

SOUTH AFRICA / JUDGMENT

Buzbee (Proprietary) Limited v Registrar of Patents and Anoter (2002/8482, A644/08) [2010] ZACCP 4; 2010 BIP 42 (CP) (14 April 2010) [2010] ZACCP 4

COURT

Court of the Commissioner of Patents

BEFORE

Ebersohn

CASE / FILE NUMBER

2002/8482, A644/08

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N THE COURT OF THE COMMISSIONER OF PATENTS FOR THE REPUBLIC OF SOUTH AFRICA
HELD AT PRETORIA

Case No. Patent 2002/8482 (A644/08)

Date: 14/04/2010

In the matter between

BUZBEE (PROPRIETARY) LIMITED Appellant

and

THE REGISTRAR OF PATENTS First Respondent

COBB INTERNATIONAL LIMITED Second Respondent (Patentee)

JUDGMENT

HANDED DOWN ON 14 APRIL 2010

JUDGMENT

EBERSOHN AJ.

[1] The appellant will be referred to as "Buzbee" in this judgment and the respondent, who is also the patentee, as "Cobb".

[2] South African patent number 2002/8482 was granted to Cobb on the 31st December 2003 on an application filed on the 21st October 2002, and claimed priority from South African provisional patent application number 2001/2447 filed on the 26th March 2001 in terms of the provisions of the Patents Act, No. 57 of 1978 ("the Act").

[3] Buzbee filed a statement dated the 18th December 2007 through its attorneys Hahn & Hahn Inc. ("Hahn & Hahn")

attacking the patent and wherein Buzbee asked for the following

orders:

(a) that South African patent number 20023/8482 be revoked; and

(b) that costs be awarded to the applicant in the event that the application is opposed.

[4] The statement was served on D.M. Kisch Inc. ("D.M. Kisch"), the attorneys of Cobb, on the 18th December 2007.

[5] In terms of Patent Regulation 90(1) the patentee had two months within which to lodge and serve a counterstatement. Regulation 90(1) reads as follows:

"Within two months of the lodging and service of the application for revocation the patentee shall lodge and serve a counterstatement in the form of a plea. If a plea is not lodged and served within two months of the application for revocation or within any extension of that period in terms of regulation 99, the patent shall be deemed to be revoked." (Own accentuation)

[6] On the 19th February 2009 Hahn & Hahn addressed the following letter to the Registrar:

"APPLICATION FOR REVOCATION OF SOUTH AFRICAN

PATENT NO. 2002/8482.

We refer to the attached application for revocation which was served and filed on 18 December 2007.

In terms of Patent Regulation 90(1), the patentee had two months within which to lodge and serve a counterstatement. By close of business on 18 February 2008, we had not received such a counterstatement.

This morning, on 19 February 2008, a counterstatement was served on us. The counterstatement does not appear to have been lodged at the Patent Office prior to being served on us and we are therefore not sure whether it has been lodged at the Patent Office at all.

The patentee has not requested an extension of time in terms of Patent Regulation 99 to lodge and serve the counterstatement and the Applicant would in any event not agree to such an extension at this late stage.

Accordingly, the patentee has failed to properly lodge and serve a counterstatement in this matter by the deadline of 18 February 2008. In terms of Patent Regulation 90(1), the patent shall therefore be deemed to be revoked.

The Applicant requests that the patent register and the relevant file at the Patent Office be marked accordingly.

Please do not hesitate to contact the writer should you have any questions regarding the above."

[7] On the 19th February 2008 D.M.Kisch addressed the following letter to Hahn & Hahn:

"APPLICATION FOR REVOCATION OF SOUTH AFRICAN PATENT NO. 2002/8482 IN THE NAME OF COBB INTERNATIONAL, LIMITED.

With reference to the abovementioned matter and due to unforeseen circumstances our counterstatement, in response to your application

for revocation, was delivered one day late.

We hereby request your agreement to an extension of time, ex post facto, to serve and file our counterstatement and your agreement not to proceed with the revocation of the patent based on the late filing of our counterstatement. Failing your agreement, we will apply for an extension to the Registrar.

We are looking forward to hearing from you."

[8] Patent Regulation 99 reads as follows: "99.Time Limits

Time limits specified may be extended by consent of the parties or, failing such consent, by the registrar on a request made to him."

[9] On the 20th February 2008 Hahn & Hahn wrote as follows to D.M. Kisch:

1. We thank you for your fax received after 4:30 pm on 19 February 2008.
2. It is our client's instruction not to agree to an extension which we, in any event, do not believe to be possible as the deadline had already passed."

[10] On the 20th February 2008 D.M. Kisch filed a Form P4 with the Registrar of Patents requesting an

"Extension of time of one day, in which to

file a counterstatement in response to an application for revocation of South African Patent number 2002\8482 which was fded on 18 December 2007."

[11] On the 27th February 2008 D.M. Kisch wrote the following letter to

Hahn & Hahn:

"APPLICATION FOR REVOCATION OF SOUTH AFRICAN PATENT NO. 2002/8482

We refer to your letter dated 19th February 2008, a copy of which came to the writer's attention on 22nd February 2008, as well as your letter dated 20 February 2008.

We enclose herewith our request to the Registrar dated 20 November 2008.

As you will see from such request and the affidavit attached thereto, the counter-statement was served on your offices on 18 February 2008 after you had closed for business and a second copy was served on 19 February 2008. The counterstatement was lodged at the patent office on the morning of 19 February 2008.

On 19th February 2008 we requested an extension of time from your client which was declined as is confirmed in our letter dated 20 February 2008, making it necessary for the patentee to make its request to the Registrar.

We would be pleased if you would indicate whether or not the applicant opposes the patentee's request for an extension of time made to the Registrar in terms of regulation 99, and, if so, the grounds of such opposition.

In the event that the applicant does not oppose the application we would be pleased if you should inform us of this fact so that we may communicate this to the Registrar who may then deal with the request accordingly."

[12] To the Form P4 containing the request was attached an affidavit which reads as follows:

"I, the undersigned,

ELIZABETH MAGRIETHA ABBOTT

do hereby make an oath and state as follows:

1. I am an adult female attorney presently employed as a professional assistant at the Sandton branch of DM Kisch Inc at 54 Wierda Road, Wierda Valley, Sandton.
2. This affidavit is made in support of a request in terms of Regulation 99 of the Patent Regulations, for an extension of one day to 19 February 2008, of the time period of two months for the lodging and serving of a counterstatement provided for in terms of Regulation 90(1).
3. The principal application for the revocation of South African Patent No 2002/8482 was filed by the applicant on 18 December 2008.

Accordingly, the time period of two months provided for in terms of Regulation 90(1) for the lodging and service of the counterstatement expired on 18 February 2008.

4. On Thursday, 14 February 2008, I prepared a draft counterstatement in response to the application for revocation ('the application'), on behalf of the patentee which is the respondent in the application for revocation.

5. On Friday, 15 February 2008, my supervising director Karel Bredekamp and I met with counsel in order to settle the counterstatement.
6. On Friday afternoon, when I left my place of work in Sandton, I had with me a settled and signed original counterstatement together with copies to be served on Monday, 18 February 2008 on the applicant's attorneys, Hahn & Hahn Inc. at 222 Richard Street, Hatfield, Pretoria. I took personal custody of the documents as I was to be working at the Pretoria branch of DM Kisch Inc. on Monday 18 February 2008.
7. On Monday morning, 18 February 2008, I left my home and went directly to the Pretoria office of DM Kisch Inc. for a meeting with one of our directors, Mr Adelhart Kruger. I was in the meeting from early that morning and got busy with instructions until 16h30 when I left the office to go home. I had not expected the meeting with Mr Kruger to carry on for so long, I expected the meeting to end before lunch. During that time I forgot completely that I was supposed to serve and lodge the patentee's counterstatement.
8. On Monday evening at around 20h00 I opened my office folder to carry out some work when I saw the counterstatement. It was then that I realized that I had forgotten to serve the counterstatement on Hahn & Hahn Inc. I immediately proceeded to Hahn & Hahn Inc.'s office in Pretoria. I filled in the date with a pencil and signed underneath. I used a pencil as I did not have a pen on me. Hahn & Hahn Inc.'s building faces west with a black steel gate forming a portal in front of the actual front door. I couldn't reach the front door since there was the security gate, so I slid the copy of the counterstatement, which I signed with pencil, through the bars of the gate for a person to find when unlocking the security gate.
9. On Tuesday, 19 February 2008, I arrived on or about 07h00 at Hahn & Hahn Inc.'s offices to conduct a service on an employee in person where I found that someone had already entered the building and the copy of the counterstatement that I left the previous night was not where I had left it.
10. The security guard led me through the front door where a Ms Natasha Botha, who took me to Ms Yolandie Hoffmann who deals with documents served on Hahn & Hahn Inc.. I asked Ms Hoffmann if she received the copy of the counterstatement that I left in the portal the previous evening and she advised that she had not received anything yet, but that the security guard would have taken it and will probably bring it to her some time during that day.
11. I asked Ms Hoffmann if she would not mind changing the pencil writing to pen, when she received the document, so that no one would be able to question the fact that I had left it at Hahn & Hahn Inc.'s premises the previous night. In response to my request she said that the dates on the documents cannot be different. She clearly misunderstood what I was asking of her. I agreed that dates should not be changed, but I tried to explain that I only wanted the pencil writing to be made permanent. I then proceeded to serve another copy of the counterstatement on Ms Hoffmann. After the service, I left for the Patent Office to lodge the original counterstatement.

12. Later in the day I confirmed with Ms Hoffmann that the copy that I had served on the night of Monday 18 February 2008 had in fact been received by another employee of Hahn & Hahn Inc., by the name of "Claudia". I assume that this is Ms Claudia

Bernt, as I see her name appears on Hahn & Hahn Inc.'s letterhead.

13. The failure to comply timeously with the provisions of Regulation 90(1) was not a wilful default on the part of the patentee, but a bona fide error on my part in that I had forgotten to effect service and lodging, as I had been required to do, of a counterstatement

which had been settled and signed off on Friday 15 February 2008."

- [13] On the 10th March 2008 Hahn & Hahn wrote a lengthy letter to the Registrar wherein they argued that as the patent had been revoked , there "is no term that stands to be extended as requested in the abovementioned letter of Messrs. D.M. Kish Inc.."

- [14] On the 20th March 2008 D.M. Kisch responded to the letter of Hahn & Hahn of the 10th March 2008 and therein advanced certain legal arguments contending that the Registrar could legally grant the extension.

- [15] The Registrar on the 16th April 2008 granted the extension and Hahn & Hahn addressed a letter dated the 21 st April 2008 to the Registrar to which was attached a request for reasons in terms of Patent Regulation 78 which request was also filed with the Registrar on the 21 st April 2008.

- [16] The Registrar handed down her written reasons dated the 25th April

2008. The reasons read as follows:

"Re: APPLICATION FOR REVOCATION OF SOUTH AFRICAN PATENT NO. 2002\8482.

GROUNDS FOR THE DECISION TO GRANT AN EXTENSION OF TIME OF ONE DAY REQUESTED BY D.M. KISCH INC. IN WHICH TO FILE AN COUNTER-STATEMENT IN RESPONSE TO AN APPLICATION FOR REVOCATION OF SOUTH AFRICAN

PATENT NO. 2002\8482

In my view, several main points need to be clarified to justify the grant of the above extension.

Firstly, from the affidavit filed by the Respondent with the request for extension of time to file a counterstatement and the fact that the counterstatement has been fded on the very next day after the expiration of the two months period in terms of regulation 90(1) it is evident that it was never the intention of the Respondent for the patent to become revoked.

Secondly, regulation 99 does not specify that a time limit may be extended by the Registrar on a request made to him only before the expiration of the time limit subject to the request for extension thereof. In the present case, the time limit in question is the two month period of time for lodging and serving the patentee's counterstatement - as provided by regulation 90(1). Therefore, the registrar has to rely on regulation 99 for his discretion to extend the two month period provided by regulation 90(1), and such discretion is not limited.

Most of all, the grounds for revocation of a patent are specified in, and limited by, section 61(1) of the Patents Act, in other words sec. 61(1)(a) to (j) are the only grounds on which a patent can be revoked.

The clear purpose of regulation 90 is to allow for an undefended application for revocation, to succeed; not to provide an additional ground for revocation of a patent in a defended application. In the present case, the application for revocation is NOT undefended.

In this regard one should bear in mind that the Patent Regulations do not supersede the Act, they provide means for giving effect to the Patents Act. Hence a regulation should be interpreted in a manner to promote the provisions of the Act,

Furthermore, in terms of regulation 90(1) the patent is only "deemed to be revoked" and in my opinion the Registrar is not functus officio, ergo section 16(2) still applies.

Finally, should I have not been exercised (sic) the discretion to grant the extension on the balance of interests, the respondent would have been gravely prejudiced [Electro-Medical Corporation (Pty) Ltd. v Madame et Monsieur Franchise (Pty) Ltd. and Others has reference (attached)]."

[17] Hahn & Hahn noted an appeal on behalf of Buzbee in terms of the provisions of section 75 of the Act against the decision of the Registrar to the Commissioner of Patents. In the notice of appeal it was contended that the Registrar could not, after the expiration of the two months and whilst the patent was deemed revoked, in terms of Patent Regulation 99 extend the two month period provided for in Patent Regulation 90(1) in which to file a counterstatement.

[18] Patent Regulation 89 prescribes that the application for revocation is to be made on Patent Form P. 20 and which shall be accompanied by a statement of particulars of the grounds upon which the application is based and requires further that the application shall be lodged and served on the patentee. If the patentee fails to file a counterstatement within 2 months "the patent shall be deemed to be revoked in terms of regulation 90(1). In the Act itself the only grounds for revocation of a patent are specified in, and limited by, section

61(1) of the Act, which subsection reads as follows:

"(1) Any person may at any time apply in the prescribed manner, for the revocation of a patent on any of the following grounds only, namely-

(a) that the patentee is not a person entitled under section 27 to apply for the patent;

- (b) that the grant of the patent is in fraud of the rights of the applicant or of any other person under or through whom he claims;
- (c) that the invention concerned is not patentable under section 25;
- (d) that the invention as illustrated or exemplified in the complete specification concerned cannot be performed or does not lead to results and advantages set out in the complete specification;

that the complete specification concerned does not sufficiently describe, ascertain and, where necessary, illustrate or exemplify the invention and the manner in which it is to be performed in order to enable the invention to be carried out by a person skilled in the art of such invention;

that the claims of the complete specification concerned are not-

- (i) clear; or
- (ii) fairly based on the matter disclosed in the specification;
- (g) that the prescribed declaration lodged in respect of the application for the patent or the statement lodged in terms of section 30(3A) contains a false statement or representation which is material and which the patentee knew or ought reasonably to have known to be false at the time when the statement or representation was made;
- (h) that the application for the patent should have been refused in terms of section 36;
- (i) that the complete specification claims as an invention a micro-biological process or a product thereof and that the provisions of section 32(6) have not been complied with."

[19] Section 91 of the Act makes provision for and empowers the Minister to make regulations for the payment of fees and the applicable

tariff, to prescribe the procedure in any proceedings before the registrar of the commissioner, prescribing the service of notices or other documents required to be served in terms of the Act, providing for the conduct and administration of the patent office and the preservation of records, prescribing the contents of any application, notice or form provided for in the Act and as to any other matter required or permitted by the Act to be prescribed by regulation. In the said section empowering the Minister to make regulations, no power is given to the Minister to regulate that there be a further ground of revoking a patent namely by way of the deeming provision contained in Patent Regulation 90(1) and thus by default.

[20] It is clear that the Minister, by way of the deeming provision contained in Patent Regulation 90(1), irregularly added a further

ground for the revocation of a patent namely by default, which is clearly irregular and contrary to the provisions of section 61 of the Act, and which deeming provisions is to be regarded irregular and as pro non scripto and of no force or effect and the Registrar was not functus officio and could act in terms of the provisions of section 16(2) of the Act.

- [21] Furthermore, I am of the opinion that the Registrar correctly ruled that Patent Regulation 99 does not specify that a time limit may be extended by the Registrar on a request made to him only before the expiration of the time limit subject to the request for extension thereof and a declarator in this regard will also be issued. The finding of the Court will obviously necessitate that Parliament must look into the matter and amend the Act.
- [22] It is clear that the appeal should be dismissed with costs and I accordingly make the following order:
1. It is declared that the passage reading as follows;"the patent shall be deemed to be revoked" appearing in Patent Regulation 60(1) is invalid and of no force and
 2. It is declared that the Registrar may, in response to a request for the extension of the period in which to file a counterstatement, made after the expiration of the period of two months prescribed in Patent Regulation 90(1), extend the period in which to file a counterstatement.
 3. The appeal is dismissed with costs which costs will include the costs of senior counsel.
 4. No order is made with regard to the costs of the 9th June 2009 when the matter was postponed .

P.Z. EBR SOHN AJ

COMMISSIONER OF PATENTS

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