



PATENT LITIGATION: PRE-TRIAL INSPECTION OF PROCESS IS NOT ALLOWED

In a decision by the Singapore High Court (*Towa Corporation v ASM Technology Singapore Pte Ltd & Anor* [2014] SGHCR 16, an in-depth examination of the rules allowing the court to order a pre-trial inspection has disclosed that the Singapore rules do not allow for such inspection of an allegedly patent infringing process.

Requirements of Pre-Trial Inspection

The legal requirements to be satisfied before the court will exercise its discretion allowing a pre-trial inspection was not in serious contention. The party applying has to show a *prima facie* case, or in an exceptional case, a lower threshold of showing a genuine and substantial issue to be tried. Furthermore, in the exercise of the court's discretion, many factors may be taken into account including safeguards to maintain in confidence the defendant's commercial secrets.

Alleged Infringement of Apparatus and Process Patent Claims

The more interesting aspect of the case concerned the procedural rules in Singapore as contrasted with the rules applicable in England. The patent in question included claims for an apparatus as well as a process and both were alleged to have been infringed. The patentee filed its application pursuant to Order 29 rule 2 of the Singapore Rules of Court (Rules) which empower the court to order an inspection of any "property" in the possession of a party to a cause or matter. The patentee sought to inspect a machine in "operation", that is, a process.

Process Is Not Property

The defendant argued that "property" did not include a "process" and as such, the court had no power to order the sought-after inspection. The court held that it runs counter the ordinary understanding of the term "property" to read the Rules as empowering the court to order an inspection of process.

The defendant had also pointed out that the patent-specific rules of procedure in Order 87A, do not contain an express provision empowering the Singapore court to order an inspection. This is unlike the equivalent English Rules, both in its current form and its predecessor, that expressly empower the court to order an inspection in patent litigation. So, even though the Singapore White Book commentary mentions the power to inspect a process under Order 87A, it is not borne out by the actual provision.

In any case, as the patentee did not attempt to rely on Order 87A, it was not in issue in the case, and the court found that Order 87A was not relevant because the application was made under Order 29.

The end result is that there is that the Singapore Rules currently do not allow for an inspection of an allegedly infringing process. The court did, however, leave it open as to whether some other provision or power may be relied on in a future application.

No Procedural Unfairness

It is submitted that the result does not mean that there is procedural unfairness. The starting principle is that the burden to prove infringement, and to prove a *prima facie* case in an inspection, rests on the patentee. Further section 68 of the Patents Act reverses the burden of proof where the subject-matter of the patent is a process



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for making a new product. The burden of proving that a product is not made by the process shall be on the alleged infringer if the product is new or a substantial likelihood exists that the product is made by the process and the proprietor of the patent has been unable through reasonable efforts to determine the process actually used.

Accordingly, if the patentee has more than a merely speculative allegation of infringement, there is no procedural unfairness. On the other hand, where the patentee has only a speculative action, the defendant is not unfairly prejudiced by the procedural rules to be potentially forced to 'open-the-vault' to aid the patentee.

Joyce A. Tan & Partners acted for the defendants.