IN THE HIGH COURT OF THE REPUBLIC OF SINGAPORE

[2017] SGHC 322

Originating Summons No 1002 of 2016

Between

NOVARTIS (SINGAPORE) PTE LTD

… Applicant

And

BRISTOL-MYERS SQUIBB PHARMA COMPANY

… Respondent

JUDGMENT

[Patents and inventions] — [Rectification of register]

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Novartis (Singapore) Pte Ltd
v
Bristol-Myers Squibb Pharma Co

[2017] SGHC 322

High Court — Originating Summons No 1002 of 2016
George Wei J
4 May 2017

20 December 2017 Judgment reserved.

George Wei J:

Introduction

1 The applicant is Novartis (Singapore) Pte Ltd ("Novartis"). The respondent is Bristol-Myers Squibb Pharma Company ("Bristol-Myers"), the proprietor of five patents under the Patents Act (Cap 221, 2005 Rev Ed) ("the Singapore Patents"). After receiving notice that Novartis was applying for a product licence under the Medicines Act (Cap 176, 1985 Rev Ed) ("the Product Licence"), Bristol-Myers commenced High Court Suit No 1146 of 2015 ("the High Court suit") seeking a declaration that the acts for which the Product Licence was sought would infringe the Singapore Patents, and an injunction to prevent the same. The present originating summons has arisen in connection with the High Court suit.

2 In the High Court suit, Bristol-Myers claims the priority date of 11 June 1988, which derives from an earlier US patent application for the same (or a similar) invention ("the US Patent Application"). In its defence, Novartis has argued that Bristol-Myers is not entitled to rely on its claimed priority date because the document cited in support of the claimed priority date relates to a completely different invention which has nothing to do with the inventions set out in the Singapore Patents. After the defence was filed, Bristol-Myers investigated the prosecution history and discovered that an error had been made during the application process: the wrong earlier US patent application number was entered in the relevant forms.

3 Bristol-Myers filed requests to the Registrar of Patents ("the Registrar") to correct the entries in the patents register ("the Register") so as to reflect the correct US patent application number in support of the claimed priority date. The Registrar granted the requests and made the corrections. Novartis takes the view that the Registrar should not have allowed the corrections, and argues that the corrections should be reversed. It has thus commenced the present originating summons for rectification of the Register under s 44 of the Patents Act.

4 In support of its application, Novartis filed an affidavit affirmed by Emmanuelle Laure Ferrari ("Ferrari"), the Head of Legal and Compliance in the Asia-Pacific Region for Novartis, dated 13 September 2016.

5 Bristol-Myers filed two affidavits in support of its attempt to resist Novartis's application, deposed by the following individuals:

(a) Warren K Volles, Assistant General Counsel for Patents for Bristol-Myers;

(b) Huang Xinhui, an associate with Dentons Rodyk & Davidson LLP, the solicitors acting for Bristol-Myers.

6 While the facts are largely undisputed, it is necessary to set out a detailed account of the circumstances in which the error was made and eventually corrected. Before I turn to that, however, seeing as this is the first time an issue of this nature has arisen in Singapore, I shall set out an overview of the process of obtaining a Singapore patent.

Obtaining a Singapore patent

7 Singapore's Patents Act is based on the UK Patents Act 1977 (c 37) (UK) ("the UK Patents Act") which, in turn, is based on the Convention on the Grant of European Patents, 5 October 1973, 1065 UNTS 199, *ie*, the European Patent Convention 1973 ("the EPC"). Since Singapore enacted the Patents Act in 1994, there have been several sets of amendments. Many of these were required because of Singapore's obligations under the Agreement on Trade-Related Aspects of Intellectual Property Rights (15 April 1994), 1869 UNTS 299 ("the TRIPS Agreement") and the US-Singapore Free Trade Agreement (6 May 2003) ("USSFTA") US-Singapore Free Trade Agreement. The basic substantive requirements, however, have not changed. A patentable invention is one that meets the requirements of novelty, inventive step and capability of industrial application. These requirements are assessed by reference to the state of art as it existed at the priority date of the claimed invention.

8 Section 17 of the Patents Act sets out detailed provisions on the priority date of a patent. Section 17(1) states that the priority date is the date of filing the application. However, an earlier date can be claimed under s 17(2).

9 Without going into the details, where there has been an earlier patent application in respect of the same invention within the preceding 12 months ("the earlier application"), the date of filing for the earlier application can be claimed as the priority date for the application in question (s 17(2)). Under s 17(5) of the Patents Act, the earlier application may be one made under the Patents Act or in a "convention country", which is defined as "a country other than Singapore that is a party to the Paris Convention [*ie*, the Convention for the Protection of Industrial Property (20 March 1883) , 828 UNTS 205 ("the Paris Convention")] or a member of the World Trade Organisation" (s 17(6)(*a*)), or a country that is gazetted as a convention country (s 17(6)(*b*)). In such cases, the applicant must make a declaration within the prescribed period.

The Patent Cooperation Treaty and international applications

10 Singapore became a contracting state to the Patent Cooperation Treaty (19 June 1970), 1160 UNTS 231 ("the PCT") on 23 November 1994, and the PCT came into force in Singapore on 23 February 1995. The US became a contracting state on 26 November 1975, and the PCT came into force in the US on 24 January 1978. In brief, the PCT sets out an international system for the filing of patent applications in member states.

11 Instead of having to make multiple applications for the grant of a patent in the different contracting states, a single international application in one language can be filed at national or regional patent offices, or at the International Bureau of the World Intellectual Property Organization ("the International Bureau"). After a search by an international search authority (and, in some cases, a preliminary examination), the international application is forwarded to the national patent offices of the relevant contracting states. The decision as to whether to grant the patent is determined by the national patent office in

accordance with its patent laws (see Ng-Loy Wee Loon, *Law of Intellectual Property of Singapore* (Sweet & Maxwell, 2nd Ed, 2014) at paras 3.1.19 and 29.4.9–29.4.12.

12 Under Art 8(1) of the PCT, an international application can claim priority based on an earlier application in a member state of the Paris Convention, provided that such application has been made within the preceding 12 months (Art 8(2)(a) of the PCT read with Art 4 of the Stockholm Act of the Paris Convention (14 July 1967) 828 UNTS 305). Both the US and Singapore are contracting states to the Paris Convention. Under Art 3(2) of the PCT, every international application must contain a request, a description of the patent, one or more claims, drawings (where required) and an abstract. Under r 4.1(b) of the Regulations under the PCT (entered into force 1 July 2017) ("the PCT Regulations"), the request must contain a priority claim, which must consist of a statement to the effect that the priority of an earlier application is claimed, and shall indicate, *inter alia*, the date on which the earlier application was filed and the number of the earlier application (r 4.10). In parallel, Art 4D(1) of the Paris Convention provides that any person who desires to avail himself of the priority of a previous application is required to specify the date of the application and the country in which it was made.

13 Part XVI of Singapore's Patents Act deals with international applications for patents. Section 85(1) provides that an international application for a patent (which designates Singapore) for which a date of filing has been accorded under the PCT shall be treated as if it was an application for a patent under the Patents Act. Section 86 sets out provisions on the international phase of the application and the start of the national phase. Section 87(1)(*a*) provides that where an international application for a patent (which designates

Singapore) is accorded a filing date under the PCT, that date is treated as the date of filing the application under the Patents Act. Under s 87(1)(*b*), any declaration of priority made under the PCT is also treated as having been made under s 17(2) of the Patents Act.

14 In short, where an international application is made designating Singapore as one of the member states in which protection is desired, the international application will (in the usual case) move into the national phase, leading (if all goes well) to a grant of the patent by the Registrar.

15 Unlike some other jurisdictions, Singapore's Patents Act does not have a provision for pre-grant opposition by third parties. This can be compared to the position under the UK Patents Act and the EPC where third parties may within prescribed time limits institute opposition proceedings after the application has been published and before grant. The relevance of this point will be explored later.

Divisional patents

16 A divisional patent application is a patent application which includes matter from a previously-filed parent application. A divisional application may retain the filing date of the parent application and claim the same priority date (see Colin Birss *et al*, *Terrell on the Law of Patents* (Sweet & Maxwell, 18th Ed, 2017) ("*Terrell on Patents*"), para 3-25).

17 The learned authors of *Terrell on Patents* explain at para 3-25 that divisional applications are made where necessary to avoid multiplicity of inventions in a single application. In other words, divisional applications are made where issues may arise as to whether the applications satisfy the "unity of

invention" requirement. In Singapore, r 25(1) of the Patents Rules (Cap 221, R 1, 2007 Rev Ed), provides that "where 2 or more inventions are claimed (whether in separate claims or as alternatives within a single claim), such inventions shall be treated as being so linked as to form a single inventive concept only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features." This provision captures the requirement of "unity of invention", which dictates that a patent application may only relate to a single invention or a group of inventions which are sufficiently closely-related. In cases where there may be an issue over this requirement, it may be necessary to split the parent application into divisional applications. The splitting of the original or parent application into several divisional applications is provided for by Art 4G of the Paris Convention.

Facts

Genesis of the dispute between the parties

18 As mentioned, Bristol-Myers is the proprietor of the Singapore Patents, which include: SG 76157, SG 77853, SG 134977, SG 111980, and SG 111981. The Singapore Patents broadly concern pharmaceutical inventions.

19 Novartis applied to the Health Sciences Authority on 30 October 2013 for the Product Licence ("the Product Licence Application"), which was sought in respect of a product called: "EFAVIRENZ SANDOZ FILM COATED TABLET 600MG" ("the Product"). On or about 24 September 2015, Novartis served on Bristol-Myers notices of the Product Licence Application under s 12A(3)(*a*) of the Medicines Act.

20 Thereafter, Bristol-Myers commenced the High Court suit against Novartis on 9 November 2015, seeking a declaration that the doing of the acts for which the Product Licence is sought would infringe the Singapore Patents, as well as an injunction to restrain Novartis from infringing the Singapore Patents.

21 Novartis filed its defence and counterclaim on 23 December 2015, in which it denies infringement and puts in issue the validity of the Singapore Patents. Novartis also seeks revocation of the Singapore Patents on the basis of invalidity, misrepresentation and non-disclosure of material information.

22 As mentioned, a core issue in the High Court suit concerns the priority date and the state of the art against which patent validity, amongst other matters, is to be assessed. Novartis has raised the issue as to whether the claimed priority date is supported by the priority document referred to in the forms and documents tendered during the filing of the US Patent Application. Novartis contends that Bristol-Myers is not entitled to rely on the claimed priority date because the document cited in support of the claimed priority date relates to a completely different invention which had nothing to do with the inventions set out in the Singapore Patents. On this basis Novartis asserts, amongst other things, that the patents relied on by Bristol-Myers should be revoked on the grounds they were obtained by a misrepresentation within the meaning of s 80(1)(*f*) of the Patents Act. Novartis also asserts that the Singapore Patents are invalid because of obviousness, insufficiency of disclosure and unclear claims. In any event, Novartis also pleads that the Product would not infringe the patents.

23 After Novartis filed its defence and counterclaim, Bristol-Myers discovered the mistake that had been made during the application process.

The error in the application process

24 On 11 June 1998, DuPont Pharmaceutical Company ("DP") filed US patent application number 60/088,981 for the invention titled "CRYSTALLINE EFAVIRENZ" ("CEFA")). DP was subsequently acquired by Bristol-Myers in 2001.[1]

25 Following the US Patent Application, an international patent application, PCT/99/13199 for CEFA was filed on 10 June 1999 under the PCT by the US patent agents for DP. The declared priority date was 11 June 1998. This was the filing date of the earlier US Patent Application for CEFA.[2]

26 A mistake was however made in the international application. Instead of "US 60/08**8**,981" [emphasis in bold], what was entered was "US 60/08**9**,981" [emphasis in bold]. The latter US patent application was for a completely different invention titled the "PAPER CARTON and BLANK THEREFOR" ("the Paper patent"). A copy of the Paper patent was also submitted.[3] The filing date of the Paper patent was 19 June 1998.[4]

27 I pause to note that the difference in the filing dates for the two US patent applications is just eight days. The two US patent applications however carried

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1 Affidavit of Warren K Volles, para 5.

2 Affidavit of Warren K Volles, para 18(1); affidavit of Huang, Exhibit HXH-1.

3 Defence and Counterclaim, para 18(c)(iii).

4 Affidavit of Warren K Volles, p 96.

distinct titles and concerned quite different inventions. There was only a single digit difference in the US application numbers.

28 An error, described as clerical in nature, was made by DP in its international application.[5] What was entered in the international application form in connection with the priority claim was the number "60/089,981." There was no mention of the title of the invention "PAPER CARTON and BLANK THEREFOR".[6] The agent handling the international application for DP was a US patent agent at DP's Legal Patent Records Center.

29 The international publication was published under the PCT on 16 December 1999 with the claimed priority date stated as "11 June 1998: US 60/089,981." The international application as published included an abstract describing the invention as a potent reverse transcriptase inhibitor Efavirenz produced in crystalline form.

30 Subsequently, the international application entered the national phase of examination and grant in Singapore pursuant to the relevant provisions in the Patents Act. The law firm acting for DP in the national phase in Singapore was Ella Cheong and G Mirandah ("ECGM"). The solicitor in charge was Ms Gladys Mirandah ("GM").[7]

31 On 28 November 2000, ECGM, acting for DP, commenced the national phase in Singapore for international application PCT/US99/13199 (CEFA) by letter to the Intellectual Property Office of Singapore ("IPOS") and enclosing the relevant forms required under the Patents Act (PF Forms 8, 37 and 41).[8]

5 Affidavit of Huang, para 5.

6 See affidavit of Huang, Exhibit HXH-1.

7 Affidavit of Huang, Exhibit HXH-2.

Patents Form 37 ("PF37") is the form required to commence entry into national phase.

32 It is apparent that the error in the earlier US application number was not detected and was simply copied over into the Singapore application. In any case, the error was not made known to the Registrar by the International Bureau or by DP or its agents. A copy of the Paper patent was filed at the Registry.

33 Subsequently, Ella Cheong Mirandah and Sprusons Pte Ltd ("ECMS") took over the handling of the application. GM was the Chief Executive Officer of ECMS.

34 On 15 February 2002, ECMS, on behalf of DP, applied to IPOS to correct typographical errors in the address, name and assignment of the Singapore patent applications from DP and Bristol-Myers.[9] I pause to note that at this stage, ECMS was acting for both DP and Bristol-Myers.

35 On 2 December 2002, Bristol-Myers, through ECMS, filed the three divisional patent applications under the parent application for SG 77853.[10] Several forms and documents were filed including Patent Form 1 ("PF1").[11]

36 PF1, which is the request for grant of a patent in Singapore, identifies the invention correctly as CEFA. Part 4 of PF1 on "Declaration of Priority" sets out the same erroneous earlier US application number referred to above. The covering letter to IPOS from ECMS however correctly described the invention

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8 Affidavit of Huang, para 6 and p 93.

9 Affidavit of Huang, para 11 and Exhibit HXH-3.

10 Affidavit of Huang, para 11 and Exhibit HXH-4.

11 Defence and Counterclaim, para 20.

for the divisional applications as "CEFA". Included with the divisional applications was a copy of the priority document, namely, US application number "60/089,981" for the Paper patent.

37 On 9 December 2002, ECMS made a request for the issuance of grant of the parent patent. The SG 77853 patent (the parent patent) was granted on 30 May 2003.[12]

38 By March 2004, ECMS had become Ella Cheong Spruson and Ferguson (Singapore) Ltd ("ECSF"). On 24 March 2005 and 1 April 2005, ECSF filed requests using Patents Form 11B to rely on the corresponding US patent 6,673,372 to obtain grant of the three divisional Singapore patents.[13] It is noted that the alleged corresponding US patent sets out the correct application number for the US CEFA patent. A copy of the US CEFA patent was also provided.

39 IPOS subsequently issued the certificate for grant for SG 111980, SG 111981 and SG 134977 on 29 June 2007, 31 July 2007 and 30 November 2007 respectively. The erroneous US application number was entered in the Register for the divisional patents regarding the claimed priority date.

Novartis's position in the High Court suit

40 Given the assertion made in this originating summons that the corrections sought and granted have a direct bearing on the claimed priority date and the substantive issues raised in the High Court suit, the position taken by

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12 Flowchart of patent prosecution history of SG77853, SG111980, SG111981 and SG134977, tendered by the parties.

13 Affidavit of Huang, para 11 and Exhibit HXH-5.

Novartis in that suit (as the pleadings currently stand) is set out in greater detail below:

41 *SG 77853.* Novartis pleads that SG 77853 is the Singapore national phase application number 2000070060 of the international application and was granted on 30 May 2003. Novartis asserts that Bristol-Myers is not entitled to rely on the claimed priority date for SG 77853 on account of the procedural irregularities and errors referred to above. In addition, Novartis challenges SG 77853 on grounds of obviousness and insufficiency.

42 *SG 111980*. Novartis pleads that SG 111980 granted on 29 June 2007 is a divisional application under application number 2000070060 filed on 10 June 1999 for CEFA. Novartis asserts SG 111980 is not entitled to rely on the claimed priority date because of the procedural irregularities and errors referred to above. Novartis also challenges SG 111980 on grounds of obviousness and insufficiency and goes on to assert that the claims would not be infringed by the Product.[14]

43 *SG 111981*. Novartis pleads SG 111981 granted on 31 July 2007 is also a divisional application under application no 2000070060 filed on 10 June 1999 for CEFA. Novartis asserts SG 111981 is not entitled to rely on the claimed priority date because of the procedural irregularities and errors referred to above. Novartis again challenges SG 111981 on grounds of obviousness and insufficiency and asserts the claims would not be infringed by the Product.[15]

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14 Defence and Counterclaim, para 60.

15 Defence and Counterclaim, para 61 and following.

44 In addition, Novartis asserts that SG 111981 is the Singapore national phase application of the PCT application. Novartis complains that as part of the application for grant of SG 111981, Bristol-Myers sought to amend the claims of the PCT application on 2 December 2002. Thereafter Bristol-Myers filed Patent Form 11B to rely on the corresponding US patent 6,673,372 to obtain grant of SG 111981[16] (and the other divisional patents). Novartis asserts that this is without basis in the case of SG 111981 since half of the claims as filed have no equivalent in US 6,673,372.[17]

45 *SG 134977.* Novartis pleads that SG 134977 granted on 30 November 2011 is also a divisional application under application number 2000070060 filed on 10 June 1999 for CEFA. Novartis asserts SG 134977 is not entitled to rely on the claimed priority date because of the procedural irregularities and errors referred to above. Novartis challenges SG 134977 on grounds of obviousness and insufficiency. It also asserts the claims would not be infringed by the Product.

46 *SG 76157.* Novartis pleads that SG 76157 was granted on 31 October 2002 pursuant to application number 2000054064 filed on 1 April 1999. The SG 76157 patent is for a different albeit related invention and claims priority from US 60/080,925 filed on 7 April 1998.[18] Novartis pleads that SG 76157 is invalid on grounds of lack of inventive step and insufficiency. It also asserts the claims would not be infringed by the Product. SG 76157 does not feature in the present originating summons.

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16 Defence and Counterclaim para 26.

17 Defence and Counterclaim, para 30.

18 Defence and Counterclaim, paras 33–34.

The request for correction

47 Bristol-Myers first attempted to file a request for corrections on 16 June 2016 by means of the IPOS online portal. The request was to correct the entry in PF1 for SG 111980, SG 111981 and SG 134977. The attempt was unsuccessful.

48 Thereafter, Bristol-Myers sought clarification from the Duty Registrar by telephone. On 16 June 2016, by letter to the Registrar through its lawyers, Bristol-Myers sets out the advice it received from the Duty Registrar, namely, that "[t]he only way to correct the priority application number listed on the Register of Patents in respect of the three captioned patents is to select 'Correction of Register of Patents or Designs' under Part 5 of the CM4 form" pursuant to r 58 of the Patents Rules. I note that whilst the letter referred to Part 5, it is clear that what was meant was Part 6 of Form CM4.[19] I pause to note that there is no affidavit from the Registrar on the events that transpired.

49 On 17 June 2016, the lawyers for Bristol-Myers by letter to the Registrar stated an obvious error had been made in each PF1 in setting out the US application number for the priority document relied on. The errors were said to be obvious because the patents relate to CEFA and not paper cartons. Bristol-Myers asserted that the interests of third parties would not be affected by the obvious errors because the errors were obvious on the face of the documents.[20]

50 Subsequently on 20 and 21 June 2016, the Registrar by letter informed Bristol-Myers that the records for the patent applications in respect of

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19 Affidavit of Huang at Exhibit HXH-6, the letter dated 16 June 2016 and the attached CM4 forms.

20 Affidavit of Huang at Exhibit HXH-9.

SG 111980, SG 111981, SG 134977 and SG 77853 had been updated in accordance with the CM4 forms as lodged on 17 June 2016.[21]

51 Thereafter on 15 July 2016, the Registrar, in response to queries, informed Novartis that the request for correction to the Register was made and granted under r 58 of the Patents Rules which did not provide for publication or opposition of the proposed corrections. Novartis was informed of s 44 of the Patents Act and the possibility of seeking rectification from the court.[22] Thus, in the present application under s 44 of the Patents Act by way of originating summons, Novartis seeks rectification of the Patent Register for SG 77853, SG 134977, SG 111980 and SG 111981 by reversal and deletion of the corrections.

The parties' cases

Novartis's case

52 Section 44(1) of the Patents Act states that "the court may on the application of any person aggrieved, order the register to be rectified by the making, or the variation or deletion, of any entry in it." Section 44(2) provides that "the court may determine any question which may be necessary or expedient to decide in connection with the rectification of the register."

53 Novartis submits that it is an aggrieved person under s 44(1) and that the Register should be rectified by reversing the decision and deleting the corrections in their entirety. Novartis relies on the following grounds:[23]

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21 Affidavit of Huang at Exhibit HXH-7.

22 Affidavit of Huang at Exhibit HXH-8

23 See affidavit of Ferrari, para 25.

(a) The filing of the requests were procedurally irregular as they should have been made under r 91 and not r 58 of the Patents Rules.

(b) The errors for which corrections were sought were not simple and obvious errors.

(c) The requests were made in bad faith.

(d) There was undue delay on Bristol-Myers's part in making the requests.

54 In its written submissions, the grounds were framed in slightly different terms:

(a) Novartis suffered grave prejudice caused by the breach of due process in that it was deliberately denied the opportunity to respond to the requests for correction until after the corrections had been made by the Registry.

(b) Bristol-Myers had used the wrong procedures to file the requests.

(c) The requests should not have been granted because of the undue delay on Bristol-Myers's part in making the application.

Bristol-Myers's case

55 Unsurprisingly, Bristol-Myers submits that Novartis has failed to make out a case under s 44 of the Patents Act. Bristol-Myers's case will be set out in more detail below. The general point is that Bristol-Myers asserts that the error was clerical in nature, no prejudice was caused and the error would have been obvious to a reader on a proper inspection of the file record and prosecution

history. It denies bad faith and the assertion that the wrong procedure had been used.

The statutory framework and corrections to forms, documents and the register

56 Before I turn to a detailed discussion of the submissions, it may be helpful to set out an overview of the main statutory provisions (and rules) on requests for corrections.

57 The right to request corrections is provided for in several provisions in the Patents Act. Section 107 provides as follows:

> **Correction of errors in patents and applications**
>
> **107. –** (1) The Registrar may, subject to any provisions 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 such an application.
>
> (2) Where the Registrar is requested to correct such an error or mistake, any person may in accordance with the rules give the Registrar notice of opposition to the request and the Registrar shall determine the matter.

58 Specific provisions are provided for under s 42 on corrections to the Register that the Registrar is required to maintain. For instance, s 42(2)(*d*) states that the Patents Rules may make provision for the correction of errors in the Register and in any document filed at the Registry in connection with registration.

59 Section 42(2)(*d*) covers (i) errors in the register; and (ii) errors in any document filed at the Registry in connection with registration. Section 107, on the other hand, covers (i) errors in the specification, (ii) errors in an application

for a patent; and (iii) errors in any document filed in connection with the patent or the application.

60 Aside from differences in scope, it is noted that whereas s 107(2) provides that "[w]here the Registrar is requested to correct such an error or mistake, any person may in accordance with the rules give the Registrar notice of opposition to the request and the Registrar shall determine the matter", there is no equivalent provision under s 42.

61 The Patents Rules are made under ss 42, 110 and 115 of the Patents Act. Section 42 concerns the Register. Section 110 deals with extensions of time. Section 115(1) makes provision for the Minister to make such rules as are expedient for regulating the business of the Registry.

62 The Patents Rules sets out several distinct rules and forms by reference to which corrections of errors can be requested. Of particular importance to the case at hand are:

(a) Rule 58, which provides that requests for correction of errors in the Register and in any document filed in connection thereto shall be made on Form CM4; and

(b) Rule 91, which provides that requests for correction of errors in patents, applications and in any document filed in connection thereto shall be made on Form CM4.

63 It should be noted that the same form, Form CM4, is used under both rr 58 and 91. I also note in passing there are several other rules and forms provided for requesting certain specific corrections such as:

(a) Rule 56, which provides that requests for alterations of name or address shall be made on Form CM2;

(b) Rule 9(3), which provides that requests to correct a mistake in a priority date declaration, which if granted would cause the priority date to be changed to a different date, shall be made on Patents Form 57 ("PF57");

(c) Rule 31(5), which provides that requests to correct the address for service shall be made on Form C2; and

(d) Rule 48, which provides that applications for amendment of the request for grant, description, claims, drawings and abstract shall be made on Patents Form 13 by striking through any matter be to replaced or deleted.

64 Quite apart from the forms to be used for requesting corrections, there are of course numerous other forms relating to other matters such as requests for grant of a patent, requests for declaration of priority, requests for amendment of application, request for entry into the national phase, requests to appoint, change or remove an agent and so on.

65 Rule 4 of the Patents Rules provides that the forms to be used under the Patents Act are to be published in the journal. Further, any form may be modified on the direction of the Registrar for use in an electronic online system.

66 Detailed provisions are set out in rr 96A to 96K on the electronic online system established by IPOS. The Registrar is empowered by r 96A(3) to issue practice directions on the documents that are to be filed or submitted using the

electronic online system. Rule 96H provides that a person shall comply with these Rules and practice directions when using the electronic online system.

67 At the time when Bristol-Myers requested corrections in respect of the US application number and the priority declaration, the practice direction applicable was Practice Direction No 2 of 2014 ("the 2014 Practice Direction") on transactions *via* the electronic online system. This has since been replaced by Practice Direction No 1 of 2017.

68 The transactions to be made using the electronic online system are set out in the First Schedule of the 2014 Practice Direction. The listed transactions include a reference to Form CM4. Paragraph 7 of the 2014 Practice Direction set out details on the procedure for amending or correcting an error in any document pursuant to r 91(1C) of the Patents Rules. It follows from the above summary that the principal rules for requests for corrections which are relevant in the present case are r 58 and r 91.

Rule 58

69 Rule 58 is titled "Request for correction of errors". As mentioned at [62(a)] above, r 58(1) provides that "a request for the correction of each error in the register or in any document filed at the Registry in connection with registration shall be made on Form CM4". Further, "the correction shall be clearly identified on a document filed together with the form or, if not, on the form itself."

70 The procedure and requirements under r 58 are simple and straightforward. If the request is made to correct the same error in both the

Register and any document filed at the Registry in connection with the registration, the request can be made on a single form (r 58(2)).

71 Thereafter, the Registrar may call for such written explanation or evidence in support as necessary to satisfy himself that there is an error before allowing the correction (r 58(3)).

72 Rule 58 appears to implement or flow from s 42(2)(*d*) which, as noted at [58] above, provides that the Patents Rules may make provision for "the correction of errors in the register and in any document filed at the Registry in connection with registration".

Rule 91

73 Rule 91 is titled "Corrections of errors in patents and applications". Section 2 defines "patent" as meaning a patent under the Patents Act. It appears that r 91 derives from s 107.

74 As stated at [59] above, s 91(1) is concerned with translation and transcription errors, and clerical errors or mistakes, in:

(a) a specification of a patent;

(b) an application for a patent; and

(c) any document filed in connection with a patent or such an application.

75 The request must be made on Form CM4 (unless the Registrar directs otherwise). Rule 91(1A) goes on to state that where the request relates to any document other than a form, the request must be accompanied by a copy of the

document with the proposed correction indicated (such as by striking through any text or figure *etc*). In cases where the request is made under the electronic online system there is no need to comply with r 91(1A). Instead, the applicant is directed to comply with the practice directions as mentioned above (r 91(1C)).

76 Rule 91(2) provides that where the request relates to the specification, no correction shall be made 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.

77 Rule 91(3) provides that the Registrar may advertise the proposed correction in the manner prescribed. Third parties can then give notice of opposition within the time-frame allowed. Rule 91(3) is consistent with and flows from s 107(2).

Bristol-Myers's request for correction

78 As briefly noted earlier at [47], on 16 June 2016, the law firm acting for Bristol-Myers attempted to submit the corrections for the three divisional patents via the online IPOS portal. After selecting Form CM4 (titled "Request for Correction of Error"), filling out the type of correction applied for and providing the reasons in Part 7 of Form CM4, the attempt to lodge the form online was unsuccessful. It is apparent that the type of correction applied for was "Correction of Form Lodged." An error message was received: "No form is available for correction".

79 As a result, the law firm contacted the Duty Registrar by telephone for assistance. The law firm was informed, *inter alia*, that it was not possible to correct the errors relating to the priority claim and declaration in PF1 of the

Singapore Patents because all the forms lodged in respect of the patents had already been approved by IPOS.

80 Bristol-Myers asserts that the Duty Registrar advised that the only way to correct the priority application number listed in the Register was to make the internal selection under Part 5 of Form CM4 headed "Correction of Register of Patents or Designs" which concerns requests under r 58.[24]

81 There is no doubt that Bristol-Myers did attempt to make an online application under r 91 which was not accepted by the electronic system. It is also clear that it was in these circumstances that Bristol-Myers next applied under r 58.

82 Thereafter, on 17 June 2016, Bristol-Myers (through its lawyers) filed the requests under r 58 to correct the priority application numbers listed in the Register on the basis that the errors were obvious. Bristol-Myers accepts that it did not copy or inform Novartis of the application. The Registrar granted the corrections for SG 111980 and SG 111981 on 20 June 2016. The corrections for SG 77853 and SG 134977 were granted on 21 June 2016.

83 It was only after the correction was made by the Registrar that Bristol-Myers informed Novartis that the application had been made and granted. What followed was correspondence between Novartis and IPOS on the propriety of the corrections applied for and granted. In brief, Novartis took the position that the application should have proceeded under r 91: the point being that under r 91, unlike r 58, the Registrar has the discretion to require advertisement of the application and to hear any opposition to the application. Novartis asserts they

[24] Affidavit of Huang, paras 18–20 and Exhibit HXH-6 (exhibiting a letter to IPOS dated 16 June 2016 setting out a summary of the conversation and advice received)

should have been made aware of the application and the Registrar should have been informed of the existing High Court proceedings in which the priority date of the claims was highly significant.

84 The position taken by the Registrar (as evidenced in the correspondence) was that r 58 did not provide for publication or opposition and that the corrections were properly made. Finally, on 2 August 2016, the Registrar informed Novartis that if they wish to dispute the corrections, the proper course of action was to seek rectification of the register under s 44 of the Patents Act. The present application for rectification by Novartis was brought on 4 October 2016.

85 I note that Novartis in its submissions makes much of the point that Bristol-Myers did not inform the Registrar, either at the time when it tried to apply under r 91 or subsequently when it applied under r 58, that there was a current patent dispute and that the question of priority date was a live issue in the High Court suit. There is no dispute over the fact that Bristol-Myers did not disclose these facts at the time of the applications. I also note that Novartis had made it clear even before Bristol-Myers had applied for corrections that it would object to any attempt to amend or correct the patent document *viz* the claimed priority date. That said, Form CM4 (whether on paper or online) does not expressly require the applicant to make a statement as to whether any third-party interests may be affected or if there are pending proceedings.

86 Before I turn to the arguments, submissions and my decision as to whether the request was properly brought and granted under r 58, I note there are similar statutory provisions and rules on requests for corrections in the UK Patents Act and under the EPC. Indeed, counsel referred the court to numerous

decisions of the European Patent Office ("EPO") and its Boards of Appeal on principles applying to requests for corrections. The main decisions will be examined later. The general observation I make at this juncture is that the EPO and UK cases and practice are not binding on this court. That said, since this is the first time the question of corrections has arisen in a Singapore court, the EPO and UK case law provides a useful starting point in the analysis.

Decision and reasons

87 It will be convenient to address the grounds raised by Novartis in accordance with the points set out above at [53]–[54].

The application was procedurally irregular

88 This point concerns whether r 58 or r 91 of the Patents Rules was the relevant and correct provision.

89 Novartis's case is that the correct procedure is r 91. Bristol-Myers's position is that whilst they attempted to apply under r 91, they were justified in making the application under r 58. It will be convenient to deal first with the reasons why Bristol-Myers did not proceed under r 91.

90 As summarised already, the error in the US application number for the document relied on for the claimed priority date originates from the international application under the PCT. It will be recalled that on 28 November 2000 an application was made in Singapore for grant of the SG 77853 patent. The error in the priority date document reference number was not detected and was copied over into the Singapore application. Subsequently on 2 December 2002, Bristol-Myers filed the three divisional patent applications. The specifications were the same as the SG 77853 application. The incorrect priority

document application number was not detected and was adopted for the divisional applications. The erroneous priority document application number was entered in the Register for the divisional patents.

91 In a broad sense, achieving a "holistic" correction of the error in the Register and the documents in the patent file would require correcting the priority document application numbers on the following:

(a) the application made on 28 November 2000 for the Singapore parent patent;

(b) the three divisional applications made on 2 December 2002; and

(c) the patent register.

92 In the end, what was corrected pursuant to the application under r 58 was nothing more than the entries in the Register for the Singapore Patents. The errors remained uncorrected in the divisional application forms as well as the parent application form. To this end, Novartis points to the confusion that this could cause if a question arose over the priority date arose in subsequent proceedings. Whilst the entry in the Register was corrected to refer to the correct earlier US application relied on for the claimed priority date, a person inspecting the patent files would however find a different US application number set out in the relevant forms. Indeed, a third party inspecting the file would also come across a copy of the Paper patent that had been submitted because of the erroneous US application number. That said, a third party inspecting the file from around April 2015 would also find the granted US CEFA patent which sets out a clear reference to the correct earlier US application number.

93 It will be recalled that the Registrar's view, at least according to Bristol-Myers, was that the entries in the forms could not be corrected under r 91 as they had already been accepted by the Registry. What could be corrected was the entry in the Register by means of r 58.

94 Novartis's core point is that if r 91 had been used or if the online request had been accepted for processing, the Registrar would enjoy the discretion to require advertisement of the request. If an advertisement had been made, Novartis would have enjoyed the chance to give notice of opposition. Of course, Novartis also asserts that it would have succeeded in opposing the proposed corrections.

95 I shall return to this point later. The question for now remains whether either r 58 or r 91 covered the case at hand such that a request could be made to correct (i) the entry in the relevant forms and (ii) the entry in the Register.

Rule 58

96 Rule 58, as noted, is titled "Request for correction of errors". The procedure and requirements under r 58 have been set out earlier.

97 The form to be used for requests for corrections under rr 58 and 91 is the same Form CM4 referred to already. Part 5 of Form CM4 includes a box entry for "Correction of Form Lodged". It appears that this "box entry" could not be used for requests under r 91 in respect of forms already submitted and accepted by the Registry. The reason for this was never made clear. It may have been because r 91(1A) only applies to a request for correction "to an error in any document other than a form".

98 This might be taken to signal that once a form had been accepted by the Registry it could not be corrected under r 91. If so, it must follow that Part 5 of Form CM4 and the box entry for "Correction of Form Lodged" was intended to relate to some other provision for making requests for correction. Bearing in mind the various rules which touch on requests for correction summarised above, it follows that this box entry in Form CM4 relates to corrections requested under r 58.

99 Rule 58 indeed does refer to requests to correct errors in the Register or in any document filed at the Registry in connection with registration. That being so, it appears at least at first sight that the Registry's procedures required requests for correction of errors in a form to be dealt with under r 58. After all, there does not appear to be any reason why an error made in filling out a form cannot be treated as an error in a document filed in connection with registration. There is certainly nothing in s 42(2)(*d*) of the Patents Act which suggests that forms used, in connection with the registration, are excluded. Neither is there any express prohibition of corrections to forms that have already been submitted and accepted by the Registry.

100 The question, however, is whether the request for a patent by way of PF1, is indeed a document that is filed in connection with the registration of an entry in the Register. PF1 is certainly a key document that starts the application process which eventually leads to the grant of the patent under s 30 of the Patents Act. Entry of particulars in the Register is distinct and separate from the actual grant of the patent.

101 The point has been made that the Registrar is required under s 42 to maintain the Register. These include matters concerning:

(a) the registration of patents and published applications for patents;

(b) the registration of transactions, instruments or events affecting rights in or under patents and applications; and

(c) the furnishing to the Registrar of any prescribed documents in connection with any matter which is required to be registered.

102 Rule 55 sets out the details that the Registrar is required to enter in the Register after publication of the application. These include:

(a) the name and address of the applicant;

(b) the name of the person stated to be the inventor;

(c) the date of filing and the file number of any application declared under s 17(2);

(d) the date on which the application is published;

(e) the date on which the patent is granted;

(f) notice of any transaction, instrument or event referred to in s 43(3); and

(g) the particulars of any decision to revoke the patent.

103 It can be seen that the particulars to be entered in the Register under r 55 can be grouped into three broad categories:

(a) those which relate to details concerned with the application and the grant;

(b) those which relate to the renewal of the patent, the term of the patent and certain transactions relating to the patent; and

(c) details relating to the cessation of the patent, particulars of any decision to revoke the patent and any other court order in relation to the patent.

104 PF1 is a document that is required under r 19 in connection with the *application* for grant of a patent. It is not, as such, a document filed at the Registry in connection with *registration*.

105 It will be recalled that s 42(2)(*c*) of the Patents Act requires the furnishing to the Registrar of any prescribed documents in connection with any matter which is required to be registered. Rule 55(3)(*f*) in turn requires notice of any transaction, instrument or event referred to in s 43(3) such as (a) an assignment of a patent or application for a patent or a right in it; (b) the mortgage of or grant of any other security interest; (c) the grant or assignment of a licence or sub-licence, or mortgage of, or grant of any other security interest in, a licence or sub-licence, under a patent or application; and (d) the death of a proprietor of any such patent or application or any person having a right in or under a patent or application and the vesting by an assent of personal representatives of a patent, application or any such right.

106 Novartis submits that the reference to documents filed in connection with registration in r 58 is concerned with documents filed in relation to an application for registration of transactions such as a mortgage or transmission upon death.[25] The court agrees with this submission. It follows that documents filed in connection with the patent or application for a patent fall under r 91.

[25] Novartis's submissions, para 60(1).

107 Indeed, the Registrar expressed the view that corrections to errors in forms, specifically PF1, could only be made before the patent had been granted. Whilst it is unclear and does not appear that the Registrar made any specific comment about corrections to PF1 under r 58, it appears that Bristol-Myers was under the impression that only the error in the Register could be corrected under r 58. Regardless, Bristol-Myers did not request a correction of PF1 under r 58. On the basis of the evidence before this court, if they did try and make the request under r 58 to correct the forms filed in connection with the application for the patent, using Form CM4, the request would have been rejected outright as the form had been already been accepted and resulted in the grant of a patent. That said, I repeat that there is no direct evidence from IPOS on this point.

108 In any event, Bristol-Myers simply requested correction of the entries in the Register. It is clear on the basis of s 42(2)(*d*) of the Patents Act that Bristol-Myers was entitled to use r 58 to make this request. Leaving aside for the moment correction of errors in PF1, it was of course important to correct the entry in the Register. The Register and the entries represent the "public face" of Singapore patents in the sense that the Register is the first port of call for any member of the public who is interested in a Singapore patent. Rule 91 does not deal with requests for corrections to an entry in the Register.

109 Before I turn to the applicable principles on granting the request for a correction of an error in the Register under r 58, it is convenient to briefly deal with two other matters.

(1) Dispensation by the Registrar

110 Novartis submitted that what Bristol-Myers was trying to achieve in substance was not so much correction of an error as opposed to replacing one

document with another document. The correct procedure for this was to be found in r 101 titled "Dispensation by Registrar."

111 Rule 101 states that:

> Where, under these Rules, any person is required to do any act or thing, or any document or evidence is required to be produced or filed, and it is shown to the satisfaction of the Registrar that from any reasonable cause that person is unable to do that act or thing, or that document or evidence cannot be produced or filed, the Registrar may upon production of such evidence and subject to such terms as he thinks fit, dispense with the doing of any such act or thing, or the production or filing of such document or evidence.

112 With respect to learned counsel, I am unable to see how r 101 is relevant. Novartis was not applying for dispensation of a requirement to produce or file a document. They were applying to correct the application number of the priority document that they relied upon for the claimed priority date. The correction was to be made in respect of the earlier US application number set out in (i) the Register; and (ii) the relevant forms connected with the applications for the Singapore Patents.

(2) Correction of the priority date

113 As noted above at [8]–[9], s 17(2) of the Patents Act sets out provisions whereby the applicant for a patent can make a declaration so as to claim a priority date based on an earlier patent application. The priority declaration can be made either at the time of application or thereafter. If it is made at the time of application, Part 4 of PF1 requires the applicant to state the country, application number and the filing date of the earlier application that is relied on under s 17(2). If the declaration is made after the date of filing, r 9(2) requires the use of PF57. The information required of the priority details remains the

same. That said, if the application for a declaration is late (after the period prescribed in s 17(2A)(*a*)), reasons for the lateness must be provided in PF57.

114 It is noted that there is no requirement to stipulate the title or name of the priority application document relied upon. All that is required is the country, application number of the document and the date of filing.

115 Rule 9(3) provides that where a request is made to the Registrar to correct a mistake in a declaration for the purposes of s 17(2) would result in the declared priority date to be changed to a *different* date, the request shall not be granted unless it is made within 16 months from the declared priority date as changed. The request must be made using PF57, the prescribed fee must be paid, and the applicant must not have made any request under s 27(2) to publish the application in suit during the prescribed period even if any such request has been withdrawn.

116 In the present case the filing date (the claimed priority date) was correct. The error that was made was simply in the application number of the US patent relied upon in support of that date. The number entered referred to a different patent for an entirely different invention dealing with paper cartons which had a different filing date. The error in the application number was a single digit. This was the correction that was requested. There was no request to change the declared priority date as such. It follows that the procedure in r 9(3) is not applicable or relevant in the present case.

Was the discretion under r 58 properly exercised?

117 As noted, the procedure set out under r 58 is simple. Once the Registrar is satisfied that there is an error, r 58(3) provides that the correction shall be

made as agreed between the proprietor of the patent or the applicant and the Registrar. There is no requirement for any advertisement or any procedure whereby a third party may oppose the request. There is no obligation imposed on the party making the request to notify other persons or any restriction against requests being made after an infringement suit has been commenced.

118 In the present case, the request was to correct the error in the US patent application number declared for the purposes of s 17(2). There was no change to the date of filing (the declared priority date).

119 The Registrar was satisfied that an error had been made and the correction was made under r 58. The point might however be made that there was no "error" in the Register in the sense that the entry accurately recorded the application number of the earlier US patent application as declared in PF1. The error or mistake was in the application number as set out in the forms. Reference has already been made to Novartis's point that correction of the entry in the Register without correction of the priority document application number in PF1 and other documents in the patent file results in a confusing state of affairs. Indeed, in one sense, such a limited correction might be seen as meaningless. Novartis's assertion is that the error permeated all the way through to the international application upon which the Singapore applications are based. The errors in "totality" were not simple errors in the Register within the meaning of r 58.[26]

120 Novartis's position appears to be that the request for correction to the forms should have been first made and decided under r 91. If the correction to the forms was granted under r 91, correction of the entry in the Register would

[26] Novartis's submissions, para 68.

follow under r 58. Conversely, if Novartis was able to successfully oppose the request under r 91, the suggestion appears to be that there would be no error as such to correct in the Register.

121 To this end, Novartis relied on the decision of the Technical Board of Appeal of the EPO ("the TBA") in *Correction of priority/SUMITOMO* T 0796/94 (27 November 1995) ("*Sumitomo*"). In this case, the Opposition Division of the EPO refused a request to correct the priority declaration of two priority documents in a European patent application. The request was made under r 88 of the 1973 pre-amendment version of the EPC ("the EPC 1975"). The TBA accepted at para 2.2 that an error in a priority declaration could be corrected in accordance with r 88 in appropriate cases. On the facts, the request was refused for reasons that will be examined below. Novartis submits that r 88 of the EPC 1973 is equivalent to s 107 of the Patents Act and r 91 of the Patents Rules. In this way, it is argued that the decision in *Sumitomo* supports Novartis's case that a request to correct errors in the priority declaration falls under r 91.

122 Bristol-Myers's position is they had no alternative but to make the request under r 58 in respect of the entry in the Register. Whilst it is true that the errors remain uncorrected in the forms and the file, Bristol-Myers's response during oral arguments was that the issue as to whether the priority date claimed can be supported as a matter of law, is a question to be determined at the hearing of the infringement action in the High Court suit.

123 Whilst the procedure for correcting an error in the Register is simple and does not require notification of other parties or provide for any opposition procedure, I have come to the decision that the discretion was wrongly exercised. There was no error in the entries in the Register. The entries

accurately set out the earlier application number as contained in the published applications and forms. It follows that Novartis as an aggrieved party has the right under s 44(1) of the Patents Act to apply for rectification of the Register by deletion of the correction that was made to the Register.

124 Counsel for Bristol-Myers, during arguments, submitted that the court had the jurisdiction and power under s 44(2) to decide any matter that the Registrar could have decided. Whilst Bristol-Myers defended the request under r 58, it states that one of the issues the court is asked to determine is whether the requirements of r 91 would have been fulfilled.[27]

125 Section 44(2) confers on the court the right to determine any question which may be necessary or expedient to decide in connection with the application for rectification.

Rule 91

126 In their submissions, the parties have dealt at length with the principles that apply to govern requests for corrections under r 91. For this reason, it is convenient to address the arguments raised by the parties on the principles applicable if the request for correction had been heard under r 91, or indeed if a request to correct the entries in the forms (such as PF1) had been made and heard under r 91.

127 Given this is the first time the issue of corrections to forms and priority data has arisen in the Singapore courts, it is not surprising that the parties cited numerous decisions of the EPO and its Board of Appeals under the EPC. What follows is an overview of the main decisions cited by the parties in connection

[27] Bristol-Myers's submissions, para 25(3).

with r 88 of the EPC 1973. The relevance and persuasive value of these decisions will be considered later.

(1) Applicable principles under r 88 of the EPC 1973 (r 139 of the current EPC)

128 Rule 88 of the EPC 1973 is identical to r 139 of the current EPC, which provides that:

> Linguistic errors, errors of transcription and mistakes in any document filed with the European Patent Office may be corrected on request. However, if the request for such correction concerns a description, claims or drawings, the correction must be obvious in the sense that it is immediately evident that nothing else would have been intended than what is offered as the correction.

129 In *Sumitomo*, the patentee filed two European patent applications which were described as sister applications. I will refer to them as Applications A and B. Both applications bore the same title. Both applications claimed a priority date of 5 July 1983 based on prior applications for patents in Japan. The titles or names of the priority applications were the same as the sister applications to the EPO. Unfortunately, an error or mistake was made. The wrong application numbers (the earlier applications in Japan) were entered in the European application forms. The priority application numbers intended to be relied on had been switched around in the European applications. Those intended for Application A had been used for Application B and *vice versa*.

130 The request for correction was only made after the grant of the patent. Opposition proceedings had been filed on the last day of the nine-month period in which oppositions could be validly filed. On the same day, requests were filed, *inter alia*, to correct the priority declaration to refer to the correct Japanese application number in support of the claimed priority date of 5 July 1983 and to

replace the incorrect priority documents on file with the correct one. The claimed priority date was correct. The titles of the invention in the two European applications and the three prior Japanese applications were the same and correctly stated.

131 The TBA at para 3.1 noted that this was the first case of a request for correction where both the date and the state of the earliest priority as claimed was correctly given. The mistake was just in the application number of the priority document. *Sumitomo* was also the first case where the request for correction was made after grant and during opposition proceedings.

132 The TBA rejected the request for correction notwithstanding that a genuine mistake had been made in the form of a clerical error. Even though the appellant had acted with due speed after discovering the error, the request was made at an "extremely" late stage. It was too late to include a warning in the publication of the application or in the publication of grant. By the time the request was made, the error and the wrong corresponding priority documents were on file and available for inspection by third parties. For this reason, the request could only be granted if there were "very exceptional circumstances" (at para 3.3). It is apparent that the exceptional reasons must relate to the underlying concern as to whether the interests of third parties may be affected by a late correction.

133 The TBA found there were no such "very exceptional circumstances". This was not a case where the error and required correction were obvious. The dates and country provided in the priority declaration for Application A appeared normal. There was no discrepancy apparent on the face of the patent as published. It would only be if the third party accessed and read the file on

Application B that the error might have been noticed. Given that the request to make the correction was only made on the very last day for filing opposition proceedings, it followed no third party would have had correct information on which to base a decision to oppose the patent.

134 The TBA went on to find at para 3.5.1 that it made no difference that there was no change in the declared priority date. This was because the change in the priority application relied on could affect the right of priority. Article 88(3) of the EPC 1973 provided that "the right of priority shall cover only those elements of the European patent application which are included in the application or applications whose priority is claimed." The TBA noted that disclosure in two different priority documents of the same date could thus have different effects on the prior art citable under Articles 54(2) and (3) EPC.

135 In the end, the TBA denied the request because it was not satisfied that any third party on accessing the file for Application A would have realised an error had been made in the application number. Given the similarity of subject matter and the identity of titles of the application and the priority documents the discrepancy would not be easy to find. Further, even if the third party managed to detect the discrepancy, he would still not be in a position to determine with reasonable certainty and without undue burden what the correct priority document(s) should be.

136 Another case relied on by Novartis is *FONTECH/Priority declaration (correction)* J0007/94 (18 January 1995) ("*Fontech*"). In this case, the European patent application filed on 11 July 1991 claimed priority from three earlier applications in Israel. The dates and application numbers were set out in the section of the application form on declaration of priority. The first priority claim

was declared as "July 11 '90 95037." On 11 February 1993, a request was made under r 88 of the EPC 1973 to correct the first priority date and priority application number to read "25 October 1990, application No. IL 96118." At the same time, the correct priority document for application number IL 96118 was filed.

137 The application was made under r 88 of the EPC 1973 on the basis that a clerical error had been made. The mistake was immediately evident and no third parties had been jeopardised by the correction.

138 The TBA agreed with the EPO's decision to refuse the request. The request had not been made sufficiently early such that a warning could be included in the publication of the application. The TBA placed much emphasis on the significance and importance of compliance with the formalities for claiming priority. The EPC required the formalities to be fulfilled at the filing date or within strict time limits. The intention was to avoid "the unsatisfactory situation that the claim of priority comes as a surprise to those affected by the patent" (at para 4).

139 The TBA noted at para 5 that the EPC provided the Applicant with provisional protection from the date of publication. Third parties would have to take account of the effects of patent protection already at this date. To this end, third parties (including competitors) needed "a reliable legal basis for the economic decisions they have to take." This included the priority data in particular.

140 For these reasons, r 38(5) of the EPC 1973 required the particulars of the priority declaration to appear in the published application. It followed that a strict approach had to be taken where a correction of a priority declaration was

not requested sufficiently early for a warning to be included in the publication. It was not enough that the mistake might have been detected after consulting the priority document. The published data should have been reliable at the publication date. In any case, on the facts, it was not apparent from the priority document relating to the priority indicated in the request form that the priority data was not correct (at para 7).

141 Bristol-Myers, on the other hand, relied on the decision of the EPO Legal Board of Appeal in *Uni-Charm Corporation Priority declaration (correction)* J 0003/91 (16 June 1992) ("*Uni-Charm*"). In this case, the patent agent filed a European patent application claiming priority from an earlier Japanese patent application. By mistake, the wrong priority application number and the wrong priority date, "Japan 31st December, 1983", was set out in the application form. A certified true copy of the correct Japanese priority document was filed on time on 24 April 1984. This set out the filing date as 31 December 198*2*. The application was published on 10 July 1985.

142 The mistake was only discovered several years later when the patent examiner raised an objection against patentability on the grounds of anticipation and obviousness by reference to a prior art document. The applicant requested correction of the priority date and the file number of the priority application under r 88 of the EPC 1973.

143 The Board of Appeal held at para 4 that r 88 allowed a correction of an incorrect priority declaration without any time bar even after publication of the patent application. Grant of the request was discretionary. The EPO was not bound to permit corrections of any kind and at any time. The overriding principle was to balance the interests of the applicant and those of the public in

respect of legal security. On the facts, the Board was satisfied that since the correction was just in respect of a typing error, the interests of third parties would not be adversely affected by the requested correction even though correction resulted in backdating the priority by one year.

144 The mistake in this case was apparent on the face of the published patent application itself. As a matter of practice, it was impossible to obtain a file number of the same year indicated in a declaration of priority filed three days later. This alone indicated to the careful reader that something was amiss (at para 4.3). Furthermore, the Board noted at para 4.3 that "the practitioner experienced in filing European and international patent applications knows that, if priority is claimed from a Japanese patent application, the original document shows the 'Showa' year. He knows that the transcription of the original source document number, as occurred in the present case, creates an additional source of error." An error of transcription in dates had been made. A certified copy of the Japanese priority document showing the correct date of application had been filed within the time frame allowed.

145 The Board of Appeal allowed correction of the filing date of the priority application as well as correction to the file number of the priority document. It is noted in passing that the *Uni-Charm* decision was briefly referred to by the TBA in *Sumitomo* in respect of permitting a correction where the error was apparent on the face of the published patent application.

146 The second case relied on by Bristol-Myers was the decision of the EPO Board of Appeal in *United States of America (Priority declaration (correction))* J 0002/92 (1 December 1992) ("*USA Priority declaration (correction)*"). The applicant had declared the wrong priority date for the first priority application

cited, as well as the wrong application number of the third priority application cited in the parent PCT application. The incorrect priority application number concerned an entirely different subject matter. The applicant made a request to correct the errors after the parent PCT application entered the regional phase in Europe.

147 The Board granted the request on the basis that the error concerning the application number of the third priority application was apparent on the face of the document. The mistake concerning the priority date (as entered in the declaration) was also apparent on the front page of the publication to practitioners. The Board commented at para 5.2.2 that the priority date of 23 July 1988 was obviously incorrect because "that day was a Saturday and US patent applications are not accorded weekend filing dates." Given the apparent discrepancy concerning the priority date of the priority document, the Board was of the view that the public could not rely on the correctness of the publication of the international application. Third parties interested in the accurate priority date would have investigated the discrepancy and ascertained the correct priority date by file inspection.

148 The Board also granted the request for the correction of the file number of the third priority document for similar reasons (at para 5.2.3). The appellant had submitted that a third party inspecting the file would not have been misled as the inspection would reveal the error since the published international application showed the correct date and State. The Board held there was no substantial interest in maintaining a wrong file number in the published application. Indeed, the Board remarked at para 5.2.3 that:

> Third parties should inspect the file if they wish to draw substantive conclusions from the priority document. In this respect, the file number as such is of no relevance to a

> competitor who has to make up his mind whether he may use the invention or not. A correction does not affect his interests.

The Board of Appeal noted at para 5.2.3, however, that the correction of the file number would only make sense if replacement of the wrong document was still possible more than three months after the publication of the international application. The Board's conclusion was that third parties could not have been misled by the replacement of the wrong document after publication of the international application. An inspection of the file would have revealed that the priority document on file was completely irrelevant. It would have been clear that the correct priority document claiming the priority date of 27 April 1989 was not yet on file (at para 6.2). On the facts, replacement was allowed although the Board of Appeal acknowledged at para 6.3 that problems might arise in other cases if the time limits in the PCT and the EPC have expired and the conditions for re-establishment of rights under the PCT and the EPC are not met.

149 The TBA in *Sumitomo* noted the decision in *USA Priority declaration (correction)* at para 3.7 and the point that it may be necessary for the third party to read the published application but also to consult the priority documents on file. Nevertheless, on the facts in *Sumitomo*, the discrepancy would not have been easy to discover given the similar subject matter and similar titles of the application and priority documents. In short, even if the third party had inspected the file, the error was not obvious or immediately apparent. Even if the third party had been concerned that a mistake had been made, it was not possible in *Sumitomo* for the third party to have discovered what the correct priority document should have been without undue burden.

150 The broad principles which emerge from the above European decisions and r 88 of the EPC 1973 can be summarised as follows:

(a) Rule 88 of the EPC 1973, now r 193 of the current EPC, allows correction of an incorrect priority declaration without any time bar even after publication of the patent application.

(b) Grant of the request is discretionary. The EPO is not bound to permit corrections of any kind and at any time.

(c) The overriding principle is to balance the interests of the applicant and the interests of the public in respect of legal security.

(d) Generally, the request should be made in time so that an appropriate warning can be provided in the publication of the application.

(e) Where the request for correction is made after publication of the application, the request could only be granted if there were "very exceptional" reasons.

(f) Whether exceptional reasons exist depends on the facts and circumstances, including whether the error and the correct position was obvious or readily apparent on the face of the published application or by reference to other documents in the patent file.

(2) Corrections and the UK Patents Act

151 For completeness, I note that the position under the UK Patents Act is similar to the principles before the EPO. Section 117 of the UK Patents Act is equivalent to s 107 of our Patents Act. Rule 105 of the Patent Rules 2007

(SI 2007 No 3291) (UK) ("the UK Patents Rules") implements s 117 of the UK Patents Act and is broadly equivalent to r 91 of our Patents Rules.

152 *The CIPA Guide to the Patents Acts by the Chartered Institute of Patent Attorneys* ("*The CIPA Guide*") (Paul Cole & Stephen Jones eds) (Sweet & Maxwell, 7th ed, 2011) at para 117.07 explains that s 117 of the UK Patents Act is general in its application to all documents filed in connection with a patent or an application. The provision does not extend to procedural errors or omissions such as mistakes in the filing of a document. *The CIPA Guide* also states that the requirement that the correction must be obvious only relates to corrections of the specification. Corrections to other documents are not required to be obvious in the sense that "it is immediately evident that nothing else would have been intended in the original specification." *The CIPA Guide* notes that where the priority application has been wrongly stated, this can be corrected without the need to invoke s 117 provided it is done within the priority year. If this is not done, a request under s 117 is necessary with evidence to establish the error and the proper manner of its correction according to the original intention of the applicant.

153 In exercising the discretion, *The CIPA Guide* refers at para 117.08 to the need to balance the interests of the applicant and that of the public who may have relied on the uncorrected document. In line with the EPO decisions, *The CIPA Guide* recognises the desirability of making corrections before the publication of the application so that a warning can be included in the publication. Requests for correction after publication requires special circumstances to be shown, as where the mistake is apparent on the face of the published application in line with *Uni-Charm* and *USA Priority declaration (correction)* decisions.

(3) Relevance of EPO decisions

154 Decisions of the EPO and its Boards of Appeal are not binding in Singapore. That said, they are of some persuasive value since our Patents Act Singapore was based on the UK Patents Act, which in turn implemented the UK's obligations under the EPC. There are, however, important differences in some of the provisions (substantive and procedural) which have an impact on the persuasive value of the EPO decisions on the issue at hand. For example, the wording of r 88 of the EPC 1973 is not the same as r 91 of the Patents Rules. There is also no procedure under the Patents Act whereby a third party can bring opposition proceedings after publication of the application and before grant.

Is Bristol-Myers entitled to seek correction of the entries under r 91?

155 Bearing in mind the differences between the Patents Act and the EPC, the first question is whether the errors were obvious from an inspection of the entries in the Register and indeed the patent forms and documents. Whilst the background as to how the error was made has been set out above, it may be convenient to highlight certain points in connection with the question as to whether the errors were obvious.

156 It will be recalled that the Singapore Patents are connected with a corresponding US patent 6,673,372 for CEFA. The application for this US patent was filed on 10 June 1999 and claimed a priority date of 11 June 1998 based on US provisional application number 60/088,981.

157 Subsequently on 10 June 1999, the international patent application, PCT/99/13199, also titled CEFA, was filed with a claimed priority date of 11 June 1998.[28] The wrong priority application number was entered, namely

"US 60/089,981" instead of "US 60/088,981". It appears that a certified copy of the Paper patent was also filed at the receiving office on 30 August 1999.[29]

158 On 28 November 2000, the PCT international application entered the national phase in Singapore. On that date, PF37, for grant of what became the SG 77853 patent, was filed at the Registry. The request was later made for issuance of grant of patent on 9 December 2002, and SG 77853 was granted on 30 May 2003.

159 On 15 February 2002, an application was made to the Registrar to correct typographical errors in the address, name and assignment of the Singapore patent applications from DP to Bristol-Myers.

160 Thereafter, on 2 December 2002, the three divisional patent applications based on SG 77853 were filed. The covering letter to IPOS dated 2 December 2002 correctly described the invention for the divisional applications as CEFA. The incorrect priority document application number was not detected and was also entered in the divisional applications. Included with the divisional applications was a copy of the priority document, namely US application "60/089,981", the Paper patent.

161 On 6 January 2004, US patent 6,673,372 for CEFA was granted. On 24 March 2005, Patents Form 11B was filed in Singapore so as to rely on the alleged corresponding US patent 6,673,372 to obtain grant of the three divisional Singapore patents. The US patent as submitted bore the correct US priority application number.

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[28] Affidavit of Warren K Volles, para 18(1).

[29] See Defence and Counterclaim, paras 18(b)&(c).

162 IPOS subsequently issued the certificate for grant for SG 111980, SG 111981 and SG 134977 on 29 June 2007, 31 July 2007 and 30 November 2007 respectively. The incorrect priority document application number was still not detected and was entered on the Register for the divisional patents.

163 Subsequently, during the course of these proceedings, the entries in the Register were corrected to set out the correct US priority application number. No change or alteration was made to PF1 or any of the other forms filed in connection with the applications for the Divisional Patents.

164 Based on the facts, it is clear that a mistake of a clerical nature had been made when filling out the US application number in respect of the claimed priority date in PF1. The mistake originated from an earlier error that was made when the international patent application under the PCT was filed at the receiving office of the PCT.

165 The original mistake was made by the agents for DP. At the time when the Singapore applications (the main and divisional applications) were published, the errors had not been detected. A third party looking at the Singapore applications as published might not have any reason to suspect that there was an error in the declared priority details. The name or title of the invention associated with the erroneous application number that was entered in the forms was not set out in the forms or the applications as published. He would only have cause to suspect something was amiss if he inspected the patent file and discovered that the application number referred to the Paper patent. To be clear, there is no doubt the patent files after 2 December 2002 (if not before) included US application number "60/089,981" for the Paper patent as this had been submitted with the three divisional applications.

166 It may have been apparent to a practitioner inspecting the file at that stage that there was some error in the application number and/or patent application cited for priority. The declared US application number concerned an invention which on inspection of the file was obviously for something completely different and unrelated to pharmaceutical inventions. The difficulty, however, is that it would still not have been immediately apparent at this stage what the error or mistake concerned was (see, for example, *Fontech* at para 8). Even if the court assumes that the diligent experienced patent agent would have been able to discover the correct number and patent document by conducting appropriate searches – time and effort would have to be expended.

167 On 30 May 2003, the Registrar granted SG 77853. At this point, the divisional applications had not yet been granted. On 24 March and 1 April 2005, US patent 6,673,372 for CEFA was submitted to the Registry in connection with the divisional applications. The patent document provided stated the correct priority application (US 60/088,981). It follows that a careful practitioner examining the files for the divisional applications after the above dates would realise that the correct US application relied on for priority must or should have been US 60/088,981, and that a single-digit error had been made in the application number.

168 Novartis submitted that if the request had been made under r 91(1) of the Patents Rules, they would have had an opportunity to oppose the correction under r 91(5) if the Registrar had decided to exercise his power to advertise the proposed correction under r 91(3). The Registrar, however, has a discretion as to whether advertisement is necessary. Further, under r 91(2), it is only when the request for correction relates to a specification that the correction shall not be made "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 a correction." There is no express provision that the error and correction should be obvious on the face of the application of the patent when the request relates to something other than the specification.

169 Nevertheless, I turn now to consider the position on the basis that the broad principles developed by the EPO in respect of r 88 of the EPC are applicable in the sense that exceptional grounds are necessary where a correction to declared priority information is requested after the publication of the application.

170 Section 27(1) of the Patents Act in brief provides that where application has a date of filing then as soon as possible after the end of the prescribed period, the Registrar shall publish it as filed. Rule 29(1) of the Patents Rules provides, *inter alia*, that an application for a patent shall be published for the purposes of s 27 as soon as possible after the expiration of 18 months from the declared priority date. Rule 93 goes on to set out detailed provisions on inspection of documents filed or kept at the Registry in relation to the application or any patent granted in pursuance of it. It follows that the application as filed for SG 77853 as well as the applications for the divisional patents would have been published as required by s 27. Any practitioner examining the published applications would not have been aware of the error in the declared priority application number. No request had been made for correcting the priority data at that stage.

171 There is no doubt that the request for corrections in the present case, whether in respect of the forms or the Register, was made very late indeed. Even though the original error is clerical in nature and dates all the way back to the

filing of the international application on 10 June 1999, an important point to consider is the impact or effect of the error (and the late request for correction) on the rights and interests of third parties. The series of decisions emanating from the EPO discussed above highlights the importance of correcting errors as soon as possible and preferably before the publication of the application. There are several reasons for this. First, patent rights on grant take effect from the date of publication of the application. Second, under the EPC, there are extensive pre-grant opposition proceedings whereby third parties can within the prescribed time limits commence opposition proceedings after publication of the application. As was said by the TBA in *Sumitomo* at para 3.5.2:

> The requirements for declaring and filing the particulars of a priority within time limits prescribed by Rule 38 EPC aim at giving the public a timely possibility to study the content of the claimed priority, as part of the information gathering process before deciding whether or not to oppose the patent. The right to challenge the patent by way of an opposition under Articles 99 and 100(a) EPC would be seriously undermined if the identity of the priority document were to be corrected after the start of the nine month period in which an opposition may be validly filed.

172 For these reasons, the "reliability" of the priority details as set out in the published application is regarded by the EPO as highly important as they may have an impact on a third party's decision as to whether opposition proceedings should be commenced within the prescribed period.

173 The position in Singapore is, however, different at least in one aspect. As noted, Singapore did not and still does not have any pre-grant opposition procedures whereby third parties can challenge the patent pre-grant. In Singapore, third parties can only formally engage the patent after grant by bringing revocation proceedings.

174 It is noted that the Patents (Amendment) Act 2004 (No 19 of 2004) did introduce a complicated post-grant search and examination procedure that could be invoked by third parties. Leaving aside the details, this procedure merely provided the public with an avenue to obtain the views of a patent examiner on whether the claims were broader than what was examined in the examination report or the prescribed information which was examined for novelty, inventive step and industrial applicability, or where the examiner had not considered all the relevant prior art (see *A Guide to Patent Law in Singapore* (Alban Kang gen ed) (Sweet & Maxwell, 2nd Ed, 2009) at paras 4.8.1–4.8.2). This procedure did not affect the granted patent as such. It merely enabled a third party in appropriate cases to obtain a written report from the examiner on the points raised. The post-grant search and examination procedure was not akin to revocation proceedings (post-grant) or opposition proceedings (pre-grant) as such. This procedure was repealed by the Patents (Amendment) Act 2012 (No 15 of 2012), and the new "positive grant" system took effect in 2014.

175 It follows that the failure to correct an error before publication of the applications does not attract the same consequence on a third party in Singapore as it does under the EPC. It does not have a prejudicial effect on his right to bring opposition proceedings pre-grant for there is no such procedure in Singapore.

176 Post-grant, any interested party has the right to bring revocation proceedings or to challenge the validity of the patent by way of defence in infringement proceedings. In many cases, the issues raised will concern novelty, inventive step, capability of industrial application and sufficiency as tested against the prior art as it existed at the priority date of the invention. In these

cases, the question as to what is the priority date that the patent owner is entitled to assert is of fundamental importance.

177 As noted above, the general rule is that the priority date is the date of filing of the application. Section 17 of the Patents Act allows the applicant to assert and claim an earlier priority date based on a filing in another "convention country" (see [9] above) that took place within the preceding 12 months. In such cases, a declaration must be made under s 17(2). This is what happened in the case at hand. The problem is that this is precisely where the mistake was made when the erroneous earlier US application set out in the international application was copied over into the Singapore applications. The claimed priority date is correct. The error is that the cited priority document for that date was incorrect by a single digit in the US application number.

178 Whilst it is true that there is nothing in the published applications or the entries in the Register that would indicate an error had been made in the US application number, any third party inspecting the files for the divisional application after 24 March and 1 April 2005 would have discovered the error since the granted US patent for CEFA had been included by this time.

179 In any event, any third party who was interested in the accuracy of the claimed priority date would have immediately appreciated on looking up the patent that the cited patent application had nothing to do with the invention in question. Indeed, the Paper patent was on file. At this stage, the third party could have brought revocation proceedings, or defended on the basis of invalidity if he was being sued for infringement. The question to be resolved is whether the patent owner is disentitled from relying on the declared priority date under s 17(2) (because of the errors). And if so, does this mean that the issues of

validity would have to be assessed against the state of art at the filing date of the applications for the Singapore Patents? Indeed, this remains an issue to be dealt with in the High Court suit.

180 Novartis submits that a strict approach to correction of priority details should be taken on account of the fact that Singapore, at the time of the Singapore applications and grant, operated a "self-assessment" examination system under which the applicant bore the responsibility of ensuring that the subject matter of the claims met the patentability criteria. Singapore only changed to the "positive grant" system in 2014. Novartis's argument was that under the self-assessment system, the responsibility fell on the applicant/patentee to ensure accuracy of the priority details.

181 Whilst I accept the general proposition that the applicant/patentee is responsible for the correctness of the information including priority details set out in the application, this does not mean that clerical errors and mistakes can never be corrected. The Patents Act and Rules, even under the self-assessment system, include extensive provisions touching on requests for corrections of errors in the application, documents and the Register. Conversely, the fact that a positive grant examination system has been implemented does not mean that the applicant/patentee is relieved of his responsibility for the correctness of the information required under the applicable Rules and provisions. In short, I am not persuaded that the fact that the Singapore applications in question were made at a time when the self-assessment system was used is a reason for a stricter approach.

182 To recapitulate, the error was clerical in nature. The identity of the correct US application and number was likely apparent at the latest from

24 March and 1 April 2005 by inspection of the divisional application files. Third parties were not prejudiced by correction after publication of the applications, at least not in the sense that their right to bring opposition proceedings was affected. Any third party examining the patent applications and the entries in the Register would have understood that the date claimed for priority was 11 June 1998. So far as revocation proceedings and infringements proceedings are concerned, the correction does not change the *claimed* priority date. The question whether Bristol-Myers is entitled to rely on that priority date given the errors is a matter that will have to be decided in the High Court suit.

183 I note that s 76 of the Patents Act provides that the applicant for a patent enjoys, as from the publication of the application, the same right as he would have had if the patent had been granted on the date of the publication of the application. Proceedings for infringement can only be brought however after the patent is granted (see s 76(3)). It follows that even though the Patents Act does not provide for pre-grant opposition proceedings, the publication of the application is still significant in that the rights effectively take effect from the date of publication if only on a provisional basis. This is clearly a matter of interest to the public at large.

184 The point might be raised that since opposition proceedings are not available pre-grant, any interested member of the public will need to wait until grant before commencing revocation proceedings. The patent applicant will also of course have to wait until grant of the patent before he can commence infringement proceedings. If infringement proceedings are commenced post-grant and before revocation proceedings are brought, the defendant can still raise validity as a defence to the infringement.

185 The difficulty, however, is that a third party may still need to consider his position as from date of publication since he will be on notice that the patent is indeed "pending", and that if the patent is granted, it may have an impact on the third party as from the date of publication of the application. As was said by the EPO in *Fontech* decision, third parties (including competitors) need "a reliable legal basis for the economic decisions they have to take" (at para 5).

186 The general rule is that the priority date for assessing validity against the state of art is the date the application was filed in Singapore. If the applicant wishes to claim the benefit of an earlier date by reference to an earlier qualifying application, he bears the burden of making the declaration as required by s 17(2) of the Patents Act.

187 Even though there is no pre-grant opposition procedure in Singapore, third parties will be put on notice by the publication of the application that their interests are already provisionally affected by the pending patent. This is undoubtedly a serious matter that affects the public as a whole. Even if it was apparent that some error must have taken place in the priority declaration at date of publication of the applications for the Singapore Patents, it would not have been apparent even on an inspection of the files as to what was the correct earlier US application intended to have been relied upon. The correct earlier application number might have been discovered by research of patent databases – but time and effort would have been required. It would only have been after the alleged corresponding granted US patent for CEFA was filed to obtain grant of the divisional patents that an inspection of the file would have pointed to the correct earlier US application number.

188 For this reason, I have, albeit with some reluctance, come to the decision that even if a request had been made to correct the entries in the forms under r 91 that the request came far too late, and in any case, the request was not supported by exceptional grounds.

189 I note in passing that Novartis also asserts that the errors were not obvious in that they did not relate merely to a mistake in a document (the priority declaration) but rather, that the wrong document had been filed. In support, they rely on *David E Berg et al* BL/O/235/05 (26 August 2005). In this case, an international application was filed under the PCT, claiming priority from an earlier US application. Unfortunately, the wrong specification was filed with the international application. Subsequently, the international application entered the national phase in the UK and the national phase application was published. Thereafter, a request was made to replace the complete specification with the correct specification for the earlier US patent application, as a correction under s 117 of the UK Patents Act and r 91 of the UK Patents Rules. The UK Patent Office Hearing Officer refused to allow the request. As in Singapore, where the request relates to a specification, no correction is 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 question whether the correction is obvious is assessed from the viewpoint of the skilled addressee. On the facts, the Hearing Officer found that that the skilled addressee would have not considered the correction obvious. In any case, the request was not to correct an error in a document but a procedural error in the filing of a document. The request was to replace the specification filed with a different specification. This fell outside the scope of s 117 of the UK Patents Act and r 91 of the UK Patents Rules.

190 If it were necessary to decide the point, I would agree that r 91 of the Patents Rules does not extend to corrections of an error in the filing procedure or the replacement of an erroneous document with a new (correct) document. Bristol-Myers, however, is not requesting a correction to the specification. The correction here relates to the application number set out in the priority declaration filed as part of the application.

Other arguments raised in favour of refusing correction

191 Aside from the points dealt with above, Novartis raised numerous other grounds or reasons as to why any discretion to allow corrections the documents and Register should not be permitted. These can be briefly dealt with in the paragraphs that follow.

192 *The role of the International Bureau and IPOS*. It is evident that neither the International Bureau nor IPOS detected the error in the US application number provided in respect of the priority declaration whether at time when the applications were filed, published or granted. The assertion made was that this fact demonstrates the error made was not obvious or readily detectable.[30] The short response is that even if the error was not obvious from a perusal of the application forms and the priority declaration, the error or mistake was apparent after 24 March and 1 April 2005 when the US patent for CEFA was submitted as part of the process to obtain grant of the divisional patents.

193 In any case, I note that s 87(1)(*b*) of the Patents Act (as of the date of filing of the SG 77853 patent on 10 June 1999) states that "any declaration of priority made under the [PCT] shall be treated as made under section 17(2)". Bristol-Myers rightly points out that IPOS will adopt the particulars of the

[30] Affidavit of Ferrari, paras 53–54.

priority application from the international application without independently verifying the accuracy of the particulars.[31] The fact that IPOS followed the procedure in adopting the declaration of priority made in the international application does not, however, assist Bristol-Myers for the reasons discussed earlier.

194 *Negligence and undue delay*. The application for SG 77853 was published in Singapore on 20 February 2001. After grant, the details were entered in the Register on 30 May 2003. Novartis makes the point that some 13 or 15 years had elapsed since the erroneous priority details had been made available to the public and the correction of the Register on 20 and 21 June 2016. The delay was considerable. Novartis assert that Bristol-Myers could have discovered the errors much earlier had they acted with reasonable diligence, such as when Patents Form 11A was filed in late March 2005 in connection with the divisional applications. The fact that Bristol-Myers had acted quickly after they became aware of the error in late 2015 was irrelevant. Novartis submits that "[t]he sole question is whether the public is prejudiced" and that the corrections were "time-barred".[32]

195 There is however no "time-bar" for making applications under s 107 and r 91 (or indeed r 58). Novartis makes the point that under r 26*bis* of the PCT Regulations, strict time limits are imposed on making requests for corrections to the priority claim of an international application. These periods had long expired with the result that the errors in the priority application number in the international application could no longer be corrected. Novartis's position is that Bristol-Myers's priority claim based on its international application was

[31] Bristol-Myers's submissions, para 53.

[32] Novartis's submissions, para 102.

permanently invalid.[33] It is not necessary for this court to decide the legal effect of the error made in the priority declaration under the PCT and under s 17(2) of the Patents Act. This is a matter that is best addressed at the hearing of the High Court suit.

196 Nevertheless, given the submissions of the parties, a few passing observations are appropriate.

(a) Rule 4.10 of the PCT Regulations states, *inter alia*, that any priority claim shall be made in the request, shall consist of a statement to the effect that the priority of an earlier application is claimed, and shall indicate: (i) the date on which the earlier application was filed; (ii) the number of the earlier application; and (iii) other stated particulars.

(b) Rule 26*bis*.2 of the PCT Regulations provides that where the receiving Office or the International Bureau finds in relation to a priority claim, *inter alia*, that the priority claim does not comply with the requirements of r 4.10, or that any indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document, the receiving Office or the International Bureau shall invite the applicant to correct the priority claim.

(c) Under r 26*bis*.2(b), if the applicant does not submit a notice correcting the priority claim before the expiration of the time limit, that priority claim shall, subject to r 26*bis*.2(c), be considered not to have been made and the receiving Office or the International Bureau shall so declare and shall inform the applicant accordingly.

[33] Novartis's submissions, para 116.

(d) Rule 26*bis*.2(c) goes on to state, *inter alia*, that "[a] priority claim shall not be considered void only because… the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing; [or] an indication in the priority claim is inconsistent with the corresponding indication appearing in the priority document". Under the PCT, a missing application number is not treated as rendering the priority claim void as such. That said, the question whether an incorrect application number should have the effect of rendering the priority claim void is a matter that is best left for the trial.

197 *Bad faith*. The point was raised in the written submissions that Novartis had been denied the chance to raise objections to the corrections prior to the decision of IPOS to allow the correction to the Register. Complaint was made of the fact that Novartis had not been copied in the correspondence with IPOS. Further, complaint is made of the fact that IPOS was not informed of the pending infringement proceedings. To this end, reference was made to r 30(1) of the Legal Profession (Professional Conduct) Rules 2015 (GN No S 706/2015) ("PCR") and the duty of a solicitor not to communicate with the Court on facts, issues or any other matters in Suit without providing the other side with a reasonable chance to reply.

198 Novartis's submission is that r 30 of the PCR should apply *mutatis mutandis* to communications with IPOS notwithstanding that the Rule is concerned with communications to the court.[34] In short, the submission is that solicitors have an ethical duty under the PCR to copy and notify counterparts of any communications made by them to the Registry on matters relating to

[34] Novartis's submissions, paras 26–42.

pending proceedings. The fact that there was no obligation to inform Novartis under r 58 of the Patents Rules was irrelevant.

199 In oral argument, counsel for Novartis appears to have withdrawn or downplayed the assertion of bad faith by the clarification that he was not alleging bad faith against any individual in particular. The complaint was the use of the wrong procedure had caused prejudice to Novartis. Nevertheless, I reject the submissions on bad faith in so far as it is based on the Patents Rules. There is nothing in either rr 58 or 91 which requires the applicant (the person making the request) to inform other persons who may be affected by the correction. There is no duty to advertise the request for correction. An advertisement is only required if an application is made under r 91 and even then, only if the Registrar decides that this is an appropriate step to take. Bristol-Myers indeed tried to apply under r 91 but were unable to proceed because the electronic online system refused to accept the application for the reasons discussed earlier. The point has been made that after communications with IPOS, the application was made to correct the entry in the Register under r 58. In these circumstances, I am of the view that the conduct of Bristol-Myers in seeking the correction to the Register under r 58 and the manner in which the request was made and dealt with, did not fall short of acceptable standards of commercial behaviour.

200 Since Novartis did not in oral argument press the submissions based on professional ethics and the PCR, I say no more on the point. That said, I note in passing that GM, the senior partner of the law firm representing Novartis in the present action, was also a partner of ECGM, the law firm which handled the national phase of the application for SG 77853, the parent patent. Indeed, it is apparent that GM was the solicitor who had conduct of the national phase

applications. It will be recalled that the erroneous US application number set out in the international PCT application (PCT/US 99/13199) was not detected and was copied into the Singapore application. Thereafter, ECGM became ECMS. ECMS took over as agent. It appears that GM remained in charge of the application at ECMS. The three divisional applications were filed by ECMS on 2 December 2002. At some point ECMS changed into ECSF. ECSF took over as agent. ECSF obtained grant of the divisional patents after filing the alleged corresponding granted US patent no 6,673,372 which contained a reference to the correct application number.

201 ECMS and ECSF appear to be specialist companies offering patent and intellectual property advice and services. Whilst the parties in submissions have expressly referred to ECGM, ECMS and ECSF in respect of the handling of the applications before IPOS, the precise relationship between ECGM (the law firm) and ECMS and ECSF was not dealt with in the affidavits or submissions.

202 During submissions, Mr Suhaimi of Mirandah Law LLP, counsel for Novartis, in response to the question whether his firm had handled the national phase and divisional applications, responded that it was a different firm who was then acting for DP and Bristol-Myers. Whilst GM is the senior partner of Mirandah Law LLP, the point made was that ECGM, ECMS, ECSF are different entities and distinct from Mirandah Law LLP. Whilst the parties had disclosed and indeed highlighted the legal representation of DP and Bristol-Myers in connection with the grant of the Singapore patents in the proceedings before me, no specific issue was raised on representation and the substantive issues before me. It is accordingly unnecessary to make any further comments.

Conclusion

203 For the reasons discussed above, my principal finding and conclusion is as follows:

(a) Bristol-Myers was entitled to make the request to correct the entry in the Register as to the application number for the declared priority date under r 58 of the Patents Rules. The request was not made in bad faith.

(b) The request to correct the entry in the Register should not have been granted since the Register had accurately set out the earlier application number as set out in the published applications and the forms that had been filed.

(c) Bristol-Myers was not entitled to seek correction to the entries in the application forms under r 58.

(d) The correct procedure for correcting the error in the application forms is under s 107 of the Patents Act and r 91 of the Patents Rules. That said, the request should be refused for the reasons set out above.

204 It follows that this application is allowed with costs. I shall hear the parties if they are unable to agree on the amount of costs.

George Wei
Judge

Suhaimi bin Lazim, Chow Jian Hong and Yan Chongshuo (Mirandah Law LLP) for the applicant;
Alvin Lim Jun Hao and Desmond Chew Tse Sern (Dentons Rodyk & Davidson LLP) for the respondent.
