

## PATENTS CASELAW UPDATE

### Lee Tat Cheng v Maka GPS Technologies Pte Ltd [2018] SGCA 18

The Court of Appeal recently clarified the approach towards claim construction in Singapore and the grant of relief for groundless threats of infringement.

The appellant, Lee Tat Cheng (“Appellant”) is the proprietor of a patent covering an in-vehicle camera (“Patent”). He alleged that Maka GPS (“Respondent”) infringed the Patent by offering for sale three models of in-vehicle cameras. In response, the Respondent counterclaimed that the Patent was invalid, or that there was no infringement and for a consequential declaration of groundless threats of infringement.

In the ensuing trial, the High Court found that the Patent was valid, but that there was no infringement. The court further found that upon establishment of groundless threats of infringement, the Patents Act mandated the grant of relief in the form of injunction. The Appellant appealed to the Court of Appeal against the finding of noninfringement and the grant of injunctive relief for groundless threats.

#### **Claim Construction**

The Singapore courts had previously adopted UK courts’ approach towards claim construction (*Kirin-Amgen [2005] RPC 9*). However, the recent UK Supreme Court decision in *Actavis UK v Eli Lilly and Company [2017] UKSC 48* (“*Actavis*”) had modified the UK approach to claim construction, and the Appellant argued that the Court of Appeal should follow suit. *Actavis* is now regarded as the leading case in UK on scope of protection of a patent and the following guidelines were as reformulated from the questions first set out in *Improver v Remington [1990] FSR 181*.

- (i) Notwithstanding that a variant is not within the literal meaning of the relevant claim(s) of the patent, does the variant achieve substantially the same result in substantially the same way as the invention, i.e. the inventive concept revealed by the patent?
- (ii) Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, that it does so in substantially the same way as the invention?
- (iii) Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?

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Accordingly, using the *Actavis* approach, in order to establish infringement in a case where there is no literal infringement, a patentee would have to establish that the answers to the first two questions are “yes” and that the answer to the third question is “no”

#### *Singapore position*

After reviewing the *Actavis* decision, the Court of Appeal rejected the *Actavis* approach and instead, endorsed the purposive construction approach of previous cases.

It held that the *Actavis* approach extended the protection of a patent beyond the scope of the claims and is inconsistent with the present statute in Singapore. Section 113 Patents Act provides that the extent of the protection conferred by a patent is to be determined by what is specified in the claims, interpreted in the light of the description and any drawings contained in the patent specification. It was hence impermissible to extend the scope of the protection beyond that as specified in the claims.

While Section 113 is materially similar to Section 125 of the UK Patents Act, the interpretation of the latter is now governed by the European Patent Convention and the Protocol on the Interpretation of Article 69. The Court of Appeal held that the UK Supreme Court was bound to interpret and apply the European Patent Convention and Protocol on the Interpretation of Article 69, both of which are not applicable to Singapore. Lord Neuberger in *Actavis* found that:

*“Such an approach complies with article 2 of the Protocol, as issue (ii) squarely raises the principle of equivalents, but limits its ambit to those variants which contain immaterial variations from the invention. It is also apparent that the two issues comply with article 1 of the Protocol in that they involve balancing the competing interests of the patentee and of clarity, just as much as they seek to balance the encouragement of inventions and their disclosure with the need for a competitive market.”*

Furthermore, the Court of Appeal opined that was not unfair that the patentee is bounded by the terms of his choosing in the claims, and provides certainty to third parties. The *Kirin-Amgen* approach strikes a right balance between affording fair protection to a patentee so that he is not without protection against third parties who make immaterial variants to the patented invention, and need to provide a reasonable degree of certainty to third parties who, in the conduct of their business, rely on patent claims to determine the limit of the patent.



On the other hand, because the *Actavis* approach incorporates the doctrine of equivalents which may introduce *ex post facto* analysis that focuses on how the patented invention works in practice based on the state of developing scientific knowledge at the date of the alleged infringement (rather than date of the patent), it introduces an element of uncertainty.

The Court of Appeal subsequently upheld the High Court's claim construction, finding that the claimed features were absent in the alleged infringing devices and upheld his finding of non-infringement.

### ***Reliefs for Groundless Threats***

The High Court held that once a claim for groundless threats of infringement proceedings was made out, it was mandatory for the court to grant at least one of the three forms of relief provided by the statutory provisions, namely, a declaration that the threats are unjustifiable, an injunction against the continuance of the threats, and damages for any loss suffered. The High Court found that the Respondent failed to prove that it had suffered any loss, and had already obtained a declaration of non-infringement, and thus granted an injunction against continued threats.

On appeal, the Court of Appeal disagreed that the grant of relief is mandatory once a claim for groundless threats of infringement proceedings has been made out. The Court of Appeal found that the statutory provisions must provide very clear words to remove the court's discretion to grant declaratory or injunctive relief. To obtain relief, the claimant needs to show that he has suffered a loss as a result of the threats or that it is appropriate for the court to grant a declaration or injunction. Therefore, the Court of Appeal allowed the Appellant's appeal with respect to the injunction.

### ***Comment***

This decision has crucially clarified the issue of claim construction of a patent under Singapore law and importantly that the application of the doctrine of equivalence in *Actavis* is not applicable. This marks a significant divergence from UK case law on claim construction.

The court's clarification of reliefs for groundless threats of infringement proceedings will also prove useful.

