

Intellectual Property Office of Singapore Case Summary: Genpharm International Inc v Lonza Biologics Tuas Pte Ltd [2014] SGIPOS 9

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This case deals with an application to correct the specifications of Patent No. 51905 in the course of revocation proceedings. The statutory provisions dealing with corrections are set out in Section 107 of the Patents Act and Rule 91 of the Patents Rules.

Correction is the alteration of a document so that it may better express the intention the drafter had at the time of drafting. In contrast to amendments, a correction may result in the document disclosing new matter or extending the scope of the patent (*Rock Shing Industrial Ltd v Braun BL O/138/94*). Once a correction is made the document is considered to have always been in the state in which it is after correction. This means that a correction could result in something becoming an infringement which was not previously an infringement. However Rule 91 requires that it must be immediately evident that nothing else would have been intended than what is offered as the correction, so that the skilled person reading the document would immediately ascertain that there was an error and correct it. There would therefore be no new disclosure, but the implications of such corrections necessitate a stringent consideration to ensure they are indeed obvious.

There has been no previous published decision by the Courts or the Registrar of Patents on these provisions. This decision is noteworthy as it clearly endorses the two-step test for assessing corrections (*Dukhovskoi's Application*, [1985] RPC 8), as used in the UK.

In order to meet the requirements of the first step, it must be apparent on the face of the document that there is an error. The standard of proof in this regard is the balance of probabilities; i.e., whether on the balance of probabilities the reader would conclude that there was an error (*R. v the Comptroller-General of Patents ex parte Celltech Ltd* [1991] RPC 475). This consideration is made through the eyes of the skilled addressee, the common general knowledge in the art and the skilled person's understanding of the document. Certain corrections may require no technical expertise in order to ascertain that there is indeed an error, but if the correction relates to a technical matter then evidence may be required from a skilled person to determine what he would have understood the patentee to mean from the language used. Furthermore, the skilled person may have regard to textbooks and the like in order to understand the document, but this does not extend to using extrinsic material in order to establish that there is an error – if such material is required then an error is unlikely to be an obvious one.

Once it has been determined that there is an error, the proposed correction must be "immediately evident" (*Dukhovskoi's Application*). This is a strict requirement – the skilled person must understand that nothing other than the proposed correction was intended. The standard in this respect is not "on balance of probabilities" or whether the proposed correction is the "most likely" solution to the skilled reader – there must be only one feasible correction. To that end, if several alternative corrections may be envisaged then the proposed correction cannot be considered immediately evident. If the document makes technical and linguistic sense, it cannot be concluded that only one other meaning was intended (*ex parte Celltech*).

In the present case, the evidence established that certain errors were obvious and therefore they could be allowed. However in relation to some of the other corrections sought, the evidence did not establish that there was an obvious error, or where there was an obvious error, the evidence showed that there was more than one feasible correction. These corrections were refused.

Disclaimer: The above is provided to assist in the understanding of the Registrar's grounds of decision. It is not intended to be a substitute for the reasons of the Registrar. The full grounds of decision can be found at <http://www.ipos.gov.sg/Services/HearingsandMediation/LegalDecisions/2014.aspx>.