High Court to hear revocation proceedings by way of application or to grant a prayer for revocation whether or not by way of counterclaim in infringement proceedings, the High Court has no such jurisdiction because such order is *in rem* in nature (see *Sun Electric Pte Ltd v Sunseap Group Pte Ltd and others* [2017] SGHC 232 ("the Judgment") at [167] and [169]). The Judgment meant effectively that all applications for the revocation of a patent at first instance

must be heard by the Registrar of Patents ("the Registrar") and the High Court's jurisdiction is limited to hearing appeals from the Registrar's decision on the same.

2 Having studied the parties' submissions and heard the parties, we are not able to agree with the conclusion that the High Court lacks original jurisdiction in all cases to hear applications for the revocation of a patent. In our view, there are two distinct categories of cases which must be dealt with separately.

3 The first category concerns applications for revocation which are brought by way of counterclaim in infringement proceedings. It is thus the defendant in infringement proceedings who challenges the validity of a patent in the course of "defending" itself and also seeks an order that the patent be revoked because of the alleged invalidity. In such a situation, the High Court has original jurisdiction to determine the validity of the patent, by virtue of s 67(1) read with s 82(1)(*a*) of the Patents Act (Cap 221, 2005 Rev Ed) ("PA"). Upon a finding of invalidity, the High Court has the power to order that the patent be revoked, pursuant to s 91(1) read with s 80 of the PA.

4 The analysis is quite different where the second category of cases is concerned. This category concerns applications for revocation brought independently of infringement proceedings. In other words, the applicant is the "attacker" who has chosen to challenge the validity of the patent on its own accord. It may have done so, for instance, as a pre-emptive measure in anticipation of infringement proceedings against it or because it is the proprietor of a similar patent. In this second category of cases, the High Court does not have original jurisdiction to hear applications for revocation because its jurisdiction to do so has been excluded by s 82(2) read with s 82(1) of the PA. In the absence of such jurisdiction to hear, it follows that the High Court has no

Version No 1: 27 Oct 2020 (22:41 hrs)

power to order the revocation of that patent.

5 We disagree with the proposition that the High Court's *in rem* jurisdiction must be invoked before the Court can order the revocation of a patent. In our judgment, a court is able to make an order with *in rem* effect, including an order for revocation of a patent, in the exercise of its *in personam* jurisdiction.

6 Given that the present appeal falls squarely within the first category of cases, we hold that in this case, the High Court has original jurisdiction to determine the validity of the Patent and the power to order revocation. We therefore allow the appeal and order that the pleadings are to stand in the terms stated at [98]–[102] below. We now explain our decision.

The key statutory provisions

7 We begin by setting out the key statutory provisions relevant to the issue before this Court. The primary statute under consideration is the PA and all references to statutory provisions in this judgment should be understood as references to the PA, unless otherwise specified.

8 Section 67 governs infringement proceedings. The relevant sub-section reads as follows:

> **Proceedings for infringement of patent**
>
> 67.—(1) Subject to this Part, civil proceedings may be brought in the court by the proprietor of a patent in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the court) in those proceedings a claim may be made —
>
> > (*a*) for an injunction restraining the defendant from any apprehended act of infringement;

Version No 1: 27 Oct 2020 (22:41 hrs)

> (*b*) for an order for him to deliver up or destroy any patented product in relation to which the patent is infringed or any article in which that product is inextricably comprised or any material and implement the predominant use of which has been in the creation of the infringing product;
>
> (*c*) for damages in respect of the infringement;
>
> (*d*) for an account of the profits derived by him from the infringement; and
>
> (*e*) for a declaration that the patent is valid and has been infringed by him.

Section 67(1) provides the basis of the High Court's jurisdiction to hear infringement proceedings as "court" is defined in s 2(1) as the High Court. We will return to consider the significance of this provision later in this judgment.

9 Section 80 deals with the power to revoke patents on application, as its title states. The chapeau of s 80(1) reads as follows:

> **Power to revoke patents on application**
>
> Subject to the provisions of this Act, the Registrar may, on the application of any person, by order revoke a patent for an invention on (but only on) any of the following grounds: …

The rest of the sub-section goes on to list the specific grounds on which revocation may be sought, *eg*, that the invention is not a patentable invention (s 80(1)(*a*)) or that the patent was obtained fraudulently (s 80(1)(*f*)(i)). For the purpose of determining whether the patent should be revoked on any of those grounds, the Registrar may cause the patent to be re-examined by an Examiner (see s 80(2) and (3)). In terms of procedure, s 80(9) specifies that an application for an order to revoke a patent shall be made in the prescribed form and filed at the Registry in the prescribed manner and accompanied by the prescribed fee. The prescribed form and manner of the application to the Registrar are detailed in rr 80–81 of the Patents Rules (Cap 221, R 1, 2007 Rev Ed) ("PR").

Version No 1: 27 Oct 2020 (22:41 hrs)

10 The omission of references to the "court" whenever "Registrar" is mentioned in s 80 forms the major plank of the Respondent's argument that Parliament intended that only the Registrar is to have original jurisdiction to hear applications for revocation. This section may be contrasted with s 78(1), for instance, where the words "by the court or the Registrar" appear.

11 The next pertinent provision is s 82(1), which lists the types of proceedings in which the validity of a patent may be put in issue.

> **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.

Section 82(2) makes it clear that s 82(1)(*a*)–(*e*) comprise an exhaustive list of the types of proceedings in which the validity of a patent may be put in issue. In other words, s 82(2) expressly excludes a specific aspect of the High Court's subject matter jurisdiction (*ie*, its jurisdiction to determine the validity of a patent) if the case does not fall within one of the five types of proceedings in s 82(1)(*a*)–(*e*).

Version No 1: 27 Oct 2020 (22:41 hrs)

12 Section 82(3) provides that the only grounds on which validity may be put in issue are the grounds in s 80:

> (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.

13 Section 82(7) should also be highlighted. It reads:

> (7) Where proceedings with respect to a patent are pending in the court under any provision of this Act mentioned in subsection (1), no proceedings may be instituted without the leave of the court before the Registrar with respect to that patent under section 67(3), 76, 78 or 80.

For example, where there are infringement proceedings under s 67 pending in the High Court and the alleged infringer intends to commence an application to revoke the patent before the Registrar under s 80, leave of court must first be obtained. We will revisit s 82(7) later in this judgment.

14 Section 83 governs the amendment of patents. The key portion of this section provides:

> **Amendment of patent in infringement or revocation proceedings**
>
> **83**.—(1) In any proceedings before the court or the Registrar in which the validity of a patent is put in issue, the court or, as the case may be, the Registrar may, subject to section 84, allow the proprietor of the patent to amend the specification of the patent in such manner, and subject to such terms as to the publication and advertisement of the proposed amendment and as to costs, expenses or otherwise, as the court or Registrar thinks fit. …

15 Sections 90(1) and (3) provide that appeals from the Registrar's decision to revoke a patent under s 80 may be appealed to the High Court and thereafter to the Court of Appeal, if leave to appeal is given by the High Court or the Court of Appeal.

Version No 1: 27 Oct 2020 (22:41 hrs)

16 Finally, s 91 deals with the general powers of the High Court. In particular, s 91(1) provides as follows:

> The court may, for the purpose of determining any question in the exercise of its original or appellate jurisdiction under this Act, make any order or exercise any other power which the Registrar could have made or exercised for the purpose of determining that question.

17 The Appellants also rely on s 16(1) of the Supreme Court of Judicature Act (Cap 322, 2007 Rev Ed) ("SCJA") as the statutory basis of the High Court's original jurisdiction to hear applications for the revocation of a patent. Section 16 of the SCJA sets out the general civil jurisdiction of the High Court:

> **Civil jurisdiction — general**
>
> **16.**—(1) The High Court shall have jurisdiction to hear and try any action in personam where —
>
> (*a*) the defendant is served with a writ of summons or any other originating process —
>
> (i) in Singapore in the manner prescribed by Rules of Court or Family Justice Rules; or
>
> (ii) outside Singapore in the circumstances authorised by and in the manner prescribed by Rules of Court or Family Justice Rules; or
>
> (*b*) the defendant submits to the jurisdiction of the High Court.
>
> (2) Without prejudice to the generality of subsection (1), the High Court shall have such jurisdiction as is vested in it by any other written law.

18 Having laid out the relevant statutory provisions, we now discuss the background facts and the procedural history leading up to this appeal.

Background facts and procedural history

The parties

19 The Respondent, Sun Electric Pte Ltd, is the plaintiff in High Court Suit

Version No 1: 27 Oct 2020 (22:41 hrs)

No 1221 of 2016 ("the Suit"). The Respondent retails solar energy to consumers in Singapore. It is the registered proprietor of a Singapore patent based on Singapore Patent Application No 10201405341Y ("the Patent") filed on 29 August 2014 and granted on 8 June 2016. This patent is in respect of a power grid system and a method of determining power consumption at building connections in the system.

20 The first appellant, Sunseap Group Pte Ltd, is the parent and holding company of the second and third appellants. The second appellant, Sunseap Energy Pte Ltd, is a licensed electricity retailer while the third appellant, Sunseap Leasing Pte Ltd, develops and manages rooftop solar photovoltaic systems. We will refer to these three entities collectively as "the Appellants".

The infringement proceedings

21 On 18 November 2016, the Respondent commenced the Suit in which it claimed that the Appellants jointly or severally infringed eight out of 12 claims in the Patent. These eight claims (*ie*, claims 1, 3, 4, 5, 7, 9, 10 and 11) are referred to collectively as the "Asserted Claims". The remaining four claims in respect of which no infringement is alleged (*ie*, claims 2, 6, 8 and 12) are referred to collectively as the "Unasserted Claims".

22 In response, the Appellants denied all the allegations of infringement. One basis for their denial was that the Patent is and has been at all material times invalid, for the reasons set out in the Particulars of Objection dated 5 January 2017. The objections grounded on the lack of novelty and the lack of inventive step were made in respect of all the claims in the Patent and not merely the Asserted Claims. Additionally, there was a separate objection based on insufficiency made in respect of only two of the Asserted Claims.[1]

Version No 1: 27 Oct 2020 (22:41 hrs)

23 In their Defence and Counterclaim ("D&CC"), the Appellants asked for the following relief:[2]

> (1) A declaration that the Patent is and always has been invalid;
>
> (2) An order that the Patent be revoked;
>
> (3) A declaration that the acts complained of by the Plaintiff do not constitute an infringement of the Patent;
>
> (4) A declaration that pursuant to Section 77 of the Patent Act (Cap 221) to the effect that the threats made by the Plaintiff in the 11 July Letter, OS 733, the SOC and/or the Particulars of Infringement are unjustifiable;
>
> (5) An injunction pursuant to Section 77 of the Patent Act (Cap 221) to restrain the Plaintiff (whether by its directors, officers, servants and agents or otherwise) from continuing to threaten (whether orally or in writing) the Defendants, their directors, officers, agents or employees, with any legal proceedings for infringement of the Patent and/or from making any such or such further threats to any third parties;
>
> (6) Damages to be assessed in respect of any loss which the Defendants have sustained by the Plaintiff's threats;
>
> (7) Costs;
>
> (8) Interest; and
>
> (9) Such further and/or other reliefs as this Honourable Court may deem fit or just.

The striking out application

24 On 17 March 2017, the Respondent filed Summons No 1221 of 2017 ("SUM 1221"), which is an application under O 18 r 19 of the Rules of Court (Cap 322, R 5, 2014 Rev Ed) ("ROC"), to strike out certain portions of the D&CC and the Particulars of Objection to the extent that the validity of the Unasserted Claims had been put in issue improperly. In relation to the D&CC, the Respondent sought to strike out paras 4 and 14 (in the "Defence" section)

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1 Appellants' Core Bundle, Tab 10, pp 173–178.

2 Appellants' Core Bundle, Tab 9, pp 171–172.

Version No 1: 27 Oct 2020 (22:41 hrs)

and para 16 (in the "Counterclaim" section):

> 4. … The Defendants aver that the Patent is and has at all material times been invalid for the reasons set out in the Defendants' Particulars of Objection.
>
> …
>
> 14. Without prejudice to the generality of the foregoing, the Defendants seek to rely on the invalidity of the Patent as set out in the Particulars of Objection filed herein as a defence to the Plaintiff's allegations of infringement.
>
> …
>
> 16. The Defendants aver that the Patent has always been invalid for the reasons set out in the Particulars of Objection served herewith.

25 In relation to the Particulars of Objection, the Respondent sought to strike out para 1:

> 1. The alleged invention, which is the subject of the Patent is not a patentable invention, is invalid, and ought to be revoked by reason of Section 80(1)(a) of the Patents Act (Cap 221) …

26 Subsequently, the Respondent sought and was granted leave to amend the summons for striking out such that it now sought to strike out para 16 of the D&CC in its entirety and not merely in respect of the Unasserted Claims. In effect, the Respondent was asserting that the Appellants could not put in issue the validity of any of the claims of the Patent by way of counterclaim in infringement proceedings.

Proceedings before the Assistant Registrar

27 On 4 May 2017, Assistant Registrar Justin Yeo ("the AR") delivered his decision on SUM 1221 (see *Sun Electric Pte Ltd v Sunseap Group Pte Ltd and others* [2017] SGHCR 6). Two of the AR's holdings are of particular relevance to the issue before this Court. First, the AR held that the validity of the Unasserted Claims could not be put in issue by way of defence in infringement

Version No 1: 27 Oct 2020 (22:41 hrs)

proceedings, pursuant to s 82(1)(*a*). In his opinion, a defendant in infringement proceedings is limited to challenging only the claims that have been asserted by the plaintiff to have been infringed. Accordingly, the AR ordered that the Appellants amend paras 4 and 14 of the D&CC, as follows:

> 4. … The Defendants aver that claims 1, 3, 4, 5, 7, 9, 10 and 11 of the Patent ~~is~~ are and ~~has~~ have at all material times been invalid for the reasons set out in the Defendants' Particulars of Objection.
>
> …
>
> 14. Without prejudice to the generality of the foregoing, the Defendants seek to rely on the invalidity of claims 1, 3, 4, 5, 7, 9, 10 and 11 of the Patent as set out in the Particulars of Objection filed herein as a defence to the Plaintiff's allegations of infringement.

28 Second, the AR held that revocation proceedings could be commenced in the High Court at first instance, particularly where infringement proceedings are already before the High Court and revocation proceedings are brought by way of counterclaim. Accordingly, the validity of all the claims in the Patent could be put in issue by way of counterclaim in infringement proceedings. The AR thus declined to strike out para 16 of the D&CC and para 1 of the Particulars of Objection. Instead, he ordered the Appellants to amend para 16 of the D&CC in the interests of clarity, in the following terms:

> 16. The Defendants aver that all the claims of the Patent ~~has~~ have always been invalid for the reasons set out in the Particulars of Objection served herewith.

29 The AR's decision meant effectively that the Appellants were entitled to put in issue the validity of both the Asserted Claims (by way of defence) and the Unasserted Claims (by way of counterclaim) in infringement proceedings before the High Court. The Respondent appealed against only the second aspect of the AR's decision. There was no appeal against the AR's decision that the validity of the Unasserted Claims could not be challenged by way of defence.

Version No 1: 27 Oct 2020 (22:41 hrs)

There was also no appeal against his orders that paras 4 and 14 of the D&CC be amended or against any other part of his decision.

Proceedings before the Judge

30 The Respondent's appeal in Registrar's Appeal No 135 of 2017 ("RA 135") came before George Wei J ("the Judge"). The Judge framed the main substantive question before the court as follows (at [2] of the Judgment): can patent revocation proceedings be properly brought before the High Court at first instance, by way of counterclaim in infringement proceedings before the Court? If this question were answered in the negative, then the prayers for an order of revocation in the pleadings would be liable to be struck out under any of the four limbs of O 18 r 19 of the ROC (at [18] of the Judgment). In the present case, this would mean that para 16 of the D&CC and para 1 of the Particulars of Objection should be struck out. It would also mean that prayers 1 and 2 of the D&CC – for a declaration that the Patent is and has always been invalid and an order that the Patent be revoked respectively – should be struck out as well (at [27(b)] and [104] of the Judgment).

31 For present purposes, we need to focus on only four key aspects of the Judge's analysis leading to his conclusion that the High Court has no original jurisdiction to hear revocation proceedings by way of application or to grant a prayer for revocation.

32 The first key aspect relates to the *in rem* nature of an order for patent revocation. It is accepted that a granted patent is a right *in rem* because the public at large is bound by a granted patent (at [70] of the Judgment). Given that a claim for patent revocation involves the determination of the status of a *res* or a thing for the very purpose of removing it from the register and depriving the patent-holder of the rights *in rem* bestowed on him as against the world, the

Version No 1: 27 Oct 2020 (22:41 hrs)

Judge concluded that *in rem* jurisdiction is necessary to make an order revoking a patent (at [158] and [168]–[169] of the Judgment).

33 The second key aspect of the Judgment is the Judge's analysis of Parliament's intention. The Judge considered the general legislative intention behind the precursor to the PA, the Patents Act 1994 (Act 21 of 1994) ("PA 1994"), which introduced the change from the self-assessment system of patent registration to the positive grant system. The remarks of the then-Minister for Law Prof S Jayakumar at the second reading of the Patents Bill (*Singapore Parliamentary Debates, Official Report* (21 March 1994) vol 6 at col 1447)) were of particular importance:

> Other important matters covered by the Bill include disputes concerning the validity of patents. Under the present system, these disputes are heard in the High Court. Under the new system, the disputes will be decided by the Singapore Registry, thus reducing litigation costs. Where the validity is challenged on technical grounds, the patent may be re-examined by a foreign patent office. The Singapore Registry will then decide on the validity based on the re-examination report and with assistance, if required, of a scientific advisor selected from a list of experts. Any appeal against the Registrar's decision will be to the High Court. …

34 The Appellants argued below (as they do on appeal) that since Parliament's broader intention in moving disputes concerning the validity of patents from the courts to the Registry was to save costs in patent litigation, this goal would be subverted should the High Court be unable to hear revocation proceedings even by way of counterclaim when infringement proceedings in respect of the same patent were already before the court (at [123] of the Judgment).

35 In response, the Judge opined that these concerns about parallel proceedings and costs could have been overstated. On the first point, he took

Version No 1: 27 Oct 2020 (22:41 hrs)

the view that Parliament must have been aware of the possibility that an application for revocation under s 80 to the Registrar might be made after the commencement of infringement proceedings in the High Court and in circumstances where the defendant had mounted a defence that raises invalidity. In such cases, pursuant to s 82(7), leave is required before revocation proceedings may be brought before the Registrar. In this manner, s 82(7) acts as a "housekeeping provision" to mitigate any unnecessary costs and confusion that may arise from parallel proceedings on validity in different fora (at [127] and [139] of the Judgment). On the second point, the Judge disagreed that the filing of an additional application for revocation to the Registrar would be unnecessary or costly. In his view, the Registrar hearing the revocation application would be able to rely on, or at least refer to, the findings on invalidity made by the High Court in respect of the asserted claims (at [128] of the Judgment).

36 The Judge then concluded that based on the provisions of the PA as a whole and the prevailing circumstances when the Patents Bill was being considered by Parliament in 1994, it was likely that Prof Jayakumar did not have in mind the specific question of whether the High Court should also possess the jurisdiction to hear and decide revocation proceedings by way of counterclaim where infringement proceedings were already properly before the court, when he made that general statement on litigation costs (as set out at [33] above).

37 The Judge went on to consider statements that were made in Parliament sittings after the enactment of the PA 1994. Specifically, he considered the second reading of the Patents (Amendment) Bill (No 13 of 2012), where Senior Parliamentary Secretary to the Minister for Law, Ms Sim Ann, referred to the High Court's decision in *ASM Assembly Automation Pte Ltd v Aurigin Technology Pte Ltd and others* [2010] 1 SLR 1 ("*ASM*"). By way of

Version No 1: 27 Oct 2020 (22:41 hrs)

background, *ASM* was a case where only certain claims of the patent were asserted to have been infringed but the defendants counterclaimed for the revocation of the entire patent, among other relief. Tan Lee Meng J made findings on the validity of each of the asserted claims and ordered that the patent be revoked but did not deal expressly with the unasserted claims. Ms Sim Ann said that *ASM* was an example of a case where the defendant had succeeded in defending an infringement action "and even managed to successfully revoke the ASM patent" (*Singapore Parliamentary Debates, Official Report* (10 July 2012) vol 89 at p 417). However, in the Judge's view, Ms Sim Ann's comment was made in the context of the change from a self-assessment system to a positive grant system. It therefore did not assist in determining whether the PA was intended to confer jurisdiction on the High Court to hear revocation applications or to grant an order for revocation in the exercise of its original jurisdiction (at [130] of the Judgment).

38 Overall, the Judge did not think that Parliamentary debates shed much light on the issue at hand and thus turned to consider the provisions of the PA. This brings us to the third key aspect to be highlighted, which is the Judge's analysis of ss 80(1), 82(7) and 91(1).

39 With regard to s 80(1), the Judge noted that it was the sole statutory provision in the PA relating to applications for revocation and that on a literal and black-letter interpretation, it only provided that the Registrar may revoke a patent but was entirely silent on whether the High Court may do so (at [132] and [135] of the Judgment). Section 80(1) was based on s 72(1) of the UK Patents Act 1977 (c 37) (UK) ("UKPA"). The key difference between the two is that the latter provides expressly that the power to revoke a patent on application is vested in both the court and the comptroller (*ie*, the equivalent in the UK of the Registrar in our context). The UK provision reads:

Version No 1: 27 Oct 2020 (22:41 hrs)

> Subject to the following provisions of this Act, the court or the comptroller may on the application of any person by order revoke a patent for an invention …

This naturally raises the question as to why Parliament omitted any reference to the High Court when adapting s 80(1) from s 72(1) of the UKPA. As alluded to briefly at [10] above, this formed the basis of the Respondent's argument (both in the High Court and on appeal) that Parliament's deliberate omission of references to the "court" was a clear manifestation of its intention to restrict revocation proceedings at first instance to the Registrar only.

40 Nonetheless, the Judge accepted that it could be argued that s 80(1) by itself simply empowers the Registrar to revoke a patent upon application but does not necessarily exclude the High Court from granting revocation orders on the basis of invalidity. He noted that s 80(1) begins with the qualifier "[s]ubject to the provisions of this Act" (at [135] of the Judgment).

41 In relation to s 82(7), the Judge rejected the Appellants' argument that the purpose of this provision was to avoid duplicative proceedings in two fora and thus showed that Parliament intended for both the High Court and the Registrar to hear revocation proceedings. Instead, the Judge agreed with the Respondent that s 82(7) made sense even if the High Court did not have jurisdiction to hear revocation proceedings. This was on the basis that issues of validity could arise outside the context of revocation proceedings (*eg*, by way of defence in infringement proceedings or in groundless threat proceedings). Therefore, the effect of s 82(7) in controlling duplicative or parallel proceedings before the Registrar could apply in those other situations as well. Accordingly, s 82(7) did not necessarily suggest that the Parliament had envisioned that both the High Court and the Registrar should have original jurisdiction over revocation proceedings (at [137] and [139] of the Judgment).

Version No 1: 27 Oct 2020 (22:41 hrs)

42 Although the Appellants argued that a party may be left without a remedy if the High Court cannot hear revocation applications and yet denies leave under s 82(7), the Judge thought this was an unfounded concern. He pointed out that s 82(7) only applies while proceedings are pending before the High Court and does not prevent a party from pursuing revocation before the Registrar when the court proceedings are over. Further, a party who succeeds in obtaining a declaration of invalidity can and must apply to register that order in the patent register to give the public notice of that decision. This would greatly reduce any mischief that could arise from the High Court not having the jurisdiction or the power to revoke a patent (at [142]–[143] of the Judgment).

43 The Judge further observed that the PA does not contain any provision akin to s 72(7) of the UKPA. That provision reads:

> **72 Power to revoke patents on application**
>
> …
>
> (7) Where the comptroller has not disposed of an application made to him under this section, the applicant may not apply to the court under this section in respect of the patent concerned unless either —
>
> (a) the proprietor of the patent agrees that the applicant may so apply, or
>
> (b) the comptroller certifies in writing that it appears to him that the question whether the patent should be revoked is one which would more properly be determined by the court.

As can be seen, s 72(7) of the UKPA contemplates the possibility of parallel revocation proceedings before the court and the comptroller and provides that generally, a party may not apply to the court for revocation when there are pending proceedings before the comptroller. In other words, it is the counterpart to s 82(7) except that it applies specifically to revocation proceedings and deals with the reverse situation where there are pending proceedings before the

Version No 1: 27 Oct 2020 (22:41 hrs)

comptroller instead of the court. Viewed in this way, the inclusion of s 82(7) in the PA together with the omission of s 72(7) of the UKPA made it more likely that Parliament did not intend to vest the High Court with original jurisdiction to hear and determine revocation applications (at [140] of the Judgment).

44 The Judge therefore concluded that s 82(7) was not conclusive on the question of jurisdiction. When read in the light of other provisions of the PA, it was equally consistent with the view that the High Court was not intended to hear revocation applications in the exercise of original jurisdiction.

45 Moving on to s 91(1), the Judge noted that academic works appeared to be of the view that this provision is the basis of the High Court's ability to hear revocation proceedings at first instance. In Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Ed, 2014), para 30.0.6 states that "[a]n application for revocation under s 80(1) may be made to the Registrar of Patents or to the High Court." At a footnote to that paragraph, the learned author adds that "[t]he power of the High Court to hear revocation proceedings is found in s 91(1)". In a similar vein, *A Guide to Patent Law in Singapore* (Alban Kang gen ed) (Sweet & Maxwell, 2nd Ed, 2009) states:

> 8.2.1 Any person may, under s 80, apply to revoke a patent before the Registrar of Patents. Section 91 grants to the court powers which the Registrar could have made or exercised under the Patents Act…
>
> 8.2.2 Section 82(1) sets out the circumstances under which the validity of a patent may be put into issue. One such circumstance is by way of a defence in an infringement action. In these proceedings, e.g. infringement proceedings, the issues relating to the validity of the patent are heard before the Singapore High Court, as part of the infringement proceedings. Where no infringement action has been commenced, an interested person would have to commence revocation proceedings before the Registrar. Thus, more often than not, issues relating to the revocation of a patent are heard in the courts rather than before the Registrar.

Version No 1: 27 Oct 2020 (22:41 hrs)

46 Nonetheless, the Judge considered that these academic texts did not consider in much detail the precise jurisdictional basis upon which the court's purported original jurisdiction over revocation proceedings is founded. The authors could be merely declaring the existing practice. As the Judge acknowledged, there have been numerous cases in which the High Court granted revocation orders when hearing counterclaims for revocation in infringement proceedings (at [116] and [118] of the Judgment). However, the court's jurisdiction could not be established on the mere basis of such a practice. Jurisdiction is conferred by statute and that is a question of law to be determined by reference to the relevant statute (at [121] of the Judgment).

47 The Judge then turned to analyse s 91(1), with reference to the following propositions set out in this Court's decision in *Re Nalpon Zero Geraldo Mario* [2013] 3 SLR 258:

> (a) The "jurisdiction" of a court is to be distinguished from its "powers". The "jurisdiction" of a court refers to its authority, however derived, to hear and determine a dispute that is brought before it. The "powers" of a court constitute its capacity to give effect to its determination by making or granting the orders or reliefs sought by the successful party to the dispute (at [31]).
>
> (b) It is only after the court's jurisdiction is established that the court's power can be exercised (at [45]).
>
> (c) The jurisdiction of a court must be conferred by the statute constituting it (at [14]).

48 Bearing these propositions in mind, the Judge observed that although s 91(1) grants the High Court, in determining any question in the exercise of its

Version No 1: 27 Oct 2020 (22:41 hrs)

original or appellate jurisdiction, the powers which the Registrar possesses for determining the same question, that provision does not address the more fundamental question of what original and appellate jurisdiction the PA confers upon the High Court. In this regard, it was clear that the High Court could determine questions on revocation under s 80 in the exercise of its appellate jurisdiction over decisions of the Registrar, by virtue of s 90(1) (see [15] above). However, the question of whether revocation proceedings fell within the High Court's original jurisdiction demanded careful consideration.

49 The Judge next considered s 16(1) of the SCJA, which is the fourth and final key aspect of the Judgment. As stated in Yeo Tiong Min SC, "Jurisdiction of the Singapore Courts" in *The Singapore Legal System* (Kevin YL Tan ed) (Singapore University Press, 2nd Ed, 1999) ("*Yeo on Jurisdiction*") at p 257, s 16(1) of the SCJA is the basis of the High Court's *in personam* jurisdiction and unlimited subject matter jurisdiction. However, in the light of the Judge's conclusion that *in rem* jurisdiction is necessary to make an order revoking a patent (see [32] above), s 16(1) of the SCJA could not assist the Appellants' case that the High Court has the relevant original jurisdiction.

50 After analysing the law, the Judge concluded that the High Court has no original jurisdiction to hear and determine revocation proceedings. Without such jurisdiction, no powers of the Registrar in respect of revocation applications under s 80, including the power to revoke a patent, could vest in the High Court by operation of s 91(1) (at [167] and [169] of the Judgment).

51 Accordingly, the Judge allowed RA 135 and made the following orders:

(a) that para 16 of the D&CC be amended to read:

> 16. The Defendants aver that claims 1, 3, 4, 5, 7, 9, 10 and 11 of the Patent ~~has~~ have always been invalid for

Version No 1: 27 Oct 2020 (22:41 hrs)

> the reasons set out in the Particulars of Objection served herewith.

(b) that prayer 2 of the D&CC for an order that the Patent be revoked be struck out;

(c) that para 1 of the Particulars of Objection be amended to remove all references to the invalidity of the Unasserted Claims and to revocation; and

(d) costs in favour of the Respondent.

The parties' cases on appeal

The Appellants' case

52 The Appellants make two main arguments. First, although the Appellants do not dispute that an order revoking a patent has an *in rem* effect, they argue that the Judge was wrong in concluding that the High Court requires *in rem* jurisdiction in order to revoke a patent. The Appellants point out that judgments with *in rem* effect (hereinafter referred to as "*in rem* judgments") need not arise invariably from the court's exercise of its *in rem* jurisdiction. They may also arise from the court's exercise of its *in personam* jurisdiction which is its jurisdiction to hear and to try an action designed to settle the rights of the parties as between themselves.[3]

53 Second, on the basis that only *in personam* jurisdiction is required, the Appellants argue that once the High Court has *in personam* jurisdiction and unlimited subject matter jurisdiction under s 16(1) of the SCJA by way of proper service of the originating process or by submission to jurisdiction, s 91(1) operates to confer upon it the same powers that the Registrar has under the PA,

[3] Appellants' Case, paras 21–52.

Version No 1: 27 Oct 2020 (22:41 hrs)

including the Registrar's power under s 80 to revoke patents.[4] The Appellants say that their position is supported by a purposive approach to statutory interpretation. In this regard, the Appellants rely mainly on extraneous material to show that the lack of a reference to the "court" in s 80(1) could not have been intended to deprive the High Court of its original jurisdiction to hear revocation proceedings. They point to Prof Jayakumar's remarks at the second reading of the Patents Bill (reproduced at [33] above) and highlight that the key consideration underlying his remarks was the reduction of litigation costs. An interpretation that would effectively require parties to invariably litigate in two separate fora – before the High Court for infringement proceedings and before the Registrar for revocation proceedings – could hardly be said to promote the reduction of costs. Therefore, such an interpretation should not be preferred.[5]

The Respondent's case

54 The Respondent's position, as appeared from its written submissions, is as follows. The starting point is the plain wording of s 80(1), which refers only to revocation proceedings before the Registrar and not before the High Court.[6] Aside from s 80(1), the Respondent points out that some of the UKPA provisions which would have otherwise governed the High Court's original jurisdiction to hear revocation proceedings were modified or omitted entirely from the PA. Additionally, the Respondent highlights the lack of provisions in the PA, PR and ROC setting out the procedure for revocation applications to the High Court. According to the Respondent, these legislative modifications and omissions were not accidental. Rather, they evinced Parliament's clear and

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4 Appellants' Case, paras 57–62 and 71–72.

5 Appellants' Case, paras 98–101.

6 Respondent's Case, paras 8–14.

Version No 1: 27 Oct 2020 (22:41 hrs)

conscious intention to restrict first instance revocation proceedings to be before the Registrar only.[7]

55 In response to the Appellants' argument on s 16 of the SCJA, the Respondent makes three points. First, such a provision of general applicability cannot overshadow ss 80(1) and 82(2), which are specific provisions intended by Parliament to govern exclusively the scope of revocation proceedings, pursuant to the principle of construction of statutes expressed in the maxim of *generalibus specialia derogant*.[8] Secondly, proceedings brought pursuant to s 16 of the SCJA do not fall within s 82(1)(*a*)–(*e*), which is a closed and exhaustive list of the types of proceedings in which the validity of a patent may be put in issue. Hence, the validity of a patent cannot be put in issue where the High Court is supposedly exercising its original jurisdiction under s 16 of the SCJA to hear an application for revocation as the High Court's subject matter jurisdiction is excluded expressly by operation of s 82(2).[9] Thirdly, *in rem* jurisdiction is necessary for the High Court to bind the world at large in respect of the status of a patent's validity and s 16 of the SCJA does not confer such jurisdiction.[10]

56 However, at the hearing before us, matters took a surprising turn. Counsel for the Respondent, Mr Ravindran, accepted that the High Court does have the jurisdiction to hear revocation applications and the power to revoke a patent if it makes a finding of invalidity, provided that the order seeking revocation is contained within the defence filed in the infringement proceedings instead of the counterclaim. We then asked Mr Ravindran how this would work

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7 Respondent's Case, paras 16–27.

8 Respondent's Case, paras 48–53.

9 Respondent's Case, paras 39–47.

10 Respondent's Case, paras 54–69.

Version No 1: 27 Oct 2020 (22:41 hrs)

in practical terms, given that revocation is essentially a form of relief following a finding of invalidity and therefore must necessarily be sought by way of counterclaim or a new action rather than by way of defence only. In response, Mr Ravindran said that the validity of the patent could be put in issue in the defence and should the court make a finding of invalidity, it would be open to counsel to draw the court's attention to s 91(1) and invite the court to exercise its power to revoke the patent.

57 We should add that given the Respondent's primary position taken in its oral submissions that the High Court has original jurisdiction to hear revocation applications, it puzzles us somewhat that the Respondent also accepted that the Judge was correct in holding that *in rem* jurisdiction is necessary to make an order revoking a patent.

Our decision

58 As mentioned at the outset of this judgment, the key question before this Court is a simple one: does the High Court have original jurisdiction to hear an application for the revocation of a patent? To answer this question, we think it is necessary to determine which of the two categories of cases (as set out at [3]–[4]) is under consideration. To recapitulate:

(a) The first category concerns applications for revocation which are brought by way of counterclaim in infringement proceedings. It is the defendant who is challenging the validity of a patent from its position of being a "defender" and seeking an order from the High Court that the patent be revoked should it be found to be invalid.

(b) The second category concerns applications for revocation brought independently of infringement proceedings. In this category, the

Version No 1: 27 Oct 2020 (22:41 hrs)

applicant is the "attacker" who is challenging the validity of the patent and asking the High Court to revoke the patent on that ground.

59 Keeping this distinction in focus, we seek the answer to the question whether the High Court has original jurisdiction to hear an application for the revocation of a patent by reference to the provisions of the PA. In our view, the PA provides that the two categories of cases are to be dealt with differently. Before we set out our analysis on the above, we address briefly two preliminary points.

On terminology

60 The first preliminary point relates to the terminology used in this judgment. Thus far, we have used the phrases "revocation proceedings", "revocation applications" and "applications for revocation" somewhat interchangeably. It should be borne in mind that "revocation" does not describe the nature of the proceedings in the sense of reflecting the underlying cause of action (unlike a term like "infringement proceedings"). Rather, revocation is a type of relief that, like a declaration of invalidity, may only be obtained following an anterior inquiry into the validity of a patent. Hence the aforementioned three terms should be understood as merely being shorthand for "proceedings in which the validity of a patent is put in issue and the relief sought by the applicant is an order that the patent be revoked for invalidity".

Section 16(1) of the SCJA

61 The second preliminary point concerns the arguments raised by the Appellants on s 16(1) of the SCJA. In our view, there is no need to invoke the SCJA beyond making the point that pursuant to s 16(1) of the SCJA, the High Court has jurisdiction once a defendant is served with the originating process in

Version No 1: 27 Oct 2020 (22:41 hrs)

the manner prescribed in the ROC or submits to the High Court's jurisdiction. This is because the answer to the question whether the High Court has the jurisdiction to hear revocation applications can be found within the PA itself. As the Respondent submits correctly, where the literal meaning of a general enactment covers a situation for which specific provision is made by some other enactment (whether or not within the same statute), it is presumed that the situation is intended to be dealt with by the specific provision. This is captured in the maxim *generalibus specialia derogant*: Oliver Jones, *Bennion on Statutory Interpretation: A Code* (LexisNexis, 6th Ed, 2013) at p 1038. Consistent with the above, s 16(2) of the SCJA provides that "[w]ithout prejudice to the generality of subsection (1), the High Court shall have such jurisdiction as is vested in it by any other written law". Thus, although s 16(1) of the SCJA sets out provisions relating to the High Court's civil jurisdiction, those general provisions must be read in conjunction with the specific provisions in the PA governing the High Court's jurisdiction to hear applications for revocation. In the premises, it is unnecessary to consider the SCJA and the parties' arguments on the same any further.

Provisions in the PA governing the High Court's original jurisdiction to determine the validity of a patent

62 We now consider the issue which engaged the Judge – are there provisions in the PA governing the High Court's original jurisdiction to hear revocation proceedings? The Judge's conclusion on this point was that the PA does not contain any express provision conferring original jurisdiction on the High Court and that it followed that the High Court has no such jurisdiction (at [167] of the Judgment).

63 It will be recalled that s 82(1) sets out a closed and exhaustive list of proceedings in which the validity of a patent may be put in issue (see [11]

Version No 1: 27 Oct 2020 (22:41 hrs)

above). These include infringement proceedings under s 67, proceedings for infringement of rights conferred by publication of application under s 76 and proceedings for groundless threat under s 77. In our judgment, in the first category of cases where the defendant in infringement proceedings avers invalidity in the course of "defending" itself and seeks an order that the invalid patent be revoked, the basis of the High Court's jurisdiction to determine the validity of a patent is s 67(1) read with s 82(1)(*a*). We explain as follows.

The first category of cases

64 Infringement proceedings are named specifically in s 82(1)(*a*):

> 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; …

Pursuant to s 82(1)(*a*), therefore, a defendant in infringement proceedings is entitled to challenge the validity of the patent by way of defence. We do not think it is material that s 82(1)(*a*) refers to validity being put in issue "by way of defence" instead of "by way of defence and counterclaim". In our view, the substantive question of the validity of the patent is raised in the defence in the infringement proceedings while the counterclaim is concerned primarily with the relief to be granted if the defendant succeeds in establishing its defence. Section 82(1) limits the types of proceedings in which validity can be raised rather than addresses the question what relief the court can or should grant following a finding of invalidity. A further indication that "defence" in s 82(1)(*a*) is not meant to exclude "counterclaim" appears in s 82(5) (concerning entitlement proceedings) where the words "[w]here the validity of a patent is put in issue by way of defence or counterclaim" are used.

Version No 1: 27 Oct 2020 (22:41 hrs)

65 We accept that s 82(1)(*a*), by itself, does not confer original jurisdiction on the High Court to determine the validity of a patent. On a proper analysis, the true root of the court's jurisdiction is the specific section named therein – s 67. As alluded to at [8] above, it is evident from its wording that s 67(1) is a jurisdiction-conferring provision:

> (1) Subject to this Part, civil proceedings may be brought in the court by the proprietor of a patent in respect of any act alleged to infringe the patent and (without prejudice to any other jurisdiction of the court) in those proceedings a claim may be made — …

By virtue of the infringement proceedings commenced under s 67, the High Court acquires the jurisdiction to determine the validity of the patent concerned, where that issue is raised by the alleged infringer in the course of "defending" the claim of infringement. In its defence, the alleged infringer is required to establish one or more of the exhaustive grounds listed in s 80(1). These are the same grounds on which a patent may be revoked: s 82(3). It follows that if the alleged infringer is able to establish invalidity of the patent on any of the grounds in s 80(1), it would also succeed in establishing that the patent should be revoked.

66 Our conclusion that the High Court has original jurisdiction to hear applications for revocation, at least where they arise in the context of infringement proceedings, is consistent with other provisions in the PA. In particular, we refer to s 83, which is titled "Amendment of patent in infringement or revocation proceedings" (see [14] above). Since s 83 provides that the court has the power to allow the patent-holder to amend the patent specifications, which, as the title of the section suggests, may arise in the course of "revocation proceedings", it follows that the PA contemplates that the High Court has the jurisdiction to hear applications for revocation under certain conditions.

Version No 1: 27 Oct 2020 (22:41 hrs)

67 Assuming that the High Court exercises its jurisdiction to hear the dispute on validity and then rules in the alleged infringer's favour that the patent is invalid, the next question is how the High Court is to give effect to that ruling. This is essentially a question of the High Court's powers and this is governed by s 91. Section 91(1) provides that the court may, in the exercise of its original or appellate jurisdiction, make any order or exercise any other power which the Registrar which could have made or exercised (see [16] above). Given that the Registrar could have revoked the patent on the same grounds under s 80(1), it follows that the High Court, in exercising its original jurisdiction to determine the validity of a patent where it is put in issue by way of defence in infringement proceedings, also has the power to revoke the patent. Certainly, where a patent has been found to be invalid, the High Court should exercise its power to remove it from the register. As noted at [105] of the Judgment, the confusion or nuisance value of an invalid patent that remains on the register as a granted patent is readily apparent.

68 The foregoing analysis has proceeded on the premise that the validity of the entire patent has been challenged in the infringement proceedings (*ie*, the validity of all the claims in the patent has been put in issue). However, this may not always be the case. For instance, a patent-holder may raise allegations of infringement in respect of some but not all of the claims in the patent, as the Respondent has done in the present case (see [21] above). Given that a defendant may only put validity in issue "by way of defence" in infringement proceedings, it follows that only the validity of asserted claims (*ie*, in respect of which allegations of infringement are made) may be put in issue within the meaning of s 82(1)(*a*). The validity of unasserted claims cannot be challenged in the defendant's defence and counterclaim.

Version No 1: 27 Oct 2020 (22:41 hrs)

69 The question then arises as to whether and how the defendant facing allegations of infringement in respect of some but not all of the claims in a patent may obtain relief in the form of revocation. We begin by broadly considering the scenarios in which a patent may be revoked. The most obvious scenario is one where the validity of the entire patent is put in issue. If the court finds in the defendant's favour that the entire patent is invalid, it follows that the High Court should exercise its power to order that the invalid patent be revoked (see [67] above).

70 However, in addition to the above, there is at least one other scenario where the patent should be revoked. This is the scenario where all the independent claims in a patent have been found to be invalid. This presupposes that the patent-holder has alleged infringement of all the independent claims in the patent and that the defendant has in turn challenged the validity of all the independent claims by way of defence. If the court finds in the defendant's favour that the independent claims are invalid, it follows that the dependent claims must also fall. This is because, as the nomenclature suggests, dependent claims (or "subsidiary claims") refer back to the independent claim and incorporate all its features (see *Lee Tat Cheng v Maka GPS Technologies Pte Ltd* [2017] 3 SLR 1334 at [104]). This would be so even if the defendant did not challenge specifically the validity of the dependent claims in its defence. Thus, in practical terms, once the defendant succeeds in establishing that all the independent claims in a patent are invalid, the dependent claims must necessarily fall away and the patent as a whole must be regarded as invalid. In such circumstances, it would also be proper for the High Court to exercise its power under s 91(1) read with s 80 to order that the patent be revoked.

71 What happens if the proprietor of the patent has raised allegations of infringement in respect of some, but not all, the independent claims? In such a

Version No 1: 27 Oct 2020 (22:41 hrs)

scenario, even if the defendant avers the invalidity of these claims by way of its defence and the court finds in the defendant's favour, there would still be some independent claims the validity of which has not been impugned as those claims were not put in issue. This being the case, it would not be appropriate for the High Court to exercise its power to revoke the entire patent. However, such a defendant would not be left without recourse because it would still be entitled to a declaration of invalidity in relation to those asserted independent claims if it succeeds in its defence in the infringement proceedings. If the defendant wishes, it may also seek revocation of the patent by a different route, namely, in proceedings before the Registrar under s 80. It may either do so after High Court proceedings have ended or while court proceedings are on-going if leave of the court has been obtained under s 82(7) (see [73]–[80] below). If the Registrar finds in the defendant's favour that the unasserted independent claims are invalid, taken together with the High Court's finding that the asserted independent claims are invalid, then the patent as a whole becomes invalid. In such circumstances, it would be proper for the Registrar to exercise his power under s 80 to order that such a patent be revoked.

72 The foregoing analysis has several practical implications on how a defendant in infringement proceedings should frame its pleadings. We summarise these as follows:

(a) In its defence, the defendant is limited to challenging only the validity of the asserted claims (*ie*, the claims in respect of which allegations of infringement have been made).

(b) In its counterclaim, the defendant may include a prayer for revocation but the precise wording of the prayer would depend on

Version No 1: 27 Oct 2020 (22:41 hrs)

whether all or only some of the claims in the patent have been put in issue.

(i) If the validity of all the claims in the patent has been put in issue, the defendant may ask simply for "an order that the patent be revoked".

(ii) If the validity of only some of the claims in the patent has been put in issue, the defendant will be required to plead for "an order that the patent be revoked, if the court finds that the asserted claims are invalid and as a consequence the remaining unasserted claims cannot be maintained without the invalid asserted claims", or words to similar effect.

The second category of cases

73 The analysis is different where a party, without having been sued for infringement, takes the view that a particular patent is invalid and commences proceedings for its revocation. This is the second category of cases – where the application for revocation is brought independently of infringement proceedings. The Judge referred to such applications as "standalone revocation proceedings" at [119] of the Judgment. In our view, this scenario is covered by s 82(1)(*d*):

> Subject to this section, the validity of a patent may be put in issue —
>
> …
>
> (*d*) in proceedings before the Registrar under section 80 for the revocation of the patent; …

74 This provision makes it clear that a party is entitled to challenge the validity of the patent in the course of proceedings for revocation before the Registrar. However, since s 82(1)(*d*) does not refer to the "court" alongside the

Version No 1: 27 Oct 2020 (22:41 hrs)

"Registrar", this necessarily means that validity of a patent cannot be "attacked" before the High Court, *ie*, where it is not "by way of defence". This is by operation of s 82(2) which makes it clear that s 82(1) provides a closed and exhaustive list of the types of proceedings in which the validity of a patent may be put in issue (see [11] above) and therefore functions as an express exclusion of the High Court's subject matter jurisdiction to determine the validity of a patent in proceedings which are not listed in s 82(1).

75 In summary, the overall effect of s 82(1)(*d*) and (2) is that the Registrar has exclusive jurisdiction to determine the validity of patents where the revocation application is brought independently of infringement proceedings. In other words, if a party, without having been sued, wishes to "attack" the validity of a patent, it can only do so by way of revocation proceedings before the Registrar and not by commencing an action in the High Court. However, such an applicant must still establish a cause of action entitling it to a ruling on validity because s 82(2) provides that "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." This means that a busybody with no cause of action cannot go before the Registrar to ask for a ruling of invalidity of a patent. The applicant "attacking" the validity of a patent before the Registrar must also be entitled to seek and is seeking relief beyond a bare declaration of invalidity. As the AR stated at [49] of his judgment, the purpose of s 82(2) in precluding stand-alone proceedings for declarations as to invalidity is to ensure that invalid patents are not merely declared to be invalid but are in fact revoked.

76 If such an applicant is dissatisfied with the Registrar's decision on the validity of the patent, its next step is to appeal to the High Court under s 90(1), and thereafter, if necessary, to the Court of Appeal under s 90(3). In those

Version No 1: 27 Oct 2020 (22:41 hrs)

instances, the High Court would be exercising its appellate jurisdiction rather than its original jurisdiction.

77 The approach set out thus far is consistent with s 83, which governs the amendment of patent specifications (see [14] above). Section 83 can be read as applying to the court's exercise of original jurisdiction in the first category of cases and to the court's exercise of its appellate jurisdiction against the Registrar's decision in the second category of cases (see [66] above).

78 We reiterate that the analysis set out in [73]–[76] is limited to the second category of cases and in no way suggests that the High Court lacks original jurisdiction to determine the validity of patents in other situations. While original jurisdiction to hear applications for revocation brought independently of infringement proceedings is vested exclusively in the Registrar (by virtue of s 82(1)(*d*) and (2)), the High Court nonetheless has original jurisdiction to hear applications for revocation which are brought by way of defence and counterclaim in infringement proceedings (by virtue of ss 82(1)(*a*) and 67), which is the first category of cases.

79 Flowing from the above, there is a further point to be considered. Is a defendant in infringement proceedings entitled to commence an application for revocation of the patent before the Registrar under s 80 or is it limited to doing so by way of defence and counterclaim in the infringement proceedings before the High Court? It will be recalled that this scenario is governed by s 82(7). If there are infringement proceedings pending in the High Court, no proceedings may be instituted before the Registrar under the four listed sections (which includes s 80) without the leave of the court. Thus, while a defendant in infringement proceedings is not barred from bringing an application for

Version No 1: 27 Oct 2020 (22:41 hrs)

revocation before the Registrar, it must obtain the leave of the court if it wishes to do so while the court proceedings are pending (see [42] above).

80 As is evident from s 82(7), the default position under the PA is that proceedings relating to the same patent should be heard in the same forum. There are at least two practical benefits of this approach. First, parties can avoid incurring unnecessary costs from having to commence proceedings in two different fora. Second, it would reduce the risk of conflicting decisions between the Registrar and the High Court. This was why the Judge took the view that s 82(7) was a "housekeeping provision" which would help to mitigate any unnecessary costs and confusion that may arise from parallel proceedings in different fora (see [127] of the Judgment). Accordingly, where a party seeks to depart from the default position, it must first obtain the leave of the court.

81 We make one final point before moving on to consider two other major areas of contention between the parties. This concerns the Respondent's contention that the High Court's jurisdiction to hear revocation applications and to revoke an invalid patent hinges on whether the prayer seeking revocation is contained within the defence or the counterclaim (see [56] above). We do not accept this submission. As explained above, the issue of jurisdiction is governed by the provisions of the PA and not by the technicalities of which pleading the prayer for revocation is contained within. We also do not accept the argument that the High Court should exercise its power to revoke a patent upon counsel for the successful party drawing its attention to the relevant statutory provisions, despite such order not having been prayed for in the pleadings filed in court. That would go against the principles of pleadings, in particular, that any relief sought must be prayed for.

Version No 1: 27 Oct 2020 (22:41 hrs)

Legislative intent behind the PA

82 We have discussed how the provisions of the PA show that the High Court has original jurisdiction to hear applications for revocation where the validity of a patent is put in issue by way of defence in infringement proceedings. That analysis alone is sufficient to dispose of a large part of this appeal. However, for completeness, we turn to address two major points of contention between the parties, the first of which is the legislative intent behind the PA.

83 As briefly mentioned at [10] and [54] above, one of the Respondent's key arguments was that the omission of references to the "court" alongside the "Registrar" in ss 80(1) and 82(1)(*d*), as compared to the equivalent provisions in the UKPA which refer to both the court and the comptroller, showed that Parliament's intention must have been that the Registrar would have the exclusive original jurisdiction to hear all applications for revocation. We reject this argument for two reasons.

84 The first reason is that there was no material put before us which could explain why references to the "court" were not made in the relevant sections of our PA. As the Respondent argued, it could be because Parliament intended the Registrar to have exclusive original jurisdiction to hear revocation proceedings. However, it could equally mean that Parliament was of the view that the other provisions in the PA were sufficient to confer original jurisdiction on the High Court to hear those proceedings and that the omission of the "court" in ss 80(1) and 82(1)(*d*) did not change the pre-existing legal position.

85 The second reason for rejecting the Respondent's argument is that it does not differentiate between the two categories of cases that we have identified. Even if we accept that Parliament had deliberately omitted references

Version No 1: 27 Oct 2020 (22:41 hrs)

to the "court" in ss 80(1) and 82(1)(*d*), at most, that only affects or restricts the High Court's jurisdiction to hear the second category of cases in which revocation is sought independently of infringement proceedings and as a stand-alone application. The omission has no impact on the High Court's jurisdiction to hear applications for revocation which are sought in the context of infringement proceedings mentioned in s 82(1)(*a*).

86 We also think that the distinction between the two categories of cases is consistent with Prof Jayakumar's remarks at the second reading of the Patents Bill (see [33] above). In this regard, we agree with the Appellants that Parliament's intention in moving disputes concerning the validity of patents from the courts to the Registry was to save costs in patent litigation (see [34] above). That being the case, Parliament could not have intended that parties in patent proceedings must invariably litigate in two separate fora, before the High Court for infringement proceedings under s 67 and before the Registrar for revocation proceedings under s 80. It makes good sense that where there are infringement proceedings already before the High Court, an application for revocation of the same patent should be heard before the High Court as well. This is consonant with our analysis regarding the first category of cases and with the leave of court requirement contained in s 82(7) for parallel proceedings.

87 However, where the application for revocation is entirely pre-emptive in nature and brought independently of infringement proceedings in the High Court, there are good reasons why exclusive jurisdiction should be reserved to the Registrar. If there are no pending court proceedings, there are no cost savings from requiring such applications to be heard in the High Court. It is pertinent to bear in mind the context in which the PA 1994 was enacted. At that time, Singapore was still operating on a self-assessment system as opposed to a positive grant system. In other words, the examiner at the Registry could grant

Version No 1: 27 Oct 2020 (22:41 hrs)

a patent as long as the formal requirements for the application were complied with, even if the examination report revealed that the invention did not meet all the substantive criteria for patentability. As the Respondent points out, during the transition period between the two systems, it must have been a "live worry" that the High Court might be "inundated with multiple proceedings for the revocation of patents of 'dubious' quality, which would unnecessarily take up valuable court time and resources."[11] This is a valid point because in the early 1990s, our Supreme Court was also in the process of clearing its backlog of pending cases. Diverting stand-alone revocation proceedings at first instance to the Registrar, a specialised forum with the requisite domain knowledge, would help to build up the Registry's expertise and not add to the caseload of the High Court. This could explain why Parliament chose to confer exclusive jurisdiction on the Registrar to hear the second category of cases.

88 For completeness, we now consider the Appellants' reliance on statements made in sittings of Parliament after the enactment of the PA 1994, which they say are significant in ascertaining Parliament's intention. The first is Ms Sim Ann's statement during the second reading of the Patents (Amendment) Bill on 10 July 2012 that the defendant in the *ASM* case had "successfully revoke[d] the ASM patent" (see [37] above).

89 The second is the statement of then-Senior Minister of State for Law, Ms Indranee Rajah, in the Parliamentary sitting of 29 January 2015 dealing with the topic of "Revocation of Local Companies' Intellectual Property Rights by Government Agencies and Government-linked Companies". A member of Parliament had asked the following question (see *Singapore Parliamentary Debates, Official Report* (29 January 2015) vol 93 at p 415):

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[11] Respondent's Case, paras 29–36.

Version No 1: 27 Oct 2020 (22:41 hrs)

> The first question was regarding why the Government agencies would go to the Courts instead of going to IPOS to apply to revoke patents, since IPOS has its own patent revocation process. Why do they go to the Courts?

In response, Ms Indranee Rajah said:

> … Mr Giam asked in what circumstances would Government agencies go to the Court instead of IPOS. As I had mentioned earlier, the two cases in question arose in the context of counterclaims. …

90 The Appellants submit that the above exchanges show that Parliament has always held the view that the High Court has original jurisdiction to hear revocation proceedings and the power to revoke patents, especially where revocation was sought by way of counterclaim to infringement proceedings.

91 In response, the Respondent argues that these statements by Ms Sim Ann and Ms Indranee Rajah were simply passing remarks commenting on the fact that the High Court had heard revocation proceedings at first instance as a matter of fact but without commenting on its legal correctness. Further, these statements were not made in the context of Parliamentary debates when the Bill containing the relevant PA provisions was being passed and/or directed towards the specific question of whether the High Court has jurisdiction to hear revocation proceedings at first instance. The Respondent thus submits that the Appellants' reliance on these two statements is misplaced.

92 While these remarks might have been made merely as statements of fact and Parliament was not, on those occasions, applying its mind specifically to the issue of the High Court's original jurisdiction to revoke patents, it is also fair to say that no adverse comment was made or doubt expressed as to the existence of such jurisdiction. It is also interesting to note that both these

Version No 1: 27 Oct 2020 (22:41 hrs)

statements in Parliament concerned cases where revocation was sought by way of counterclaim in infringement proceedings.

93 On the whole, the approach set out in this judgment is not inconsistent with or contradicted by Parliament's intention as expressed in the words of the PA. There is also no inconsistency or contradiction between our view of the PA and Prof Jayakumar's remarks during the second reading of the Patents Bill and the statements made in sittings of Parliament after the enactment of the PA 1994.

In rem *jurisdiction*

94 The second major point of contention between the parties relates to the question whether the High Court needs to have *in rem* jurisdiction before it can revoke a patent. Although this argument was not raised by parties before the High Court, it is a significant feature in the Judge's reasoning and is now endorsed by the Respondent on appeal (see [55] and [57] above).

95 In our judgment, an *in rem* judgment does not arise only from the court's exercise of its *in rem* jurisdiction. It may arise equally in an *in personam* action. As noted in *Cheshire, North & Fawcett: Private International Law* (Paul Torremans ed) (Oxford University Press, 15th Ed, 2017) at pp 544–545, the essence of an *in rem* judgment is that it constitutes an adjudication on the existence of rights over property, or its status. Thus a decree of divorce or nullity of marriage – which is a decree declaring the status of persons – must also be classed as operating *in rem*. This Court reached a similar conclusion in *Murakami Takako (executrix of the estate of Takashi Murakami Suroso, deceased) v Wiryadi Louise Maria and others* [2007] 4 SLR(R) 565, where it was noted at [33] that "[a] divorce decree may be a judgment *in rem*, in so far as it determines the status of the parties". This provides a clear example that *in*

Version No 1: 27 Oct 2020 (22:41 hrs)

rem judgments may arise other than through the court's exercise of its *in rem* jurisdiction, which is in any event generally viewed as being limited to its admiralty jurisdiction (see *Yeo on Jurisdiction* at p 260).

96 Given the above, we cannot agree with the Judge's reasoning that because an order revoking a patent is of an *in rem* nature, the High Court needs to possess *in rem* jurisdiction before it can grant such an order (see [32] and [49] above). In our judgment, only *in personam* jurisdiction is necessary and the High Court has such jurisdiction once a defendant is served in the manner prescribed in the ROC or submits to the High Court's jurisdiction.

Summary of legal principles

97 We summarise our main legal conclusions as follows:

(a) The PA envisages two categories of cases involving applications for revocation and these are to be dealt with differently.

(b) In the first category of cases where the application for revocation is brought by way of defence and counterclaim in infringement proceedings (*ie*, the alleged infringer challenges the validity of a patent in the course of "defending" itself and consequently in its counterclaim seeks an order that the patent be revoked), the High Court has original jurisdiction to determine the validity of the patent, by virtue of s 67(1) read with s 82(1)(*a*).

(c) If the patent is found to be invalid, the High Court has the power to order that the patent be revoked, pursuant to s 91(1) read with s 80. The court's power to revoke a patent is subject to the following principles:

Version No 1: 27 Oct 2020 (22:41 hrs)

(i) If all the claims or all the independent claims in the patent are found to be invalid, the court should revoke the patent.

(ii) If there are independent claims the validity of which has not been impugned and which can be maintained without the invalid claims, the court should not revoke the patent. Pursuant to s 83(1), the court may allow the proprietor of the patent to amend the specification in such manner and subject to such terms as the court thinks fit. In dealing with the proposed amendments and any opposition that may arise under s 83(2), the court may engage the assistance of the Registrar in the spirit of s 83(4).

(d) In the second category of cases where the application for revocation is brought independently of infringement proceedings (*ie*, the applicant "attacks" the validity of the patent as a stand-alone application), the High Court does not have jurisdiction to determine the validity of the patent, such jurisdiction having been expressly excluded by s 82(2) read with s 82(1) of the PA. Pursuant to s 82(1)(*d*) and (2), exclusive jurisdiction to determine the validity of the patent in this category of cases is reserved to the Registrar.

(e) In relation to how pleadings should be phrased, the following guidelines apply:

(i) In its defence, the defendant is limited to challenging only the validity of the asserted claims (*ie*, the claims in respect of which allegations of infringement have been made).

(ii) In its counterclaim, the defendant may include a prayer for revocation but the wording of the prayer depends on whether

Version No 1: 27 Oct 2020 (22:41 hrs)

all or only some of the claims in the patent have been put in issue.

(A) If the validity of all the claims in the patent have been put in issue, the defendant may ask simply for "an order that the patent be revoked".

(B) If the validity of only some of the claims have been put in issue, the defendant will be required to plead for "an order that the patent be revoked, if the court finds that the asserted claims are invalid and as a consequence the remaining unasserted claims cannot be maintained without the invalid asserted claims", or words to similar effect.

(f) *In rem* jurisdiction is not required in order for the High Court to order that an invalid patent be revoked.

Application of legal principles to the facts

98 The present case falls within the first category of cases where the application for revocation is brought by way of defence and counterclaim in the context of infringement proceedings. Accordingly, the High Court has the jurisdiction to determine the validity of the Patent and if invalidity is established, the court may exercise its power to revoke the Patent. However, the present appeal does not concern the substantive validity of the claims in the Patent but only whether certain portions of the D&CC and the Particulars of Objection should be struck out. These pleadings should now be drafted to accord with the legal principles set out at [97] above.

Version No 1: 27 Oct 2020 (22:41 hrs)

99 In our view, the D&CC should stand in the following terms. In the "Defence" section, paras 4 and 14 remain unchanged from the AR's decision:

> 4. … The Defendants aver that claims 1, 3, 4, 5, 7, 9, 10 and 11 of the Patent are and have at all material times been invalid for the reasons set out in the Defendants' Particulars of Objection.
>
> …
>
> 14. Without prejudice to the generality of the foregoing, the Defendants seek to rely on the invalidity of claims 1, 3, 4, 5, 7, 9, 10 and 11 of the Patent as set out in the Particulars of Objection filed herein as a defence to the Plaintiff's allegations of infringement.

100 In the "Counterclaim" section, para 16 remains unchanged from the Judge's decision:

> 16. The Defendants aver that claims 1, 3, 4, 5, 7, 9, 10 and 11 of the Patent have always been invalid for the reasons set out in the Particulars of Objection served herewith.

101 However, prayer 2 of the D&CC which was struck out by the Judge on the basis of his conclusion that the High Court lacks original jurisdiction to revoke the Patent (see [51(b)] above) should be restored. Prayers 1 and 2 should now be in the following terms:

> **AND THE DEFENDANTS CLAIM:**
>
> (1) A declaration that claims 1, 3, 4, 5, 7, 9, 10 and 11 of the Patent ~~is~~ are and always ~~has~~ have been invalid;
>
> (2) An order that the Patent be revoked, if the court finds that claims 1, 3, 4, 5, 7, 9, 10 and 11 are invalid and as a consequence the remaining claims cannot be maintained;
>
> …

102 As for para 1 of the Particulars of Objection, we uphold the Judge's order that it should be amended to remove all references to the invalidity of the Unasserted Claims (see [51(c)] above). However, instead of removing the reference to revocation entirely, the paragraph may be amended to aver that

Version No 1: 27 Oct 2020 (22:41 hrs)

revocation be ordered if the court finds that the Asserted Claims are invalid and that as a consequence the Unasserted Claims cannot be maintained, similar to how prayer 2 in the D&CC is to be amended.

Conclusion

103 For the reasons above, the appeal is allowed.

104 In their costs schedule, the Appellants estimate their costs for this appeal at $30,000 in costs and $6,338.59 in disbursements. The Respondent's estimate is $30,000 in costs and $1,453.35 in disbursements. As this appeal involves an important point of law regarding patent revocation and has been heard before a Court of Appeal comprising five Judges, we think the amounts suggested by the Appellants are entirely reasonable. We therefore order the Respondent to pay the Appellants $30,000 in costs and $6,338.59 in disbursements for this appeal. The usual consequential orders relating to security for costs of the appeal will apply. In addition, it is only fair that the costs ordered by the Judge for the hearing before him be reversed. The Respondent is therefore to pay the Appellants the costs of the hearing before the Judge.

Version No 1: 27 Oct 2020 (22:41 hrs)

Andrew Phang Boon Leong Judge of Appeal	Judith Prakash Judge of Appeal	Tay Yong Kwang Judge of Appeal

Steven Chong Judge of Appeal	Belinda Ang Saw Ean Judge

Lau Kok Keng, Lauw Yu An, Nicholas Lynwood and Leow Jiamin (Rajah & Tann Singapore LLP) for the appellants;
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Version No 1: 27 Oct 2020 (22:41 hrs)