

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

Case No: Patent 2003/9331

In the matter between:

SHEZI INDUSTRIAL HOLDINGS (PTY) LTD

Applicant (Patentee)

and

FELTEX HOLDINGS (PTY) LTD

Respondent

JUDGMENT

~~DELETE WHICHEVER IS NOT APPLICABLE~~

(1) REPORTABLE: ~~YES~~/NO.

(2) OF INTEREST TO OTHER JUDGES: ~~YES~~/NO.

(3) REVISED: ✓

17/2/14

[Signature]
SIGNATURE

FOURIE J:

[1] This is an application for the amendment of South African Patent No. 2003/9331 registered in the name of the applicant. The patent relates to metatarsal guards for footwear and in particular gumboots. Pending in this Court is the main application in terms of which the respondent applies for the revocation of the said patent in terms of section 61 of the Patents Act, No. 57 of 1978. That application has been stayed pending finalisation of this application.

BACKGROUND

[2] The grounds relied upon in the revocation application are the following: first, the invention claimed in claims 1 to 4, 9, 11, 12 and 14 of the patent are not clear and have no reasonably ascertainable meaning;

second, the invention claimed in claims 1, 4, 8, 14 and 16 of the patent are not fairly based on the matter disclosed in the specification; third, the declaration and power of attorney contains a false statement or representation which is material; lastly, the invention claimed in each of claims 1 to 18 of the patent was at the date immediately before the earliest priority date not new and did not involve an inventive step within the meaning of section 25(1) of the Act.

[3] These grounds for revocation are all denied by the patentee who has also pleaded that the application for revocation should be stayed pending an application to amend the patent in the manner set out in the proposed amendment annexed to the plea. Subsequent thereto, this application (the application to amend) has been filed. It is opposed by the respondent who is the applicant in the main application.

[4] In essence, the applicant contends that the proposed amendment limits the claims to a single embodiment of the invention, being a metatarsal guard that has a plurality of impact absorption zones. It is also contended by the applicant that in the claims of the patent the proposed amendment combines the wording of certain of the claims before amendment and proposes the deletion of a number of old claims with a view of overcoming and avoiding the prior art cited in the revocation application.

[5] The respondent opposes the application for amendment on the following basis: first, the amendment seeks to introduce new matter into

the specification; second, the amendment is not fairly based on matter disclosed in the specification before the amendment; third, the applicant had culpably delayed the application and it should accordingly not be allowed; and lastly, the continued invalidity of the patent after the proposed amendment based on the selected and limited grounds that a number of the proposed claims to be amended are unclear and the prescribed declaration in respect of the patent contains a false statement.

PROCEDURAL CONSIDERATIONS

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

[7] In Deton Engineering (Pty) Ltd & Another v J P McKelvey & Others 1997 BIP 113 (CP) Van Dijkhorst J, sitting as the Commissioner of Patents, refused to consider the question of continuing invalidity in amendment proceedings, holding that they should be ventilated in the

pending application for revocation. He justified this approach by pointing out that where the viability of the patent itself is the subject of debate in another forum it would *prima facie* be folly to introduce it as an issue in the amendment proceedings when it is not specifically pertinent to the amendment itself but only generally. He also emphasised that amendment proceedings should be relatively simple and issues should not be allowed to multiply.

[8] In my view the approach followed by Van Dijkhorst J applies with equal force to the application before me. Furthermore, the learned author, Burrell's South African Patent and Design Law, 3rd Edition, p 437 has commented as follows on the approach followed by Van Dijkhorst J:

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

[9] The same author (p 437) also points out that there is no rule of procedure which would deny a High Court the right to rule that an issue raised in two matters between the same parties be tried in one of the two matters where it would be natural and more convenient to do so, provided that the ruling would not deny the party a substantive (as opposed to

procedural) right. I agree with this suggestion. In any event, in terms of section 51(9), any amendment (where proceedings are already pending) may be dealt with by the Court "*as it thinks fit*".

[10] In this regard one should also bear in mind that amendment proceedings should not be turned into full scale revocation proceedings, especially if there is an application for revocation pending. If this were to be allowed, the pending revocation proceedings can be usurped and may eventually become irrelevant (Deton Engineering v J P McKelvey, *supra*, p 118A). For these reasons I am of the view that the two applications, the pending application for revocation and the present application to amend, should be heard together. Such a procedure will not deny any party a substantive right, as all issues will be considered and decided by the same Court and not in a piecemeal fashion by different Courts. The costs of this application should be reserved. In the result I make the following order:

1. The application for revocation and the application to amend with regard to Patent 2003/9331 should be heard together;
2. The costs of this application (application to amend) are reserved.


D S FOURIE
JUDGE OF THE HIGH COURT

Date: 17/2/14