Sun Electric Pte Ltd *v* Sunseap Group Pte Ltd and others
[2017] SGHCR 6

Case Number : Suit No 1229 of 2016 (Summons No 1221 of 2017)

Decision Date : 04 May 2017

Tribunal/Court : High Court

Coram : Justin Yeo AR

Counsel Name(s) : Mr Jevon Louis (Ravindran Associates) for the Plaintiff; Ms Leow Jiamin (Rajah & Tann Singapore LLP) for the Defendants.

Parties : Sun Electric Pte Ltd — Sunseap Group Pte Ltd — Sunseap Energy Pte Ltd — Sunseap Leasing Pte Ltd

Patents and Inventions – Validity

Patents and Inventions – Defence

Patents and Inventions – Groundless Threats

Patents and Inventions – Revocation

Civil Procedure – Pleadings – Striking Out

4 May 2017 Judgment reserved.

Justin Yeo AR:

1 This is an application by the plaintiff, Sun Electric Pte Ltd ("the Plaintiff"), under O 18 r 19(1) (*a*) to (*d*) of the Rules of Court (Cap 322, R 5, 2006 Rev Ed) ("Rules of Court"), to strike out parts of the Defence and Counterclaim (Amendment No 1) dated 17 February 2017 ("Defence and Counterclaim") and the Particulars of Objection dated 5 January 2017 ("Particulars of Objection"), on the basis that these purport to put in issue claims in a patent that the Plaintiff has not asserted.

Background facts

2 The Plaintiff is the registered proprietor of a Singapore patent granted based on Singapore Patent Application No 10201405341Y ("the Patent"). The Patent is in respect of a power grid system and method of determining power consumption at one or more building connections in the power grid system.

3 The 1st Defendant, Sunseap Group Pte Ltd, is the parent company of a group of related subsidiary companies, which includes the 2nd Defendant, Sunseap Energy Pte Ltd, and the 3rd Defendant, Sunseap Leasing Pte Ltd (collectively, "the Defendants").

4 The Plaintiff's claim against the Defendants in this suit is for alleged infringement of the Patent. The Patent consists of 12 claims. Of these, the Plaintiff alleged that the Defendants have jointly or severally infringed claims 1, 3, 4, 5, 7, 9, 10 and 11 by carrying out a number of alleged acts listed in the Plaintiff's Particulars of Infringement (Amendment No 1) dated 2 February 2017. The Plaintiff did not allege infringement of the remaining claims in the Patent, *ie* claims 2, 6, 8 and 12 ("the

Unasserted Claims").

5 The Defendants have, by way of defence, denied all allegations of infringement of the Patent. The Defendants have also filed a counterclaim against the Plaintiff, of which the following claims are relevant for the purposes of the present application:

(a) an order that the Patent be revoked; and

(b) remedies for groundless threats under s 77 of the Patents Act (Cap 221, Rev Ed 2005) ("the Patents Act"), namely:

(i) a declaration that the Plaintiff has made unjustifiable threats;

(ii) an injunction against the continuance of the threats; and

(iii) damages in respect of any loss which the Defendants have sustained by the threats.

6 Based on the Defence and Counterclaim, the Defendants have put the validity of the entire Patent, *including* the Unasserted Claims, in issue. These are also found in the Particulars of Objection.

The present application

7 Section 82(1) of the Patents Act stipulates a list of five categories of proceedings in which the validity of a patent may be put in issue. Beyond this list, the validity of a patent "may not be put in issue in any other proceedings" (s 82(2) of the Patents Act). Section 82 of the Patents Act reads, in relevant part, as follows:

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.

…

8 The Plaintiff objects to the Defendants putting the validity of the Unasserted Claims in issue.

This is because each claim in a patent stands on its own, and even within a single patent, each individual claim has to be assessed separately (see *Astrazeneca AB v Ranbaxy (Malaysia) Sdn Bhd* [2012] SGHC 7 at [8] ("*Ranbaxy*")). As such, given that the Plaintiff has not relied on the Unasserted Claims, it contends that the Defendants should not be allowed to seek invalidation of the Unasserted Claims.

9 The Plaintiff therefore brought the present application, seeking a striking out of the following:

(a) First, paragraphs 4 and 14 of the Defence and Counterclaim, to the extent that the validity of claims 2, 6, 8 and 12 of the Patent are put in issue. The paragraphs provide as follows:

> 4. Save that it is admitted that the Singapore Patent Application No.10201405341Y (the "Patent") was filed on 29 August 2014 and was subsequently granted on 8 June 2016, paragraph 3 of the SOC is denied. 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.

(b) Second, paragraph 16 of the Defence and Counterclaim, which provides as follows:

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

(c) Third, paragraph 1 of the Particulars of Objection, to the extent that the validity of claims 2, 6, 8 and 12 of the Patent are put in issue. The paragraph provides as follows:

> 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) on the basis that:
>
> a. the alleged invention lacks novelty; …
>
> b. the alleged invention of the Patent involves no inventive step. …

10 The Defendants resisted the application on the basis that they were entitled to put in issue the validity of the entire Patent, including the Unasserted Claims, on each of the grounds stipulated in [11] below.

Issues

11 The issues before this court are whether the Unasserted Claims are properly put in issue by the Defendants on any of the following grounds:

(a) by way of *defence* against the Plaintiff's infringement claim, pursuant to s 82(1)(*a*) of the Patents Act;

(b) by way of a *counterclaim for groundless threats of infringement proceedings*, pursuant to

s 82(1)(*b*) of the Patents Act; and

(c) by way of a *counterclaim for revocation of the Patent*, pursuant to s 80 (read with s 91) and s 82(1)(*d*) of the Patents Act.

12 The parties agreed that if any one or more of the above grounds are made out, the present application for striking out will fail. I turn to analyse each of the grounds in turn.

Section 82(1)(a) of the Patents Act – defence against infringement claim

13 The first issue is whether the Unasserted Claims can be put in issue by way of defence against the Plaintiff's infringement claim, pursuant to s 82(1)(*a*) of the Patents Act.

Parties' arguments

14 Counsel for the Plaintiff ("Mr Louis") argued, citing the authority of *Ranbaxy*, that the Unasserted Claims cannot be put in issue by way of defence.

15 In *Ranbaxy*, the defendant applied to the Singapore Health Sciences Authority for the grant of product licences pursuant to the Medicines Act (Cap 176, Rev Ed 1985) ("the Medicines Act"). The plaintiff instituted proceedings against the defendant, seeking a declaration that certain claims (*ie* claims 1, 2, 3, 11 and 12) of its patent would be infringed by the defendant's intended acts of infringement. The defendant, in its Defence and Counterclaim and Particulars of Objection, put in issue the validity of other claims (*ie* claims 4, 5, 6, 7, 8, 9, 10, 17 and 18) that had not been asserted.

16 The court in *Ranbaxy* held that the defendant was not entitled to put in issue the validity of claims that had not been asserted by the plaintiff. The reasons were as follows:

(a) First, s 82(1)(*a*) of the Patents Act cannot be read to give the defendant the right to put in issue the validity of a patent, where the plaintiff has only alleged infringement of some (but not all) of the claims in the patent. This is by virtue of claim independence and as a matter of logic – putting a claim in issue does not function as a *defence* to infringement of another claim. See *Ranbaxy* at [8]–[9].

(b) Second, the fact that the plaintiff may subsequently assert the other unasserted claims is more properly dealt with by the court as and when the situation arises. The court would, at that time, have to consider *inter alia* whether the plaintiff's fresh assertions of the previously unasserted claims should be struck out as an abuse of the court's process. In particular, the plea of *res judicata* may apply. See *Ranbaxy* at [5]–[6] and [10].

(c) Third, there are practical considerations as to why a defendant should not be allowed to put in issue claims that have not been asserted. Allowing a defendant to do so would be "putting the cart before the horse" (*Ranbaxy* at [29]), and would result in the expending of unnecessary costs and time. While the plaintiff may subsequently attempt to bring infringement proceedings for the previously unasserted claims, this may well be struck out as an abuse of process (see [16(b)] above).

17 In summary, *Ranbaxy* stands for the proposition that, for the purposes of s 82(1)(*a*) of the Patents Act, a defendant can only put in issue claims that have been asserted to be infringed; there is no *carte blanche* for a defendant to put in issue the validity of the entire patent.

18 With regard to *Ranbaxy*, counsel for the Defendants ("Ms Leow") raised the following three arguments:

(a) First, *Ranbaxy* ought to be distinguished from the present case. Unlike the claim in *Ranbaxy*, which concerned a declaration of intended infringement under the Medicines Act, the present case relates to infringement proceedings commenced under the Patents Act.

(b) Second, the reasoning in *Ranbaxy* ought to be disregarded, because that case related to a claim under the Medicines Act instead of the Patents Act and, as such, s 82(1) of the Patents Act should not have been applicable at all. In this regard, Ms Leow cited *AstraZeneca AB (SE) v Sanofi-Aventis Singapore Pte Ltd* [2012] SGHC 16 ("*Sanofi-Aventis*") at [30] for the proposition that an action brought pursuant to s 12A of the Medicines Act is "incompatible" with a patent infringement action brought under s 67 of the Patents Act. Ms Leow further suggested that the incompatibility between the two legislative regimes was "the fundamental reason" that the court in *Ranbaxy* found that the defendant was unable to put the validity of the entire patent in issue under s 82(1)(*a*) of the Patents Act.

(c) Third, unlike the Defendants, the defendant in *Ranbaxy* could not avail itself of any of the other grounds in s 82 of the Patents Act (*viz*, s 82(1)(*b*) to (*e*) of the Patents Act).

Decision

19 In my view, the reasoning in *Ranbaxy* is applicable to the present application, for four reasons:

(a) First, while the underlying claim in *Ranbaxy* (under the Medicines Act) is different from the underlying claim in the present case (under the Patents Act), the mere fact of this difference does not, in and of itself, mean that the *reasoning* in *Ranbaxy* is of no application. Indeed, given that the decision in *Ranbaxy* was specifically based on s 82(1)(*a*) of the Patents Act, the reasoning *ought* to be considered in the present application.

(b) Second, the relevant holding in *Sanofi-Aventis* is that s 12A of the Medicines Act provides a separate cause of action from s 67 of the Patents Act. The issue of whether s 82 of the Patents Act applies to a cause of action under s 12A of the Medicines Act was not discussed at all in *Sanofi-Aventis*. As such, the "incompatibility" referred to by Ms Leow (see [18(b)] above) does not have any direct bearing on the applicability or persuasiveness of the reasoning in *Ranbaxy*. Indeed, it ought to be noted that Ms Leow's alleged "fundamental reason" for the decision in *Ranbaxy* was neither mentioned in, nor implied by, the published decision itself. It should also be noted that the decisions in *Ranbaxy* and *Sanofi-Aventis* were rendered just 6 days apart, and that the former decision did not appear to have been cited to the court deciding the latter case.

(c) Third, in *Sanofi-Aventis*, the court recognised that actions under both s 12A of the Medicines Act and the Patents Act similarly require that the allegedly infringing product must fall squarely within the claim of the patent (see *Sanofi-Aventis* at [31], read with [19] and [23]). This is consistent with the reasoning in *Ranbaxy*, *viz*, that infringement is tied to specific patent claims. It also implies that the invalidation of an unasserted claim is no defence to infringement of an asserted claim.

(d) Fourth, even assuming that the court in *Ranbaxy* had incorrectly proceeded on the basis of s 82 of the Patents Act, the three reasons highlighted at [16] above continue to hold true in the context of infringement proceedings taken out under the Patents Act. In this regard, Ms Leow did

not provide any compelling reason to justify putting the Unasserted Claims in issue by way of defence. While she argued that a claim under s 12A of the Medicines Act deals with intended infringement (*contra* actual infringement), the point remains that the question of infringement – whether *intended* or *actual* – is tied to specific asserted claims in the patent (see the analysis of *Sanofi-Aventis* at [19(c)] above).

20 As such, applying the approach at [16] above, I find that the Defendants are *not* entitled to put the Unasserted Claims in issue by way of defence under s 82(1)(*a*) of the Patents Act.

Section 82(1)(b) of the Patents Act – counterclaim for groundless threats

21 The next issue is whether the Unasserted Claims can be put in issue by way of a counterclaim for groundless threats of infringement proceedings, under s 82(1)(*b*) of the Patents Act.

Parties' arguments

22 Ms Leow argued that the validity of the entire Patent, including the Unasserted Claims, can be put in issue once groundless threats proceedings are brought. She cited the following reasons:

(a) First, nothing in the plain wording of s 82(1)(*b*) of the Patents Act imports a restriction against putting the validity of the entire Patent in issue in groundless threats proceedings.

(b) Second, none of the Plaintiff's threats complained of had made reference to any specific claims in the Patent. As such, the Defendants are entitled to put the validity of the entire Patent in issue.

(c) Third, the scope of infringement proceedings is irrelevant to proceedings for groundless threats, because the commencement of proceedings is, in itself, not a "threat" (citing *Singsung Pte Ltd v LG 26 Electronics Pte Ltd (trading as S Electrical Trading)* [2016] 4 SLR 86 at [134], in the context of the Copyright Act). It follows that the entire Patent can be put in issue regardless of the fact that the Plaintiff has relied only on selected claims in the Patent.

(d) Fourth, there are precedent cases, such as *Siegfried Demel (Trading as Demotec Siegfried Demel) v C & H Jefferson (A Firm) and Another* [1999] FSR 204 ("*Siegfried*"), in which the validity of entire patents have been put in issue in groundless threats proceedings.

23 Mr Louis submitted that only asserted claims can be put in issue in groundless threats proceedings. He raised the following three counter-arguments to Ms Leow's position that the Defendants have a *carte blanche* right to invalidate the entire Patent in groundless threats proceedings:

(a) First, Ms Leow's position flies in the face of the express wording and structure of s 77 of the Patents Act. In particular, the phrase "in a relevant respect" in s 77(2)(*b*) of the Patents Act (the relevant legislation is reproduced at [24] below) precluded the Defendants from putting the Unasserted Claims in issue.

(b) Second, allowing the Defendants to put the Unasserted Claims in issue would result in wasted time and costs for the parties as well as the court. The statutory framework could not have been intended to entitle a party to embark on a pointless and often costly exercise of invalidating unasserted claims of a patent, when these are ultimately irrelevant to the groundless threats proceedings.

(c) Third, on closer inspection of the cases cited by Ms Leow as examples of the validity of entire patents being put in issue in groundless threats proceedings, none of these were helpful to her case. For instance, with regard to *Siegfried*, the parties had in fact commenced separate applications for revocation of the patent in question.

Decision

24 Section 77 of the Patents Act provides the statutory framework for groundless threats proceedings. Of relevance to the present application is s 77(1)–(3) of the Patents Act, reproduced below. To avoid doubt, the reference to "plaintiff" therein includes a plaintiff in a counterclaim (*viz*, the Defendants, in the present case).

Remedy for groundless threats of infringement proceedings

77.—(1) Where a person (whether or not the proprietor of, or entitled to any right in, a patent) by circulars, advertisements or otherwise threatens another person with proceedings for any infringement of a patent, a person aggrieved by the threats (whether or not he is the person to whom the threats are made) may, subject to subsection (4), bring proceedings in the court against the person making the threats, claiming any relief mentioned in subsection (3).

(2) In any such proceedings, the plaintiff shall, if he proves that the threats were so made and satisfies the court that he is a person aggrieved by them, be entitled to the relief claimed unless —

(*a*) the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute an infringement of a patent; and

(*b*) the patent alleged to be infringed is not shown by the plaintiff to be invalid in a relevant respect.

(3) The said relief is —

(*a*) a declaration to the effect that the threats are unjustifiable;

(*b*) an injunction against the continuance of the threats; and

(*c*) damages in respect of any loss which the plaintiff has sustained by the threats.

…

25 In my view, s 77 of the Patents Act should be approached as follows:

(a) A person ("the threatenor"), whether or not the proprietor of the patent in question, threatens another person with proceedings for infringement of the patent. There is no requirement that the threat must stipulate the specific claims of the patent that are allegedly infringed; indeed, in many cases, there would probably be no such specificity in the threats.

(b) A person aggrieved by the threats ("the aggrieved person"), whether or not he is the person to whom the threats are made, brings proceedings in court against the threatenor, for the making of groundless threats. The aggrieved person will have to prove *both* that the threats were made, *and* that he is a person aggrieved by them.

(c) If the threatenor does not seek to justify the threats made, the aggrieved person succeeds on his claim for groundless threats.

(d) If the threatenor seeks to defend himself against the claim for groundless threats, he will have to justify the threats made. In this regard:

(i) The threatenor will have to prove that the patent has been, or will be, infringed by the acts in respect of which the threats were made. In doing so, he must necessarily *specify the claim or claims* that he alleges have been, or will be, infringed. If he fails to prove actual or potential infringement of those claims, the aggrieved person succeeds on his claim for groundless threats. For example, in *Bean Innovations Pte Ltd and another v Flexon (Pte) Ltd* [2001] 2 SLR(R) 116, the patent proprietor sought to defend itself against groundless threats proceedings by relying on only one claim of its patent. It was unable to establish infringement of this specific claim. As such, the aggrieved party succeeded in its claim for groundless threats.

(ii) The aggrieved person may seek to prove that the patent is invalid "in a relevant respect", pursuant to s 77(2)(*b*) of the Patents Act. This means that he must seek to invalidate the *specific claims* that were relied upon by the threatenor in the threatenor's defence against the claim for groundless threats.

26 The crux of the issue before me is whether the phrase "in a relevant respect" in s 77(2)(*b*) of the Patents Act limits an aggrieved person to putting *only* the specific asserted claims in issue; or, put the other way, whether the phrase *precludes* an aggrieved person from putting unasserted claims in issue.

27 On the one hand, the phrase itself does not expressly prescribe any preclusion of putting unasserted claims in issue. Indeed, as a "relevant respect" of a patent is, by definition, a *subset* of the *entire* patent, invalidating the *entire* patent will necessarily also mean that the patent is invalid "in a relevant respect". As such, the phrase may be interpreted simply to mean that an aggrieved person does not have the burden to invalidate the entire patent in order to make out his claim for groundless threats; all he has to do is to show that a "relevant respect" – *ie* the asserted claims – of the patent is invalid. A literal interpretation therefore does not determine whether or not an aggrieved person is *precluded* from putting unasserted claims in issue.

28 On the other hand, there is merit in Mr Louis' observation that, in the context of groundless threats proceedings, it would be entirely futile for an aggrieved person to put the validity of unasserted claims in issue. This is because invalidating those claims would not assist, in any way, his claim for groundless threats. To illustrate, if a threatenor defends against a groundless threats claim by contending that claims 1 and 2 of a 4-claim patent have been infringed, it is pointless for the aggrieved person to prove that claims 3 and 4 of the patent are invalid – for even if he successfully so proves, he still fails to make out his claim for groundless threats.

29 For the reasons stated in [28] above, in the context of groundless threats proceedings, the issue of validity of patent claims ought to be limited to the claims for which actual or potential infringement is alleged. Precluding an aggrieved person from putting unasserted claims in issue would also be consistent with the approach taken *vis-à-vis* defence (see [16] read with [19] and [20], above). If the aggrieved person is really seeking to invalidate all the claims in a patent, including unasserted claims, the proper approach is for him to commence revocation proceedings, instead of relying on a claim for groundless threats.

30 I therefore find that the Defendants are *not* entitled to put the Unasserted Claims in issue by way of a counterclaim for groundless threats of infringement proceedings, under s 82(1)(*b*) of the Patents Act.

Section 82(1)(d) of the Patents Act – counterclaim for revocation

31 The final issue is whether the Unasserted Claims can be put in issue by way of the Defendants' counterclaim for revocation of the Patent.

Parties' arguments

32 At the hearing, Mr Louis cited s 82(2) of the Patents Act for the proposition that proceedings cannot be instituted to seek only a declaration as to the invalidity of a patent.

33 However, Ms Leow clarified that for the purposes of the application, the Defendants were not relying on a declaration as to the invalidity of a patent. Rather, they were relying on a separate cause of action under the counterclaim, which is for an order "that the Patent be revoked" under s 80 of the Patents Act. Paragraph 1 of the Particulars of Objection (see [9(c)] above) makes this clear.

34 Ms Leow made the following submissions.

(a) First, the validity of the entire Patent can be put in issue where revocation is brought as a counterclaim in infringement proceedings. This is because s 82(1)(*d*) of the Patents Act permits validity of a patent to be put in issue "in proceedings before the Registrar [*viz*, the Registrar of Patents] under section 80 for the revocation of the patent".

(b) Second, while s 82(1)(*d*) of the Patents Act makes express reference to "proceedings before the Registrar", and s 80 of the Patents Act mentions only "the Registrar" and not "the court", revocation proceedings can nonetheless be brought directly before the court at first instance. This is in view that s 91 of the Patents Act empowers the court to "make any order or exercise any power which the Registrar could have made or exercised… ".

35 Mr Louis agreed that under ss 82(1)(*d*) read with 80 of the Patents Act, a party is entitled to put in issue *all* claims of a patent because, in his view, s 80 of the Patents Act "does not contain any express limitation". In this regard, he drew a distinction between revocation proceedings and the situations envisaged under ss 82(1)(*a*) (*viz*, defence) and (*b*) (*viz*, claim for groundless threats) of the Patents Act.

36 However, he contended that the right to institute revocation proceedings is confined to proceedings before the Registrar, citing the express wording in ss 80 and 82(1)(*d*) of the Patents Act (see [34(b)] above). He argued that such wording evinced a careful delineation of the proper forum for revocation proceedings to be brought at first instance. In this regard, he cited *Energenics Pte Ltd v Musse Singapore Pte Ltd and another suit* [2013] SGHCR 21 ("*Energenics*") at [56]:

> … 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). [emphasis in original]

37 At the hearing, I informed Mr Louis and Ms Leow that an appeal had been successfully brought

against the decision in *Energenics*, although there is no published judgment or grounds of decision of the appeal. Nonetheless, Mr Louis maintained that the proposition in [56] of *Energenics* should still be considered in the present application.

38 Finally, Mr Louis also pointed out that in *Ranbaxy*, the court had similarly considered a situation in which the defendant had included a prayer for revocation of the patent. The court appeared to disagree with the defendant's attempt to "[sidestep] the statutory restriction in s 82(2)" by seeking a declaration as to invalidity along with revocation (*Ranbaxy* at [17]). The court concluded, at [20], that the defendant had "put the validity of the plaintiff's unasserted patents in issue on a basis falling *outside* of those enumerated in s 82(1), [and therefore] has invariably run afoul of the general rule in s 82(2)" (emphasis in original). Mr Louis thus relied on *Ranbaxy* to argue that, in the present case, the Patent is similarly being put in issue in instances falling outside of s 82(1) of the Patents Act, and that this is contrary to s 82(2) of the Patents Act.

Decision

39 It is undisputed that in revocation proceedings, a party is entitled to put the validity of *all* claims, including unasserted claims, in issue.

40 It is also uncontroversial that s 91 of the Patents Act empowers the High Court to determine revocation proceedings brought under s 80 of the Patents Act. If authority is needed for this trite proposition, it suffices to cite Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Ed, 2009) at paragraph 30.06, where the learned author observed that an application for revocation under s 80(1) of the Patents Act "may be made to the Registrar of Patents *or to the High Court*" (emphasis added), and included a footnote reference indicating s 91(1) of the Patents Act as the source of the High Court's power to hear revocation proceedings.

41 The key issue in contention is therefore whether, in the present case, revocation proceedings may properly be commenced in the High Court at first instance.

42 In this regard, it should be noted that despite Mr Louis' reliance on *Energenics*, the decision does not actually further his arguments. The court did *not* make any finding on the *existence* of the court's *jurisdiction* to deal with issues for which the Registrar is, at least based on the wording of s 20(1)(*a*) of the Patents Act, stipulated as the port of call. Rather, it dealt with whether it was an *abuse of process* for a party to circumvent the legislative framework by commencing such proceedings in the High Court at the first instance (see *Energenics* at [60] and [67]). Furthermore, the decision did not deal at all with s 80 of the Patents Act, which calls for separate analysis.

43 In my view, revocation proceedings can properly be commenced in the High Court at first instance, particularly (as in the present case) where infringement proceedings are already before the High Court and revocation proceedings are brought by way of counterclaim.

44 Indeed, s 82(7) of the Patents Act supports this conclusion. That section provides that where proceedings with regard to a patent are pending in the High Court under any provision mentioned in s 82(1) of the Patents Act (including, *eg*, proceedings for patent infringement), revocation proceedings cannot be instituted before the Registrar except with the leave of the High Court. This means that where revocation proceedings are brought as a counterclaim in proceedings concerning the patent in question, the matter *should*, as a starting point, be brought before the High Court at first instance, unless the High Court grants leave for the matter to go before the Registrar. There is good reason for such an approach – it will avoid a situation where infringement proceedings (which may concern the validity of specific claims in the patent) are before the High Court while revocation proceedings

(which concern the validity of the entire patent) are before the Registrar, as well as the attendant risks of inconsistent decisions arising from such a bifurcation. It would generally also help to streamline proceedings within a single forum, and possibly reduce the resources expended in resolving the dispute.

45 I am fortified in this view by numerous examples of cases where revocation proceedings have been brought by way of a counterclaim and dealt with by the High Court. The examples cited by Ms Leow include *Main-Line Corporate Holdings Ltd v DBS Bank Ltd* [2012] 4 SLR 147, *Dextra Asia Co Ltd and another v Mariwu Industrial Co (S) Pte Ltd and another suit* [2006] 2 SLR(R) 154 and *V-Pile Technology (Luxembourg) SA and others v Peck Brothers Construction Pte Ltd* [1997] 3 SLR(R) 981. It has also been observed in *A Guide to Patent Law in Singapore* (Alban Kang gen ed) (Sweet & Maxwell, 2nd Ed, 2009) at paragraph 8.2.2, that "more often than not, issues relating to the revocation of a patent are heard in the courts rather than before the Registrar".

46 As such, I find that the Defendants are entitled to put the Unasserted Claims in issue under s 82(1)(*d*) of the Patents Act, by way of a counterclaim brought before the High Court for revocation of the Patent.

47 For completeness, I should also address the concern expressed in *Ranbaxy* about a party "sidestepping" the statutory restriction in s 82(2) of the Patents Act by seeking a declaration as to invalidity along with revocation (see [38] above). The court made no clear finding on this issue, and its eventual decision was arrived at on the basis that the defendant had run afoul of s 82(2) of the Patents Act by putting the validity of unasserted claims in issue on a basis falling *outside* the grounds enumerated in s 82(1) of the Patents Act.

48 In my view, when a party brings revocation proceedings, s 82(2) of the Patents Act does not preclude him from concurrently seeking a declaration as to invalidity of the patent in question. This is because he is not instituting proceedings seeking *only* a declaration as to invalidity – on the contrary, he is in fact seeking a declaration *together with* a revocation claim, the latter itself plainly falling within the scope of s 82(1) of the Patents Act.

49 One may then query as to why s 82(2) of the Patents Act precludes a party from instituting standalone proceedings for declarations of invalidity of a patent, while allowing the party to "sidestep" this preclusion simply by concurrently bringing a claim for revocation of the same patent – after all, in both situations, *all* of the claims in the patent are put in issue. In this regard, it should be noted that there is a distinction between a declaration as to invalidity and a revocation of a patent – the latter is executory in nature and is an additional step beyond the former. The purpose of s 82(2) of the Patents Act in precluding standalone proceedings for declarations as to invalidity is, in fact, precisely to ensure that invalid patents are not merely declared to be invalid, but are in fact revoked: see *Terrell on the Law of Patents* (Sweet & Maxwell, 18th Ed, 2017) at para 23-78 (commenting on s 74(2) of the UK Patents Act 1977, which is *in pari materia* with s 82(2) of the Patents Act).

Conclusion

50 Based on my findings at [20], [30] and [46] above, I decline to strike out the paragraphs in the Defence and Counterclaim and the Particulars of Objection. Instead, I order that the Defendants amend paragraphs 4, 14 and 16 of the Defence and Counterclaim as follows:

> 4. Save that it is admitted that the Singapore Patent Application No.10201405341Y (the "Patent") was filed on 29 August 2014 and was subsequently granted on 8 June 2016, paragraph 3 of the SOC is denied. 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.

…

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.

51 I further order that:

(a) If no appeal is brought against this decision within the time limited for appeal as stipulated in O 56 r 1(3) of the Rules of Court:

(i) the amendments to the Defence and Counterclaim, specified at [50] above, are to be made within 7 days after the time limited for appeal; and

(ii) leave is granted for any consequential amendments to the Reply and Defence to Counterclaim to be made within 7 days thereafter.

(b) If an appeal is brought against this decision within the time limited for appeal, the order at [50] above is stayed pending determination of the appeal.

52 I will hear parties on costs.