

SOUTH AFRICA / JUDGMENT

Kreepy Krauly (Pty) Ltd. v Hofmann (162/86) [1986] ZASCA 154 (28 November 1986)

[1986] ZASCA 154

COURT

Supreme Court of Appeal

BEFORE

Corbett, Joubert, Smalberger, Galgut, Nicholas

CASE / FILE NUMBER

162/86

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IN THE SUPREME COURT OF SOUTH AFRICA (APPELLATE DIVISION)

In the matter of:

KREEPY KRAULY (PROPRIETARY) LIMITED ... appellant and HELMUT JOSEF HOFMANN
respondent.

Coram: CORBETT, JOUBERT, SMALBERGER JJA, GALGUT et NICHOLAS AJJA.

Date of Hearing: 18 August 1986. Date of Judgment: 28 November 1986.

JUDGMENT GALGUT AJA:

The appellant applied in the Court of the Com-missioner of Patents (NESTADT J) for the
revocation of Patent No 77/6199 ("the patent"). The respondent is

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2the patentee. The application was dismissed with costs. The judgment is reported in 10 Burrell's
Patent Law Reports at p 360. The nature of the patent and the issues in the case are fully set out in
that judgment. I shall refer to it as the reported judgment. I will set out only so much as is
necessary to facilitate the reading of this judgment and will confine myself to the main sub-
missions made in this Court. The appeal is direct to this Court, the parties having consented
thereto, in terms of sec 76(4) of the Patents Act No 57 of 1978 ("the 1978 Act"). The effective date of
the patent is 18 October

1977. It was granted on an application made under the provisions of Patents Act No 37 of 1952 ("the 1952 Act"). The revocation proceedings are therefore regulated by sec 61 read with sec. 3(1)(a) of the 1978 Act. The grounds of revocation are governed by sec. 23 read with sec. 43 of the 1952 Act.

/ The 3The patent is for an invention entitled "Cleaning apparatus for submerged surfaces".

Sec. 23 of the 1952 Act read with sec. 43 sets out the grounds on which revocation can be sought. Six of these grounds were relied on and set out in the notice of application for revocation. I set them out hereunder, in the sequence in which they were urged in this Court. I also set out the relevant subsections of sec. 23 of the 1952 Act. The words in brackets are the headings used in this Court.

A. "That the invention is not useful" (Inutility). See sec. 23(1)(e). B. "That the invention was not new at the effective date of the application" (Anti- cipation). See sec. 23(1)(l).

C. "That the claims of the complete specifi-cation do not sufficiently and clearly define the subject-matter for which pro-tection is claimed" (Ambiguity). See sec. 23(1)(g).

/ D. "That

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D. "That the complete specification doesnot fully describe and ascertain theinvention and the manner in which it is to be performed" (Insufficiency).See sec. 23(1)(f).

E. "That the application contains a material

misrepresentation" (Material Misrepresen-tation). See sec. 23(1)(i).

F. "... that the invention is obvious in thatit involves no inventive step having re-gard to what was common knowledge in theart at the effective date of the appli-cation" (Obviousness). See sec. 23(1)(d).

In order to consider the submissions made in this Court it is necessary to ascertain the nature and scope of the invention. The nature of the apparatus covered by the patent is depicted in two drawings, Figures 1 and 2, contained in the specification. For reasons which will appear later they have been reproduced and attached to this judgment. The apparatus is designed

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to be connected to a source of suction power. In a swimming bath it would be the pool filter motor.

The opening paragraphs of the specification

read:

"This invention relates to equipment for cleaning submerged surfaces and more particularly to the type of equipment known as 'suction sweepers'. Suction sweepers are almost universally used for cleaning submerged surfaces such as swimming pools and the like. Many forms of sweepers have been designed and produced and some of these have included features which make them more or less self-propelled while suction is applied through the equipment. Alternatively this desirable self-propelling action has been obtained by applying an auxiliary fluid flow to the cleaning head."

There then follows a description of known types of equipment (ie the prior art) for cleaning submerged surfaces (see the reported judgment at pp 362 to 363).

Having set out that the types of equipment

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in present use move slowly over the surfaces to be cleaned and are, in some cases, cumbersome, the specification then goes on to read:

"It is the object of the present invention to provide equipment which will effectively clean submerged surfaces and which is neat and compact and which can move over the surface to be cleaned at a rate in the vicinity of twelve feet per minute."

Thereafter the consistory clause reads (the reason for the underlining, which is mine, will appear later):

"According to this invention there is provided apparatus for cleaning sub-merged surfaces comprising -

a balanced operating head having an inlet and an outlet defining respective inlet and outlet axes, the outlet adapted to be swivelably connected to a longitudinally resilient and flexible suction hose, the inlet axis being inclined at an angle of between thirty degrees and sixty degrees to that of the outlet axis,

a passage through the head from inlet to outlet,

an oscillatable valve in the head adapted to alternately open and close said passage.

/ a baffle

7 a baffle plate in the head between the inlet and the valve to form a restricted suction connection between the inlet and outlet around the valve when the passage is closed, the connection being as restricted as practically commensurate with proper valve movement, the valve shaped so that liquid flow through the head will cause automatic oscillation thereof between terminal positions."

The specification then states:

"Many other features of this invention will become apparent from the following description of a pre-ferred embodiment which is made with reference to the accompanying draw-ings in which:

Figs. 1 and 2 show part sectional front and side elevations of one embodiment of the invention.

This form of the invention is designed as swimming pool cleaning apparatus."

The description then set out is lengthy. It need not be set out in detail. It is sufficient to say that a valve is located within the head of the apparatus and

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it is vital to the operation of the apparatus that this valve is so placed and designed that when suction is applied, water is drawn through the head and that the force of the water passing from the inlet to the outlet of the head causes the valve to oscillate. It is of the essence of the invention that the position and design of the valve is such that when so oscillating it opens and closes on its one side a passage which is termed a "flow" passage and on its opposite side a "suction communication which is designed so that there is as restricted an opening between inlet and outlet of the head as is commensurate with the proper operation of (the) valve". Having set out the above (as already stated at some length), the specification then reads:

"With the construction above set forth it has been found that when the head is submerged and a swimming pool suction filter applied to the pipe 12

9 the flow of water causes the valve to oscillate between its two terminal positions. In one such position the flow is substantially full and direct through opening 18 and passage 13 to outlet 3 while in the other there is maximum reduction in liquid flow through the head."

The patent has six claims. Claims 2 to 5

are dependent on claim 1. It is common cause that only claims 1 and 6 need be considered. As to claim 6 more later. Claim 1 is set out in full at p 364 of the reported judgment. It is accepted by both parties that it has the following integers:

(i) An apparatus for cleaning submerged surfaces comprising (ii) a balanced operating head having an inlet and an outlet defining respective inlet and outlet axes, (iii) the outlet adapted to be swivelably connected to a longitudinally resilient and flexible suction hose, (iv) the inlet axis being inclined at an angle of between thirty degrees and sixty degrees to that of the outlet axis,

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(v) a passage through the head from inlet to outlet, (vi) an oscillatable valve in the head adapted to alternately open and close said passage,

(vii) a baffle plate in the head between the

inlet and the valve to form a restricted suction connection between the inlet and the outlet around the valve when the pas-sage is closed, (viii) the connection being as restricted as practically commensurate with proper valve movement, (ix) the valve shaped so that liquid flow through the head will cause automatic oscillation thereof between terminal positions.

It is convenient at this stage, in order to better understand the areas of the dispute between the parties, to set out relevant principles governing the interpretation of a specification. Sec. 10(1) of the 1952 Act provides that every specification shall commence with a title sufficiently indicating to what the relevant invention relates. Secs. 10(3)(a) and (c) read:

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"A complete specification shall —

- (a) fully describe and ascertain the in-vention and the manner in which it is to be performed;
- (b)
- (c) end with a claim or claims defining the subject-matter for which protection is claimed."

I set out hereunder some of the relevant principles discussed in *Gentiruco A.G. v Firestone SA (Pty) Ltd* 1972 (1) SA 589 (A) at pages 614-616.

- (a) A specification must be construed like any other document (p 614 A). (b) The words used must be read grammatically and in their ordinary meaning (p 614 C). (c) If words are of a technical nature or if in the particular art or science words have a special meaning, extrinsic expert evidence

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12 is permissible to prove their meaning (p 614 D).

- (d) A court must be instructed by expert evidence in so much of the art or science, commonly known at the time, as is necessary to enable it to construe the specification properly (p 614 E).
- (e) If a word or expression is susceptible of some flexibility in its ordinary connotation, it should be interpreted so as to conform with and not to be inconsistent with or repugnant to the rest of the specification (p 615 B).
- (f) The interpreter "must be mindful of the objects of a specification and its several parts" (p 615 B).

- (g) "... if the object of the claims is borne in mind, their meaning, as ascertained from their own language, must prevail over the rest of the specification.

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For not only have they, according to sec. 16(3), to be stated distinctly and precisely, but their purpose is to delimit the monopoly claimed;

'the forbidden field must be found in the language of the claims and not elsewhere' — per TROLLIP JA at p 615 C. (Sec. 16(3) above referred to is of the 1916 Act. Sec. 10(3) (quoted above) of the 1952 Act is for all practical purposes the same as sec. 16(3).)

- (h) "If the meaning of a claim so ascertained is clear and unambiguous, it is decisive, and cannot be restricted or extended by anything else stated in the body or title of the specification (see the above authorities). On the other hand, if it is ambiguous (in the wide sense), the body and title of the specification must be invoked to ascertain whether at least a reasonably certain meaning can be given to the claim" — per TROLLIP JA at p 615 F.

At pages 616 D to 618 F TROLLIP JA discusses

the question of whether the evidence of a skilled expert witness's opinion as to the meaning of any part of the

/ specification

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specification including the claims is admissible. It appears from what is there said (p 617 B) that the learned Judge was of the view, in cases where the subject-matter of a specification is of a highly complex scientific nature, that the opinions of the parties' well-qualified and experienced experts, as being representative of the skilled addressees of the specification, on the meaning of their understanding of its relevant parts, while not binding on the court, might be of appreciable help. The learned Judge concluded, however, that such evidence was not admissible and at p 618 A he quoted, with approval, the following dictum of Lord TOMLIN in *British Cel-*

lanese Ltd v Courtaulds Ltd (1935) 52 RPC 171:

"He (ie the skilled expert witness) is not entitled to say nor is counsel entitled to ask him what the specification means, nor does the question become any more admissible if it takes the form of asking him what it means to him as an engineer or a chemist. Nor is he entitled to say whether any given step or alteration is obvious, that being a question for the Court."

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It was said by Lord RUSSELL, in *Electric and*

Musical Industries Ltd and Another v Lissen Ltd and Another

(1939) 56 RPC at p 39,

"The function of the claims is to define clearly and with precision the monopoly claimed."

The learned Judge then goes on to say:

"The claims must undoubtedly be read as part of the entire document, and not as a separate document."

Blanco White in his Patents for Inventions

(5th edition) at para 2-103 on p 12 states:

"A specification is a single document and like any other document, must be read as a whole. It is necessary to read the body before proceeding to the claims. A claim must be treated as part of the entire document, not as a separate document. If the claims when so read are still not clear, reference should again be made to the body of the specification to assist in construing them; in particular, reference should be made to the 'consistory clause' and the preamble generally."

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In para 2-104 at p 13 the learned author goes on to say:

"Where it is obvious to a skilled reader what the patentee meant to include and what to exclude, the claims should be read accordingly: they must be read 'purposively' rather than being subjected to 'meticulous verbal analysis'. Thus preference should be given to the clear intention of the whole, as against particular words that might destroy it, a construction leading to an absurd result being avoided wherever possible."

A specification is addressed to those who will be responsible for putting it into practice and who have the necessary skill to use it. Such persons "may be assumed to possess not only a reasonable amount of common sense but also a competent knowledge of the art or arts which have to be called into play in carrying the patentee's directions into effect" - see the authorities cited in *Colgate-Palmolive Co v Unilever Ltd* 1983 (4) SA 249 (T) at pp 252 H to 254 C. The Court when interpreting a specification has to do so as would the addressee.

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As we have seen a specification must be given a purposive construction. It must be read with a mind willing to understand and not to misunderstand -see *Selero (Pty) Limited & Another v Chauvier & Another* 9 Burrell's Patent Law Reports at 171 C and 1984 (1) SA 128 (A) at p 143 D-G.

I pause to stress that the onus is on the applicant for revocation to prove his case upon a balance of probabilities - see *Miller v Boxes & Shooks (Pty) Ltd* 1945 AD 561 at 581.

Having set out some of the relevant principles relating to the interpretation of specifications I turn to discuss the grounds of invalidity raised by appellant.

Ad A above - Inutility

Both parties filed affidavits by experts. They were Dr Schwartz on behalf of the appellant and Dr Stephenson on behalf of the respondent. To the

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extent that they expressed their opinions as to the meaning of claim 1 their evidence is, as we have seen, inadmissible. I do not find it necessary to refer to those aspects of their evidence. The conflicts in their evidence relating to technical aspects will be referred to later. Drs Schwartz and Stephenson were agreed that the addressee of the specification in issue would be (to quote Dr Schwartz) "a person having training and experience in fluid mechanics and concerned in the principles of manufacture and design of pool cleaners". He does not have to be a highly qualified academic.

Both Dr Schwartz and Dr Stephenson set out their interpretation of claim 1. Their opinions differed in regard to the interpretation of the words "a passage" in integer (v) and "connection" in integers (vii) and (viii). As we have seen their opinions in this regard are not admissible. They were, however, agreed that

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19there had to be two flow paths through the head, one on each side of the valve, in order for the valve to oscillate and to render the patent utile, and that without such oscillation the apparatus would not be operative.

The submissions by counsel for the appellant can be summarised as follows:

(aa) The subject-matter of the specification was not of a highly complex scientific nature; it did not contain words of a technical nature or having a particular import, scientific or otherwise.

(bb) The word "passage" in integer (v) is an ordinary English word and its meaning is clear and unambiguous. This, too, is the meaning it would have to one skilled in the art of the apparatus claimed.

(cc) There is no express or implied definition

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in the body of the specification to suggest

that any special meaning be given to the word other than its ordinary meaning. (dd) The body of the specification contains a des-

cription of the prior art as having provided "a pair of rigid passages" and "two passages". (ee) Reading the specification as a whole, therefore,

the use of the singular "passage" must be given its normal meaning. (ff) The words "suction connection" in integer

(vii) are also ordinary English words which

must be given their ordinary English meaning.

The ordinary English meaning of the word "con-

nection", in the context of this integer is "a join" or "a fastening". (gg) There is, in the use of the word "connection",

no connotation of a path or passage allowing

/ a flow

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a flow of water or fluid.

(hh) The consequence of adopting the ordinary English meaning of the words used is thus that there is no ambiguity and results in a claim for a device having one passage (only) through which the water or liquid is to flow.

(ii) The conflict between the description of the invention in the body of the specification and the claim made in the claims does not render them ambiguous or unclear.

(jj) It does not follow from the wording of integers (vii) and (viii) that integer (v) is to be given any other meaning than the ordinary meaning of the words used therein.

It follows from what has been said above that the addressee is a man of some skill and understanding in the field of the invention; he is not a mere layman;

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he will read the specification as a whole, ie the body of the specification and the claims; he will then seek to analyse what is said in claim 1; he will not do so with "an attitude of studied obtuseness" but will do so "with a mind willing to understand and not to misunderstand". He will obviously not stop reading when he has read integer (v) but will read all the integers following thereon; he will not, as it were, peer excessively at integer (v) and ignore integers (vii), (viii) and (ix); he will see that in integer (vii) there is a baffle plate between the inlet and valve to form a restricted suction connection around a valve when the passage in (v) is closed; he will immediately be driven to wonder what is meant by "a restricted" connection which is also a

"suction" connection. Further-more he will wonder how such a connection can be "around a valve"; he will then read in integers (viii) and (ix)

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that the connection is to be restricted so as to be "commensurate with proper valve movement" in respect of a valve so shaped that liquid flowing through the head will cause the valve to oscillate; he will, in my view, immediately realise that the patentee did not intend "connection" to be a "join" or "fastening".

The word "connection" is not limited to meaning "a join" or "fastening". The word can connote a linking up; one also speaks of a "connecting" rod. Hence a restricted suction connection which can pass round a valve which oscillates does not suggest a "join" or "fastening".

It will be remembered that in the Gentiruco case, sup. cit., TROLLIP JA said (see (e) above) that if a word or expression is susceptible of some flexibility in its ordinary connotation it should be interpreted so as to conform with the rest of the specification.

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He also said if a claim was ambiguous (in the wide sense) the body and title of the specification must be invoked to ascertain whether a reasonable meaning can be given to the claim. It appears also from what CORBETT JA said in the Selero case, sup. cit., at p 140 that where a term in a specification is "sufficiently flexible and imprecise", it is permissible to have recourse to the body of the specification. This also appears from what is said by Blanco White in the par. 2-103 above-quoted.

It follows that the addressee of this specification who does not approach the issue of interpretation of claim 1 with an attitude of studied obtuseness but with a mind willing to understand what the patentee intended to convey, will have, and will be entitled to have, recourse to the body of the specification. For the reasons stated above there can be no doubt that the

/ words

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words "restricted suction connection" are sufficiently flexible and imprecise to permit him (and of course the Court) to do so. As will be seen from p 386 E of the reported judgment the Commissioner was of the view that the "meaning of 'passage' and 'restricted connection' is sufficiently unclear to render it permissible,

indeed obligatory, to interpret these expressions in the light of the body of the specification". In the

specification the following is said:

"On the side of the valve opposite the flow passage 13 through the head is a suction communication which is designed so that there is as restricted an opening between inlet and outlet of the head as is commensurate with the proper operation of valve 14. Water flow through the suction communication is therefore greatly reduced compared to that through the passage 13. The suction communication is adapted to be shut off when the flow passage is open and is only open for a brief period when the valve 14 closes the flow passage. The shape and size of the valve 14 in the head together with the location of the partition member 17 constricts the suction

/ communication

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communication to the size which prevents appreciable liquid flow therethrough."

There is thus a direct reference to a flow of water "through the suction communication". The specification discloses a device with a flow passage 13 through which the water passes to the filter and a suction connection

so

through which there is a flow of water/reduced as is

commensurate with proper valve movement.

It follows from all the above that claim 1 has two flow paths through the head (albeit one is restricted) and hence the apparatus will operate. The appellant has failed to establish that the patent is inutile.

Ad B above —Anticipation In terms of sec. 43(1) read with sec. 23(1)(l) of the 1952 Act a patent may be revoked on the ground

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that the invention was not new at the effective date of the application. "New" is defined in sec. 1(ix) of the above Act. There is no need to set out the definition. The facts are self-explanatory. The respondent had at an earlier date applied for a patent for a similar device in terms of an application No 76/5024. That application was opposed. It would have as effective date, 23 August 1977. In terms of sec. 1(ix)(e) of the 1952 Act it ranks, as a patent, prior in date to No 77/6199, the effective date of which is 18 October 1977.

In both cases the invention was entitled "Cleaning Apparatus for Submerged Surfaces". The two specifications are largely identical. A comparison of the consistory clauses shows that the subject-matter is similar. The consistory clause in No 77/6199 has been set out above. I draw attention to the underlining. In No 76/5024 the consistory clause reads (the underlining is mine):

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"According to this invention there is provided apparatus for cleaning submerged surfaces comprising

a balanced operating head having an inlet and/outlet, the outlet being adapted to be swivelably connected to a longitudinally resilient and flexible suction hose,

the inlet axis being inclined at an angle of between thirty degrees and sixty degrees to that of the outlet, a pair of passages through the head from inlet to outlet,

an oscillatable valve in the head adapted to alternately close said passages,

a baffle plate in the head between the inlet and valve to cause one of the passages to be more restricted and less direct between inlet and outlet than the other and

the valve shaped so that liquid flow through the passages will cause automatic oscillation thereof between terminal positions in each of which one of the passages through the head is closed."

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The difference in the wording of the consistory clauses in the two specifications appears from the passages I have underlined. In No 77/6199 the invention consists of a passage and a suction connection which as we have seen (see A above) is a suction communication through which the flow of water is as restricted as is practically commensurate with valve movement. In No 76/5024 the invention consists of a pair of passages, one of which is more restricted than the other.

The appellant's contention was that claim

6 of Patent No 77/6199 was anticipated by claim 7 of

Application No 76/5024. Claim 6 reads:

"6. Apparatus for cleaning a submerged surface substantially as described with reference to the accompanying drawings."

Claim 7 reads:

"7. Apparatus for cleaning swimming pools substantially as described

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with reference to Figures 1 and

2 or 3 of the accompanying drawings."

The law on this aspect of the case is set out by TROLLIP JA in the Gentiruco case at the pages set out hereunder. He was there concerned with sec. 6 of the 1916 Act. Its provisions differ from the prior claiming provisions in sec. 1(ix)(e). The effect, however, for the purpose of this case is the same. At p 646 C of the report the learned Judge said:

"I turn now to the objection of anticipation. It relates to the claims and not the description of the invention in the body of the specification (Veasey 's case, p 282). Hence the particular claim must be construed to ascertain its essential constituent elements or integers. For the purpose of this objection the claim so construed is assumed to be inventive (Veasey 's case, pp 280,

284). The prior patent alleged

to be anticipatory is then construed. As Blanco White, supra, says at p 101:

'The question whether a claim has novelty over what is disclosed in an earlier document is primarily one of construction of the two documents.'

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The two documents are then compared to ascertain whether the prior patent was granted for the same process,

etc, as that claimed. And at p 653:

The prior patent must have been granted for the same or substantially the same process, etc, as claimed in the patent in suit; that is, the two must overlap to the extent that the prior process, etc must contain at least the essential integers of the latter and their special combination, if any. This is usually determined by construing and then comparing the claims of the respective patents."

I proceed, therefore, to construe the said claims 6 and 7.

The drawings referred to in claim 6 of No 77/6199 are Figure 1 (which shows a part sectional front elevation of one embodiment of the invention) and Figure 2 (which shows a side elevation of that embodiment). Those drawings are identical (save in an irrelevant minor respect) with Figures 1 and 2 of Application No

/ 76/5024

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76/5024. The Figure 3 in No 76/5024 relates to an alternative embodiment and is not relevant to the present inquiry.

It was contended on behalf of the appellant that claim 6 of No 77/6199 is stated as being a claim to the apparatus which is "substantially as described with reference to the accompanying drawings" and therefore it would not be proper to consider the description in the patent in suit; that claim 7 in No 76/5024 is similarly stated; since the drawings are identical, so the argument that prior claiming is established.

I do not agree with the premise. Neither the drawings nor the description are intelligible without the other. The numbers on the drawings cannot be understood without reference to the description; and the description cannot be understood without reference to the drawings. In this regard the words of PULLOCK MR in *Tucker v Wandsworth Electrical Manufacturing Company Ltd* 42 (1925) RPC 531

/ (CA)

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(CA) at 537, line 35, to 538, line 1, are apposite;

"The Claim, in fact, is in these words:

'2. An electric switch, substantially as herein set forth and illustrated.'

Those words 'substantially as herein set forth and illustrated' are commonly used in drawing the Claims to Specifications. As Mr Terrell has pointed out, it was said by Lord MOULTON in the case to which he referred that they had not received judicial interpretation. On the other hand, one must not forget that in a very recent case, the case of *Hale v Coombes*, Lord BUCKMASTER said of those words that the result was to throw one back to the body of the Specification. His

words are: 'I do not see how they can be used so as to exclude the references to the figures which are the graphic representations of the actual invention', and he finds himself thrown back to the body of the Specification and the illustrations; that is to say, he interprets those words according to their face meaning."

/ See

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See also the judgment of WARRINGTON L J at p 540, lines 25-35.

In each of the specifications the description

is prefaced by the following words:

"Many other features of this invention will become apparent from the following description of a preferred embodiment ('preferred embodiments' in the case of Application No 76/5024) which is made with reference to the accompanying drawings ".

Thus it is emphasized that what is claimed in the respective claims is the preferred embodiment. Compare the following passage from the speech of Lord MORTON of HENRYTON in *Raleigh Cycle Coy Ltd v H Miller and Coy* 65 (1948) RPC 141 (H.L.) at 157 lines 35-44:

"I now come to Claim 5, and before examining its wording I desire to make some preliminary observations. For many years it has been a common practice to insert, as the last claim in a patent specification, a claim on the same lines as Claim 5 in the present case. I think

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that the reason why such a claim has been inserted, in the present case and in countless other cases, is as follows. The patentee fears that his earlier claims may be held invalid, because they cover too wide an area or fail sufficiently and clearly to ascertain the scope of the monopoly claimed. He reasons as follows: 'If I have made a patentable invention and have described the preferred embodiment of my invention clearly and accurately, and without any insufficiency in the directions given, I must surely be entitled to protection for that preferred embodiment, and that protection may fairly extend to cover anything which is substantially the same as the preferred embodiment'. This reasoning seems sound to me "

The effect of the phrase "as described with reference to the accompanying drawings" is therefore to "import into the claim those features of the embodiments described that (as a matter of construction) are held out in the specification as essential features of the invention". *Blanco White*, 5th ed, p 23 para 2-113 D, citing *Rose Street Foundry & Engineering Company Ltd*

/ v India

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v India Rubber Gutta Percha and Telegraph Works Company Ltd 46 (1929) RPC 294 (CA).

The main differences between the description of the preferred embodiment of Patent No 77/6199 and that of Application No 76/5024 are the following.

According to Application No 76/5024 there

are two flow passages through the head, which passages open and close alternately as the valve moves between

its terminal positions. The passages are of different

shape and size; in one the flow is substantially direct through opening 18 to outlet 3; in the second passage the flow is restricted and indirect because the water must pass in the space 22 between the partition member

17 and the base of the valve 14. The description

states -

"The space 22 may be made about one tenth of the opening 18".

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According to Patent No 77/6199, on the other

hand, there is a passage through the head between inlet and outlet, and

"On the side of the valve opposite the flow passage 13 through the head is a suction communication which is designed so that there is as restricted an opening between inlet and outlet of the head as is commensurate with the proper operation of valve 14. Water flow through the suction communication is therefore greatly reduced compared to that through the passage 13. The suction communication is adapted to be shut off when the flow passage is open and is only open for a brief period when the valve 14 closes the flow passage. The shape and size of the valve 14 in the head together with the location of the partition member 17 constricts the suction communication to the size which prevents appreciable liquid flow there-through."

Despite the difference in terminology it is clear that

the "suction communication" of No 77/6199 performs a

function similar to that of the second (restricted)

passage of Application No 76/5024. However that may

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be, the difference in terminology does not assist in solving the issue. What must be considered is substance, not language (see Blanco White (5th ed) at p 116 para 4-306). The substantial difference between the two descriptions is that the "suction communication" of No 77/6199 is "designed so that there is as restricted an opening between inlet and outlet of the head as is commensurate with the proper operation of valve 14"; whereas, although the second passage of Application No 76/5024 is restricted, it is not limited in the same way: all that is said is that "the space 22 may be made about one tenth of the opening 18". In other words, in the prior specification the space 22 may be determined in proportion to the opening 18. In Patent No 77/6199, the patentee does not tell the world the proportion between integers 22 and 18; the extent of the restriction is defined with reference to a desired

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result, namely, the proper operation of the valve. The fact that an earlier claim is wider or less specific than the later claim does not mean that the former anticipates the latter. See the *Gentiruco* case at p 649 E-G. It is clear from the consistory clause, which sets out the various elements of which the invention is to consist, that this feature (which was not claimed in the earlier application) is an essential feature of Patent No 77/6199. Cf. *Tucker v Wandsworth Electrical Manufacturing Company Ltd* (supra) at p 540. The following statement by Dr Stephenson is significant:

"In the latter case (ie No 77/6199) the claims are confined to a restricted passage that has been reduced to a suction communication only. In other words, there must be significant interruption in the flow through the head in the latter case. I consider that the latter specification and claims could develop from the former. The significantly restricted flow will result in a more positive movement of the machine over the surface to be cleaned."

/ Dr. Schwartz

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Dr Schwartz did not challenge the portion underlined by me. The difference between the two patents is thus a real one.

It follows that all the essential features of claim 6 of No 77/6199 were not claimed in claim 7 of No 76/5024. Consequently invalidity on the ground of anticipation was not established.

Ad C above —Ambiguity.

In support of this ground counsel for appellant submitted (I quote from his heads of argument):

"(a) Integer (vi) of claim 1 claims an

oscillatable valve adapted alternatively to open and close the passage. However, integer (vii) provides for a baffle plate in the head between the inlet and valve to form a restricted suction connection between the inlet and outlet around the valve when the passage is closed.

/ (b)

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(b) integer (vii) was incompre-

hensible since, if the passage is closed, there can be no communication between the inlet and outlet."

As was shown when considering the issue of lack of utility (Ground A above), integers (vii), (viii) and (ix) describe a "restricted suction connection" through which there is a restricted flow of water. Integer (v) refers to a passage through which there is a flow of water. The flow in this passage is the main flow from the inlet to the outlet of the head of the apparatus - and such flow would go to the filter. The restricted flow is to be commensurate with proper valve movement, ie, the valve in integer (vi). The claim therefore describes two flow paths, the one being the passage carrying the main flow, the other being the restricted connection carrying the restricted flow. The flow in the passage and the flow in the restricted communication are around opposite sides of the oscillatable

/ valve

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valve. There is thus no ambiguity when integers (v), (vi), (vii) (viii) and (ix) are read together. In short, once it has been found, for the reasons set out in A above, that this patent is not inutile, the ground of ambiguity cannot be sustained.

Ad D above — Insufficiency.

All that need be said on this ground is to

quote from appellant's written heads of argument. The relevant passages read:

"The Appellant's contentions insofar as the objection of insufficiency is concerned, depend upon the argument that the claim is one for an apparatus having one passage. The fate of the objection on the ground of insufficiency is, therefore, dependent upon the fate of claim 1 on the ground of lack of utility. It is respectfully

/ submitted

43 submitted that it is therefore immaterial whether it be on the ground of insufficiency or on the ground of inutility that the appeal be upheld."

In the result this ground of revocation has not been

established.

Ad E above - Material Misrepresentations

In the notice of application for revocation

this ground was set out as follows:

"The Patentee knew of the existence of his prior patent application No 76/ 5024 and the product covered by such patent application. Despite this, the Patentee represented in the Patents Form no. 1 filed in support of his patent application No 77/6199 that to the best of his knowledge and belief there is no lawful ground of objection to the grant of a patent on the application. In the circumstances the Patentee has obtained a patent which should not have been granted."

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It was not suggested that there was any evidence as to appellant's alleged knowledge and belief other than as stated by him on the said patents form. The submission by appellant on this ground is that "if the objection of anticipation based on claim 6 is upheld, the objection based on misrepresentation need not be dealt with as a separate ground of objection". Coun-sel for appellant intimated that if appellant failed to establish anticipation he could not urge this ground of invalidity. More need not be said.

Ad F above - ObviousnessAn inquiry into obviousness involves determining what the common knowledge in the art was at the effective date of the patent in suit and determining whether the invention claimed is a step forward on such common know-ledge and, if so, whether that step is inventive.

/ This

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This in effect means an investigation into what formed part of the ordinary mental equipment of a skilled per-son at the time of the application for the patent. It is essentially a matter for evidence - see the Gentiruco case, sup. cit. at pp 653 G - 659.

The appellant submitted that the evidence of Dr Schwartz showed -

- (i) that a device made in accordance with Figure 1 of the patent in suit - if it was a two-passage device -was such as was known as a Kreepy Krauly which formed part of the common knowledge as at October 1977; and(ii) that a skilled addressee would have to make only a few simple experiments to produce a device that was more compact and moved faster than the Kreepy Krauly device if he set out to do so;(iii) that the Commissioner had erred in finding that there was a conflict of fact on this issue and

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in finding that appellant had not discharged the onus of showing obviousness.

The Commissioner dealt with this issue at pp 370 G to 371 F of the reported judgment. As appears from the extracts of evidence there quoted, and from the

affidavits of Dr Schwartz and Dr Stephenson, there existed

1977 as at 18 October/a two-passage device known as Kreepy

Krauly. Dr Schwartz contended that -

"It would have required a skilled addressee only a few simple experiments to produce a device that was more compact and moved faster than the Kreepy Krauly device if he set out to do so "

Dr Stephenson, in his affidavit, explained that -

" the Kreepy Krauly machine referred

to has two passages of equal and substan-tial length of about a metre and of exactly equal size. There is no restriction at all of either of the passages.

He then went on to say :

/".... there

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" there is no possible basis for the assumption that such experiments would lead to a construction falling within the scope of the claims of Patent No 77/6199."

Dr Stephenson thus stresses that the flow

paths in the Kreepy Krauly machines are very different from the flow paths in No 77/6199.

Furthermore, the last-quoted passage from his evidence is a denial of Dr Schwartz's contenti on.

There is thus a conflict of fact which cannot be resolved on affidavit, ie. without oral evidence. I agree, with respect, with the Commissioner that appellant has not discharged the onus of establishing this ground for revocation.

In the result the appeal is dismissed with costs, including the costs of two counsel.

O GALGUT. CORBETT JA) NICH0LA5 AJA)

COMPLETE SPECIFICATION

HELMUT JOSEF HOFMANN 2 Sheets

COMPLETE SPECIFICATION Sheet No. 1 APPLICATION NO. 77/6199 Orignal SEE ORIGINAL
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HELMUT JOSEF HOFMANN 2 Sheets COMPLETE SPECIFICATION Sheet No. 2 APPLICATION NO.
77/6199 Orignal SEE ORIGINAL JUGDMENT SKETCH JOHN & KERNICK Patent Attorneys for the
Applicant

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