Frank Joffe

Two new patent judgments on inventiveness

The Supreme Court of Appeal rules on inventive step

The Supreme Court of Appeal recently delivered two patent judgments dealing with the issue of inventive step as a requirement for a valid patent. Neither judgment was considered by the judges of appeal to be reportable, but they are still worthy of comment, if for no other reason than that they are rare examples of the court revoking a patent for lack of inventive step. (Ensign-Bickford (South Africa) (Pty) Ltd & others v AECI Explosives and Chemicals Ltd 1999 (1) SA 70 (SCA) is the only case under the current Patents Act 57 of 1978; see also Marine Construction and Design Company v Hansen’s Marine Equipment (Proprietary) Limited 1971 BP 187 (A) and John Hay Chapman Drummond-Hay v D I Fram and Company 1962 BP 343 (T), which are the only such cases under the previous Act.)

Section 25 of the Patents Act lays down the requirements with which an invention must comply in order to be patentable. One of them is that an invention must involve an inventive step (s 25(1)). An invention is deemed to involve an inventive step if it is not obvious to a person skilled in the art, having regard to any matter which forms, immediately before the priority date of the invention, part of the state of the art (s 25(10)). Generally, the state of the art comprises all matter that has been made available to the public in South Africa or elsewhere (s 25(6)).

Whether an invention involves an inventive step is a notoriously difficult question to answer. Indeed, the Supreme Court of Appeal has cited with approval the statement that ‘[w]hat with hindsight, seems plain and obvious, often was not so seen at that time’ (Ensign-Bickford v AECI Explosives and Chemicals supra at 81E–H, quoting Sir Donald Nicholls VC in Mölnlycke AB & another v Procter & Gamble Ltd & others (no 5) [1994] RPC 49 (CA) at 113).

In Buckman Laboratories (Pty) Ltd v Bromine Compounds (655/06) [2008] ZASCA 37 (28 March 2008) the SCA considered an appeal against a judgment of the Court of the Commissioner of Patents, dismissing an application for the revocation of a patent. The appeal court dealt solely with the question of the inventiveness of the patent in issue and held that the patent was indeed revocable on the ground of lack of inventiveness. Apart from providing an example of our highest court finding against the patentee on the ground of lack of inventive step, the judgment in this case is otherwise unexceptional.

Three days later, in Northpark Trading v Ausplow (278/07) [2008] ZASCA 46 (31 March 2008), the court delivered another judgment on the question of inventive step. Again, the court considered an appeal from the Court of the Commissioner of Patents against a judgment
dismissing an application for the revocation of the patent in issue. Again, the Supreme Court of Appeal found it necessary in upholding the appeal to consider only the issue of the lack of an inventive step. As with Buckman Laboratories, Northpark Trading is notable as an example of a judgment against the patentee on the ground of the lack of an inventive step.

However, Northpark Trading is notable for another reason. In the specification of the patent in issue, the patentee had included sections dealing with the background to and the object of the invention. Although it is common practice to include such sections in a patent specification, this practice is by no means universal and is certainly not a requirement of the Patents Act. Actually, the Act requires of a patent specification only that it

- has an abstract;
- sufficiently describes, ascertains, and, where necessary, illustrates or exemplifies the invention and the manner in which it is to be performed in order to enable the invention to be performed by a person skilled in the art of such invention; and
- ends with a claim or claims defining the invention for which protection is claimed (s 32(3)).

These requirements can be met without including descriptions of the background to the invention or its object.

In Northpark Trading (supra para [15]), Nugent JA stated:

'If I think it is fair to infer from the background to and object of the invention as it is recorded in the specification that the inventive step that the inventor considered himself to be taking lay in linking the seeding assembly to the tine in such a way that the seeding assembly is capable of moving in a vertical plane relative to the tine and causing the seeding assembly to move in that plane so as to follow the profile of the soil. Implicitly, this would solve the difficulty that the inventor said (in the portion of the specification that I have referred to) was the object of the invention.'

The judge added (para [16]):

'The specification is silent as to any benefits that are to be achieved by extending the outlet of the seeding tube into the slot and that integer is also immaterial to achieving the proclaimed object of the invention. But in argument it was submitted that the inventiveness of projecting the seed tube into the slot lies in the propensity this gives to the seed tube to avoid seed being displaced by wind. If that was why the inventor considered the projection of the tube into the slot to be an inventive step it is remarkable that no reference was made to it when describing the background to and the object of the invention. It seems to me that reliance upon that integer as constituting an inventive step is merely an opportunistic exploitation of the absence of that integer from the description in Dreyer [US Patent no 4,726,304]."

'The last temptation is the greatest treason: to do the right deed for the wrong reason' (TS Eliot)

It is clear from the remainder of the judgment that the court found that in the light of the prior art submitted in evidence, the invention lacked inventiveness (see para [17]). So perhaps there was little need to go into the inventor's own description of the background to and object of the invention. But, having these available to it, the court did not hesitate to consider the inventor's mere say so and to hold his words (and omissions) against him.

However, the excursion of the court into the sections of the specification dealing with the background to and object of the invention in order to ascertain what the invention comprised and whether it was inventive is misguided and sets a dangerous precedent. The correct procedure for
testing whether or not an invention is inventive is to compare the invention as claimed with the prior art (Roman Roller CC & another v Speedmark Holdings (Pty) Ltd 1996 (1) SA 405 (A) at 413). The inventor in Northpark Trading was not under any obligation to say what the benefits of a particular integer (feature) of the claimed invention were. Nor was he obliged to state what he considered to be his inventive step, or even to provide a statement of his objectives. To the extent that the inventor’s statements in the section called ‘background to the invention’ provide an accurate description of the prior art, they may be relevant to the enquiry into inventiveness, but no more relevant than any other source of such anticipatory prior art. The inventor is not obliged to provide a survey of the prior art. Similarly, the inventor’s objectives in making his invention are, in this context, irrelevant. The test for inventive step is objective and does not depend on the subjective views of the inventor when he filed his patent application. It is for the court to decide, on the basis of the evidence before it, whether the invention as claimed is inventive (Gentiruco AG v Firestone SA (Pty) Ltd 1971 BP 58 (A) at 92; see also Timothy Donald Burrell Burrell’s South African Patent and Design Law 3 ed (1999) 156-157).

There is a lesson to be learnt from Northpark Trading: drafters of patent specifications should be particularly careful about the statements that they make in setting out the background to and objects of the invention. If the courts continue to give weight to the inventor’s stated objectives in deciding on the inventiveness of inventions, we may well end up with the unfortunate practice found in many American specifications, in which the inventor states as the objects of his invention virtually everything of which he can conceive, from curing cancer to finding God.

Frank Joffe: Bowman Gilfillan, Sandton
(e-mail: fjoffe bowman.co.za)