

**Kimberly-Clark of SA (Pty) Ltd v Proctor & Gamble SA (Pty) Ltd**  
**[1998] 3 All SA 77 (A)**

**Division:** Supreme Court of Appeal  
**Date:** 27 May 1998  
**Case No:** A488/96  
**Before:** Eksteen, Harms, Marais, Schutz and Plewman JJA  
**Sourced by:** JJF Hefer and I Potgieter  
**Summarised by:** S Moodliar  
**Parallel Citation:** [1998 \(4\) SA 1](#) (SCA)

. [Editor's Summary](#) . [Cases Referred to](#) . [Judgment](#) .

*Interpretation of statutes - Patents Act 57 of 1978 - [Section 51\(10\)](#) - Whether Commissioner of Patents may set aside an amendment under [section 51\(10\)](#) on the grounds that the application to amend did not contain adequate reasons for the proposed amendment - Commissioner has no jurisdiction to review an amendment on such grounds - Registrar makes decision as to whether adequate reasons have been furnished and such decision is subject to common law review within a reasonable time.*

*Patents - Specification - Amendment to - Patents Act 57 of 1978 - [Section 51\(10\)](#) - Whether Commissioner of Patents may set aside an amendment under [section 51\(10\)](#) on the grounds that the application to amend did not contain adequate reasons for the proposed amendment - Commissioner has no jurisdiction to review an amendment on such grounds - Registrar makes decision as to whether adequate reasons have been furnished and such decision is subject to common law review within a reasonable time.*

### **Editor's Summary**

The Appellant instituted a patent infringement action and applied for a temporary interdict against the Respondent. The Respondent entered an appearance to defend the action, opposed the application and applied for the setting aside of three amendments which had been made to the The court *a quo* set aside all three amendments and the Appellant appealed against this decision. The matter was settled between the parties and the Respondent withdrew its opposition.

The main question before the Court was whether, upon a proper interpretation of [section 51\(10\)](#) of the Patents Act [57 of 1978](#), the Commissioner of Patents could set aside an amendment because of inadequate reasons given for making such an amendment. [Section 51\(1\)](#) stipulated that an application for

### **Page 78 of [1998] 3 All SA 77 (A)**

amendment to a specification had to set out the nature of the proposed amendment and furnish full reasons therefor. The court *a quo* held that non-compliance with [section 51\(1\)](#) could be raised in an application under [section 51\(10\)](#) and, if the reasons were found wanting, the Commissioner of Patents could set aside the amendment.

**Held** - The Court held that the order of the court *a quo* had not been rendered academic by the settlement of the litigation between the parties. The order affected the state of the specification and was an order *in rem* which would have a bearing on other litigation still pending.

The Court examined previous cases and considered the language and the purpose of the Act. The Court held that the adequacy of reasons provided under [section 51\(1\)](#) was for the Registrar of Patents to decide and [section 51\(10\)](#) did not create jurisdiction for the Commissioner to review such reasons. If the registrar's acceptance of the reasons was to be attacked, such attack had to be made under common law review within a reasonable time.

The appeal was accordingly upheld.

### **Notes**

For the Interpretation of statutes, see LAWSA (Vol 25, paragraphs 257-311)

For Patents, see LAWSA (Vol 20, paragraphs 1-67)

### **Cases referred to in judgment**

("C" means confirmed; "D" means distinguished; "F" means followed and "R" means reversed.)

#### **South Africa**

*Aktie Bolaget Astra Apotekarnes Kemiska Fabriker v Willows Francis Pharmaceutical Products Ltd* [1959 \(4\) SA 1](#) (T)

*Amalgamated Packaging Industries Ltd v Hutt and another* [1975 \(4\) SA 943](#) (A)

*Brelko CC and others v Hans-Otto Schwarze and others* 1991 BP 100

*Jaga v Dönges NO and another* [1950 \(4\) SA 653](#) (A)

*Lewis Berger and Sons Ltd v Svenska Ojeslageri Aktiebolaget* [1959 \(3\) SA 604](#) (T)

*Man-Dirk (Pty) Ltd v Yao-Chang Lin and others* 1993 BP 479

*Proctor and Gamble SA (Pty) Ltd v Carlton Paper of South Africa (Pty) Ltd and another* [1997 \(3\) SA 292](#) (T) - R

*Rollamatic Engineering (Pty) Limited v President Steel Corporation Pty Limited* 1973 BP 437

*Setsokosane Busdiens (Edms) Bpk v Voorsitter, Nasionale Vervoerkommissie en 'n ander* [1986 \(2\) SA 57](#) (A)

*Stoner v SA Railways and Harbours* 1933 TPD 265

*Willows Francis Pharmaceutical Products Ltd v Aktiebolaget Astra Apotekarnes Kemiska Fabrieker* [1960 \(3\) SA 726](#) (A)

*Wolgroeiërs Afslaers (Edms) Pty v Munisipaliteit van Kaapstad* [1978 \(1\) SA 13](#) (A)

### **United Kingdom**

*GE Trade Mark* [1973] RPC 297

**Page 79 of [1998] 3 All SA 77 (A)**

[View Parallel Citation](#)

## **Judgment**

### **PLEWMAN JA**

The amendment to patent specifications in terms of [sections 50](#) and [51](#) of the Patents Act [57 of 1978](#) ("the Act") has become a contentious matter. This appeal concerns amendments to the complete specification of South African Letters Patent 77/1894 in respect of an invention entitled "Disposable Diaper with Elastically Constricted Crotch Section" ("the patent"). Reports of patent cases show that the patent (the term of which has now finally expired) has formed the subject matter of litigation in at least eight other proceedings and, so the Court was informed, there is still litigation in progress which will be affected by the decision in this appeal. An observation that the fields of human endeavour in which ingenuity may be applied in pursuit of financial gain seem infinitely wide may perhaps be excused.

By a notice filed on the afternoon preceding the hearing the respondent withdrew its opposition to the appeal and abandoned its cross-appeal. An explanation of the origin and the form of the proceedings is called for. In 1995 the appellant, who had taken assignment of the patent, instituted an infringement action against the respondent. It also launched an application for the grant of a temporary interdict against the respondent. Respondent entered an appearance to defend the action, opposed the application and went onto the offensive by applying on motion for the setting aside of three amendments which had been made to the patent in the years 1982 and 1993.

The interdict application and the application to set aside the amendments were argued before Preiss J, sitting as Commissioner of Patents, on 12 May 1995. In so far as the application to set aside the amendments was concerned, he with the consent of the parties and after what is described in the judgment as a "brief argument" referred the application to the full court. The reason for this order was that there had been a

[View Parallel Citation](#)

number of conflicting decisions in the Commissioner's Court dealing with the basis of applications for setting aside amendments of patent specifications - as indeed there have. The application to set aside the amendments was then argued before a full court on 11 June 1996. The decision of the full court is reported as *Proctor and Gamble SA (Pty) Ltd v Carlton Paper of South Africa (Pty) Ltd and another* [1997 \(3\) SA 292](#) (T). (The appellant has since that hearing changed its name.). The court set aside all three amendments.

On 2 December 1996 leave to appeal to this Court was granted by the full court (which had sat as a court of first instance). In so ordering, the court also granted leave to the respondent to cross-appeal. The cross-appeal concerned an attempt by respondent to lead further evidence in the application to set aside the amendments. No order was made thereon. Consequently no appeal lay - a situation which was merely the final episode in a comedy of errors which it is happily unnecessary to discuss. The "cross-appeal" has been abandoned as has been pointed out and no more need be said of it.

It remains only to state that the full court's order has not been rendered academic by the settlement of the litigation between the parties which led the respondent to withdraw its opposition to the appeal. The respondent has not abandoned the order in its favour. It has merely withdrawn its opposition to the appeal. The court's order, since it affects the state of the specification (in effect as of 1982), is an order *in rem*. It will also have a bearing on other litigation still pending.

The order of the court *a quo* covers what are referred to in its judgment as "the first", "the second" and "the third" amendments to the patent specification. The main question in contention is the proper interpretation of [section 51\(10\)](#)

**Page 80 of [1998] 3 All SA 77 (A)**

of the Act, but it is necessary to set out the full sequence of events. These are as follows. The patent was applied

for by Kimberly-Clark Corporation of the United States of America as a convention application on 17 December 1976. Priority was claimed on the basis of a United States patent application made on 29 March 1976. The patent was granted on 5 July 1978 under the provisions of the repealed Patent Act [37 of 1952](#). In terms of [section 3\(1\)\(a\)](#) of the present Act (which came into force on 1 January 1979) the validity of a patent for all purposes is to be determined under the provisions of the 1952 Act but any amendments to the complete specification sought after January 1979 had to be made in terms of the present Act.

On 19 February 1982 Kimberly-Clark Corporation applied in terms of [section 51](#) of the Act, which deals with amendments to patent specifications, for the first amendment, giving as its reason for so doing a desire "to limit and clarify the scope of the claims". This amendment was allowed by the Registrar of Patents ("the registrar") and the amendment was entered in the register.

On 15 November 1990 the patent was assigned to appellant. On 6 December 1993 appellant applied (simultaneously) for the second and third amendments. The normal term of the patent had by this time already expired but had been extended for five years by an order of the Commissioner of Patents. (Details of this order are not given in the record but the order would have been made in terms of [section 39](#) of the 1952

[View Parallel Citation](#)

Act on the grounds that the patentee had not derived adequate remuneration. The extended term expired on 29 March 1998.) The second application was purportedly made in terms of [section 50](#) of the Act which deals with the correction of clerical errors and the amendment of documents for the amending of which no express provision is otherwise made in the Act. The third amendment (an amendment in precisely the same terms as the first amendment) was sought again in terms of [section 51](#) of the Act. The reasons for this double-barrelled procedure is made evident by the reasons for the third amendment given in the appropriate form - Patents Form 13. I quote the substance thereof:

"The Patentee hereby applies afresh to amend the complete specification of the above patent as shown on the attached relevant pages of that specification. The full reasons for making the amendment are as follows:-

The claims of the complete specification of the patent were amended in terms of an application to amend made by the then patentee on 19 February 1982 ('the earlier application to amend'). A copy of the earlier application to amend is annexed hereto marked 'A'.

In the earlier application to amend, the full reasons were given by the then patentee as being to 'limit and clarify the scope of the claims'.

The present patentee believes that, in the light of recent judgments of the Commissioner of Patents, the earlier application to amend could be open to attack by a third party on the basis that the reasons given were not sufficiently 'full', with the result that the earlier amendment could be set aside by the Commissioner.

The patentee has thus today, on form P4, withdrawn the earlier application to amend, and has abandoned the allowance thereof and now hereby applies for the allowance of precisely the same amendment as was allowed following the earlier application to amend.

The nature of the earlier application to amend and the present application is by way of a limitation of the claims of the patent.

#### **Page 81 of [1998] 3 All SA 77 (A)**

The full reasons for making both the earlier and the present applications are to avoid prior art which has come to the patentee's attention and, more especially, the disclosures contained in the specification of United States patent 3 860 003 granted to Buell.

A copy of the specification of the Buell patent, which was published on 14 January 1975, is annexed hereto marked 'B'."

The application for the second amendment was made on Patents Form 4. The substance is as follows:

"In terms of [section 50\(1\)\(b\)](#) of the Act and/or regulation 39 of the Patent Regulations, the applicant hereby withdraws an application to amend the complete specification of the patent made on 19 February 1982; abandons the allowance of that application to amend; and requests the Registrar to endorse the earlier application to amend, and any entry which may have been made in the register, accordingly."

Both applications were granted. With what validity is discussed later. They were also entered in the register. Both were, even if incorrectly made, not a nullity (see *Rollamatic Engineering (Pty) Limited v President Steel Corporation Pty Limited* 1973 BP 437 at 400A-G).

The court (correctly) observed with regard to the second amendment that the registrar was *functus officio* after he had granted the first amendment and was therefore not entitled to grant the second. It also pointed out that the grant of the second amendment would have had the

[View Parallel Citation](#)

effect of amending the patent (by restoring it to its original form) which could only be done under [section 51](#). It then held that the second amendment could be set aside in terms of [section 51\(10\)](#). I shall return to this question presently. As far as the third and first amendments were concerned (to take them in the order in which they must in the circumstances be dealt with) the court held that the Commissioner in exercising a discretion in terms of [section 51\(10\)](#) of the Act was entitled to set aside an amendment to a patent where there has been non-compliance with the requirements of subsection (1) of the section. The court then, after an examination of the Buell patent which is referred to in the "reasons" for the third amendment, concluded that the reasons given for both amendments were

inadequate. On this basis it set them aside under a jurisdiction founded upon [section 51\(10\)](#). It is necessary to quote [section 50\(1\)\(b\)](#) and [51](#) (as a whole).

[Section 50\(1\)\(b\)](#) is in the following terms:

**"50. Correction of clerical errors and amendment of documents. -**

- (1) The registrar or commissioner may authorize -
  - (a) ...
  - (b) the amendment otherwise of any document for the amending of which no express provision is made in this Act."

What is contemplated is corrections to documents other than patent specifications. Specifications are dealt with in [section 51](#).

[Section 51](#) reads:

**"51. Amendment of specification. -**

- (1) An applicant for a patent or a patentee may at any time apply in the prescribed manner to the registrar for the amendment of either the relevant provisional specification or the

**Page 82 of [1998] 3 All SA 77 (A)**

relevant complete specification, and shall in making such application, set out the nature of the proposed amendment and furnish his full reasons therefor.

- (2) An application for the amendment of a specification that is open to public inspection shall, except in the case of an application so open in terms of [section 43\(3\)](#), be advertised in the prescribed manner.
- (3) ~~(a)~~ person may oppose such application for amendment within the prescribed time and in the prescribed manner.
  - (b) Such opposition to such application for amendment shall be dealt with by the commissioner in the prescribed manner, and the commissioner shall determine whether and on what conditions, if any, the amendment ought to be allowed.
- (4) Where the acceptance of a specification concerned has not been published in terms of [section 42](#) or there is no opposition in terms of subsection (3)(a) of this section, the registrar may determine whether and on which conditions, if any, the amendment ought to be allowed.
- (5) An amendment of a provisional specification shall be allowed if it is by way of correction, including correction of an obvious mistake, and no amendment of a provisional specification shall be allowed if it would introduce new matter or matter not in substance disclosed in the specification sought to be amended.
- (6) No amendment of a complete specification which becomes open to public inspection after the publication of the acceptance of the specification in terms of [section 42](#), whether before or after it so becomes open to public inspection, shall be allowed if -
  - (a) the effect of the amendment would be to introduce new matter or matter not in substance disclosed in the specification before amendment; or

**[View Parallel Citation](#)**

- (b) the specification as amended would include any claim not fairly based on matter disclosed in the specification before amendment.
- (7) No amendment of a complete specification which has become open to public inspection after the publication of the acceptance of the specification in terms of [section 42](#) shall be allowed if the specification as amended would include any claim not wholly within the scope of a claim included in the specification before amendment.
- (8) Where an amendment may not be allowed by reason of the prohibition imposed by [subsection \(6\)\(a\)](#), but it describes matter which may fairly be associated with the matter described in the specification as framed and the acceptance of the specification concerned has not been published in terms of [section 42](#), the new matter may be introduced by way of a supplementary disclosure attached to the specification and dated with the date on which the application for amendment is made: Provided that in determining the validity of the patent under this Act, regard shall be had to the date of the supplementary disclosure.
- (9) Where any proceedings relating to an application for a patent or a patent are pending in any court, an application for the amendment of the relevant specification shall be made to that court, which may deal with such application for amendment as it thinks fit but subject to the provisions of

**Page 83 of [1998] 3 All SA 77 (A)**

subsections (5), (6) and (7), or may stay such pending proceedings and remit such application for amendment to the registrar to be dealt with in accordance with subsections (2), (3) and (4).

- (10) Any amendment of a specification made in conflict with the provisions of this section, other than an amendment allowed by the commissioner or a court, may be set aside by the commissioner at any time on application made to him."

[I have quoted the Act as it currently reads. It was amended both in 1983, by Act [67 of 1983](#) and in 1986, by Act [44 of 1986](#). The amendments so made, do not affect the question in issue in this appeal.]

For present purposes attention must be directed to the fact that the section deals with the amendment of specifications which have not become open to public inspection, and to specifications which have become open to public inspection. Only the latter need be advertised. Although subsection (3)(a) is not in terms so restricted the public can, in the nature of things, only become involved as objectors in the latter case. Where opposition is entered it is the Commissioner and not the registrar who determines whether the amendment is to be allowed. Amendments allowed by the Commissioner may not be set aside in terms of [section 51\(10\)](#). What the registrar deals with is unopposed amendments and amendments at a stage when the public is not involved (subsection (4)). Attention must also be directed to subsections (5), (6) and (7) which repeat or preserve the limitations found in the earlier Act [9 of 1916 \(section 47\(8\)\)](#) and Act [37 of 1952 \(section 36\(3\)\)](#) as to the permissible scope of amendments. In short, no amendments may be made which would (i) introduce new matter or matter not in substance disclosed in the specification before amendment and (ii) no claim not fairly based on matter disclosed in the specification before amendment or (iii) include a claim not wholly within the scope of a claim in the patent before amendment. These limitations are fundamental to the scheme of the Act as I will later show. They are designed

[View Parallel Citation](#)

to ensure that a patentee may not obtain a priority date (that is the date from which a claim is to have effect) to which he is not entitled and may never broaden his monopoly after his invention has been made known to the public by public disclosure. Any amendment allowed in breach of these provisions would, it is clear, be an amendment made in conflict with the provisions of the section. What is new in the section as compared with the repealed Act, is subsection (10).

It will be convenient first to dispose of the second amendment. Clearly an application once granted cannot be retrospectively withdrawn. But the real reason why this amendment must be set aside is that it is simply not competent in terms of [section 50\(1\)\(b\)](#). What was sought was not an amendment of a document for the amending of which no (other) express provision is made in the Act and the amendment (whatever its other shortcomings) fell to be set aside for that reason. It did not, because of what it sought to achieve, become an application for an amendment in terms of [section 51](#). It could not therefore be brought within the special jurisdiction created by subsection (10) which relates only to amendments in conflict with the provisions of that section. The result is perhaps illustrative of a question to be dealt with later, namely, how does the Commissioner or the court on an appeal deal with the obvious irregularity which occurred? The answer would seem to be by way of common-law review. The further question would be how this would affect the third amendment. Since the third amendment was sought only on the basis that the second had

**Page 84 of [1998] 3 All SA 77 (A)**

eliminated the first, it too will have been irregularly allowed. As it is what was sought to be achieved by the use of the second barrel was the resurrection of what after the second amendment was hoped would have been blown away by the first barrel - that is the withdrawal of the first amendment. In truth, the second application did not seek to amend the specification at all - it sought to amend the reasons given for the first amendment. There is no provision for this under [section 51](#). But whatever the position in this regard, the third amendment enjoyed no separate life. It was wholly dependent on the second amendment.

However, neither amendment need be further discussed because counsel for the appellant (recognising the difficulties) abandoned the appeal against that part of the court's order which set aside the second and third amendments. In the light of that abandonment that part of the order of the court *a quo* must stand.

This opens the way for a consideration of the court *a quo*'s interpretation of [section 51](#) and in particular [section 51\(10\)](#). The court, as I have stated, held that non-compliance with subsection (1), (which stipulates that in making an application in the prescribed manner the application must set out the nature of the proposed amendment and furnish full reasons therefor), could be raised and, if the reasons were found wanting, the Commissioner may set aside the amendment. This is contrary to the conclusion reached in the three decisions referred to at 295F-296E of the reported decision all of which held, in essence, that the reasons and the fullness of paucity thereof were matters for the registrar and that [section 51\(10\)](#) did not create a jurisdiction for the reconsideration of such reasons after the grant of an amendment. The underlying rationale of these decisions is

[View Parallel Citation](#)

that [section 51\(10\)](#) is concerned with the substance of the amendments and not with procedural requirements. In effect what these decisions come down to is a conclusion that [section 51\(10\)](#) constitutes a self-contained means of control to ensure that amendments as such comply with the substantive requirements of the section.

Two reasons are given by the court *a quo* for rejecting this approach. The first is that such a conclusion ignores the "clear wording of [s 51\(10\)](#)" (at 296E-G). This is based, in the main, on the fact that the section refers to "any amendment". It was reasoned that "any" being an "indefinite term which includes all of the things to which it relates" therefore included objections to procedural steps taken in the past. This proposition in my view, focuses undue attention on the word "any" and ignores the dominant phrase in the subsection namely "in conflict with the provisions of this section". The apparent width introduced by the word "any" of itself takes one nowhere. One must examine the section to determine what amendments would conflict with the provisions thereof. As I have already pointed out the only amendments which could be said to do so would be amendments going beyond the stated substantive limitations.

The court *a quo* next sought support for its views in examples offered by Van Dijkhorst J in *Brelko CC and others v Hans-Otto Schwarze and others* 1991 BP 100, which are said to illustrate "startling" consequences. This fares no



better. It will assist if I repeat the learned judge's concerns. He said (at 105B-F):

"[T]his would mean that the following would not be reviewable under [section 51\(10\)](#):

- . an application which is wholly in conflict with the prescribed manner or even the grant of an amendment on the oral application of an applicant
- . an application where the nature of the amendment is not stated but left to the discretion of the Registrar

#### Page 85 of [1998] 3 All SA 77 (A)

- . where the application was not advertised at all or advertised wholly in conflict with the prescribed manner eg in the Lowveld Advertiser only
- . where opposition is dealt with in material conflict with the prescribed manner.

Some of these examples may be a little far-fetched, but none is inconceivable."

The answer to these illustrations is that, in each instance (and accepting for this purpose that the somewhat extreme situations envisaged could arise), the remedy would be a common-law review. In the context of the Act as a whole these examples do not have startling consequences. To illustrate with reference to the first. If a patent application is made "wholly in conflict with the prescribed manner" or is "granted on an oral application", the public has no statutory remedy similar to [section 51\(10\)](#). The only available remedy is a common-law review. Such procedural defects do not provide a ground for revocation. The question can then be fairly posed whether procedural defects in a patent application are of less consequence than those in an application for amendment. The answer is obviously no. What would arise would not be whether the amendment was "in conflict with the section" but whether the conduct of the registrar had been regular. This is how this Court viewed a comparable problem in the case of *Amalgamated Packaging Industries Ltd v Hutt and another* [1975 \(4\) SA 943](#) (A)

#### [View Parallel Citation](#)

at 951D-952B. Indeed one may speculate that it was the *Hutt* case coupled with a judicial suggestion in *Aktie Bolaget Astra Apotekarnes Kemiska Fabriker v Willows Francis Pharmaceutical Products Ltd* [1959 \(4\) SA 1](#) (T) at 7D that the reasons called for in [section 36\(1\)](#) of the 1952 Act need go no further than to describe the object as, for example, "a disclaimer" that induced the legislature to add subsection (10) and to add the word "full" to amplify the requirement for reasons.

There are two other suggestions which have been said, in the cases which adopted the approach favoured by the court *a quo*, to support the court's view. In *Brelko CC and another (supra)* at 106C-D it is said that under the Act, in contrast to the 1952 Act, "it is no longer possible to oppose the grant of an application for a patent". [Section 51](#) it was suggested "affords an objector the right and a means to oppose". This proposition is, with respect to the learned judge, not easy to fathom. [Section 23](#) of the 1952 Act permitted opposition to the grant of a patent on a patent application on certain stated grounds but on no others. These limitations also applied in regard to revocation in terms of [section 43](#). The grounds of revocation in the present Act are similarly exhaustively defined. Inadequate reasons for an amendment was not such a ground under [section 23](#) (or [section 43](#)) of the 1952 Act and is not now under [section 61](#) a ground for invalidating a

It was this conclusion which gave rise to the comment in the case of *Man-Dirk (Pty) Ltd v Yao-Chang Lin and others* 1993 BP 479, that if the approach in the *Brelko* case were to be adopted, what would in effect have happened is that a further ground of invalidity would have been introduced into the Act contrary to the provisions of [section 61](#). The court *a quo* said of this proposition (at 296H-I) that the setting aside of an amendment does not result in revocation of the The court also observed that "[the] patentee is not precluded from seeking a further amendment". There are two comments to be made. The first is that to state that the setting aside of an amendment is not the same as revoking a patent, while literally correct, is simply a distinction without a difference.

#### Page 86 of [1998] 3 All SA 77 (A)

Amendments are invariably sought in order to avoid an actual or apprehended attack on the validity of the patent (see *Willows Francis Pharmaceutical Products Ltd v Aktiebolaget Astra Apotekarnes Kemiska Fabriker* [1960 \(3\) SA 726](#) (A) at 737C-D). Indeed counsel was unable to suggest any other circumstance which would lead to an application to amend. The interest of an objector in an amendment lies in the effect of the amendment upon the monopoly, in other words, whether the patentee by amending becomes entitled to a broader monopoly. That is an objective question and involves a comparison between the unamended and amended specification. It must also be said that it is the universal practice of courts when upholding a revocation application is to allow the patentee to apply, within a determined time, for a suitable amendment so as to validate the otherwise invalid Revocation applications may be made over the entire life of the patent and if the court *a quo*'s order were to be upheld so too would any attack on the patentee's reasons for an amendment with the consequential result that the patent would be rendered invalid. This is the objectionable feature

#### [View Parallel Citation](#)

and this is why allowing such a procedure would in effect create an additional ground of invalidity not sanctioned by [section 61](#).

In the *Brelko* case (*supra*) it was also said that the reasons for the amendment given by the applicant "will be of great importance when the possible objector has to decide whether to oppose or not. Whether the reasons given

are cursory or full may make all the difference in such decision". While I do not suggest that the reasons can be other than the true reasons or that they need not be given in full, the above statement is not a realistic reflection of what the basis for opposition to an amendment will be in practice. Patent specifications are technical documents of importance only to persons involved in the particular art or science involved. The decision to oppose an amendment will almost certainly be made only after a study of the specification itself and (almost invariably in practice) a study of all publicly available literature in the field worldwide. This is normally obtained by way of a patent search. The applicant's reasons play no role in this procedure and a dispute about the adequacy or otherwise of the reasons will not assist the true purpose of the patent system and (otherwise possibly than causing delays) the purposes of the objector. The purpose of this analysis of how objections are pursued is made merely to assist in determining whether in the scheme of the Act those reasons are (or are not) to be viewed as matters for the registrar and not the subject of a jurisdiction under [section 51\(10\)](#). The question is whether the subsection is to be so interpreted as to allow of a patent being attacked (which patent was at the time either not open to public inspection or the amendment of which had been advertised for opposition and not opposed) some (say) twenty years after the amendment was entered in the patent register, on a ground of attack not sanctioned by [section 61](#). Such an attack if successful would only render the patent open to a renewed attack and revocation on grounds acknowledged by the patentee at the time of the amendment and therefore corrected by the very amendment to be set aside.

The court *a quo's* approach to the question was a linguistic (or mainly a linguistic) one. There is of course complimentary approach to the work of statutory interpretation. This is to examine the statute in the light of its context. Context here is not limited to the language of the rest of the statute regarded as throwing light of a dictionary kind on the part to be interpreted. It is the matter of the statute, its apparent scope and purpose, and, within limits its background (see *Jaga v Dönges NO and another* [1950 \(4\) SA 653](#) (A) at 662G-664H). As Schreiner JA points out in this instructive passage the result should always be the same whichever of the two lines of approach is adopted, since, in the end, the

**Page 87 of [1998] 3 All SA 77 (A)**

object to be attained is unquestionably the ascertainment of the meaning of the language in its context. Each approach Schreiner JA observes has its own peculiar dangers (see also *GE Trade Mark* [1973] RPC 297 at 324).

However, if in this case the work of interpretation is undertaken in accordance with the second line of approach one arrives again at the conclusion that the court *a quo's* interpretation is incorrect. This judgment cannot be converted into a treatise on patent law and the purpose, scope and background of the statute must be stated in rather

**[View Parallel Citation](#)**

broad terms. It is an act which, like its predecessors, is intended to give effect to the accepted basic theory of the patent system which is followed throughout the developed world. From a statement of that basic theory the more critical provisions of the Act can be identified.

The theory is that it is desirable in the public interest that industrial techniques should be improved. In order to encourage improvement and the disclosure of improvements a person making such improvement is, upon disclosure thereof, given a monopoly for a defined period after which the improvement passes into the public domain. A fuller statement of this principle is found in the case of *Lewis Berger and Sons Ltd v Svenska Ojeslageri Aktiebolaget* [1959 \(3\) SA 604](#) (T) at 612A-C. A further essential feature of the theory is that the patent register should not be cluttered with patents which are not valid. Patentees are accordingly encouraged to review their patents in the light of new information which comes to hand and, if this is called for, to amend them.

The Act thus establishes a register of patents to give public access to the disclosure made. The core (for present purposes) of the Act is found in Chapter V [sections 25-43](#). The Act here follows the pattern of its predecessors. What is to be protected is an invention - that is broadly stated an improvement in technology which is new, useful and inventive (or non-obvious). In accordance with modern international practice the standard set is publicly available knowledge. The test of whether anything is patentable is found in [section 25](#). In terms of that section what is patentable is measured against "the state of the art immediately before the priority date of any claim (in the specification)". The notion "state of the art" includes any matter which is available to the public by written or oral description in South Africa or elsewhere, the object being to prevent the creation of monopoly rights in respect of machines or processes already in the public domain. This shows why the lot of a draftsman of patent specifications, and particularly patent claims, is (in common with WS Gilbert's policeman) not a happy one.

It is against this setting that the mechanism for the revocation of patents in [section 61](#) and the provisions for the amendment of patents in [section 51](#) should be seen. One may appropriately ask what purpose would disputes relating to the registrar's conduct (no doubt relevant for other purposes) serve to ensure that disclosures of technological improvements are properly made and monopolies are limited to valid patents which claim no more than is strictly justifiable. Procedural problems are not only different in character they are also subject to different forms of control. [Section 89](#) is a significant pointer to this. That section allows condonation of and the correction of irregularities in procedure.

Seen in the light of this background [section 51\(10\)](#) must be interpreted as introducing a procedure comparable in some respects to an appeal and in others to a review jurisdiction to ensure that the essential limits to the amplification of the disclosure made and alterations to the boundaries of patent claims are observed. It is an internal mechanism in the section to ensure that substantive amendments going beyond those permitted are not entered on the register. I

therefore hold that the court *a quo* erred and that its interpretation of the section is incorrect. The adequacy of the reasons provided to the registrar with applications for amendments in

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terms of [section 51](#) is for the registrar to decide and no jurisdiction to review them after allowance is created by [section 51\(10\)](#). If the registrar's acceptance of the reasons is to be attacked, such an attack would have to be made by a common-law review and, if so attacked such attack could normally only be made within a reasonable time (*Stoner v SA Railways and Harbours* 1933 TPD 265 at 272-273; *Wolgroeiërs Afslaers (Edms) Pty v Munisipaliteit van Kaapstad* [1978 \(1\) SA 13](#) (A) at 38H-39D; *Setsokosane Busdiens (Edms) Bpk v Voorsitter, Nasionale Vervoerkommissie en 'n ander* [1986 \(2\) SA 57](#) (A)). To the extent to which the court's order set aside the first amendment it must itself be set aside. Counsel did not seek an order for costs. The order I make is:

The appeal succeeds. The order of the court *a quo* setting aside the amendments to South African Letters Patent 77/1894 on the application made on 19 February 1982 is set aside and the registrar is ordered to restore to the register the entry reflecting the amendment then made.

(Eksteen, Harms, Marais and Schutz JJA concurred in the judgment of Plewman JA.)

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