

**IN THE FEDERAL COURT AT PUTRAJAYA  
(APPELLATE JURISDICTION)  
CIVIL APPEAL NO. 02(f)-97-12/2014**

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ANTARA

**SKB SHUTTERS MANUFACTURING SDN BHD ... APPELLANT**

DAN

**1. SENG KONG SHUTTER INDUSTRIES SDN BHD ... RESPONDENTS  
2. TAN KOOI LIM**

Coram: Zulkefli bin Ahmad Makinudin, CJ (Malaya)  
Abdull Hamid bin Embong, FCJ  
Jeffrey Tan, FCJ  
Mohamed Apandi bin Hj. Ali, FCJ  
Abu Samah bin Nordin, FCJ

**JUDGMENT OF THE COURT**

Introduction

1. This is the appellants/plaintiffs appeal against the whole of the decision of the Court of Appeal in allowing the respondents/defendants appeal against the decision of the High Court of Kuala Lumpur. It was the finding of the Court of Appeal that the appellants/

Malaysian Patent No. My-128431-A [Patent 431] was invalid and that the appellant's claim against the respondents for infringement of the appellant's patent was therefore unsustainable. In consequence thereof, the Court of Appeal reversed the decision of the High Court in allowing the claim against the respondents for infringement of the appellant's patent.

2. The questions of law upon which leave as obtained read as follows:

- (1) Where a patent comprises multiple claims, whether, in invalidating a patent for lacking novelty and/or inventive step, the Court must make a determination on each and every claim.
- (2) Where a patent comprises multiple claims, some of which are independent, and other claims which are dependent on the independent claims:
  - (i) whether having determined that an independent claim of a patent lacks novelty and/or inventive step, the Court is required to assess the claim dependent from the said independent claims before invalidating a patent; and
  - (ii) whether having only determined that one or more claims of a patent lack novelty and/or inventive step, the Court should invalidate those claims whilst preserving the patent in respect of the valid dependent claims.

- (3) Where there is no dispute that the appellant's /plaintiff's product is an embodiment of the claims of the appellant's patent, whether, in assessing Prior Art to determine if the appellant's patent is anticipated by or is inventive over the Prior Art, it is permissible to compare features of the appellant's product to the features of the Prior Art.
- (4) Whether, on a true construction of the case of **The General Tire & Rubber Co. v. The Firestone Tyre & Rubber Co. Ltd. & Ors. [1972] RPC 457**, in particular the passage of **Sachs LJ** that was cited by the Court of Appeal, when the English Court of Appeal referred to *"...To determine whether a patentee's claim has been anticipated by an earlier publication it is necessary to compare the earlier publication with the patentee's claim... If the earlier publication so construed discloses the same device as the device which the patentee by his claim, so construed, asserts that he has invented, the patentee's claim has been anticipated, but not otherwise. In such circumstances the patentee is not the true and first inventor of the device and his claimed invention is not new..."*; a comparison between a device that is disclosed by the claims of a patent with a device that is disclosed by an earlier publication (or Prior Art) is permitted.
- (5) In the event the answer to Questions 3 and 4 above are in the negative, whether, having determined that the Prior Art must be compared to the Patent Claims in assessing if the appellant's patent is anticipated by or is inventive over the

Prior Art, it is open to the Court of Appeal to construe the Patent Claims without the assistance of persons skilled in the art.

- (6) Upon finding that the expert witnesses could hardly be described as *the unimaginative skilled addressee* in determining if there is inventive step in the appellant's invention or otherwise, whether it is permissible for the Court to refer to the evidence of such experts to make a finding that the concept embodied in the appellant's patent is common general knowledge in the field of mechanical engineering which would be obvious to a normally skilled but unimaginative addressee in the art.
- (7) Where there is a finding that the Prior Art does not contain clear and unmistakable directions to do what the inventor claims to have invented and where the Prior Art in itself does not disclose the device disclosed by the Patent Claims, whether it is permissible for the Court of Appeal to make a finding that the appellant's patent lacks novelty as it is anticipated by the Prior Art.

### Background Facts

3. The appellant is the registered proprietor of Patent 431 entitled *Rolling Door*. The appellant's patent pertain to the features and parts of a *rolling door*. The appellant is in the business of manufacturing, distributing and dealing in roller shutters, roller doors and a wide range of shutters.

4. The first respondent is also in the business of dealing in roller shutters and related parts. The second respondent who is a director of the first respondent was sued in his personal capacity as the sole proprietor of Sing Keong Enterprise which ceased business sometime in or about 2008.

5. The appellant's claim against the respondents was *inter alia* for infringement of the appellant's patent. The appellant alleged that the respondents by manufacturing, selling, offering for sale and using roller shutters which incorporate the features of the appellant's patent, had infringed the appellant's patent.

6. The respondents' essential defence was that the appellant's patent was invalid by reason that it lacked novelty and an inventive step by reason of the prior disclosure and or prior use of the following Prior Art:

- (a) An Aluminium PVC Piece [~~the~~ PVC Piece+] which PVC Piece had been sold in the market since 1996, which date is prior to the application date of the appellant's patent on 24.2.1997.
- (b) United States Patent No. 5456305 [~~US~~ 5456305 Patent+] for *Rollable or Foldable Shutter*+ filed on 18.1.1995 and published prior to 24.2.1997.
- (c) United States Patent No. 4433714 [~~US~~ 4433714 Patent+] for *Roller Shutter Doors*+ filed on 23.10.1981 and published prior to 24.2.1997.

### Findings of the High Court

7. The learned High Court Judge held that Patent 431 was novel, did not lack an inventive step and was valid and allowed the appellants' claim against the respondents for infringement of the appellants' patent. In considering the question of novelty of the appellants' patent the learned High Court Judge made a comparison of the appellants' product with the Prior Art.

### Findings of the Court of Appeal

8. The Court of Appeal reversed the decision of the High Court and held that the learned High Court Judge erred when he made a comparison of the appellants' product with the Prior Art when considering the question of novelty of the appellants' patent when he should have compared the claims of the appellants' patent with the Prior Art. The Court of Appeal made comparison between the features of Claim (1) of the appellant with the PVC Piece and found that the said Claim was not novel and had been anticipated by the PVC piece.

9. The Court of Appeal in arriving at its decision that the appellants' patent lacked an inventive step adopted the approach in **Windsurfing International Inc. v. Tabur Marine (Great Britain Ltd. [1985] RPC 59** and found that the appellants' patent was obvious to a skilled but unimaginative addressee in the art and lacked an inventive step.

## Principles of Patent Law

10. At the outset it would be appropriate here to state the relevant provisions of the law and the principles relating to patent. In Malaysia patent is a creature of statute and as a general rule the rights and protection thereof are found within the Patents Act 1983 [~~the Act~~] and the Patents Regulations 1986 [~~the Regulations~~].

11. On ~~the~~ *invention* section 12 of the Act states that:

~~(1)~~ *An invention means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology.*

~~(2)~~ *An invention may be or may relate to a product or process.*

12. On ~~the~~ *Patentable Invention* section 11 of the Act states that:

~~An~~ *invention is patentable if it is new, involves an inventive step and is industrially applicable.*

In order for an invention to be granted a monopoly and protected under the Act, it must be new, involves an inventive step and be industrially applicable.

13. On the meaning of ~~the~~ *Novelty* or ~~the~~ *New* section 14 of the Act defines what is new as follows:

- (1) An invention is new if it is not anticipated by prior art.*
- (2) Prior art shall consist of –*
- (a) everything disclosed to the public, anywhere in the world, by written publication, by oral disclosure, by use or in any other way, prior to the priority date of the patent application claiming the invention.*
- ....+*

14. An *inventive step* is defined in section 15 of the Act as follows:

*An invention shall be considered as involving an inventive step if, having regard to any matter which forms part of the prior art under paragraphs 14(2)(a), such inventive step would not have been obvious to a person having ordinary skill in the art.+*

### Rights of Patent Owner

15. The owner of a patent shall have the exclusive right to *inter alia* exploit the patented invention. *Exploitation* is defined in the Act to include, when the patent is granted in respect of a product, the *making, importing, offering for sale, selling or using the product and stocking such product for the purpose of offering for sale, selling and using*. **[See section 36 of the Act].**

### Infringement

16. Infringement is the performance of any acts referred to in section 36(3) of the Act in Malaysia by a person other than the owner

of the patent and without the agreement of the latter in relation to a product or a process falling within the scope or protection of the patent. **[See section 58 of the Act]**.

### Invalidation of a Patent

17. The Court may invalidate a patent if *inter alia* that what is claimed as an invention in the patent is not an invention within the meaning of section 12 or is excluded from protection under section 13 or subsection 31(1) or is not patentable because it does not comply with the requirements of section 11, 14, 15 and 16. **[See section 56(2) of the Act]**.

18. The grounds to invalidate a patent thus includes (i) if the patent is not new [**section 14**] or (ii) lacks an inventive step [**section 15**]. Section 56(3) of the Act states that where it applies only to some claims or parts of a claim, such claims or parts of a claim may be declared invalid by the Court and the invalidity of part of a claim shall be declared in the form of a corresponding limitation of the claim in question.

### Claims

19. The claims define the invention in terms of the technical features of the invention. **[See Regulation 13(5) of the Regulations]**. The function of the claims is to define clearly and with precision the monopoly claimed so that others may know the exact

boundaries of the area within which they will trespass. Their primary object is to limit and not to extend the monopoly. What is not claimed is disclaimed. **[See Terrell on the Law of Patents]**.

20. The first claim is usually the main claim which is made as wide as possible. The subsidiary claims refer to the main claim and include qualifying or explanatory clauses on the various integers of the main claim or optional features. They may also contain independent claims.

#### Dependent Claims

21. Claims which include all the features of one or more of the other claims are known as dependent claims. They will, if possible at the beginning, contain a reference to the other claim or claims and will then state the additional features claimed. **[See Regulation 14 of the Regulations]**. A claim which is not dependent on another is known as an independent claim.

#### Decision

#### Questions (1) and (2)

22. We shall first deal with Questions (1) and (2) together. Learned counsel for the appellant submitted that the Court of Appeals' findings of invalidation are unsound in its entirety, because the invalidation of entire Patent 431 following a finding of only one invalid claim and/or

invalid parts of a claim is unsustainable in law. It was contended for the appellant that at most the Court of Appeal could only partially invalidate Patent 431.

23. The appellant also contended that the Court of Appeal failed to assess each claim individually for lack of novelty and or an inventive step. As such, it was argued that those claims which had not been assessed individually ought not to have been declared invalid by the Court of Appeal.

24. It is noted that claims (1) and (11) of the appellant's Patent 431 are independent claims. Claims (2) to (10) of the appellant are dependent claims, being dependent on the preceding claims. All are ultimately dependent on Claim (1).

25. On the issue of novelty, it is clear that the Court of Appeal considered Claim (1). We are of the view that the Court of Appeal also considered Claim (11). In fact the appellant's witness PW2 conceded that *the US'305 Patent is probably destructive of the novelty of claim (11)*.

26. As regards the rest of the claims which are dependent claims [Claims (2) to (10)], we are of the view that having considered Claim (11) and Claim (1) and found them to be invalid, the Court of Appeal was entitled to then hold that the appellant's Patent 431 was invalid as the rest of the claims, being claims dependent on Claim (1), would also fall.

27. The dependent claims in essence incorporate all the features of the claim upon which it depends but are drafted to only make reference to the claim upon which it depends without expressly setting out all the features of that claim. As such, in the event that the independent claim upon which they depend is invalid, the only way the dependent claim can survive and stand if at all is if the dependent claims are redrafted to incorporate the features of the claim upon which they are dependent and are made an independent claim. They cannot remain as *dependent claims* when the claim upon which they depended is invalid. We agree with the contention of the respondents as that was not done in the present case and as it could not be redrafted, the dependent claims must fall. **[See the case of E I Du Pont De Nemours & Co. v. Imperial Chemical Industries Plc. & Anor. (2007) FCAFC 163].**

28. The position in Malaysia relating to amendments of patent claims must be distinguished from the position in the United Kingdom. In the United Kingdom, the patent claim can be amended pending litigation in respect of its validity. **[See section 75 of the UK Patents Act 1977]**. There is a further provision which gives the Court in the United Kingdom express power to enforce the part of the patent which is found to be valid. Section 63 of the UK Patents Act 1977 states as follows:

*%f the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the court or the comptroller may, subject to subsection*

*(2) below, grant relief in respect of that part of the patent which is found to be valid and infringed.+*

29. There is no such provision in the Malaysian Patents Act 1983 similar to the provisions of sections 63 and 75 of the UK Patents Act 1977. It is clearly by reason of the said provision of section 63 in the United Kingdom that one can enforce a partially valid patent without amendment. Section 56(3) of our Patents Act 1983 is clearly not the equivalent of section 63 of the UK Patents Act 1977. It merely states that some claims or part of a claim may be declared invalid which in our view it can only refer to the independent claims of a patent.

30. On the issue of lack of inventive step we agree with the submissions of respondents that each of the 11 claims lacked an inventive step. Although the Court of Appeal did not expressly state that they dealt with each of the said claims, it should be obvious it must have been so dealt with in light of the submission of the respondents and the finding of a lack of inventive step in the appellants' Patent 431 with regard to claims 1 and 11.

31. It is our judgment that Questions (1) and (2) if answered can have no impact on independent claims (1) and (11). The Questions are academic, in so far as the independent claims are concerned.

Questions (3) and (4)

32. We shall now deal with Questions (3) and (4) together. Questions 3 and 4 relate to the principles of novelty on a comparison of the Prior Art to the device embodiment of the patent claims. It was submitted for the appellant that the learned High Court Judge was at liberty to compare the appellant's device on the basis that it constituted the claimed invention in itself and that the principles of **The General Tire & Rubber Co. v. The Firestone Tyre & Rubber Co. Ltd. & Ors.** [supra] do not exclude the comparison of a device disclosed by prior use with the device embodiment of a patent and/or patent claim in question.

33. The respondents however submitted that when assessing the issue of novelty and inventive step the High Court ought to have compared the claims of the appellant's patent and not the appellant's product with the Prior Art. On this point the case of **The General Tire & Rubber Co. v. The Firestone Tyre & Rubber Co. Ltd. & Ors.** [supra] held as follows:

*To determine whether a patentee's claim has been anticipated by an earlier publication it is necessary to compare the earlier publication with the patentee's claim.*

34. We are of the view the law is clear that when it has to determine if an invention which is the subject of a patent claim lacks novelty or inventive step, one looks at the language of the claims

which define the scope and monopoly claimed. **[See the case of Electric and Musical Industries Ltd. & Ors. v. Lissen Ltd. & Anor. (1939) RPC 23]**. The reference in **The General Tire & Rubber Co. v. The Firestone Tyre & Rubber Co. Ltd. & Ors.** [supra] to a device is still in the context of a device as disclosed by the claims. It is ultimately the claims which must be looked at and considered.

35. We find on the facts of this case that the device disclosed by the claims is not identical to the appellant's product. The appellant's product is in three parts but the claims of the appellant's patent do not restrict the device to three parts. There was no concession by the respondents that the claims disclosed a three part product.

36. As the appellant's product differs from the device as disclosed by the claims in the appellant's patent, Questions (3) and (4) are in fact abstract and hypothetical, not relevant to the facts of this case and do not assist the appellant. We agree with the contention of the respondents that the Court of Appeal was correct to construe the claims and compare the claims with the Prior Art in finding that the appellant's patent was invalid.

#### Questions (5) and (6)

37. We shall deal with Questions (5) and (6) together. These two questions relate to the issue of whether there are requirements for patent construction and assessment by persons skilled in the art. It was submitted for the appellant that the Court of Appeal wrongly

invalidated Patent 431 as it did so without the assistance of appropriate technical experts and/or without the sufficient backing of the technical evidence from persons skilled in the relevant art particularly on .

- (i) the technical meaning and wording of the claims in light of the relevant art;
- (ii) the common general knowledge;
- (iii) the inventive concept of each claim in question;
- (iv) the differences between the inventive concept and the state of the art; and
- (v) whether it is obvious.

38. On the said Questions (5) and (6) posed by the appellant we are of the view the general principles relating to the construction of patent claims and the role to be played by the ~~%experts+~~ are well-established. The function of the expert is to educate the court in technology and that they come as teachers, as makers of the mantle for the Court to don. For that purpose it does not matter if they do not approximate a person skilled in the art. **[See the case of Technip France SA's Patent (2004) RPC 46]**. As such, clearly the Court can construe patent claims without the assistance of a person skilled in the art. Any assistance required is from an expert and he need not approximate a skilled person.

39. It is our judgment that the Court of Appeal was entitled to construe the claims of the appellants' patent and compare them with

the Prior Art. Any assistance required on the technology, technical terms and common general knowledge had been led through the evidence of DW3, the respondents' expert at trial, whose evidence was before the Court of Appeal.

40. As regards Claims (4) to (11), a perusal of the same evinces that any additional features relate to simple concepts, are unambiguous and plain in meaning and in respect of which in our view required no explanation on the technical terms.

41. We are of the considered view that as the experts who educate the Court on technology, technical terms and common general knowledge do not have to approximate persons skilled in the art, the Court of Appeal was entitled to hold that neither DW3 [the respondents' experts] nor PW1 [the appellant's expert] were *unimaginative skilled addressees* and yet make reference to their evidence on technical terms and common general knowledge when assessing if the claims of a patent were obvious.

#### Question (7)

42. Question (7) touches on principle of assessment of novelty. It was submitted for the appellant that the Court of Appeal's assessment of novelty on Patent 431 when compared to the PVC Piece Prior Art was flawed in holding that the PVC Piece did not contain clear and unmistakable directions to do what the inventor claims to have invented.

43. It was also contended for the appellant that the Court of Appeal had wrongly considered the ~~%diagrams+~~ and ~~%drawings+~~ in addition to the PVC Piece in this part as they .

- (i) did not form part of the Prior Art;
- (ii) were not led in evidence by either parties' experts; and
- (iii) which were not adduced at trial but only on appeal.

We are of the view the ~~%diagrams+~~ and the ~~%drawings+~~ submitted before the Court of Appeal were merely to assist the Court of Appeal in its assessment of novelty of claims 1 and 11 which contained drawings of the PVC Piece already admitted in evidence as well as drawings of the appellant's patent which were from the Patent itself and also already admitted in evidence. They were submitted to illustrate the features found in the claims and in the PVC Piece for comparison. The diagrams and drawings were not a separate Prior Art.

44. For a patent to lack novelty, it must be shown that the claimed invention has been anticipated in a single document and/or a single Prior Art. We are of the view the Court of Appeal's reference to the fact that the PVC Piece did not contain clear and unmistakeable directions must be read in context. It is clear that the Court of Appeal held that the PVC Piece did not contain clear and unmistakeable directions to do what the inventor claimed to have invented. It was in the context that there were no literal written ~~%directions+~~ disclosed by the PVC Piece as the PVC Piece was a device as opposed to a

written publication. However, this does not equate to the Court of Appeal having found by that statement that the PVC Piece did not destroy the novelty of the claims of the appellants' patent.

45. Having considered claim (1), the Court of Appeal made a specific finding that all the elements found in the claim were found in the PVC Piece and thus the claim was invalid. Question (7) assumes the fact that the claims did not disclose the device disclosed by the Prior Art when this is inaccurate as a finding of fact had been made that it did. We are therefore of the view Question (7) does not assist the appellant in its case against the respondents.

### Conclusion

46. For the reasons abovestated we, the remaining Judges (**see section 78 of the Courts of Judicature Act 1964**) following the resignation of Mohamed Apandi Ali FCJ, as he then was, now Attorney General, find there is no merit in this appeal. The appeal is therefore dismissed with costs.

(ZULKEFLI BIN AHMAD MAKINUDIN)  
Chief Judge of Malaya

Dated: 26<sup>th</sup> October 2015.

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