



THE SUPREME COURT OF APPEAL OF SOUTH AFRICA

JUDGMENT

Case No: 742/10

In the matter between:

AUSFLOW (PTY) LTD

Appellant

and

NORTH PARK TRADING 3 (PTY) LTD

First Respondent

THE REGISTRAR OF PATENTS

Second Respondent

MARAIS ENGINEERING (PTY) LTD

Third Respondent

MARAIS STEYN

Fourth Respondent

Neutral citation: *Ausflow v Northpark Trading (742/10)* [2011] ZASCA 123 (7 September 2011)

Coram: Harms AP, Ponnann, Snyders and Malan JJA and Plasket AJA

Heard: 18 August 2011

Delivered: 07 September 2011

Summary: Patents – application to amend to cure invalidity - obviousness

ORDER

On appeal from: Court of the Commissioner of Patents (Murphy J sitting as court of first instance):

A. The appeal is upheld with costs (jointly and severally against the first, third and fourth respondents), including the costs of two counsel.

B. Paragraphs 3, 4 and 5 of the order of the Court of the Commissioner of Patents are set aside and replaced with the following:

‘3 The application to amend the specification of Patent ZA 95/0812 is granted.

4 The provisional order of revocation lapses.

5 The parties are to pay their own costs.’

JUDGMENT

HARMS AP (PONNAN, SNYDERS and MALAN JJA and PLASKET AJA concurring)

INTRODUCTION

[1] This is an appeal against a judgment by the Commissioner of Patents (Murphy J) who dismissed an application by the appellant, Ausplow (Pty) Ltd, an Australian company (the patentee), to amend its patent ZA 95/0812 entitled ‘Improvements in or relating to seeding machinery’.¹ The patent application was filed on 2 February 1995 and proceeded to grant on 29 November 1995, claiming priority from an Australian patent application. The appeal is with leave of the learned commissioner.²

¹ *Ausplow (Pty) Ltd v Northpark Trading 3 (Pty) Ltd & others* (95/0812) [2010] ZACCP 5 (30 April 2010).

² *Ausplow Pty Ltd v Northpark Trading 3 (Pty) Ltd & Others* (95/0812) [2010] ZAGPPHC 135 (5 October 2010).

[2] The background to the application for amendment is this. The patentee instituted an infringement action against the first respondent, Northpark Trading 3 (Pty) Ltd, alleging infringement of ‘the claims’ of the patent.³ The patent has 15 claims: claims 2 to 12 are directly or indirectly dependent on claim 1 while claim 13, although based on claims 1 to 7, contains an added aspect that is, for the purposes of this judgment, of special importance. Claims 14 and 15 are omnibus claims and do not require consideration.

[3] Northpark, while denying infringement, counterclaimed for the revocation of the patent on a number of grounds but for present purposes it is only necessary to mention two, namely lack of novelty and obviousness. Southwood J, sitting as Commissioner of Patents, was called upon to consider the issues of validity and infringement in relation to claim 1 only. He concluded in a detailed judgment that claim 1 was valid and infringed and issued a certificate of validity.⁴

[4] Northpark lodged an appeal to this court, which upheld the appeal on the basis that the invention claimed in claim 1 was obvious.⁵ The judgment was marked ‘not reportable’ and I shall refer thereto in the course of this judgment as the SCA judgment. Because no other claim was in issue it was not necessary for the SCA to express any view on the issue of infringement. It consequently upheld the counterclaim and, subject to the following, the patent was revoked:

‘The order [for revocation] is provisional. It will become fully operative if the patentee does not within one month file notice of an application to amend the patent, or, having filed such application, withdraws it. If an application as aforesaid is made and not withdrawn, it shall be decided at the hearing of such application whether or not the revocation order is to be put into operation.’

³ The second respondent is the Registrar of Patents who was cited for formal reasons and who did not take part in the proceedings. The third respondent is Marais Engineering (Pty) Ltd, and the fourth respondent is Mr Marais Steyn, the sole shareholder of the first and third respondents. The third and fourth respondents were not party to the initial litigation. How they became involved in the amendment proceedings is no longer of consequence but appears from *Ausplow (Pty) Ltd v Northpark Trading 3 (Pty) Ltd* 2009 BIP 37 (C of P).

⁴ *Ausplow (Pty) Ltd v Northpark Trading 3 (Pty) Ltd* 2007 BIP 1 (C of P).

⁵ *Northpark Trading 3 (Pty) Ltd v Ausplow (Pty) Ltd* (278/07) [2008] ZASCA 46; 2008 BIP 14 (SCA).

[5] This order was, according to the judgment, justified on the following basis: 'We were asked by counsel for the [patentee], if that were to be our finding, to postpone the order of revocation to enable the patentee to effect amendments to the specification, as contemplated by s 68 of the Act. The appellant's counsel advanced no adequate reason why that should not be done.'⁶

There may have been a misunderstanding between counsel and court because s 68 of the Patents Act 57 of 1978 could not underpin the eventual order.⁷ For s 68 to have had application the SCA should, in addition, have found one or other claim valid and infringed, something the court did not consider or hold.

[6] The reference to s 68 gave rise to a number of disputes, futile litigation and unnecessary side issues, all mentioned in the judgment of Murphy J. It is not necessary to revisit them because the answer appears to me to be as follows. In cases where a patent is found to be invalid, whether partially or in the whole, and s 68 does not apply, it is customary for courts to afford the patentee an opportunity to apply for an amendment which may save the patent. This court has, in the past, relied on s 61(3) of the Act for justifying such an order: *Ensign-Bickford (SA) v AECI Explosives and Chemicals* 1999 (1) SA 70 (SCA) at 84D-E. The provision gives the commissioner, when dealing with an application for revocation of a patent, a discretion to 'decide whether the patent shall be revoked or whether and, if so, subject to what amendments, if any, of the specification or claims thereof, the patent

⁶ Para 18.

⁷ Section 68:

'Relief for infringement of partially valid specification—Where in any proceedings for infringement of a patent, the commissioner finds that any claim in the complete specification in respect of which infringement is alleged, is valid, but that any other claim therein is invalid, the following provisions shall, notwithstanding anything contained in section 66 (5), apply, namely—

(a) If a counterclaim for the revocation of the patent has been made in the proceedings on the ground of the invalidity of any claim in the specification, the commissioner may postpone the operation of any order issued thereon for such time as may be required to enable the patentee to effect any amendment of the specification pursuant to the conditions imposed by the commissioner, who may attach such other condition to any order to be issued on the counterclaim as he may deem fit; and

(b) when the specification has been amended in terms of paragraph (a), the commissioner may, subject to such order as to costs as he may issue and as to the date from which damages shall be calculated, grant relief in respect of any claim which had, before the amendment, been found to be valid and infringed, and in exercising his discretion he may take into consideration the conduct of the patentee in inserting in the specification those claims which had been found, before amendment, to be invalid or permitting such claims to remain there.'

shall be upheld'. A party counterclaiming for revocation of a patent in terms of s 65(4) 'applies' for all intents and purposes in a prescribed manner for its revocation (s 61(1)). It is therefore not necessary to rely on the doubtful proposition put forward by the respondents that the order under consideration could have been made with reference to an inherent jurisdiction.

[7] If regard is had to the whole of the SCA judgment and not to the quoted paragraph only, it is in my view clear that the reference to s 68 instead of s 61 was an error which did not affect the clear language of the order: *Firestone SA (Pty) Ltd v Gentiruco AG* 1977 (4) SA 298 (A) at 304D-H.

[8] In the general course of events, if issues of lack of novelty and obviousness arise, courts as a matter of logic first decide the novelty issue and then obviousness: *Ensign-Bickford (SA) (Pty) Ltd* at 80E-F. Furthermore, if courts find that a patent is invalid on one ground, for instance, on the ground of lack of clarity (ambiguity) or, as in this case, obviousness, they normally consider the other grounds of invalidity as well for the sake of not only questions of costs but in relation to the suspension of the revocation order and the later amendment application: *Gentiruco AG* at 645. The court that subsequently has to deal with the amendment application has to know what the trial or appeal court's findings in relation to the other aspects were. The SCA did neither and this gave rise to an anxious analysis by Murphy J of the SCA judgment in the light of that of Southwood J in an attempt to understand the scope of the SCA findings and its reasons for overruling the latter. For reasons that will become apparent it is not necessary for purposes of this judgment to revisit those issues.

[9] The factual finding of the SCA that claim 1 in its unamended form is invalid on the ground of obviousness stands and this judgment proceeds from that premise. The issue in this case is accordingly whether the application to amend claims 1 and 13 should have been granted by Murphy J. This involves a number of distinct inquiries: (a) whether the patentee complied with the order of the SCA quoted; (b) whether the proposed amendments conflict with the provisions of s 51(6) or (7) of the Act;⁸ (c) almost invariably, whether the patent as amended will be valid; and (d)

⁸ Section 51:

whether there are reasons why the court's discretion to refuse an amendment that is otherwise in order should be exercised. It is not disputed that, as far as (a) and (b) are concerned, the onus of compliance rests on the patentee and that, as far as (c) is concerned, the onus of continuing invalidity rests on the objector: *Water Renovation (Pty) Ltd v Gold Fields of South Africa Ltd* 1994 (2) SA 588 (A) at 593J-594F. As to (d), the onus rests on the objector to establish the facts that would entitle the court to refuse the amendment: compare *Interfelt Products (Pty) Ltd v Feltex Ltd* 1972 (3) SA 335 (T) at 342H-343A.

[10] The argument that the application for amendment had to be made to the registrar of patents in terms of s 51 and not to the Commissioner was rightly rejected by Murphy J and it was not argued that he had erred in that regard. There was otherwise due compliance with the court order. As far as (b) is concerned, the respondents in two affidavits filed on their behalf and sworn to by Mr Marais Steyn, who is the managing director of the first and third respondents and who is, in his personal capacity the fourth respondent, admitted unequivocally that the application for amendment was not in conflict with the mentioned provisions. In spite of this the respondents sought to argue in the context of invalidity that the new claims are not fairly based on the matter disclosed in the specification. The respondents submitted that they were entitled to do so because this question is a legal issue and not factual and that the admission was accordingly not binding. Nicholas AJA disposed comprehensively of an identical argument in *Water Renovation (Pty) Ltd* at 604J-608B and the issue need not be revisited. Another submission, which was made in the heads but not adverted to during argument, was that the patentee had failed to

'(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 or 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 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 to 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.'

provide full reasons for the amendment (as if everyone did not know what they were). Since the submission was made with reference to a judgment that had been overruled by this court in *Kimberly-Clark of SA (Pty) Ltd (formerly Carlton Paper of SA (Pty) Ltd) v Proctor & Gamble SA (Pty) Ltd* 1998 (4) SA 1 (SCA) no more need be said about the matter.

[11] The respondents submitted at the outset that Murphy J had exercised a discretion by refusing the application and that this court is not entitled to interfere with that exercise except in very limited circumstances. The first point is that the learned commissioner did not purport to exercise his discretion. He found that the amendments sought would not cure the invalidity of the patent. If an amendment fails at hurdles (a) or (b), that is usually the end of the matter. Discretion does not arise. The same (possibly subject to what van Dijkhorst J said in *Deton Engineering (Pty) Ltd v JP McKelvey* 1997 BIP 113) applies at hurdle (c). It is only if that is passed that the discretion to refuse can arise. Whether a court has a discretion in the strict sense to refuse an amendment has not yet been decided and need not be decided: *Media Workers Association of SA v Press Corporation of SA Ltd ('Perskor')* 1992 (4) SA 791 (A) at 797E-G; *Knox D'Arcy Ltd v Jamieson* 1996 (4) SA 348 (A) at 360D-362E.

THE INVENTION

[12] As the title of the specification indicates, the invention relates to improvements to agricultural seeding machinery. For some background: the conventional steel ploughshare, famously invented by John Deere, tills the soil by turning it over and thereby cuts furrows for planting. More recently, a no-till farming method has taken hold. Chisel ploughs in the form of elongated pointed chisels or sharp prongs (referred to as tines in the specification) are mounted onto a frame which is drawn behind a tractor. As appears from the prior art, seed planters and fertilizer dispensers are often attached to the chisel plough sequentially, enabling ploughing, fertilizing and planting to take place in a single operation.

[13] Under the heading 'Object of the invention' the patentee stated:

'It has been found in practice that tined seeding machinery and attachments have difficulty in penetrating soil deeply whilst at the same time maintaining accurate placement of seed and fertilizer. Due to the undulating ground conditions nearly always encountered, and with seeding depth controlled by widely spaced ground wheels, seeding depth cannot be

maintained, often with seed and fertilizer placed together on a hard impenetrable barrier causing poor seed germination, loss of plant vigour, low yields, poor water infiltration, waterlogging and fertilizer toxicity and a greater incidence of disease.'

The object of the invention, the specification states, is to overcome or substantially ameliorate these disadvantages. Nugent JA gave this description in the SCA judgment:

'The machinery is designed for planting seeds in untilled soil. It is essentially a frame that is dragged behind a tractor on which a series of tools are mounted in a line one behind the other each performing one of a series of functions. First in line is a tine (or share) that cuts a slot in the untilled soil. Optionally, a tube might be mounted behind the tine, through which fertilizer may be deposited in the slot. Behind the tube is a device of one kind or another that collapses soil into the slot so as to partially fill it, which serves a dual purpose: the collapsed soil separates the fertilizer (if fertilizer is used) from the seed and avoids the seed being burnt, and it forms a suitable bed upon which to deposit the seeds. Behind that tool is another vertically-mounted tube through which seeds are deposited on the bed. And behind that is a wheel, wider than the slot, which dislodges more soil from the sides of the slot, covering the seed, and simultaneously tamping it down to ensure that the seed is in good contact with the surrounding soil.'

THE PROPOSED AMENDMENT

[14] The patentee did not seek to effect any amendments to the body of the specification but only to claims 1 and 13. In addition, the omnibus claims are to be deleted but nothing turns on this. The object of the proposed amendments to claim 1 is to limit its scope through the introduction of an integer of the original claim 13 into claim 1. The amended claim 13 is not much different.

[15] It is not necessary to quote the original claim 1 because its terms are apparent from the proposed amended claim 1, which reads as follows (the insertions are in bold and the deletion is indicated):

'A seeding assembly to be used with a plough frame supporting at least one plough tine, said assembly comprising:

- (A) a seeding tube (i) to extend downwardly into a slot formed in a soil layer by the tine, (ii) said tube having a lower extremity through which seed is delivered into the soil layer;
- (B) a closing tool (i) fixed with respect to said lower extremity and having a leading surface forward thereof relative to the normal direction of travel of the frame over the soil layer, (ii)

said closing tool being aligned in said direction with respect to said lower extremity so that it engages soil adjacent said slot to dislodge the soil to partly close the slot and provide a seed bed onto which seed leaving said lower extremity is delivered; **and**

(C) **a first mounting means to attach the tube and closing tool to the frame to permit height adjustment of the tube and the closing tool with respect to the frame; and**

(D) ground engaging means operatively associated with the tube and closing tool to engage the soil layer to cause said height adjustment; and

(E) **a second mounting means, which is adjustable for adjustably attaching the ground engaging means to the tube and closing tool thereby enabling said ground engaging means to effect said height adjustment.'**

The numbering of integers has been added for the sake of convenience but is simpler than that used by the previous courts and by counsel.

[16] The proposed claim 13 is in these terms:

'In combination, a plough tine having a lower extremity to which there is attached a digging blade, a fertilizer tube and a seeding assembly to be used with a plough frame supporting at least the plough tine, said assembly comprising:

a seeding tube to extend downwardly into a slot formed in a soil layer by the tine, said tube having a lower extremity through which seed is delivered into the soil layer;

a closing tool fixed with respect to said lower extremity and having a leading surface forward thereof relative to the normal direction of travel of the frame over the soil layer, said closing tool being aligned in said direction with respect to said lower extremity so that it engages soil adjacent said slot to dislodge the soil⁹ to partly close the slot and provide a seed bed onto which seed leaving said lower extremity is delivered;

a first mounting means to attach the tube and closing tool to the frame to permit height adjustment of the tube and the closing tool with respect to the frame;

wherein said first mounting means is adapted to be attached to the tine in order to be attached to the frame;

ground engaging means operatively associated with the tube and closing tool to engage the soil layer to cause said height adjustment

wherein the digging blade, fertilizer tube, closing tool, seeding tube and ground

⁹ The phrase 'to dislodge the soil' was omitted by mistake from the draft contained in the notice of motion. Since it had always been part of the claim and the patentee did not give notice of any intention to delete the phrase, the omission is immaterial.

engaging means are aligned in that order in the intended direction of travel;

wherein said digging blade, closing tool and ground engaging means each have an operative width, with the operative width of said digging blade being narrower than the operative width of said closing tool and with the operative width of said closing tool being narrower than the operative width of said ground engaging means;

a second mounting means, which is adjustable for adjustably attaching the ground engaging means to the tube and closing tool thereby enabling said ground engaging means to effect said height adjustment; and

wherein the seeding assembly is directly attached to the tine, so as to be movable relative thereto to provide said height adjustment.'

OBJECTIONS TO THE AMENDMENT

[17] The main objections to the amendment are based on continuing obviousness and, in the alternative, culpable delay and reprehensible conduct. Before dealing with these it might be convenient to dispose of other allegations concerning continuing invalidity.

[18] The first is that the invention as illustrated or exemplified cannot be performed or lead to the advantages and results set out in the complete specification (s 61(1)(d)). This objection is based on the fact that in some countries integer C of claim 1 of the corresponding claim contains at the end the words 'and tine', reading 'a first mounting means to attach the tube and closing tool to the frame to permit height adjustment of the tube and the closing tool with respect to the frame **and tine**.'

As a result of the omission of the tine the argument was that the amendment does not include a limitation which permits height adjustment of the seeding tube and closing tool relative to the tine but only relative to the frame. What the argument ignored is the fact that the plough frame supports the tine and that the first mounting means attaches the tube and the closing tool with respect to the frame. As the tine is supported by the frame, height adjustment of the tube and the closing tool with respect to the frame will result in height adjustment of the tube and closing tool relative to the tine. Simply put, the tine is attached to the frame and if the frame's height is adjusted so is that of the tine.

[19] Other objections relate to lack of clarity (s 61(1)(f)(i)). A surprising aspect of the objections under this heading is that what was clear at the time of the

infringement action is no longer clear. Another amazing aspect is that the respondents' expert, Mr Steyn, in his affidavit on behalf of Northpark apparently understood the claims but when he filed his affidavit on his and the third respondent's behalf some ten months later it all became opaque.

[20] Since patent cases are about construction and not deconstruction of a text it might be useful to have regard to this statement:¹⁰

'The board adds that the skilled person when considering a claim should rule out interpretations which are illogical or which do not make technical sense. He should try, with synthetical propensity i.e. building up rather than tearing down, to arrive at an interpretation of the claim which is technically sensible and takes into account the whole disclosure of the patent (Article 69 EPC). The patent must be construed by a mind willing to understand not a mind desirous of misunderstanding.'

[21] The first issue relates to the preamble of claim 13, which is in these terms:

'In combination of a plough tine having a lower extremity to which there is attached a digging blade, a fertilizer tube and a seeding assembly'

The claim then proceeds to recite the integers of claim 1. The complaint is that it is not worded as is the US claim:

'a plough tine having attached to it a fertilizer tube and seeding assembly of claim 1, as well as a digging blade attached to the lower extremity of the tine.'

I fail to see the difference between the two.

[22] Integer D is about 'a first mounting means to attach the tube and closing tool to the frame to permit height adjustment of the tube and the closing tool with respect to the frame'. The respondents say that they do not know where to find this mounting means. The integer is in my view clear. It is a means to attach the tube and closing tool to the frame in such a manner that they can be adjusted in relation to the frame. Had there been evidence that the skilled person in the art could not, with reference to the specification, construct such apparatus an argument of insufficiency could have been made but not one of lack of clarity.

¹⁰ Boards of Appeal of the European Patent Office Case no T 0190/99 - 3.2.4. The statement that a patent 'must be read by a mind willing to understand, not by a mind desirous of misunderstanding' comes from *Lister v Norton Brothers and Co* (1886) 3 RPC 199 (Ch D).

[23] The last complaint relates to integer E:

‘a second mounting means, which is adjustable for adjustably attaching the ground engaging means to the tube and closing tool thereby enabling said ground engaging means to effect said height adjustment.’

The case for the respondents is that it is not clear from the wording of this integer exactly how the second mounting means enables the ground engaging means to effect the height adjustment. This, too, smacks of an allegation of insufficiency without evidence to sustain it. The patentee’s response was that the second mounting means allows for the attachment of a wheel (the ground engaging means) to the tube and closing tool in such a manner that the relative position of the wheel to the tube and closing tool is adjustable; and it is not the mere presence of the wheel that enables height adjustment but the fact that the wheel is attached to the tube and closing tool. Respondents’ counsel did not deal with the response and I do not know why it is wrong.

OBVIOUSNESS: SOME LEGAL CONCEPTS

[24] As mentioned, Murphy J held that the amendment could not be granted because it would not cure the invalidity of the patent on the ground of obviousness. Before dealing with the facts of the case it might be useful to restate some basic legal principles that appear to have been overlooked and that impact on the case.

[25] As was explained in *Roman Roller CC v Speedmark Holdings (Pty) Ltd* 1996 (1) SA 405 (A) at 412H-413D, a patent may be granted ‘for any new invention which involves an inventive step’ (s 25(1)). (In what follows I am dealing in a simplified manner with only those provisions that are relevant for this judgment.) A patent may be revoked on the ground ‘that the invention concerned is not patentable under section 25’ (s 61(1)(c) and s 65(4)). There are, accordingly, two relevant requirements for patentability. The first is that the invention must be new. This means that the invention does not form part of the prior art (‘the state of the art’). The provision requires identity between the claimed invention and the state of the art. The state of the art ‘comprises all matter (whether a product, a process, information about either, or anything else) which has been made available to the public (whether in the Republic or elsewhere) by written or oral description, by use or in any other way’ (s 25(6)). If the invention does not form part of the prior art, it is deemed to be new (s 25(5)).

[26] The second requirement, which is based on the assumption that the invention is new (an aspect alluded to earlier in this judgment), is that it must involve ‘an inventive step’. An invention is ‘deemed to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms, immediately before the priority date of any claim to the invention, part of the state of the art’ at the relevant time (s 25(10)). In other words, the issue is whether the invention, which differs from the state of the art, has inventive merit. This means that the respondents had to prove that the patent as amended was not inventive, ie, ‘that it was obvious and not due to any inventive ingenuity’: *B-M Group (Pty) Ltd v Beecham Group Ltd* 1980 (4) SA 536 (A) at 557D-E.

[27] The requirement of inventiveness was formulated differently in the repealed Patents Act 37 of 1952 (s 23(1)(d)). The first difference is that in the past the inventive step was measured against the ‘common knowledge in the art’ only and not against the more formally defined state of the art as in the current Act. This difference does not impact on the present case.

[28] The second difference is that the 1952 Act simply asked whether the invention was obvious in that it involved no inventive step and not, as the current Act does, whether it was not obvious *to a person skilled in the art*. Against an identical legislative backdrop, Sir Donald Nicholls VC said the following in *Mölnlycke AB v Proctor & Gamble Ltd* [1994] RPC 49 at 112-113:

‘Under the statutory code (which is further confirmed in its completeness by sections 74 and 72) the criterion for deciding whether or not the claimed invention involves an inventive step is wholly objective. It is an objective criterion defined in statutory terms, that is to say whether the step was obvious to a person skilled in the art having regard to any matter which forms part of the state of the art as defined in section 2(2). . . . The statute has laid down what the criterion is to be: it is a qualitative not a quantitative test. . . .

The Act requires the court to make a finding of fact as to what was, at the priority date, included in the state of the art and then to find again as a fact whether, having regard to that state of the art, the alleged inventive step would be obvious to a person skilled in the art.

In applying the statutory criterion and making these findings the court will almost invariably require the assistance of expert evidence. The primary evidence will be that of properly qualified expert witnesses who will say whether or not in their opinions the relevant step would have been obvious to a skilled man having regard to the state of the art. All other

evidence is secondary to that primary evidence. In the past, evidential criteria may have been useful to help to elucidate the approach of the common law to the question of inventiveness. Now that there is a statutory definition, evidential criteria do not form part of the formulation of the question to be decided.'

[29] This court, in *Ensign-Bickford (SA) (Pty) Ltd* at 81E-F, quoted the last paragraph with approval but I believe that the preceding ones are necessary for context and they, in addition, emphasize that one is concerned with a factual issue. A court has 'to find again as a fact whether, having regard to that state of the art, the alleged inventive step would be obvious to a person skilled in the art'. This conforms to what Lord Reid tersely stated in *Technograph Printed Circuits Ltd v Mills & Rockley (Electronics) Ltd* [1972] RPC 346 at 362:

'But the question is not whether it is now obvious to the court (or to the jury) but whether at the relevant date it would have been obvious to the unimaginative skilled technician.'

[30] Dealing with the reliance in *Ensign-Bickford (SA) (Pty) Ltd* on the statement of the Vice-Chancellor, this court in *Schlumberger Logelco Inc v Coflexip* 2003 (1) SA 16 (SCA) para 34 said, as far as is relevant for present purpose, this:

'It is the technical evidence by expert witnesses in respect of the nature of the step claimed to have been inventive, the state of the art as at the priority date relevant to that step and the respect or respects in which the step goes beyond or differs from that state of the art, which constitutes the primary evidence. It is clear from a reading of the *Ensign-Bickford* case, at 81D-83A, that the Court considered the question of obviousness on that basis. The technical evidence of the witnesses was considered without any reference to their opinions as to whether the invention was obvious. Expert witnesses who are either of the opinion that the invention is obvious or that it is not obvious would almost invariably give the primary technical evidence. In these circumstances it may sometimes be difficult to avoid them expressing the conclusion that the step is either obvious or not obvious, but that would do no harm so long as it is borne in mind that that conclusion is immaterial.'

[31] The inventive step has often been referred to as a step forward but that term is misleading. A new analgesic need not be as good as or better than the century-old Aspirin in order to be inventive. The seeding apparatus of the patent in suit may do the same as other seeding machines but provided it does it in a sufficiently different manner it may be inventive: *B-M Group (Pty) Ltd* at 557A-D.

[32] The question whether an invention is new or inventive is determined with reference to the invention claimed in each claim and not in relation to the description of the invention in the body of the specification: compare *Netlon Ltd v Pacnet (Pty) Ltd* 1977 (3) SA 840 (A) at 861H-862B; *Ensign-Bickford (SA) (Pty) Ltd* at 81C-D. A particular claim may also embody more than one invention in which event the question would be whether the particular embodiment lacks novelty or inventiveness.

[33] The Act does not require that the inventive step be stated in the body of the specification or, if stated, that it should have been correctly stated. As was said in *Ensign-Bickford (SA) (Pty) Ltd* at 82E-F:

‘Secondly the questions themselves were not properly directed to the invention defined by the claims. The objection of lack of inventiveness is not an objection to "teaching" in the body of the specification. It is the claims which must be considered . . .’

[34] It is useful to quote in this regard from the judgment of Sir Robin Jacob LJ in *Nichia Corp v Argos Ltd* [2007] EWCA Civ 741 (19 July 2007) paras 12-16:

‘The structured approach to considering obviousness is well-settled (see per Oliver LJ in *Windsurfing v Tabur Marine* [1985] RPC 59 at 73). I recently restated it in *Pozzoli* [2007] EWCA Civ 588 at [23]: (1) (a) Identify the notional “person skilled in the art”; (b) Identify the relevant common general knowledge of that person; (2) Identify the inventive concept of the claim or if that cannot readily be done, construe it; (3) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim or the claim as construed; (4) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of invention?

For present purposes what matters is that this basic formulation does not involve expressly what the inventor actually did or thought. Nor for that matter what his opponent did or thought. The inventor may have thought that what he did was little short of, or actually, a work of genius - that he was a latter day Edison. . . . No matter what it was, the test is not what he did or thought but whether the step would have been obvious to the man skilled in the art.

It is quite possible that what the inventor did was, given his particular circumstances, actually very clever, yet his patent be held invalid for obviousness. . . .

The inventor can say what he thought was clever in his patent, though it is well-settled that he need not do so – it is not an objection to validity that the patentee has failed to distinguish what is new from what is old. But whether it actually was inventive depends on the expert

evidence establishing the common general knowledge of the person skilled in the art and the teaching of the cited prior art.

And there are more reasons why that should be so. A patent is a public document. Any member of the public ought in principle to be able to make his own assessment of not only what the monopoly actually is, but whether that monopoly is valid. Obviousness is an objective question. . . .’

OBVIOUSNESS: THE FACTS

[35] To understand the factual issues surrounding the obviousness issue it is necessary to begin with the judgment of Southwood J. He had to consider whether four patent specifications anticipated claim 1. Two of these require mention. The first is US patent 4, 726, 304 (Dreyer) and the second US patent 4, 691, 645 (Anderson). He found that neither anticipated claim 1. The reason why Dreyer did not anticipate, he held, was that integers A(i) and B(ii) were not disclosed. The reasons why Anderson did not anticipate are not strictly speaking relevant but I mention Anderson because it discloses integer A(i).

[36] Against that background Southwood J considered inventiveness. In that context Northpark relied heavily on US Patent No. 5, 161, 472 (Handy). There was also a reference to a Soilmaster implement but that has since been lost in the wash and can be discounted. Northpark’s case was (both in evidence and in argument) that, except for one integer, the Handy patent disclosed all the integers of the claim and that the skilled addressee would have combined integer A(i) from Anderson with the Handy implement. Southwood J rejected the argument.

[37] The SCA, as mentioned, did not consider novelty and all assume that it thereby confirmed the finding of Southwood J in that regard. It differed, however, from Southwood J’s interpretation of Dreyer by holding (in the course of its determination of the state of the art for purposes of obviousness) that Dreyer did indeed disclose integer B(ii). The SCA then combined Dreyer and Anderson to conclude that claim 1 lacked an inventive step.

[38] Building on that finding, the respondents’ case is that the claims in their amended form lack subject matter because they are obvious through a mosaicing of Dreyer and Anderson. (On the subject of mosaicing: Simon Thorley et al *Terrell on*

the Law of Patents 16 ed para 7-62.) This presupposes, on the respondents' argument, that the added integer (E) 'a second mounting means, which is adjustable for adjustably attaching the ground engaging means to the tube and closing tool thereby enabling said ground engaging means to effect said height adjustment' was disclosed in Dreyer. It is fortunately not necessary to analyze Dreyer because respondents' counsel, during argument, fairly conceded that this integer was not disclosed by Dreyer. And it was not suggested that the integer could be found elsewhere in the prior art.

[39] That leaves for consideration the issue of inventiveness: did the respondents show that the invention claimed was not inventive? It should be borne in mind that we are dealing with a mechanical apparatus and the invention claimed is the combination of a number of elements that interact in a particular manner. In *De Beers Industrial Diamond Division (Pty) Ltd v Ishizuka* 1980 (2) SA 191 (T) at 201C-E, Nicholas J quoted with approval this statement from *Albert Wood and Amicolite v Gowshall Ltd* (1937) 54 RPC 37 at 40:

'The dissection of a combination into its constituent elements and the examination of each element in order to see whether its use was obvious or not is, in our view, a method which ought to be applied with great caution since it tends to obscure the fact that the invention claimed is the combination. Moreover this method also tends to obscure the fact that the conception of the combination is what normally governs and precedes the selection of the elements of which it is composed rather than that the obviousness or otherwise of each active selection must in general be examined in the light of this consideration. The real and ultimate question is: Is the combination obvious or not?'

[40] In *Technograph Printed Circuits* at 362, Lord Diplock said this:

'Once an invention has been made it is generally possible to postulate a combination of steps by which the inventor might have arrived at the invention that he claims in his specification if he had started from something that was already known. But it is only because the invention has been made and has proved successful that it is possible to postulate from what starting point and by what particular combination of steps the inventor could have arrived at his invention. It may be that taken in isolation none of the steps which it is now possible to postulate, if taken in isolation, appears to call for any inventive ingenuity. It is improbable that this reconstruction *a posteriori* represents the mental process by which the inventor in fact arrived at his invention, but, even if it were, inventive ingenuity lay in

perceiving that the final result which it was the object of the inventor to achieve was attainable from the particular starting point and in his selection of the particular combination of steps which would lead to that result.'

[41] The inventor's (Mr Ryan's) evidence that the invention solved the problems set out under the quoted 'Background' was met by what fairly may be called a bald denial by Mr Steyn who was in any event not an agricultural engineer at the effective date of the patent. Mr Ryan, furthermore, testified that the claimed combination overcame a number of deficiencies of the prior art. In particular he mentioned the following: The failure to create a deep root bed; the failure to create a compacted seed bed directly above the root bed; the failure to create the seed bed at a relatively constant depth; the failure to effect precision placement of the seed on the seed bed directly above the root bed; the failure to effect closing of the seed with soil of a relatively constant depth; the failure to compact the soil around the seed; the failure to allow for independence in the working depth of the tine and the depth at which the seed is placed; the failure to allow adjustment of the seeding depth independently from the working depth of the tine; having broad faced working tools which increase drag and caused wide and unnecessary soil disruption; and the failure to create a deep root bed, a seed bed, the precision placement of seed and the closing of the seed with soil which is compacted around the seed, at a relatively constant depth in a single operation.

[42] This evidence, too, was met with a bald denial from Mr Steyn. Murphy J disregarded the evidence on two main bases. The first was 'the important point that many of the advantages Ausplow claims the invention has over the prior art are not referred to in the specification'. And the second was that 'to read these advantages into the specification would be to introduce new matter not in substance disclosed in the specification before amendment'. I have already pointed out the first point is legally unsound. As Lord Hoffmann said in *Conor Medsystems Inc v Angiotech Pharmaceuticals Inc & Ors* [2008] UKHL 49 para 19:

'In my opinion, however, the invention is the product specified in a claim and the patentee is entitled to have the question of obviousness determined by reference to his claim and not to some vague paraphrase based upon the extent of his disclosure in the description.'

A similar statement appears in *Unilever v Chefaro* [1994] RPC 567 at 580:

'It is the inventive concept of the claim in question which must be considered, not some generalised concept to be derived from the specification as a whole.'

[43] The second is based, I fear, on a misconception. The objection to new matter in the specification arises when an application for amendment is made in order to introduce that matter into the specification (s 59(6)). The patentee did not seek to amend the specification by introducing this evidence. The provision has nothing to do with evidence in support of the inventiveness of a claimed invention. As was said in *McKelvey v Deton Engineering (Pty) Ltd* 1998 (1) SA 374 (SCA) at 379D-E:

'The Act draws a clear distinction between "matter" and the claimed invention. "Matter", in general, refers to the disclosure in the body of the specification that *can* support a claim, whether or not there is a claim based thereon.'

(Compare eg *Bonzel v Intervention Ltd* [1991] RPC 553.)

[44] The learned commissioner also relied on part of the reasoning of the SCA when it had to consider whether the invention claimed in the unamended claim 1 was inventive. That reasoning cannot simply be made applicable to another invention claimed in a different claim. The learned commissioner, I respectfully suggest, should have decided the case on the facts before him and not with reference to the reasoning of the SCA which was directed at something different.

[45] I therefore conclude that the respondents have failed to establish that the invention claimed in the amended claims 1 and 13 did not involve an inventive step because it was obvious to a person skilled in the art.

DISCRETION

[46] The respondents asked us, in the event of having found that the amendment will cure the invalidity, to refuse the application in the exercise of this court's discretion. The first ground advanced was the patentee's alleged culpable delay in applying for the amendment. The argument was based on the fact that the patentee had known of the Dreyer prior art and that it delayed to effect an amendment until after the adverse judgment of the SCA. There are many answers to the point but what follows suffices. Dreyer was quoted as an anticipation, which it is not. As far as obviousness is concerned, not even Northpark had thought that it could be the basis of a finding of obviousness. I have already indicated that its case before Southwood

J was based on a mosaic of Handy and Anderson. The SCA, however, based its judgment on a mosaic of Dreyer and Anderson. How that should have been apparent to the patentee before the SCA judgment has not been explained.

[47] One can dispose on more or less the same basis of the allegation that the patentee was guilty of reprehensible conduct because, being aware of the invalidity of the patent in the light of Dreyer, it sought to enforce its patent rights. Once again, the premise on which the argument is based has not been established. It is also not possible to dispose glibly of the fact that Southwood J had held in a fully reasoned judgment that the patent was good. If he thought so after a lengthy trial it is difficult to understand why the patentee should have thought differently, especially since it took legal advice before it commenced litigation.

[48] The respondents did not ask us to consider the grant of the amendment subject to conditions. The reason may be because Northpark is a property owning company and the third and fourth respondents allege that they do not infringe the amended claims. It would, accordingly, be wrong to impose conditions of which the patentee had not been forewarned.

CONCLUSION

[49] This means that the appeal must be upheld to the extent that the order of the court below dismissed the application to amend the specification and finally revoked the patent. The orders not appealed against stand. Because of the partial success of the respective parties in the court below the appropriate order would be that the parties pay their own costs in that court. The appellant is entitled to its cost of appeal including the costs of two counsel.

ORDER

A. The appeal is upheld with costs (jointly and severally against the first, third and fourth respondents), including the costs of two counsel.

B. Paragraphs 3, 4 and 5 of the order of the Court of the Commissioner of Patents are set aside and replaced with the following:

‘3 The application to amend the specification of Patent ZA 95/0812 is granted.

4 The provisional order of revocation lapses.

5 The parties are to pay their own costs.'

L T C Harms
Acting President

APPEARANCES

For Appellant: P Ginsburg SC (with him D R Harms)

Instructed by:

Adams & Adams, Pretoria

Lovius Block Attorneys, Bloemfontein

For Respondent: C J vd Westhuizen SC (with him R B Engela)

DR Gertholtz Inc, Pretoria

McIntyre & Van der Post, Bloemfontein

Second Respondent:

The Registrar of the Court of the Commissioner of
Patents Pretoria

