

**IN THE GENERAL DIVISION OF
THE HIGH COURT OF THE REPUBLIC OF SINGAPORE**

[2022] SGHC 164

Tribunal Appeal No 24 of 2021

Between

Nippon Shinyaku Co, Ltd

... Applicant

And

Registrar of Patents

... Respondent

FOUNDATIONS OF DECISION

[Intellectual Property — Patents and Inventions — Registration]

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Nippon Shinyaku Co, Ltd

v

Registrar of Patents

[2022] SGHC 164

General Division of the High Court — Tribunal Appeal No 24 of 2021

Lee Seiu Kin J

7 March 2022

14 July 2022

Lee Seiu Kin J:

Introduction

1 Patent registration is a technical, and highly specialised process where precision is key. Mistakes can therefore prove costly. There are two important technical documents involved in registering a patent: ‘claims’ and ‘specifications’. The former defines the scope of protection afforded by a patent. As for the latter, it is said that a patent “lives or dies” by its specification – if the description of the invention in the specification is not disclosed in a manner which is “clear and complete for the invention to be performed by the person skilled in the art”, the specification is said to lack enabling disclosure which may result in the patent being revoked: Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Ed, 2014) (“*Law of Intellectual Property of Singapore*”) at [29.4.14], see also Robert Burrell and Catherine Kelly, “Parliamentary Rewards and the Evolution of the Patent System” (2015)

74(3) Cambridge Law Journal 423 at pp 426–427 for a brief history of patent specifications. Consequently, any error in these documents would affect the scope of protection afforded by a patent, and whether a patent can be registered in the first place.

2 That said, the law recognises that patent agents, who are usually responsible for drafting these documents, are liable to make mistakes: see David Vaver, “Clerical Errors in the Patent Office” (2011) Intellectual Property Journal 131 at pp 132–133. Section 107 of the Patents Act 1994 (Rev Ed 2020) (“the Patents Act”) states:

The Registrar may, subject to any provision of the rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.

3 In the case before me, the Applicant appealed against the decision of the Registrar of Patents (the “Registrar”) refusing a proposed correction to the specification of the patent application filed in Singapore. The main issue I had to deal with in this dispute was whether the Applicant’s proposed correction should be allowed.

Background

4 The Applicant in the present case is a company incorporated in Japan. They filed a patent application numbered 2018-089867 in Japan (“Japanese Patent Application”).¹ On 7 May 2019, the Applicant filed a Patent Cooperation Treaty (“PCT”) application numbered PCT/JP2019/018201 (the “PCT

¹ Applicant’s Bundle of Documents at p 5.

Application”).² Later, on 5 November 2020, the PCT Application entered the National Phase in Singapore as Singapore Patent Application No 11202011003T (the “Subject Application”).³ Both the PCT application and the Subject Application claims priority of the Japanese Patent Application.

5 Subsequently, the Applicant discovered an error in Table 7 of the verified English translation of the PCT Application that had been filed with the Intellectual Property Office of Singapore (“IPOS”). The Applicant’s patent agent, Marks & Clerk Singapore LLP (“M&C”) filed Form CM4 with the Registry of Patents (the “Registry”), requesting to correct the said error under Rule 91(1) of the Patents Rules (Cap 221, R 1, 2007 Rev Ed) (“the Patents Rules”) on 1 April 2021.⁴ Apart from Form CM4, the following documents were also submitted to the Registry:⁵

- (a) A cover letter from M&C explaining the reasons for the correction (the “Cover Letter”).
- (b) A marked up copy of pages 131 and 131a of the specification of the Subject Application showing the proposed corrections to Table 7.
- (c) A clean copy of the replacement for page 131 of the specification of the Subject Application.
- (d) A copy of the full Japanese Patent Application.

² Applicant’s Written Submissions at para 2.1.2.

³ Applicant’s Bundle of Documents at p 7.

⁴ Applicant’s Written Submissions at para 2.2.1, Respondent’s Bundle of Documents at pp 9 – 12.

⁵ Applicant’s Written Submissions at para 2.2.1, Respondent’s Bundle of Documents at pp 8 – 242.

- (e) A verified English translation of pages 88 and 89 of the Japanese Patent Application showing the correct Tables 6 and 7.

6 After a reminder sent by M&C, IPOS, acting in its capacity as the Registrar, issued a final decision on 5 October 2021 stating that it was rejecting the request to make the proposed corrections for the following reasons:⁶

- (a) The two-step test as set out in *Dukhovskoi's Applications* [1985] RPC 8 (“*Dukhovskoi*”) was applicable: first, whether it is clear that there was an error; and second, if so, whether it is clear that what is now offered is what was originally intended.

- (b) The first step in *Dukhovskoi* was satisfied as there were clearly errors in Table 7.

- (c) However, the second step in *Dukhovskoi* was not satisfied – the proposed correction could not be allowed as it is not immediately evident to the skilled addressee that what is now offered is what was originally intended. It was not always the case that when an application claims priority from a foreign application, one would expect the application to be identical to the priority application.

- (d) Further, while the skilled person would think that it was more likely than not that the intention was for Table 7 of the Subject Application to be identical to that of the Japanese Patent Application, that was insufficient to meet the requirement for a correction to be made under r 91(2) of the Patent Rules.

⁶ Applicant’s Written Submissions at para 2.2.2, Respondent’s Bundle of Documents at pp 254 – 256.

7 The Applicant thus filed the present appeal seeking an order that the Respondent’s decision be reversed in part, specifically that the proposed correction to Table 7 of the Subject Application be allowed.⁷ At the Pre-Trial Conference held on 7 December 2021, the Senior Assistant Registrar (“SAR”) directed the Respondent’s counsel to update the court on who the proper party to TA 24 was.⁸ After several rounds of correspondence, parties were directed to consolidate their respective arguments on the issue and include them in the written submissions for the hearing before me on 7 March 2022.⁹

8 There were therefore two issues before me in the present appeal:

- (a) Is the IPOS, acting in its official capacity as the Registrar, the proper party to be named as the Respondent in TA 24?¹⁰
- (b) Should the proposed correction be allowed?

9 I heard parties on 7 March 2022 and found that the Registrar, and not IPOS, was the proper party to the present appeal. I further allowed the Applicant’s appeal and allowed the proposed correction. These are the reasons for my decision.

Whether IPOS or the Registrar should be the proper party to the present appeal

10 The Applicant argued that the IPOS, being a body corporate, is capable of being sued in its own name and that any relief sought can only be granted by

⁷ Applicant Written Submissions at para 2.2.4.

⁸ Applicant Written Submissions at para 2.3.1.

⁹ Applicant Written Submissions at para 2.3.1.

¹⁰ Applicant Written Submissions at para 2.3.2.

the IPOS acting in its official capacity as the Registrar. In support of their case, they cite the decision in *Axis Law Corp v Intellectual Property Office of Singapore* [2016] 4 SLR 554 (“*Axis*”) for the proposition that the proper party to be named as the Respondent in TA 24 is the IPOS.

11 The Respondent, however, takes the position that it is the Registrar, being the officer upon whom the power to correct patent applications was conferred by Parliament, and who had made the decision against which the Applicant appeals against, who should be the proper Respondent in TA 24.¹¹ The Respondent further submits that *Axis* does not stand for the proposition that the proper party to the present proceedings should be IPOS because in that case, the question before the court was whether IPOS or the Attorney General (“AG”) was the proper party, as opposed to whether IPOS or the Registrar of Trade Marks (in that case) was the proper party.¹²

12 Having considered parties’ submissions, I was of the view that it was the Registrar, and not IPOS, who was the proper party to the present proceedings.

13 In *Axis*, the plaintiff sought to invalidate and revoke the “AXIS” trade mark which was registered and held by Axis Intellectual Capital Pte Ltd (the “Registered Proprietor”). In proceedings before the Principal Assistant Registrar of Trade Marks of IPOS (the “PAR”), the plaintiff applied for leave to amend its statement of grounds (“SOG”) which had been submitted as part of its application to invalidate and revoke the trade mark. Because amendments were sought after pleadings were deemed closed, the PAR directed the plaintiff to seek the Registered Proprietor’s consent. When said consent was not

¹¹ Respondent Written Submissions at para 5.

¹² Respondent Written Submissions at para 30.

forthcoming, the PAR directed parties to file written submissions on the proposed amendments. A week before parties were due to file the written submissions, the plaintiff filed a revised version of the proposed amendments in which they sought to include an additional ground of revocation.

14 After considering parties’ written submissions, the PAR dismissed the application for leave to amend the SOG. The plaintiff subsequently sought leave to apply for a quashing order against the PAR’s decision and for a mandatory order directing the PAR to allow amendments to the SOG on grounds that the PAR’s decision suffered from illegality and irrationality.

15 As the plaintiff had initially brought the application for judicial review against the AG instead of IPOS, the issue as to who the proper party to the application for judicial review arose. At the first pre-trial conference before the Assistant Registrar, the AG objected to being named as a party to the judicial review proceedings, and argued that the proper party to be sued was IPOS as: a) the relief the plaintiff sought could only be performed by IPOS, and b) IPOS was a statutory board and a separate legal entity from the Government (*Axis* at [12]).

16 After the first pre-trial conference, the AG wrote to the plaintiff, asking them to explain their position and invited them to amend the originating summons. No reply was forthcoming, but at the second pre-trial conference, the plaintiff explained (*Axis* at [14]) that it named the AG as a party pursuant to s 19(3) of the Government Proceedings Act (Cap 121, 1985 Rev Ed) (“GPA”) which states:

Civil proceedings against the Government shall be instituted against the appropriate authorised Government department, or, if none of the authorised Government departments is appropriate or the person instituting the proceedings has any

reasonable doubt whether any and if so which of those departments is appropriate, against the Attorney-General.

17 The AG, however, took the view that s 19(3) of the GPA did not apply as IPOS was not a government department within the meaning of s 19(3) (*Axis* at [17]). Rather, IPOS, being a body corporate established under the Intellectual Property Office of Singapore Act (Cap 140, 2002 Rev Ed), was capable of suing and being sued in its own name. Further, being a statutory board, IPOS was legally separate from the Government in identity and representation. The AG also took the view (*Axis* at [18]) that the requirement to serve applications for leave on the AG under O 53 r 1(3) of the Rules of Court (Cap 322, R 5, 2014 Rev Ed) did not make the AG a party to all judicial review proceedings.

18 After considering the various arguments canvassed by parties, Tay Yong Kwang J, as he then was, held (*Axis* at [20]) that IPOS was the proper defendant to the proceedings because it was a statutory board capable of suing and being sued in its own name.

19 It is clear from the *Axis* case, that neither party in that case considered whether the Registrar of Trade Marks should have been a party to the proceedings. The main contention between the parties focused on whether it was the AG, or IPOS, who should be a proper party to the suit. This was because the plaintiff in that case had originally brought judicial review proceedings against the AG, and not IPOS. As far as I can tell, neither party in *Axis* made submissions on whether it was the Registrar of Trade Marks or IPOS who should have been the proper party to the judicial review proceedings.

20 I therefore respectfully decline to follow the holding in *Axis*. It is the Registrar, and not IPOS which is the proper party to the present proceedings.

This is made clear by the following statutory provisions. First, s 106 of the Patents Act draws a distinction between IPOS and the Registrar:

Immunity of Office, its officers and Examiners

106. The Office, any officer of the Registry and any Examiner shall not —

- (a) be taken to warrant the validity of any patent granted under this Act or any treaty to which Singapore is a party;
- (b) incur any liability by reason of or in connection with any examination or investigation required or authorised by this Act or any such treaty or any report or other proceedings consequent on any such examination or investigation; or
- (c) incur any liability by reason of an incorrect entry in the register of patent agents or the register of foreign patent agents maintained under Part 19.

21 Section 2(1) of the Patents Act defines the “Office” to mean the IPOS whereas s 4 states that the Registrar is an officer of the Registry. It is therefore clear from s 106 that the Act envisions that legal proceedings may be brought against either the IPOS or the Registrar, as distinct entities, in the exercise of their respective powers.

22 This distinction between the IPOS and the Registrar is similarly reflected in ss 34(2) and 34(3) of the Intellectual Property Office of Singapore Act 2001 (“IPOS Act”) which states:

Proceedings conducted by officers of Office

(2) Despite any written law, **a legal officer of the Office** who has been admitted as an advocate and solicitor under the Legal Profession Act 1966 may —

- (a) appear in any civil proceedings **involving the Office or any Registrar** in the performance of the legal officer’s functions or duties under any written law; and

(b) make and do all acts and applications in respect of such proceedings on behalf of the Office or any Registrar.

(3) For the purposes of this section, “**Registrar**” means the **Registrar of Designs** referred to in section 49 of the Registered Designs Act 2000, the **Registrar of Geographical Indications** referred to in section 17 of the Geographical Indications Act 2014, the **Registrar of Patents** referred to in section 4 of the Patents Act 1994, the **Registrar of Trade Marks** referred to in section 62 of the Trade Marks Act 1998, or the principal officer administering the system for the protection of any other intellectual property under any other written law.

[emphasis in bold]

23 Under s 2 of the IPOS Act, “Office” is defined to mean IPOS. As defined in s 34(3), “Registrar” refers to either the Registrar of Designs, the Registrar of Geographical Indications, the Registrar of Patents or the Registrar of Trade Marks. Therefore, references in s 34(2) of the IPOS Act to “proceedings involving the Office or any Registrar” clearly shows, as the respondent rightly points out,¹³ that the IPOS Act contemplates that civil proceedings may either involve the IPOS or the Registrar.

24 That the IPOS and the Registrar have different powers is supported by ss 103(2) and 107 of the Patents Act. Under s 103(2), the IPOS may, with the approval of the Minister, make regulations prescribing offences which may be compounded. Under s 107 (reproduced above at [2]), the Registrar has the power to correct errors in patent applications. Section 90 of the Patents Act also provides that decisions of the Registrar may be appealed:

Appeals from Registrar

90.—(1) An appeal shall lie to the court **from any decision of the Registrar** under this Act or the rules except any of the following decisions:

¹³ Respondent Written Submissions at para 20.

- (a) a decision falling within section 25(7);
- (b) a decision under section 27(3) to omit any matter from a specification;
- (c) a decision to give directions under section 33(1) or (2);
- (ca) a decision under section 38A(4) not to grant a request for re-examination;
- (cb) a decision under section 38A not to revoke a patent;
- (d) a decision under the rules which is excepted by the rules from the right of appeal conferred by this section.

(2) For the purpose of hearing appeals under this section, the court may consist of one or more judges of the court in accordance with directions given by or on behalf of the Chief Justice.

(3) An appeal shall not lie to the appellate court from a decision of the court on appeal **from a decision of the Registrar** under this Act or the rules —

- (a) except where the decision of the Registrar was given under section 20, 38, 47, 67, 80, 81 or 83; or
- (b) except where the ground of appeal is that the decision of the court is wrong in law,

but an appeal shall only lie to the appellate court under this section if leave to appeal is given by the appellate court.

[emphasis in bold]

25 In the present case, the Applicant appeals against a decision of the Registrar made pursuant to s 107(1) of the Patents Act, which confers upon the Registrar the power to correct errors in patent applications. Here, it was the Registrar who, having the power to make the correction to the patent application, refused to do so. The Registrar provided reasons for his decision which the Applicant now appeal against. They say the Registrar erred, and the correction should be allowed. Therefore, it follows that the Registrar who made the decision in the exercise of his powers under the Patents Act, should be the proper party to the present appeal.

26 As a final point, s 91(2) of the Patents Act states:

General powers of court

... (2) In all proceedings before the court under this Act, the **costs of the Registrar** are in the discretion of the court, **but the Registrar is not to be ordered** to pay the costs of any other of the parties.

[emphasis in bold]

27 This provision clearly envisions that the Registrar may be made party to proceedings and provides the appropriate costs order for such an event. When read together with s 90, the effect is that the Registrar shall be a party to any appeal made against his decision.

28 Having found that it was the Registrar which should be the proper party to the proceedings, I granted the Applicant leave to amend the OS and substitute the Registrar as the Respondent.

Whether the proposed correction should be allowed

29 I turn now to the substantive issue of whether the proposed correction should be allowed. As stated above (at [2]), s 107 of the Patents Act confers on the Registrar, the power to grant such a correction. Apart from that provision, Rule 91 of the Patents Rules contains further formalities and substantive conditions that must be fulfilled before a correction request may be granted: see *Novartis (Singapore) Pte Ltd v Bristol-Myers Squibb Pharma Co* [2018] 3 SLR 1194 at [73]. In the present case, because the proposed correction involves the description of the invention which is part of the patent specification,¹⁴ Rule 91(2) is applicable:

¹⁴ Applicant Written Submissions at para 4.1.2.

Correction of errors in patents and applications

...(2) Where such a request relates to a specification, no correction shall be made therein **unless the correction is obvious** in the sense that it is immediately evident that **nothing else would have been intended than what is offered** as the correction.

[emphasis in bold]

30 A plain reading of r 91(2) demonstrates that a strict approach is taken to the correction of errors in patent specifications. As noted in *Lonza Biologics Tuas Pte Ltd v Genpharm International Inc* [2014] SGIPOS 9 (“Lonza”) at [5], the rationale for this strict approach to the correction of patent specifications is:

Correction is different to amendment. In particular, Section 84 states that an amendment cannot add subject matter or in the case of a patent, extend the protection conferred. The limitations of Section 84 apply only to amendments under sections 31, 38(1), 81 and 83. In contrast **Section 107 has no such restriction, and as a consequence a correction can potentially result in the specification disclosing new matter or extending the scope of protection of a patent** (Rock Shing Industrial Ltd v Braun AG BL O/138/94). Furthermore, **once the correction is made the document is considered to have always been in the state in which it is after correction.** In theory this can change the scope of the granted patent and make something an infringement that was not an infringement prior to the correction, but this is tempered by the requirement that it must be immediately evident that nothing else would have been intended than what is offered as the correction. Thus a skilled person reading the document would immediately ascertain that there was an error and understand what was intended. In effect there would be no new disclosure provided the error is truly obvious. **Nevertheless, the implications of such corrections necessitate a stringent consideration of whether they are obvious.**

[emphasis in bold]

31 The Applicant, being the one seeking the exercise of the Registrar’s powers to make the correction, bears the burden of proof to show that the correction is justified: *Lonza* at [1]–[2] citing Jeffrey Pinsler, *Evidence and the Litigation Process* (LexisNexis, 4th Ed, 2013) at [12.007].

32 What then is the applicable test in deciding whether the correction should be made? UK practice adopts the two-step test in *Dukhovskoi: Lonza* at [7]. First, there must clearly be an error, and second, if there is an error, it must be clear that what is now offered is what was originally intended. Given that the corresponding provisions in the UK Patents Act 1977 (“UK Patents Act”) and the UK Patents Rules 2007, viz, s 117 and Rule 105(3) are essentially *in pari materia* with s 107 of our Patents Act and Rule 91 of the Patents Rules, I am of the view that the two-step test in *Dukhovskoi* is applicable: see *Lonza* at [6].

33 Here, both the Applicant and Respondent agree that the first step of the test in *Dukhovskoi* is satisfied given that the Registrar had acknowledged that there was a clear error in Table 7 of the verified English translation of the PCT application.¹⁵ What is in dispute is whether the second step in *Dukhovskoi* has been satisfied.

34 The Applicant argues that the second step of the *Dukhovskoi* test has been satisfied because the proposed correction is obvious – following the skilled person’s reference to the Japanese Patent Application, it is immediately evident that nothing else could have been intended other than that which is offered as the correction.¹⁶

35 In response, the Respondent argues that the proposed correction was not obvious because the Applicant did not canvass any justifications in either its Cover Letter or Form CM4 to explain why it would be immediately evident to the skilled person that Table 7 of the specification would contain the same

¹⁵ Respondent Written Submissions at para 37, Applicant Written Submissions at para 5.1.1.

¹⁶ Applicant Written Submissions at para 5.2.

information as that found in Table 7 of the priority application.¹⁷ A mere discrepancy between the specification of a patent application and its priority document does not establish an error in the specification, let alone the correction to be made.¹⁸ One could not make the assumption that the proposed corrections to Table 7 of the Subject Application would contain the same information as that found in Table 7 of the priority application because several alternative corrections to Table 7 could be envisaged by the skilled person.¹⁹

36 I turn now to consider whether reference can be made to the priority documents in assessing whether nothing else other than the proposed corrections could have been intended, and if such reference could be made, whether that was indeed the conclusion reached.

37 In *Berg's Patent* BL O/235/05 (“*Berg*”), the applicant was notified that an incorrect specification had been filed with the international application. The applicant requested, pursuant to s 117 of the UK Patents Act, which is *in pari materia* with s 107 of our Patents Act, a replacement of the incorrectly filed specification with the specification of an earlier application that had been filed in the US (the “priority application”). In rejecting the application, the Hearing Officer stated (at [21]):

But I do not believe it would be immediately evident to the notional reader that nothing else could have been intended than to file an existing document, namely the priority application, as the specification. It may be that a notional reader, after examining the priority application and noting its completeness (in the sense that it has a set of claims and a description related to the set of claims), would think it more likely than not that the intention was to use an existing

¹⁷ Respondent Written Submissions at para 90.

¹⁸ Respondent Written Submissions at para 87

¹⁹ Respondent Written Submissions at para 91.

document as the specification for the application in suit and that the existing document to be used was the priority application. But the notional reader would be aware that **it is by no means always the case that an existing document, in particular the priority application, was used as the specification of an application claiming foreign priority, even if the priority application looked like a complete document.**

[emphasis in bold]

38 Similarly, in *Intermec, Inc's Application* BL O/769/18 (“*Intermec*”), the applicant filed a patent application GB1716996.2 which claimed priority from US application 15/343553. The Examiner notified the applicant’s counsel that an incorrect set of drawings appeared to have been filed. Counsel for the applicant subsequently filed a new specification which was identical to that of the US priority application and requested that the new specification be considered a correction under s 117 of the UK Patents Act. The Examiner refused the request, and the case went before the Hearing Officer who disallowed the proposed correction. The Hearing Officer took the view (at [16] and [18]) that:

...[A] fully-informed and inquisitive skilled reader would, upon discovering that the error existed, **be fully aware that replacing the description as filed with the description of the priority application would correct the error. Such a reader would also be aware that an application may differ, sometimes significantly, from its priority application. To my mind, the existence of these two distinct possibilities creates a discrepancy which fails to meet the second part of the two-step test.** It cannot be said, with certainty, that what is now offered is what was originally intended. It may be likely, but that does not equate to the level of certainty required by Rule 105(3)...

... I note that the wording of s.117(1) is concerned with correcting errors of translation or transcription, clerical errors or mistakes in a specification of a patent. To my mind, the error in this case is not of the same sort. It appears that **the attorney has filed the wrong set of documents as a whole.** As such, I am not totally convinced that s.117(1) is even intended to apply to such an error.

[emphasis in bold]

39 The Applicant cites the case of *Rieter/Textile Machines* [1996] EPOR 72 (“*Rieter*”) for the proposition that regard may be had to a priority document to determine the applicant’s intention when filing a patent application.²⁰ In that case, the appellants had filed a request for the grant of a European patent for a ‘heating method in textile machines’, claiming priority of 29 August 1988 from Swiss patent application No. CH-03 204/88-4 under the Convention on the Grant of European Patents (5th Ed, 1989) (“the EPC”). The drawings, however, did not correspond with the description of the invention, but corresponded instead, with the drawings in the priority document. The appellants requested a correction under Rule 88 of the Implementing Regulations to the Convention on the Grant of European Patents (European Patent Convention) (5th Ed, 1989) (“the EPC Regulations”) whereby the description, claims and abstract as filed would be replaced with a text identical to that in the priority document. In allowing the appeal, the German Technical Board of Appeal was of the view (*Rieter* at [10]) that it was immediately evident that nothing else would have been intended than what was offered as the correction. The appellants had obviously wished to file a patent application in keeping with Swiss patent application No. 03 204/88-4 whose priority was claimed, and this could be deduced from the request for the grant of a European patent.

40 However, the editor’s note to the case, which is an English translation of the official German text, states that: the reasoning in this decision was likely to be examined in the pending case of *AIOTECH Deutschland GmbH G 2/95* (“*Aiotech*”) as the following point of law had been referred to the Enlarged Board of Appeal. The question was: “Can the complete documents forming the

²⁰ Respondent Written Submissions at para 5.2.4.

description claims and drawings be replaced by way of a correction under Rule 88 EPC by other documents which the applicant intended to file with his request for grant?”. This question was referred to the Enlarged Board of Appeal due to the divergence of opinions in *Rieter* and the decision in J 21/85 (OJ EPO 1986, 117), which was the subject of the appeal in *Aiotech*.

41 The Enlarged Board of Appeal in *Aiotech* answered the question in the negative – the complete documents forming a European patent application (*ie*, the description, claims and drawings) could not be replaced by way of a correction under Rule 88 EPC Regulations by other documents which the applicant intended to file with his request for grant. The Enlarged Board of Appeal reasoned that:

The interpretation of Rule 88, second sentence, EPC must therefore be in accord with Article 123(2) EPC. This means that a correction under Rule 88 EPC is thus bound by Article 123(2) EPC (point 1 above), in so far as it relates to the content of the European patent application as filed (G 3/89, loc. cit.; Reasons, 1.3). Such a correction may therefore be made only within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the date of filing, from the whole of the documents forming the content of the European patent application (G 3/89, loc. cit.; Reasons, 3). The content of the European patent application is formed by the parts of the application which determine the disclosure of the invention, namely the description, claims and drawings (G 3/89, loc. cit.; Reasons, 1.4). **As a result of the prohibition of extension under Article 123(2) EPC, documents other than the description, claims and drawings may only be used in so far as they are sufficient for proving the common general knowledge on the date of filing** (G 3/89, loc. cit.; Reasons, 7). **On the other hand, documents not meeting this condition may not be used for a correction even if they were filed together with the European patent application. These include, inter alia, priority documents, the abstract and the like** (G 3/89, loc. cit.; Reasons, 7). Since infringement of the prohibition of extension under Article 123(2) EPC is a ground for both opposition (Article 100(c) EPC) and revocation (Article 138(1)(c) EPC), this interpretation of Rule 88, second sentence,

EPC goes some way to ensuring the legal validity of a granted European patent (G 3/89, loc. cit.; Reasons, 1.6).

[emphasis in bold]

42 Article 123(2) EPC provides that the European Patent Application or European Patent may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed. The Enlarged Board of Appeal in *Aiotech* therefore made it clear that any documents, such as priority documents, which did not meet the requirement imposed by Art 123(2) EPC, could not be used for corrections made pursuant to Rule 88 EPC Regulations.

43 It is therefore clear from the aforementioned authorities that where the correction request involves the replacement of the entire specification, no reference can be made to the priority document to show that it was immediately obvious that nothing else would have been intended than what was filed as the correction.

44 The Respondent, however, recognised that the present case did not involve the replacement of the entire specification. They argued that the principle drawn from cases such as *Berg*, that a discrepancy between the specification of an application and that of its priority application does not mean that it is immediately evident that the intention was for the former to correspond to the latter, is equally applicable to requests for correction of a part of the specification.²¹

45 I disagree. In my view, where the proposed correction does not involve the replacement of the entire specification, reference can be made to the priority

²¹ Respondent Written Submissions at paras 57 – 58.

documents in determining whether nothing else other than the proposed correction was intended. For instance, in *Caisse Palette Diffusion/Correction of drawings* [1991] EPOR 521 (“*Caisse*”), the appellant filed with the European Patent Office, a European patent application which included seven drawings. Three drawings, however, were missing from the application as filed, but was referred to in the application and contained in a copy of the priority document. As the appellant’s request for correction of the application under Rule 88 EPC Regulations by filing the missing drawings was rejected by the Receiving Section, the case went before the French Legal Board of Appeal. There, the Board, in allowing the appeal, noted (*Caisse* at [6]–[7]) that while the description filed expressly mentioned Figures 8 – 10, there was no corresponding drawing, and this could only be due to error which was confirmed by the copy of the priority document which showed the drawing containing the missing figures.

46 Similarly, in *Tragen’s Application* BL O/096/90 (“*Tragen*”), the Principal Examiner held that, in principle, if an error was present in a specification, it could be corrected by reference to the priority document. There was, however, a high evidentiary burden placed on the applicant to show that nothing else other than the proposed correction would have been intended. In particular, one had to consider the nature of the omission and the relationship of the two documents to each other. The Principal Examiner refused the application for correction because, upon comparing the specification with that of the priority document, the differences between both documents were “the result of a conscious act of judgment by the drafter rather than the result of an error”. In light of this, and in the absence of any other evidence, the Principal Examiner opined that it could only be assumed that the words used by the drafter of the present application accurately reflected his intentions, and that the priority document did not afford any guidance at all as to the intentions of the drafter.

47 In ascertaining whether it was immediately obvious to the skilled observer that nothing else apart from the proposed corrections to Table 7 would have been intended, I therefore consider the nature of the error and the relationship between the Subject Application and the priority application.

48 Here, the nature of the error in the present case is slightly different from cases such as *Dukhovskoi*. In that case, the specifications of a patent application in Russian were translated into English. These specifications concerned a rubber surface wetted under vacuum with “carbon tetrafluoride”. The translator, relying on one dictionary, translated the relevant Russian word as “carbon tetrafluoride”. The correct translation, however, according to another reputable dictionary, should have been “fluorocarbon”. This was because wetting the rubber surface with carbon tetrafluoride was clearly impossible given that it was a gas with a boiling point of -128 degrees Celsius. The applicants made a request to correct this error of translation by replacing the words “carbon tetrafluoride”, which was used in the specification, with “fluorocarbon”, and sought to justify this correction by reference to the mistranslated document which was not identical with the priority document, which had not previously been available to the Patent Office. The Principal Examiner, who was acting for the Comptroller, refused to make the correction, and parties appealed.

49 Whitford J, who heard the appeal, took the view that the correction ought to be allowed, subject to the Comptroller being able to satisfy themselves that in truth, “the word in the Russian original from which the English translation of the specification of the application was made can only be sensibly translated in the sense now claimed”: *Dukhovskoi* at p 16.

50 In contrast, the error in the Subject Application relates to data that is included in the specification. Here, the patent specification first describes the

invention – subsequently, it goes on to describe the invention in more detail by making reference to various chemical compounds.²² After listing these various compounds, and the manner in which they are prepared, the specification then provides, in the form of tables, instrumental analytical data such as mass spectrometric and elemental analytical data.²³ The error is found in Table 7 which contains this instrumental analytical data. This, to my mind, is a critical difference. The concern in cases such as *Dukhovskoi*, where the error was in the substantive content of the specification, rather than data that was included in the specification, was that it may not be immediately obvious to a skilled observer that the proposed correction was what was initially intended. After all, as noted in *Tragen*, any differences between the priority application and the present specification may be the result of a conscious act of judgment by the drafter rather than the result of an error. Where the difference relates to data included in the specification itself, in my view, it is more likely to be the result of an error, rather than a conscious act of judgment by the drafter.

51 Because the error in this case related to data that was presented in the specification, I was satisfied that it would have been immediately obvious to the skilled observer, looking at the priority document, that nothing else other than the proposed correction could have been intended. The error in Table 7 was quite clearly, the result of the wrong set of data having been copied over. Therefore, the data that should be in Table 7 was exactly that which was found in the priority document.

²² Applicant's Bundle of Documents at p 71.

²³ Applicant's Bundle of Documents at p 134.

Conclusion

52 In the circumstances, I was of the view that the application for correction should be allowed as the proposed corrections to Table 7 of the PCT would be obvious to the skilled addressee. I therefore allowed the appeal.

53 As for costs, s 91(2) of the Patents Act (see [26] above) states that the Registrar is not to be ordered to pay the costs of any of the other parties. I therefore made no order as to costs.

54 Finally, it remains for me to express my profound gratitude to both counsel for their clear and cogent submissions which greatly assisted me.

Lee Seiu Kin
Judge of the High Court

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