

## PATENT AMBIGUITIES

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**TAN** Tee Jim SC  
*Senior Partner, Lee & Lee.*

### **I. Clinical background**

1 The collection and management of specimens (*eg*, blood and urine) for laboratory analysis is an important aspect of clinical care in hospitals. The collection commences from a doctor's request for the specimens to be analysed for purposes of diagnosis. The request is transmitted to a phlebotomist (who may also be a nurse) to collect the specimens from the patient. Typically, the transmission is carried out electronically through the hospital's computer systems. Based on the request, the phlebotomist would collect the specimens in colour-coded test tubes and in accordance with a specific order (to prevent contamination) and, after collection, affix labels containing the patient's information and specimen requirements to the tubes before dispatching them to the laboratory. During this whole process, human errors can occur and they may be due to, for instance, misunderstanding of the doctor's request, wrong choice of colour-coded tubes or wrong order, and mis-labelling. To obviate or reduce such errors, modern technology has been deployed by hospitals and healthcare institutions.

2 In 2004, National University Hospital (Singapore) Pte Ltd ("NUH"), which operated a hospital, was involved in a project to digitise its clinical care processes, including the collection and management of specimens. One of the processes which it needed to digitise and make it work with its existing systems was the printing of test tube labels when specimens were taken from patients and the specimens were registered in its laboratory system. It engaged Cicada Cube Pte Ltd ("Cicada"), a software company, to develop a software for this purpose and both

embarked on a “proof of concept” project to ascertain if the software could indeed be used in the hospital.

3 After the completion of the project, and unbeknown to NUH, Cicada applied for and obtained a patent for “a laboratory specimen collection management system for the clinical laboratory, and especially, a system to identify the type and number of tubes to use to collect patient specimens at the point of care” (the “Patent”). NUH objected to the Patent being granted to Cicada and filed a reference to the Registrar of Patents (the “Registrar”) for a determination as to who was the true proprietor of the Patent. The Registrar declined to deal with the reference as it appeared to him that the question involved in the reference was complex and would more properly be determined by the court. NUH then asked the court to determine. The request eventually went to the Court of Appeal which recently issued its judgment (the “Judgment”) in *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd*<sup>1</sup> (“Cicada Cube”). The Judgment dealt with a number of knotty questions concerning determining the inventive concept of a patent, entitlement proceedings and the time limit for filing the proceedings.

## II. Determining the inventive concept of a patent

4 A patent grants a monopoly in respect of an invention which may be a product or process. Section 66(1) of the Patents Act<sup>2</sup> (the “Act”) states that the patent proprietor has the exclusive right to prevent others from, *inter alia*, making, offering to sell, selling and using the invention in Singapore. Like the other species of intellectual property (such as copyright and registered designs), this is essentially a negative right to exclude others (*eg*, counterfeiters, interlopers and even third parties who have independently reached the same ideas) from exploiting the invention without the licence of the proprietor.

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1 [2018] SGCA 52. The writer appeared for NUH.

2 Cap 221, 2005 Rev Ed.

5 The patent for an invention is to be granted primarily to the inventor or joint inventors.<sup>3</sup> The word “inventor” is defined in s 2(1) of the Act to mean “the actual deviser” of the invention. He is the natural person who “came up with the inventive concept” of the invention.<sup>4</sup> Such a person would be entitled to be registered as the proprietor of the patent, “even though the precise details of how the inventive concept may be realised into a functional product may be worked out by other persons”.<sup>5</sup>

6 It follows that determining the inventive concept of an invention is an essential precursor to identifying the inventor who came up with the concept. The determination of the inventive concept is concerned with ascertaining “the core (or kernel, or essence) of the invention – the idea or principle ... which entitles the inventor’s achievement to be called inventive”.<sup>6</sup> This is a fact-finding exercise based on the specifications of the patent concerned.

7 In *Cicada Cube*, the Court of Appeal was involved in such an exercise. The specifications of the Patent indicate that errors in specimen collection and management could be obviated through a laboratory specimen collection management system. This system has, amongst others, a specimen processing system which determines the specimen requirements for the specimen test orders and a specimen collection station which retrieves from the specimen processing system the specimen requirements that are to be printed onsite on a label to be affixed to the specimen tube. The processing system is controlled by a proprietary processing logic which is referred to as the “heart” of the specimen processing system.

8 The court held that both the specifications and the claims of a patent could be considered in determining the inventive concept as they are useful and relevant in explaining and

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3 Section 19(2)(a) of the Patents Act (Cap 221, 2005 Rev Ed).

4 *Yeda Research v Rhone-Poulenc Rorer* [2008] RPC 1 at [20].

5 *Dien Ghin Electronic (S) Pte Ltd v Khek Tai Ting* [2011] 3 SLR 227 at [13].

6 *Generics (UK) Ltd v Lundbeck A/S* [2009] RPC 13 at [30].

describing the invention.<sup>7</sup> It added that in respect of granted patents which have been examined and approved by the Registrar, it is entirely legitimate to expect the claims to be a reasonable pointer to the heart of the invention. In the event, after setting out the problems in the pre-existing system and reviewing the inventive concepts identified by the trial judge and the parties, the court concluded that the inventive concepts of the Patent were:

- (a) the “automatic” determination and relaying of specimen requirements to the specimen collection system by a specimen processing system that connects the specimen test ordering system to the specimen collection system; and
- (b) the “automatic” and centralised retrieval by the specimen processing system of all information required to be printed on a label for the use of both the specimen taker and the laboratory analyser and the relaying of such information by the specimen processing system to the specimen collection system for printing on a single label.<sup>8</sup>

9 The use of the word “automatic” is intriguing.

10 In the first place, neither the specifications nor the claims of the Patent use that word. The processes of the automation were not disclosed in the Patent and by the court. Nor did the court explain what it meant by the word in the context of determining, relaying and retrieving the specimen requirements.

11 Also, in law, the specifications of a patent must disclose the invention in a manner which is “clear and complete” for it to be performed by a person skilled in the art<sup>9</sup> and the claims must be “clear and concise” and “be supported by the description” in

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7 *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52 at [73].

8 *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52 at [83].

9 Section 25(4) of the Patents Act (Cap 221, 2005 Rev Ed).

the specifications.<sup>10</sup> These conditions “spell out the need for an ‘enabling disclosure’, which is central to the law of patents”.<sup>11</sup> An enabling disclosure is a disclosure which enables the invention to be performed (that is, to be carried out if it is a process or to be made if it is a product) by a person skilled in the art “without undue burden”.<sup>12</sup> This means that the person:<sup>13</sup>

[S]hould not be required to carry out any prolonged research, enquiry or experiment. He may need to carry out the ordinary methods of trial and error, which involve no inventive step and generally are necessary in applying the particular discovery to produce a practical result.

12 Further, it would appear that the use of the word “automatic” relates to the specimen processing system which determines the specimen requirements for the specimen test orders and relays the requirements to a specimen collection station such that a label is printed onsite for the tube and to be affixed to the specimen tube – that is, the specimen processing system automates the determination, relaying and retrieval of the requirements. In this regard, it will be recalled that the specifications refer to the proprietary processing logic as the “heart” of the specimen processing system. Typically, the disclosure of a computer system and software would be by way of algorithms and diagrams showing the various integers and how they interface with one another. However, the processing logic is not described and explained in the specifications such that a person skilled in the art (*eg*, a software engineer) would be able to perform the invention in the Patent without undue burden. There was no explanation as to how the processing logic automates or controls the determination, relaying and retrieval of the specimen requirements. Consequently, it would seem that the person skilled in the art would be required to carry out prolonged research, enquiry or experiment in order to ascertain

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10 Sections 25(5)(b) and 25(5)(c) of the Patents Act (Cap 221, 2005 Rev Ed).

11 *Generics (UK) Ltd v Lundbeck A/S* [2009] RPC 13 at [20].

12 See, *eg*, *Novartis AG v Johnson & Johnson Medical Ltd* [2010] EWCA 1039 at [74].

13 *Mentor Corp v Hollister Inc* [1991] FSR 557 at 561, *per Aldous J*.

how the processing logic works in the specimen processing system.

13 This is to be contrasted with the case of *Dien Ghin Electronic (S) Pte Ltd v Khek Tai Ting* (“*Dien Ghin*”), which concerned a patent for a system comprising a panel of multicoloured light-emitting diodes which could be mounted on the rooftop of a vehicle to display visual information (eg, advertisements). Amongst others, the patent claims a method of displaying visual information comprising a number of integers, including a multicoloured display mounted on the transportation means for displaying the information and a logic controller for providing logic control in relation to the display of the information. Chan Seng Onn J observed that although the claim purported to describe a process or method of achieving a particular result:<sup>14</sup>

[I]t fails to describe sufficiently to a person skilled in the art how the remote control centre monitors and controls the movement of the transportation means through the logic controller and how it controls the multicoloured display mounted on the transportation means through the logic and display controllers.

### III. Entitlement proceedings

14 As indicated above at para 5, the inventor who “came up with the inventive concept” of the invention would be entitled to be registered as the proprietor of the patent. To cater to disputes as to who should be the proprietor, s 47 of the Act provides the mechanism. It stipulates that any person having or claiming a proprietary interest in or under a patent may refer to the Registrar to determine the question as to who is entitled to be the true proprietor of the patent.<sup>15</sup> The Registrar is given the

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14 [2011] 3 SLR 227 at [19].

15 Section 47(1) of the Patents Act (Cap 221, 2005 Rev Ed).

“primary” jurisdiction to hear the reference on entitlement.<sup>16</sup> The legislative purpose of this is to reduce litigation costs.<sup>17</sup>

15 The person must, however, make the reference to the Registrar within two years of the grant of the patent. If he fails to do so, no order shall be made in relation to the reference unless it can be demonstrated that the registered proprietor knew at the time of the grant that he was not entitled to the patent.<sup>18</sup>

16 If the Registrar declines to deal with the reference, the person may apply to the court. Specifically, s 47(8) of the Act states that:

If it appears to the Registrar on a reference under this section that the question referred to him would more properly be determined by the court, he may decline to deal with it and, *without prejudice to the court's jurisdiction to determine any such question and make a declaration*, the court shall have jurisdiction to do so. [emphasis added]

17 Section 47(9) of the Act stipulates that:

The court shall not in the exercise of *any such declaratory jurisdiction* determine a question whether a patent was granted to a person not entitled to be granted the patent if *the proceedings in which the jurisdiction is invoked* were commenced after the end of the period of 2 years beginning with the date of the grant of the patent, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent. [emphasis added]

18 The highlighted aspects of these provisions spawn the following patent ambiguities:

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16 *Luxim Corp v Ceravision Ltd* [2007] RPC 33 at [41], *per* Warren J, in relation to the equivalent provision in the UK 1977 Patents Act (c 37).

17 The purpose was stated at the second reading of the Patents Bill (No 4/94/A) by the then Minister for Law, Prof S Jayakumar: *Parliamentary Debates, Official Report* (21 March 1994), vol 6 at col 1447.

18 Section 47(5) of the Patents Act (Cap 221, 2005 Rev Ed).

(a) whether, under s 47(8), the High Court can determine who is entitled to be the true proprietor of a patent only *after* the Registrar has declined to determine the question – that is, its jurisdiction is *sequential* to the Registrar’s jurisdiction – or whether its jurisdiction to determine the entitlement is *concurrent* with the Registrar’s jurisdiction; and

(b) whether the two-year time limit mentioned in s 47(9) relates to the court’s sequential or concurrent jurisdiction or both.

19 In *Cicada Cube*, the Court of Appeal grappled with these ambiguities against the following background.

20 NUH filed a reference to the Registrar pursuant to s 47(1), seeking to be the sole or, alternatively, the joint proprietor of the Patent (the “Reference”). This was on 27 July 2012, three days before the expiry of two years from the date of the grant of the Patent (30 July 2010). It was only about two and a half years later (on 18 February 2015) that the Registrar decided to decline to deal with the Reference on the ground that the matter was relatively complex and involved contractual issues between the parties. The matter was therefore left to the court to decide. Consequently, on 17 March 2015, NUH filed an originating summons in the High Court (the “OS”) seeking an order that it be named as the sole or, alternatively, the joint proprietor of the Patent. Cicada opposed the OS on the ground that NUH was barred by the two-year period stipulated in s 47(9) of the Act.

**A. Sequential or concurrent jurisdiction or both in section 47(8) of Patents Act?**

21 The Court of Appeal agreed with the parties’ submissions that the High Court and the Registrar have concurrent jurisdiction and noted that the submissions were supported by the expression “without prejudice to the court’s jurisdiction to



determine any such question and make a declaration” (the “Expression”) in s 47(8) of the Act.<sup>19</sup>

22 In fact, NUH’s submission was more nuanced. As indicated in the Judgment,<sup>20</sup> its submission was two-fold. First, it submitted that the nature of the jurisdiction conferred on the court by s 47(8) is *statutory* and this jurisdiction is *sequential* to the Registrar’s jurisdiction in that it is to be invoked and exercised only after the Registrar has declined to deal with the reference. Reliance was placed on the UK High Court case of *Luxim Corp v Ceravision Ltd*<sup>21</sup> in which Warren J held, in relation to s 37(8) and other equivalent provisions of the UK 1977 Patents Act (the “UK Patents Act”),<sup>22</sup> that the jurisdiction is statutory and to be invoked only after the Comptroller has declined to deal with the reference. Specifically, he said that:<sup>23</sup>

41c Sections 8, 12 and 37 all provide for the reference to the Comptroller of a question without the court having any original jurisdiction, again with the power for the Comptroller to decline to deal. I would add here, to emphasise, that the *statutory jurisdiction* of the court under these sections does not arise unless and until the Comptroller has declined to deal. These are not provisions where there is a coterminous jurisdiction with one suspended whilst the other operates. *The jurisdiction only arises under section 8(7), 12(2) and 37(8) and therefore only once the Comptroller has declined to deal.*

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19 *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52 at [27].

20 *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52 at [25(a)].

21 [2007] RPC 33.

22 Section 37(8) of the UK 1977 Patents Act (c 37) is *in pari materia* with s 47(8) of the Patents Act (Cap 221, 2005 Rev Ed).

23 Section 8 of the UK 1977 Patents Act (c 37) (“UK Act”) is *in pari materia* with s 20 of the Patents Act (Cap 221, 2005 Rev Ed) (“Singapore Act”) whilst s 12 of the UK Act has no equivalent in the Singapore Act. They both relate to patent applications whereas s 37 of the UK Act (s 47 of the Singapore Act) relates to a granted patent.

63 I see the scheme of the legislation this way: *under sections 8, 12 and 37, questions are in the first instance referred to the Comptroller. He is then the arbiter about which forum is the more appropriate, with the default being that the case remains with him unless it appears to him that the question (or matters involved) is more proper to be determined by the court.*

[emphasis added]

23 NUH's further submission was that the statutory jurisdiction does not, however, affect or take away the court's *inherent* jurisdiction to determine patent entitlement – as evidenced by the Expression in s 47(8) – and this jurisdiction is *concurrent* with the Registrar's jurisdiction. Reliance was placed on the House of Lords debate in February 1977 concerning cl 34(7) of the UK Patents Bill (the "UK Patents Bill") (now s 37(8) of the UK Patents Act) which resulted in the insertion of the Expression ("without prejudice to the court's jurisdiction to determine any such question and make a declaration") in cl 34(7). The need for the Expression stemmed from the concern that the statutory jurisdiction in cl 34(7) could throw doubt on whether the court retained the inherent jurisdiction to determine the parties' rights concerning patent proprietorship. During the debate, Lord McCluskey explained as follows:<sup>24</sup>

Under Clause 34(7), the comptroller may decline to deal with any question referred to him under subsection (1) of that clause and, if he does so, subsection (7) states that the court shall have jurisdiction to do so. The words added by this Amendment—and I think we have seen similar Amendments before—are intended to make it clear that *the fact that subsection (7) expressly confers jurisdiction upon the court to determine the question is not to be taken as in any way implying that any other jurisdiction which the High Court in England ... may have to make a declaration as to the rights of the parties is in any way impugned or diminished.* [emphasis added]

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24 United Kingdom, House of Lords, *Parliamentary Debates* (24 February 1977), vol 380 at col 395–396 (Lord McCluskey).

24 In similar vein, Lord McCluskey said, in relation to a similar provision in the UK Patents Bill, that:<sup>25</sup>

Clause 7(8) ... enables the comptroller to decline to deal with disputes which could more properly be dealt with by the court. ... Since Clause 7 deals with a wider variety of disputes than does section 56 of the 1949 Act, it was thought advisable to specify that upon the comptroller declining to deal with the case the court had jurisdiction to do so. *This, however, could conceivably throw doubt upon the inherent jurisdiction already possessed by the court. The purpose and effect of the Amendment is simply to make it clear that such inherent jurisdiction does exist and will remain.* [emphasis added]

25 The practical effect of the retention of the court's inherent jurisdiction is that an applicant has a choice – he can choose to make an application directly to the High Court pursuant to its inherent jurisdiction (the “High Court Application”) or make a reference to the Registrar pursuant to s 47(1) and, if the Registrar declines to deal with the reference, invoke the court's statutory jurisdiction under s 47(8) to deal with the reference.

26 The concomitant effect is that there are *two* jurisdictions involved in s 47(8). It will shortly be shown below (at para 33) that whilst the inherent jurisdiction relates to the court's power to make a declaratory order (“a declaration as to the rights of the parties”), the statutory jurisdiction simply relates to the court dealing with the reference and does not extend to making a declaratory order.

### **B. Time limit in section 47(9) of Patents Act**

27 As mentioned above (at para 20), NUH chose to make the Reference to the Registrar pursuant to s 47(1) and, as the Registrar declined to deal with its reference some two and a half years later, it filed the OS on 17 March 2015 pursuant to s 47(8)

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25 United Kingdom, House of Lords, *Parliamentary Debates* (15 February 1977), vol 379 at col 1443–1444 (Lord McCluskey).

asking the court “to do so”. As the OS was filed more than two years after the date of the grant of the Patent (30 July 2010), the question was whether the two-year conditional time limit mentioned in s 47(9) applied. If so, NUH would have to demonstrate that Cicada knew at the date of the grant of the Patent that it was not wholly or solely entitled to the Patent in order to prevent the OS from being barred.

28 Specifically, the question is whether the two-year conditional time limit in s 47(9) applies to a situation where the court’s statutory jurisdiction under s 47(8) is invoked or where its inherent jurisdiction is invoked by a High Court Application. As rightly noted by the Court of Appeal, this depends on the meaning of the phrases “any such declaratory jurisdiction” and “the proceedings in which the jurisdiction is invoked” in s 47(9).<sup>26</sup> It is salutary to set out that provision again:

The court shall not in the exercise of *any such declaratory jurisdiction* determine a question whether a patent was granted to a person not entitled to be granted the patent if *the proceedings in which the jurisdiction is invoked* were commenced after the end of the period of 2 years beginning with the date of the grant of the patent, unless it is shown that any person registered as a proprietor of the patent knew at the time of the grant or, as the case may be, of the transfer of the patent to him that he was not entitled to the patent. [emphasis added]

(1) “*any such declaratory jurisdiction*”

29 The Court of Appeal ruled that the phrase “any such declaratory jurisdiction” refers to “any” situation in which the court’s declaratory jurisdiction is invoked to determine patent entitlement.<sup>27</sup> It dismissed as “restrictive” NUH’s submission that the phrase refers to the court’s inherent jurisdiction only.<sup>28</sup>

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26 *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52 at [33].

27 *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52 at [34].

28 *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52 at [35].

The practical effect of the dismissal is that an applicant who wishes to make a reference to the Registrar must do so within two years from the grant of the patent (as mandated by s 47(5)) and, if the Registrar declines to deal with the reference, he must also file a court application to invoke its statutory jurisdiction within the same period of two years.

30 The court explained that the time limit is to provide the registered proprietor with some degree of protection and is not concerned with the forum that determines the question. It reasoned that since the Registrar is constrained by the time limit in s 47(5) if he determines the question whether the patent was granted to a person not entitled to it, it is “logical” that the court should be similarly constrained by the same time limit in s 47(9) when it determines the same question.<sup>29</sup> With respect, the logic applies in respect of the High Court Application to invoke its inherent jurisdiction to determine patent proprietorship but not in relation to an application to the court to invoke its statutory jurisdiction under s 47(8) after the Registrar has declined to deal with a reference. The rationale for imposing an additional burden on the applicant who had initially filed a reference to the Registrar to comply with the time limit on two occasions is elusive, especially as the statutory jurisdiction is invoked due to the Registrar’s decision to decline and not due to the applicant’s fault. Furthermore, the registered proprietor is already protected by the time limit in s 47(5) and the applicant’s invocation of the court’s statutory jurisdiction in s 47(8) is in effect a continuation of the process of seeking the Registrar’s determination as to proprietorship, which continuation was necessitated by his decision to decline to deal with the reference.

31 It is suggested that the court’s ruling also does not comport with the legislative history and intent of cll 34(7) and 34(9) of the UK Patents Bill (which are similar to our ss 47(8) and 47(9), respectively). First, the court was mistaken in stating that cl 34(7), with the Expression (“without prejudice to the court’s

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29 *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52 at [35].

jurisdiction to determine any such question and make a declaration”), was inserted after cl 34(9) was already in place.<sup>30</sup> The fact is that cl 34(7) was inserted in February 1977<sup>31</sup> whilst cl 34(9) was inserted three months later, in May 1977.<sup>32</sup>

32 Secondly, prior to the insertion of the Expression, cl 34(7) read:

If it appears to the Comptroller on a reference under this section that the question referred to him would more properly be determined by the court, he may decline to deal with it and the court shall have jurisdiction to do so.

33 It is noticeable that there was no reference in the above clause to the court or the Comptroller making a declaratory order. Indeed, the Comptroller had no power to make such an order. His role under cl 34(1) (now s 37(1) of the UK Patents Act) was only to determine the reference. Hence, the words “to do so” in cl 34(7) would have been read as referring or relating to the court’s statutory jurisdiction to do what the Comptroller would have done – that is, to determine the question. It follows that the statutory jurisdiction in cl 34(7) concerns determining the question only and does *not* extend to making a declaratory order.

34 As mentioned above at para 23, Lord McCluskey inserted the Expression in cl 34(7) in February 1977 to address the doubt as to whether the statutory jurisdiction in cl 34(7) would oust or diminish the court’s inherent jurisdiction to “make a declaration as to the rights of the parties” (including in relation to patent proprietorship).

35 Soon after, in May 1977, cl 34(9), with the phrase “in the exercise of any such declaratory jurisdiction”, was introduced. It

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30 *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52 at [36]. It was also mistaken to have referred cl 34(7) of the UK Patents Bill as cl 34(8).

31 United Kingdom, House of Lords, *Parliamentary Debates* (24 February 1977), vol 380 at col 395–396 (Lord McCluskey).

32 United Kingdom, House of Lords, *Parliamentary Debates* (17 May 1977), vol 383 at col 569–570 (Lord Oram).

was expressly stated that the clause was introduced to correspond UK domestic law with art 27(3) of the Community Patent Convention relating to European Community patents.<sup>33</sup> Given that the only declaratory jurisdiction referred to in the preceding cl 34(7) is the court’s jurisdiction mentioned in the Expression in the clause, the words “such declaratory jurisdiction” in the phrase in cl 34(9) must have been intended to have reference to that jurisdiction, not to the court’s statutory jurisdiction which, as suggested above, does not extend to making a declaration. It follows that the conditional two-year time limit in cl 34(9) (our s 47(9)) applies only to a High Court Application in which its inherent jurisdiction is invoked.

(2) “*the proceedings in which the jurisdiction is invoked*”

36 The Court of Appeal held that this phrase in s 47(9) refers to the court proceedings filed after the Registrar has declined to deal with the reference. It interpreted the word “jurisdiction” as referring to the court’s declaratory jurisdiction, not the Registrar’s, and said that this jurisdiction is invoked by applying to the High Court for the determination of patent entitlement, not through the reference to the Registrar.<sup>34</sup> In comparing the language of ss 47(5)(b) and 47(9), the court noted a “key difference” between them, in that whereas s 47(5)(b) uses the expression “the reference”, s 47(9) uses the phrase “the proceedings in which the jurisdiction is invoked”. This, according to the court, militates against construing the phrase as referring to the reference to the Registrar.

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33 United Kingdom, House of Lords, *Parliamentary Debates* (17 May 1977), vol 383 at col 569–570 (Lord Oram). Article 27(3) of the Community Patent Convention (76/76/EEC) states that:

Legal proceedings in respect of the rights [relating to Community patents] may be instituted only within a period of not more than two years after the date on which the European Patent Bulletin mentions the grant of the European patent. This provision shall not apply if the proprietor of the patent knew, at the time when the patent was granted or transferred to him, that he was not entitled to the patent.

34 *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52 at [39].

37 With respect, the court’s interpretation overlooks the fact that there are two jurisdictions involved in s 47(8), one of which does not extend to making a declaratory order. The interpretation is also not supported by the difference in language between ss 47(5)(b) and 47(9) as they deal with very different applications. Section 47(5)(b) concerns a reference to the Registrar made pursuant to s 47(1) whereas in s 47(9), there are two court applications involved. Hence, it is understandable that the word “jurisdiction” in the phrase in s 47(9) refers to the court’s jurisdiction but it does *not* mean that the word refers to its statutory jurisdiction invoked after the Registrar declines to deal with the reference.

38 Instead, the word “jurisdiction” in the phrase should have been read as referring to the “declaratory jurisdiction” in the expression “in the exercise of any such declaratory jurisdiction” which appears earlier in the same provision (s 47(9)). So read, the word “proceedings” in the phrase would refer to a High Court Application to invoke the court’s inherent jurisdiction to make a declaratory order as to the rights of the parties concerning patent proprietorship.

#### **IV. Conclusion**

39 In the event, the Court of Appeal found NUH and Cicada to be joint proprietors of the Patent and NUH’s chief of the Department of Laboratory Medicine and Cicada’s directors to be joint inventors. It made these findings despite ruling that the two-year time limit in s 47(9) applied. This was because it found that Cicada’s directors knew at the time of the grant of the Patent that they were not solely entitled to the Patent.

40 The court advised applicants who choose to make a reference to the Registrar under s 47(1) to be mindful of the two-



year time limit in s 47(9) in the “unlikely” event that the Registrar takes a long time to decline to deal with the reference:<sup>35</sup>

If the two-year mark is approaching and the Registrar has not made a determination or declined to hear the reference, it would be prudent for the applicant to withdraw the reference and to commence proceedings in the High Court. Otherwise, he will be subject to the additional burden of proving the registered proprietor’s knowledge if his court application is filed more than two years after the grant of the patent.

41 The advice indicates that the burden is all on the applicant. There is no other recourse or protection available for the applicant while he waits for the Registrar to determine the reference in the hope that the Registrar does not exceed the two-year time limit. There is no reason in principle why applicants should have to bear such a burden, however unlikely it may be that the Registrar would delay declining the reference. The practical effect is that applicants are likely to choose to apply to the court directly instead of making a reference to the Registrar. This would be unfortunate as the reference was intended by Parliament to be a cheaper route.

42 The consequence of the court’s decision is that registered proprietors are more than adequately protected by the two-year time limit:

- (a) under s 47(5)(b) of the Act in respect of a reference to the Registrar;
- (b) under s 47(9) in respect of a High Court Application; and
- (c) under s 47(9) in respect of a court application filed after the Registrar declines to deal with the reference.

43 Such expansive protection is unwarranted, particularly for registered proprietors who knew at the time of the grant of the patent that they were not entitled to the patent.

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35 *Cicada Cube Pte Ltd v National University Hospital (Singapore) Pte Ltd* [2018] SGCA 52 at [47].