

SOUTH AFRICA / JUDGMENT

Abell v Screen Graphics CC

(2005/6649) [2010] ZACCP 2;

2010 BIP 18 (CP) (9 March 2010)

[2010] ZACCP 2

COURT

Court of the Commissioner of Patents

BEFORE

B.R. Southwood

CASE / FILE NUMBER

2005/6649

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IN

THE COURT OF THE COMMISSIONER OF PATENTS

Date:	2010-03-09
	Case
Number:	2005/6649
	In
the matter between:	ALISTAIR
	RICHARD ABELL Applicant
	and
	SCREEN
	GRAPHICS CC Respondent

JUDGMENT

SOUTHWOOD J

- [1] The applicant, the patentee of South African Patent No 2005/6649 entitled 'An Advertising Device' ('the patent') applies on notice of motion for a final interdict restraining the respondent from infringing the patent by making, using, disposing of or offering to dispose of its Lantern Advertising device ('the Lantern') and an order for delivery-up for destruction of all infringing articles under the respondent's control. In the alternative, the applicant seeks an interim interdict in the same terms pending finalisation of an action to be instituted by the applicant within 20 days of the order. The respondent opposes the application for final relief on the grounds, firstly, that the Lantern does not infringe any claim

in the patent, and, secondly, that the patent may be revoked in terms of s 61 (c) read with s 25 of the Patents Act 57 of 1978 ('the Act') because the invention was not new. The respondent opposes the grant of interim relief on the ground that the applicant has not made out a case for s

[2] It is common cause that the applicant is the patentee of the patent; that the respondent manufactures, markets and distributes the Lantern; that the Lantern is an advertising device which has the material bearing the advertisement stretched outside the framework

created by the shaft and flexible rods connected to the shaft and that the respondent sells and distributes the Lantern at outlets

called 'Adapt Advertising' and 'Hot Ice Promotions'. It is also common cause what the integers of the claims are and which of these

integers are incorporated in the Lantern. Accordingly it is possible to decide on the papers whether or not the Lantern infringes the patent. As will appear later, this depends upon the interpretation of the patent. However, before embarking on the interpretation of the patent it will be convenient to consider the patent specification and claim 1 and the parties' opposing contentions.

[3] The patent sets out the background to the invention and the general description of the invention as follows:

'Background to the invention

The applicant is aware that one dimensional advertising devices such as flags and banners are not visible from all angles. One way of making such one dimensional flags or banners visible is by causing them to rotate. Such a device is described in South African Patent 2003/8904 by the same applicant. It is an object of this invention to provide a further device for advertising, which addresses the problem of visibility.

General description of the invention

According to a first aspect of the invention there is provided a device for advertising, which device includes:

a shaft to be vertically mounted, in use;

an upper connection means proximate the upper end of the shaft for connecting to one end of each of at least two resiliently flexible

rods; and

a lower connection means proximate the lower end of the shaft for connecting to each other end of the resiliently flexible rods, such that with each rod being longer than the distance between the upper and lower connection means a banner of flexible material can, in use, be spanned by each rod in a plane defined by the rod and the shaft.'

[4] Claim 1 of the patent claims -

'A device for advertising, which device includes:

a lower connection means proximate the lower end of the shaft for connecting to each other end of the resiliently flexible rods, such that with each rod being longer than the distance between the upper and lower connection means a banner of flexible material can, in use, be spanned by each rod in a plane defined by the rod and shaft.'

It is common cause that this claim has the following integers:

a device for advertising, which device includes: a shaft to be vertically mounted, in use;

an upper connection means proximate the upper end of the shaft for connecting to one end of each of at least two resiliently flexible

rods; and

a lower connection means proximate the lower end of the shaft for connecting to each other end of the resiliently flexible rods, a device for advertising, which device includes:

(e) such that with each rod being longer than the distance between the upper and lower connection means a banner of flexible material can, in use, be spanned by each rod in a plane defined by the rod and shaft.

[5] To determine whether the patent is infringed a comparison must be made between the Lantern, which is alleged to infringe, and the words of the claims in the patent. If the Lantern falls within the ambit of any of the claims an infringement is proved - see *Letraset Ltd v Helios Ltd* 1972 (3) SA 245 (A) at 274G-H; *Stauffer Chemical Co and Another v Sasfan Marketing and Distribution Co (Pty) Ltd and Others* 1987 (2) SA 331 (A) at 342D-E. The present case turns on whether the Lantern infringes claim 1 of the patent.

[6] The parties agree that the Lantern incorporates integers (a), (b),

(c) and (d) and that the dispute relates to integer (e). The applicant contends that the word 'can' in integer (e) clearly indicates that the feature of having a banner of flexible material

spanned in the plane between the rod and the shaft is not essential to the working of the invention. Accordingly, the applicant contends that because the Lantern incorporates the essential integers, (a) to (d), the Lantern infringes the patent. The respondent contends that integer (e) is essential; i.e. the patent claims a monopoly in the particular way in which a banner of flexible material is used as an advertising device, which is by being spanned by each flexible rod in a plane defined by the rod and shaft. Accordingly, the respondent contends that because

the Lantern does not span the flexible material in a plane defined by the rod and shaft, it does not incorporate integer (e) and does not infringe the patent.

- [7] The parties agree that if integer (e) is essential the applicant's application must fail and if it is not essential the final interdict must be granted. The issue therefore turns on the proper interpretation of the claim.
- [8] In *Aktiebolaget Hassle and Another v Triomed (Pty) Ltd* 2003
- (1) SA 155 (SCA) at paras 8 and 9 the court emphasised that the proper interpretation of a patent claim is not achieved by a meticulous verbal analysis which concentrates on the language used, but by determining the intention of the inventor as conveyed by the language used, purposively: i.e. by establishing what were intended to be the essential elements or the essence of the invention. This is done not by viewing each word in isolation but by viewing them in the context of the patent as a whole. See also *Monsanto Co v MDB Animal Health (Pty) Ltd* (formerly MD Biologies CC) 2001
- (2) SA 887 (SCA) at 892B-C.
- [9] On the question of whether a particular feature is essential to the working of an invention, the court said in *Stauffer Chemical Co and Another v Sasfan Marketing and Distribution Co (Pty) Ltd and Others* supra at 346I-347D:

'To ascertain what are and what are not the essential features or integers of a claimed invention the specification must be read and interpreted purposively or realistically, with the understanding of persons with practical knowledge and experience of the kind of work in which the invention was intended to be used and in the light of what was generally known by such persons at the date of the patent (see the *Frank and Hirsch* case supra at 762-3; the *Marconi* case supra at 217-18; the *Catnic* case supra at 243), which date by our law is the priority date of the claim (see *Burrell* (op cit) para 5.23 at 246)). Obviously, the fact that a claim incorporates a particular feature does not alone suffice to make that feature an essential one. Otherwise the problem would not arise. In general, if the feature is in fact essential to the working of the claimed invention, then it must be regarded as an essential feature. On the other hand, a patentee may indicate in his specification, either expressly or by implication, that he regards a particular integer as essential; and in that event it must be treated as essential and it matters not that it may not be essential to the working of the invention. Where, however, a feature is not essential to the working of the invention and the patentee has not indicated that he regards it as an essential integer, then in general it may be treated as unessential and an alleged infringer may be held to have infringed the claim notwithstanding that his product or process does not incorporate that feature or substitutes an equivalent for it (see the *Van der Lely* case supra at 76 lines 29-30; *Catnic* case supra at 226-7, 228 per Buckley LJ CA and 243 per Lord Diplock in HL).'

- [10] The applicant emphasises the use of the word 'can' in integer (e) and contends that this indicates that a banner of flexible material spanned by each rod in a plane defined by the rod and shaft is merely a possible feature rather than an essential feature of the invention.

While conceding that a banner is an essential feature of the invention the applicant's counsel contends that the wording of the specification indicates that this is not the only place in which the banner will be attached and/or displayed. In this regard the applicant's counsel refers to lines 16-28 on page 4 of the specification, lines 19-22 on page 6 of the specification and claim

12. In my view these passages and the claim do not assist the plaintiff. At best for the applicant they raise as a theoretical

possibility that the banner may be displayed and/or attached in a different place to that referred to in claim 1.

- [11] It is clear that the purpose of the invention is to display a banner on which advertising material appears. Once it is accepted that the device will always display a banner the manner in which it is displayed will be an essential feature of the invention. The manner in which the banner is displayed in the device is expressly set out in integer (e) (as it is in the consistory clause in the body of the specification) and this is not varied in any way in the remaining claims which are all directly or indirectly dependent on claim 1. Nowhere in the claims or the body of the specification or the detailed description of the invention or the drawings is any other method of displaying the banner of flexible material indicated or even suggested. In my view the wording of integer (e), particularly the words 'such that', read together with the word 'can', means that the banner of flexible material is installed in the device in this way and in this position. This is an essential feature of the invention and central to its utility. When read as a whole the patent describes a dart shape when three or more rods are used, or a weather vane if only two rods are used, and makes it plain that the device is designed to catch the wind and rotate. This is made possible if the banners are installed in the manner described in integer (e). Accordingly, the invention clearly provides that the banner of flexible material is to be attached so that it stretches across the plane defined by the rod and the shaft. This is clearly provided because the patent simply does not suggest an alternative.

- [12] Integer (e) is therefore an essential feature of the invention and the applicant has not proved the infringement. The application must therefore be refused. Strictly speaking, that is the end of the matter and renders it unnecessary to consider the other issues

raised. Nevertheless I shall briefly record my views.

- [13] The respondent raised as a defence, as it was entitled to do in terms of s 65(4) of the Act, that the patent may be revoked in terms of s 61(1)(c) read with s 25 of the Act on the ground that the invention was not new. The respondent tendered evidence that in 2005 a device (the J-Teck device) with all the features of the Lantern was displayed at a trade fair in Germany. This preceded the priority date for the patent and, if the Lantern contains all the integers of claim 1, means that the J-Teck device anticipated the invention. The applicant could not dispute this evidence and simply denied that the photographs taken by the witness, Byron de Villiers, showed the features alleged. In argument the applicant's counsel contends that this

evidence is unreliable and should not be accepted, primarily, as I understood the argument, because when the respondent applied for the registration of its patent in respect of the Lantern it must have deposed to an affidavit to the effect that the invention was not anticipated. He also contends that the evidence is vague.

- [14] This is an application for final relief and the applicant is bound by the respondent's averments unless they are so clearly far-fetched, false or untenable that they must be rejected on the affidavits - see *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* [1984] ZASCA 51; 1984
- (3) SA 623 (A) at 632D-634B: *National Director of Public Prosecutions v Zuma* 2009
- (1) SACR 361 (SCA) para
26. I am not persuaded that I should do so in this case. The applicant has not placed the respondent's application before this court. It has therefore not proved that the respondent made a false statement to the registrar of patents. The applicant has also not investigated whether the J-Teck device was on display at the trade fair and accordingly cannot dispute the respondent's evidence to this effect. Nor can the applicant dispute the respondent's evidence that the J-Teck device incorporated all the features of the Lantern. The applicant's denial that the photographs show the features does not assist the applicant in the absence of countervailing evidence with regard to the features.
- [15] The respondent's defence based on anticipation therefore appears to be sound and it follows that the conditional counter-claim should be upheld, provided that the Lantern infringes the patent.
- [16] The applicant has not made out a case for an interim interdict. The applicant has simply made a number of bald averments which have no factual basis. In my view none of the requirements for such relief have been satisfied. See e.g. *Reckitt & Colman SA (Pty) Ltd v SC Johnson & Son (SA) (Pty) Ltd* 1995
- (1) SA 725 (T) at 729I-730E and 733H-734G. The applicant has also delayed bringing the application for interim relief and this is an important reason for the court to exercise its discretion against the grant of interim relief - see *Juta & Co Ltd v Legal and Financial Publishing Co Ltd* 1969
- (4) SA 443 (C) at 445A-F. It was not appropriate to seek interim relief in this application only if final relief is refused. If interim relief was necessary it should have been sought by way of an urgent application pending the outcome of proceedings for final relief. By adopting the procedure which it did in this application the applicant has allowed the respondent to continue doing business with and develop a market for the Lantern.
- [17] I agree with the applicant's counsel that the respondent's costs should not include the costs consequent upon the employment of two counsel and that the importance and complexity of the case were not such that the employment of two counsel was justified.

[18] Finally, I record that the respondent did not proceed with its application for striking out in terms of Rule 6(15). Nevertheless the respondent's counsel contend that the matters sought to be struck out served only to increase the costs. If necessary I would have ordered that the applicant pay the costs of the matter referred to in the notice as it was irrelevant and/or inadmissible and, as contended, simply increased the costs.

Order

[19] The application is dismissed and the applicant is ordered to pay the costs of the application.

B.R. SOUTHWOOD

COMMISSIONER OF PATENTS

CASE NO: 2005/6649

HEARD ON: 1 March 2010

FOR THE APPLICANT: ADV. C.J. VAN DER WESTHUIZEN SC

INSTRUCTED BY: Mr. Pieter Venter of Hahn & Hahn

FOR THE RESPONDENT: ADV. G.E. MORLEY SC

ADV. L.M. MILLS

INSTRUCTED BY: Morrison Foster Inc.

DATE OF JUDGMENT: 9 March 2010

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