

SOUTH AFRICA / JUDGMENT

Bateman Equipment Ltd and Another v Wren Group (Pty) Ltd (480/97) [1999] ZASCA 89; 2000 (1) SA 649 (SCA) (29 November 1999) [1999] ZASCA 89

COURT

Supreme Court of Appeal

BEFORE

Vivier, Grosskopf, Harms, Scott, Melunsky

CASE / FILE NUMBER

480/97

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THE SUPREME COURT OF APPEAL

OF SOUTH AFRICA

Case No. 480/97

In the matter between: BATEMAN EQUIPMENT LTD 1st Appellant
ELANDSRAND GOLD MINING CO LTD 2nd Appellant
and THE WREN GROUP (PTY) LTD Respondent

Coram: VIVIER, GROSSKOPF, HARMS and SCOTT JJA, and MELUNSKY AJA

Heard: 15 NOVEMBER 1999
Delivered: 29 NOVEMBER 1999
Patent amendment to section 51(9) of the Patents Act 57 of 1978

JUDGMENT

HARMS JA/

HARMS JA:[1] The registered proprietor (“the patentee”) of patent 93/6167 instituted infringement proceedings against the appellants in the Court of the Commissioner of Patents. In response, the appellants filed a counterclaim for the revocation of the patent alleging its invalidity because of a lack of novelty, obviousness and a lack of clarity. Attempting to avoid the possible consequences of the counterclaim, the patentee (the present respondent) applied for an amendment of the specification in terms of s 51(9) of the Patents Act 57 of 1978. It provides that where proceedings relating to a patent are pending in a court, any application for the amendment of the specification has to be made to that court. Mynhardt J, sitting as Commissioner, granted the application in spite of the wide-ranging objections to the amendment. The appeal is before us with his leave.[2] On appeal, the number of objections to the amendment persisted in were substantially less than in the court below. Three matters remain in contention: whether the main reason given for the amendment to the former claims 1 and 7

amounted to “full reasons” (s 51(1)), whether these claims in their amended form lack a fair basis in the specification (s 51(6)(b)), and whether certain terms in the amended claims are unclear and would render them invalid and subject to revocation (s 61(1)(f)(i)).[3] The court below and counsel before us assumed that the statutory requirement in s 51(1) of furnishing “full reasons” for a proposed amendment applies to an application which is not governed by that provision but by ss (9). There is no basis for the assumption. Section 51(1) deals with applications for amendment directed to the Registrar of Patents and in terms requires “full reasons”. (See, in general, the discussion of the matter in *Kimberly-Clark of SA (Pty) Ltd (formerly Carlton Paper of SA (Pty) Ltd v Proctor and Gamble SA (Pty) Ltd* 1998 (4) SA 1 (SCA).) The same or a similar requirement is not contained in ss (9). There may be a valid reason for the distinction. If, during the course of litigation concerning the patent an application for amendment is made, the court usually is aware of the reasons for the amendment. To require in those circumstances a setting out of full reasons could be unnecessary and formalistic. This does not mean that, depending upon the circumstances of any particular case, the court should not be informed of the patentee's reasons or that the reasons should not be full (cf *De Beers Industrial Diamond Division (Pty) Ltd v General Electric Company* 1988 (4) SA 886 (A) 895G-J). Nevertheless, the difference between the two cases has material legal consequences: under ss (1), “full reasons” are jurisdictional facts; under ss (9) reasons are not a jurisdictional requirement and a failure to give sufficient reasons can at most be a factor which a court may take into account in the exercise of its discretion to refuse an amendment which is otherwise in accordance with ss (9). In this instance, the onus is on the objector to make out a case that the paucity of reasons is such that the court should exercise its discretion against the patentee.[4] The inventor and managing director of the patentee, Mr Batson, explained in the founding affidavit that, upon the receipt of the counterclaim, he engaged the services of another firm of attorneys, namely the patent attorneys who had drafted the original specification, to take over the conduct of the litigation. This firm advised him that a court could find the patent invalid. Whilst still believing in its validity, he decided to apply for the amendment “with the intention of removing any invalidity from the patent specification, if it exists, and strengthening the patent by limiting the claims to commercial practical embodiments and deleting unnecessary matter.” The main reason for the amendment to claims 1 and 7, he said, was to ensure that they were clearly distinguishable over the prior art. (The appellants' attack is limited to the sufficiency of this reason and the subsidiary reasons dealing with specific words and phrases do not require further consideration.) Batson attached a list of all prior art documents of which he had become aware but added that he did not believe that any were relevant, although one cited by the appellants “could be considered relevant”. [5] The appellant's argument was based upon a statement - in the context of “full reasons” in s 51(1)

- by McCreath J. Speaking on behalf of a full court in *Proctor & Gamble SA (Pty) Ltd v Carlton Paper of South Africa (Pty) Ltd* and another 1997 (3) SA 292 (T), he said that “sufficient information should be given to enable prospective objectors and the Registrar to be properly apprised of the real reasons for the amendment” (at 297G-H). This meant, so the argument went, that it was incumbent upon the patentee to identify that which he accepts forms part

of the prior art and which necessitates the amendment, because without the identification of the prior art potential objectors will not know whether the patentee has achieved the object of the amendment.[6] McCreath J's judgment was overruled on appeal (in Kimberly-Clark) and the substance of the quoted statement was not accepted as correct because it does not reflect realistically the basis of opposition to patent amendments (ibid at 13A-D). Whether the patentee has failed in achieving its object is for the objector to establish (cf Water Renovation (Pty) Ltd v Gold Fields of SA Ltd [1993] ZASCA 169; 1994 (2) SA 588 (A) at 594C-D) and I know of no reason why the patentee should assist the objector in finding fault with the amended specification.

- [7] The nature and object of amendment proceedings must be seen in the context of our patent system as a whole. Ours is a non examining country and an alleged inventor is entitled to a patent for his supposed invention without having to satisfy anyone of its merit or validity. He does not have to give any reasons for his choice of wording. Should he sue for infringement, he has no duty to assist the alleged infringer in establishing whether his monopoly is valid or not. Why should he be saddled with a burden if he wishes to reduce the scope of his protection in an attempt to render the patent valid, while in obtaining or enforcing a monopoly he bears no similar burden? As much as it is in the public interest that persons with inventive minds should be encouraged to give the results of their efforts to the public in exchange for the grant of a patent (cf Miller v Boxes & Shooks (Pty) Ltd 1945 AD 561 at 568 and 578), it is in the public interest that patents should be rectified or validated by way of amendment. [8] Mynhardt J, in a full and careful judgment, held that it depended upon the circumstances whether adequate reasons were provided and concluded that, on the information given, the appellants could have established whether the patentee had succeeded in avoiding the attack on the ground of lack of novelty. It was not argued that he had misdirected himself in a manner which had prejudiced the appellants and this Court has consequently no basis of interfering with his value judgment (South African Druggists Ltd v Bayer AG 1989 (4) SA 103 (A) 108 I-J). [9] In essence, the invention has two aspects. The first is a process for treating a suspension of solid particles in a carrier liquid to separate the liquid from the solids. The other is a settling apparatus which has no moving parts but uses gravity to perform the separation process. In the course of the process, during which the carrier liquid is circulated and re-circulated, the suspension is progressively thickened. The slurry which is formed is withdrawn at the lower end of the apparatus whereas the clarified liquid, due to its lower density, rises and is withdrawn at the upper end.[10] The amendments relating to claims 1 and 7 remain in contention. In the amended specification claim 7 was renumbered and is now claim 6. In quoting these two claims in their amended form, I have underlined the insertions brought about by the amendment and they have been numbered from {A} to {F} in accordance with the system used in the application. Deletions are indicated by square brackets.[11] Claim 1 is a process claim and provides:

"A process for treating a suspension of solid particles in a carrier liquid, which comprises subjecting the particles in the suspension to gravity settling in a treatment zone {A} by feeding the suspension into a feed zone of the treatment zone, the treatment zone having at least an upper free settling region in which free settling of solid particles through the liquid takes place, a hindered settling region below the free settling region in which hindered settling of particles takes place, and a compaction region below the hindered settling region in which the solid particles are in contact with one another so that a slurry is formed in this region[;] {B} the feed zone being located in the free settling region ; withdrawing clarified liquid from the free settling region; allowing liquid, in at least the compaction region, to move upwardly along at least one upwardly inclined pathway {C} located in at least the compaction region while at least partially protected from settling solid particles {D} each said pathway being provided in the lee (relative to the direction in which the solid particles are settling) of at least one continuous or discontinuous static inclined separating member;

allowing clarified liquid from the pathway or pathways to pass upwardly through a conduit or conduits into the feed zone, with substantially no mixing thereof with liquid in the free settling region, due to the difference in specific gravities of the clarified liquid passing upwardly and that of the suspension in the compaction, hindered and free settling regions; and

withdrawing slurry from the compaction region."

[12] Claim 6 (originally claim 7) is a claim directed towards an apparatus:

"Settling apparatus, which comprises a vessel providing , in use , a liquid treatment zone having at least an upper free settling region in which free settling of solid particles in suspension in a liquid introduced into the liquid treatment zone, through the liquid, can take place, a hindered settling region below the free settling region and in which hindered settling of particles can take place, and a compaction region below the hindered settling region in which solid particles will be in contact with one another so that a slurry is formed in this region;

feed means for feeding the suspension into the vessel[;] {E} said feed means comprising a feed well or cylinder located in the free settling region and having a suspension discharge outlet at the bottom thereof; a suspension feed conduit leading into the feed well or cylinder; clarified liquid withdrawal means for withdrawing clarified liquid from the free settling region of the vessel; at least one static separating member having an inclined surface in at least the compaction region of the vessel so that liquid can pass upwardly along an upwardly inclined pathway provided by the [underside of the surface; and] undersurface of the member; {F} a conduit or conduits defining a passageway opening into the feed well or cylinder and adapted in use to receive liquid from the upwardly extending pathway and lead it through at least the free settling region into the feed well or cylinder due to the difference between the specific gravity of clarified liquid in the pathway and conduit(s) and the specific gravity of the suspension in the compaction, hindered and free settling regions; and

slurry withdrawal means for withdrawing slurry from the compaction region of the vessel."

[13] The appellants argue through their expert witness, Mr Kun, and in the heads of argument that insert {A} renders the claim uncertain because the use of the word “by” creates the impression that the gravity settling takes place in the feed zone only. Kun, while insisting that this is what the claim literally means, accepted that such a meaning is nonsensical and in conflict with the body of the specification. The answer to the objection is fairly straightforward. The patent and the claim describe a continuous process. If the claim is read as a whole - as it should be - it is even to the unskilled clear that the feeding of the suspension into the feed zone of the treatment zone is but the first step in the claimed process and that gravity settling takes place throughout the whole process until the slurry settles in the compaction region and the clarified liquid is withdrawn. One can only describe Kun's approach to interpretation as one of “studied obtuseness” (Roman Roller CC and another v Speedmark Holdings (Pty) Ltd [1995] ZASCA 78; 1996 (1) SA 405 (A) 419E).[14] The second aspect of lack of clarity raised is that it is not clear where the different regions (namely the free settling region, the hindered settling region and the compaction region) end or start for any particular installation or process. Before proceeding with a consideration of the facts, it may be useful to recall what the approach to interpretation should be and to refer for that purpose to some extracts from Corbett CJ's judgment in Roman Roller at 419C-420C:

“It is the duty of a patentee to state clearly and distinctly the nature and limits of his claim: to define his monopoly. Only if this is done will others know exactly what they may do and what they may not do. The degree of clarity required is that which leads to 'reasonable certainty'. In determining whether a patent claim stakes its monopoly with a sufficient degree of clarity, the Court must view the patent through the eyes of the skilled addressee in the relevant art; and the Court must take into account that such addressee is expected to use reasonable skill and intelligence in interpreting the language of the patent. He is not required to struggle unduly with it, but he must make the best of it and not adopt an attitude of studied obtuseness.”

“Where the words permit it, an interpretation should be adopted which is consistent with the description of the problem to be overcome and the method of doing so described in the body of the specification.”

“Moreover, the mere fact that simple, non-inventive test trials or experiments may be necessary in order to ascertain whether a particular item falls within the ambit of a patent or not will not invalidate the patent . . .”

The specification states that the various regions are not necessarily sharply demarcated and can overlap. (Kun acknowledges that it is well known and well documented that different regions will change in elevation depending on the process parameters.) Because of the nature of the invention, mathematical precision is not possible and the addressee is called upon to conduct simple, non-inventive test trials in order to establish, in operation, where the borders lie and to adapt the process parameters accordingly. There is not the slightest suggestion in the evidence that the addressee will be unable to perform such tests. Instead, the appellants rely on the argument that the addressee must be able to predict accurately whether a particular process or

apparatus will fall within or outside the limits of a claim. There is no rule that requires that the limits of a claim have to be predictable. The limits only need to be reasonably certain.[15] The last issue relating to the lack of clarity concerns the meaning of the term “inclined surface” in claim 6. Counsel did not raise the matter during oral argument and I find it difficult to fathom what the point is which is made in the heads of argument. Respondent's counsel, in their heads of argument, also had a problem in coming to grips with the argument. The term “inclined surface” is used throughout the specification and it is common cause that it has there a clear meaning. It follows that any ambiguity in the claim can be resolved by means of a quick reference to the body of the specification (*Gentiruco AG v Firestone SA (Pty) Ltd* 1972 (1) SA 589 (A) 615E).[16] Mynhardt J referred with approval to an unreported judgment (*Deton Engineering (Pty) Ltd and another v McKelvey and others*[1]) of Van Dijkhorst J, sitting as Commissioner of Patents. Probably sensing that amendment litigation has become overly formalistic and is being used as a delaying tactic, Van Dijkhorst J, in the exercise of his discretion, refused to consider the question of continuing invalidity in amendment proceedings, holding that they should be ventilated in the pending revocation proceedings. His justification was that since the viability of the patent was the subject of debate in the revocation proceedings, it would *prima facie* be a folly to introduce it as an issue in the amendment proceedings when it is not specifically pertinent to the amendment itself but only generally; amendment proceedings, he said, should be kept relatively simple and issues should not be allowed to multiply. Mynhardt J did not, however, follow the commendable approach of Van Dijkhorst J because the judgment became available only after the argument had commenced. In the light of the exercise of his discretion, the question of continuing validity remained an issue before this Court.[17] I turn then to the final and main point argued, which is whether the two claims in their amended form are fairly based on matter disclosed in the specification before amendment (s 51(6)(b)). Unless they are so based, their amendment could not as a matter of law have been granted. [18] It is accepted (at least implicitly) by the appellants that the amendment did not introduce new matter or matter not in substance disclosed in the specification before amendment (ss (6)(a)), and that the amended claims fall wholly within the scope of the unamended claims (ss (7)). The appellants have also not alleged in their counterclaim that the unamended claims were not fairly based upon the unamended specification. If (i) the old claims were fairly based upon the old specification, (ii) no new matter was introduced into the body of the specification and (iii) the new claims fall wholly within the scope of the old claims, it ought to follow logically that the new claims are also fairly based upon the old specification. That would put an end to the objection, but in the event of any fault in the equation, I proceed to deal with the issue as argued.[19] Appellants' counsel took as the point of departure a threefold test propounded by Lloyd-Jacob J (*In the matter of the Mond Nickel Company Ltd's Application for a Patent* [1956] RPC 189 (PAT) at 194) for determining whether the claims of a complete specification are fairly based upon an earlier provisional specification (see s 33(2) and (5)), the submission being that the requirement must “certainly be analogous” to the “fair basis” requirement of s 51(6)(b) (by parity of reasoning, presumably also to that of s 32(4) read with s 61(1)(f)(ii) which deals with the requirements for claims). Burrell *South African Patent and Design Law* (3rd ed) does not agree and argues that the two situations are “not altogether analogous” (at par 2.31 and 2.57). Whether the situations are analogous or not

is unnecessary to decide. But before dealing with the Mond Nickel test, it appears to me appropriate to determine at the outset what the object of the requirement of fair basis in s 51(6)(b) is and then to consider whether or not, properly construed, the new claims are fairly based upon the original disclosure.[20] It is a basic requirement of patent law that a patentee is not entitled to claim more than he has disclosed and identified as the invention in the specification. That does not mean that the claim may not extend beyond the examples or embodiments disclosed, but only that the claim may not be for something not covered by the general or generalised disclosure of the invention. (Cf Burrell at par 2.32; Matbro Ltd v Michigan (Great Britain) Ltd and another [1973] RPC 823 (Ch) 831; Screen Printing Machinery Ltd's Application [1974] RPC 628 (PAT) 635; Singer The European Patent Convention p 715.) Transposed to the amendment stage, and taking into account that the effect of an amendment is retrospective, the objective of s 51(6)(b) is to prevent an inventor from claiming ex post facto something not contained in his original disclosure which has become available for public inspection. The previous Patents Act 37 of 1952, for instance, had a substantially identical requirement (s 36(3)), namely that the amended claim had to be limited to matter disclosed in substance in the original (cf Ethyl Corporation's Patent [1972] RPC 169 (CA) 195). In that judgment the point was made that the provision should be interpreted in a broad common sense way (at 192 line

- 23) and that it should be given a liberal interpretation so as to permit any fair amendment which has already in substance been disclosed (at 195 line 9).[21] [21] The Mond Nickel questions, having been formulated in a different context, have to be adapted in order to fit facts of the present case. So adapted, one must determine first whether the objectionable part or integer “can be said to have been broadly described” in the original specification; then one must consider whether there is anything in the original specification which is “inconsistent with” the integer; and last, whether the original specification is “wholly silent” on the integer. I have some reservations about whether there are three enquiries, or whether these questions are not really the same couched in a different form.

It is difficult to envisage how a specification can describe in broad terms something on which it is wholly silent or how something inconsistent with the invention can at the same time fall broadly within its terms.[22] In order to identify the appellant's complaint I intend to refer to the argument as developed in the heads of argument and will only to a limited extent attempt to deal with the oral argument. The latter, it seems to me, amounted to nothing other than the written argument although at times it was presented as something different. The objection relates to insert {D} in claim 1 and insert {F} in claim 6. Both inserts are to the same effect, the only difference being that the one relates to the process and the other to the apparatus performing that process. Since the objection is the same, I shall limit the discussion to insert {F} because it is easier to describe.[23] For purposes of the discussion it is necessary to explain in more general terms a few aspects of claim 6. As mentioned, it claims a settling apparatus. The contaminated liquid passes through a treatment zone which is divided into three settling regions. In the third and lowest region, the compaction region, the slurry is deposited. There is in this region one or more static separating members which may be cone-like. (For ease of understanding I shall limit the discussion that follows to cones, fully aware that the claim is wider.) They form, in the terms

of the specification, an “upwardly extending pathway” - the purified or partially purified liquid passes upwardly along the inner side of the inverted cone and from the apex of the cone, by way of a conduit (of which there may be more than one), to the upper part (the feed well) of the apparatus where clarified liquid is drawn off. Insert {F}, among other things, defines the conduit. Relevant for present purposes is the requirement that the conduit must be “adapted in use to receive liquid from the upwardly extending pathway”. [24] For the conduit merely to be adapted in use to receive liquid from the upwardly extending pathway, say the appellants, is not sufficient. The conduit, according to the argument, in order to be consistent with the unamended specification, should at least lead from an upper edge of the uppermost static inclined surface (the inverted cone in the example). In other words, the conduit must at least protrude from or be connected to the top cone. (Mynhardt J held, and it is not in issue that, properly interpreted, the amended claim does not require such protrusion or connection.)[25] The specification in its unamended form stated that the conduit “may lead upwardly from an upper edge of at least the uppermost static inclined surface, into the feed well so that, in use, clarified liquid passes from the underside of the surface over its upper edge, along the conduit, and into the feed well.” (My emphasis.) The appellants' confusion arose from the fact that the underlined “may” was consistently rendered as “must” in the heads of argument. Also, they relied heavily on the drawings which show two examples of the use of a conduit, in both instances connected to the cone, thereby suggesting that claims must be based on examples and may not be based upon a general disclosure. Eventually it was conceded, as it was conceded before Mynhardt J, that the specification did not require a connection between the static inclined surface (in my example, the inverted cone) and the conduit. [26] The retreat was a repeat of the events in the court below. The alternative argument there and here was that the integer meant that the conduit could be “remote” from the static inclined surface, something not envisaged by the unamended specification. I have difficulty with the argument. The integer does not use the term “remote”, nor does it imply that the conduit can be “far apart” (the meaning of remote) from the upper end of the static inclined surface. The conduit is defined by function in the body of the specification: it must convey the liquid from the apex of the cone to the feed well. The same applies to the integer. The conduit must be adapted in use to receive liquid from the upwardly extending pathway and to lead the liquid to the feed well. If it is so adapted, it cannot be “remote” or “far apart” from the upper edge of the cone.[27] For the sake of completeness I revert to the Mond Nickel questions. From what I have said, it follows that the integer was broadly described in the original specification, that nothing therein is inconsistent with the integer and that the specification is not wholly silent on the matter.[28] In the result the appeal is dismissed with costs, such costs to include those consequent upon the employment of two counsel.

L T C HARMS JUDGE OF APPEAL AGREE: VIVIER JAGROSSKOPF JASCOTT JAMELUNSKY AJA

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