

131/95

Case No 172/94

IN THE SUPREME COURT OF SOUTH AFRICA
(APPELLATE DIVISION)

In the appeal of :

G I MARKETING CC

Appellant

and

I FRASER-JOHNSTON

Respondent

CORAM: CORBETT CJ, E M GROSSKOPF, NESTADT, HARMS JJA,
et SCOTT AJA.

DATE OF HEARING: 18 September 1995

DATE OF JUDGMENT: 20 November 1995

J U D G M E N T

CORBETT CJ: /

CORBETT CJ:

In the Court below, the Court of the Commissioner of Patents, the respondent made separate applications for the revocation of patent no 87/6659 ("the 1987 patent") and patent no 89/8855 ("the 1989 patent"). The patentee in each case was the appellant. The two applications were heard together by the Commissioner (Van Dijkhorst J).

The history of the two patents is briefly as follows. The 1987 patent application was filed on 7 September 1987. One aspect of the invention as described in the body of the specification was a lavatory plumbing arrangement, which included a toilet pan incorporating a water-trap, a waste disposal pipe connected to the pan, a waste pipe extension, which extended only a short height above the pan flood level, and a two-way valve means (normally closed) leading to the atmosphere. Another aspect of the invention described in detail in the specification was the two-way valve means. The patent specification contained 15 claims. Of these claims 1 to 8 inclusive and 14 related to the lavatory plumbing arrangement; and claims 9 to 13 inclusive and

15 to the two-way valve means. In 1989 applications were made to amend the 1987 patent by the excision of the claims pertaining to the valve means, i.e. claims 9 to 13 and 15. At the same time the patentee launched a divisional application for the 1989 patent with the request that it be antedated to 7 September 1987. This application related essentially to the same invention but, when granted (as it was), it had the effect of claiming the valve means formerly claimed in the 1987 patent, though in different language and in 25 claims. These applications were granted.

It later transpired, however, that the amendments to the 1987 patent were not sought and effected in the manner prescribed in sec 51(1) of the Patents Act 57 of 1978 ("the Act") and in 1992 the amendments were set aside by the Commissioner. In the result the 1987 patent reverted to its original state. Thus claims relating to the valve means are to be found in both patents.

At the hearing before Van Dijkhorst J the grounds of revocation were reduced to three, viz lack of novelty, obviousness and, in the case of the 1987 patent, ambiguity as well. These issues were referred for the hearing of

oral evidence, but at the request of the parties Van Dijkhorst J decided the issues of novelty and ambiguity on the papers. For the purposes of deciding the issue of novelty he concentrated on claim 9 of the 1987 patent and claim 1 of the 1989 patent, since it was common cause that a successful attack upon them would, as he put it, "bring about the demise of the patents". He held that claim 9 of the 1987 patent was anticipated by a state-of-the-art document referred to as "the Schneider patent" and that both patents were anticipated by a document known as "the Blau patent". He further held that claim 2 of the 1987 patent was ambiguous, i.e. was not clear (see sec 61(1)(f)(i) of the Act). He accordingly made an order revoking the patents, "subject to what is ordered in paragraph 2 of this order", and decreeing that the patentee should pay the costs of both applications. Paragraph 2 of the order reads as follows:

"The revocation orders granted . . . are provisional. They will become fully operative in respect of the patent concerned, if the patentee does not within one month file notice of an application to amend such patent, or if having filed such application, the patentee withdraws it. If such an application is made as aforesaid and not withdrawn, it shall be decided at the hearing of such application whether or not the revocation order is to be put into operation."

The judgment of the Court *a quo* has been reported (see Ian Fraser-Johnston v G I Marketing CC 1993 BP 461).

With the necessary leave, appellant has appealed to this Court against the judgment and order of the Court *a quo*, save for the finding and order of invalidity made in respect of the 1987 patent on the ground that claim 2 thereof was lacking in clarity. Thus all that remains in issue, as far as this appeal is concerned, is whether either or both of the patents is/are not new by reason of anticipation by either the Blau patent or the Schneider patent or both of these state-of-the-art documents. Before dealing with these issues it is necessary to say more about the patents themselves.

I commence with the 1987 patent. It is entitled simply "Vent" and the opening sentence of the specification states that the invention relates to vent systems for use in the "plumbing field". The background to the invention is thus described in the specification (for convenience of reference I have numbered this and other paragraphs quoted from the specification):

- (1) "A lavatory pan is in practice connected behind the trap to

a waste pipe for conveying away matter flushed from the pan. This waste pipe is normally provided with an extension pipe extending upwardly above the roof of the building (at least two metres above the location of the pan). This extension pipe provides a source of air to the waste pipe when matter is flushed down the pipe to prevent there being an airlock in the waste pipe or the syphoning dry of the water trap. Furthermore the upper extension of the waste pipe provides a safety feature for the plumbing in case there should be a blockage in the waste pipe. The feature of the waste pipe extension is technically satisfactory and is widely and extensively used in plumbing. However the provision of this extension has its disadvantages because of the extra costs involved in the erection of the extension, especially in tall buildings, and the fact that roofs have to be modified to accommodate these extensions and whenever a building is being decorated or re-decorated the extension pipe must itself be additionally painted separately from the wall beside which it is located."

The specification then proceeds to describe the two "aspects" of the invention (to which I have already alluded) in the following terms:

(2) "According to one aspect of the invention there is provided a plumbing arrangement including a toilet pan incorporating a water trap, a waste disposal pipe connected to the pan and a waste pipe extension extending above the water trap, characterised in that the waste pipe extends only a short height above the pan flood level and there has a normally closed two way valve means leading to

atmosphere. The valve means is preferably a differential valve opening to the atmosphere, the arrangement being such that only a small pressure difference is required to permit air to flow into the waste pipe extension and a larger pressure is required to allow air to escape. A cover is preferably provided to permit the air flow to and from the valve but still to prevent the ingress of leaves or dirt which could have a detrimental effect upon the working of the valve.

(3) According to another aspect of the invention there is provided two-way valve means for use in an arrangement as set out above, the valve comprising a housing, which is preferably cylindrical, having a cross-plate thereacross, at least two apertures through the cross-plate and a pair of one-way valves opening in opposite directions and carried in the cross-plate, the one-way valves being preferably arranged to open at different pressures. The one-way valves preferably each comprise a seat, a flexible disc which can seal on to the seat but which when there is excess pressure through the seat moves off the seat to permit gas flow therethrough and spring means holding the disc on to the seat, the strength of the spring means determining the said excess pressure. There are preferably more than one such aperture and a one-way valve therein."

The specification continues by describing various embodiments of the invention with reference to certain accompanying drawings. These show the general plumbing arrangement, including lavatory pan, water trap, waste pipe

and an upward waste pipe extension; and also, in detail, the two-way valve means. From the drawings it appears that the "flood level" of the pan, referred to in the specification in the context of the height of the waste pipe extension, is located at the top of the rim of the pan. It is claimed in the specification that the valve arrangement provides a satisfactory seal in normal circumstances to prevent gasses with foul smells escaping from the waste pipe, while at the same time permitting air ingress to the waste pipe extension to prevent (a) air locks being formed in the waste pipe or (b) the syphoning dry of the pan trap. It further permits gasses to escape should there be a blockage in the waste pipe.

Claims 1 and 9 of this patent read as follows:

"1. A plumbing arrangement including a toilet pan incorporating a water trap, a waste disposal pipe connected to the pan and a waste pipe extension extending above the water trap, characterised in that the waste pipe extends only a short height above the pan and there has a normally closed two way valve means leading to atmosphere.

.....

9. Two way valve means for use in an arrangement as claimed in any one of the preceding claims, the valve means comprising a housing having a cross-plate thereacross, at least two apertures

through the cross-plate and a pair of oppositely opening one-way valves carried in the cross-plate."

The "arrangement as claimed in any one of the preceding claims" referred to in claim 9 consists of the general plumbing arrangement described in claim 1 and the body of the specification (including the two-way valve) and various permutations thereof referred to in claims 2 to 8.

According to its specification the 1989 patent, which is entitled "Plumbing Equipment", describes an invention relating to "vent systems for use in the sanitary plumbing field". The specification explains the background to the invention in terms identical to those appearing in the 1987 patent. (See the above-quoted paragraph (1) of the 1987 specification.) It then refers to the plumbing arrangement provided for in the 1987 patent; and continues to describe "the present invention", viz a two-way valve means, in terms similar, but by no means identical, to those appearing in the above-quoted paragraph (3) of the specification relating to the 1987 patent. There follow embodiments of the invention which use exactly the same drawings as those appearing in the specification of the 1987 patent.

The specification of the 1989 patent claims the advantages to be derived from the valve arrangement in the same terms as the specification of the 1987 patent. Claim 1 of the former specification reads as follows:

- "1. A valve means for use in sanitary plumbing, the valve comprising a housing, having
- (a) an inlet connectable to a pipe,
 - (b) sealing means at the said inlet whereby the inlet can be sealed to the said pipe,
 - (c) a cross-plate across the housing
 - (d) a plurality of apertures through the said cross-plate, and
 - (e) a plurality of one way valves respectively controlling fluid flow through the said apertures, at least one of such valves permitting flow through its associated aperture in one direction only and the other said valve permitting flow through its associated aperture in the opposite direction only."

It will be apparent from the foregoing that essentially the invention to which these patents relate is the two-way valve means as utilised in a sanitary (or lavatory) plumbing arrangement. The arrangement, in so far as it comprises a toilet pan, a water-trap, a waste disposal pipe and a waste pipe

extension, is well-known and commonplace and could not possibly constitute subject-matter for a patent. And the main advantage claimed for the two-way valve means is that it enables one to dispense with a relatively long waste pipe extension.

I turn now to the issue of anticipation. By reason of the view which I take of the matter it is necessary to refer only to the Blau patent specification. It is not disputed that this document formed part of the state of the art immediately before the priority date of the 1987 and 1989 patents and that it consequently qualifies as a document which could legally anticipate. The vital question is whether it does anticipate. This involves a comparison between the claims which I have highlighted and the Blau specification.

It is appropriate to now take a closer look at the Blau specification which was published in 1973 and in terms of which a patent was granted by the Patent Office, London. The specification, entitled "Closure Cap", states that:

"The present invention relates to a closure cap for a container or which may be used as a pipe socket closure in which excess

internal or external pressures occurring in the interior can be compensated automatically by valve members mounted in the closure."

After referring to various other known closure devices, the specification proceeds:

"It is an object of the present invention to provide a simplified structure and mounting of automatically acting valve members relative to a rigid insert plate having air vents and sealing tori, and whereby both excess internal and external pressures are automatically compensated.

According to the present invention, there is therefore provided a closure cap comprising a rigid insert plate having vent holes provided therethrough, which vent holes are adapted to be opened and closed by valve members subject to the action of compression springs, at least one valve member allowing air or gas to pass through at least one vent hole in one direction and at least one other valve member allowing air or gas to pass through another vent hole in the opposite direction, the valve members being constituted by a sealing plate supported against annular toroidal supports pressed out of the insert plate, one such sealing plate being located above the insert plate and a second sealing plate being located below the insert plate such that when the pressures on opposite sides of the insert plate are not equal, one sealing plate is removed from its supports and air or gas passes through the thus opened vent hole.

Preferably, the vent holes are eccentrically disposed in the insert plate.

Advantageously, the vent holes allowing the passage of air or gas through the insert plate in one direction are located diametrically to but on opposed sides of the centre of the insert plate from the vent holes allowing the passage of air or gas through the insert plate in the opposite direction."

There follow examples or embodiments, accompanied and illustrated by drawings. In describing one illustrated embodiment the specification states:

"Over the inner circumference of the closure cap 1, there is mounted a rigid insert plate 2 having a sealing ring 3. The sealing ring 3 is located around the circumferential edge of the closure cap and is retained in a hollow 4 provided in the lower portion 4 of the closure cap which is pressed thereunder in the region of the rim portion 1 of the closure cap. Against the outer surface thereof, a sealing ring 5 is supported between the closure cap and the edge of a socket (not shown) of a container or pipe socket part. In the embodiment shown the lower portion 4 is drawn cup-shaped similar to the closure cap. In a known manner, a bayonet catch bridge member is mounted thereon which is subject to the action of a compression spring. The invention is, however, applicable to any kind of closure cap, such as screw threaded sockets to be fastened downwardly or even simple stopper closures. "

And, finally, claim 1 of the patent reads:

"1. A closure cap comprising a rigid insert plate having vent holes provided therethrough, which vent holes are adapted to be opened and closed by valve members subject to the action of compression springs, at least one valve member allowing air or gas to pass through at least one vent hole in one direction and at least one other valve member allowing air or gas to pass through another vent hole in the opposite direction, the valve members being constituted by a sealing plate supported against annular toroidal supports pressed out of the insert plate, one such sealing plate being located above the insert plate and a second sealing plate being located below the insert plate such that when the pressures on opposite sides of the insert plate are not equal, one sealing plate is removed from its supports and air or gas passes through the thus opened vent hole."

Upon analysis Van Dijkhorst J found claim 9 of the 1987 patent to comprise the following integers:

- (a) Two-way valve means for use in an arrangement as claimed in any one of the preceding claims,
- (b) the valve means comprising a housing,
- (c) having a cross-plate thereacross,
- (d) at least two apertures through the cross-plate,
- (e) and a pair of oppositely opening one-way valves carried in the cross-plate.

As regards claim 1 of the 1989 patent, the learned Commissioner found the following integers:

- (a) A valve means for use in sanitary plumbing the valve comprising
- (b) a housing having
- (c) an inlet connectable to a pipe,
- (d) sealing means at the said inlet whereby the inlet can be sealed to the said pipe,
- (e) a cross-plate across the housing,
- (f) a plurality of apertures through the said cross- plate and
- (g) a plurality of one-way valves respectively controlling fluid flow through the said apertures,
- (h) at least one of such valves permitting flow through its associated aperture in one direction only,
- (i) and the other said valve permitting flow through its associated aperture in the opposite direction only.

These analyses are accepted by the appellant.

Van Dijkhorst J made a comparison between these claims, thus analysed, and the Blau patent and held that it was clear that integers (b), (c), (d) and (e) of claim 9 of the 1987 patent and integers (b), (c), (e), (f), (g), (h) and (i) of claim 1 of the 1989 patent were to be found in the Blau patent. (The judgment does not mention integer (c) in this context, but this appears to have been an oversight: there does not seem to be any dispute about integer (c).) This finding was not challenged on appeal. The dispute is thus narrowed down to integer (a) of both patents and integer (d) of the 1989 patent. I shall deal first with integer (a).

Integer (a) of the 1987 patent speaks of a two-way valve means -
"for use in an arrangement as claimed in any one of the preceding claims."

Clearly this must be read as referring to use in a plumbing arrangement in a toilet system. Integer (a) of the 1989 patent speaks of a valve means -

". . . for use in sanitary plumbing . . ."

Appellant contends that these uses are integral parts of the invention and that they serve to distinguish the 1987 and 1989 patents, as claimed, from the Blau

patent. The same contention was put forward, and rejected, in the Court *a quo*, which held that the words expressing these uses informed the reader of the claims what the field of application of the invention was, but did not constitute essential integers thereof. (See reported judgment, at pp 474-5.)

I agree. The general approach to be adopted in regard to words in a patent claim indicative of a use or purpose to which the invention is put was dealt with by this Court in the case of Gentiruco AG v Firestone SA (Pty) Ltd 1972 (1) SA 589 (A). The subject-matter of the invention in that case was mainly a method for the making of pneumatic tires out of synthetic rubber. The opening words of claim 1 of the specification read -

"A method of making a rubber compound suitable for a rubber tire
..."

The meaning in this context of the words "suitable for a rubber tire" was a much-debated issue on appeal to this Court. The question was whether they imported an integer delineating the kind of rubber compound and, if so, in what way; or whether it was merely descriptive and consequently of no real significance. This issue of interpretation was of importance, *inter alia*, on the

question of anticipation. In regard to certain submissions made on behalf of the respondent (Firestone SA (Pty) Ltd), the alleged infringer of the patent in suit, the judgment of the Court (delivered by Trollip JA) stated the following (at 631 C-D):

"Mr. *van Reenen*, for Firestone, relied on authorities to show that claiming a process, machine, etc., "for" or "suitable for" a particular purpose is usually ineffective, since the inventor's purpose or object is irrelevant. That may be so especially with a machine or product claim, where, as the Court *a quo* observed, the words may merely

'define the field of application of the invention as distinct
from limiting the invention itself '.

But it is always essentially a problem of construing the words in the context of the claim; where the phrase imports some limitation or special quality or characteristic into the allegedly invented method, machine, product, etc., then the claim must be construed accordingly; what its effect will be, i.e., whether that renders it inventive or novel, is another matter."

In the context of anticipation the judgment dealt with similar submissions by counsel for the respondent as follows (at 651 H - 652 C):

"On this and other aspects of the appeal Mr. *van Reenen* for Firestone argued, on the authority of *Molins and Molins Machine Co. Ltd. v Industrial Machinery Co. Ltd.*, 55 R.P.C. 31 (C.A.) that

difference in purpose between two processes was irrelevant, and he referred to the minority judgment of WILLIAMSON, J.A., in *Drummond-Hay's case, supra*, 1963 (3) S.A. 490 (A.D.) at pp. 506B-D, 508H. That argument is, I think, probably correct where two processes are otherwise the same or substantially the same, since such processes could conceivably serve different purposes. But usually processes devised for different purposes are themselves different in one or more essential integers, and difference in purpose therefore might well be a good indication that the processes do differ or that, if the difference is small, it is real or crucial. That is, I think, the explanation of certain *dicta* by STRATFORD, J.A., in *Veasey's case* at pp. 284-5 which WILLIAMSON, J.A., said in *Drummond-Hay's case, supra*, may require some qualification. STRATFORD, J.A., compared the respective purposes or objects of the two rival rock-drills and concluded that they were so radically different in aim that the defence of anticipation had necessarily to fail. But it is clear from the facts that the difference in purpose or object was really a manifestation of an essential difference in an important device of the two machines. See too p. 268 of *Veasey's case, per* WESSELS, J.A."

(See also Letraset Ltd v Helios Ltd 1972 (3) SA 245 (A), at 268 A-D.)

Thus, where a patent claim contains words denoting a particular object or purpose for the invention, a distinction must be drawn between (i)

words which, especially with machine or product claims, merely define the field of application of the claimed invention and (ii) words which import some limitation or special quality or characteristic of the invention and consequently constitute an essential integer of the claim. Whether words indicating object or purpose fall into category (i) or category (ii) is essentially a problem of construing them in the context of the claim. If the words of the claim in question fall into category (i) they will not serve to distinguish the invention claimed from - and thus avoid anticipation by -for example a prior state-of-the-art document which otherwise discloses all the integers of the claim. If, on the other hand, they fall into category (ii), they may constitute a vital or crucial distinction between the invention as claimed and the prior disclosure which will defeat anticipation.

Applying these principles to the facts of the present case, I am of the view that the words denoting use or purpose in claim 9 of the 1987 patent and claim 1 of the 1989 patent merely indicate or define the field of application of the invention claimed. In this connection it must be emphasized that these claims relate to a machine or mechanical contrivance; that, use aside, all the

integers of these claims are to be found in the Blau patent; that the disclosure in the Blau patent of a closure cap which may be used as a pipe socket closure in which excess internal or external pressures occurring in the interior can be compensated automatically by valve members mounted in the closure, is general in its terms and is not limited to any field of application; that the contrivance described in the claims does not differ mechanically in any material respect from that described in the Blau patent; that the contrivance in the claims operates in exactly the same way and serves the same purpose as that disclosed in the Blau patent; and that the words in the claims denoting use or purpose do not import any limitation or special quality or characteristic into the contrivance described in the claims and the Blau patent.

It was submitted by appellant's counsel that the law as laid down in the Gentiruco case, *supra*, had been rendered obsolete by the Act and in this regard he referred in particular to the new provisions introduced into our patent law by sec 25 (9), (11) and (12). Counsel also referred to similar provisions contained in the British Patents Act of 1977 and to various decisions of the

English courts relating to those statutory provisions. In addition our attention was drawn to the decisions of the various courts of the European Patent Office in the so-called *Mobil* case. His submission, as I understood it, was that these authorities confer novelty on a "new use" claim, not only within the medical field, but in other fields as well.

I do not intend to be drawn into a consideration of these matters and authorities. Subsections (9), (11) and (12) of sec 25 of the Act deal solely with inventions consisting of a substance or composition for use in a method of treatment of the human or animal body by surgery or therapy or of diagnosis practised on the human or animal body and have no application to the facts of the present case. The new use of a known chemical compound, dealt with in the Mobil case, is also far removed from the problem now under consideration.

For these reasons I hold that the Court *a quo* correctly found that the words denoting use in claim 9 of the 1987 patent and claim 1 of the 1989 patent do not rescue the patents from anticipation by the Blau patent.

The other issue concerning novelty raised on appeal and in the

Court *a quo* relates to integer (d) of claim 1 of the 1989 patent which, it will be recalled, consists of a -

"sealing means at the said inlet whereby the inlet can be sealed to the said pipe."

It was contended on behalf of appellant that this integer was not disclosed in the Blau patent. The contention is, in my view, without substance. The "inlet" referred to in integer (d) means the inlet in the "housing" of the valve which is connectable to a pipe; and the sealing means is one which seals the connection between the inlet and the pipe. In the third of the extracts from the Blau patent quoted above reference is made to -

". . . a sealing ring 5 . . . supported between the closure cap and the edge of a socket (not shown) of a container or pipe socket part."

This description must be read in conjunction with figure 1 attached to the specification and the number 5 serves to identify the sealing ring. Having studied the illustration in conjunction with the description in the body of the specification, I am of the view that this sealing ring performs substantially the

same function as the sealing means described in integer (d). Consequently integer (d) does not save the 1989 patent from anticipation by the Blau patent.

Accordingly the appeal fails. The order of the Court *a quo* stands, save that it is necessary to provide that the period of one month referred to therein will now run as from the date of this judgment.

The following order is made:

- (1) The appeal is dismissed with costs.
- (2) The period of one month referred to in para 2 of the order of the Court *a quo* shall run as from the date of this judgment.



M M CORBETT

E M GROSSKOPF	JA)	
NESTADT	JA)	
HARMS	JA)	CONCUR
SCOTT	AJA)	