

SOUTH AFRICA / JUDGMENT

Sasol Dyno Nobel (Proprietary) Limited v Master Blaster (Proprietary) Limited and Another (P2004/8313) [2015] ZACCP 1; 2014 BIP 114 (CP) (4 February 2015)

[2015] ZACCP 1

COURT

Court of the Commissioner of Patents

BEFORE

MNGQIBISA-THUSI

CASE / FILE NUMBER

P2004/8313

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IN

THE COURT OF THE COMMISSIONER OF PATENTS FOR THE
REPUBLIC OF SOUTH
AFRICA

Case No: Patent

2004/8313

Date: 3 February
2015

In the matter

between:

SASOL DYNO NOBEL
(PROPRIETARY)

LIMITED.....Applicant/Patentee

and

MASTER

BLASTER (PROPIETARY) LIMITED.....1st

Respondent

REGISTRAR

OF

PATENTS.....2nd

Respondent

In re: An

application in terms of s 51(9) of the Patents Act, 1978 to amend
South African Patent 2004/8313 while an application for the
revocation of the patent is pending

JUDGMENT

MNGQIBISA-THUSI, J

[1] The applicant is seeking the following relief:

1.1 the amendment of complete patent specification and the claims of South African Patent number 2004/8313 ("the patent") as set out in annexure "RVD3" of the supporting affidavit of Ronald Marinus Johannes van Dijke ("Van Dijke");

1.2 that the "Notice of Advertisement for an Application for Amendment during Pending Court Proceedings" to be published in the patent journal during or about June 2012, will, as published, be accepted as an advertisement in terms of section 51 of the Patents Act 57 1978 ("the Act");

1.3 that the proceedings in the application for the revocation of the patent dated 30 September 2011 brought by the first respondent be stayed pending the final determination of the present application;

1.4 Costs if the matter is opposed.

[2] The applicant does not seek any relief against the second respondent. Hereinafter the first respondent will be referred to as 'the respondent'.

[3] The applicant is the inventor of a "Dual Detonator Assembly" ("the patent") which invention was patented under patent number 2004/8313. The patent contains 16 claims, three (claims 1, 12 and 13) are independent claims, 14, 15 and 16 are omnibus claims and claims 2-11 are dependent (directly or indirectly on claim 1. As described by the deponent to the affidavit in support of this application, the patent relates to a detonator assembly, which comprises of "an elongate detonation transfer mechanism, a first inhole detonator connected towards a first end of the mechanism and a second in-hole detonator connected towards a second end of the mechanism. The invention also relates to a detonator system and a method of priming a plurality of blast holes at blast site." The patent has a priority date of 16 October 2003. The proposed amendment was published in the Patent Journal on 27 June 2012 and it is common cause that no objections to the proposed amendment were received from the public.

[4] There is a pending application for the revocation of the patent instituted by the first respondent.

[5] The grounds on which the respondent seeks the revocation of the patent are that the patent:

5.1 lacks novelty;

5.2 lacks inventive step; and

5.3 lacks clarity, specifically claim 13.

[6] Instead of filing its answering evidence to the revocation application, the applicant launched this application for the amendment of the patent in terms of section 51(9) of the Act.

[7] Section 51 (9) of the Act provides that:

"(9) 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 any 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)."

[8] In its founding affidavit the applicant avers that after the respondent launched its application for the revocation of the patent, it (the applicant) reviewed the specification and came to the view that it should seek an amendment of the patent to bring clarity to the patent specification.

[9] According to Van Dijke, the deponent to the applicant's founding affidavit, the purpose of the proposed amendment is to:

9.1 insert words and phrases into the body of the specification and into claims 12 and 13; 7.2 to introduce and delete numerals on the drawings attached to the specification; and

9.2 to correct the diagrams of errors and omissions made.

[10] Further, applicant contends that the proposed amendment to claims 12 and 13 will be achieved by (i) adding the word 'detonator' before the word 'assembly' and (ii) adding the words 'elongate detonation transfer' before the word 'mechanism; and 'elongate detonation' before the word 'transfer'. Furthermore, with regard to claim 13, it is proposed to amend the claim by (i) adding the word 'detonator' before the word 'assembly'; (ii) adding the words 'detonator assembly' after the words 'first kind'; (iii) adding the word 'first' before the word 'detonator'; and (iv) adding at the end of the claim 'and connecting the attachment means of the second assembly of the second kind of detonator assembly to the elongate detonation transfer mechanism of the second assembly of the first kind of detonator assembly.' It is also proposed that the consistency clauses would be accordingly amended to be consistent with the proposed amendments to claims 12 and 13.

[11] With regard to corrections to the diagrams it is proposed that (i) in the diagram in figure 2 the numeral '32' and its reference line would be deleted; (ii) change reference '30' to reference '32' and (iii) add a new reference numeral 30. With regard to figure 3 it is proposed to add a reference numeral '43'.

[12] The grounds on which the respondent is opposing the application for the amendment of the patent are the following:

12.1 that the proposed amendment is in conflict with the provisions of subsections 51(6) and 51(7) of the Act; and

12.2 that post-amendment, the patent will continue to be invalid for lack of novelty and inventive step.

[13] Subsections 51(6) and 51(7) of the Act read as follows:

"(6) No amendment of a complete specification which becomes open to public inspection after the publication of the acceptance of the specification in terms of section 42, whether before after it so becomes open to public inspection, shall be allowed if-

- (a) the effect of the amendment would be to introduce new matter or matter not in substance disclosed in the specification before the amendment; or
 - (b) the specification as amended would include any claim not fairly based on matter disclosed in the specification before amendment.
- (7) No amendment of a complete specification which has become open for public inspection after the publication of the acceptance of the specification in terms of section 42 shall be allowed if the specification as amended would include any claim not wholly within the scope of a claim included in the specification before amendment."

[14] In opposing the application, the following submissions were made on behalf of the respondent. That the proposed amendment seeks to introduce new matter or matter in in substance disclosed in the specification before amendment. Furthermore that the amendment to figure 2 seeks to introduce a different prior art drawing. It is contended that the additions and deletions intended to be made to figure 2 amounts to a substitution of one document by another and is thus in contravention of section 51(6) in that it seeks to introduce new matter or matter not in substance disclosed before the amendment. With regard to the proposed amendments to figure 3, it is the first respondent's contention that pre-amendment the diagram did not contain the numeral '3' and therefore the amendment amounts to the introduction of a new matter or matter not in substance disclosed before the amendment. It is the first respondent's contention that the intended additions to claims 12 and 13 will not bring any consistency since the reading of the amended claims apply to a different context. Furthermore, that claims 15 and 16, after the amendment, are now based on a different prior art drawing.

[15] Mr Du Plessis, counsel for the applicant, submitted that the patent relates to a dual detonator assembly, which is different from the known detonator, which is an in-hole detonator at one end and a connector on the other end. It was contended that if the amendment were allowed the revocation hearing would be limited to lack of novelty or lack of inventive step. Counsel argued that the interest of an objector to an amendment, lies in the effect of the amendment in the monopoly, particularly, where the patentee by amending becomes entitled to a broader monopoly. *Kimberly-Clark Corporation of SA (Pty) Ltd v Procter & Gamble SA (Pty) Ltd* 1998

- (4) SA 1 (SAC). Counsel submitted that it is accepted that one cannot introduce an amendment, which is not fairly based on the specification before the amendment, however, you can amend your claims, provided they are based on what is in the specification at the time it was filed. Counsel further submitted that the only assemblies talked of are detonator assemblies and the only mechanism talked of are elongated transfer mechanism. Therefore, the insertion of those words is a full description of the mechanism.

[16] In *Bateman Equipment Limited and Another v The Wren Group (Pty) Ltd* 1999 BIP 411 (A) Harms JA held at para 20 that:

"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."

[17] As correctly pointed out by counsel for the applicant, the relevant claims had been disclosed in the prior art and are therefore not new. In comparing the specification prior to the amendment and after the amendment, I am satisfied that the proposed changes made give better clarity to the invention's specification and aligns the wording in the relevant claims with the consistency. With regard to the deletion and addition of numerals, I am of the view that they do not anything substantially, which renders the diagrams to be different from the drawing before the amendment. Furthermore, the proposed amendment does not broaden the patentee's monopoly from what it was before. In fact, the applicant has asserted that with regard to claim 13, the alteration would in fact limit the scope of the invention. First respondent did not respond to this assertion. I am therefore satisfied that the proposed amendment is not in conflict with the provisions of section 51 (6) and (7) of the Act.

[18] The respondent also objects to the amendment by contending that even if the amendment is allowed the patent is still invalid for lack of novelty and inventive step. The respondent attached the founding affidavit (evidence) in the application for revocation and its annexures to its answering affidavit and seeks reference to be made thereto in conjunction with its objection to the amendment on the ground of continuing invalidity. Mr Van der Westhuizen, counsel for the respondent, submitted that the proposed amendment does not deal or address the invalidity of the patent on the grounds alluded to in the application for revocation. Counsel argued that it is not in the public's interest for an invalid patent to remain on the patent register. Counsel suggested that this court should consider also the invalidity of the patent as set out in the application for revocation. The respondent relies on *Deton Engineering (Pty) Ltd and Another v JP McKelvy and Others* 1997 BIP 113 (C) where the court stated that when a determination is whether to allow or refuse an amendment, the efficacy of such an amendment has to be considered.

[19] Mr Du Plessis contended that the purpose of the application for amendment was not to deal with the issues of lack of novelty and inventive step, the two other grounds raised by the first respondent in the application for revocation. Counsel submitted that the amendment was

merely to improve the clarity of the patent. Counsel further submitted that the attempt by the first respondent to introduce issues pertinent to the revocation application should not be entertained since the objective of this application is to limit the issues to be dealt with at the revocation application, by an amendment in order to improve clarity. Counsel further submitted that the first respondent cannot seek to have the issue of lack of novelty and inventive step be determined in these proceedings in that the applicant has not provided its evidence in answer to the first respondent's revocation application. Counsel argued that if the issue of the invalidity of the patent is dealt with in these proceedings, the applicant would be denied 'a substantive (as opposed to a procedural) right to deal with both. Deton matter (supra). Mr Du Plessis relying on *Bateman Equipment Ltd and Another v The Wren Group (Pty) Ltd* 2000

- (1) SA 649 (SAC), argued that it was not intended that a full scale revocation hearing would replace relatively simple amendment proceedings. Mr Du Plessis submitted that the issue of the invalidity of the patent is not relevant to these proceedings and should be pended until decided by the court hearing the revocation application.

[20] In the *Denton* matter (supra), the court refused to deal with the question of continuing invalidity during amendment proceedings on the basis that the issue of

continuing invalidity should be dealt with in the pending application for revocation. The court went further to hold that "It would prima facie be folly to introduce it as an issue in the amendment proceedings when it is not specifically pertinent to the amendment itself but only generally."

- [21] I am satisfied that the applicant has shown sufficient cause why the issue of the continuing invalidity should not be dealt with in these amendment proceedings, which are intended to be simple. Furthermore, as held in the *Deton* matter (supra), it would be unfair on the applicant to deal with issues of lack of novelty and inventive steps as it has yet to answer to the allegations made by the respondent in its founding papers in the application for revocation. In an amendment is usually allowed unless the conduct of the patentee has been such that the court, in the exercise of its discretion, considers that the patentee should be refused such relief. *B Braun Melsungen AG and Another v Specialised Systems Electro Medical (Pty) Ltd and Others* 2005 BIP 22 (CP) at para 8. The respondent will not be prejudiced by the issue of continuing invalidity being dealt with in the application for revocation.

- [22] The respondent has also contended that the applicant has adopted a wrong procedure for the alteration of the numerals in the drawings. It is the respondent's contention that the applicant should have brought an application in terms of section 50 of the Act. Section 50 of the Act, relates to the amendment of clerical errors and is brought before the registrar. Mr Du Plessis argued that you can amend a document by correcting clerical errors since amendments can also include errors that might otherwise be clerical errors. Counsel submitted that section 51(5) refers to "correction, including correction of an obvious

mistake" as an amendment. I am, however, not convinced by the submissions made on behalf of the respondent in this regard. I am satisfied that could be corrected under section 59. As correctly pointed out by counsel for the applicant, respondent is not prejudiced by the adoption of the procedure in section 59 for the correction of the numeral errors.

[23] Accordingly the following order is made:

1. that the amendment of complete patent specification and the claims of South African Patent number 2004/8313 ("the patent") as set out in annexure "RVD3" of the supporting affidavit of Ronald Marinus Johannes van Dijke ("Van Dijke");
2. that the advertisement in respect of the amendment in the patent journal on 27 June 2012, will, as published, be accepted as an advertisement in terms of section 51 of the Patents Act 57 1978;
3. that the proceedings in the application for the revocation of the patent dated 30 September 2011 brought by the respondent in the present application against the applicant in the present application, be hereby stayed pending the final determination of the present application;
4. that the respondent pay the costs of the application consequent upon its opposition to the application.

NO MNGQIBISA-THUSI

Judge of the North Gauteng High Court

Appearances

For Applicant: Adv B Du Plessis, SC

Instructed by: Hahn & Hahn Inc

For Respondent: Adv Van der Westhuizen, SC

Instructed by: DM Kisch Inc

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