

SOUTH AFRICA / JUDGMENT

Glaxo Group Limited v Cipla Medpro (Pty) Limited and Others (90/7136) [2007] ZACCP 1; 2007 BIP 59 (CP) (19 June 2007) [2007] ZACCP 1

COURT

Court of the Commissioner of Patents

BEFORE

B.R. Southwood

CASE / FILE NUMBER

90/7136

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IN THE COURT

OF THE COMMISSIONER OF PATENTS

(FOR THE

REPUBLIC OF

SOUTH AFRICA)

Date: 2007-06-19

Case Number:

90/7136

In the matter between:

GLAXO GROUP
LIMITED Patentee
(Applicant for amendment)
and
CIPLA MEDPRO
(PTY) LIMITED
First
Respondent
(Applicant for Revocation)
REGISTRAR OF
PATENTS
Second
Respondent
CIPLA LIMITED
Third
Respondent

JUDGMENT

SOUTHWOOD J

- [1] The applicant, Glaxo Group Limited, applied in terms of Rule 30 for the setting aside of the third respondent's, Cipla Limited's, Notice of Opposition Form P19 and accompanying Statement of Particulars, as an irregular step.
- [2] The applicant is the patentee in terms of the Patents Act 57 of 1978 ('the Act') of patent number 90/7136 Medicaments which relates to the treatment of asthma and other respiratory disorders ('the patent').
- [3] On 7 November 2006 the first respondent, Cipla Medpro (Pty) Limited, launched an application in the Court of the Commissioner of Patents for the revocation of the patent in terms of section 61 of the Act. The application is based on three grounds –
- (1) All the claims are invalid because they lack an inventive step and were therefore not patentable in terms of section 25(1) read with section 25(10) of the Act;
 - (2) Claim 7 is invalid because the invention claimed is a method of treatment of the human or animal body and is therefore not patentable in terms of section 25(1) read with section 25(11) of the Act;
 - (3) Claim 7 is not clear and is therefore liable to revocation in terms of section 61(1)(f) of the Act.
- [4] On 19 December 2006, without conceding that these grounds of alleged invalidity are well-founded, the applicant launched an application in the Court of the Commissioner of Patents to amend the complete specification of the patent by the deletion of claims 6 and 7. Because proceedings relating to the patent were pending in the Court of the Commissioner of Patents the applicant was obliged by the provisions of section 51(9) of the Act to apply for the amendment in the same court. The subsection provides that –
- 'Where any proceedings relating to an application for a patent or a patent are pending in any court, an application for the amendment of the relevant specification shall be made to that court, which may deal with such application for amendment as it thinks fit but subject to the provisions of subsections (5), (6) and (7), or may stay such pending proceedings and remit such application for amendment to the registrar to be dealt with in accordance with subsections (2), (3) and (4).'
- [5] Subsections 51(1), (2), (3) and (4) of the Act govern applications for amendment where there are no pending proceedings in connection with that patent before the court. Subsection 51(9) on the other hand governs applications for amendment where proceedings relating to the patent are pending before the court. The requirements of subsection 51(9) are different from those in subsections 51(1), (2), (3) and (4) which read as follows:

‘51(1) An applicant for a patent or a patentee may at any time apply in the prescribed manner to the registrar for the amendment of either the relevant provisional specification or the relevant complete specification, and shall in making such application, set out the

nature of the proposed amendment and furnish his full reasons therefor.

(2) An application for the amendment of a specification that is open to public inspection shall, except in the case of an application so open in terms of section 43(3), be advertised in the prescribed manner.

(3)(a) Any person may oppose such application for amendment within the prescribed time and in the prescribed manner.

(b) Such opposition to such application for amendment shall be dealt with by the Commissioner in the prescribed manner, and the Commissioner shall determine whether and on what conditions, if any, the amendment ought to be allowed.

(4) Where the acceptance of a specification concerned has not been published in terms of section 42, or there is no opposition in terms of subsection (3)(a) of this section, the registrar may determine whether and on which conditions, if any, the amendment ought to be allowed.’

[6] The applicant caused to be published in the Patent Journal on 27 December 2006 the following advertisement –

‘ADVERTISEMENT OF AMENDMENT DURING REVOCATION PROCEEDINGS

Cipla Medpro (Proprietary) Limited has applied for the revocation of South African patent number 90/7136 in the name of Glaxo Group Limited in respect of the invention entitled “Medicaments”. During the pendency of the revocation proceedings, Glaxo Group Limited made application in terms of section 51(9) of the Patents Act, 57 of 1978, for the amendment of the claims of the patent.

The application for the amendment of the claims of the patent is open to inspection at the Patent Office, DTI Campus, Block F, 77 Meintjies Street, Sunnyside, Pretoria, or copies can be obtained, on request, from the patent attorneys for Glaxo Group Limited whose address is set forth below.

Any person wishing to oppose the application for the amendment of the patent may join in the proceedings by filing a notice of intention to oppose the application for amendment within two (2) months from the date of publication hereof. The further proceedings are to be governed by the provisions of rule 6 of the Uniform Rules of Court, subject to the provisions of section 51 of the Patents Act and Regulations 82-88.

Address for service in the Republic of South Africa: D.M. Kisch Inc, Suite 3, Parkland Building, 223 Bronkhorst Street, Nieuw Muckleneuk, Pretoria. Tel: (011) 324-3000. Ref: N.J. Vermaak.’

- [7] This advertisement elicited a notice of opposition from the third respondent. On 27 February 2007 the third respondent, which is represented by the same attorney as the first respondent, delivered a Notice of Opposition (Form P19) as prescribed by Regulation 82, accompanied by a Statement of Particulars.
- [8] The applicant considered this to be an irregular step and on 9 March 2007 the applicant delivered a notice in terms of Rule 30(2)(b) to notify the third respondent of the applicant's cause of complaint and to give the third respondent an opportunity to remove that cause of complaint. The cause of complaint is described as follows –

‘1.

1.1 The application for amendment is an application brought in terms of section 51(9) of the Patents Act 57 of 1978 (‘the Act’) to amend South African patent 90/7136 (‘the Patent’) while an application for the revocation of the patent is pending.

1.2 The procedure applicable to such an application is that determined by the court. Unless and until other directions are given by the court the Uniform Rules of Court (‘the rules’) apply to such application in terms of section 19(1) of the Act.

2. The opposers filing of Form P19 and an accompanying statement of particulars:

2.1 is a form of opposition which would be appropriate to an amendment application launched in terms of section 51(1);

2.2 is not a procedure or form of opposition applicable to an application in terms of Section 51(9) unless the court so directs (which the court has not done); and

2.3 is in the premises irregular.’

[9] The third respondent failed to remove the cause of complaint and on 10 April 2007 the applicant served its application. The crisp issue is whether the procedure adopted by the third respondent, i.e. delivery of the Notice of Opposition P19 and Statement of Particulars is correct.

[10] The third respondent relies particularly on the third paragraph of the advertisement which reads as follows –

‘Any person wishing to oppose the application for the amendment of the patent may join in the proceedings by filing a notice of intention to oppose the application for amendment within two (2) months from the date of publication hereof. The further proceedings are to be governed by the provisions of rule 6 of the Uniform Rules of Court, subject to the provisions of Section 51 of the Patents Act and Regulations 82-88’.

The third respondent contends that publication of the advertisement brought into operation the provisions of subsection 51(3) and accordingly the procedure prescribed by Regulations 82-88 and that Regulation 82 directs that a notice of opposition shall be made on Form P19 and shall be accompanied by a statement of particulars of the grounds on which the opposition is based. The

third respondent also contends that the reference to Rule 6 of the Uniform Rules of Court does not affect the procedure as the advertisement expressly states that this is to be 'subject to the provisions of Section 51 of the Patents Act and Regulations 82-88' and that the applicant was not entitled to require that the procedure prescribed by Rule 6 be followed, as the rules of court only apply to the extent that the matter is not otherwise governed by the Patents Act and regulations. Finally, the third respondent contends that the applicant cannot seek to set aside as an irregular procedure what the applicant prescribed in the advertisement.

[11] Neither the Act nor the regulations require that there be an advertisement in applications for amendment in terms of section 51(9) and the form of the advertisement is not prescribed, not even for the purpose of subsections (1), (2), (3) and (4). During argument it became clear that the advertisement was placed prematurely to give notice of the application for amendment to interested parties. The applicant determined the content of the advertisement to ensure that other interested parties received notice of the application and knew how and when to give notice of intention to oppose. The Court would then be requested to order that the advertisement was sufficient to give notice to such parties.

[12] Section 51(9) must be read together with section 19(1) which provides –

'Save as is otherwise provided in this Act, the procedure in connection with any proceedings before the commissioner shall, as far as is practicable, be in accordance with the law governing procedure in civil cases in the Transvaal Provincial Division, and in default thereof and where no relevant provision is made in this Act, the commissioner shall act in such manner and on such principles as he may deem best fitted to do substantial justice and to give effect to and carry out the objects and provisions of this Act.'

[13] As pointed out by the applicant, when a court deals with an application for amendment in terms of section 51(9) it must do so in accordance with the procedure provided for in section 19(1); i.e. as far as practicable in accordance with the law governing procedure in civil cases in the Transvaal Provincial Division. The court may stay the pending proceedings and remit the application for amendment to the registrar to be dealt with in accordance with subsections (2), (3) and (4). However, until the court stays the pending proceedings and remits the application for amendment to the registrar the law governing civil procedure in the Transvaal Provincial Division will apply. That is what the law clearly provides. See *Dresser Industries Inc v South African Inventions Development Corporation* 1980 BP 263 (CP) at 265E-267C.

[14] The applicant's notice of motion issued on 19 December 2006 informed the first respondent that if it intended to oppose the application it should notify the applicant's attorney in writing on or before 27 March 2007 and thereafter, within 15 days, file its answering affidavit. The application is clearly one in terms of Rule 6 of the Uniform Rules of Court. The applicant's

advertisement which appeared in the Patent Journal on 27 December 2006 notified third parties that the applicant was applying in terms of section 51(9) of the Act for the amendment of the patent; that the application was open to inspection at the Patent Office, DTI Campus, Block F, 77 Meintjies Street, Sunnyside, Pretoria and that a copy can be obtained, on request, from the applicant's

attorney, D.M. Kisch Inc, Suite 3, Parkland Building, 223 Bronkhorst Street, Nieuw Muckleneuk, Pretoria; that any person wishing to oppose the application may join in the proceedings by delivering a notice of intention to oppose within two months of the date of publication of the advertisement. It also stated that further proceedings were to be

governed by the provisions of Rule 6 of the Uniform Rules of Court, subject to the provisions of section 51 of the Patents Act and Regulations 82-88.

[15] This last statement is superficially confusing but clearly susceptible of ready clarification. If the third respondent's attorney read the application for amendment he would have seen that he was dealing with an application in terms of Rule 6 of the Uniform Rules of Court. The advertisement informs him that if the third respondent wishes to oppose it can do so simply by delivering a notice of intention to oppose within two months of the date of publication of the advertisement. It states clearly that Rule 6 is to apply. The words 'subject to' clearly indicate the provisions of section 51(9). An application for amendment in terms of Rule 51(9) of the Act is subject to section 51 of the Act and will be subject to Regulation 82-88 if the court, acting in terms of subsection 51(9), orders that it be dealt with in accordance with subsections (2), (3) and (4) of section 51. The advertisement is doing nothing more than notifying interested parties of this possibility which will be readily apparent from a reading of section 51(9). A reasonable interpretation of subsection 51(9) leads inevitably to that conclusion. If the third respondent's contention is correct the result is an absurdity. If both respondents oppose the application for amendment the first respondent would be bound to do so in terms of Rule 6 and the third respondent in terms of Regulations 82-88.

[16] The contents of the advertisement could not alter the procedure provided by the law. The third respondent was therefore not entitled to follow a procedure different from that stipulated in the Uniform Rules of Court. The third respondent should have filed a notice of intention to oppose in terms of Rule 6(5)(d)(i) and thereafter, within 15 days, delivered its answering affidavit in terms of Rule 6(5)(d)(ii). This was clearly indicated in the applicant's notice of motion and was ignored by the third respondent. It simply chose to file a Form P19 accompanied by a statement of particulars with the clear intention of going through the protracted process provided for in regulations 82-88. The third respondent was not entitled to do this.

[17] Those are the reasons for the following order which I made on 15 June 2007:

It is declared that the Form P19 Notice of Opposition and accompanying Statement of Particulars filed by the third respondent is an irregular step;

The Form P19 and Statement of Particular filed by the third respondent are struck out;

The third respondent is ordered to pay the costs of these proceedings including the costs consequent upon the employment of two counsel.

B.R. SOUTHWOOD

JUDGE OF THE HIGH COURT

CASE NO: 90/7136

HEARD ON: 2007-06-15

FOR THE APPLICANT: ADV. S.A. CILLIERS SC

ADV. T. PLEWMAN

INSTRUCTED BY: Mr A. Apostolides of D.M. Kisch Inc

FOR THE THIRD RESPONDENT: ADV. J.W. LOUW SC

INSTRUCTED BY: Dr. S. Gregory of Samantha Gregory Attorneys

DATE OF JUDGMENT: 2007-06-19

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