

Re Platts-Mills, Mark Fortescue QC
[2005] SGHC 191

Case Number : OM 31/2005
Decision Date : 07 October 2005
Tribunal/Court : High Court
Coram : Judith Prakash J
Counsel Name(s) : Ponnampalam Sivakumar (Joseph Lopez and Co) for the applicant; Tony Yeo and Joanna Koh (Drew and Napier LLC) for the respondent; Laurence Goh (Laurence Goh Eng Yau and Co) for the Law Society of Singapore; Dominic Zou (Attorney-General's Chambers) for the Attorney-General
Parties : —

Legal Profession – Admission – Ad hoc – Whether Queen's Counsel admissible as advocate and solicitor of Singapore Bar – Whether three-stage test for admission as advocate and solicitor satisfied – Whether appropriate for court to grant application – Section 21 Legal Profession Act (Cap 161, 2001 Rev Ed)

7 October 2005

Judith Prakash J:

Background

1 Mr Mark Fortescue Platts-Mills QC (“the applicant”) applied under s 21 of the Legal Profession Act (Cap 161, 2001 Rev Ed) (“LPA”) to be admitted as an advocate and solicitor of the Singapore Bar for the purpose of appearing as counsel on behalf of the appellants in Civil Appeal No 70 of 2005 and Civil Appeal No 127 of 2004 (collectively “the Appeals”). I allowed his application. Trek Technology (Singapore) Pte Ltd, the respondent in the Appeals, has appealed against my decision.

2 The appellants in the Appeals, namely F E Global Electronics Pte Ltd, Electec Pte Ltd and M-Systems Flash Disk Pioneers Ltd, were the plaintiffs in High Court Suit No 604 of 2002. They had commenced that action against the respondent in order to claim relief in respect of what they asserted were groundless threats of infringement proceedings made by the respondent and in order to obtain an order invalidating the respondent’s Singapore patent no 87504 (“the respondent’s patent”). Subsequently, Suit No 604 of 2002 was consolidated with Suit No 609 of 2002, an action which the respondent had started against the appellants alleging that the appellants had infringed the respondent’s patent. The respondent’s patent was granted in respect of a portable computer data storage device and the appellants were manufacturers and distributors of a similar device.

3 The consolidated action was heard before Lai Kew Chai J between 12 April 2004 and 5 May 2004. The appellants were represented by Mr Ponnampalam Sivakumar assisted by Mr Daryl Ong, whilst Mr Davinder Singh SC, assisted by Mr Tony Yeo and Ms Joanna Koh, appeared for the respondent. At the trial, the appellants called five witnesses of fact and one expert witness and the respondent called four witnesses of fact and two expert witnesses. During the course of the trial, there was an application by the respondent for leave to amend the respondent’s patent by reason of the discovery of certain prior art. In respect of this application, the respondent relied on the evidence of three witnesses of fact and one expert witness whilst the appellants relied on the evidence of two witnesses of fact and one expert witness. After the conclusion of the trial, but before judgment was rendered, the appellants applied for the admission of further evidence. This application was refused and in December 2004, the appellants appealed against the judge’s decision. This appeal was unsuccessful.

4 Judgment in the consolidated action was rendered on 12 May 2005 in favour of the respondent. Lai J found that the respondent's patent was valid and had been infringed by the appellants and that the application to amend the respondent's patent should be allowed. The court dismissed the appellants' claim for groundless threats of infringement and for a declaration that the respondent's patent was invalid.

The application

5 The application was made under s 21 of the LPA. It was common ground that in considering applications of this nature, the court would apply a three-stage test, to wit:

- (a) whether the case contained issues of fact or law of sufficient difficulty and complexity to justify the admission of a Queen's Counsel;
- (b) whether the circumstances of the case warranted the court's exercise of discretion in favour of the applicant; and
- (c) whether the applicant was a suitable candidate for admission.

See *Price Arthur Leolin v AG* [1992] 2 SLR 972 and *Re Beloff Michael Jacob QC* [2000] 2 SLR 782.

Complexity of the issues

6 Dealing with the first stage of this test, counsel for the applicant submitted that the difficult and complex issues of law involved in the Appeals justified the admission of a Queen's Counsel. These were:

- (a) how the claims of the respondent's patent should be construed and how the patent as a whole should be construed in the light of the guidance given by the recent judgment of the House of Lords in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9 ("*Kirin-Amgen*");
- (b) what factors had to be taken into account by a court in deciding whether to allow a patent to be amended after it had been granted and, in particular, what the correct approach to such an application should be, given that the approach taken by the trial judge was inconsistent with the approach of the English Court of Appeal;
- (c) what test had to be applied in order to make a foreign manufacturer of a product liable for patent infringement in Singapore as a joint tortfeasor with the local retailer in a patent infringement action, where the foreign manufacturer did not itself make direct sales of the infringing product within the jurisdiction; and
- (d) how s 77 of the Patents Act (Cap 221, 2002 Rev Ed) in respect of an action for a groundless threat of patent infringement should be interpreted and, in particular, what statements may be made by a Singapore patentee, when issuing letters to other parties in Singapore regarding the grant of a Singapore patent, which will not render the Singapore patentee liable to an action for damages pursuant to this section.

The respondent and the Law Society of Singapore did not agree that the above issues were of the degree of complexity and difficulty required by s 21 of the LPA.

7 In relation to the first issue, Mr Sivakumar, counsel for the applicant, amplified in the course of submissions that the difficulty lay in reconciling two prior Singapore decisions, to wit, *Bean Innovations Pte Ltd v Flexon (Pte) Ltd* [2001] 3 SLR 121 ("*Bean Innovations*") and *Genelabs Diagnostics Pte Ltd v Institut Pasteur* [2001] 1 SLR 121, with each other in the light of the guidance given by Lord Hoffmann in *Kirin-Amgen* that the approach to patent construction set out in *Catnic Components Limited v Hill & Smith Limited* [1982] RPC 183 ("*Catnic Components*") was the bedrock of patent construction, universally applicable, whereas the so-called "Protocol questions" enunciated in *Improver Corporation v Remington Consumer Products Limited* [1990] FSR 181 were only guidelines, more useful in some cases than in others.

8 Mr Yeo's response to the above was that this was not the first time that the Singapore courts were dealing with the issues of claim construction and the construction of a patent. Local counsel and the courts had considered patent cases for many years and had been able to deal with these issues without any assistance from Queen's Counsel. The *Kirin-Amgen* case did not establish new law as it simply applied and reinforced the decision of Lord Diplock in *Catnic Components*, the *locus classicus* on construction of patent claims, and an authority that had been applied in most Singapore patent infringement cases, including *Bean Innovations*, a decision of the Singapore Court of Appeal. Accordingly, a Queen's Counsel was not required to apprise the Court of Appeal of the significance of *Kirin-Amgen*.

9 In relation to the second issue, Mr Sivakumar pointed out that an application to amend a patent, after it had been granted, involved complex considerations of fact and law. The factual issues involved determining exactly what the amendments comprised of and whether they added subject matter to the patent claim. In this case, that was a complex exercise because of the nature of the goods concerned: they were electronic items produced in a competitive and developing market and therefore the judge had to consider, as a matter of fact, whether there was prior art that anticipated the amendments applied for. The legal issues involved the manner in which the judge's discretion to allow an amendment should be exercised, *ie*, what factors the court should take into account when making such a decision. This was a new area of law that had not been adjudicated upon previously in Singapore.

10 Mr Yeo submitted in reply that the mere fact that there had not been any previous local decision on the factors to be taken into account in deciding whether a patent could be amended did not automatically mean that the issue was one of sufficient difficulty or complexity. There were UK authorities that had dealt with such issues and local counsel were well qualified to submit on the relevant case law to the Court of Appeal in order to assist the court in deciding whether such law applied to the present case and, if so, in what manner. Local counsel were also more qualified to argue whether English principles should be applied in the local context.

11 As for the third issue, according to Mr Sivakumar, the novel point here arose from the factual background. The third appellant, who was the manufacturer of the products, was a foreigner and had never undertaken any direct sales of the products in Singapore. The judge had, however, found that the third appellant had made an "offer to dispose of" the products in Singapore within the meaning of s 66 of the Patents Act simply because there was a hyperlink between the third appellant's website and the other appellants in Singapore, which directed interested parties back to the website of the Singapore distributor from whom they could buy the products in Singapore. The legal question was whether the existence of such a hyperlink on its website meant that the third appellant was making an offer to dispose of the goods in Singapore and, therefore, what the exact meaning of "offer to dispose" in s 66 of the Patents Act was. Mr Sivakumar also pointed out that a determination of this issue could have wide-ranging implications in view of the widespread use of the Internet in modern commerce.

12 Rebutting this point, Mr Yeo repeated his submission that a lack of local decisions on the issue was not necessarily an indication that the issue was of "sufficient difficulty or complexity". Even if there were important commercial ramifications, such an argument did not explain the need for a Queen's Counsel. Having dealt with this case from its inception in 2002, Mr Sivakumar himself as local counsel for the appellants would have an intimate knowledge of the business relationship between the three appellants, and it was that relationship that was crucial in determining whether the hyperlink was part of a common design between the three appellants to infringe the respondent's patent in Singapore, thus making the third appellant a joint tortfeasor here, notwithstanding that it did not physically sell or advertise the goods in Singapore.

13 The fourth issue, that of what constituted a groundless threat under s 77 of the Patents Act, had not been considered in Singapore before this case although there had been an extensive body of law on it in England. Mr Sivakumar informed me that, in this case, the respondent had written to the appellants stating that it was the owner of the respondent's patent and asking the appellants whether they would like to enter into discussions on the matter with the respondent. Lai J had held that this letter was a business collaboration letter and not a threat. The appellants criticised this holding on the basis that it did not take into account the subjective reaction of the appellants and other recipients of the letter to its contents; they had felt threatened. Mr Sivakumar submitted that the determination of this issue would be of importance to the business community generally as it would affect the way that businesses in Singapore were able to notify third parties about their rights without crossing the line between an innocent notification, which is permissible under s 77, and an illegal groundless threat, which the section proscribes. In reply, Mr Yeo relied basically on the same arguments that he had made in relation to the previous issues.

14 I considered Mr Yeo's arguments carefully. In my view, the issues delineated by the applicant were of varying degrees of difficulty, the most difficult and complex ones being the second and third issues. Whilst the first issue was one that the courts in Singapore had dealt with on previous occasions and the fourth issue would not present too much difficulty even though the courts here had not considered it before, the case had to be looked at in its full context. The difficulty and complexity of the case as a whole was increased by the fact that counsel would have to deal with all four issues in relation to a complex set of acts arising out of a lengthy trial involving several experts. I was particularly concerned with the tests to be applied for the amendment of a patent after it had been granted, as this would send a signal to all patent holders and potential applicants for patents as well as provide guidance for our patent registry which, it has to be admitted, is a young institution. I also thought that the question of what it meant to make an "offer to dispose of" goods within Singapore involved interesting points for determination in an age where the Internet has global reach and that the court would benefit on this issue from the experience of counsel who had international, not just local, experience. I was satisfied, overall, therefore, that the issues in the Appeals were of sufficient complexity and difficulty to justify the admission of a Queen's Counsel.

Circumstances of the case

15 The second stage of the inquiry was for me to determine whether the circumstances of the case warranted my exercise of discretion in favour of admitting a Queen's Counsel. The circumstances that the applicant put forward as supporting the application were that he had already represented the third appellant in contested proceedings initiated by the third appellant to revoke the respondent's UK patent, which had been derived from the same patent application as the respondent's patent which was the subject matter of the Appeals. The UK patent was therefore in respect of the same invention as the respondent's patent that would be considered by our Court of Appeal. Furthermore, the respondent had also attempted to amend its UK patent and the third appellant had challenged the amendment. There was some overlap in respect of the evidence and

prior art relied on by both parties in the UK proceedings and those which had been tendered in Singapore.

16 Accordingly, the applicant was fully aware of all the evidence that had been filed and of the issues that had been raised in the Singapore actions by reason of the patent for the same invention being litigated on in the UK. There was no need to separately brief the applicant or familiarise him with the evidence or the issues or the law. The applicant was also familiar with the technology behind the invention. This was an important consideration as local senior counsel would have to be apprised of the technology, review the voluminous documents filed in the record of appeal and understand the relevance of the physical exhibits and the technology in the prior art documents. It was also argued that the appellants would be prejudiced if they had to brief a local senior counsel as there was not sufficient time for him to become familiar with the papers and, in any case, the costs of briefing local senior counsel would exceed the costs of employing the applicant for the Appeals since he was already familiar with the facts and law.

17 Mr Yeo's submission was that the applicant's arguments did not give the full picture. The applicant had only represented the third appellants in the UK in relation to the revocation proceedings and the issues involved in those proceedings were more limited than the issues in the Appeals. The UK proceedings did not deal with the joint-tortfeasor issue or with the issue relating to groundless threats of infringement. Although there was an application to amend the UK patent, that took place before the UK Patents Registry and not before a court during the trial of a patent infringement and therefore different considerations were involved.

18 I considered that the circumstances here did justify the admission of the applicant. It was not only an advantage to the appellants, but also an advantage to the court if the counsel who appeared on the appeal was already conversant with the issues and the facts. A local senior counsel who had not been involved in the proceedings would have considerably more difficulty in preparing for the appeal than the applicant would. Whilst the issues raised were legal issues, proper elucidation of the first and second issues in particular required a full understanding of the facts and the technology involved in the invention and any prior art relied on by the appellants to invalidate the respondents' patent. The invention concerned was not a simple mechanical product but involved complex technology, and thus a prior and full understanding of the product would be a great advantage to counsel handling the case. It is not easy to acquire such knowledge in a few short weeks.

19 I also found relevant the circumstance that the invention involved in this case is of a type of product that is sold all over the world by different manufacturers and, therefore, there will be international interest in the way in which the respondent's patent is interpreted and also in the guidance the court gives on how the actions of manufacturers overseas may be regarded as infringing patents registered in Singapore. In addition, whilst the Court of Appeal has dealt with patent cases in the past, counsel could not name more than four such cases that had come up before the Court of Appeal in the past few years. This is still very much a developing area of the law. It is also an area of the law that has been explored in greater depth in other jurisdictions due to the earlier establishment of patent registries abroad. Foreign counsel who have spent many years specialising in patent law can, therefore, in the appropriate case, be of great assistance to our courts as they strive to develop patent law in Singapore.

20 As the representative from the Attorney-General's Chambers noted (the Attorney-General did not take a position on this application but did offer the court assistance), the purpose of the amendments that were made to s 21 of the LPA in 1991 was to restrict the hitherto rather free admission of Queen's Counsel in order to assist in the development of the local Bar, but not to eliminate the appearance of Queen's Counsel in our courts altogether. Those amendments have had

the desired effect and, as pointed out by Lai Kew Chai J in *Re Flint Charles John Raffles QC* [2001] 2 SLR 276 at [9], the local Bar has matured and is acquitting itself commendably and contains a body of Senior Counsel, potential senior counsel and impressive young counsel with excellent academic credentials and a right attitude. This being the case, the occasional admission of a Queen's Counsel in the right case is not going to damage the development of the local Bar but, in my view, will enhance its independence and competence especially in an area where few local counsel have had the benefit of seeing top-notch counsel in action. I understand that in Singapore, at present, there is only one senior counsel who is a specialist in intellectual property law, including patent law.

Conclusion

21 Coming to the third stage of the test, it was not disputed that the applicant did possess the special qualifications and the experience required to represent the appellants in this appeal. As, in my judgment, the applicant had satisfied the three-stage test for admission as an advocate and solicitor on an *ad hoc* basis under s 21 of the LPA, I granted the application.

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