

167/93

CASE NO. 481/91
J VD M

IN THE SUPREME COURT OF SOUTH AFRICA

(APPELLATE DIVISION)

In the matter between:

WATER RENOVATION (PTY) LTD

APPELLANT

and

GOLD FIELDS OF SA LTD

RESPONDENT

CORAM: BOTHA, E M GROSSKOPF, MILNE, JJA et
NICHOLAS, HARMS, AJJA

HEARD: 25 FEBRUARY 1993

DELIVERED: 12 NOVEMBER 1993

J U D G M E N T

HARMS, AJA:

The appellant, Water Renovation (Pty) Ltd
("the patentee"), is a company involved in the treatment

of industrial effluent. It does basic research and development work and also sells industrial filtration plants. Its managing director and sole shareholder is Mr R G Batson, a civil engineer. Batson invented a method and means to separate solids from a liquid in which they are suspended and the patentee, as assignee of the invention, filed an application for an invention entitled Separation of a Suspension into its Component Parts on 4 November 1986. The application was accompanied by a provisional specification (number 86/8409). As is customary, the provisional specification contained no claims but a description of the invention and a drawing.

The purification of mine water containing suspended solids is a major problem in the mining industry. The research organisation of the Chamber of Mines ("Comro") has a water treatment division and it maintains a facility for the testing of

water treatment devices and for research and development into mine water treatment processes at the ERPM gold mine at Boksburg. Its manager at the time was Mr W Pulles, a scientist. Pulles was aware of the fact that Batson had published an article stating that he had invented a purification system useful to the mining industry and that the patentee was inviting inquiries from interested parties. Already during November 1986, he approached Batson and informed him of Comro's interest. The outcome was a loose arrangement whereby the patentee agreed to build two substantially identical pilot plants, one to be operated and tested by Comro at ERPM and the other by the patentee at its premises. That was done and certain development work followed. The results of the Comro tests were published when Pulles delivered a paper called Suspended Solids Removal from Mine Waters using Floating Media Separation and Crossflow Microfiltration ("the Pulles paper") on 13

November 1987 at a seminar organised by Compro.

The patentee filed its complete specification (number 88/0772) on 2 February 1988. In terms of section 31(1)(a) of the Patents Act 57 of 1978 it claimed the date of the provisional specification, 4 November 1986, as its earliest (and only) priority date. (The relevance of the priority date is, in the context of this case, that the novelty or inventiveness of a claimed invention is assessed as on the day immediately before that date: section 25(5) and (10) of the Act). A patent was granted in the form applied for and it was sealed on 28 June 1989.

The respondent, Gold Fields of SA Ltd, wished to utilise aspects of the invention as claimed. It could not reach an agreement with the patentee and on 27 October 1989 launched an application for the revocation of the patent. Its case, in essence, was the following:

- (i) The development work at ERPM during the period between the filing of the provisional and complete specifications resulted in a new apparatus ("the new configuration").
- (ii) This configuration is the subject of claims 21 to 25.
- (iii) It did not form part of the disclosure contained in the provisional specification.
- (iv) It became part of the state of the art when it was disclosed in the Pulles paper.
- (v) In any event, Batson and Pulles were the co-inventors of the new configuration.

Therefore, the respondent alleged that the invention claimed in these claims lacked novelty; that the patentee was not a person entitled to apply for the patent; that the claims were not fairly based on the

matter disclosed in the provisional specification; and that the prescribed declaration contained false representations (namely that Batson was the sole inventor of the new configuration and that to the belief and knowledge of the patentee there were no lawful grounds for revocation).

In answer to the application for revocation the patentee filed a counterstatement (which is in the nature of a plea). It admitted that claims 21 to 25 were not fairly based on the matter disclosed in the provisional specification and that these claims were only entitled to the priority date of the later complete specification. It denied however that the Pulles paper had formed part of the state of the art before the date of the complete specification, that Pulles was a co-inventor of the new configuration and that any misrepresentations had been made.

An application in terms of section 51(9) of

the Act for the amendment of the patent was filed concurrently. The essence of the proposed amendment was to remove from the body of the specification any reference to the experiments conducted at ERPM and to introduce a limitation in the nature of a disclaimer into claim 21 (and consequently into its dependent claims 22 to 25). The limitation will be referred to as "insert A". The revocation proceedings were stayed pending the final determination of the amendment application. Factual disputes arose from the affidavits and a number of issues were referred for oral evidence by MacArthur J, sitting as Commissioner of Patents. Plewman J, in the same capacity, heard the matter and dismissed the application for amendment. He granted the patentee leave to appeal to this Court. Hence the present appeal.

An application for the amendment of a patent is usually based on the ground that the patent in its

unamended form is, or may be, invalid. The grant of an amendment is a discretionary matter and is dependent, among other things, upon whether the application complies with the provisions of section 51 of the Act, whether it can attain its object (for example, remove the alleged invalidity), and whether the patent after amendment would be otherwise valid. See, in general, Willows Francis Pharmaceutical Products Ltd v Aktiebolaget Astra Apotekarnes Kemista Fabriker 1960 (3) SA 726 (A) 738C-H; De Beers Industrial Diamond Division (Pty) Ltd v General Electric Company 1988 (4) SA 886 (A) 896E-I.

In regard to the onus of proof it was argued on behalf of the patentee that the objector to the grant of an amendment is burdened with the onus in respect of all the issues which may arise in the application, while respondent's counsel argued to the contrary. It may well be, however, that in relation to some of the issues

the onus rests on the applicant for amendment, while in relation to others it rests on the objector. For instance, where the objection to an amendment is based on the ground of continuing invalidity of the patent, it would seem that the onus lies with the objector (see the De Beers Industrial Diamond Division case supra at 901 A-D); but, on the other hand, where the issue is whether there has been due compliance with the statutory requirements for the application (e g as to the furnishing of "full reasons" for the amendment) and a factual dispute arises in that connection, it is arguable that the patentee bears the onus (cf Interfelt Products (Pty) Ltd v Feltex Ltd 1972 (3) SA 335 (T) 343A-B; and cf Smith Kline & French Laboratories Ltd v Evans Medical Ltd [1989] FSR 561 569; Hsiung's Patent [1992] RPC 497 (CA) 523 lines 1-4). There is yet a further possible category of facts namely those that relate to the exercise of the court's discretion, such

as undue delay. The Interfelt Product case held that the objector bears the onus in that situation. It is not necessary, however, to pursue this enquiry, for in the present case the issues can be resolved without resort to the incidence of the onus, as will appear below.

In this case the patentee applied for amendments in order to reduce the ambit of the issues in the revocation proceedings. In particular, it wished to remove from contention the Pulles paper so that it could no longer be relied upon to destroy the novelty of claims 21 to 25. In accordance with the provisions of section 25(5) of the Act these claims could have been anticipated by the Pulles paper only if -

- (a) the priority date of the claims was the date of the complete specification;
- (b) the Pulles paper became part of the state of

the art before that date; and

- (c) the paper disclosed the invention in its essential integers as claimed in those claims.

In its affidavits the patentee admitted (a), denied (b), and did not deal with (c). It applied for the introduction of insert A "to ensure that [these claims are] distinguished over the disclosure of the Pulles paper despite my [Batson's] believing that the Pulles paper did not form part of the state of the art before the priority date of [these claims]". In this regard the respondent's contention that insert A "does not in substance distinguish over the disclosure" contained in the Pulles paper. The patentee did not place this contention in issue. In relation to anticipation, MacArthur J referred only issue (b) above to oral evidence.

At the hearing before Plewman J counsel for the patentee stated in opening that, although there was an admission in the affidavits concerning (a) above, the patentee was not bound by it and that he (counsel) would present a contrary argument on the point. In the course of the evidence counsel admitted (b). During argument in the court a quo and in this Court items (a) and (c) were placed in issue on the basis that they related to legal contentions in respect of which a party is not bound by admissions made in its affidavits. Plewman J found that the issues had been fully canvassed and that the respondent was consequently not prejudiced by the patentee's change of heart. (Counsel for the respondent did not challenge this finding during the appeal.) Plewman J held further that the claims in question were not fairly based on the matter disclosed in the provisional specification, and found consequently that the patentee's admission relating to the priority

date of the claims had been made correctly. On that basis it was not necessary for him to decide whether the patentee was bound by the admission and he expressed no opinion in that regard.

For the purpose of deciding the appeal it is again not necessary to decide whether the patentee is bound by its admission, but the view I take of this aspect of the matter differs from that of the court a quo. It can be stated briefly, as follows. The express object of the application for amendment was to remove a ground for revocation; its object was not to litigate the validity of the unamended specification. Consequently, in order to assess whether the introduction of insert A can achieve the object of distinguishing claims 21 to 25 from the Pulles paper, it is proper to assume the matters stated in (a), (b) and (c) above. In other words, for the purposes of the exercise it does not matter whether (a), (b) and (c)

have been established whether by way of admission or otherwise. If it is found that insert A cannot achieve the intended object, the amendment will serve no purpose and ought for that reason not to be granted. On the other hand, if insert A does serve to distinguish the claims from the Pulles paper, the amended claims will be novel in relation to the Pulles paper, irrespective of whether (a), (b) and (c) are established.

The court a quo refused the amendment on the grounds inter alia that insert A does not distinguish the claims in question from the Pulles paper and that the amendment sought was in any event in the nature of a stratagem, which justified the court in declining to exercise its discretion in favour of the patentee.

In order to understand the nature of the proposed amendments and their effect, regard must first be had to the description of the invention. The invention as described in both the provisional and the

complete specifications has three aspects namely (i) a method of, and (ii) a separating apparatus for, separating solids ("particulate material") from the unfiltered ("carrier") liquid in which they are suspended, as well as (iii) a feed means for feeding the suspension into the separating apparatus. This trichotomy is also reflected in the claims : claims 1 to 6 are method claims; 7 to 16 claim a separating apparatus and 17 to 25 the feed means. So, too, the three omnibus claims : 26 deals with the method, 27 with the separating apparatus and 28 with the feed means. The three aspects are nevertheless closely interrelated. The description of, and claims relating to, aspect (ii) always incorporate aspect (iii). And the method, aspect (i), employs aspects (ii) and (iii).

In order to explain the invention as set out in the provisional specification I intend using the apparatus as described and illustrated in its figure 1.

I am conscious of the fact that figure 1 represents a preferred embodiment only but, for present purposes, it is of no consequence. The separating apparatus (aspect (ii)) has two basic elements namely a vessel and a feed means (aspect (iii)). The vessel consists of a vertical cylindrical body. It is divided operationally, but not mechanically, into three zones. The upper zone collects the clarified liquid. The lower zone gathers the separated solids. The intermediate zone is called the feed zone. It is the function of aspect (iii) to feed the suspension into the feed zone.

The feed means, once again according to figure 1, consists of a cylinder of a diameter smaller than that of the vessel. This cylinder is located within the intermediate feed zone of the vessel. Its upper end is open and its tapered lower end has an opening for the discharge of solids. In use, the

untreated liquid is fed into this cylinder. It is there that the separation takes place with the assistance of flocculants. Agglomerated particles are carried out of the cylinder and settle down in the lower zone of the vessel. The purified liquid is withdrawn from its upper zone.

The complete specification contains the same drawing, figure 1, and a similar description of this embodiment and aspect (iii) thereof is claimed in (at least) claims 17 and 18. It is not in issue that these claims (among others) are fairly based upon the provisional specification and are therefore entitled to its priority date. They are accordingly unaffected by the Pulles paper.

The complete specification in addition contains a detailed exposition of the new configuration and calls it "a second embodiment" of aspect (iii). It describes the tests that were conducted at ERPM and uses

parts quoted verbatim from the Pulles paper for this purpose. In this embodiment the feed means has a second cylindrical member located at least in part within the first cylinder of the feed means. The discharge outlet of the feed conduit is within the second cylindrical member. The specification describes, by way of example, two feed conduits: the one is co-axial with the second cylindrical member and the other extends radially inwardly through the side walls of the vessel and the two cylinders. This second embodiment of aspect (iii) is then claimed in claims 21 to 25. As stated, the respondent alleged (and the patentee initially admitted), that this embodiment is not fairly based upon the provisional specification and accordingly that these claims are only entitled to the priority date of the complete specification.

It suffices for purposes of this judgment to quote claim 21 only. For ease of reference it is

reproduced in its present and proposed amended form.

The words underlined represent insert A and the words within brackets are to be deleted.

"21. Feed means according to Claim 18, which includes a second cylindrical member located at least partially within the other or first cylindrical member, the feed conduit having a discharge outlet including an end portion extending co-axially with and opening within the second cylindrical member, [with the conduit discharge outlet being located in the second cylindrical member,] the secondary cylindrical member having a smaller cross-sectional area than the first cylindrical member and providing a primary region with the sub-zone, with the remainder of the first cylindrical member constituting a secondary region with the sub-zone."

Insert A is the most important aspect of the amendment applied for, but before I deal with it, it will be convenient first to dispose of another feature of the application. As mentioned earlier, an amendment

is sought to the body of the specification by the deletion of the description of the tests conducted at ERPM. In his affidavit, Batson stated that these tests were conducted by Pulles and his co-workers on an apparatus invented by himself (Batson). He proceeded to say that the full reason for the amendment is that whereas he regards himself as the sole inventor, he wishes to delete all reference to the tests conducted by Pulles, presumably to remove doubt as to Pulles's co-inventorship. Pulles, in his answering affidavit, pointed out that some of the passages to be deleted were taken from his paper and suggested that Batson probably plagiarized his paper. In reply, Batson denied the second statement and stated that since the testing was done on his invention, he was entitled to refer to the test results.

The facts as they unfolded during evidence have a different flavour. During preparation of the

complete specification Batson handed a copy of the Pulles paper to his patent attorney for inclusion in it. Batson was advised to obtain Comro's consent thereto. He considered the possibility that the consent could be refused and decided, without obtaining any further advice, to proceed without it. Passages were clearly plagiarized. Plewman J refused to allow this part of the amendment on the grounds that the Pulles paper anticipated the contentious claims prior to the amendment and that an elimination of all references to the Pulles paper and the ERPM pilot plant test could not change that fact.

The patentee is in truth embarrassed by the inclusion of these passages. The embarrassment was caused by its own doing. Batson received sound legal advice and he chose to ignore it. The inclusion was intentional with knowledge of a risk involved. The deletion will not remove the embarrassment because,

insofar as the passages could be used as evidence of Pulles's co-inventorship, they can still so be used. Co-inventorship is a matter of fact and any admission by a patentee, even in a specification prior to amendment, may be admissible evidence. It is not the patentee's case that this amendment is required to validate the patent. There was, consequently, good ground for a refusal of this part of the application in the exercise of the court's discretion. Compare Union Carbide (Bailey & O'Conner's Application) [1971] RPC 854. Also this Court cannot interfere with the exercise of a discretion except on certain well-known limited grounds. See e g Holtite Ltd v Jost (Great Britain) Ltd [1974] RPC 81; Ex Parte Neethling and Others 1951 (4) SA 331 (A) 335 D-E. It was not argued that any such ground was present in this case.

Turning then to the amendment relating to insert A, it will be immediately apparent from a reading

of claim 21 that the unamended claim covers a feed conduit of any configuration and that it is immaterial whether the conduit extends radially inwardly through the side wall (as shown in the Pulles paper) or whether it is co-axial with the second cylindrical member (as shown in figure 4 of the complete specification) or whether it extends through the side wall and then takes a turn at right angles in a vertical direction (as is shown in figure 1 in relation to the first embodiment). The stated object of insert A is to limit the claim to the figure 4 configuration.

It was argued on behalf of the patentee that if this amendment were allowed, insert A would be an essential integer of the amended claims and that since it is not to be found in the Pulles paper, the latter cannot anticipate. The respondent's undisputed contention that insert A does not in substance distinguish over the Pulles disclosure is, according to

the argument, beside the point because a patentee is entitled to make by the words used an integer essential even if it is from a practical point of view inessential. If the chosen integer is not to be found in the cited document, so the submission proceeded, there can be no anticipation in the same way as an alleged infringer cannot escape liability by replacing or substituting that integer.

Whether insert A would be an essential integer, depends on the interpretation of the complete specification in its proposed amended form. Compare Gentiruco AG v Firestone SA (Pty) Ltd 1972 (1) SA 589 (A) 646 C-D. And, as counsel stressed, a specification has one meaning only, irrespective of whether the issue is invalidity or infringement. Compare Veasey v Denver Rock Drill and Machinery Co Ltd 1930 AD 243 at 280. Also, in construing the specification, no regard should be had to what the infringer has done (Selero (Pty) Ltd

and Another v Chauvier and Another 1984 (1) SA 128 (A) 137 F-G), and, more appositely in this case, to what the prior art described, save to define and delimit the areas of dispute.

In Stauffer Chemical Co & Another v Safsan Marketing and Distribution Co (Pty) Ltd & Another 1987 (3) SA 331 (A) 346I-347D, Corbett JA said the following:

"To ascertain what are and what are not the essential features or integers of a claimed invention the specification must be read and interpreted purposively or realistically, with the understanding of persons with practical knowledge and experience of the kind of work in which the invention was intended to be used and in the light of what was generally known by such persons at the date of the patent (see the Frank and Hirsch case supra at 762-3; the Marconi case supra at 217-18; the Catnic case supra at 243), which date by our law is the priority date of the claim (see Burrell (op cit para 5.23 at 246)). Obviously, the fact that a claim incorporates a particular feature

does not alone suffice to make that feature an essential one. Otherwise the problem would not arise. In general, if the feature is in fact essential to the working of the claimed invention, then it must be regarded as an essential feature. On the other hand, a patentee may indicate in his specification, either expressly or by implication, that he regards a particular integer as essential; and in that event it must be treated as essential and it matters not that it may not be essential to the working of the invention. Where, however, a feature is not essential to the working of the invention and the patentee has not indicated that he regards it as an essential integer, then in general it may be treated as unessential and an alleged infringer may be held to have infringed the claim notwithstanding that his product or process does not incorporate that feature or substitutes an equivalent for it (see the Van der Lely case supra at 76 lines 29-30; Catnic case supra at 226-7, 228 per Buckley LJ in CA and at 243 per Lord Diplock in HL)."

(The authorities referred to are Frank and Hirsch (Pty)

Ltd v Rodi & Wienenberger Aktiengesellschaft 1960 (3) SA

747 (A); Marconi v British Radio Telegraph and Telephone Co Ltd [1911] 28 RPC 181; Catnic Components Ltd & Another v Hill & Smith Ltd [1982] RPC 183; Burrell SA Patent Law and Practice 2nd ed; C Van der Lely v Bamfords Ltd [1963] RPC 61.) See also Bodenheimer and Beton Infringement by Equivalents in the United States and Europe : A Comparative Analysis [1993] 3 European Intellectual Property Review 83.

It follows from this that the mere presence of insert A in these claims is not conclusive of whether it is essential to the invention there claimed. The conduit may be a necessary integer, but that does not mean that its configuration is "essential to the invention" (per Schreiner JA in the Frank & Hirsch case supra at 763 A). It is not in dispute that the configuration of the conduit was at the date of the complete specification, to the knowledge of the addressee, in no way essential to the invention.

The next leg of the inquiry is whether the patentee, expressly or impliedly, elevated insert A to an essential integer. Whether the skilled addressee, reading the specification in its proposed amended form, in order to determine whether insert A is an essential integer, could have regard to the fact that the integer was the result of an amendment, was not argued. It would seem as a matter of principle that the document in its amended form should speak for itself and that its history would be inadmissible extrinsic evidence. Compare the Stauffer case supra at 346 F-G. So, too, the fact that the reason for the integer is to attempt to distinguish alleged prior art. It must also be borne in mind that "(w)hat the patentee intended to claim is immaterial" (per Van der Heever JA in Power Steel Construction Co (Pty) Ltd v African Batignolles Constructions (Pty) Ltd 1955 (4) 214 (A) 225E).

If regard is had to the specification as a

whole, it is apparent that the feed conduit performs one function and that is to transport the untreated liquid to the inner cylindrical member of aspect (iii). The discharge outlet is simply the end of the pipe. Since the apparatus has no moving parts, it does not matter what route the conduit follows. The drawings show three configurations : that of figure 1 has already been mentioned, namely a horizontal pipe through the walls of the cylinders and then bending vertically; the conduit of figure 4 is the co-axial one of insert A; and figures 6, 7 and 8 show "a feed conduit 112 extending radially inwardly through the wall of the vessel". The specification does not attach any significance to these configurations and treats them all as equivalents. There is no indication that in the context of the new configuration as claimed in claims 21 to 25 the positioning of the conduit has any importance or that the patentee believed that it did. I am therefore of

the view that there is not a sufficiently clear indication in the specification that insert A is an essential integer. That being so it must follow that it cannot serve to distinguish these claims from the Pulles paper and that the amendment ought not to be granted.

As indicated earlier the amendment was also refused in the exercise of the trial judge's discretion. He said in this regard:

"The evidence of Mr Batson himself establishes that it is quite immaterial whether the feed is introduced vertically, horizontally or coaxially in the claim 21 - apparatus. This means that the patentee is seeking to introduce an inessential integer into the claim in an effort to limit it so as to avoid an objection of lack of novelty. What is and what is not an essential integer of a claim is always a difficult and controversial question. But where, as here, there is no gainsaying the fact that what the patentee is doing is to introduce an inessential feature so as to provide

an argument in relation to a future attack on the novelty the question presents itself in a different form.

Amendment, being a discretionary matter, it seems to me that if an amendment is truly no more than what may perhaps be described as a stratagem to try to save the claim in this way, the court would be justified in refusing the amendment in the proper exercise of its discretion. In the present circumstances this is what I propose to do."

To elaborate, what the learned Judge wished to convey is that a court can, in the exercise of its discretion, refuse an amendment if the patentee attempts to elevate what he regarded as immaterial and what is in fact inessential, to an essential integer in order to save the claim. That may justifiably be termed a stratagem and is to be distinguished from an amendment by way of a true disclaimer to save a claim. The approach of the learned Judge cannot, in my view, be faulted. It is

therefore unnecessary to consider, on the assumption that, contrary to my finding, insert A would be an essential integer, whether the amended claims would be non-inventive in the light of the Pulles paper.

The patentee also applied for an amendment by the introduction of insert A into claim 12. Claim 12 is not a claim in issue in the revocation proceedings and the reason for the amendment was said to be to create consistency between claims 21 to 25 and claim 12. In view of my conclusion on the former claims, it follows that this amendment cannot be granted because it cannot effect the consistency sought.

The last amendment of substance sought relates to the splitting of claims 27 and 28 into four claims, the reason being to ensure that the new claims 27 and 29 are entitled to the priority date of the provisional, and the new claims 28 and 30 to that of the complete specification. The old claims claim aspects

(ii) and (iii) respectively "substantially as described and illustrated herein". Since the provisional specification had one drawing (figure 1) only, it is the patentee's case that insofar as these claims relate also to the other drawings, they are, to that extent, not fairly based on the provisional specification. The amended claims will deal separately with figure 1 on the one hand and figures 2 to 7 on the other. The latter will then have the priority date of the complete specification.

The respondent did not oppose this amendment and Plewman J, probably by oversight, did not deal with it expressly. He simply dismissed the application in its entirety. It appears that the patentee does not require this amendment in order to meet an allegation of invalidity. It is also not necessary as a matter of law because a claim may anyhow have more than one priority date (section 33(6)). The splitting of the

claims will also not inform the addressee of the specification that the patentee is of the view that the new claims 28 and 30 are not fairly based on the provisional specification - a view to which he is, on his own case, not bound. There is thus no good reason for granting this amendment.

In view of the conclusions reached above it is not necessary to deal with the other issues decided by Plewman J. Two in particular were much debated in argument before this Court: whether claims 21 to 25 were fairly based on the provisional specification, and whether Batson and Pulles were co-inventors of the invention disclosed therein. Counsel for the patentee submitted that this Court should express its views on these issues, for two reasons: first, because the findings of the court a quo on these issues would otherwise create an issue estoppel, and second, because this Court's views would assist the parties in the

future conduct of their litigation. Counsel's invitation must be declined. As to his first point, the issues in question are expressly left undecided by this Court on the basis that no decision on them is required for the purpose of determining the fate of the application for amendment and hence the outcome of the appeal. At the present stage of the litigation between the parties these issues are accordingly left open for consideration in any further proceedings that may eventuate in the court a quo. Since this Court has the last word, the findings of Plewman J cannot now be regarded as final and binding on the parties for the purposes of founding an issue estoppel. As to counsel's second point, this Court does not sit in an advisory capacity and is not called upon to express non-binding opinions on matters pending in a lower court.

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

Sam

L T C HARMS
ACTING JUDGE OF APPEAL

BOTHA, JA)
)
E M GROSSKOPF, JA) AGREE

167A/93

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WATER RENOVATION (PTY) LTD

Appellant

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GOLD FIELDS OF SA LTD

Respondent

CORAM: BOTHA, E M GROSSKOPF, MILNE, JJA et

NICHOLAS, HARMS, AJJA

HEARD: 21 February 1993

DELIVERED: 12 November 1993

J U D G M E N T

NICHOLAS, AJA

I have had the opportunity of reading in draft the judgment prepared by Harms AJA. I agree with the order which he proposes. Since, however, my approach differs from that adopted by my learned colleague, I have written a separate judgment.

This is an appeal against a judgment of Plewman J sitting as Commissioner of Patents. In the court a quo the present appellant, Water Renovation (Pty) Ltd ("Water Renovation") applied for the amendment of the complete specification of SA Letters Patent No 88/0772 which relates to an invention entitled "Separation of a Suspension into its Component Parts". The application was opposed by Gold Fields of South Africa Limited ("Gold Fields"). Conflicts of fact having arisen on the affidavits filed by the parties, the matter was referred by McArthur J, sitting as Commissioner of Patents, for the hearing of oral evidence on certain specified issues. The matter then came before Plewman J

who, having heard the evidence, made an order refusing the application for amendment with costs, but granted leave to appeal to this court.

The events which gave rise to the application for amendment had their beginning in the second half of 1986. In the August 1986 issue of The SA Water Bulletin there was published a short article by Mr. Richard Guy Batson ("Batson") who was the inventor of the subject invention and the sole shareholder and managing director of Water Renovation. Batson referred to the fact that the clarification of water through the process of chemical dosing and filtration had received the attention of engineers for over a hundred years. He now reported the invention of a separator for liquid filtration which, he claimed, was the most significant development in water filtration for years. After a broad description of the new system (which was described as "our floating media separator") the article indicated that further information could be obtained from

Water Renovation.

The article attracted the attention of Mr. Wilhelmus Pulles ("Pulles"), a scientist employed on a project on water treatment which was then being conducted in the Environmental Engineering Laboratory of the Chamber of Mines Research Organisation ("COMRO"). Pulles was interested because this project related inter alia to the removal of solids in suspension from water and aqueous solutions, and he was experimenting with and testing proposals for the cheap and efficient removal of solids from liquids. The problem was one which, partly because of the significant costs involved (R140 million per annum), had exercised the South African mining industry for many years. The finding of a solution had become urgent at this time in view of the prospect of the introduction on the mines of hydro-electric power systems - the presence of an excessive concentration of abrasive particles in mine water was likely to be harmful to the reticulation pipework and the equipment comprising

hydro-electric power systems.

On 3 November 1986 Water Renovation lodged at the South African Patent Office Application No 86/8409 together with a provisional specification relating to an invention made by Batson and entitled "Separation of a Suspension into its component parts". It recited that -

"THIS INVENTION relates to the separation of a suspension into its component parts. It relates in particular to a method of, and separating apparatus for, separating particulate material from a carrier liquid in which it is suspended, and to feed means for feeding a suspension into a separating apparatus."

There followed a description of each of the three aspects of the invention, viz. (1) the method, (2) the separating apparatus and (3) the feed means. The invention was then described by way of example with reference to an accompanying drawing, which showed diagrammatically a longitudinal sectional view of the separating apparatus according to the second aspect of the invention.

Pulles communicated with Batson, who gave him a

demonstration of his Floating Media Separator. COMRO then decided to construct and investigate the operation of a pilot plant at the Hercules Shaft of the ERPM Gold Mine. This plant was constructed between March and May 1987 at COMRO's expense and in accordance with a design provided by Batson. At its own premises in Benoni Water Renovation constructed a duplicate pilot plant.

When the ERPM pilot plant was commissioned it became apparent that it did not work very well: after a few hours of operation the feed means became clogged. The problem was the subject of many hours of discussion between Batson, who regularly visited the pilot plant at ERPM, and Pulles, who saw Batson there and occasionally visited him at Water Renovation's Benoni premises. Eventually there was produced at Water Renovation's premises a modified feed device which worked.

At a seminar on "Improving the Quality of Mine Water" held on 13 November 1987 Pulles presented a paper

entitled Suspended Solids Removal from Mine Waters using floating media separation and crossflow filtration ("the Pulles Paper"). The seminar was attended by representatives of the mining industry who were supplied with copies of the Pulles paper. This included as figure 2 a schematic diagram of a floating media separator which included the modified feed means, and a report of the results of the operation of the pilot plant between 4 July 1987 and 27 September 1987.

Pulles's original intention had been that Batson would be a co-author of the paper, but Pulles's supervisors in COMRO decided otherwise. Batson was, however, aware in general of what the paper would contain, and he attended the seminar and, like other participants, he received a copy.

On 3 February 1988 Water Renovation lodged at the South African Patents Office Patent Application No. 88/0772 which claimed the priority date of South African Patent Application No. 86/8409 which had been lodged on 4 November 1986. The patent was sealed on Application No. 88/0772 on 28

June 1987. When they drafted the complete specification, Water Renovation's patent attorneys had before them Batson's copy of the Pulles paper, and it is clear that they drew extensively upon it. Notwithstanding the advice of his attorneys, Batson did not seek Pulles's approval.

On 27 October 1989 Gold Fields filed an application for the revocation of Patent No. 88/0772 mainly on the ground that claims 18 to 25 had been anticipated by the Pulles paper. Water Renovation's counterstatement was ultimately filed on 7 May 1990. On that date Water Renovation also served on Gold Fields a notice of motion, supported by an affidavit by Batson, in which was sought an order for the amendment of SA Patent No. 88/0772 in the manner indicated in an annexure to the affidavit. The application for amendment, it is plain, was made as a riposte to the revocation application.

There are attached hereto as Annexure A the "pleadings", in consolidated form, in the revocation

application. The averments in the statement of claim are set out in ordinary type: those in the counterstatement are indented and in heavy type. As Annexure "B" there is attached an extract from Batson's affidavit filed in support of the application for amendment. Also included in Annexure "B" are copies of relevant extracts from Batson's replying affidavit.

Attention is drawn to the following features of the two annexures. Batson attached to his supporting affidavit a copy of Gold Fields' application for revocation and statement of particulars. He stated that simultaneously with the serving of the notice of motion, Water Renovation was filing its counterstatement. The affidavits supporting the application for amendment made a number of references to the counterstatement, and in the counterstatement notice was given in para 10.3 that Water Renovation would apply for the amendment of the complete specification of its patent and referred to its application for amendment. In the prayer to

the counterstatement, Water Renovation sought an order allowing the application for amendment and dismissing the application for revocation.

It is plain that the counterstatement and the application for amendment were closely interlinked, and that it was originally contemplated by Water Renovation that the application for revocation and the application for amendment would be heard and dealt with together. In the result, however, this is not what happened. The parties agreed that the application for revocation would be stayed pending the decision of the application for amendment, in connection with which the parties proceeded to file further evidence in the form of affidavits. On those affidavits a number of disputes of fact arose, and when the application came before McArthur J on 16 October 1990, it was postponed for the hearing of evidence viva voce in regard to the following issues:

"3.1 Whether Wilhelmus Pulles ("Pulles") and Richard Guy Batson ("Batson") were the co-inventors of the invention claimed in Claims

21 to 25 of Patent No. 88/0772, or any of them ("the invention").

3.2

3.2.1 whether the statements made by Batson in Form P.3 date 3 February, 1988, namely:

- (i) that he was the inventor of the invention claimed in any one of Claims 21 to 25; and
- (ii) that to the best of his knowledge and belief if the patent was granted on the application there would be no lawful ground for the revocation of the patent,

were false; and if so:

3.2.2 whether he knew that these statements of either of them were false at the time at which they were made;

3.3 whether the paper presented by Pulles at the ERPM Gold Mine on or on about 13 November 1987 ("the Pulles paper") formed part of the state of the art immediately before February 1988 (the priority date of at least claims 21 to 25 of Patent No. 88/0772".

The matter eventually came before Flewman J on 29 April 1991.

The issues referred to in paras 3.2.1 and 3.2.2 of McArthur J's order are not issues in the appeal. The issue referred to in para 3.3 became a non-issue when, in the course of the evidence given by Pulles, it was formally

admitted on behalf of Water Renovation that "the Pulles paper was made available to the public by written description on 13 November 1987". As a result, the only issue which remained of those specified in McArthur J's order was that in 3.1, - co-inventorship.

On the "pleadings" in the revocation proceedings and the affidavits filed in the amendment application it was common cause (as a result of admissions made by Water Renovation and by Batson) that the "priority date" of claims 21 to 25 was 3 February 1988, being the date when application No 88/0772 was lodged with the patent office; and that those claims were not fairly based on the provisional specification. (See paras 7.2, 8.1, 11.1, 11.3 of the counterstatement, para 7.2 of Batson's supporting affidavit, and para 5.3 of Batson's replying affidavit.) That was the reason why, in terms of para 3.3 of McArthur J's order, evidence was to be led on the question whether the Pulles paper formed part of the state of the art before 3

February 1988.

The priority date is of prime importance in the decision of this appeal. Blanco White, Patents for Inventions, 5th ed. s 2-201 states:

"For the purpose of determining whether a claim is valid it is essential that a date should be attached to it: the date, that is to say, at which it is to be determined whether the invention the subject of that claim was new or old, was obvious or not, had or had not been patented before."

At the beginning of the hearing before Flewman J, Water Renovation sought to make a volte-face. Its senior counsel, Mr. Puckrin, gave notice that he proposed to argue that the priority date of the invention in claim 21, and the claims dependent upon it, was not 3 February 1988 as had been admitted, but 3 November 1986, being the date of the provisional specification. Water Renovation was, he said, not bound by the admission made on its behalf in the counterstatement and in Batson's affidavits in the application proceedings. Mr. Bowman, counsel for Gold Fields, contended that this course was not open to Water

Renovation, which was bound by the admission. Plewman J did not decide the dispute, but sought a practical solution to the problem. Having considered the arguments on both sides he came to the conclusion that the admission had been correctly made.

The question of principle was fully argued in this appeal and it does, I think, call for a decision by this court.

Mr. Puckrin made the following submissions:

1. Correctly interpreted the 'admission' was not in fact a formal unequivocal admission;
2. The 'admission' related to a conclusion of law, not of fact, and is demonstrably incorrect; and
3. The Respondent elected to cross-examine Mr. BATSON on the admission and is bound by the answers elicited.

It is to be noted that there was no application to

the court a quo or in this court for the withdrawal of the admissions, and there was no reference in the argument to the corresponding admissions in Water Renovation's counterstatement in the revocation proceedings. In my view the latter admissions cannot be ignored. As pointed out above, the application for amendment and the revocation proceedings are interlinked. Each of them has cross-references to the other, and Batson's affidavits in the amendment application confirm what is set out in Water Renovation's counterstatement. To uphold counsel's argument would mean that for the purpose of the revocation proceedings it was common cause that the priority date of claims 21 to 25 was 3 February 1988, but that for the purpose of the amendment proceedings, whose main object was to meet the application for revocation, the priority date was 3 November 1987, being the date of the provisional specification. That would be an impossible position.

In regard to counsel's first submission, I do not

agree that the admission was not a formal admission. It was made in the counterstatement as a formal admission of an allegation made in the statement of particulars, and it constituted what Wigmore on Evidence (vol IX paras 2588-2590) calls a "judicial admission". Such an admission is binding upon the party making it, i.e. it prohibits any further dispute of the admitted fact by the party making it and any evidence to disprove or contradict it (para 2590). Cf. Gordon v Tarnow 1947(3) SA 525 (A) at 531-532 where Davis AJA said

"Wigmore (loc cit), speaking of judicial admissions in general refers to the Court's discretion to release a party from the consequences of an admission made in error. It does not seem to me that such a discretion could be exercised, in a case where the admission has been made in a pleading, in any other way than by granting an amendment of that pleading ... Here there has at no stage been any such application to amend. But it is only right to add that in any case I see no valid grounds for thinking that there has been any error."

See also Martin v De Kock 1948(2) SA 719 (A) at 734. The effect of the admission was that the priority date was not an

issue which was to be determined by the trial court, and the trial court had no jurisdiction to adjudicate upon it. The case on which Mr. Puckrin relied (Paddock Motors (Pty) Ltd v Igesund 1976(3) SA 16 (A)) is not ad rem. There the court was concerned with the question whether abandonment of a contention of law formulated in a case stated in terms of Rule 33 of the Rules of Court was binding on the party concerned. It did not deal with an admission made in a pleading. (See at 23 A-H).

Nor do I agree that the admission was equivocal. It was argued that although there was an admission in para 11.3 of the counterstatement that the proposed amended claims 21 to 25 were entitled to a priority date of 3 February 1988, there was no admission in the pleading that such claims are entitled to such a priority date only. In my opinion such an admission is implicit. There is not to be found in the admission any suggestion that the claims are entitled to any other priority date. (See para 8.2 read with paras 11.1 and

11.3 of the counterstatement). Reliance was placed on the second sentence of para 5.5.3 of Batson's replying affidavit, namely,

"Nevertheless the embodiments of those claims (claims 21-25, 28 and 30) fall within the scope of the invention described in the provisional specification ..."

In the light of the admission that claims 21-25 are entitled to a priority date of only 3 February 1988, and the admission in para 7.2 of the counterstatement, the second sentence quoted is not capable of an interpretation that the claims are fairly based on the provisional specification and hence entitled to the priority date of that document. It means no more than that these claims are within the broad statement of the invention in the provisional specification.

In regard to the second submission, Water Renovation admitted in para 11.1 of the counterstatement that "claims 21 to 25, in the form in which they appeared in the complete specification, as accepted, were not fairly based on the

matter disclosed in the provisional specification" Mr. Puckrin said that the question of "fairly based" was a question of law, not of fact.

Priority dates are dealt with in s. 33 of the 1978 Act. It provides in s.s. (1)(a) that

"Every claim of a complete specification shall have effect from the date prescribed by this section in relation to that claim"

and in s.s. (2) that -

"Where a claim in an application claiming priority from a single application whether it be another application or an application in a convention country, is fairly based on the matter disclosed in the specification of that other application or on the matter disclosed in the application in a convention country, the priority date of that claim shall be the date of that other application or the application in the convention country."

The test of "fairly based" was stated as follows by Plewman J in his judgment in the court a quo (p. 194):

"If developments and improvements made to the invention between the filing of the provisional specification and the complete specification are no more than improvements of or refinements to the invention already described the claims therefor are entitled to the priority date of the provisional specification. If they are more than that and

constitute new matter of a patentable character they must be given the priority date of the complete specification."

This accords with what was said by Buckley LJ in Stauffer Chemical Company's Application, 1977 RPC 33 (CA) at 54 lines 7 to 17):

"Can these new features be regarded as developments or additions the introduction of which is justified by section 4(6) ? If a new feature were a development along the same line of thought which constitutes or underlines the invention described in the earlier document, it might be that that development could properly be regarded as fairly based on the matter disclosed in the earlier document, and that the new process described in the later document which incorporated that development could as a whole be regarded as fairly based upon the matter disclosed in the earlier document. If, on the other hand, the additional feature involves a new inventive step or brings something new into the combination which represent a departure from the idea of the invention described in the earlier document, it could not, I think, be properly described as fairly based upon the earlier document."

The question, What are the new features?, is to be determined by comparing the provisional specification with the complete specification. That is a factual enquiry.

Whether the new features can be regarded as mere developments or additions, or whether they constitute new matter of a patentable character, is not a question of law, but is the subject of a value judgment. It is essentially a question of degree, and is answerable only for the particular case. It is therefore a question of fact. Cf. Cohen v CIR 1946 AD 174 at 178 and Morrison v CIR 1950(2) SA 449(A) at 179.

Nor do I agree that the admission is "demonstrably incorrect". In view of the fact however that this is a matter which does not now arise, it is unnecessary to give reasons for my disagreement.

In regard to the third submission, I do not agree that the answers given by Batson in cross-examination "were clearly to the effect that no admission was intended." Those answers make it clear that the admission was made, not in error or unintentionally, but deliberately, in order that the issue be removed from the arena of dispute. It was put to Batson by cross-examining counsel, and he agreed, that at

the stage of drafting the amendment application, the patentee's case was not that the Pulles paper did not anticipate certain of the claims, but that the Pulles paper could not be used, because it had not been available to the public at the relevant date. Batson then explained that when the decision was made to seek an amendment of the complete specification, it was decided "to take out everything that was in the Pulles paper, that was not covered by the provisional patent ... By amending the complete, we could avoid the difficulties of having to go to court, the costs involved and of fighting with a potential client".

What Water Renovation did was to make an election, in regard to which the principle applies, Quod semel placuit in electionibus amplius displicere non potest. See Churchyard v Redpath, Brown and Co Ltd 1911 WLD 125 at 131-2. Having once made an election, a party must abide by it. In this, as in all cases of election, he cannot first take one road and then turn back and take another. (per Bristowe J in Anghern

and Piel v Federal Cold Storage Co Ltd 1908 TS 761 at 786.

The position is, therefore, that Water Renovation is bound by its admission in the "pleadings" that claims 21 to 25 have the priority date of 3 February 1988. The next question is whether claim 21 (and the claims dependent on it) were anticipated by the Pulles paper. This can be briefly dealt with.

In para 9 of Batson's affidavit, he said that the reason for the amendment of claim 21 was to limit claim 21 "to ensure that it is distinguished over the disclosure in the Pulles paper despite my believing that the Pulles paper did not form part of the state of the art before the priority date of claim 21."

It was admitted on Water Renovation's behalf at the hearing before Plewman J that the Pulles paper was made available to the public by written description on 13 November 1987. It was therefore part of the state of the art before 3 February 1988. It is clear, too, despite Mr. Puckrin's faint

argument to the contrary, that what is claimed in claim 21 was disclosed in the Pulles paper. The result is plain: claim 21 is invalid by reason of lack of novelty.

The question then is whether the proposed amendment would cure the invalidity. If it would not, then it should not be granted. "No purpose can be served by amending a patent ... which will even after amendment be subject to revocation." (Bendz Ltd v SA Lead Works 1963(3) SA 797 (A) at 803 F.)

In his judgment Harms AJA sets out claim 21 in its present and its proposed amended form, and deals with the effect of the amendment, and the question whether "insert A" would be an essential integer of claim 21 (pp 26-33). I respectfully agree with what my learned colleague states in regard to these matters, and with his conclusion that the proposed amendment would not save the claim from invalidity. Claim 21 would still be invalid on the ground of anticipation. It follows the amendment was correctly

refused in the court a quo.

The issue which remains of those set out in the order made by McArthur J was that of co-inventorship (para 3.1). Plewman J dealt with this question in his judgment, and came to the conclusion, after referring to the evidence given by Pulles and Batson respectively, that -

"[The solution to the problem] was the joint effort of Mr Pulles and Mr Batson, and in my view Mr Pulles was therefore a co-inventor of the embodiment which is claimed".

It was argued on behalf of Gold Fields that this finding should be upheld, and that there should be a consequential finding that the patent is invalid on the further ground that the patentee was not a person entitled under s.27 of the Act to apply for patent No. 88/0772 (see para 23 of the statement of Claim in the revocation proceedings). In view of my conclusion that claims 21 to 25 are invalid by reason of anticipation by the Pulles paper, it is unnecessary to consider this question, and for the reasons which follow I think that it would be inappropriate to do so.

In the amendment proceedings, the question of co-inventorship was raised not by the applicant for amendment, but by Gold Fields as an additional or alternative reason, why, in the exercise of the court's discretion, the amendment should be refused. In Willows Francis Ltd v Aktiebolaget Astra Apotekarnes Kemiska Fabriker 1960(3) SA 726 (A), one of the arguments advanced (see pp 737-738 C) was that the Commissioner of Patents could not under s 36 of the 1952 Patents Act, at the instance of an objector at any rate, investigate such questions as misrepresentation or inutility, or excessive broadness of specification or claims, because those are matters for which the Legislature has provided separate proceedings for opposing the grant of a patent (s 23), and for revocation and infringement (secs 43 and 53). The argument in effect amounted to this: an application for an amendment under s 36(3) could not be opposed on any ground mentioned in s 23. Steyn CJ said at 738 C-D that he was unable to accede to the argument that because such matters

can be dealt with by other procedures under the Act they could not be investigated under s. 36. He continued (at 738 D-G).

"But that does not mean that they can always be investigated. Unless such a matter is relevant to the determination to be made, it would not call for investigation. Depending upon the circumstances of the case, merely to show that a patent is invalid, may be quite irrelevant as a ground of objection to amendment. One of the purposes, if not the main purpose, of an amendment by way of disclaimer, is to cure admitted invalidity or to forestall possible invalidity. To treat invalidity per se as an obstacle to such an amendment, would be to frustrate the achievement of that purpose. It can become an obstacle only in the context of other relevant circumstances showing that the amendment should not be allowed, or should be allowed only subject to conditions. Mala fides or recklessness in the drawing of the specification would be such a circumstance. The blameworthiness of an applicant in obtaining an invalid patent is not irrelevant to the question whether or not relief should be granted. But it is not, of course, the only or necessarily the decisive consideration. To mention only one other, it is undesirable, as pointed out in Raleigh Cycle Co. Ltd. v Miller & Co Ltd 67 R.P.C. 226 at p. 234, to leave invalid claims on the register of patents, and a Court would naturally be reluctant to do so. The same may be said of an invalid patent."

There is still pending in the Commissioner's court the

application for the revocation of the patent in which co-inventorship is an issue, and which the parties have agreed should be stayed pending the decision of the application for amendment. In the circumstances, I think that the question of co-inventorship can be more appropriately considered, if that should prove necessary, in the revocation application.

As indicated at the beginning of this judgment, I agree that the appeal should be dismissed with costs, including the costs consequent upon the employment of two counsel.

A handwritten signature in dark ink, appearing to read 'Nicholas', is written over a horizontal line.

NICHOLAS, AJA

MILNE, JA concurs

ANNEXURE A.

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

In the matter between

GOLD FIELDS OF SOUTH AFRICA LIMITED

Applicant

and

WATER RENOVATION (PRORIETARY) LIMITED

Patentee

in an application for the revocation of patent No. 88/0772

CONSOLIDATED "PLEADINGS"

APPLICATION FOR REVOCATION

In the application for revocation, the "grounds for revocation" were stated as follows:

"GROUNDS FOR REVOCATION:

A. That the invention concerned is not patentable under section 25.

B. That the patentee is not a person entitled under section 27 to apply for the patent.

C. That the prescribed declaration lodged in respect of the application for the patent contains a false statement or representation which is material and which the patentee knew to be false at the time when the declaration was made."

In the counterstatement it was stated by Water Renovation:

"A. AD GROUNDS OF REVOCATION the Patentee denies each and everyone of the grounds of revocation."

STATEMENT OF PARTICULARS

COUNTERSTATEMENT

1.

The applicant is GOLD FIELDS OF SOUTH AFRICA LIMITED of 75 Fox Street, Johannesburg.

2.

The patentee is WATER RENOVATION (PROPRIETARY) LIMITED, the registered proprietor of patent No. 88/0772 and having its address for service at Adams & Adams Pretoria.

3.

Patent No. 88/0772 was applied for on 3 February 1988, for an invention entitled "SEPARATION OF A SUSPENSION INTO ITS COMPONENT PARTS" and with claims to a method, separating

apparatus and feed means.

4.

The patent application claimed the priority of South African patent application No. 86/8409 lodged on 4 November 1986 and accompanied by a provisional specification.

5.

The prescribed declaration in each of applications Nos.

88/0772 and 86/8409 states that the inventor is RICHARD GUY BATSON.

1. Ad Paragraphs 1 to 5 of the Applicant's Statement

The Patentee admits the allegations in these paragraphs.

6.

During 1987 the Chamber of Mines Research Organisation (COMRO) constructed a pilot plant at Hercules Shaft of ERPM gold mine in order to conduct tests on the inventions of patent No. 86/6597 and patent application No. 88/0772.

7.

In the course of commissioning the pilot plant problems were experienced with the internal configuration of the separating apparatus, but these problems were resolved during recommissioning as a result of discussions between RICHARD GUY BATSON and the COMRO staff, in particular WILHELMUS PULLES.

2. Ad Paragraphs 6 and 7 of the Applicant's Statement

2.1 The Patentee admits that, during 1987, tests were carried out on the embodiment illustrated in the provisional specification of the invention of Patent Application No. 86/6597 and on the further embodiments invented by Mr Batson, and which he incorporated in the complete specification filed as Patent Application No. 88/0772 (hereinafter "the Patent").

2.2 The Patentee denies that the tests were carried out on a single pilot plant.

2.3 The Patentee admits that one pilot plant was at Hercules Shaft of ERPM Gold Mine.

2.4 The Patentee admits that, in the course of commissioning the pilot plant at Hercules Shaft of ERPM Gold Mine, problems were experienced with the internal configuration of the separating apparatus.

2.5 Save for the aforesaid admissions, the Patentee denies the allegations in paragraphs 6 and 7.

8.

The final configuration of the pilot plant was the joint brainchild of RICHARD GUY BATSON and WILHELMUS PULLES.

Ad Paragraph 8 of the Applicant's Statement

The Patentee denies this allegation.

9.

During November 1987 WILHELMUS PULLES presented a paper (the Pulles paper) entitled "Suspended solids removal from Mine

Waters-Using Floating Media Separation and Crossflow

filtration" to a seminar attended by representatives of the Mining Industry.

4. Ad Paragraph 9 of the Applicant's Statement

4.1 The Patentee admits that a paper (the Pulles paper)

entitled "Suspended Solids Removal from Mine Waters Using Floating Media Separation and Crossflow filtration" was presented by Wilhelmus Pulles during November 1987 to a seminar.

4.2 The Patentee denies that the seminar was "attended by representatives of the Mining Industry" but states that the paper was presented to a restricted audience of selected mining engineers expected to be concerned with the next step of the research testing period of the invention and from whom confidence of the disclosure was to be expected.

4.3 The Patentee denies that the Pulles paper forms part of the state of the art before the priority

... date of any of the claims of the Patent.

10.

RICHARD GUY BATSON knew the contents of the Pulles paper and about the presentation of the paper.

5. Ad Paragraph 10 of the Applicant's Statement

The Patentee admits that Mr Batson knew about the presentation of a paper by Pulles. The Patentee specifically denies that Mr Batson knew the contents of the Pulles paper prior to its presentation.

11.

The Pulles paper presented results of pilot plant operations conducted by COMRO between 4 July 1987 and 27 September 1987, and contained a schematic diagram of a floating media separator marked "Figure 2".

6. Ad Paragraph 11 of the Applicant's Statement

6.1 The Patentee admits the Pulles paper contains a figure 2 entitled "schematic diagram of floating

media separator".

6.2 Save for this admission, the Patentee denies the allegations in paragraph 11 of the Applicant's statement.

12.

The complete specification of patent No. 88/0772 includes matter not included in the provisional specification, being apart from the claims, extra drawings in the form of Figures 2 to 8, extra descriptive matter describing the extra drawings and a report on tests which were conducted on a pilot plant, the report commencing at page 17, last paragraph, and ending at page 20, second paragraph, and referring to a plant with the feed means 80 of Figures 4 and

5.

7. Ad Paragraph 12 of the Applicant's Statement

7.1 The Patentee admits that the provisional specification did not include claims.

7.2 The Patentee admits that the complete specification

of Patent No. 88/0772 includes matter being extra drawings in the form of figures 2 to 8, extra descriptive matter describing the extra drawings and matter from page 17 last paragraph to page 20 second paragraph, which matter was not present in the provisional specification.

7.3 Save for the aforesaid admissions, the Patentee denies the allegations in paragraph 12.

13.

The priority date of the matter not included in the provisional specification but included in the complete specification is 3 February 1988.

8. Ad Paragraph 13 of the Applicant's Statement

8.1 The Patentee denies this allegation.

8.2 The Patentee states that the priority date of the claims of his invention is 4th November 1986 for claims which are fairly based on provisional Patent Application No. 86/8409 filed 4th November 1986

and, if any claim is not fairly based on Patent Application No. 86/8409 the priority date of such claim is 3rd February 1988, being the date of filing of Patent Application No. 88/0772. A certified copy of Patent Application No. 86/8409 and of Patent Application No. 88/0772 as filed is annexed hereto as annexure A.

14.

The Pulles paper discloses and in Figure 2 illustrates feed means which is substantially the same as the feed means 80 of Figures 4 and 5 of the complete specification.

9. Ad Paragraph 14 of the Applicant's Statement

The Patentee admits this allegation.

15.

The Pulles paper discloses the results reported between pages 17 and 20 of the complete specification.

10. Ad Paragraph 15 of the Applicant's Statement

10.1 The complete specification of the Patent presently includes this disclosure.

10.2 The Patentee denies that the complete specification, as proposed to be amended, includes this disclosure.

10.3 In this respect the Patentee hereby gives notice that it will apply for amendment of the complete specification of its patent and refers to its application for amendment filed herewith.

16.

Claims 18 to 25 are not fairly based on matter disclosed in the provisional specification of application No. 86/8409, but are fairly based on matter disclosed in relation to Figures 4 and 5 and the results reported between pages 17 and 20 of the complete specification.

17.

Claims 18 to 25 therefore have the priority date of 3

February 1988.

11. Ad Paragraphs 16 and 17 of the Applicant's
Statement

11.1 The Patentee admits that claims 21 to 25 inclusive, in the form in which they appeared in the complete specification, as accepted, were not fairly based on the matter disclosed in the provisional specification of Application No. 86/8409 but were fairly based on the matter disclosed in the complete specification of the Patent.

11.2 The Patentee refers to its application for amendment filed herewith.

11.3 The Patentee admits that proposed amended claims 21 to 25 are entitled to a priority date of 3 February 1988.

11.4 Save for the aforesaid admissions, the Patentee denies the allegations in paragraphs 16 and 17, specifically denies that claims 18, 19 and 20 are

not fairly based on the matter disclosed in the provisional specification and states that claims 18,19 and 20 have a priority date of 4th November 1987.

18.

In so far as the Pulles paper discloses the matter claimed in claims 18 to 25 that matter has been made available to the public by the presentation of the Pulles paper during November 1987.

12. Ad Paragraph 18 of the Applicant's Statement

The Patentee denies the allegations in this paragraph.

19.

Claims 18 to 25 therefore claim inventions which are not new in that they formed part of the state of the art at the priority date of those claims.

13. Ad Paragraph 19 of the Applicant's Statement

The Patentee denies the allegations in this

paragraph.

20.

The inventions claimed in claims 18 to 25 are based on the configuration of the pilot plant referred to in paragraphs 6 to 8 above.

14. Ad Paragraph 20 of the Applicant's Statement

The Patentee denies the allegations of this paragraph.

21.

The inventions of claims 18 to 25 are therefore jointly made by BATSON and PULLES.

15. Ad Paragraph 21 of the Applicant's Statement

The Patentee denies the allegations in this paragraph and specifically states that the invention, so far as claimed in each of the claims of the complete specification was made solely by Batson and that Pulles is not an inventor or co-inventor.

22.

The patentee has not acquired the right to apply for a patent from PULLES.

16. Ad Paragraph 22 of the Applicant's Statement

The Patentee admits that it has not acquired the right to apply for any patent from Pulles but denies that it needs to acquire any right from Pulles to apply for, or be granted, the Patent which was granted on Application No 88/0772.

23.

In respect of the inventions claimed in claims 18 to 25 the patentee is therefore not a person entitled under section 27 to apply for patent No. 88/0772.

24.

In the prescribed declaration for application No. 88/0772 the following statements or representations are false:

(a) that BATSON is the sole inventor, and

(b) that there will be no lawful ground of revocation of the patent.

25.

The statements or representations are material and the patentee knew them to be false at the time when the declaration was made.

17. Ad Paragraph 23, 24 and 25 of the Applicant's Statement

The Patentee denies each and every allegation made in paragraphs 23, 24 and 25 of the Applicant's Statement.

WHEREFORE the applicant requests that the patent be revoked with costs payable in the event that the patentee resists this application.

WHEREFORE the Patentee asks for an order:

(a) Allowing the application for amendment referred to in paragraph 10.

(b) Dismissing the application for revocation.

(c) Costs of suit and/or

(d) Granting the Patentee such further or
alternative relief as to this Honourable Court
may deem fit."

ANNEXURE B

IN THE COURT FOR THE COMMISSIONER OF PATENTS

FOR THE REPUBLIC OF SOUTH AFRICA

In the matter between:

WATER RENOVATION (PROPRIETARY) LIMITED Applicant

(Patentee)

and

GOLD FIELDS OF SOUTH AFRICA LIMITED Respondent

(Applicant for

Revocation)

In re: South African Patent No. 88/0772

AFFIDAVIT

I, RICHARD GUY BATSON

of c/o Renovation House, 25 Moore Avenue, Benoni Extension 7,
Transvaal Province, Republic of South Africa being duly sworn
make oath and say as follows :-

.....

7.1 In their statement of particulars, Gold Fields claims that
claims 18 to 25 of the complete specification were not fairly
based on matter disclosed in the provisional specification of
Patent Application No. 86/8409 and so were only entitled to a
priority date of 3rd February 1988.

7.2 In Water Renovation's Counterstatement, it is admitted
that claims 21 to 25 are only entitled to a priority date of
3rd February 1988 but it is denied that claims 18, 19 and 20
are not entitled to a priority date of 4th November 1986.

7.3 Gold Fields in its statement of particulars alleges that a document, referred to as the "Pulles paper" discloses matter which has been made available to the public before the priority date of the claims which are not entitled to a priority date of 4th November 1986.

7.4 Gold Fields also allege that Pulles is a joint inventor of the invention claimed in claims 18 to 25, together with me.

7.5 As a result, Gold Fields allege :-

(a) that the invention claimed is not patentable under section 25 of the Patents Act no. 57 of 1978;

(b) that the Patentee is not a person entitled under section 25 of the Patents Act no. 57 of 1978 to apply for the Patent;
and

(c) that the prescribed declaration lodged in respect of the

application for the Patent contains a false statement or representation which is material and which the Patentee knew to be false at the time when the declaration was made.

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Water Renovation denies these allegations but wishes to amend its specification in order to deal still further with the points in contention. Thus, Water Renovation wishes to apply to amend its complete specification of the Patent in the manner set out in Annexure RGB-2 annexed hereto. The full reasons for maturing these amendments appear from the following paragraphs.

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EXTRACT FROM BATSON'S REPLYING AFFIDAVITS

5.3I admit, as stated in my earlier Affidavit, that claims (numbered as per the proposed amended copy of the complete

Specification in Annexure RGB-2) as 21 - 25, 28 and 30 are entitled to a priority date of only 3rd February 1988.

Nevertheless the embodiments of those claims fall within the scope of the invention described in the provisional specification (a copy which is annexed hereto as Annexure RGB-5), as I set out below. I deny that the invention claimed in any of the claims of the complete specification is not patentable under section 25 of the Patents Act No 57 of 1978.