

IPOS Registrar's Decision Overturned – Appeal to Correct Error in Patent Application Allowed

Case Update: Nippon Shinyaku Co, Ltd v Registrar of Patents [2022] SGHC 164

Nippon Shinyaku Co, Ltd (the “**Applicant**”) commenced proceedings against the Intellectual Property Office of Singapore (“**IPOS**”) in an appeal against the Registrar of Patents’ decision to refuse a proposed correction to the specification of a Singapore patent application. The IPOS Registrar of Patents tends to be quite strict in allowing corrections, and in this case, the Registrar’s decision to refuse the correction was overturned by the High Court.

The High Court considered the following issues: (1) whether IPOS or the Registrar should be the proper party to the appeal; and (2) whether the proposed correction should be allowed. In allowing the appeal, the High Court held that the Registrar is the proper respondent, and that the proposed correction should be allowed on the facts of the case.

Background

The Applicant is a company incorporated in Japan. They filed a patent application in Japan (“**Japanese Patent Application**”), and subsequently filed a Patent Cooperation Treaty (“**PCT**”) application (the “**PCT Application**”) which entered the National Phase in Singapore. Both the PCT Application and the Singapore national phase application (the “**Subject Application**”) claim priority of the Japanese Patent Application.

Upon discovering an error in Table 7 of the verified English translation of the PCT Application that had been filed with IPOS, the Applicant requested to correct said error under rule 91(1) of the Patents Rules. IPOS, acting in its capacity as the Registrar, rejected the request for correction on the basis that it was not immediately evident to the skilled addressee that what is now offered is what was originally intended.

The Applicant filed an appeal seeking that the proposed correction to Table 7 of the Subject Application be allowed.

Decision

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

The Applicant argued that IPOS is the proper party to be named as the Respondent in the present appeal, citing the decision in *Axis Law Corp v Intellectual Property Office of Singapore* [2016] 4 SLR 554 (“*Axis*”) in support of their case. Since the issue in *Axis* was whether IPOS or the Attorney General was the proper party, and it was not considered whether the Registrar of Trade Marks should have been a party to the proceedings, the High Court declined to follow the holding in *Axis*.

The High Court concluded that it is the Registrar, and not IPOS, which is the proper party to the present appeal. This decision was based on the following statutory provisions:

- Section 106 of the Patents Act and sections 34(2) and 34(3) of the IPOS Act draw a distinction between IPOS and the Registrar. It was found that these statutes envision that legal proceedings may be brought against either IPOS or the Registrar.
- Section 103(2) of the Patents Act provides that IPOS may make regulations to prescribe offences which may be compounded, and section 107 of the Patents Act provides that the Registrar may correct errors in patent applications. These provisions were deemed to support the conclusion that IPOS and the Registrar have different powers.
- Section 90 of the Patents Act provides that decisions of the Registrar may be appealed.
- Section 91(2) of the Patents Act provides that “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”. This provision, when read together with section 90, was considered to envision that the Registrar may be a party to any appeal made against his decision.

The High Court noted that, since the Applicant is appealing against a decision of the Registrar where the Registrar, having the power to make the correction to the patent application, refused to do so, it follows that the Registrar should be the proper party to the present appeal. The Applicant was granted leave to amend the name of the Respondent from IPOS to the Registrar.

Whether the proposed correction should be allowed

The more interesting aspect of this decision is whether the proposed correction should be allowed. In this case, the error relates to Table 7 of the Subject Application containing the same information as Table 6, whereas Tables 6 and 7 of the priority Japanese Patent Application contain different information. The Applicant’s proposed correction was to replace Table 7 of the Subject Application with Table 7 of the priority Japanese Patent Application. As the proposed correction involves the specification, the condition stipulated in rule 91(2) of the Patents Rules is applicable. Rule 91(2) provides that no correction would be allowed “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”.

The applicable test in deciding whether the correction should be made is the two-step test as set out in *Dukhovskoi’s Applications* [1985] RPC 8 (“**Dukhovskoi**”). 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. Both the Applicant and Respondent agreed that the first step of the test in *Dukhovskoi* was satisfied, and the IPOS Registrar had also found that there was an error.

With respect to the second step, the Applicant argued that following the skilled person’s reference to the priority Japanese Patent Application, it is immediately evident that nothing else could have been intended other than that which is offered as the correction. The Respondent argued that the proposed correction was not obvious because 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. In the Registrar’s decision, the Registrar had found that it is not always the case that the application filed is identical to the priority application. There may be omissions or additions in the application with respect to the foreign priority application. Hence, it was not obvious that nothing other than the proposed correction was intended.



The High Court however held a different view from the Registrar based on the following considerations:

First, the High Court considered whether reference can be made to the priority documents in assessing whether nothing else other than the proposed corrections could have been intended. Citing *Caisse Palette Diffusion/Correction of drawings* [1991] EPOR 521 and *Tragen's Application* BL O/096/90, the High Court found that such reference can be made where the proposed correction does not involve the replacement of the entire specification.

Next, the High Court considered whether it was immediately obvious to the skilled observer that nothing else apart from the proposed corrections to Table 7 would have been intended. As the error in this case related to data that was presented in the specification, and was not an error in the substantive content of the specification, the High Court found 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. Thus, the data that should be in Table 7 was exactly that which was found in the priority document.

The High Court concluded that the application for correction should be allowed as the proposed corrections to Table 7 would be obvious to the skilled addressee. The appeal was allowed.

Comments

This decision provides clarity on the issue of the proper respondent to be named when appealing to the High Court from a decision made by a Registrar. Whether it is the Registrar or IPOS who should be sued would depend on whether the decision is one made by the Registrar or by IPOS in the exercise of their respective powers.

It is now clear that, where a proposed correction does not involve the replacement of the entire specification, reference can be made to the priority documents in assessing whether nothing else other than the proposed corrections could have been intended. As to whether it is immediately evident that nothing else apart from the proposed correction would have been intended, this would be ascertained from the facts of the case. However, the High Court appear to take a more lenient approach when interpreting whether the proposed correction was the only one intended.

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