Intellectual Property Office

BL O/344/20

7th August 2020

PATENTS ACT 1977

PROCEEDINGS

Opposition under Section 117(2) of the Patents Act 1977
in respect of a request to correct the application form of GB 2 570 857 A

Wootzano Ltd	Opponent
and	
Zakareya Hussein	Requester

HEARING OFFICER Stephen Probert

For the opponent: Dr Andrew White of Mathys & Squire LLP

For the requester: Dr Michael Ellis of Ellis IP Limited

Decision off the papers

DECISION

Background

1. Patent application GB 2570857A (the application) was filed on 27 November 2017. It concerns flexible substrate laminates for electronic devices (eg. force sensors). The application form (Patents Form 1) gave the name of the applicant and sole inventor as Dr Atif Syed. The address for service on the application form is Dr Michael Ellis, the applicant's agent at that time

2. On 10 September 2018, Dr Syed wrote to the Office requesting the removal of his patent agent, Dr Ellis, as the address for service in respect of the application. At the same time, Dr Syed also provided his own name and address as the new address for service. A week later, on 17 September 2018, Dr Ellis wrote to the Office acknowledging that a new representative had been appointed, and (for the avoidance of doubt) withdrawing himself as representative. Three days later, on 20 September 2018, there was a further change of address for service when Dr Syed appointed Mathys & Squire LLP as his new representative.

3. On the same day, 20 September 2018, Dr Ellis (the former agent) requested a correction to the application form (Patents Form 1) under section 117(1) and rule 105(1). The request says that the application form should have included a

second applicant/inventor, and that the second name (Zakareya Hussein) had been left out in error.

4. The uniqueness of this request, eg. coming from an agent who is no longer authorised to represent the applicant, may have caused some head-scratching in the Office. A month later, while the Office was still deciding how to handle the request, the new agent (Mathys & Squire) filed a statement of inventorship[1] naming Dr Atif Syed and Dr Enrico Mastropaolo as the two inventors.

5. Shortly after, by virtue of an assignment made on 29 October 2018, Dr Syed transferred the patent application to a company that he had founded, Wootzano Limited.

6. After seeking comments from the patent applicant in respect of the correction request, the Office wrote to Zakareya Hussein (% Dr Ellis) on 12 September 2019 refusing the request and advising that if he believed that Zakareya Hussein should be granted a patent for the invention described in this application, he should make a reference for entitlement under section 8 of the Act.

7. Dr Ellis complained that this refusal did not provide any reasons, and also that he had not been sent a copy of the evidence provided by the patent applicant. This prompted some further head-scratching in the Office, and a reconsideration of the correction request. Although it does not clearly state that the refusal was rescinded, that is the only way in which the official letter of 18 October 2019 can be interpreted. It confirms that the correction request would be advertised in the Official Journal for opposition purposes on 13 November 2019.

8. These proceedings were commenced on 10 December 2019 when the patent applicant, Wootzano Ltd, filed an opposition to the correction request.

The Law

9. It may be helpful to set out the relevant legal provisions at this point — ie. section 117(1) and rule 105.

> **Correction of errors in patents and applications**
>
> 117.-(1) The comptroller may, subject to any provision of rules, correct any error of translation or transcription, clerical error or mistake in any specification of a patent or application for a patent or any document filed in connection with a patent or such an application.
>
> **Correction of errors**
>
> 105.—(1) A request to the comptroller to correct an error or mistake under section 117 must be made in writing and identify the proposed correction.
>
> (2) The comptroller may, if he thinks fit, require the person requesting a correction to produce a copy of the document indicating the correction.
>
> (3) Where the request is to correct a specification of a patent or application, the request shall not be granted unless the correction is obvious (meaning that it is immediately evident that nothing else could have been intended in the original specification).

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[1] Patents Form 7 dated 17 October 2018

(4) But paragraph (3) does not apply where the error in the specification of the patent or application is connected to the delivery of the application in electronic form or using electronic communications.

(5) Where the comptroller determines that no person could reasonably object to the correction no advertisement shall be published under rule 75.

(6) Where the comptroller is required to publish a notice under section 117(3), it must be published in the journal.

(7) This rule does not apply to a correction of a name, address or address for service (which may be corrected under rule 49).

10. The correction request does not refer to rules 49 and 50, but these provisions are worth reproducing here as they are the more common statutory provisions used for correcting names.

Correction or change of name or address; correction of address for service

49.—(1) Any person may request that a correction be entered in the register or made to any application or other document filed at the Patent Office in respect of any of the following—

(a) his name;

(b) his address;

(c) his address for service.

(2) A request under paragraph (1)(a) to correct a name must be made on Patents Form 20. (3) Any other request under paragraph (1) must be made in writing.

(4) If the comptroller has reasonable doubts about whether he should make the correction—

(a) he must inform the person making the request of the reason for his doubts; and

(b) he may require that person to file evidence in support of the request.

(5) If the comptroller has no doubts (or no longer has doubts) about whether he should make the correction, he must enter the correction in the register or make it to the application or document.

(6) For the purposes of this rule a request for a correction includes—

(a) a correction made for the purposes of section 117; and

(b) a change to any of the matters listed in paragraph (1)(a) or (b) in respect of an entry recorded in the register or made to any application or other document filed at the Patent Office.

Request for correction of error

50.—(1) Subject to rule 49, any person may request the correction of an error in the register or in any document filed at the Patent Office in connection with registration. (2) The request must be—

(a) made in writing; and

(b) accompanied by sufficient information to identify the nature of the error and the correction requested.

(3) If the comptroller has reasonable doubts about whether there is an error—

(a) he shall inform the person making the request of the reason for his doubts; and

(b) he may require that person to furnish a written explanation of the nature of the error or evidence in support of the request.

(4) If the comptroller has no doubts (or no longer has doubts) about whether an error has been made he shall make such correction as he may agree with the proprietor of the patent (or, as the case may be, the applicant).

Case Management Conference

11. A CMC was held on 21 April 2020 to determine the most appropriate way of dealing with this opposition. I was particularly concerned that whatever the outcome of this correction request, it would almost certainly be followed by entitlement and/or inventorship proceedings between the parties. That would be the usual procedure for determining which inventor(s) contributed to the invention in the patent application, and, as a consequence, to whom the application belongs. However, both Dr Ellis and Dr White told me that entitlement and/or inventorship proceedings were not inevitable; I did not understand how they could be so certain.

12. After listening to Dr White and Dr Ellis, it was my preliminary view that it would not be appropriate for the Office to allow the correction. It appeared to me that the provision in section 117 is intended for typographical corrections, usually requested by the owner of the patent or patent application, that will generally be non-contentious[2]; whereas this correction is being opposed by the owner. I also observed that the Act makes specific provisions for questions of ownership and inventorship of patent applications - eg. sections 8 and 13. In connection with this latter point, I referred to *Antiphon AB's Application*[3], which (as Dr Ellis accepted) establishes that a provision such as section 117 which is expressed in general terms in the Patents Act cannot be used to circumvent a specific provision directed to the matter in question.[4]

13. Having heard my preliminary view, Dr White was content for me to decide the matter without further evidence or submissions from the opponent. Dr Ellis quite reasonably wanted an opportunity to respond with written submissions in support of the correction request, and in particular to address the issues that had come up in the CMC. With a view to minimising the cost and inconvenience to the parties, I proposed to give Dr Ellis a period of four weeks in which to provide written submissions and if, having read those submissions, I was not persuaded that the correction should be allowed, I would proceed to issue a decision to that effect without needing to put the opponent to the unnecessary expense of filing evidence or submissions. Both Dr White and Dr Ellis agreed with this approach.

14. Dr Ellis filed his written submissions on 19 May 2020. Although he has put the case for the requester very clearly, I have concluded that the correction cannot be allowed, for the following reasons.

The reasons

15. I have considered this matter from two different directions, and I am going to set out my reasons along both lines. Both approaches reached the same result, and I think there may be some synergy between them, which is why I have decided to set them both out.

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[2] In most cases the comptroller does not need to advertise requests for corrections because he considers that no person could reasonably object — rule 105(5).

[3] Antiphon AB.'s Application [1984] RPC 1

[4] This was already a well established legal principle, but Antiphon shows that it applies to this specific area of patent law.

16. To begin with, I assumed that section 117 can be used to correct Patents Form 1 so as to insert an additional named applicant/inventor. In this approach, the critical question is which rule applies: is it rule 105, or does rule 49 apply?

17. Secondly, in view of the fact that there has been an opposition to the request for correction, I needed to consider whether the use of section 117 in a case like this would be circumventing a more specific legal provision. In this approach, the critical question is whether, in this particular case, sections 8 and 13 are more specific provisions than section 117?

18. In some respects, it might have appeared more logical to set out the two sets of reasons in the reverse order (eg. because it might not have been necessary to consider the rule 49 point if section 117 itself does not apply), but I have stuck with the order in which I processed the issues mentally. This seemed to fit with the submissions of both parties that they are not anticipating entitlement and/or inventorship proceedings to follow, after this correction request has been decided. It also corresponds with the chronology of these proceedings, since the second question only arose some time after the request was filed — ie. when it was opposed.

Does rule 49 apply?

19. This question was discussed at the CMC, and is also covered in Dr Ellis' written submissions. It is an important question because if rule 49 does apply in this case, the standard of proof required by the Office before the correction can be made is 'beyond doubt', as distinct from the more usual 'balance of probabilities'. Given that the registered owner of the patent application is opposing the correction, I think it was common ground that if the standard of proof is as high as 'beyond doubt', then it would be very unlikely that the correction would be allowed.

20. Dr Ellis says that rule 49 does not apply because if it did, Patents Form 20 must be used, and Patents Form 20 is entitled 'A request to correct a name or address *held by us*' (Dr Ellis' italics), and according to parts 4, 5 & 6 of the form, and with particular reference to note c on the reverse of the form, it is apparent that the form is particularly for changes (corrections or updates) of actual names already on the register. This clearly weighs in Dr Ellis' favour, but as it is only an administrative form designed to give effect to rule 49, I cannot give it enough weight to outbalance the plain meaning of the words in rule 49 itself.

21. Furthermore, Dr Ellis refers to an official consultation document[5] that was produced by the IPO ahead of amendments to the Patents Rules in 2016. Paragraph 53 of the document (with Dr Ellis' underlining) says:

> 53. Rule 49 governs the correction of names, addresses, and addresses for service relating to patents and patent applications (i.e. where there was an <u>error</u> in the information recorded <u>on the register</u>). The rule also covers changes of name, address and address for service (i.e. where the information was correct but there is then a change in situation, such as a house move). However, the existing rule only explicitly refers to "corrections" and does not mention "changes". The rule

[5] https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/503493/Proposed_changes_to_the_Patents_Rules.pdf

therefore understandably causes confusion for some customers, who are unclear whether the rule applies to both situations. Consequently, we propose to amend the rule to make clear that it covers both situations. We propose replacing rule 49(6) with:

> "(6) For the purposes of this rule a request for a correction includes-
>
> (a) a correction made for the purposes of section 117; and
>
> b) a change to any of the matters listed in paragraph (1) in respect of an entry recorded in the register or made to any application or other document filed at the Patent Office."

22. Dr Ellis submits that it is clear from this consultation document that rule 49 covers corrections and changes, but that it is specific to names already on the register.

23. I am inclined to agree with Dr Ellis with respect to the "changes" covered by subsection (6)(b), but I do not consider that the text of the consultation document assists his case in respect of "corrections". The words that Dr Ellis has underlined in paragraph 53 of the consultation document appear to me to describe exactly the situation that he is seeking to rectify — ie. an error in the information recorded on the register. Moreover, as in relation to the wording on Patents Form 20, the wording of the consultation document can only go so far in assisting with the interpretation of rule 49; it cannot significantly change the plain meaning of the words in the rule.

24. Dr Ellis also goes back to an even earlier incarnation of rule 49, In the Patents Rules 1995, the rule corresponding to current rule 49 was rule 45. It was titled "Alteration of name or address", and the opening subsection read as follows:

> 45.—(1) A request by any person, upon the alteration of his name, for that alteration to be entered in the register or on any application or other document filed at the Patent Office shall be made on Patents Form 20/77.

25. Referring to another official consultation document [6] from 2007 when it was proposed to replace this rule with the current rule 49, Dr Ellis points out that although the word 'alterations' was to be replaced with 'corrections', the consultation document confirms that there was "intended to be no change of practice". It was at this time that subsection (6) was introduced to make it clear that rule 49 would then [also] apply to the correction of a name or address under section 117. Dr Ellis interprets this as meaning that name alterations (now termed corrections) are made under rule 49 regardless of whether one's name has legally changed or was incorrect by way of an error of transcription.

26. However, I think Dr Ellis is wrong to limit the operation of section 117 to errors of transcription here in connection with rule 49, while at the same time maintaining that section 117 has a much broader scope (eg. in relation to rule 105) so as to permit the addition of an entirely new applicant and/or inventor on Patents Form 1. He can't have his penny and the bun.

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[6] https://webarchive.nationalarchives.gov.uk/20140603184010/http://www.ipo.gov.uk/consult-patentrules.pdf

27. Dr Ellis argues that rule 105 applies in this instance, and not rule 49. Rule 105 is frequently used for making corrections to patent specifications, however it clearly has a broader scope. While subsection (3) prevents a correction being made to a patent specification unless the correction is obvious, by implication this requirement does not apply to other corrections.

28. The difficulty I have with this, is subsection (7) of rule 105 — ie. rule 105 does not apply to a correction of a name. Dr Ellis says that he is not seeking to correct a name; he maintains that he is seeking to correct some errors that he made when completing Patents Form 1. It is an attractive argument, and if I only had to consider rule 105, I think it might have prevailed. But rule 49(1) clearly allows a person to request that a correction be …. made to any … document filed at the Patent Office in respect of … his name. I consider that that covers a correction to Patents Form 1 that concerns (or is in respect of) the requestor's name (Zakareya Hussein).

29. My understanding of the effect of rule 105(7) is that where correction of a name (or address) is concerned rule 105 specifically does not apply, because rule 49 exists to meet this need.

30. Furthermore, it would seem inconsistent to require the high standard of proof in rule 49 (ie. beyond doubt) when correcting or changing names that are already on a document, and yet accept a significantly lower standard of proof when the change involves adding a completely new name. For these reasons I am satisfied that rule 105 does not apply, and rule 49 does.

31. Having found that rule 49 applies, I still need to consider whether the correction should be made. Patents Form 20 has not been filed, but that is an omission that could be easily and swiftly rectified if that was the only difficulty. However, as I have intimated above, it is not the only difficulty. If the owner of this patent application had consented to the correction, or possibly even if they had not actively opposed the correction, I strongly suspect that the correction would be allowed. But as the owner has opposed the request for correction, I cannot say that the comptroller has no doubts about whether he should make the correction. Even if these proceedings were drawn out sufficiently to enable a full analysis of the respective contribution of all the alleged inventors, it is still unlikely that the comptroller would have no doubts about whether he should make the correction. Most entitlement proceedings are decided on the balance of probabilities, and it would be quite rare for the comptroller to have no doubts about the outcome of one of those cases.

32. Dr Ellis says that the question that needs to be decided is not the complex issue of inventorship, but the much simpler issue of what name(s) he should have entered on the Patents Form 1 at the time of filing the patent application. He says there are three possible scenarios:-

    1. He didn't list Zakareya Hussein as an inventor/applicant because he had not appreciated that he was a co-inventor;
    2. He knew that Zakareya Hussein was a co-inventor, but for some reason made an informed decision not to name him as a co-inventor;

3. He knew that Zakareya Hussein was a co-inventor, but erred at the time of filing the application by failing to enter his name in Patents Form 1.

33. According to Dr Ellis, in the first two scenarios there is no error in the form, and the correction should not be entered. But in the third scenario, there is an error in the form, and it should be corrected.

34. I am unable to accept this submission. It seems to me that it was not a single isolated oversight that lead to the omission of Zakareya Hussein's name on Patents Form 1. At part 7 of Patents Form 1 (dealing with inventorship), the following questions have been answered as shown in bold:-

> Are all the applicants name above also inventors? **Yes**
>
> If yes, are there any other inventors? **No**

35. In other words, Dr Ellis did not merely forget to include Zakareya Hussein's name on the form as an inventor in addition to that of the applicant (Atif Syed). He positively affirmed that there were no other inventors by answering "No" to the second question at part 7.

36. I also note, in passing, that if this was an accidental omission, it went unnoticed for almost a year, and was only detected after there was a falling out between Atif Syed and Zakareya Hussein. Dr White says [7] that:

> "… the request for correction has been filed approximately 10 months after the application was originally filed and four months after the original applicant, Atif Syed parted ways with his ex-business partner Zakareya Hussein in May 2018. In the intervening period letters were sent between solicitors acting on behalf of Atif Syed and solicitors acting on behalf of Zakareya Hussein relating to a potential defamation action … The request was therefore not filed in a timely manner, and is part of a wider business dispute between Zakareya Hussein against Atif Syed."

37. So the first approach, relying upon section 117 and rule 49, ends with the result that the correction *cannot* be made because of remaining doubt about whether it *should* be made. Continuing these proceedings, with evidence rounds and further argument, would not remove that doubt. This brings me to the second approach.

Generalia specialibus non derogant

38. This delightful latin phrase refers to a well established legal principle that general provisions should not be construed so as to derogate from more specific ones. It is the reason why I referred to *Antiphon*[3] at the CMC.

39. In the following passage from *Antiphon*, at page 10 lines 16-28, Falconer J concluded:

> "Section 117(1), which I have already read, is, of course, expressed in general terms, but to allow, under its provisions and those of rule 91 (which is the rule made pursuant

[7] In a letter from Mathys & Squire to the office dated 28 June 2019. (Para 1.6)

> thereto), correction of an error or mistake such as that sought to be corrected in this case, so as to allow the application to proceed as if the drawings filed later were part of the documents initially filed, would be to allow the provisions of section 117(1) and rule 91 to 20 be used to circumvent the clear mandatory provisions of section 15(2). Section 15(2) is a particular enactment in the statute and, although section 117(1) is an enactment in general terms in the statute, it seems to me that it can have no application to a case which falls within the terms of section 15(2) and must be taken to affect only the other parts of the statute to which it may properly apply: see *Halsbury's Laws of England,* 3rd Edition, 25 Volume 36, paragraph 597 at page 397. In my judgement, under the provisions of section 117(1) and rule 91, a correction may not be allowed if the effect of it would be to allow an applicant to circumvent the clear mandatory requirements of section 15(2)."

40. In this case, it is clear to me that there is a dispute between the registered owner of the patent application (Wootzano Ltd, originally Atif Syed) and the requestor (Zakareya Hussein) as to who should be named as an inventor on the patent application, and (in consequence) to whom the patent application rightly belongs. There are, as I have said, specific legal provisions in the Act for resolving such disputes — section 8 and section 13. Section 117 is a general provision allowing correction of errors. It would not be consistent with the principle of *generalia specialibus non derogant* to allow section 117 to be used in an attempt to deal with a genuine (inter partes) dispute that should more properly be considered under section 8 and/or section 13.

41. Had I been aware of it at the time, I might also have mentioned *Genentech & MDC v The comptroller* [8], in which the Court of Appeal confirmed that section 117 is an entirely general provision about rectifying errors in documents and it cannot be used to nullify the effect of other, more specific provisions.

42. In his written submissions, Dr Ellis argues that the principle of g*eneralia specialibus non derogant* is not relevant in this situation because he says that sections 8 and 13 are not specific provisions that would prevent the application of section 117(1) to a correction of an error, even if that error concerned the identity of the inventor/ applicant. He says this is because the matter at issue is quite different — it entails not necessarily determining the correct inventorship and the correct ownership, but determining what was his (ie. Dr Ellis') intent at the time of filing (ie. in this case, whether or not to include a second inventor/applicant in the patent application).

43. I disagree. Whatever the intention at the time of filing, the name of the applicant(s) and inventor(s) provided on Patents Form 1 becomes entirely superfluous after the comptroller has determined the question of entitlement under section 8 and/or the right to be mentioned as inventor under section 13 (respectively). I suspect that a request under section 117(1) to correct a name on the application form of a patent application that had already been the subject of a reference under section 8 would get short shrift. In Dr Ellis' words, the **correct** inventorship and the **correct** ownership would have been determined, so why contemplate changing the names on the original application form.[9]

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[8] Genentech Inc and Master Data Center Inc v Comptroller General of Patents [2020] EWCA Civ 475

[9] NB. That is not to say that it would never be appropriate to use section 117 to correct or change a name or address after entitlement proceedings. Eg. there could be several reasons to change or correct a name or address on the register, but I cannot envisage any reason for altering the names on the original application form after the correct ownership/inventorship has been established under section 8 and/or section 13.

44. Consequently, this approach ends with the result that the correction should not be allowed because to do so would involve construing section 117 (a general provision) so as to derogate from the more specific provisions of section 8 and section 13.

45. Despite submitting that the matter at issue is not determining the correct or actual inventorship and ownership, Dr Ellis has provided some detailed explanation of Zakareya Hussein's technical input to the invention in the patent application, but I cannot give it any real weight in the absence of argument and evidence from the opponent, and without allowing the 'evidence' to be tested in cross-examination. In any event, for the reasons given above, I do not think it would be appropriate to do that here. The time and place for that analysis is during entitlement/inventorship proceedings, if/when such proceedings are initiated.

Summary

46. For all the reasons given above, I hereby refuse this request to correct the Patents Form 1.

Costs

47. The opposition has been successful, and the opponent is entitled to a contribution towards its costs in the action. I am not aware of any circumstances in these proceedings that justify an award above the standard scale. The standard scale is set out in Tribunal Practice Notice (TPN) 2/2016. I would assess the various categories as follows:-

Preparing a statement and considering the other side's statement	£250
Preparing evidence and considering and commenting on the other side's evidence	-
Preparing for and attending a hearing (in this case, a short CMC)	£200
Expenses (ie. official fees - Form 15 (£50) and Form 4 (£350))	£400
Total	**£850**

48. Zakareya Hussein is ordered to pay Wootzano Limited the sum of £850 as a contribution towards its costs in this opposition. This sum is to be paid within seven days of the appeal period below.

Appeal

49. Any appeal must be lodged within 28 days after the date of this decision.

Stephen Probert
Deputy Director, acting for the Comptroller