



Recent Developments in Patent Law – *Sun Electric Pte Ltd v Sunseap Group Pte Ltd and others* [2017] SGHC 232

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In *Sun Electric Pte Ltd v Sunseap Group Pte Ltd and others* [2017] SGHC 232, the Court had to deal with the issue of whether a party can seek revocation of a patent by way of a counterclaim.

The Court clarified that the Singapore High Court has no original jurisdiction to hear revocation proceedings or grant a prayer for revocation regardless of whether it is by way of a counterclaim in infringement proceedings or an application for revocation.

A. Background

Sun Electric Pte Ltd (the "**Plaintiff**"), brought a patent infringement action against Sunseap Group Pte Ltd, Sunseap Energy Pte Ltd and Sunseap Leasing Pte Ltd (the "**Defendants**"). Both the Plaintiff and the Defendants are in the business of retailing solar energy.

The Plaintiff was the registered proprietor of a Singapore patent concerning power grid system and a method of determining power consumption at building connections in the system (the "**Patent**").

The Plaintiff commenced an action against the Defendants, averring that the Defendants infringed eight out of 12 claims subsisting in the Patent. The Defendants denied the claims, and counterclaimed for, among other things, a declaration that all 12 claims of the Patent are invalid, and an order that the Patent be revoked. In response, the Plaintiff sought to strike out the counterclaim.

At the hearing before the Assistant Registrar (the "**AR**"), the practical outcome was that the Defendants' counterclaim was substantially allowed to remain as it was. The Plaintiff therefore appealed against the AR's decision.

B. The Appeal

On appeal, the substantive issue was whether patent revocation proceedings can be properly brought before the High Court at first instance by

After considering the relevant provision of the Patents Act (the "**PA**"), the current practice in Singapore, and the legislative intention behind the PA, Justice Wei found that the High Court does not have the jurisdiction to hear revocation proceedings or to grant an order for revocation by counterclaim.

First, Justice Wei took the view that the purpose of s 82(7) of the PA was to prevent "duplicate proceedings". He agreed with the Plaintiff that Parliament did not intend for this provision to give both the High Court and the Registrar of Patents ("**Registrar**") original jurisdiction over revocation proceedings. He noted that the omission of the reference to the High Court in s 82(7), in contrast to its equivalent provision in the UK Patents Act, made it even more likely that Parliament did not intend to give the High Court jurisdiction to hear revocation proceedings.

Second, Justice Wei held that while s 91 of the PA expressly provides the High Court with appellate jurisdiction over many decisions of the Registrar, it does not go so far as to confer on to the High Court the Registrar's original jurisdiction to hear patent revocation proceedings by way of a counterclaim in an infringement suit. S 91 merely provides the High Court with the same powers as the Registrar, when it is exercising its appellate jurisdiction over the Registrar's decision.

Third, Justice Wei drew a distinction between an action *in personam* which binds the parties, and an action *in rem* which also affects parties not in the proceedings. He concluded that a claim for patent revocation goes beyond a defence to an *in personam* claim for infringement. This is because, a patent revocation proceeding involves the determination of the status of a *res*, for the purpose of depriving the patentees of the rights *in rem* that he had against the world. Therefore, in relation to patent revocation proceedings, jurisdiction *in rem* is required. In light of the absence of any statutory basis conferring

original jurisdiction upon the court to hear patent revocation proceedings, Justice Wei held that the High Court therefore does not have jurisdiction to hear patent revocation proceedings.

C. Conclusion

In light of this case, it is important to note the following:

- Revocation proceedings cannot be heard in the High Court at first instance, regardless of whether by way of a counterclaim or an application for patent revocation;
- The High Court has jurisdiction to hear a claim regarding infringement of rights against the proprietor of the patent where the validity of the patent is raised as a defence; and
- A challenger of a patent must initiate revocation proceedings at the patent office even if a court has found the relevant patent to be invalid.

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