National Patent Litigation—Singapore

By Darrell Low

I. Available Reliefs

The starting point is the Singapore Patents Act. The common reliefs available are invalidation and revocation proceedings before the Intellectual Property Office of Singapore (IPOS). Only upon an agreement by the parties involved can the matter of infringement be brought before IPOS.

Relief(s) for Proprietor or the Patent

The reliefs that may be granted by the High Court of Singapore (as court of first instance) would include (a) an injunction to restrain the infringer from any apprehended act of infringement; (b) an order for delivery up or destruction of any patented product in relation to which there is infringement or any article in which the patented product is inextricably comprised or any material and implement for the predominant use for the creation of the infringing product; (c) an award of damages; (d) an order for an account of the profits derived from the infringement; and (e) a declaration that the patent is valid and has been infringed. Do note that the award of damages and order for an account of the profits derived from the infringement are mutually exclusive.

Relief(s) for Alleged Infringer

An alleged infringer may avail himself to the relief of groundless threats of infringement if it is shown that either the patent is invalid in a relevant aspect or the patent is not infringed.

II. Fact Finding & Preservation of Evidence

1. Prior to Litigation

Especially in more complex cases, it is possible to use and employ private investigators to undertake trap purchases for the infringing product. These private investigators will work hand in hand with both the proprietor of a patent and counsel to better ensure that the correct evidence is preserved and obtained for the purposes of any trial.

Alternatively, where appropriate, it is possible for the proprietor of a patent to make online purchases of the infringing product and to keep screenshots or scanned copies of the relevant webpages, delivery order(s) and invoice(s).

Where there is a risk of destruction of the infringing product, upon providing sufficient evidence to the same, the proprietor of the patent may try seek a search order which comes in the form of an injunction that is issued by the High Court for preservation of the evidence; this is at times referred to as an Anton Piller order. The injunction would subsequently be executed the next day at the various premises where the infringing products may likely be manufactured or stored. In more complex cases, the execution of the search order may span a few days. Such injunctive relief should be applied for as early as possible.

2. During Litigation

Where the risk of destruction of the infringing product is low but there is still continued manufacture and sale of the said infringing product, it is possible to seek interim relief in terms of a prohibitory injunction to stop continued use of a patent. To succeed in this regard, it must be demonstrated that the potential damage by the infringer caused cannot be compensated by an award of damages. Again, such injunctive relief should be applied for as early as possible.

If further facts are found and discovered during the course of the litigation, it may be possible to amend the statement of claim (which is the foundation of any infringement proceedings before the High Court) to supplement and augment what had been stated earlier on.

III. Strategic Options

1. Warning/Notice Letters

Such letters can be issued prior to commencement of any formal proceedings (whether before IPOS or the High Court). We would suggest that such letters be drafted in a substantial and impactful manner to demonstrate the seriousness with which the proprietor of the patent treats cases of infringement.

Notice letters may be sent by the proprietor of the patent to inform the alleged infringer of the existence of the patent but reference to the patent should include the number of the patent.

That said, we would also be mindful and careful that an alleged infringer may avail himself to the remedy for groundless threats of infringement proceedings which is provided for under the Patents Act.

2. Preliminary Relief

It is possible to seek interlocutory relief by an application to the High Court for a prohibitory injunction against any alleged infringer to stop them from using the patent(s) that belongs to the proprietor. To succeed in this regard, it must be demonstrated that the potential damage by the infringer caused cannot be compensated by an award of damages. Again, such injunctive relief should be applied for as early as possible.

3. Main Proceedings

The proceedings will have certain interlocutory/interim steps (eg. discovery in terms of document disclosure) to be taken to ready the case for trial itself (which is the main event). Given the dispute(s) of fact that would arise, proceedings before the High Court would be commenced by way of a writ that is coupled with a statement of claim. Upon the writ being served on a relevant party, then the other relevant timelines and procedural rules would be applicable.

4. Claim Amendments During Pending Proceedings

Permission must be obtained by the Court to amend claim(s). The Court of Appeal, in the decision of *Warner-Lambert Company LLC v Novartis* (Singapore) *Pte Ltd* [2017] SGCA 45 stressed that even if the claim amendment does not disclose additional matter or extend the protection conferred by the patent, it retains the general discretion to refuse an amendment application. Some considerations include any unreasonable delay in making such amendment.

5. Protective Letters

Such a mechanism does not currently exist under Singapore law and procedure to allow such protective letters to be filed with the High Court with respect to what would be the foundations of an anticipatory defence to potential infringement.

6. Declaratory Actions for Non-Infringement

A person may seek a declaration from the High Court or Registrar (at IPOS) that he is not infringing on a patent by doing or proposing to do an act, provided that the person has applied in writing to the proprietor of the patent for a written acknowledgment to the effect of the declaration claimed, and has furnished him with full particulars in writing of the act in question; and the proprietor of the patent has refused or failed to give any such acknowledgment.

7. Enforcement Prior to Grant

There is no enforcement action available before grant, although publication of the patent application provides possible back-dating of the calculation of damages subjected to conditions.

8. Customs Seizure

At this stage, the Singapore laws for customs seizures revolve primarily around Copyrights and Trademarks.

IV. Procedural Aspects

1. Court System and Specialization

The court proceedings in Singapore are based on an adversarial system (which differs in various aspects when compared to the inquisitorial system that is found in civil law jurisdictions). As Singapore is a fused system, counsel are both advocates and solicitors. Therefore, the counsel who advises the proprietor of the patent and assists with the discovery process is often the same counsel who argues the interlocutory applications and appears at the trial of the matter.

The High Court has specialist intellectual property law judges and judicial commissioners who hear patent-related matters.

2. Bifurcation

It is possible to apply for a bifurcation of the trial before the High Court in two aspects. First, it is possible to seek a determination as to the validity of the patent in question before one turns to the issue of infringement. This may help to save time and costs for all concerned. Secondly, it is also possible to have a trial on the question of liability (in terms of whether there has been infringement) and then subsequently touch on the issue of the assessment of damages or the account of profits to a later date.

■ Darrell Low,
Yusarn Audrey,
Partner,
Singapore
E-mail: darrell@yusarn.com

3. Who Can Sue

Aside from the proprietor of the patent, in cases of infringement, where there are two or more joint proprietors, any of these co-owners can, without the concurrence of the other co-owners, bring proceedings in respect of alleged infringement of the patent but these other co-owners must be included as parties to the proceedings.

Where the proprietor of the patent has granted an exclusive license, the exclusive licensee shall have the same right as the proprietor to bring proceedings in respect of any infringement of the patent committed after the date of the licence.

4. Who Can be Sued

In relation to a patented product, anyone who makes, disposes of, offers to dispose of, uses or imports the patented product or keeps it whether for disposal or otherwise can be sued.

In relation to a patented process, anyone who uses the process or offers it for use in Singapore with knowledge, or it is obvious to a reasonable person in the circumstances, that its use without the consent of the proprietor would be an infringement of the patent, can be sued.

There is no contributory infringement under Singapore law, but anyone abetting the infringement could potentially be sued under common law of joint tortfeasorship.

5. Admissibility of Evidence

Evidence that is to be admitted shall be by way of lists of documents in the discovery process. The dis-

covery process is on-going and the parties are required to disclose all relevant documents (this includes any documents that may be adverse to the disclosing party). At the same time, the complimentary mode by which evidence is admitted is through the affidavit of evidence-in-chief of each witness (which acts as a witness statement for the trial); this applies to both witnesses of fact and expert witnesses.

6. Structure of the Proceedings

The proceedings commence with the pleadings. The plaintiff(s) file and issue a writ and statement of claim (which sets out the key facts being relied on for the reliefs being sought). The defendant(s) then respond by way of a counterstatement in the form of a defence; should there be related claims then a counterclaim would also be filed at the same time. In response, the plaintiff may choose to file a reply (and defence to counterclaim).

After the pleadings stage is completed, parties move on to discovery and the related interlocutory matters (eg. the issuance of request for further and better particulars to the pleadings)—this interim period before the trial is to get all the relevant matters resolved and ready for trial.

All witnesses giving evidence at trial are to provide their evidence in written form in an affidavit of evidence-in-chief.

At trial, most of the time would be taken up in cross-examination where the witness would attend in court to be asked questions by opposing counsel to test the evidence that has been put forth. In some instances, the judge or judicial commissioner may also pose questions to the witnesses to seek clarifications on.

At the conclusion of the trial, the Judge or Judicial Commissioner would usually ask for written closing arguments (which could be supplemented by way of another oral hearing for reply arguments). Thereafter, upon further consideration the judge or judicial commissioner would hand down the Judgment.

7. Timing Including Preparation

We would propose a window of around one and one-half to two months from the time counsel is briefed to the time court proceedings are commenced. This period would allow for preparation as well as consultation with any potential expert witnesses that may be selected for trial.

For court proceedings, if the matter is not complex, from the time the writ is issued up until judgment is handed down it could be around one year to one-half years. In the more complex cases, this could take anywhere between two years to three years. This is because the High Court has a rather busy calendar and is not that easy to schedule a long and involved trial that could be around three to four weeks (without any breaks in between).

8. Costs and Cost Reimbursement

As a general rule, the successful party would be entitled its costs (as well as reasonable disbursements) that were incurred. Costs are in the discretion of the court and much depends on the factors of each case—this would include how the party conducted the proceedings and its behaviour during the trial itself.

In this regard, these costs would be known as party-and-party costs—this means the costs that is payable by one party to another. These party-and-party costs are always a fraction of the costs that would be incurred by the party in terms of the professional fees and disbursements in relation to its own counsel.

9. Enforcement of Decisions

Enforcement steps that can be taken with respect to a judgment handed down by the High Court include the following:

(a) examination of judgment debtor—where the judgment debtor would be called upon to provide information (on oath) both in writing and by appearance for hearings before the courts as to the assets that it holds and can be used to satisfy any judgment sum;

(b) writs of seizure and sale—the judgment creditor can issue proceedings to have the court's bailiff attend at specified locations to seize items of value and subsequently auction the same off for value to satisfy the judgment sum; and/or

(c) garnishee proceedings—where the judgment creditor is aware of any bank accounts that are located in Singapore, an application can be filed against the banks in relation to that specific bank accounts to freeze the monies contained in these accounts for the purposes of satisfying the judgment sum.

Decisions or Judgments of foreign courts can be enforced in Singapore in two routes. First, if they fall within either the Recognition of Commonwealth Judgments Act or the Recognition of Foreign Judgments Act then the process is comparatively more straightforward. Second, all other decisions or judgments can be enforced by suing on the same as a fresh set of proceedings before the High Court.

10. Appeal

Any appeal from the High Court to the Court of Appeal must be made within one month from the date of the decision.

Should any party be dissatisfied with the decision of the High Court in relation to interlocutory matters (ie. in the period leading up to trial), only certain classes of appeals would be allowed and some other can only be

appealed if leave for appeal was obtained.

After the Notice of Appeal is filed, parties would then have to prepare the relevant bundles and their written arguments (eg. The Appellant's Case or The Respondent's Case). Thereafter, there will be a date fixed for the hearing of oral arguments for the appeal.

A matter that is appealed to the Court of Appeal may take anywhere between eight to 12 months to be heard. Again, much depends on the caseload of the Court of Appeal and the Judges of Appeal.

There is only one round of appeal and the matter would end at the Court of Appeal.

11. Service Abroad

Under the procedural rules, proceedings that are issued can be served outside Singapore.

The High Court can grant leave to the plaintiff(s) to effect service of the writ on any defendant outside Singapore but it must be satisfied that the plaintiff(s) has/have a good arguable case in being able to demonstrate that some factors such as the following exist (a) where relief is sought against the defendant who is domiciled, ordinarily resident or carrying on business or who has property in Singapore, and/or (b) an injunction is sought ordering the defendant to do or refrain from doing anything in Singapore and/or (c) the claim is brought in respect of a breach committed in Singapore of a contract made in Singapore. At the same time, it must be shown that there are serious issues to be tried with respect to the causes of action being put forth.

The application made before the High Court would usually take around three to four weeks from the date it is filed to be heard and decided upon.

Where leave is granted, service outside Singapore must comply with the laws and procedures of the country in which service is effected.

12. Influence of Foreign Decisions

The starting point is the principle of territoriality which allows the High Court to independently determine the outcome in relation to the patent in suit (and the construction of the claims). However, it may in certain instances take into account the on-going prosecutions or outcomes of other related decisions in other jurisdictions' courts and patent offices as a factor in its overall decision-making process.

13. Protection of Confidential Information

For proceedings before High Court, it may be possible to seek confidentiality undertakings to be imposed which are over and above the usual application of the implied application of the Riddick principle (which prevents the use of documents disclosed for any other purpose aside from pursuing the action in which discovery was given without prior approval from the court).

The additional protection can come in form of reinforcing the Riddick principle as an explicit term of an order of court. Alternatively, it may be possible for a Non-Disclosure Agreement (NDA) to be executed by the relevant individuals (*eg.* lawyers, expert witness(es), representatives of the litigants) who may have access to certain more commercially sensitive documents so that any disclosure must be subject to the terms and conditions as spelled out in NDA.

V. Claim Construction

1. Most Important Rules for Literal Claim Construction

Patent claims should be as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly.

Rules derived from case law include:

1. Claims must be read and given their ordinary and natural meaning without incorporating extracts from the body of the specification into them. Hence, if a claim has a plain meaning, then reliance ought not to be placed on the language used in the body of the specification so as to make them mean something different.
2. Regard can (and should) be given to the description and drawings of the patent, as long as these are not used to alter the plain meaning of the claim.
3. The Singapore Court of Appeal has repeatedly endorsed a purposive approach to claim construction. This approach posits that a patent specification "should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge."
4. Even when adopting a purposive construction, one cannot write words into a claim that are not there or give a meaning to a term of a claim that is contrary to its language.
5. Claim construction is done through the eyes of the person skilled in the art.

2. Doctrine of Equivalents

There is no Doctrine of Equivalents under Singapore law for claim construction and interpretation. The purposive approach to claim construction is adopted.

VI. Liability

1. Direct Infringement

In relation to a patented product, a person is liable if he makes, disposes of, offers to dispose of, uses or imports the patented product or keeps it whether for disposal or otherwise. In relation to a patented process, a person is liable if he uses the process or he offers it

for use in Singapore with knowledge, or it is obvious to a reasonable person in the circumstances, that its use without the consent of the proprietor would be an infringement of the patent.

2. Indirect Infringement

Singapore has not legislatively provided for indirect or secondary patent infringement, preferring to leave the matter to be governed by the common law position on joint tortfeasorship on proof of a common design to procure or actually participate in acts of infringement: Susanna H. Leong, Intellectual Property Law of Singapore (Academy Publishing, 2013) at *para* 19.054.

3. Divided Infringement

There is no divided infringement under Singapore law.

VII. Particular Defenses

1. Limitation of Claims

Under the Limitation Act, the time bar of six years from the date the cause of action would be relevant. For example, the limitation period would run from the date on which the infringement first came to the notice and knowledge of the proprietor of the patent.

Since the claims are founded in the Patents Act, the equitable doctrine of laches may not be relevant.

2. Exhaustion

The defence of parallel import enshrines the exhaustion of rights principle. In summary, it is not considered an act of infringement if a patent product, or a product that is obtained by means of a patented process or to which a patented process has been applied, is imported to Singapore, provided that the aforementioned product(s) was produced by or with the consent (conditional or otherwise) of the proprietor of the patent (including corresponding patents for the same invention outside Singapore) or any person licensed by him.

3. Conversion of an Invalid Patent Into a Utility Model

Not possible in Singapore. There is no utility model regime in Singapore.

VIII. Statistics

We are unable to locate any such statistics. ■

Available at Social Science Research Network (SSRN): *https://ssrn.com/abstract=3271174.*