

Energenics Pte Ltd v Musse Singapore Pte Ltd and another suit
[2013] SGHCR 21

Case Number : Suit No 577 of 2011 (Summons No 1047 of 2013) and Suit No 383 of 2012 (Summons No 1955 of 2013)

Decision Date : 19 July 2013

Tribunal/Court : High Court

Coram : Justin Yeo AR

Counsel Name(s) : Mr Lionel Tan and Ms Jocelyn Chan (Rajah & Tann LLP) for the plaintiff in Suit No 577 of 2011 and Suit No 383 of 2012; Mr Vignesh Vaerhn and Ms Tan Lijun (Allen & Gledhill LLP) for the defendant in Suit No 577 of 2011; Mr Nicholas Narayanan (Nicholas & Tan Partnership LLP) for the defendant in Suit No 383 of 2012.

Parties : Energenics Pte Ltd — Musse Singapore Pte Ltd

Patents and Inventions – Assignment

Civil Procedure – Pleadings – Striking Out

19 July 2013

Justin Yeo AR:

1 This judgment concerns two separate but related applications, *viz* Summons No 1047 of 2013 (“Summons 1047”) and Summons No 1955 of 2013 (“Summons 1955”), brought respectively in Suit No 577 of 2011 (“Suit 577”) and Suit No 383 of 2012 (“Suit 383”). Energenics Pte Ltd (“Energenics”) is the plaintiff in both suits. The defendant in Suit 577 is Musse Singapore Pte Ltd (“Musse Singapore”) – a company incorporated in Singapore, while the defendant in Suit 383 is Musse Incorporated (“Musse Incorporated”) – a company incorporated in Malaysia. Musse Singapore is a wholly owned subsidiary of Musse Incorporated. For clarity, all parties will be referred to by their abbreviated names as set out in the present paragraph, although where appropriate, Musse Singapore and Musse Incorporated will be referred to collectively as “the Defendants”.

2 The applications are deceptively simple. Summons 1047 is an application by Energenics pursuant to O 20 r 5 of the Rules of Court (Cap 322, R 5, 2006 Rev Ed) (“Rules of Court”), for leave to amend its pleaded Reply in Suit 577. Summons 1955 is an application by Musse Incorporated to strike out certain paragraphs of Energenics’s Statement of Claim in Suit 383. However, it will become apparent that the applications involve a complex procedural history and (more importantly) raise novel legal issues.

Background

3 There is a common factual background to both suits. On 20 October 2009, Musse Singapore filed a patent application No 200907041-8 titled “An Apparatus and Method for Size Reduction” (“the Patent Application”) *vis-à-vis* the invention in question (“the Invention”) with the Intellectual Property Office of Singapore (“IPOS”) or, more specifically, the Registry of Patents. The inventors named in the Patent Application are (collectively, “the Named Inventors”):

(a) Mr Mark Pilgrim;

- (b) Mr Paul Hitchcock;
- (c) Mr Wayne Pearce; and
- (d) Mr Ronen Hazarika ("Mr Hazarika").

4 According to the Defendants, the Named Inventors assigned their individual rights in the Invention to Musse Singapore by way of a Deed of Assignment dated 16 October 2009. Subsequently, Musse Singapore assigned its rights and interests in the Invention to Musse Incorporated by way of a Deed of Assignment dated 15 June 2011.

5 Energenics purports to assert its rights and interest in the Invention by claiming, *inter alia*, that:

(a) Energenics's then-employee, Mr Hazarika, had contributed to the inventive concept of the Invention in the course of his duties while he was under Energenics's employ, and that as such, Energenics has ownership rights in the Invention pursuant to s 49(1) of the Patents Act (Cap 221, Rev Ed 2005) ("the Patents Act"); and

(b) Further or in the alternative, that one Mr David Mansel Williams ("Mr Mansel") who had contributed to the inventive concept of the Invention had, together with his employer MNT Consultants (UK) Limited, assigned all the rights and interest in the Invention to Energenics by way of a Deed of Assignment dated 3 November 2011 ("the Mansel Assignment Deed").

6 Due to the complicated procedural history to the applications, it would be useful to set out a brief summary of the lead-up to the present applications:

(a) On 18 August 2011, Energenics filed a Statement of Claim in Suit 577, asserting rights to the Invention as the employer of Mr Hazarika. On 14 September 2011, Musse Singapore filed its Defence, denying Energenics's rights and contending that Mr Hazarika is not an inventor of the Invention;

(b) On 15 December 2011, Mr Mansel applied to the Registry of Patents via Patents Form 7 to include himself as one of the inventors to be named in the Patent Application ("the Inventorship Application");

(c) On 26 January 2012, Energenics filed an amended Statement of Claim in Suit 577, pleading that Mr Mansel is an inventor of the Invention. Musse Singapore filed an amended Defence on 16 February 2012, denying that Mr Mansel is an inventor of the Invention;

(d) On 9 March 2012, Mr Mansel filed a Statement of Inventorship with the Registry of Patents, setting out the facts relied upon in the Inventorship Application;

(e) On 25 June 2012, Energenics filed a Statement of Claim in Suit 383, asserting rights to the Invention, and that both Mr Hazarika and Mr Mansel are inventors of the Invention. On 8 August 2012, Musse Incorporated filed its Defence, asserting that neither Mr Hazarika nor Mr Mansel are inventors of the Invention;

(f) On 22 August 2012, Musse Incorporated filed a detailed Counter-Statement with the Registry of Patents, opposing the Inventorship Application; and

(g) A Case Management Conference was scheduled on 22 October 2012. However, Mr Mansel *withdrew* the Inventorship Application by way of a letter to the Registry of Patents dated 19 October 2012. Energenics asserts that Mr Mansel withdrew, not because he was not an inventor of the Invention, but because he did not wish to be directly embroiled in any acrimonious legal tussle over the Invention.

7 The result of the above chain of events is that neither Energenics nor Mr Mansel have applied (or are applying) to be named as the proprietor or inventor of the Invention in any of the applications filed with the Registry of Patents in respect of the Invention.

8 Energenics, however, continues to seek its legal rights to the Invention and to the Patent Application through Suit 577 and Suit 383. The crux of Energenics's claim in both suits is for a declaration by the High Court of Energenics's lawful rights and interests in the Invention and the Patent Application.

9 It should be noted that Energenics was initially quite content to emphasise that it was not seeking, in the High Court, any determination of Mr Mansel's inventorship of the Invention (see paragraph 3(a) of the Reply in Suit 577). Indeed, in the 7th Affidavit of Hanumanth Rao Bhunsle filed on behalf of Energenics on 9 May 2012 at paragraph 13, the deponent confirmed that "the issue of inventorship is to be decided before the Registrar of Patents".

The applications before this court

10 Both of the applications before this court concern only Energenics's claims related to Mr Mansel's purported inventorship of the Invention as well as his purported assignment of rights and interests in the Invention to Energenics ("the Mansel Claims").

11 Energenics applied, through Summons 1047, to amend its Reply in Suit 577. While the proposed amendment is technically a deletion of certain paragraphs of Energenics's Reply, it is a deletion of a limitation and clarification at paragraph 3 of the Reply. In other words, the proposed deletion *substantially broadens* the claim being brought by Energenics in Suit 577. It effectively purports to *reintroduce* the issue of Mr Mansel's inventorship of the Invention (as part of the Mansel Claims) as an issue to be determined in Suit 577.

12 Musse Incorporated applied, through Summons 1955, to strike out paragraphs 8, 15-18 and 28(b) of Energenics's Statement of Claim in Suit 383. The paragraphs sought to be struck out relate to the Mansel Claims. The basis for the striking out is O 18 r 19(1) of the Rules of Court, *viz* that the said paragraphs disclose no reasonable cause of action, that they are scandalous, frivolous or vexatious, that they may prejudice, embarrass or delay the fair trial of the action, or otherwise abuse the process of the court.

13 Both applications were heard together because they concerned the same subject matter, *viz*, the Mansel Claims. Indeed, as is evident from the two foregoing paragraphs, the paragraphs of the Statement of Claim that Musse Incorporated sought to strike out in Suit 383 concerned precisely the same issues that Energenics sought to reintroduce in Suit 577 through an amendment to its Reply. The issue of Mr Mansel's inventorship therefore constituted the substantial crossing of swords in both applications. This means that should I decide to strike out the allegedly offending paragraphs of Energenics's Statement of Claim in Suit 383, it would follow that I would be slow to allow an amendment to introduce the very same issues in Energenics's Reply in Suit 577.

14 I therefore directed that Summons 1955 be heard first, followed immediately by Summons 1047.

The respective counsel for Energenics (Mr Lionel Tan ("Mr Tan")), Musse Singapore (Mr Vignesh Vaerhn ("Mr Vaerhn")) and Musse Incorporated (Mr Nicholas Narayanan ("Mr Narayanan")) were simultaneously present during the hearings of both applications. Indeed, in view of similarity of issues raised, Mr Tan was content to stand by the submissions he had made in Summons 1955 during the hearing of Summons 1047. Mr Vaerhn and Mr Narayanan also provided helpful assistance to this court during both applications, to which Mr Tan graciously did not object.

Parties' arguments

15 Mr Narayanan argued that the principle of *nemo dat quod non habet* applies to choses of action (including patents), and accordingly, that Energenics had no *locus standi* to make any claims related to Mr Mansel's inventorship. He emphasised that the Mansel Claims are premised on Mr Mansel's purported inventorship rights, and are – in the circumstances – "wholly baseless" and "no more than a mere speculation that Mr Mansel is an Inventor or would make a claim on any inventorship rights, where the objective record shows otherwise". [\[note: 1\]](#) Mr Narayanan argued that s 24(1) of the Patents Act, read with r 17 of the Patents Rules (Cap 221, R 1, 1996 Rev Ed) ("the Patents Rules"), means that it is mandatory for a person who alleges that he ought to have been mentioned as an inventor to make his application to the Registry of Patents on Patents Form 7. [\[note: 2\]](#) Mr Narayanan also argued that sidestepping the Registry of Patents, and going directly to the High Court for a determination of Mr Mansel's inventorship is an abuse of process, [\[note: 3\]](#) especially since Mr Mansel had the opportunity to determine his inventorship in the proper forum (*viz*, before the Registrar of Patents) but instead elected to withdraw the Inventorship Application. [\[note: 4\]](#)

16 Mr Vaerhn argued that inventorship is not assignable under the law, and therefore that Mr Mansel's purported inventorship could not have been assigned to Energenics. He further contended that Energenics could not rely on the Mansel Assignment Deed to claim that it had been assigned the right to commence an application to determine Mr Mansel's inventorship or to do so on Mr Mansel's behalf. [\[note: 5\]](#) He emphasised that the right to be mentioned as an inventor is a personal right, and that Energenics had no *locus standi* to bring the claims related to Mr Mansel's inventorship. [\[note: 6\]](#) Mr Vaerhn also argued that the Registrar of Patents has the first instance jurisdiction for determining issues of inventorship, that the High Court is *not* the proper forum of first instance, and that Energenics's claim in this regard is an "attempt to disregard the appropriate legal process and forum shop for its own self-serving needs". [\[note: 7\]](#)

17 Mr Tan, on the other hand, argued that as Mr Mansel had already assigned to Energenics all his rights and benefits arising from the Invention, Mr Mansel no longer had any *locus standi* to claim reliefs and/or benefits arising from the Invention. [\[note: 8\]](#) He claimed that the Mansel Claims were solely for Energenics's own interest and benefit, and not for the benefit of Mr Mansel. He argued that s 24(2) of the Patents Act evinces that persons other than the inventor, such as an applicant for a patent, may identify the person or persons whom he believes to be the inventor. [\[note: 9\]](#) Section 24(2) of the Patents Act provides:

(2) Unless he has already given the Registry the information mentioned in this subsection, *an applicant for a patent* shall, within the prescribed period, *file with the Registry* a statement –

(a) *identifying the person or persons whom he believes to be the inventor or inventors; and*

(b) *where the applicant is not the sole inventor or the applicants are not the joint inventors, indicating the derivation of his or their right to be granted the patent,*

and, if he fails to do so, the application shall be treated as having been abandoned.

[emphasis added]

18 It should be noted that s 24(2) of the Patents Act does not further Mr Tan's cause. The section refers to "an applicant for a patent", and also the requirement for the applicant to file, within the "prescribed period", a statement with the Registry of Patents. It is undisputed that Energenics is *not*, at the moment, an applicant for a patent. The point on s 24(2) of the Patents Act is therefore not directly relevant to the applications before this court.

19 Mr Tan claimed that a finding of inventorship by the High Court would be an objective determination based on documentary evidence and/or witness testimony, regardless of Mr Mansel's unwillingness to register himself as an inventor with the Registry of Patents. [\[note: 10\]](#) He further argued that Energenics was entitled to seek the High Court's determination, at first instance, of the Mansel Claims. In making this argument, he cited s 91 of the Patents Act (relating to the general powers of the High Court; see [42] below), emphasising that whether Energenics had the "lawful rights and interests" or "proprietary interests" in the Invention and the Patent Application was a question for the High Court's determination, and that in determining this issue, the High Court may have to determine whether Mr Mansel was an inventor of the Invention. [\[note: 11\]](#) He also suggested that, pursuant to s 44(1) of the Patents Act (relating to the rectification of the Patent Register; see [62] below), it would follow from such a determination by the High Court that the Patent Register may have to be rectified as it does not currently list, *inter alia*, Mr Mansel as an inventor.

20 With respect, it was not absolutely clear what Mr Tan meant by the "lawful rights and interests" and "proprietary interests" that Energenics purportedly had in the Invention as well as the Patent Application. During oral submissions, it appeared that Mr Tan was relying on s 20(1)(a) of the Patents Act, which allows a person to "refer to the Registrar the question whether he is entitled to be granted... a patent for that invention or has or would have any right in or under any patent so granted or any application for such a patent". The analysis therefore proceeds on this basis (see [27] *et seq*).

Issues before this court

21 The overarching question before this court is that of whether Energenics's attempt to seek, in the High Court at first instance, a determination on its rights to the Invention (as purportedly assigned via the Mansel Assignment Deed) attracts any of the grounds for striking out in O 18 r 19(1) of the Rules of Court. This question may, for convenience and analytical clarity, be broken down into two issues:

- (a) First, whether Energenics has the *locus standi* to seek a determination of the Mansel Claims ("Issue 1"); and
- (b) Second, if Issue 1 is answered affirmatively, whether Energenics's seeking of a determination of the Mansel Claims in the High Court at first instance nonetheless amounts to an abuse of process ("Issue 2").

Issue 1: Locus Standi

22 The first issue is that of whether Energenics has the *locus standi* to seek a determination of the Mansel Claims.

Non-assignability of inventorship

23 With regard to this issue, there is a preliminary point that can be quickly addressed and disposed of. This point arises because it is unclear whether Mr Narayanan and Mr Vaerhn are making the following contention: that because inventorship cannot be assigned under the law, Mr Mansel *could not have* assigned his inventorship to Energenics, and accordingly, Energenics has no *locus standi* to seek any determination of the Mansel Claims (see [15]-[16] above).

24 In any event, this does not seem to be a “live” issue, as Mr Tan agrees that inventorship cannot be assigned. [\[note: 12\]](#) Indeed, it is clear that inventorship cannot be assigned, for at least two reasons:

(a) First, s 2(1) of the Patents Act defines an “inventor” as “the *actual deviser* of the invention” [emphasis added]. The phrase has been interpreted to mean “the *natural person* who came up with the inventive concept” [emphasis added], and excludes those who merely “contributed to the claim” especially if the contribution is in the form of “non-patentable integers derived from prior art” (*Yeda Research and Development Co Ltd v Rhone-Poulenc Rorer International holdings Inc* [2007] Bus LR 1796; [2008] RPC 1 (“*Yeda Research*”) at [20] *per* Lord Hoffmann; see also Susanna Leong, *Intellectual Property Law of Singapore* (Academy Publishing, 2013) (“*Susanna Leong*”) at p 535 paragraph 21.010). Indeed, only those who have contributed to the “formulation of the inventive concept” are considered to be “actual devisers” (*University of Southampton’s Applications* [2005] RPC 220 at 234 *per* Laddie J; and see *Susanna Leong* at p 535 paragraph 21.010). Furthermore, it bears emphasis that an inventor must be a “natural person” (*Yeda Research* at [20]); as such, it is *impossible* for Energenics to be the “inventor” (or to possess “inventorship”) of the Invention.

(b) Second, inventorship is a *personal right* which is unique to the inventor, and which cannot be *assigned* the way proprietary (and other) interests can. Indeed, it is telling that the inventor has a “moral right” to be named even if he is not the proprietor of the patent: see s 24(1) of the Patents Act, which confers upon the inventor the right to be mentioned in any patent granted for the invention (and see also *Susanna Leong* at p 553 paragraph 21.062). Section 24(1) of the Patents Act provides:

The inventor or joint inventors of an invention *shall have a right to be mentioned* as such in any patent granted for the invention and shall also have a right to be so mentioned if possible in any published application for a patent for the invention and, if not so mentioned, a right to be so mentioned in accordance with the rules in a prescribed document. [emphasis added]

25 For completeness, it should be noted that in contrast to an “inventor”, the “proprietor” or “owner” of a patent is the entity to whom the patent is granted and who therefore has the right to conduct activities that would otherwise be considered to have infringed the patent under s 66(1) of the Patents Act (see *A Guide to Patent Law in Singapore* (Alban Kang gen ed) (Sweet & Maxwell, 2nd Ed, 2009) at p 215, paragraph 5.1.2). The proprietor is also the legal owner of all the rights to the patent. Proprietorship of a patent is *not* tied to the inventor *in personam*, and therefore *can* be assigned.

26 For the reasons in [24]-[25] above, the issue of non-assignability of inventorship is not a live issue before this court. In determining whether Energenics has *locus standi* to bring the Mansel Claims, the real question relates to whether Mr Mansel *could have assigned*, under the Mansel

Assignment Deed, any interest to Energenics that would enable Energenics to sustain the Mansel Claims, and if so, the precise nature of the interest purportedly so assigned. This is an issue to which I now turn.

The interest assigned under the Mansel Assignment Deed

27 In the present suits, it is undisputed that although the Patent Application has been made, no patent has actually been granted. The proprietorship right over the patent has therefore not (yet) crystallised, and it is presently purely speculative as to whether or not any patent will eventually be granted. As such, even assuming that Mr Mansel was indeed an inventor of the Invention and that he had assigned his rights to Energenics, it would not be possible for Mr Mansel to have assigned any proprietorship of the patent to Energenics.

28 We are *not*, therefore, dealing with an assignment of a *patent* and/or the *proprietary rights in it*. We are also *not*, for reasons stated in [24]-[25] above, concerned with the assignment of *inventorship rights*. Rather, we are dealing with the assignment of an *interest* in the Invention which has purportedly taken place pursuant to the Mansel Assignment Deed *before* the grant of a patent over the Invention. What, then, is the precise nature of this interest?

29 In my view, the *interest* purportedly being assigned is essentially a bundle of rights related to patent prosecution, which includes the right to refer questions to the appropriate forum regarding (a) the *entitlement* to any patent granted over the Invention (if so granted); (b) a *right in or under any such patent*; and/or (c) a *right in or under any application* for such a patent. In this regard, reference should be made to ss 19(2) and 20(1)(a) of the Patents Act.

30 Section 19(2) of the Patents Act provides:

(2) A patent for an invention may be granted –

(a) primarily to the inventor or joint inventors;

(b) *in preference to paragraph (a)*, to any person or persons who, by virtue of any enactment or rule of law, or any foreign law or treaty or international convention, or by virtue of an ***enforceable term of any agreement entered into with the inventor before the making of the invention*** , was or were at the time of the making of the invention entitled to the whole of the property in it (other than equitable interests) in Singapore; or

(c) in any event, to the *successor or successors in title of any person or persons mentioned in paragraph (a) or (b)* or any person so mentioned and the successor or successors in title of another person so mentioned,

and ***to no other person*** .

[emphasis added in italics and bold italics]

31 Section 20(1)(a) of the Patents Act provides:

Determination before grant of questions about entitlement to patents, etc.

20.—(1) At any time before a patent has been granted for an invention —

(a) any person may refer to the Registrar the question whether he is *entitled to be granted*

(alone or with any other persons) a patent for that invention *or has or would have any right in or under any patent so granted or any application for such a patent*;

[emphasis added]

32 For the avoidance of doubt, whether the interests referred to in [29] above are solely statutory in nature (see *LIFFE v Pinkava* [2007] EWCA Civ 217; [2007] RPC 30 (at [95]), albeit in a different context, where the Court of Appeal of England and Wales held that the ownership of a patent between employer and employee was governed by the UK Patents Act 1977 (“UK Patents Act”) and not by contract; and see *Terrell on the Law of Patents* (Sweet & Maxwell, 17th Ed, 2011) (“*Terrell*”) at paragraph 4-13) or contractual ones (as suggested by the learned author in *Susanna Leong*, on which see [35] below) is not material for the purposes of the present judgment.

The basis of Energenics’s locus standi

33 Section 19(2) of the Patents Act, which prescribes the entities to whom a patent may be granted, expressly allows an inventor to assign to another party his right to be granted the patent (see [30] above). This provision is, for all intents and purposes, *in pari materia* with s 7(2) of the UK Patents Act.

34 As was explained by the High Court of England and Wales in *KCI Licensing Inc v Smith & Nephew plc* [2010] EWHC 1487 (Pat) (“*KCI Licensing*”), if one of the circumstances mentioned in the UK equivalent of ss 19(2)(b) and 19(2)(c) of the Patents Act applies, the person to whom the invention has been assigned *becomes entitled to apply for and be granted a patent* (*KCI Licensing* at [66]). The court also noted that the reference to “the whole of the property” in s 19(2)(b) of the Patents Act must mean that it is possible to assign the *legal title* (and *not* merely the *beneficial interest*) in an invention *before it is made* (*KCI Licensing* at [67]). The court rejected the submission that a purported assignment of a future invention only took effect as an agreement to assign (see also *Terrell* at paragraph 4-12).

35 The Singapore High Court decision of *Trek Technology (Singapore) Pte Ltd v FE Global Electronics Pte Ltd and others and other suits* [2005] 3 SLR(R) 389 (“*Trek Technology*”) illustrates how ss 19(2)(b) and 19(2)(c) of the Patents Act work. In that case, two companies had agreed that the patents arising from their employees’ collaboration would be registered in the name of the plaintiff company. The High Court held that the plaintiff company was entitled to the grant of the patent in question *inter alia* because it had been assigned the right to the invention under s 19(2)(c) of the Patents Act (see *Trek Technology* at [113(b)]; and see Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Ed, 2009) at paragraph 31.1.4). It has also been observed in *Susanna Leong* at paragraph 21.004 that:

... a person or a company may be able to claim an *entitlement* to a patent grant on account of *prior contractual arrangements* with the inventor.

... The company which engages [a consultant-inventor] is entitled to claim a grant of the patent by virtue of the *contractual obligation* (although the consultant would remain the inventor).

[emphasis added]

36 In related vein, s 20(1)(a) of the Patents Act (see [31] above), which is *in pari materia* with s 8(1)(a) of the UK Patents Act, expressly provides that prior to the grant of a patent, a person claiming rights in or under any *patent* so granted or *patent application* may refer his claim to the

Registrar of Patents.

37 I pause here to note two arguments that may militate against finding that Energenics has *locus standi* to bring the Mansel Claims:

(a) First, it may be thought necessary, to ground the Mansel Claims, to determine whether Mr Mansel can even be considered to be an "inventor" for the purposes of, *inter alia*, s 19(2) of the Patents Act, given that he is neither named in the Patent Application nor applying for a patent over the Invention. Mr Narayanan points out that it is undisputed that only the Named Inventors are reflected as the inventors in the Patent Application, and that Mr Mansel is nowhere so named. He also argues that r 17 of the Patents Rules makes it clear that "a person who alleges that he ought to have been mentioned as an inventor or joint inventor *shall* make his application to the Registrar on Patents Form 7" [emphasis added]. Given that Mr Mansel has chosen to *withdraw* the Inventorship Application, it may be thought that he cannot be considered an "inventor" for the purposes of, *inter alia*, s 19(2) of the Patents Act.

(b) Second, Mr Narayanan and Mr Vaerhn have raised numerous arguments with regard to the difficulties engendered should Energenics be permitted to seek a determination of Mr Mansel's inventorship without Mr Mansel being a party to the suits. One obvious difficulty is whether Mr Mansel – not being a party to the suits – would be *bound* by the court's decision on his inventorship. Another difficulty is that despite Mr Tan's assertion that Mr Mansel "will" be attending trial as a witness, the only affidavit evidence available before this court was the more-qualified "may". Mr Vaerhn further submitted that the court cannot *compel* the naming of a person as an inventor where that person is unwilling to be so named. On a related note, it is also unclear whether Energenics is also seeking a direction from the High Court to compel Mr Mansel to assert his purported inventorship via Patents Form 7. As against this, it should be noted that Mr Tan has, in his further submissions, cited the cases of *Stanelco Fibre Optics Limited v Bioprogress Technology Limited* [2004] EWHC 2263 and *Henry Brothers (Magherafelt) Ltd v Ministry of Defence and Northern Ireland Office* [1999] RPC 442 as examples where the court determined issues of inventorship despite the inventors themselves not being parties to the proceedings.

38 There may be some (or even substantial) force in the arguments canvassed by Mr Narayanan and Mr Vaerhn. However, the arguments, while certainly relevant, will – at best – suggest that the Mansel Claims are weak and not likely to succeed (on which I make no determination). This is clearly no ground for striking out the Mansel Claims: see *Gabriel Peter & Partners v Wee Chong Jin* [1998] 3 SLR(R) 649, where the Court of Appeal held (at [21] and [39]) that:

21 The guiding principle in determining what a "reasonable cause of action" is under O 18 r 19(1)(a) was succinctly pronounced by Lord Pearson in *Drummond-Jackson v British Medical Association* [1970] 1 All ER 1094. A reasonable cause of action, according to his lordship, connotes a cause of action which has some chance of success when only the allegations in the pleading are considered. As long as the statement of claim discloses some cause of action, or raises some question fit to be decided at the trial, **the mere fact that the case is weak and is not likely to succeed is no ground for striking it out**

...

39 The court's power to strike out an action pursuant to O 18 r 19 is a **draconian** one. The **discretion should not be exercised too readily** unless the court is convinced it has been clearly shown that the plaintiff's case is **wholly devoid of merit**

[emphasis added in bold italics]

39 In view of the foregoing, I find that Energenics has *locus standi* under ss 19(2) and/or 20(1)(a) of the Patents Act to seek a determination of the Mansel Claims. It cannot be said, at this stage and in this forum, that the Mansel Claims are “wholly devoid of merit”, or that they fail to disclose a reasonable cause of action for the purposes of O 18 r 19(1)(a) of the Rules of Court.

Issue 2: Abuse of Process

40 Having answered Issue 1 in the affirmative, I turn to consider the second issue, *viz* whether Energenics’s seeking of a determination of the Mansel Claims in the High Court at first instance nonetheless amounts to an abuse of process for the purposes of O 18 r 19(1)(d) of the Rules of Court.

The legislative framework

41 It is clear from s 20(1)(a) of the Patents Act that *before* the grant of a patent, the Registrar of Patents has *first instance jurisdiction* to hear any question on whether a person is “entitled to be granted” a patent, or “has or would have any right in or under any patent so granted or any application for such a patent” (“s 20(1)(a) question”). The key issue is whether *only* the Registrar of Patents has *first instance jurisdiction* to hear a s 20(1)(a) question, and that the High Court *does not* have such jurisdiction.

42 Mr Tan emphasised that s 91(1) of the Patents Act (which is *in pari materia* with s 99 of the UK Patents Act) is broad ranging and designed to grant the court a wide jurisdiction over all matters related to the Patents Act. As such, he argued that the High Court *has* the jurisdiction to hear s 20(1)(a) questions at first instance. Section 91(1) of the Patents Act provides:

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.

43 There was, however, some dispute over the meaning of “in the exercise of its original or appellate jurisdiction *under this Act*” [emphasis added] in s 91(1) of the Patents Act. Mr Narayanan and Mr Vaerhn contended that the phrase “under this Act” suggests that the court *does not* have “original... jurisdiction” over *all* matters, and that regard must be had to the precise phrasing of each statutory provision to determine the ambit of the court’s original jurisdiction.

44 In this regard, Mr Narayanan and Mr Vaerhn argued that s 20(1)(a) questions *must* be brought before the Registrar of Patents at first instance. They contrasted the phrasing of s 20(1)(a) of the Patents Act with that of s 67(1) of the Patents Act, arguing that had the legislative intention been that s 20(1)(a) questions could be brought before the High Court at first instance, the section would have been phrased in a manner similar to s 67(1) of the Patents Act. Section 67(1) of the Patents Act reads in relevant part as follows:

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 ... [emphasis added]

45 They further pointed out that if it was envisaged that proceedings could be brought, at first instance, *either* in the High Court *or* before the Registrar of Patents, s 20(1)(a) of the Patents Act

would have been phrased in a manner similar to s 78(1) of the Patents Act, which reads in relevant part as follows:

78. —(1) Without prejudice to the jurisdiction of the court to make a declaration apart from this section, a declaration that an act does not, or a proposed act would not, constitute an infringement of a patent may be *made by the court or the Registrar* in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the proprietor, if it is shown — ... [emphasis added]

46 There is an absence of local authority directly on the point of whether a s 20(1)(a) question *must* be heard at first instance by the Registrar of Patents. UK authorities would be especially persuasive given the *in pari materia* nature of the relevant legislation and similarity of the patent regimes. It would also be useful to consider the *practice* of the UK Intellectual Property Office (“UKIPO”) with regard to patent proceedings, as encapsulated in the UKIPO Patent Hearings Manual and the UKIPO Manual of Patent Practice.

47 It is crucially important to note s 20(7) of the Patents Act, which relates directly to s 20(1)(a) questions, and alludes to the respective jurisdictions of the Registrar of Patents and the High Court in the context of such questions. Pursuant to s 20(7) of the Patents Act, *if* the Registrar of Patents is of the view that the question referred to him involves matters which “would more properly be determined by the court”, the Registrar of Patents may *decline* to deal with the matter and the court “shall have jurisdiction to [determine the matter]”. Section 20(7) of the Patents Act (which is *in pari materia* with s 8(7) of the UK Patents Act) provides:

If it appears to the Registrar on a reference of a question under this section that the question involves matters which would *more properly be determined by the court*, he may *decline to deal with it* and, without prejudice to the court’s jurisdiction to determine any such question and make a declaration, *the court shall have jurisdiction to do so*. [emphasis added]

48 It is unclear whether s 20(7) of the Patents Act, and in particular the phrase “the court shall have jurisdiction to do so”, means that the High Court has first instance jurisdiction to determine a s 20(1)(a) question *if*, and *only if*, the Registrar of Patents declines to deal with it. This interpretation appears to be taken by the UKIPO. Paragraph 8.30 of the UKIPO Manual of Patent Practice states in relation to s 8(7) of the UK Patents Act that:

... If he [*viz*, the Comptroller or the hearing officer] ***does decline to deal*** then the court can ***then*** exercise all the powers given to the comptroller by section 8, *which it could not do if the parties had simply gone first to the court* and launched proceedings for a declaration as to entitlement. [emphasis added in italics and bold italics]

49 A possible alternative interpretation of s 20(7) of the Patents Act is that given the immediately preceding phrase (“without prejudice to the court’s jurisdiction to determine any such question and make a declaration” – a phrase which is also found, albeit in slightly varied form, in ss 67(1) and 78(2) of the Patents Act), the High Court effectively retains all jurisdiction – *including* jurisdiction at first instance – to hear a s 20(1)(a) question.

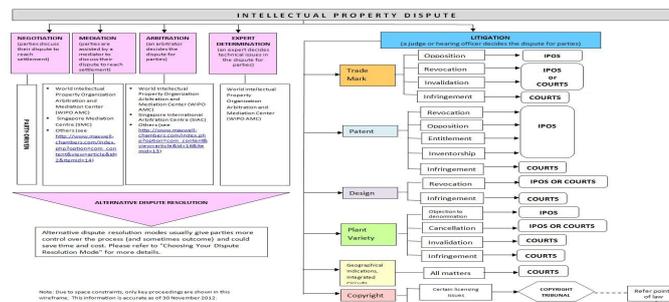
50 I am of the view that a s 20(1)(a) question should be heard at first instance by the Registrar of Patents and *not* the High Court, for three reasons.

51 First, it is clear from s 20(7) of the Patents Act (see [47] above) that the legislature has seen it fit to designate the *Registrar of Patents* as the first instance decision-maker regarding whether he

should decline to determine a s 20(1)(a) question. In this regard, the High Court of England and Wales held, in *Luxim Corp v Ceravision Ltd* [2007] EWHC 1624; [2007] RPC 33 ("*Luxim Corp*"), that the scheme of s 8 of the UK Patents Act (with which s 20(1) of the Patents Act is *in pari materia*) is such that questions are "*in the first instance* referred to the Comptroller" [emphasis added] (*Luxim Corp* at [63]). This is because the Comptroller is the "arbiter about which forum [*viz*, whether the Comptroller or the court] is the more appropriate" (*ibid*). Indeed, the court in *Luxim Corp* went so far as to state that the *default* position is that the case "*remains with him* [*viz*, the Comptroller] unless it appears to *him* [*viz*, the Comptroller] that the question (or matters involved) is more proper to be determined by the court" [emphasis added] (*ibid*). The court noted that while it may be that the very nature of entitlement proceedings may "commonly involve matters which form the regular diet of the court", this is *not* a reason for saying that such cases are more properly to be determined by the court as such an interpretation would result in the Comptroller's statutory jurisdiction being "unduly curtailed" (*ibid* at [50]).

52 The position taken in *Luxim Corp* is reiterated in both the UKIPO Manual of Patent Practice as well as the UKIPO Patents Hearing Manual. Paragraph 8.30 of the UKIPO Manual of Patent Practice expressly cites the *Luxim Corp* decision, stating that it is "*necessary* for hearing officers to consider the matter [of which forum is the more appropriate] in *all cases*" [emphasis added], and that even if both parties request that the Comptroller decline to deal with a matter, the Comptroller may "decide that it is nevertheless proper for the matter to be determined by the comptroller". The Comptroller retains this discretion *even if* "there are parallel High Court proceedings covering much the same issues" (UKIPO Manual of Patent Practice at paragraph 8.30). See also paragraph 2.82 of the UKIPO Patents Hearing Manual.

53 A similar position appears to have been adopted in Singapore by IPOS in its online flow chart on the possible routes for intellectual property disputes (online: <<http://www.ipos.gov.sg/Services/hearingsandMediation.aspx>>, last accessed on 19 July 2013). The part of the diagram relating to patent litigation is reproduced here for reference:



54 If the position taken in the UK (and seemingly taken by IPOS) is adopted, it follows that *even if* all the parties are agreed that a particular dispute about a s 20(1)(a) question should be heard in the High Court (which, for the avoidance of doubt, is not the case here given that the Defendants are disputing the appropriateness of such a proposition), it is the *Registrar of Patents* who is statutorily empowered under s 20(7) of the Patents Act with the discretion to decide on this matter – *not* the parties, whether unilaterally or jointly. To put the same point in another way, should there be any dissatisfaction with the decision of the Registrar of Patents regarding the appropriate forum, the proper recourse is for the dissatisfied party (or parties) to *appeal* to the High Court against the Registrar's decision (see, *eg*, s 90 of the Patents Act). In this regard, *Luxim Corp* was itself a case in which the parties appealed against the Comptroller's refusal to decline to deal with the entitlement proceedings in favour of the High Court.

55 By way of a parenthetical (but related) observation, it should be noted that there is in fact

substantial case law on the factors that the Comptroller should take into consideration in exercising his jurisdiction in this regard (see, eg, *Luxim Corp* and *IDA Ltd v Metcalfe* [2006] EWCA Civ 145; see also paragraphs 8.05-8.09 of the UKIPO Manual of Patent Practice and paragraphs 2.81-2.83 of the UKIPO Patent Hearings Manual). Paragraph 2.81 of the UKIPO Patent Hearings Manual provides a useful non-exhaustive summary of these principles:

... The comptroller should consider exercising discretion to decline to deal whenever a case was complex and should not do so "sparingly" or "with caution". In making the determination, it was necessary to consider the technical, factual and legal aspects of the case and judge these against the expertise and experience of a hearing officer as compared with that of a judge. Technical matters, expert witness evidence, English or foreign patent law would not indicate transfer to the court. Fraud, breach of fiduciary duty, and legal issues falling outside patent law, for example, might do so. The limited costs regime in the Office and its effect on the parties could also be a relevant factor.

56 Second, to borrow the terminology of the court in *Luxim Corp* at [58], it is important to distinguish between the legislative provisions which refer to a "single point of entry" (*viz*, that the applicant must *first* refer a question to a specific forum, which may either be the Registrar of Patents or the High Court as specified in the relevant provision), and one where there is a "choice of points of entry" (*viz*, that the applicant may commence proceedings with *either* the Registrar of Patents *or* the High Court). In the context of the Patents Act, an example of the former is s 67(1) of the Patents Act, which makes clear that patent infringement proceedings must be commenced in court, while an example of the latter is s 78(1) of the Patents Act, which makes clear that a declaration that an act is not an infringing one may be made by either the High Court or the Registrar of Patents (see [44]-[45] above). The same distinction is drawn in the UKIPO Patents Hearing Manual between the provisions relating to, *inter alia*, the determination of entitlement and inventorship (for which the Comptroller has "first instance jurisdiction" and "proceedings must in general be launched before him, not the court") and those relating, *inter alia*, to declaration of non-infringement (for which "there is concurrent jurisdiction at the choice of the plaintiff"). Paragraph 1.04-1.06 of the UKIPO Patents Hearing Manual, dealing with the jurisdiction of the Comptroller, is instructive on this point:

JURISDICTION

1.04 For any issue, *the legislation may prescribe that jurisdiction lies with the comptroller, the courts or both.*

Jurisdiction of the comptroller

1.05 In addition to the comptroller's responsibility for resolving matters arising from the search and examination and grant of applications for patents; in the following matters he has *first instance jurisdiction*, ie *proceedings must in general be launched before him, not the court*:

For patents, proceedings under sections 8, 12, 13 or 37 of the 1977 Act (entitlement and inventorship), sections 27-29 (post-grant amendment, restoration and surrender), sections 46-53 (licences of right and compulsory licences) and section 117 (correction).

...

1.06 In the following matters there is *concurrent jurisdiction at the choice of the plaintiff*, ie

proceedings can be *brought in the first instance before either the court or the comptroller*:

[emphasis added]

57 Third, there are good policy reasons, at least from the perspective of case management and efficiency, to support channelling certain cases through the Registrar of Patents first, before allowing a matter to proceed for determination in the High Court. The possible benefits of the requirement that *inter alia* s 20(1)(a) questions be brought first before the Registrar of Patents may be surmised from the experience in the UK. I name just two.

(a) First, as noted in *Luxim Corp*, there are good reasons, from the perspective of costs, for certain matters to be brought first before the Registrar of Patents. Indeed, the different costs regime for applications before the Registrar of Patents (*contra* the High Court) may be a factor for consideration in determining whether a case should proceed in the High Court (see *Luxim Corp* at [49] and [91]). The court in *Luxim Corp* observed that “there could be a real difference in costs, not least because a party can be represented by an agent without the need to employ lawyers” (*ibid* at [49]). Indeed, Mr Narayanan informed me that cost-savings must, in and of itself, provide good reason as to why the legislature decided to give the Registrar of Patents the power to deal with issues on entitlement, inventorship and registration. He pointed out that in the IPOS proceedings, he had filed a Counter-Statement on behalf of Musse Incorporated in response to the Inventorship Application and was awarded costs and disbursements of only \$190. This is to be contrasted with the significantly higher costs awards that may have been granted for proceedings in the High Court.

(b) Second, it is important to remember the specialist nature of the Registry of Patents, which is precisely the basis for granting the Registrar of Patents the jurisdiction to determine certain matters related to patents (although, of course, it must also be recognised that this is nonetheless subject to the appellate jurisdiction of the High Court). Just like their counterparts in the UK (on which, see *Luxim Corp* at [90]), hearing officers in the Registry of Patents are experienced officers who are well equipped to deal with issues relating to patents. While there may be cases where the issues of fact and law are sufficiently complex to render them more suitable for judicial determination, there will also be cases in which the losing party may not appeal against the decision of the Registrar of Patents (see an allusion to this point in *Luxim Corp* at [56]).

58 It also bears noting that if every purported inventor and/or his assignee insists on asserting rights in the High Court at first instance, this would defeat the legislative intention behind granting the Registrar of Patents the jurisdiction to determine certain matters related to patents.

Application to the facts

59 If Mr Vaerhn and Mr Narayanan are correct that the High Court does *not* have first instance jurisdiction to hear s 20(1)(a) questions, this would render a finding of abuse of process highly likely in the present case.

60 However, for the purposes of the present judgment, it is not necessary, in the final analysis, to decide whether the High Court has first instance jurisdiction to hear s 20(1)(a) questions. This is because the question of whether the High Court has jurisdiction to hear s 20(1)(a) questions at first instance is *conceptually separate* from the question of whether an attempt to bypass the Registrar of Patents and/or to circumvent the legislative framework amounts to an abuse of process. This is not a novel proposition: for instance, albeit in a different context, it is clear that bringing an action for a

“collateral purpose” may result in the same being struck out for abuse of process regardless of whether the court has jurisdiction to hear the claim: see *eg Singapore Civil Procedure 2013* vol 1 (G P Selvam gen ed) (Sweet & Maxwell Asia, 2013) at paragraph 18/19/15.

61 In other words, *even if* I were to find that the High Court *has* jurisdiction to hear a s 20(1)(a) question at first instance, this does *not*, in and of itself, mean that a party is *entitled* to bypass the Registrar of Patents and attempt to seek a determination of a s 20(1)(a) question in the High Court at first instance. An attempt at such circumvention would clearly be a factor to consider *vis-à-vis* whether that party’s actions amount to an abuse of process. The onus is on the party seeking to circumvent the legislative framework – in this case, Energenics – to justify why it should be allowed to do so.

62 In the present case, Energenics proffered a potential reason for trying to proceed before the High Court at first instance: it was applying for a rectification of the Patent Register pursuant to s 44(1) of the Patents Act, and therefore, that the High Court may determine any question which may be necessary to be decided in connection with the said rectification. Section 44(1) of the Patents Act provides:

The court may, on the application of any person aggrieved, order the register to be rectified by the making, or the variation or deletion, of any entry in it.

63 I did not give much weight to this argument. First, it is undisputed that no patent has been granted over the Invention. As such, there is nothing in the Register of Patents to be rectified under s 44(1) of the Patents Act, and the argument is accordingly a non-starter.

64 Second, the argument regarding s 44(1) of the Patents Act appeared to be raised at the hearing as a pure afterthought. This is because in order to bring an application for rectification for the Register of Patents, an applicant must comply with O 87A r 10 of the Rules of Court, which provides:

10. Application for rectification of register of patents (O. 87A, r. 10)

(1) An application to the Court for an order that the register of patents be rectified must be made by originating summons, except where it is made by way of counterclaim in proceedings for infringement.

(2) Where the application relates to the register of patents, the applicant shall forthwith serve a copy of the application on the Registrar who shall be entitled to appear and to be heard on the application.

65 It bears emphasis that O 87A r 10(2) of the Rules of Court expresses that the Registrar of Patents is *entitled to appear and to be heard on the application*. There are no such proceedings in the present case, and the Registrar of Patents has not even exercised his jurisdiction, let alone be able to appear before the High Court and be heard on the Mansel Claims.

66 Upon my querying, Mr Tan confirmed that the procedure mandated by O 87A r 10 had not been followed, and that the present basis for the High Court to hear anything related to the Mansel Claims therefore *cannot* be s 44(1) of the Patents Act. This is not merely a procedural issue; it is illustrative of the larger point that Energenics was *not* in fact attempting to attract the High Court’s jurisdiction under s 44(1) of the Patents Act. Indeed, Mr Tan eventually accepted that s 44(1) of the Patents Act was “irrelevant” to the current proceedings.

67 In the final analysis, even if the High Court has first instance jurisdiction to determine s 20(1) (a) questions (on which I need make no finding), I am not satisfied with the reasons proffered to justify allowing such an approach in this case. I therefore find that attempting to raise the Mansel Claims before the High Court at first instance amounts to an abuse of process.

Conclusion

68 In view of the foregoing, I strike out paragraphs 8, 15-18 and 28(b) of the Statement of Claim in Suit 383. It follows that Energenics should not be allowed to amend its Reply in Suit 577 to introduce the very same claims that I have found to amount to an abuse of process.

69 In making these orders, I note that Energenics may not be left without legal recourse *vis-à-vis* the Mansel Claims. Indeed, Mr Vaerhn noted in oral submissions that “no one is saying that [Energenics or Mr Mansel] cannot try in IPOS”.

70 For instance, it may be thought that Energenics may attempt to apply to the Registrar of Patents for a determination that Energenics is entitled to rights and interests under any patent granted over the Invention, if so granted. Alternatively, Energenics may attempt to take out the appropriate legal proceedings to compel Mr Mansel to apply to the Registrar of Patents for a determination of his inventorship. With regard to this last mentioned point, I note that there are in fact mandatory directions in clause 3 of the Mansel Assignment Deed for Mr Mansel “to assist”, “execute”, “do all acts as may reasonably be necessary or proper” and “to apply” so that Energenics may enjoy its rights and interests in the Invention.

71 However, as the substance of the issues relating to alternative recourse are not before me, it should be emphasised that I make no finding or suggestion on whether Energenics can or will succeed in pursuing such recourse. I am merely making the point that if Energenics has not explored these avenues, the court should be very slow to assist it in what amounts to circumvention of the legislative scheme, especially in the absence of strong and cogent reasons to justify the same.

72 I thank all counsel for the detailed submissions, and for providing valuable assistance to this court on the numerous issues raised in the applications. I will now hear parties on costs.

[\[note: 1\]](#) Written Submissions in Suit 383 (Musse Incorporated) at paragraph 16

[\[note: 2\]](#) Written Submissions in Suit 383 (Musse Incorporated) at paragraph 19

[\[note: 3\]](#) Written Submissions in Suit 383 (Musse Incorporated) at paragraph 28

[\[note: 4\]](#) Written Submissions in Suit 383 (Musse Incorporated) at paragraph 32

[\[note: 5\]](#) Further Written Submissions in Suit 577 (Musse Singapore) at paragraph 53

[\[note: 6\]](#) Written Submissions in Suit 577 (Musse Singapore) at paragraph 33 *et seq*

[\[note: 7\]](#) Written Submissions in Suit 577 (Musse Singapore) at paragraph 37-41

[\[note: 8\]](#) Written Submissions (Energenics) at paragraph 31

[\[note: 9\]](#) Written Submissions (Energenics) at paragraph 35

[\[note: 10\]](#) Written Submissions (Energenics) at paragraph 37

[\[note: 11\]](#) Written Submissions (Energenics) at paras 14 and 36

[\[note: 12\]](#) Further Written Submissions (Energenics) at paragraph 12

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