



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

1. REPORTABLE: NO
2. OF INTEREST TO OTHER JUDGES: NO
3. REVISED: NO

DATE: 12/6/2025

GDP Case no.: 2023-063620

Patent no: 2010/06044

In the matter between:

TIMRITE (PTY) LTD

First Applicant

TUFBAG (PTY) LTD

Second Applicant

and

VESPER PROJECTS (PTY) LTD

First Respondent

THE REGISTRAR OF PATENTS

Second Respondent

This Order is made an Order of Court by the Judge whose name is reflected herein, duly stamped by the Registrar of the Court and is submitted electronically to the Parties / their legal representatives by email. This Order is further uploaded to the electronic file of this matter on Case Lines by the Judge or his / her secretary. The date of this Order is deemed to be 11 June 2025.

In re: Application for the amendment of South African Patent of Addition No. 2010/06044 in terms of section 51(9) of the Patents Act, No. 57 of 1978

JUDGMENT

Strydom AJ

- 1) The first Applicant ("Timrite") is the holder of a patent, entitled "Yielding Mine support" relating to a mine support pack which incorporates a load support bag, that includes a grout bag with a yield element ("Timrite's patent"). It now applies to amend certain claims of this patent.
- 2) The patent, in its current form, is the result of a prior amendment application which served before the registrar in 2016. At that time, Timrite motivated the

amendment by stating that it was brought “.... *to narrow the scope of claim 1 with a view further to differentiate the claimed invention from GB2,131.850, WO03/085234, US2010/0189514, US4,966,310, US 5,660,478, US5,665,887 and US6,109,785.*” The 2016 amendment application was, initially, vigorously opposed by Company S (not a party in the present dispute), however, following a settlement reached inter partes, the opposition was withdrawn in 2017 and claim 1 was duly amended.

- 3) Vesper, the first respondent, sells a competing mine support pack (the “Vesper bag”). In 2023, it received a letter of demand from Timrite, accusing it of infringing on Timrite’s patent and warning that, should it persist in infringing, Timrite would consider instituting patent infringement proceedings, including claims for interdictory relief, delivery of infringing products for destruction and/or an enquiry into damages and costs.
- 4) Vesper countered the by launching an application for declaration of noninfringement (“the declaration application”) in terms of section 69(1) of the Patent’s Act, where it argues for such a declaration on the basis that:
 - a) The Vesper bag does not infringe on Timrite’s patent given various differentiations between the specifications of the two products;
 - b) Even if it was infringing, current claims 1 and 15 (the independent claims) are invalid for lack of novelty and/or was not inventive in light of three prior art documents: PCT/IB2008/000107 (“IB107”), PCT/IB03/01323 (“IB323”) and PCT/GB98/02363 (“GB363”).
- 5) IB323 is specifically mentioned in the reasons provided for the 2016 amendment application. Timrite submits that, in 2016 it was not aware of IB107 and it only came to their attention when they perused the affidavit of Mr Keen, Vesper’s expert, attached to Vesper’s founding affidavit in the declaration application. In relation to GB363, Timrite admits to having been aware of and having considered it for purposes of the 2016 amendment. However, it explains that, as, at that stage, it did not consider GCB363 to be “*one of the most relevant prior art documents*”, it was not pertinently mentioned in the reasons for the 2016 amendment application.

- 6) The declaration application remains pending as Timrite, having given notice of opposition, has yet to file its answering affidavit.
- 7) Instead, Timrite has brought the present application to amend. Objectively, there can be no real dispute that the amendments are sought as a result of the evidence contained in Mr Keen's declaration application. Timrite has attached Keen's declaration affidavit to its founding affidavit herein. Under the heading "reasons", Timrite starts its motivation for the amendments sought by first engaging with the allegations contained in Mr Keen's declaration affidavit as follows:
- a) In paragraph 9 of his declaration application affidavit, Mr Keen states that some of the claims of the patent are not novel in light of the disclosures in GB363.
 - b) Mr Keen's contention is incorrect as the claims are novel as they differ from the disclosures contained in GB363 in the following respects:
 - i) The straps described and shown GB363 include metal bracing plates through which the loop portions of the straps pass as well as a heavy-duty metal ring through which the loop portions pass and are folded over.
 - ii) GB363 does not disclose two lines of stitching and also does not contain a disclosure of the opposite ends of the at least one strap being stitched into the opposed lines of stitching.
- 8) Invalidity of the claims in their current form, having been so denied, Timrite then indicates that it now *"...wishes to better define the invention by specifying important features of the commercial embodiments of the invention in the amended independent claims 1, 15 and 16 to 19"* by:
- a) Amending claims 1 and 15 to include two following additional specifications:
"each line of stitching forms an intermediate seam on the side surface" and *"at least the opposite ends of the at least one strap being stitched into the intermediate seams"*,
 - b) Adding new independent claims 16 to 19 and a new dependant claim 21
 - i) New claims 16,18 and 21 introduce the following additional specification:
"the or each strap comprises a reinforcing web constituted by a layer of fabric"

- ii) New claim 19 introduces the following additional specification:
 - iii) *"the grout bag being internally divided by at least one layer made up of the first yield control element comprising a reinforcing web constituted by a layer of woven polypropylene fabric"*
 - c) Deleting claim 17 and the omnibus claims 18 to 20.
- 9) Vesper opposes the application and has advanced four grounds of objection. It has attached to its answering affidavit a second affidavit deposed to by its expert, Mr Keen ("Keen's amendment affidavit"), wherein he provides evidence and argument in relation to the four grounds of objection, namely:
- a) In relation to the proposed new claims 16, 18, 19 and 21: That the amendments sought do not comply with section 51(6)(b) of the Act as they are not fairly based on matter disclosed in the specification before amendment ("lack of fair basis");
 - b) In relations to proposed new claims 1 and 15: That the amendment serves no purpose because the claims in their current form are invalid for lack of novelty and the proposed amendments will not cure the invalidity ("continuing invalidity");
 - c) That Timrite has failed to provide full reasons for the amendment ("failure to provide reasons");
 - d) That, as Timrite has delayed, culpably, in bringing the application to amend, and has acted mala fide in threatening to enforce, an invalid patent, this court should exercise its discretion to refuse the application ("culpable delay and reprehensible conduct").

Issues for determination

- 10) Timrite has, as a preliminary point, argued that the continuing invalidity objection should not be decided in the present application and should, instead be deferred for decision simultaneously with the pending declaration application. As the culpable delay and reprehensible conduct objections are dependent on a determination of existing invalidity of the patent, which forms part of the determinations for purposes of the continuing invalidity objection, they by necessary implication are to be likewise deferred.

11) In view hereof, it submits that for purposes of the present application, the only determination that should be made is whether there is a fair basis for the amendments, which it submits there is.

12) In summary, it submits that this court should:

- a) Uphold the preliminary point and defer the continuing invalidity objections (inclusive of the culpable delay and reprehensible conduct objections) to the declaration application;
- b) After determining the preliminary point in its favour, proceed to:
 - i) Determine that there is fair basis for the amendments and dismiss the fair basis objections; and
 - ii) Dismiss the lack of full reasons objection.
- c) Allow the amendments

15) Vesper argues that the continuing invalidity objection stands to be determined in the current proceedings. As such, it argues that this court should:

- a) Dismiss the preliminary point;
- b) After determining the preliminary point in its favour, proceed to:
 - i) Determine and uphold its continuing invalidity objection; and/or
 - ii) Determine that there is no fair basis for the amendments and uphold the fair basis objections; and/or
 - iii) Uphold the lack of full reasons objection.
- c) Dismiss the application

16) The commonality between the two submissions is that this court must decide whether or not the amendments should be granted, taking into account, at least, Vesper's lack of fair basis objection.

17) Having noted in preparation that the arguments in relation to the lack of fair basis objection, *prima facie*, also overlap with issues raised in declaration application, I raised the possibility of postponing the entire application.

18) Counsel for both parties, were adamant that it is only in relation to continuing invalidity objections that a court should apply the arguments made in the preliminary point. It was also submitted that the legislative scheme of the Act does not afford this court a discretion to defer the hearing of the entire application on this basis.

19) I do not agree with the parties' contentions in relation to the discretion and/or powers of a court in patent amendment applications. I have found no basis for such a limitation on the court's powers. To the contrary, in the matter of *Antell*¹, (which I had also pertinently brought to counsels' attention at the hearing) Fourie J refused to decide either the lack of fair basis or the continuing invalidity objections on the basis of overlap and, as a result, deferred the hearing of the amendment application to pending revocation proceedings. I had also, in relation to the submission on the legislative scheme referred counsel to the provision of section 51(9) in terms of which any amendment may be dealt with by this court 'as it thinks fit'. Having also now considered, in depth, the reasoning of Van Dikhorst J in *Deton* (fully discussed below), I am further fortified in my view that, as a general proposition, this court may decline to hear the application in toto and order that such an application be determined simultaneously with pending proceedings.

20) That having been said, as context and a proper grasp of the issues is required before any determination of overlap, similarity or deferral (in relation to any issue) can be made, it was necessary to, in any event, hear the totality of the parties' submissions in relation to the amendments and the objections..

Contextualisation

21) The relevance and "ranking" of the respective objections raised by Vesper are perhaps best understood within the framework for deciding patent amendment application, as set out by Supreme Court of Appeal ("SCA") in *Ausplow (Pty) Ltd v Northpark Trading 3 (Pty) Ltd and Others*²:

"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 s51(6) or (7) of the Act; (c) almost invariably, whether the patent as amended will be valid; and (d) 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)

¹ *Antel and Another v Virtual Consulting Engineers (Pty) Limited and Others* (63720/12) [2014] ZAGPPHC 476 (27 February 2014)

² *Ausplow (Pty) Ltd v Northpark Trading 3 (Pty) Ltd and Others* [2011] 4 All SA 221 (SCA) (7 September 2011) (*'Ausplow'*)

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: As to (d), the onus rests on the objector to establish the facts that would entitle the court to refuse the amendment.

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.”

22) For present purposes, the framework can be restated thusly:

- a) Hurdle A: Has Timrite proven that the proposed amendments are fairly based on matter disclosed in the specification before amendment? If not, the amendments must be refused. If proven, the Court will still consider hurdles B (if not considered yet) and C below.
- b) Hurdle B: Has Vesper proven that the claims in their amended form will be invalid? If proven, the amendments must be refused. If not, the Court will still consider hurdles A (if not considered yet) and C. It is however also open to the court to decline to consider continuing invalidity in the amendment proceedings and to postpone the question for determination simultaneously with future pending proceedings. The circumstances under which the so-called “*Deton*”³ approach apply, will be further discussed below.
- c) If the amendment is warranted per A and/or B supra, has Timrite managed to establish any other grounds upon which this court may exercise its discretion to nonetheless refuse the amendments?

23) Per clarification: The determinations of hurdles A and B are not interdependent and do not follow each other consecutively. However, Hurdle C considerations only come into play if it is found that the amendments sought have overcome both hurdles A and B (i.e. are “otherwise in order”).

³ *Deton Engineering (Pty) Ltd v JP McKelvey 1997 BIP 113*

24) In relation to Hurdle C, in casu, Vesper has raised two objections that have been held to be factors which a court may consider in the exercise of its discretion to refuse an amendment that is otherwise in order:

- a) the objection based on the failure to provide full reasons⁴ and
- b) the objections based on culpable delay and reprehensible conduct.⁵

25) With regards to the objections of culpable delay and reprehensible conduct it is crucial to appreciate that Vesper can only avail itself of these objections in certain very specific circumstances:

- a) As Timrite denies pre amendment invalidity, the first proviso, in casu, is that the court, in determining hurdle B finds that patent in its unamended form is invalid. This much is trite and not disputed by either party.
- b) There is, however, a second proviso: A court must also have found that, as stated in *Ausplow*, "...the patent in its amended form will be valid." In other words, the court must determine post amendment validity in favour of the applicant. The impact of this second proviso is that Vesper cannot avail itself of these objections for purposes of its hurdle B continuing invalidity arguments. The court must have dismissed the continuing invalidity objection on the basis that the proven existing validity (proviso 1) will be cured by the proposed amendments (proviso 2) before it will engage the subject matter of these hurdle C objections.

Hurdle B "Continuing invalidity"

26) As Timrite has raised a preliminary point in relation to the continuing invalidity objection and much of my reasoning in relation to hurdle B also applies to hurdle A, it is convenient to first deal with hurdle B.

27) This objection is raised in relation to the proposed amendments to claims 1 and 15. As previously indicated, the amendments sought directly address, at least

⁴ *Bateman Equipment Ltd v Wren Group (Pty) Ltd* 2000 1 SA 649 (SCA) para 13

⁵ Kgomo J, in *SHFL Entertainment Inc (Formerly Shuffle Master Inc) v TCS John Huxley (Pty) Ltd and Another* 2013 SIP 92 (CP) for instance, states at para 28 that: "The conduct of an applicant for an amendment that might militate against the grant of an amendment includes undue delay in the moving of the amendment, which delay prejudices or is potentially prejudicial to the [f] respondent; as well as mala fides in seeking the amendment."

some, of the grounds upon which Mr Keen's asserts, in his declaration application.

28) Vesper maintains that, for the reasons elucidated in Mr Keen's declaration affidavit, the claims, in their current form are invalid. It then proceeds to argue, per the reasons advanced in Mr Keen's amendment affidavit, that the proposed amendments will not cure the existing invalidity.

29) Timrite, argues that this court should grant the amendments sought, without entertaining the continuing invalidity objection. The argument, very broadly stated is that:

- a) Existing invalidity is not a bar to granting an amendment and, as such, it is irrelevant for purposes of the current proceedings.
- b) As amendment proceedings should be relatively simple, Van Dijkhorst's approach in *Deton*⁶ should be followed by deferring the continuing invalidity objections to declaration application, where existing invalidity has been pertinently raised.

The *Deton* arguments

30) Timrite contends that this court should grant the amendments and, essentially, 'postpone' the determination of the continuing invalidity objection to the pending declaration application as *"...(t)he recognised approach to amendment applications ought to be followed — the amendment application should be kept simple. The applicants must demonstrate compliance with sections 51(6) and (7), and continuing invalidity should remain where it belongs: in the declaration application."*⁷

31) In support of this "recognised approach" Timrite referenced the following excerpt of Van Dijkhorst J's *dicta* in *Deton*⁸:

"It is evident that the commissioner when deciding whether to grant or refuse an amendment will have regard to the efficacy of the amendment. Where an amendment would obviously serve no purpose as it would not prune the dead branch from the otherwise healthy tree it should not be granted. The

⁶ *Deton Engineering (Pty) Ltd and Another v 3 P McKelvey and Others* 1997 BIP 113 (CP)

⁷ Timrite's heads of argument para 41

⁸ *Deton Engineering (Pty) Ltd and Another v 3 P McKelvey and Others* 1997 BIP 113 (CP)

commissioner will not participate in an exercise in futility. But where the viability of the patent itself is the subject of debate in another forum it would prima facie be a folly to introduce it as an issue in the amendment proceedings when it is not specifically pertinent to the amendment itself but only generally It would tangentially multiply the issues. Amendment proceedings should be relatively simple.” [Underling as per Timrite’s heads of argument]

32) This excerpt is only part of Van Dijkhorst J’s reasoning and should be interpreted within context::

- a) The judgment starts by explaining that the continuing invalidity objections raised in the amendment application did not arise as a consequence of the proposed amendments.

“It is in fact an attack upon the remainder of the patent on the grounds of invalidity advanced in the application for revocation which is pending but not before me. There are other grounds of revocation too in that application which have not been introduced as defences in this application for amendment.”

- b) Even though a Respondent in amendment applications is entitled to raise grounds of invalidity outside the specifications of the amendments, Van Dijkhorst J opines that, if validity of the patent in general is already the subject of debate in another forum, it would “...*prima facie* be a folly to introduce it as an issue in the amendment proceedings when it is not specifically pertinent to the amendment itself but only generally It would tangentially multiply the issues.” [Underlining my own]
- c) It is in this sense that he then states that amendment applications “...*should be relatively simple.*” In other words, the commissioner should preferably only be tasked with deciding objections that relate to the amendments. To expand the scope of the determination to determining viability of the patent in general, would result in amendment proceedings becoming full scale revocation proceedings.
- d) He then warns that determinations of validity “...*wider than that part of the specification covered by the amendment...*”. may result in the pending revocation proceedings being usurped and being rendered irrelevant “...*(as*

on the basis of issue estoppel the parties would be found by the judgment on the amendment)”.

33) Van Dijkhorst J’s ‘commendable’ approach was therefore not that, as amendment applications should be relatively simple, and continuing invalidity objections are ‘complex’, such objections should not be determined by a court in amendment applications.

34) To my mind, the commendability of the approach lies in Dijkhorst J’s appreciation of the fact that the powers of a court in patent matters is no different from a court in any other civil matters⁹ As a result, he then proceeded to determine the matter with reference to ‘normal’ civil principles of law and procedure:

“I know of no rule of procedure which would deny a High Court the right to rule that an issue raised in two matters between the same parties be tried in that matter where it would be natural and more convenient to do so, provided the ruling would not deny the party a substantive (as opposed to procedural) right. In the present case the deferral of the adjudication on the grounds of revocation to the application for revocation affects the procedure but does not extinguish any substantive right the respondent may have. In any event in terms of section 51(9) any amendment may be dealt with by this court ‘as it thinks fit’.”

[Underlining my own]

35) Essentially, Van Dijkhorst J’s exercised his discretion (in refusing to consider the continuing invalidity objections) on the basis of the same considerations that would apply in any case where separation of issues is considered in terms of Rule 33(4), such as:

- a) Whether the issues in respect of which a separation is sought are discrete, or inextricably linked to the remaining issues; ¹⁰
- b) Whether it will facilitate the proper, convenient and expeditious disposal of litigation and what advantages and disadvantages might flow from such a separation.

⁹ In fact, it may be argued that given the provisions of S17(1) and S51(9) of the Act, a court in patent matters has broader powers than it would have in normal civil proceedings.

¹⁰ **Copperzone 108 (Pty) Ltd v Gold Port Estates (Pty) Ltd 2019 JDR 0587 (WCC) para 25**

- c) Whether it would be appropriate and fair to all the parties or whether there is a likelihood that such separation might cause the other party some prejudice.¹¹

36) The excerpt relied on by Timrite (*supra*) is the application of these principles within the context of patent amendment applications. It sets out two conditions that must be met before a court in patent amendment proceedings would consider exercising its discretion in this manner:

- a) First condition: The objections must relate to the validity of the patent in general and not the amendments specifically. In other words: are the determinations required for the validity objections discrete from the those required for the amendments sought?
 - i) As the continuing invalidity objections in *Deton* did not relate to the amendments sought specifically, a decision to allow such amendments, would not be finally determinative of any issue raised in the pending proceedings.
 - ii) Simply put, as is the case with any separation of issues in terms of R33(4), a court can only rule that issues should be decided separately if those issues are, in fact, separate issues. If not, that is the end of the enquiry. It is only in instances where the first condition precedent is satisfied, that second condition would become relevant.
- b) Second condition: The court in the amendment application can only decline to entertain an issue so separated, if there are pending proceedings where such an issue will be fully ventilated and finally disposed of.
 - i) If there are no pending proceedings to which the issue can be deferred, the refusal to consider such an issue would be tantamount to a dismissal thereof.
 - ii) If there are pending proceedings, the nature of such proceedings must allow for the final determination of issue as it has been raised before the court in the amendment application.

37) For the sake of convenience and structure, I have considered the arguments raised in *casu* with reference to these two conditions below.

¹¹ *Molotlegi v Mokwalase 2010 JDR 0360 (SCA)*

First condition: Are the issues discreet?

- 38) From a plain reading of how Vesper has framed its continuing invalidity objections, to my mind, it is clear that the validity challenges relate to the amendments specifically (claims 1 and 15) and not just the patent generally.
- 39) However, it seems that Timrite has furthered its argument, in relation to the preliminary point, on the basis of a general challenge. I note, for instance, in the replying affidavit, it is stated that: “*In this case the validity of the patent is already the subject of debate in the declaration application and is not specifically pertinent to the amendment application itself.*”¹² Vesper has not directly challenged this contention and has focused its argument on the second condition.
- 40) Though not pertinently stated, Timrite’s arguments in relation to the irrelevance of existing invalidity, seem to have been made within the general context of determining whether the issues are discreet and can be conveniently separated. Whether the argument is brought on the basis that the challenge does not relate to the amendments specifically or whether it is brought to substantiate same, as will be shown below, does not effect my analysis thereof.
- 41) Before delving into the specific line of reasoning employed, it is necessary to address the following statement contained in Timrite’s heads of argument:
“*Patent amendment proceedings are, however, intended to be kept simple. The Supreme Court of Appeal [in Bateman] has said [in paragraph 7] that if the barrier to obtaining a patent is low, and the patentee does not need to demonstrate validity to either obtain a patent or sue for infringement, amendment proceedings should unfold on a similar basis.*”¹³ [insertions my own]¹⁴
- 42) The *dicta* in *Bateman* needs to be understood within context:
- a) In deciding an objection based on lack of full reasons, the SCA found, in paragraph 5, that there is no duty on an applicant, in formulating the reasons, to “*...identify that which he accepts forms part of the prior art and which necessitates the amendment, because without the identification of the*

¹² Replying affidavit: Mr Mukondeleli para 4.2

¹³ First and Second Applicant’s heads of argument, para 25 (Case Lines 07-13)

¹⁴ In the heads of argument, the footnote to the submission is *Bateman Equipment Ltd v Wren Group (Pty) Ltd* 2000 1 SA 649 (SCA) para 7. The insertions incorporate for ease of reference this authority.

prior art potential objectors will not know whether the patentee has achieved the object of the amendment” and, in paragraph 6, that “(w)hether the patentee has failed in achieving its object is for the objector to establish.”

b) It is within this context that the SCA then in paragraph 7 states:

“[7] The nature and object of amendment proceedings must be seen in the context of our patent system as a whole. Ours is a non examining country and an alleged inventor is entitled to a patent for his supposed invention without having to satisfy anyone of its merit or validity. He does not have to give any reasons for his choice of wording. Should he sue for infringement, he has no duty to assist the alleged infringer in establishing whether his monopoly is valid or not. Why should he be saddled with a burden if he wishes to reduce the scope of his protection in an attempt to render the patent valid, while in obtaining or enforcing a monopoly he bears no similar burden?”

c) The dicta therefore relates to the nature and sufficiency of the reasons to be provided in an application to amend. At best for Timrite, the dicta can be extrapolated to, within the context of determining a continuing invalidity objection, mean that the onus is on the objector to prove existing invalidity. It is not authority for Timrite’s, ‘irrelevancy of invalidity’ argument.

43) The argument seems to be an attempt to, by way of syllogistic reasoning, extrapolate from the principle that pre-amendment validity is generally not a barrier to amendment, authority for the submission that this Court may grant the amendments without making any determination in respect of the continuing invalidity objection first. However, as is usually the case with syllogisms, argument relies on a series of sequential logical fallacies or legal errors to reach this conclusion.

44) For the sake of brevity, I will repeat Timrite’s arguments (paraphrased for clarity) as they were developed in its heads of argument in italics and, where appropriate comment on the logical fallacy, as the case may be, applicable to that stage of the development of the argument:

a) *Existing invalidity is not a barrier to an amendment. Therefore, even if Vesper’s contention that the patent in its unamended form is invalid was correct, it would not be a barrier to amendment... Existing invalidity would only*

be a barrier to amendment if, for instance, the objector proves that the patentee has with knowledge of the invalidity, sought to enforce the patent.

This statement is legally unsound. It elevates a principle of general application to that of an absolute rule, by removing ignoring the context within which the challenge to existing invalidity is to be considered.

In casu, it would be a barrier if the amendments sought do not cure the invalidity.

- b) *Existing invalidity would only be a barrier to amendment if, for instance, the objector proves that the patentee has with knowledge of the invalidity, sought to enforce the patent.*

Apart from the obvious contradiction to the first sentence supra, this submission would be correct if the invalidity was cured by the proposed amendments.

However, within the context of the present challenge to the post amendment validity, this statement in fact contradicts Timrite's contention that existing invalidity is not a barrier to amendment:

Timrite accepts that:

(Existing invalidity) + (Undue delay) = Barrier

but also seeks to persuade this Court that existing invalidity is not a barrier to amendment, despite the fact that Vesper's continuing invalidity objection is literally that:

(Existing invalidity) + (amendments fail to cure) = Barrier

- c) *In casu, Vesper's allegation that Timrite sought to enforce an allegedly invalid patent, does not make pre amendment validity relevant to this application. The objection of continuing invalidity depends on knowledge of invalidity. At a minimum Vesper would have to show that Timrite unreasonably shut their eyes to the truth, namely that the patent was invalid.*

- The implication is that if Vesper proves Timrite unreasonably shut their eyes to the truth, this court should hear the continuing invalidity objection (as existing invalidity would then be relevant to the current proceedings). In other words, the continuing invalidity objection (hurdle B) should only be determined if Vesper succeeds with its hurdle C objections, which it can only rely on after hurdle B is determined... The broader implication hereof is that a court may have regard to factors that would influence the exercise of its discretion to refuse an amendment that is otherwise in order (hurdle C) at a stage when the prerequisites for the exercise of such a discretion have not yet been met.

- The patently incorrect submission that the “objection of continuing invalidity depends on knowledge of invalidity “ illustrates just how far off the garden path these errors and logical fallacies have caused Timrite to stray.

45) Accordingly, the irrelevance of existing invalidity argument does not support the contention that the issues are discreet and can therefore be conveniently decided in the pending forum.

46) However, previously noted, Vesper did not directly challenge Vesper’s statement regarding the generality of the validity challenge and the arguments presented by both parties centred around the second condition precedent (the nature of the pending proceedings).

47) As such, in fairness to the parties and, in the event that I am incorrect in either my interpretation of the conditions precedent or the specificity of Vesper’s invalidity challenge, I will also consider the preliminary issue on the basis of the dispute as framed by the parties.

Second condition: Are there pending proceedings?

48) According to Timrite, a refusal to consider the continuing invalidity argument at this stage, would not prejudice Vesper. It argues that the validity of the patent pre amendment will be tested in the declaration application. As to post amendment validity, as patents are presumed to be valid and can be enforced without proving validity, any challenges to the validity of the patent in its post amendment form, can be raised by Vesper (or any other party) as and when Vesper decides to enforce the (amended) patent. During argument, it was confirmed that Timrite intends to bring a counter application for infringement in response to the declaration application. In that counter application it will rely on the amended claims and it is at that stage, that Vesper would then be able to attack the validity of the patent in its amended form.

49) Vesper argues that the future proceedings in casu, unlike, for instance, applications for revocation, are not proceedings where the patent in its amended form will be challenged.

a) The declaration application only relates to declaring non infringement of the patent in its current, unamended, form. Regardless of Timrite’s intentions to, in future, launch infringement proceedings based on the amended patent, the

fact remains that the present application for amendment is currently the only proceeding where the validity of the patent post amendment has been challenged.

- b) As such, there are no pending proceedings that will be determinative of the requirements for a valid objection of continuing invalidity: namely, whether Timrite's patent in its current form is invalid and, if so, whether the proposed amendments cure the invalidity or not.

50) To my mind, Vesper's argument in relation to the nature of the pending proceedings implicitly raise a further consideration that militates against granting the amendments and 'postponing' the issue of continuing invalidity. As submitted by Vesper, its objections based on culpable delay and reprehensible conduct relate to validity of the patent in its current (unamended) form and the delay and conduct of Timrite vis a vis seeking an amendment of the current form. Once the amendments are granted, any future infringement proceedings or challenges to Timrite's enforcement of the patent, will be based on the patent in its amended form. It would not be open to that future forum to retrospectively consider whether these objections were validly raised.

51) That these objections should be decided at the time of the amendment application, is for instance evidenced from the remainder of judgment in *Deton*. Van Dijkhorst J, 'postponed' the continuing invalidity objections (which were not raised in relation to any of the amendments sought) to the revocation proceedings and then called for oral evidence and subsequently proceeded to decide the objection of culpable delay raised by the Respondent in relation to specific amendments sought by the Applicant to cure potential invalidity as a result of prior art.

52). I am accordingly in agreement with Vesper's contention that there are no pending proceedings where the issues of continuing invalidity, as well as culpable delay and reprehensible conduct will be determined

53) I pause here to note that the issues identified supra, illustrate, in general, the problematic nature of separating issues that are not in fact separate issues. They also support a finding that the validity objections raised herein are not general, but relate to the amendments specifically...

Finding iro Hurdle B objection

54) In any event, regardless of which interpretation of the conditions precedent was followed or whether or not the challenge was general or amendment specific, the conclusion remains the same: Vesper's contention that the continuing invalidity objections cannot and/or should not be decided separately from the application to amend, is correct.

55) I however disagree with the parties' commonly held contention that once this preliminary point in relation to B has been decided, this court must proceed to determine whether the amendments sought should be granted. The parties have typecast Van Dijkhorst J's reasoning as being solely applicable within the sphere of continuing validity objections. I do not agree

Hurdle A: "Lack of fair basis"

56) The commentary on *Deton* in *Burrell's South African Patent and Design Law*¹⁵ encapsulates the essence of Van Dijkhorst J's reasoning

"The line of reasoning adopted by Van Dijkhorst J and as set out above will, hopefully, lead to a more sensible practice being in the future adopted: a practice in which in cases where an application to amend the specification of a patent and an application for the revocation of the patent are both pending, the Commissioner will be inclined to rule that if there is a large overlap between the two applications, they should be heard together rather than separately as has heretofore been the practice," [Underlining my own]

57) Van Dijkhorst J's reasoning was based on the sensibility and practicality of deciding overlapping issues simultaneously. The fact that in *Deton* the reasoning related to only the overlap of issues pertaining to continuing invalidity, does not mean that the reasoning applies exclusively to issues of validity. In *Deton*, Van Dijkhorst J was not called upon to determine an unfair basis objection. His reasoning makes it pertinently clear that it applies to similar issues raised in separate proceedings and that, in the matter before him the similar issues happened to relate to continuing invalidity:

¹⁵ *Burrell's South African Patent and Design Law, 3rd Edition, p 437*

“I know of no rule of procedure which would deny a High Court the right to rule that an issue raised in two matters between the same parties be tried in that matter where it would be natural and more convenient to do so, provided the ruling would not deny the party a substantive (as opposed to procedural) right. In the present case, the deferral of the adjudication on the grounds of revocation to the application for revocation affects the procedure but does not extinguish any substantive right the respondent may have.” [underlining my own]

58)As indicated previously, at the commencement of the hearing, I had referred counsel to *Antel*¹⁶, where Fourie J declined to decide either objection raised (and consequently postponed the application altogether). His reasoning therein also lends credence to the aforementioned interpretation of Van Dikhorst J’s reasoning as relating to separation of issues and not specifically only separation of continuing invalidity issues:

A comparison between the application for revocation and the application to amend will reveal that there is a large overlap between the two applications. In both applications issues such as the invention claimed and the proposed amendment are not fairly based on the matter disclosed in the specification and that the prescribed declaration in respect of the patent contains a false statement, have been raised. Furthermore, there appears to be a nexus between the last ground relied upon (invention not new) in the application for revocation and the defence of continuing invalidity as raised in the application to amend. It may well be that these issues are not only overlapping, but that they are also intertwined to such an extent that they should not be dealt with separately.¹⁷ [Underlining my own]

59)The overlap in relation to hurdle A in casu is obvious:

- a) Vesper has indicated that “...one of Vesper’s primary arguments in the declaration application is that the Vesper bag does not include a strap

¹⁶ *Antel and Another v Virtual Consulting Engineers (Pty) Limited and Others* (63720/12) [2014] ZAGPPHC 476 (27 February 2014)

¹⁷ *Antel and Another v Virtual Consulting Engineers (Pty) Limited and Others* (63720/12) [2014] ZAGPPHC 476 (27 February 2014) at para 6

because the "dividing panel" in the Vesper bag is of the same length and width (i.e. not narrower) than the bag itself;"

b) By way of comparison, Vesper's lack of fair basis objections are directed at amendments which, *prima facie*, would, if granted, effectively neutralise this primary argument in the declaration application. For instance:

i) Proposed new claims 16, 18 and 21 seek to introduce a new feature into the claims of the patent, namely that *"the or each strap" 'comprising a reinforcing web constituted by a layer of fabric'*. Vesper argues that the patent prior to amendment did not disclose, or teach, that the "strap" could be a reinforcing web constituted by a layer of fabric.

ii) Proposed new claim 19 includes the (similar) limitation that the *"first yield control element"* comprises *'a reinforcing web constituted by a layer of woven polypropylene fabric'*. Vesper argues that:

"For the reasons already explained the first yield control element cannot be both a strap and a layer of woven polypropylene fabric because they are different things. A strap is, by definition, narrower than the width of the sheet material of the bag, while there is no such limitation in respect of the reinforcing web that is constituted by a "less open" layer of woven polypropylene fabric."

and that:

"There is thus no disclosure in the patent, in its current form, of a strap which is also a reinforcing web constituted by a layer of woven polypropylene fabric. The new feature of claim 19 is not therefore fairly based on the teaching of the specification prior to amendment."

60) Van Dijkhorst J's warning in *Deton* applies with equal force to determinations to hurdle A determinations: A court in an amendment application should be mindful of the fact that its determinations could effectively, through issue in estoppel, result in the pending declaration application proceedings being usurped and being rendered irrelevant. During the hearing counsel for both parties all but admitted that if I find that there is fair basis for the amendments sought, it would effectively dispose of Vesper's current grounds for alleging non infringement in the declaration application.

61) Ironically therefore, Timrite's submission in support of postponing the continuing invalidity objection supra, is more appropriate within the current context: The determination of the unfair basis objection "*...should remain where it belongs: in the declaration application.* "

FINDING

62) Given the aforementioned, the position is as follows:

- a) *The amendments sought cannot be granted without a determination of the continuing invalidity objection.*
- b) *The continuing invalidity objection must therefore be determined simultaneously with the lack of fair basis objection.*
- c) *However, findings made in the amendment application in relation to the lack of fair basis objection will be determinative of the noninfringement grounds, which have been pertinently raised in the declaration application.*

63) As already indicated, this court has the discretion to deal with the application for amendment as it deems fit and its discretion in relation to the procedural aspects of the application (as opposed to substantive aspects such as the discretion to refuse to grant the amendments) is limited only to the extent that it must be exercised judicially.

64) In casu, I have, inter alia, considered the following factors in exercising my discretion:

- a) If the amendment application is decided prior to the declaration application, there is a real risk that those proceedings will be rendered irrelevant.
- b) A postponement of the application in toto would not have any effect on Timrite's substantive right to apply for and be granted an amendment. I also cannot fathom any effect it would have on Vesper's rights as they would be in the exact position they were in prior to the amendment application – i.e they have applied for a declaration of non infringement.
- c) Timrite's reasons advanced for the amendments, as well as Vesper's objections to such amendments, both have their genesis in Mr Keen's evidence contained in his declaration affidavit. That affidavit however also deals with evidence not addressed in the amendment application. Would it be appropriate to consider the amendments without considering Mr Keen's

evidence as a whole? Whilst Timrite has dealt with some of the allegations raised in Mr Keen's declaration affidavit in its founding affidavit herein, the fact remains that it has not filed an answering affidavit dealing with the totality of Mr Keen's submissions in the declaration affidavit.

- d) Not only would it be more natural and convenient for the overlapping issues in general to be determined simultaneously with the declaring application, but, in postponing the application in toto, the (very valid) problems raised by Vesper in relation to separating the determination of continuing invalidity from the amendment application, would also no longer arise.

65)I accordingly make the following order:

ORDER

1. The application to amend the complete specification of South Africa patent of addition no. 2010/06044 entitled 'Yielding Mine Support' ("the application to amend") is postponed.
2. The application to amend may be set down for determination simultaneously with the application for declaration of non infringement brought under case no 2023-063620, subject to the discretion of the court in that application.
3. Alternatively to (2), in the event that the application to amend is not determined simultaneously with the application in case no 2023-063620, the application to amend shall not be set down before a final determination has been made in the application brought under case no 2023-063620.
4. The costs of the application to amend as well as any wasted costs occasioned by the present hearing, are reserved.
5. If the application is withdrawn or, if applicable, the Applicants fails to within 30 days of the final determination referred to in (3) apply to set the application down for hearing, the Respondents may set the application down for the determination of the costs reserved per (4).

Postscript

The parties are owed an apology for the delay in the handing down of the judgment. The judgment, as set out above, was, according to my records, finalised in the first week of December 2024. It was only when, at the end of May 2025, I attempted to

find the Saflii reference for the judgment that it became clear that I had noted the judgment as “finalised” despite not forwarding same to the registrar for distribution. The already inexcusable delay is therefore also inexplicable. I can only express my utmost regret for the oversight in the hopes that my apology will be accepted by the parties



K STRYDOM

**ACTING JUDGE OF THE HIGH
COURT, GAUTENG DIVISION,
PRETORIA**

Date reserved: 24 October 2024

Date handed down: 11 June 2025

APPEARANCES:

FOR THE APPLICANTS:

ADV P GINSBURG SC, instructed by ADAMS & ADAMS

FOR THE FIRST RESPONDENT:

ADV GAVIN MARRIOTT, instructed by SPOOR & FISHER