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IP Alert



High Court has Power to Revoke Patents

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Sunseap Group Pte Ltd and Others v Sun Electric Pte Ltd [2019] SGCA 4

In earlier proceedings reported [here](#), the High Court had held - in a decision that came as a surprise to many - that the Singapore Patents Act and other legislation did not provide the High Court with original jurisdiction to hear applications for patent revocation or to order that a patent be revoked. This meant that all applications for patent revocation must be heard by the Registrar of Patents at the first instance, and the High Court could only hear appeals from the Registrar's decision.

The High Court's decision has now been reversed by the Court of Appeal, which has held that the High Court has the power to hear applications for patent revocation and to revoke patents. However, this is confined to instances where the application was brought by way of defence and counterclaim in infringement proceedings, and does not extend to applications brought independently of infringement proceedings.

The nuts and bolts

The Court of Appeal explained that if a defendant is able to establish invalidity of all the claims of the asserted patent on any of the grounds in section 80(1) of the Patents Act, it would also succeed in establishing that the patent should be revoked. Following on from that, if the High Court has exercised original jurisdiction to hear the dispute on validity of a patent (i.e., via a defence and counterclaim), section 91(1) of the Patents Act gives the High Court the power to revoke the patent.

Additionally, the High Court may only revoke the patent where the validity of the entire patent is

challenged in the infringement proceedings. In this regard, only the validity of asserted patent claims (i.e., which are said to have been infringed) may be challenged by the defendant and a declaration of invalidity may only be obtained in relation to such claims. Where the validity of the entire patent is not in issue, the High Court has no power to revoke the patent and the defendant would have to seek revocation of the patent by way of proceedings before the Registrar of Patents.

On the other hand, the High Court does not have original jurisdiction to hear applications for revocation brought independently of infringement proceedings because its jurisdiction has been excluded by section 82(2) read with section 82(1) of the Patents Act.

Dependent claims stand and fall together with independent claims?

The Court of Appeal also discussed a scenario where all the independent claims of the patent were asserted and found to be invalid. In this case, the Court of Appeal indicated that if all the independent claims are invalid, "*it follows that the dependent claims must also fall*". In such a case, the Court of Appeal held, the entire patent must be regarded as invalid and it would be proper for the High Court to revoke the same.

This indication can be contrasted with Justice George Wei's statement in the earlier decision of *Lee Tat Cheng v Maka GPS Technologies Pte Ltd* [2017] 3 SLR 1334 that "*it does not follow that the novelty of subsequent claims must ipso facto stand or fall on the fate of the independent claim. Much*

will depend on the scope of the invention as set out in the subsequent claims. The label 'dependent claim' or 'subsidiary claim' should not distract the court from the enquiry which it is tasked to undertake, which is whether the elements or features in the subsequent claim(s) taken together with the invention as set out in the preceding claim meet the requirements of novelty."

Justice Wei's approach is consistent with that taken by the English courts, which will only assume that dependent claims stand and fall together with the independent claim if the patentee concedes that this has to be the case. Otherwise, evidence will be heard on the issue of the validity of the dependent claims and this issue will be considered separately notwithstanding that the independent claim may be found to be invalid for lack of novelty or obviousness. (See, e.g., *Unilever PLC v. Chefaro Proprietaries Ltd* [1994] RPC 567; *Cairnstores v. Atkiebolaget Hassle* [2002] EWHC 309 (Ch).)

It will be interesting to see what happens next in this case. Watch this space for updates!

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