Re Howe Martin Russell Thomas QC
[2001] SGHC 219

Case Number : OM 600012/2001

Decision Date : 14 August 2001

Tribunal/Court : High Court

Coram : Yong Pung How CJ

Counsel Name(s) : Dedar Singh Gill and Jupiter Kong (Drew & Napier LLC) for the plaintiffs/applicant; Pradeep Kumar for the Law Society; Wilson Hue Kuan Chen (State Counsel) for the Attorney General; Lai Yew Fei (Cooma Lau & Loh) for the defendants

Parties : —

Legal Profession – Admission – Ad hoc – Admission of Queen's Counsel – Three stage test for admission – Whether issues of sufficient complexity and difficulty – Whether local expertise present – Whether circumstances of case warrant admission – Whether applicant has special qualifications and experience – s 21(1) Legal Profession Act (Cap 161, 2000 Ed)

: By this originating motion, Mr Martin Russell Thomas Howe QC (`Mr Howe`) of 8 New Square, Lincoln`s Inn, London, sought ad hoc admission under s 21 of the Legal Profession Act (Cap 161, 2000 Ed) (`the Act`) to practise as an advocate and solicitor of this court as leading counsel, to appear for Fico BV (`Fico`) in a patent infringement action in the High Court, until its final disposal. At the conclusion of the hearing of the application, I dismissed it.

Section 21 of the Legal Profession Act

Section 21 of the Act, states as follows:

> *(1) Notwithstanding anything to the contrary in this Act, the court may, for the purpose of any one case where the court is satisfied that it is of sufficient difficulty and complexity having regard to the circumstances of the case, admit to practise as an advocate and solicitor any person who -*
>
> *(a) holds Her Majesty`s Patent as Queen`s Counsel;*
>
> *(b) does not ordinarily reside in Singapore or Malaysia but who has come or intends to come to Singapore for the purpose of appearing in the case; and*
>
> *(c) has special qualifications or experience for the purpose of the case.*

The applicant also showed to the court his very impressive credentials. It was obvious that the requirements of special qualifications and experience under s 21(1) of the Act were not in issue.

In **Re Oliver David Keightley Rideal QC** [1992] 2 SLR 400 at 402D, Chan Sek Keong J (as he then was) very accurately pointed out that the amendment in 1991, Act No 10 of 1991, to s 21 was aimed at specifying some guidelines in the ad hoc admission of Queen`s Counsel. The objective of the amendment was to help develop a strong core of good advocates at the local Bar, by `the imposition of more stringent conditions for the admission of Queen`s Counsel to appear in our courts, but, at the same time, to continue to allow litigants to avail of their services in appropriate cases`. In **Price Arthur Leolin v A-G** [1992] 2 SLR 972 at 975E, I stated that:

> *The objective of the amendment was to help the development of a strong core of good advocates at the local bar by restricting access to Queen`s Counsel only in the more difficult and complex cases.*

The amendment to s 21 of the Act thus requires the court to take into account two additional requirements: (1) that the case must be of sufficient difficulty and complexity; and (2) the circumstances of the case.

Again, I took the opportunity to clarify this in **Re Caplan Jonathan Michael QC (No 2)** [1998] 1 SLR 440 at [para]11:

> *At the first stage, the applicant must demonstrate that the case in which he seeks to appear contains issues of law and/or fact of sufficient difficulty and complexity to require elucidation and/or argument by a Queen`s Counsel. Such difficulty or complexity is not of itself a guarantee of admission, for the decision to admit is still a matter for the court`s discretion. At the second stage, therefore, the applicant must persuade the court that the circumstances of the particular case warrant the court exercising its discretion in favour of his admission. Finally, he has to satisfy the court of his suitability for admission.*

Our courts have had a decade in dealing with s 21(1) of the Act. As it was quite rightly pointed out by Lai Kew Chai J in **Re Flint Charles John Raffles QC** [2001] 2 SLR 276 at [para]9, the local Bar has matured and is acquitting itself commendably. Lai J has put this elegantly:

> *There has been forged and carefully nurtured, particularly over the last ten years, a body of Senior Counsel, potential senior counsel and an impressive group of young advocates and solicitors, both in the public service and in the private sector, with excellent academic credentials and a right attitude. The process continues during which opportunities must be judiciously offered and challenges thrown, though never at the expense of justice to any litigant before our courts.*

It is in this context that the court has then to analyse the nature of the suit to consider it if it merits an ad hoc admission of a Queen`s Counsel.

The suit

The plaintiffs are the proprietors of three patents of a moulding machine. The patents relate to different parts of a moulding machine for moulding semiconductor lead frames. They are Patent No 35031 for a `Modular Moulding Apparatus`, Patent No 52483 for a `Single Strip Moulding Apparatus with Means for Exerting Pressure`, and Patent No 56503 for a `Press for Encapsulating Electronic Components and Methods for Use of the Press`. The plaintiffs` claim against the defendants was about an allegation that certain mechanical parts of the defendants` IDEALmold infringed their three patents. The plaintiffs asked for an injunction, damages and costs in relation to the alleged infringement. The trial of this matter has been fixed for August 2001.

As I stated in **Price Arthur Leolin v A-G** [1992] 2 SLR 972 at 975H, the onus is on the applicants to

show in an affidavit the specific issues for which admission is sought and persuade the court that they are complex and difficult.

Complexity and difficulty

In the affidavit, the applicant stated three main issues to justify his admission. These issues were all matters to be decided at the trial proper:

> *(a) whether the Plaintiffs` inventions were valid in that they were novel and involved an inventive step;*
>
> *(b) whether the Defendants had a right to continue to use the allegedly infringing article pursuant to s 71 of the Patents Act;*
>
> *(c) whether the Registrar`s grant of Patent No 56503 in respect of claims 7-19 was illegal irrational and/or unreasonable on account of the fact that the International Preliminary Examination Report covered only claims 1-6 of the patent application.*

The first issue

The test to be used to determine novelty and inventive step has been twice ruled on by the Court of Appeal, in both **Merck & Co Inc v Pharmaforte Singapore** [2000] 3 SLR 717 and **Genelabs Diagnostics v Institut Pasteur** [2001] 1 SLR 121 .

The High Court, in hearing the case, will have to decide the issue in accordance with these decisions. In **Re Price Arthur Leolin QC** [1998] 3 SLR 782 at [para]16, I made it clear that once there is a precedent binding the High Court, the High Court, in hearing the case, will have to rule in accordance with that precedent. In such circumstances, the first issue posed no complexity.

The second issue

On the second issue, the applicant did not explain why the issue was complex or difficult. The applicant merely stated that no local decision had had an opportunity of construing s 71 of the Patents Act (Cap 221, 1995 Ed). However, the mere fact that there is no local decision interpreting a provision of a statute does not per se turn that into a complex or difficult issue of law. If it were so, it means that whenever a fresh statute is enacted and becomes the subject of dispute as to its applicability, s 21 of the Act will warrant the admission of a Queen`s Counsel. That cannot be right.

The logical approach should instead be to refer to decisions of other Commonwealth jurisdictions and the High Court would have to decide on it. As stated by Chan Sek Keong J in ***Re Oliver David Keightley Rideal QC*** (supra at p 404I), `Novelty of this nature is not ... prima facie evidence of complexity.`

On this issue too, it is for the defendants to show that they have been doing something towards the manufacture of an equivalent similar to what is contained in the plaintiffs` patents before the priority

dates of the patents. The issue is thus essentially an issue of fact that will have to be determined by the High Court on the basis of documents and witnesses` testimony and the High Court`s evaluation of the evidence.

The third issue

Again, the applicant did not state in his affidavit why the third issue was complex or difficult. The applicant merely stated that no local decision has had an opportunity to construe the application and applicability of s 71 of the Patents Act. It is more an issue of administrative law in the context of the Patents Act. On this specific issue of administrative law, numerous precedents are available. Although it may be a novel context of the Patents Act, I failed to see how that alone per se should turn it into an issue of sufficient complexity and difficulty, warranting the admission of a Queen`s Counsel.

Circumstances to justify admission

It was thus clear that this case did not pass the first stage of the test.

At the second stage, the court has to balance the need to foster a strong and independent Bar and the individual justice of each case which demands the special skills of a Queen`s Counsel.

The applicant cited several reasons in his affidavit, the main reason of which was an allegation that the level of patent expertise in Singapore was low. Such a statement was hardly justifiable. I will merely cite a number of patent cases, involving local counsel. **V-Pile Technology (Luxembourg) SA v Peck Bros Construction** [2000] 3 SLR 358 was a case about whether the defendants` machine infringed the plaintiffs` patent. It also touched on whether the invention possessed any inventive step. In ***Merck & Co Inc v Pharmaforte Singapore*** (supra), the issues were whether the lack of utility rendered the invention devoid of novelty, and whether the invention was obvious to a person skilled in the art. The case of **Flexon v Bean Innovations** [2001] 1 SLR 24 touched on the issues of groundless threats of infringement proceedings and the applicability of s 77(4) of the Patents Act, as well as the construction of the claims in specification of the defendants` patent. In ***Genelabs Diagnostics v Institut Pasteur*** (supra), the issues touched on novelty, inventive step, sufficiency of disclosure, infringement and acquiescence.

Queen`s Counsel should only be admitted for complex and difficult cases where the necessary knowledge and experience is not available from, or cannot be provided by, local counsel. This was not one of those cases.

The applicant also seemed to allude to the likelihood that the High Court`s eventual ruling with regard to the third issue will have a wide impact on the patent practice in Singapore; also that there are many other cases where the Registrar grants patents without looking at the Examination Report. I failed to see that this was the case, and in any case, why such a wrong practice, if it existed, required the elucidation of a Queen`s Counsel for it to be highlighted by the High Court. The local Bar has more than sufficient expertise and competence to compare the practice across the Commonwealth jurisdictions and bring it to the High Court`s attention.

Outcome:

Application dismissed.