

# Patent litigation in Singapore: overview

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A Q&A guide to patent litigation in Singapore

The Q&A gives a high-level overview of patent disputes, including sources of law; court systems; substantive law; parties to litigation; enforcement options; competition and anti-trust issues; procedure in civil courts; preliminary relief; final remedies; appeal procedure; litigation costs; and reform.

To compare answers across multiple jurisdictions, visit the patent litigation [Country Q&A tool](#).

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## Sources of law

1. What are the principal sources of law and regulation relating to patents and patent litigation?

The principal sources of law and regulation relating to patents and patent litigation are legislation, international treaties (to the extent they are incorporated into domestic law), and decisions of the courts interpreting the legislation.

The principle sources of national legislation in Singapore are the:

- Patents Act (Chapter 221) Revised Edition 2005 (as amended by the Patents (amendment) Act 2017 (No. 18 of 2017)).
- Patents Rules Revised Edition 2007 (as amended by No. S 573, Amendment No. 2).

The Examination Guidelines for Patent Applications at the Intellectual Property Office of Singapore provide guidance on the procedures relating to search and examination of patent applications, as set out in the Patents Rules and associated provisions of the Patents Act.

IP-related laws in Singapore include the:

- Medicines Act (Chapter 176) Revised Edition 1985 (as amended).

- Competition Act (Chapter 50B) Revised Edition 2006 (as amended).
- Civil Law Act (Chapter 43) Revised Edition 1999 (as amended).
- Evidence Act (Chapter 97) Revised Edition 1997 (as amended).

Singapore is a party to major international IP treaties, including the:

- WIPO Paris Convention for the Protection of Industrial Property 1883.
- Patent Cooperation Treaty 1970 (PCT).
- WTO Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 (TRIPS).

The Singapore legal system is based on the English common law system. The common law courts in Singapore generally adopt an adversarial approach to litigation.

Apart from referring to relevant Singapore case law, judges may refer to English case law where the issues involve the interpretation of Singaporean statutes based on English enactments or English statutes applicable in Singapore (which includes patent law issues).

However, the Singapore courts have made significant departures from the decisions of the English courts, as the common law in Singapore develops with a greater recognition of local jurisprudence. Further, there is a greater tendency to consider decisions of important Commonwealth jurisdictions (such as Australia, particularly if they adopt a different approach from that of the English courts).

## Court system

2. In which courts/government bodies are patents enforced?

Patents are enforced primarily in the Singapore High Court and the Intellectual Property Office of Singapore (IPOS).

The following can only be brought before the Singapore High Court:

- Patent infringement proceedings.
- Application for compulsory licences.

Patent revocation proceedings can be brought before the IPOS. The IPOS can resolve disputes between different parties on most issues relating to patents, including:

- Validity.
- Opposition.

- Entitlement.
- Inventorship.

3. Do the courts/government bodies deal with infringement and invalidity simultaneously or must invalidity actions be brought in separate proceedings?

The Singapore courts deal with both infringement and validity together. The validity of a patent is typically raised either as a counterclaim in infringement proceedings or in an action for a declaration of non-infringement.

Although invalidity proceedings can be brought before the Intellectual Property Office of Singapore (IPOS) to revoke a patent, if proceedings are pending in the Singapore court, no proceedings can be instituted before the Registrar at the IPOS without the leave of the court. Further, the IPOS has discretion to refer cases to the court if the issues can be dealt with better by the courts.

4. Who can represent parties before the court and/or government body?

In proceedings before the Singapore High Court, parties must be represented by a qualified advocate and solicitor admitted to the Singapore Bar. Unlike in the UK or some Commonwealth jurisdictions, there is no distinction between solicitors and barristers in Singapore.

In proceedings before the Intellectual Property Office of Singapore, parties can be litigants in person or represented by lawyers or patent agents/attorneys.

5. What is the language of the proceedings? Is there a choice of language?

The language of the proceedings in the Singapore courts and the Intellectual Property Office of Singapore is English. There is no other choice of language available. Evidence can be taken in other languages if translated.

6. To what extent are courts willing to consider, or are bound by, the opinions of other national or foreign courts, or other national or international bodies, that have handed down decisions in similar cases?

The common law system of Singapore is characterised by the doctrine of judicial precedent (or *stare decisis*). Therefore, the decisions of the Singapore Court of Appeal are strictly binding on the High Court, the District Court and the Magistrate's Court.

However, other judicial statements (*obiter dicta*) made by the higher court in the judgment which do not directly affect the outcome of the case can be disregarded by the lower court.

Court decisions from England and other Commonwealth jurisdictions are not legally binding on the Singapore courts. However, because of the commonality of legal traditions and jurisprudence, English and other Commonwealth decisions are often considered and sometimes adopted.

## Substantive law

7. How is patent infringement assessed?

A patent is infringed if a person does any of the following in Singapore in relation to a patented invention that is in force, without the consent of the patent owner:

- If the invention is a product, making, disposing, offering to dispose, using or importing the product, or keeping the product for disposal or otherwise.
- If the invention is a process, using the process or offering the process for use, or disposing, offering to dispose, using or importing any product obtained directly by means of that process or keeping any such product whether for disposal or otherwise.

For there to be infringement, the defendant's product or process must contain all the essential features of a patent claim. Singapore does not have a doctrine of equivalents. Instead, the Singapore courts adopt a purposive approach to the construction of claims. In other words, the courts consider what a skilled person would have understood the claim to mean in light of the common general knowledge and the specification as a whole at the date of filing of the patent. Therefore, the defendant's product or process may fall within the claim as construed despite any differences or variations.

The Patents Act does not contain provisions on contributory infringement. Contributory infringement and liability for authorising infringement are governed by the common law rules on joint tortfeasorship.

A person cannot use or offer a process for use in Singapore when they know, 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 (*section 66(1)(b), Patents Act*). Under territoriality principles, both the offer and use must be made in Singapore. The offeror's knowledge is judged objectively, taking into account what is obvious to a reasonable person in the circumstances.

8. What defences are available to an alleged infringer?

The key defences are that the allegedly infringing act does not fall within the claims and/or that the relevant patent claims are invalid.

The alleged infringer can also rely on statutory exceptions to infringement, which include:

- Acts done privately and for non-commercial purposes.
- Acts done for experimental purposes relating to the subject matter of the invention.
- Acts consisting of the extemporaneous preparation of a medicine for an individual in accordance with a prescription given by a registered medical or dental practitioner, or consisting of dealing with a medicine so prepared.
- Acts consisting of the use of a product or process in the body or operation of an aircraft, hovercraft or vehicle that has temporarily or accidentally entered or is crossing Singapore (including the air space above it and its territorial waters), or the use of accessories for that aircraft, hovercraft or vehicle.
- Acts consisting of the use, exclusively for the needs of a ship, of a product or process in the body of the ship or in its machinery, tackle, apparatus or other accessories, where the ship has temporarily or accidentally entered the territorial waters of Singapore.
- Acts consisting of the use of an exempted aircraft that has lawfully entered or is lawfully crossing Singapore, or of the importation into Singapore, or the use or storage, of any part or accessory for that aircraft.
- Acts consisting of the importation, use or disposal of a patented product or a product obtained by means of a patented process, which is produced by or with the consent (conditional or otherwise) of the proprietor of the patent or its licensee, including a patent granted outside Singapore in respect of the same or substantially the same invention.
- Acts carried out for the sole purpose of meeting the requirements for marketing approval of a pharmaceutical product.
- Acts carried out under a compulsory licence granted by the Singapore High Court to remedy an anti-competitive practice.
- Acts consisting of the use of a patented product or process by the Singapore Government for public non-commercial purposes, or for or during a national emergency or other circumstances of extreme urgency.

The defence of innocent infringement has consequences on the quantum of damages and account of profits, but not on liability for infringement.

9. On what grounds can a patent be invalidated?

A patent can be invalidated on the following grounds:

- Lack of novelty (anticipation).
- Lack of inventive step (obviousness).
- Lack of industrial applicability.
- Ineligible patent subject matter.
- Absence of or defective title (entitlement issues).
- Insufficiency (that is, the specification of the patent does not disclose the invention clearly and completely for it to be performed by a person skilled in the art).
- Added matter extending beyond the application as originally filed.
- Unallowable amendment or correction made to the patent specification.
- The patent was obtained fraudulently, on any misrepresentation.
- Double patenting.

10. Can a court only partially invalidate a patent or transform it into a utility model?

If the validity of a patent is challenged in infringement proceedings and it is found that the patent is only partially valid, the court or the Registrar at the Intellectual Property Office of Singapore can grant relief in respect of the part of the patent that is found to be valid and infringed. However, the claimant must prove that the patent specification was framed in good faith and with reasonable skill and knowledge.

Singapore does not recognise protection through utility models, petty patents, or equivalent rights. Therefore, a patent cannot be transformed into a utility model.

11. Is it possible to amend patent claims during proceedings?

It is possible to amend patent claims during revocation or infringement proceedings.

In proceedings before a Singapore court or the Intellectual Property Office of Singapore (IPOS) in which the validity of a patent is challenged, the court or the Registrar can allow the patent proprietor to amend the patent specification as the court or Registrar thinks fit. Generally, the amendments cannot broaden or extend the protection conferred by the patent, and cannot add new matter.

The proposed amendments will be published and advertised for opposition by third parties. If a third party files an opposition, the court or Registrar will notify the patent proprietor and consider the opposition in deciding whether the amendment should be allowed.

The allowability of amendments is subject to the court's discretion, which can take into account factors such as the conduct of the patentee (for example, undue advantage sought previously using the unamended patent) and undue delay.

12. Are there any grounds on which an otherwise valid patent can be deemed unenforceable?

An otherwise valid patent may be unenforceable if:

- The alleged infringing acts fall under the statutory exceptions to infringement (*see Question 8*).
- The patent was not in force when the alleged infringing acts occurred.
- Proceedings have been previously brought before a Singapore court or the Intellectual Property Office of Singapore, where the same issue could and should have been raised.
- Proceedings for infringement have not been brought within six years of the date on which the infringing acts occurred (as for most other torts).
- Enforcement of the patent constitutes a breach of competition rules.
- The alleged infringing act constitutes prior use in good faith by a third party before the priority date of the patent.

## Parties to litigation

13. Who can sue for patent infringement?

### **Patent holder**

A patent proprietor can sue for patent infringement.

If a patent is owned by more than one person, each of the co-owners can bring infringement proceedings without the consent of the other co-owner(s).

Any co-owner who is not a claimant must be joined as a party, but will not be liable for costs.

### **Exclusive licensee**

An exclusive licensee has the same rights as the patent proprietor to bring proceedings in respect of any infringement committed after the grant of the exclusive licence. The patent proprietor need not be made a party to the proceedings.

### **Non-exclusive licensee**

A non-exclusive licensee cannot sue for patent infringement in its own capacity.

### **Distributor**

A distributor cannot sue for patent infringement in its own capacity.

### **Other**

In Singapore, the patent proprietor and another party can agree to refer to the Registrar at the Intellectual Property Office of Singapore the question of whether the party has infringed the patent. On this reference, the patent proprietor can make claims for damages and an account of profits.

14. Under what conditions, if any, can an alleged infringer bring proceedings to obtain a declaratory judgment on non-infringement?

A declaration of non-infringement can be sought before the Singapore High Court or the Intellectual Property Office of Singapore, provided that both:

- The potential infringer first sought written confirmation from the patent proprietor that the potential infringer's activities do not infringe the patent (including sufficient detail of the activities for assessment by the patent proprietor).
- The patent proprietor has failed to give such confirmation.

An application for a non-infringement declaration can bring certainty and/or choice of forum. However, such application also puts the burden of proof (at least initially) on the potential infringer.

15. Who can be sued for patent infringement?

Any person who has committed an infringing act (whether themselves or through an agent) can be sued for patent infringement.

Where an infringing act is committed by a body corporate, a director can be sued personally if either:

- It can be shown that he/she is the alter ego or directing mind of the company and the company is a sham.
- He/she authorised the performance of a potentially infringing act knowing that it was potentially infringing, and acted in concert with the company.

Two or more parties who combine to infringe can be sued as joint tortfeasors.

16. Is it possible to add or remove parties during litigation?

It is possible to add or remove parties during litigation under the Rules of Court.

The court can, at any stage in any matter, on terms as it thinks fit and either of its own motion or on application:

- Order any person who has been improperly or unnecessarily made a party, or for any reason ceased to be a proper or necessary party, to cease to be a party.
- Order any of the following persons to be added as a party:
  - any person who should have been joined as a party or whose presence before the court is necessary to ensure that all matters in the cause or matter may be effectually and completely determined and adjudicated upon; and

- any person between whom and any party to the cause or matter there may exist a question or issue arising out of, relating to, or connected with any relief or remedy claimed in the cause or matter that in the opinion of the court it would be just and convenient to determine as between them and that party as well as between the parties to the cause or matter.

No person can be added as a claimant without their consent signified in writing or in any other manner as may be authorised.

Any application by a person to add parties must (except with leave of the court) be supported by an affidavit showing their interest in the matters in dispute, or in the question or issues to be determined between them and any party to the cause or matter.

Change of parties can also be allowed following the death or bankruptcy of an existing party.

## Enforcement options

17. What options are open to a patent holder when seeking to enforce its rights in your jurisdiction?

### Civil proceedings

Patents are enforced in civil proceedings brought by the patent proprietor or, in some cases, the exclusive licensee (see [Question 13](#)).

Civil actions are typically brought in the Singapore High Court or the Intellectual Property Office of Singapore (IPOS). The Registrar at IPOS can decide on infringement disputes, but its powers in infringement proceedings are limited (see [Question 13](#), [Other](#)).

### Criminal proceedings

The Patents Act does not provide for criminal proceedings for patent infringement.

### Border measures

The Patents Act does not provide for the seizure of imported goods by Singapore Customs or any other border measures.

18. Is it compulsory to send a cease and desist letter to an alleged infringer before commencing patent proceedings?

It is not compulsory to send a cease and desist letter before commencing proceedings. The patent proprietor must consider whether to do so given the specific circumstances, the objective(s) it wishes to secure, and take advice on the consequences. Caution should be exercised, as a cease and desist letter can amount to a groundless threat of infringement proceedings.

Mere notification of the existence of a patent, which does not constitute a threat of proceedings, can be sent to minimise the risk of the alleged infringer claiming innocent infringement (through having no prior knowledge of the existence of the patent).

An aggrieved party can bring an action for groundless threats and claim:

- A declaration to the effect that the threats are unjustified.
- An injunction against the continuance of the threats.
- Damages for any loss sustained as a result of the threats.

19. To what extent are courts willing to grant cross-border or extra-territorial injunctions (preliminary or permanent)?

The Singapore courts do not generally grant cross-border or extra-territorial injunctions. For example, it has been held that a worldwide Mareva injunction (that is, a freezing order) will only be granted in very exceptional circumstances.

20. To what extent do courts recognise the blocking effect of "torpedo" actions abroad?

The use of a torpedo action in a foreign court to impose an obligation on another court (in which a mirroring infringement action is or may be commenced) to stay its proceedings has not been reported in Singapore.

The Singapore courts are unlikely to recognise the blocking effect of torpedo actions in Singapore, due to the principle of territoriality.

21. To what extent are arbitration, and alternative dispute resolution (ADR) methods (such as mediation), available to resolve patent disputes?

Intellectual property disputes can be resolved through ADR, including:

- Party-driven negotiation.
- Mediation and neutral evaluation provided by the:
  - World Intellectual Property Organization Arbitration and Mediation Center (WIPO AMC);
  - Singapore Mediation Centre; and
  - Singapore International Mediation Centre.
- Arbitration provided by the:
  - WIPO AMC; and
  - Singapore International Arbitration Centre.
- Expert determination provided by the WIPO AMC.

The main forms of ADR in Singapore are arbitration, mediation and neutral evaluation. ADR methods are generally voluntary or agreed under a contract.

The courts cannot force parties to use ADR, but encourage such use. The use of ADR methods is also strongly promoted and encouraged by the Singapore Government and the Intellectual Property Office of Singapore (IPOS).

In recent years, ADR methods have significantly increased in importance as a means of dispute resolution in a wide range of disputes. ADR can be considered at various stages of litigation, and failure to engage in ADR can have an adverse impact on costs recovery.

### **Arbitration**

Any dispute that the parties agree to submit to arbitration under an arbitration agreement can be determined by arbitration, unless this is contrary to public policy.

While Singapore statutes do not expressly define matters that are non-arbitrable, the Court of Appeal has held that certain matters may not be arbitrable for reasons of public interest (*Larsen Oil and Gas Pte Ltd v Petropord Ltd (2011) SGCA 21*). One example is patent validity, which has a wide public impact.

### **ADR**

There are currently no statistics available on the number of patent disputes resolved through ADR methods in Singapore. ADR methods are currently not commonly used in patent-related matters. One reason may be that

injunctive relief, which can be crucial in patent-related matters, is more appropriately ordered by the courts than an arbitrator.

The IPOS is looking to set up a team of IP expert adjudicators to resolve IP disputes filed with the IPOS.

## Competition and anti-trust

22. Can a patent holder bring proceedings claiming both patent infringement and unfair competition for the same set of facts?

A patent infringement action can be combined with a number of other claims, including copyright infringement, passing off, trade mark infringement, and breach of contract, provided they can be heard by the same forum (generally, the Singapore High Court).

There is no action for unfair competition available in Singapore.

23. To what extent can enforcement of a patent expose the patent holder to liability for an anti-trust violation?

The Singapore Competition Act penalises certain types of agreements or conduct relating to intellectual property (including patents) that may have appreciable anti-competitive effects. This includes agreements (such as licensing agreements) that:

- Have as their object or effect the prevention, restriction or distortion of competition in Singapore.
- May facilitate or amount to price-fixing, market-sharing or output limitation.
- May amount to abuse of a dominant position (for example, through extending the patent holder's market power beyond the scope granted by its patent rights, or protecting, enhancing or maintaining a dominant position other than through merit).

To date, enforcement under these provisions has not been brought up in Singapore patent cases. For example, no public case involving payment for delay (PFD) agreements has come before the Competition Commission of Singapore (CCS). However, this does not mean that PFD agreements would be accepted under Singapore competition law. Instead, any agreement shown to be anti-competitive by object or effect will attract scrutiny and sanctions of the CCS, including PFD agreements (such as the agreement between Johnson & Johnson and Novartis

AG to delay market entry of a generic version of the painkiller Fentanyl, which was found to be anti-competitive by the European Commission).

## Procedure in civil courts

24. What is the format of patent infringement proceedings?

Patent infringement proceedings are initiated by filing a writ of summons. The endorsed writ must be served on the named defendant in accordance with prescribed rules within its validity period. The claimant must file a statement of claim, setting out its claims against the defendant. The defendant must then file its defence and any counterclaim against the claimant (for example, revocation of the patent).

The process for discovery and exchange of affidavit evidence then takes place. Once completed, parties and the court can set a trial date, where the matter will be substantively presented by the parties and examined in court. Disputed issues are decided by a judge.

A patent infringement trial typically lasts between 18 to 24 months, depending on the complexity of the claim.

The usual order of matters is as follows:

- Filing of parties' pleadings.
- Case management conferences.
- Discovery process.
- Conduct of experiments.
- Exchange of evidence (witness statements and expert reports).
- Pre-trial directions by the judge.
- Submission of opening statements.
- Open court trial.
- Closing submissions.

25. What are the rules and practice concerning evidence in patent infringement proceedings in your jurisdiction?

## **Documents**

In principle, all evidence (including documentary evidence) must be adduced by way of affidavit.

## **Witness evidence**

Witness evidence in patent cases is usually confined to confirming the contents of the witness affidavit. However, any fact required to be proven at trial by witness evidence must be proved by the examination of witnesses in open court, unless the court orders or the parties agree otherwise.

## **Expert evidence**

The use of expert evidence in patent cases is common due to the technical nature of patent matters. Neutral assessors are usually appointed by the court and experts engaged by the parties to comment on questions of fact or opinion where specialised skill and/or knowledge is required. All experts owe a duty to court to be independent and honest.

Expert evidence is particularly relevant in assessing issues that must be read through the eyes of a "person skilled in the art", such as disputes over novelty, inventive step and enabling disclosure. The role of an expert witness is to:

- Explain words or terms of science or art appearing in the documents that must be construed by the court.
- Give expert assistance to the court (for example, on the laws of science or the principles behind a technical process or system).
- Inform the court on the state of public knowledge with regard to the matters before it.

However, an expert witness cannot assist the court in its interpretation of a document, as the court is responsible for analysing the facts and applying the law to the facts.

It is desirable that expert witnesses have no actual or apparent interest in the outcome of the proceedings. However, it is also recognised that there are fields in which only a limited number of experts are available and that those who are pre-eminent may have direct work experience in the field or with competitors who may be thought to threaten their independence. Such cases should be dealt with care.

The mere fact that expert witnesses are not independent because they may be related in any way with the patentee does not disqualify them as witnesses. However, this means that their evidence must be scrutinised with greater care because of the increased likelihood of bias. The test for determining whether expert evidence should be discounted is one of actual partiality rather than apparent partiality.

26. Is evidence obtained in criminal proceedings admissible in civil proceedings and vice versa?

The Patents Act does not provide for criminal proceedings for patent infringement, unlike for trade mark, copyright and registered design offences.

Generally, evidence that is given in open court in civil or criminal proceedings or recorded in a judgment (and is therefore not confidential) can be referred to in other proceedings. Alternatively, permission can be sought from the court to use the material.

Under the Riddick principle, documents obtained through discovery can only be used for the purposes of the specific proceedings (whether criminal or civil), unless either:

- They are read to the court or by the court in a public hearing.
- The court or disclosing party gives permission.

Criminal convictions can be relied on in a civil action to prove that certain conduct took place.

27. Is evidence obtained in civil proceedings admissible in other civil proceedings?

Evidence obtained in civil proceedings can be used in other civil proceedings. However, where documents or information were obtained by compulsion (that is, through a court process or by court order), the party that received the documents or information cannot use them in other proceedings without leave of the court.

28. To what extent is pre-trial disclosure permitted and what other mechanisms are available for obtaining evidence from an adverse party or third parties?

### **Pre-trial discovery**

Pre-trial discovery is permitted on application to court, if the applicant can demonstrate the following:

- A reasonable prima facie case of wrongdoing against the person(s) whom information/identity is sought of.
- The documents or information are relevant to the contemplated proceedings against these persons.
- Discovery is necessary for disposing fairly of the matter or saving costs.

### **Other mechanisms**

Other methods of obtaining evidence from an adverse party or third parties include pre-action interrogatories and search orders.

29. What level of proof is required for establishing infringement or invalidity?

The standard of proof in civil proceedings is on the balance of probabilities (that is, an allegation is more likely to be true than not). This burden initially lies on the claimant. However, in some circumstances the burden may shift to the defendant if the claimant has made out a prima facie case of infringement. In all cases, the defendant must prove invalidity on the balance of probabilities.

For example, in infringement proceedings, the initial burden of proof is on the patent proprietor to prove that its patent has been infringed to the required standard of proof. However, the burden is reversed if the patent is a process for obtaining a product. The burden of proving that a product is not made by the process lies with the alleged infringer if either:

- The product is new.
- There is substantial likelihood that the product was made by the process and the patent proprietor has been unable, through reasonable efforts, to determine the process actually used.

In considering whether a party has discharged its burden, the court must not require them to disclose any manufacturing or commercial secret if it appears to the court that it would be unreasonable to do so.

If a declaration of non-infringement is sought, the burden of proof lies on the person seeking that declaration.

In invalidity proceedings, the initial burden is on the party seeking invalidation to prove that the patent is invalid to the required standard of proof. For example, bare assertions made by an expert witness that the patent in suit is obvious in light of the prior art are insufficient to discharge the burden of proof to establish obviousness. The expert must provide reasons and explanation on why and how the prior art would obviously have led a skilled person in the art to the patented invention. To establish invalidity of a patent on the grounds of insufficiency, the burden of proof is not discharged if the expert only highlights ambiguities in the text of the patent specification. The expert must provide solid evidence to prove that those ambiguities will render the patented invention unworkable from the point of view of a person skilled in the art.

The claimant must also prove damages (usually after the trial on liability). However, the courts are often willing to infer that damage has been caused by the wrongful invasion of a patentee's monopoly, and will not be deterred from awarding substantial damages simply because of the difficulty or impossibility of proving precise figures for calculating such damages.

30. How long do patent infringement proceedings typically last?

Patent infringement proceedings typically last between 18 months and three years. Matters such as the complexity of the case, extent of interlocutory applications and availability of court time, will have an impact on the timeline.

### **Fast-track procedures**

Fast-track procedures are not available for patent proceedings in Singapore. However, a party can apply for the proceedings to be heard on an expedited basis.

### **Timetable**

An initial timetable for proceedings is ordered at the first case management conference. Subsequent and regular conferences are conducted by the court to issue deadlines and manage the flow of the proceedings.

### **Delay**

A defendant can seek to delay the proceedings by:

- Avoiding service of process.
- Challenging jurisdiction of the court if either party is not in Singapore.
- Applying for a stay of action based on *forum non conveniens*.
- Applying for a stay of action based on concurrent proceedings in another jurisdiction.
- Filing interlocutory applications, whenever possible.
- Delaying discovery obligations.
- Filing appeals against decisions, whenever possible.
- Seeking extensions of time.
- Seeking to apply for determination of preliminary issues, or to bifurcate the proceedings between validity and infringement.

## **Preliminary relief**

31. Is preliminary relief available, and if so what measures are available and under what conditions?

Preliminary measures are available in the form of interim injunctions, interim detention or preservation of property, interim payments and search orders.

### **Search and preservation orders**

To obtain a search order (formerly known as an Anton Piller order), the following conditions must be satisfied:

- The claimant has an extremely strong prima facie case.
- Very serious damage would be caused to the claimant if the search order is not granted.
- There is clear evidence that the defendant has in its possession incriminating materials, and there is a real possibility that it may conceal or destroy such materials.

### **Injunctions**

Generally, a preliminary injunction will be granted if the following conditions are met:

- Existence of a serious question to be tried (that is, the claimant's claim is not frivolous or vexatious).
- If the claimant subsequently succeeds in establishing a right to a permanent injunction, it would not be adequately compensated by an award of damages for the loss sustained in the meantime if a preliminary injunction is not awarded.
- The balance of convenience lies in favour of granting the injunction (that is, if the defendant subsequently succeeds in establishing that the injunction was not justified, they would be adequately compensated by damages for the loss arising from the preliminary injunction).

To obtain a Mareva injunction, the following conditions must be met:

- The claimant must:
  - have a valid interest/cause of action over which the court has jurisdiction;
  - have a good arguable case;
  - have made full and frank disclosure to the court; and
  - provide an undertaking to abide by an order to pay damages.
- The defendant must have assets in the jurisdiction (or outside the jurisdiction, for worldwide Mareva injunctions).
- There is a real risk that the assets will be dissipated, so as to render the judgment nugatory.

### **Other**

An interim payment can be ordered if the court is satisfied that:

- The defendant has admitted liability for the claimant's damages, or the claimant has obtained judgment or an order regarding a sum (yet to be assessed) due from the defendant to the claimant.
- If the action proceeded to trial, the claimant would obtain judgment against the defendant for a substantial sum of damages, or other sum of money apart from damages or costs.



32. Can a protective writ be filed at the court at which an ex parte application may be filed against that defendant?

Protective writs are not available in Singapore.

33. What is the format/procedure of preliminary injunction proceedings?

### **General**

An application for a preliminary injunction is filed by way of summons supported by evidence set out in an affidavit.

An application cannot be made before the issue of the originating process unless the case is urgent and if so, the originating process must be issued by a certain time after the grant of the injunction. The defendant will have an opportunity to respond by filing a responsive affidavit. The matter will then be heard in chambers.

### **Level of proof**

To obtain a preliminary injunction, the claimant must satisfy the court that it has a serious issue to be tried, and that the balance of convenience favours the granting of an injunction.

To establish that there is a serious issue to be tried, the claimant must show that it has a real, credible case of patent infringement, but this requirement is not as high as establishing infringement at the final hearing. If the defendant alleges invalidity, the claimant must also address the defendant's invalidity arguments.

In considering the balance of convenience, the court considers the harm suffered by the claimant if the preliminary injunction is not granted against the harm suffered by the defendant if the preliminary injunction is granted. An important factor is whether financial compensation will be an adequate remedy to the claimant if infringement is established.

### **Evidence**

Generally, evidence is given through written witness statements in all preliminary applications.

### **Patent validity**

A defendant can raise the issue of validity, but the issue will not be determined at that stage. However, clear evidence may be taken into account.

### **Length of proceedings**

Preliminary injunction proceedings usually last between one and two months. A preliminary injunction, if granted, will continue until discharged at trial or earlier.

34. If a preliminary injunction is granted and the main infringement action is finally lost, can the defendant claim damages for the unjustified preliminary injunction?

The defendant can claim damages if it can prove that it has suffered damage as a result of the unjustified preliminary injunction.

The claimant is usually not required to provide any bond or guarantee, but must provide an undertaking to abide by any possible order for damages if the defendant sustains any damage due to the injunction.

## Final remedies

35. What remedies are available against a patent infringer?

### **Permanent injunction**

Usually, the grant of a permanent injunction relates to the products or processes alleged to infringe the patent. However, the courts have discretion to determine the extent of the relief granted.

The court may grant an injunction that is broader in scope where the exclusion of certain items not specifically covered in the injunction requested by the patent owner would render the injunction ineffective against future infringement by the infringer.

Any third party (including the infringer's suppliers or customers) who has been notified of an injunction and knowingly aids, abets, assists in or permits a breach of an injunction order will be in contempt of court. Acting in contempt of court can lead to a fine or imprisonment, at the discretion of the court.

### **Monetary remedies**

The monetary remedies available against a patent infringer are damages and an account of profits. Only one type of monetary remedy can be awarded in respect of the same infringement, which means that either damages or an account of profits can be awarded to the patent owner.

Punitive damages are not available in patent infringement disputes.

The quantum of monetary remedies is generally assessed by the Singapore courts at a separate, later stage after the liability assessment.

### **Delivery up or destruction of infringing goods**

The court can order the delivery up or destruction of any infringing product or any article in which the patented product is inextricably comprised or which can only be used in an infringing manner.

### **Declaration of infringement and validity**

The Singapore court can make a declaration that the patent is valid and has been infringed. A certificate of contested validity can be issued to deter subsequent infringers from challenging the patent validity under threat of additional costs consequences if validity is upheld.

## **Appeal procedure**

36. What avenues of appeal are available for a defeated party and under what conditions?

If the proceedings are brought before a registrar of the High Court, an appeal can be brought before a judge or judicial commissioner of the High Court and then to the Court of Appeal.

An appeal must be made by filing a notice of appeal in the prescribed form within 14 days after the judgment, order or decision appealed against was given or made in the case of an appeal to a judge or judicial commissioner, and within 30 days in the case of appeals to the Court of Appeal. In certain cases, the notice of appeal must be accompanied by the provision of security for the respondent's appeal costs.

In certain matters, appeals can only be brought to the Court of Appeal with leave. Any judgment or order of a district court exercising civil jurisdiction to which the parties have already consented in writing cannot be appealed against.

## **Litigation costs**

37. What level of cost should a party expect to incur to take a case through to a first instance decision, preliminary injunction proceedings and appeal proceedings?

The level of cost that will be incurred depends on a variety of factors, including the value of the claim and the complexity of the case.

Rough estimates are as follows:

- First instance decision in the High Court: US\$250,000 to US\$350,000.
- Preliminary injunction proceedings in the High Court: US\$20,000 to US\$50,000.
- Appeal proceedings:
  - appeal to the High Court: US\$8,000 to US\$30,000;
  - appeal to the Court of Appeal: US\$30,000 to US\$60,000.

## Reform

38. What are the important developing and emerging trends in your country's patent law?

The following key changes to the Singapore patents regime took effect on 30 October 2017.

### **Broadening of grace period**

The broadened grace period allows inventors greater leeway in disregarding their prior public disclosures of the invention. Under the new rules, public disclosure must not be made more than 12 months before the filing date of the Singapore patent application. The public disclosure must be made by the inventor or a person who obtained the subject matter of the invention directly or indirectly from the inventor. The provision does not exclude the inventor's earlier validly filed and pending patent (or utility model or other IP rights) applications that have been published.

### **Patentability of natural products and processes**

Under the amended Intellectual Property Office of Singapore (IPOS) Examination Guidelines, an isolated or purified material or micro-organism is considered a discovery and not an invention (that is, non-patentable subject matter). Only a new use of the isolated or purified material or micro-organism is patentable.

Isolated material or micro-organisms that have been modified, and are clearly distinguished from the naturally occurring material or micro-organism, are patentable. However, the extent of modification that is required is not immediately apparent.

A claim directed at a naturally occurring process is not patentable subject matter, but a new application of such a naturally occurring process is patentable.

### **Stricter patent examination procedure**

The following summarises the upcoming main changes to the patent examination system from 2020, which aim to promote innovation and Singapore's economic growth:

- All patent applications filed on or after 1 January 2020 will go through a full substantive examination by the IPOS. Patent applications filed on or after 1 January 2020 include:
  - national patent applications with a filing date on or after 1 January 2020;
  - international patent applications entering the national phase having a filing date on or after 1 January 2020; and
  - divisional patent applications having an initiation date on or after 1 January 2020.
- The supplementary examination that relies on a foreign grant or final examination results from approved corresponding applications (foreign route) will be abolished for patent applications filed on or after 1 January 2020. Under the current foreign route where a supplementary examination is carried out, the examiner examines whether the foreign grant or final results of a foreign examination meet Singapore requirements, and does not consider substantive issues of novelty and inventive step. While the foreign route is discontinued, the search process can still be conducted by either the IPOS or a foreign patent office.

## Online resources

### Singapore Statutes

W <https://sso.agc.gov.sg>

**Description.** This is an official website managed and maintained by the Legislation Division of the Attorney-General's Chambers providing free online access to national legislation, including the Patents Act and Patent Regulations, as well as IP-related laws.

### Intellectual Property Office of Singapore (IPOS)

W [www.ipos.gov.sg](http://www.ipos.gov.sg)

**Description.** This is the official website of the IPOS.

### Singapore Academy of Law

W [www.singaporelaw.sg/sglaw](http://www.singaporelaw.sg/sglaw)

**Description.** This is the official website managed and maintained by Singapore Academy of Law, providing information on the Singapore legal system and Singapore case law, among others.

## Contributor profiles

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**Areas of practice.** Intellectual property disputes; telecommunications.

### Recent litigation and transactions

- Patent infringement action involving synthetic diamond manufacture.
- Copyright proceedings involving pirated movie site blocking orders.
- Patent revocation cases in the field of petrochemicals.
- Patent infringement action involving oil drilling platforms and exhaust systems.
- Patent infringement and invalidity actions concerning a patent for portable USB flash devices.
- IT contract claims involving design, delivery and installation of IT systems for a pension statutory body.
- Patent infringement action concerning the HIV-2 virus.
- Advised local telecommunications providers on auction rules for spectrum licences, network infrastructural roll-outs, licensing regimes, interconnection and interoperability, pricing, anti-competition rules and data protection.

**Languages.** English, Chinese, Chinese dialects

**Professional associations/memberships**

- Co-Chairperson, Anti-Counterfeiting Committee (2015-2018) and Copyright Committee (2008-2014) of the Asian Patent Attorneys Association of Asian Patent Attorneys Association.
- Adjunct tutor for Practice Law Course conducted by the Singapore Institute of Legal Education.
- Adjunct tutor for the Graduate Certificate in IP Law of the National University of Singapore.
- Member of the Law Ministry's Committee for Review of Singapore's IP Dispute Resolution Framework.
- Law Society's Inquiry Panel 2015-2017.
- INTA Parallel Imports Committee, Asia-Pacific Subcommittee

**Publications.** Contributing Author to *"Law and Practice of Commercial Litigation in Singapore"* (Sweet & Maxwell 2015).

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