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## Patents – Case Note

### SINGAPORE'S HIGH COURT HAS NO JURISDICTION UNDER THE PATENTS ACT TO REVOKE A PATENT

#### Overview

In *Sun Electric Pte Ltd* (“the Plaintiff”) v *Sunseap Group Pte Ltd* (“the Defendant”), the Singapore High Court (“the Court”) considered the Defendant’s counterclaims for revocation for Singapore Patent Application No 10201405341Y (“the Patent”) titled “Power Grid System and Method of Determining Power Consumption At One Or More Building Connections In A Power Grid System”, owned by the Plaintiff. The Court found that it does not possess the original jurisdiction under the Patents Act to revoke a patent by way of a counterclaim in infringement proceedings, thus overturning the decision of the Assistant Registrar (“the AR”) in earlier proceedings.

#### Facts

The facts of the case are briefly provided as follows. The Plaintiff is the proprietor of the Patent, which comprises 12 claims. The Plaintiff alleged that the Defendant infringed Claims 1, 3, 4, 5, 7, 9, 10 and 11 of the Patent. The Defendant denied any infringement, and counterclaimed for an order to revoke the Patent, and to seek remedies for groundless threats.

**Decision by Assistant Registrar** - The AR found that the Defendants were entitled to put the validity of all claims, including claims 2, 6, 8 and 12 (“the unasserted claims”)

before the Court by way of a counterclaim in a revocation proceeding.

**At the High Court** - The issue before the High Court was whether the Court may hear revocation proceedings brought by the Defendants by way of a counterclaim in infringement proceedings. Justice George Wei found that the Court does not possess original jurisdiction under the Patents Act to revoke a patent by way of a counterclaim in infringement proceedings and that the Defendant’s prayer for declaration that the patent as a whole is invalid, is too broad and must be limited to the asserted claims the validity of which has been put in issue by way of the defense and the counterclaim for groundless threats of suit.

In reaching the decision, Justice Wei turned to the provisions of the Patents Act itself to determine whether the Patents Act was intended to confer jurisdiction on the High Court to hear revocation applications or to grant an order for revocation in the exercise of its original jurisdiction. Specifically, Justice Wei discussed about Section 80(1), Section 82(7) and Section 91(1) of the Patens Act.

#### i. Section 80(1) of the Singapore Patents Act

The Plaintiff’s main argument was based upon the statutory interpretation of Section 80(1) of the Singapore Patents Act. Section 80(1) reads:

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

On a plain reading of Section 80(1) of the Singapore Patents Act, the provision only provides that the Registrar may revoke a patent, but does not necessarily exclude the Court from granting revocation orders on the basis of invalidity.

Acknowledging that Section 80(1) is expressly made “subject to the other provisions of this [Singapore Patents] Act”, the Court looked to other provisions of the Act. However, Justice Wei found that the statutory provisions on application for revocation in the Singapore Patents Act are set out exclusively in Section 80. There are no other provisions in the Patens Act which explicitly mention or refer to the making of revocation orders by the court in the exercise of its original jurisdiction.

## **ii. Section 82(7) of the Singapore Patents Act**

Section 82(7) of the Patents Act reads:

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

This provision provides that where there are already infringement proceedings before the court, leave of court is required before revocation proceedings can be commenced before the Registrar in respect of the same patent.

Justice Wei was of the view that Section 82(7) is “a house-keeping provision” which did not assist with the question as to whether the court enjoys a jurisdiction to revoke patents. Where the Court is dealing with issues of validity arising by way of defence in infringement proceedings or in groundless threat proceedings, it will be preferable to prevent the defendant from commencing parallel proceedings before the Registrar until the conclusion of the Court proceedings.

Therefore, Section 82(7) does not suggest that both the Court and the Registrar should have jurisdiction over revocation proceedings and is not conclusive on the question of jurisdiction.

## **iii. Section 91(1) of the Singapore Patents Act**

Justice Wei further considered whether Section 91(1) of the Patents Act supports the Defendant’s position. Section 91(1) of the Patents Act reads:

*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.*

Section 91(1) deals with the general powers of the Court in respect of any question in the exercise of its original or appellate jurisdiction under the Patens Act.

Justice Wei found that although, undoubtedly, the High Court can determine questions on revocation under Section 80 in the exercise of its appellate jurisdiction, the High Court does not have original jurisdiction to hear applications for revocation under Section 80 of the Patents Act, nor can the High Court grant an order for revocation by way of a counterclaim in an infringement suit.

### **Pointers to note:**

In short, clients should note that all applications for revocation of a patent should be filed in accordance with the procedures set out in Section 80(9) of the Patents Act and filed with the Registry.

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