IN THE COURT OF THE COMMISSIONER OF PATENTS

FOR THE REPUBLIC OF SOUTH AFRICA

CASE/PATENT NO: 95/0812

Date: 30/04/2010

In the matter between:

AUSPLOW PTY LTD

Applicant

and

NORTHPARK TRADING 3 (PTY) LTD First Respondent

THE REGISTRAR OF PATENTS Second Respondent

MARAIS ENGINEERING (PTY) LTD Third Respondent

MARAIS STEYN Fourth Respondent

JUDGMENT

MURPHY J

1. This is an application in which the applicant seeks amendment of South African Patent No 05/0812. At the time it launched the application it sought also an interdict restraining the first respondent (and later the third and fourth respondents) from infringing claims 1 and 13 of the patent as amended, an inquiry into damages suffered by it as a result of an alleged infringement, and an order to deliver up for destruction certain offending implements. The applicant now limits the relief it seeks to an order for amendment and requests that the question of, and relief claimed in respect of, infringement be referred to trial.

2. The applicant, Ausplow (Pty) Ltd ("Ausplow"), is the registered owner of the patent entitled *"Improvements in or relating to seeding machinery"*. The patent was filed on 2 February 1995 and proceeded to grant on 29 November 1995. It claims priority from Australian patent application PM3667 dated 3 February 1994.

3. The patent has been the subject of prior litigation between the parties. The present litigation flows from an order made by the Supreme Court of Appeal in *Northpark Trading v Ausplow* (278/07) [2008] ZASCA 46. Nugent JA usefully described the invention in his judgment in that matter as follows:

> "The invention is entitled 'Improvements in a Relating to Seeding Machinery'. A brief description of the machinery of the prior art will assist to understand the claims. The machinery is designed for planting seeds in untilled soil. It is essentially a frame that is dragged behind a tractor on which a series of tools are mounted in a line one behind the other each performing one of a series of functions. First in line is a tine (or share) that cuts a slot in the untilled soil. Optionally, a tube might be mounted behind the tine, through which fertiliser may be deposited in the slot. Behind the tube is a device of one kind or another that collapses soil into the slot so as to partially fill it, which serves a dual purpose: the collapsed soil separates the fertiliser (if fertiliser is used) from the seed and avoids the seed being burnt, and it forms a suitable bed upon which to deposit the seeds. Behind that tool is another vertically-mounted tube through which seeds are deposited on the bed. And behind that is a wheel, wider than the slot, which dislodges more soil from the sides of the slot, covering the seed, and simultaneously tamping it down to ensure that the seed is in good contact with the surrounding soil."

4. The object of the invention in the patent in suit is to overcome or substantially ameliorate certain disadvantages referred to in the specification under the heading *'Background to the Invention'* where it is stated:

> "It has been found in practice that tined seeding machinery and attachments have difficulty in penetrating soil deeply whilst at the same time maintaining accurate placement of seed and fertiliser. Due to the undulating ground conditions nearly always encountered, and with seeding depth controlled by widely spaced ground wheels, seeding depth cannot be maintained, often with seed and fertiliser placed together on a hard impenetrable barrier causing poor seed germination, loss of plant vigour, low yields, poor water infiltration, waterlogging and fertiliser toxicity and a greater incidence of disease."

5. Ausplow instituted action for the infringement of the patent during August 2002 to prohibit the first respondent ("Northpark") from the unauthorised making and selling of a seeding assembly for use with a planter (known as *"the Voorplanter Mark V).* The court in *Ausplow (Pty) Ltd v North Park Trading 3 (Pty) Ltd (formerly Marais Engineering CC)* 2007 B1P I (CP) (Southwood J) found in favour of Ausplow and interdicted Northpark from infringing the patent. The court also ordered an enquiry into the damages suffered by Ausplow and certified the patent as being valid in terms of section 74 of the Patents Act 57 of 1978 ("the Act"). The decision was reversed on appeal by the Supreme Court of Appeal in the judgment I have referred to and for reasons which I will discuss in due course.

6. Ausplow's rights as patentee are defined in 15 claims. Southwood J found that claim 1 had been infringed. Claim 2-12 are dependant claims. Claim 13 has now assumed greater relevance. For the purposes of this application it is necessary to refer only to these two claims. Claim 1 in its original form can be divided into the following integers:

> "A seeding assembly to be used with a plough frame supporting at least one plough tine, said assembly comprising:
>
> (A) a seeding tube
>
> (i) to extend downwardly into a slot formed in a

soil layer by the
tine,

(ii) said tube having a lower extremity through which seed is delivered into the soil layer;

(B) a closing tool

(i) fixed with respect to said lower extremity and

(ii) having a leading surface forward thereof relative to the normal
direction of travel of the frame over the soil layer,

(iii) said closing tool being aligned in said direction with respect to
said lower extremity so that it engages soil adjacent said slot,

(iv) to dislodge the soil to partly close the slot and

(v) provide a seed bed onto which seed leading said lower extremity
is delivered:

(C) mounting means

(i) to attach the tube and closing tool to the frame

(ii) to permit height adjustment of the tube and the closing tool with
respect to the frame; and

(D) ground engaging means

(i) operatively associated with the tube and closing tool to engage the soil layer to cause said height adjustment."

7. Claim 13 in its unamended form can be divided into the following integers:

"(P) The seeding assembly of any one of claims 1 -7, wherein

(i) said mounting means is a first mounting means, and

(ii) said assembly further includes a second mounting means, which
second mounting means

(1) is adjustable to adjustably attaching the ground engaging means to the tube and closing tool

(2) thereby enabling said ground engaging means to effect said height

adjustment."

8. In the court *a quo* in the infringement action Northpark denied that the *Voorplanter* fell within the scope of the claims of the patent and infringed the patent. It also denied that the patent is valid and sought revocation on three grounds, namely: the invention was not new; the invention did not involve an inventive step; and the claims of the patent are not clear. At the commencement of the trial Northpark admitted that certain of the integers of claim 1 are present in the *Voorplanter*. What remained in issue was whether integers (A)(i), (A)(ii), (B)-(B)(v); (C)(i), (C)(ii) and (D) were present, the disputes being whether the seeding tube extended into the slot, whether the seed is delivered into or onto the soil layer, and whether the *Voorplanter* had a closing tool with the described features. The last mentioned dispute was considered to be "the main issue". Southwood J held that all the integers of (B)(i)-(v) of claim 1 are exhibited in the *Voorplanter* and that the scraper forming part of it is a closing tool. That finding disposed of the issues relating to integers (C)(i), (C)(ii) and (D). The only issue remaining was whether integers (A)(i) and (A)(ii) were present. Southwood J found that they were and accordingly, in his assessment and subject to the validity of the patent, the *Voorplanter* infringed claim 1.

9. Northpark based its case of anticipation (lack of novelty) on four prior patents, three USA patents ("Halford", "Anderson" and "Dreyer") and one South African patent ("Van Tonder"). After careful analysis and comparison of the Halford patent, Southwood J concluded that integer (B)

- a closing tool to engage and dislodge the soil to close the slot -

was not present in the Halford patent. As for the Anderson patent, the learned judge concluded that the "earth working tool" of that invention did not engage the soil adjacent to the slot and dislodge it into the slot and hence that integers (B)(iii) and (iv) of the patent in suit were not present in the Anderson patent. Likewise, he held that Northpark had not established that integers (C)(ii) and D(ii) were present in the Anderson patent. The issue here was whether the mounting means and ground engaging means permit an automatic height adjustment of the tube and closing tool, with respect to the

frame in use. Southwood J held that there was no evidence that it is a characteristic of the leaf spring rods in the Anderson invention that they are able to flex and allow vertical movement or that there would be height adjustment with respect to the frame. With regard to the Dreyer patent, the court held that integers <B)(iii)-(v) were not present, nor integer (A)(i) because the seeding tube in the Dreyer invention did not extend downwardly into the slot formed in a soil layer by the tine, and nor did the closing tool ("expansion structure" in Dreyer) engage the soil adjacent to the slot ("furrow") and dislodge it to partly close the slot and thereby provide a seedbed. The expansion structure merely pushed soil within the furrow ahead forcing it over the fertiliser before the seed is deposited. There is no dislodging of adjacent soil to form a seedbed. Finally, the court found that the Van Tonder patent also did not anticipate the patent in suit. Because Northpark abandoned reliance upon it on appeal before the Supreme Court of Appeal it is not necessary to consider the reasons. In the result, Southwood J dismissed the counterclaim for revocation on grounds of anticipation.

10. Southwood J further held that the invention involved an inventive step and accordingly also dismissed the counterclaim for revocation on the grounds of obviousness. Ausplow had maintained that the inventive step was the combination of a tine (to form a slot), a separate closing tool (which engages the sides of the slot and forms a seed bed with the soil dislodged from the sides of the slot), a seeding tube (which extends into the slot to deposit seed on the seed bed) and a mounting means which allows height adjustment of the seeding tube and closing tool relative to the frame and the ground engaging means which causes height adjustment. In its counterclaim Northpark referred to 42 prior art documents but during the trial limited its reliance to the four patents relied on in its case for anticipation, and another US patent, "the Handy patent", as well as copies of photographs of an implement called "Soilmaster". Northpark's expert witness submitted that the Handy patent disclosed all the integers of claim 1 of the patent in suit, with the exception of integer (B)(iv) (the closing tool dislodging the soil to

partly close the slot). Accordingly, it was argued that the skilled addressee would have imported the boot 12 disclosed in the Anderson patent into the Handy implement. Southwood J rejected the argument because, in his view, the Handy patent does not disclose a seeding tube which descends downwardly into a slot formed in the soil layer by the tine and consequently integers (A) and (A)(i) are not disclosed. Moreover, the Handy patent discloses a planting sweep which delivers seed into the soil layer and does not engage soil adjacent to the soil adjacent to the slot, to dislodge it to partly close the slot and provide a seed bed to which the seed is delivered. For that reason Southwood J held that the Handy patent did not disclose integers (A)(ii) or (B)(i)-(v). Consequently, he held further that the combination of the integers of the invention was different from any in the prior art.

11. It is evident from the learned judge's analysis and discussion that he saw the inventiveness as being the combination of the means for creating the furrow, placing the fertiliser in the furrow, planting the seed at a consistent optimum depth and compacting the soil, into one assembly which makes it possible for all the operations to be performed during a single pass and which ensures consistent depth of seed and fertiliser by means of mounting the seed delivery devices so that they move vertically up and down with the contours of the land. The combination, through its use of the adjacent soil to create a seed bed, has the additional advantage of avoiding contact between fertiliser and seed by placing them away from each other by covering the fertiliser before the seed is placed in the soil. In concluding that the invention of the patent in suit involved a step forward, Southwood J took into account the fact that Northpark did not produce any evidence to show that products made in accordance with the prior art have been and are in commercial production. He also felt that had the combination been obvious to the person skilled in the art the question must be asked why that was not done. The combination resulted in an effective seeding assembly which is commercially viable.

12. For reasons that need not detain us Southwood J also dismissed the counterclaim for revocation on the grounds of lack of clarity.

13. Northpark appealed to the Supreme Court of Appeal. The appeal was upheld in a brief judgment handed down by Nugent JA on behalf of a unanimous court. The court of appeal did not consider it necessary to deal with the question of infringement because it considered the validity of the patent to be decisive of the appeal. It was of the opinion that the invention did not involve any inventive step and thus upheld the counterclaim for revocation on the ground of obviousness. Its reasoning has implications for the present application and therefore must be examined carefully.

14. Nugent JA held that all of the constituent elements of claim 1 are described in the Dreyer patent except one, namely that "the seeding tube extending downwardly into the slot that is formed by the tine" is not described by Dreyer. In other words, without actually saying so, the learned judge of appeal agreed with Southwood J that integer (A)(i) of claim 1 of the patent in suit is not disclosed in Dreyer. He disagreed with Southwood J that integers (B)(iii)-(v) were also not present. In the opinion of the court of appeal what Dreyer describes as the "expansion structure" is in all respects the equivalent of the "closing tool" of the patent in suit. In this regard he referred to the description of the invention in the Dreyer specification where it is said:

> "The expansion structure on the sowing share between the forward and rear outlet ensures that the material deposited in the furrow through the first outlet will be covered with soil in such a way that the fertiliser and seed will be separated by a layer of soil even when the soil is very heavy or a lot of soil is thrown up. The expansion structure always pushes at least a iittle soil ahead, forcing it over the material deposited in the furrow from the first outlet. The material coming from the rear outlet on the sowing share will then always fall on top of the soil covering the first material."

Nugent JA considered the apparent distinction between "the expansion structure" and "the closing tool" to be one of nomenclature only. He seemed to attach no significance to the fact that the closing tool engaged the soil adjacent to the slot, dislodged it to partly close the slot and provided a seed bed

into or onto which the seed was delivered. He did not explain whether he considered that operation to be the equivalent of the expansion structure pushing "a little soil ahead, forcing it over the material deposited (fertiliser) from the first outlet". It is reasonable to assume he did.

15. Nevertheless, as mentioned, to the extent that the seeding tube of the invention projects into the slot the invention is not described by Dreyer. Put differently, integer (A)(i) of claim 1 of the patent in suit is not disclosed in Dreyer. Consequently, it would follow, Dreyer does not anticipate the patent in suit. And despite the Supreme Court of Appeal making no reference to or any explicit finding regarding Southwood J's ruling that the patent in suit was not anticipated by the other patents, Ausplow's claim of novelty seems to have been upheld on appeal.

16. When dealing with the question of obviousness in paragraph 16 of his judgment, Nugent JA commented:

> "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."

If the only integer distinguishing the patent in suit from Dreyer, integer (A)(i), is immaterial, there is perhaps room to argue that there is no integer distinguishing the two patents, possibly justifying revocation on grounds of anticipation without any need to reach the question of inventiveness. It is trite that where the alleged anticipation and the alleged invention are substantially the same then there is no novelty in the alleged invention. There must be a real difference - *Veasy v Denver Rock Drill and Machinery Co Ltd* 1930 AD 243 at 282.

17. In other words, a case of lack of novelty could be made from Nugent JA's *dictum* that integer (A)(i) was immaterial. I, however, do not believe that the Supreme Court of Appeal was of the view that Dreyer anticipated the patent in suit. Had the learned judge of

appeal intended to make such a finding he would not have embarked upon an enquiry into obviousness. The issue of lack of inventiveness arises only if the invention has survived the attack on novelty - *Ensign-Bickford (SA) (Pty) Ltd v AECi Explosives and Chemicals Ltd* 1999 (1) SA 70 (SCA) at 80 E-F. Moreover, and most importantly, a finding that an integer is immaterial to achieving the proclaimed object of the invention is a finding of a lack of inventive ingenuity, not a finding of no real difference. That much is apparent from what follows in the judgment of the Supreme Court of Appeai.

18. The finding on the question of obviousness is at paragraphs 15-17 of the judgment, which read:

> "[15] 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.
>
> [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.

[17] I do not think that integer can be said to constitute a step forward upon the state of the art and least of all a step that is inventive. I think there can be little doubt that a person skilled in the art, faced with the problem of wishing to ensure accuracy of the placement of the seed (which was the only reason advanced in argument for why the step is inventive) would extend the outlet of the tube into the slot so as to be as close as possible to the bed upon which it is to be placed. To the extent that he or she might not already know that, it would be apparent from the description in Anderson in which that is disclosed. In my view the invention in the present case does not involve an inventive step."

19. In the course of the hearing before the Supreme Court of Appeal, counsel for Ausplow, undoubtedly having realised that there was a distinct possibility that the court would hold the patent invalid, requested the court to make an order in terms of section 68. Nugent JA, remarking that counsel for Northpark had advanced no adequate reason why that should not be done, made the following order:

'The appeal is upheld with costs. The orders of the court below are set aside and the following orders are substituted:

1. The plaintiff's action is dismissed with costs.

2. The defendant's counterclaim for the revocation of South African Patent No. 95/0812 is granted and, subject to the orders beiow, the patent is revoked.

3. The order in paragraph (2) above is provisional. It will become fully operative if the patentee does not within one month file notice of an application to amend the patent, or, having filed such application, withdraws it. If an application as aforesaid is made 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.

4. The plaintiff is ordered to pay the defendant's costs in respect of the counterclaim."

20. As it turns out, there may indeed be an adequate reason why an order in terms of section 68 of the Act should not have been granted: the jurisdictional pre-conditions for such an order did not exist. Section 68 deals with relief for infringement of partially valid specifications. To the extent that it is relevant, it provides:

> "Where in any proceedings for infringement of a patent, the commissioner finds that any claim in the complete specification in respect of which infringement is alleged, is valid, but that any other claim therein is invalid, the following provisions shall .... apply, namely -
>
> (a) If a counterclaim for the revocation of the patent has been made in the proceedings on the ground of the invalidity of any claim in the specification, the commissioner may postpone the operation of any order issued thereon for such time as may be required to enable the patentee to effect any amendment of the specification pursuant to the conditions imposed by the commissioner, who may attach such other condition to any order to be issued on the counterclaim as he may deem fit;"

The preamble to section 68 has two jurisdictional requirements which must be met before it can find application. The first is that a claim is valid; and secondly the commissioner (court of appeal) must make a finding that the said valid claim is alleged to be infringed albeit that other claims are found to be invalid. The Supreme Court of Appeal did not find any of the claims of the patent to be valid. The only claim considered by both the court a *quo* and the Supreme Court of Appeal was claim 1. The Supreme Court of Appeal found that claim 1 was invalid for want of an inventive step. There was no finding that any other claim was valid, or that any valid claim was alleged to be infringed. Added to that, the action for infringement was dismissed on appeal and hence there was no finding that any claim was in fact infringed. The problem is compounded by the curious fact that the order ultimately made by the Supreme Court of Appeal was not an order of the kind contemplated in section 68(a) of the Act. The provision authorises the court to postpone the operation of an order of revocation for a stated period for the purpose of enabling the patentee to effect amendments. A postponed order of revocation has the effect that the

patent remains unrevoked until such time as the period of postponement lapses. The order made by the Supreme Court of Appeal granted the counterclaim and revoked the patent subject to paragraph 3 of the court order. That paragraph declared the order of revocation to be provisional, to become fully operative at a later stage. A provisionally revoked patent is not the same as a patent in respect of which revocation has been postponed or suspended. The effect of a provisional order for revocation of a patent is that the patent is invalid until validated by an amendment and the provisional order for revocation is discharged by the court granting the amendment.

21. The unusual nature of the order of the Supreme Court of Appeal has awkward implications. Firstly, is a lower court required to defer to the court on high when the latter in directing the lower court to act in a certain way mistakenly assumes a jurisdiction not conferred by the statute? That question raises troubling rule of law or legality issues, which, though perhaps interesting, might better be avoided by adopting a pragmatic, albeit robust, policy approach or attitude to what the order sought to achieve. Secondly, and of particular significance in the present case, can an infringement action be brought in respect of a patent which has been provisionally revoked? I will return to these questions at a later stage in the judgment.

22. Relying on the order it obtained from the Supreme Court of Appeal, Ausplow has brought the present application to amend the patent. As mentioned it originally sought an interdict prohibiting Northpark from infringing the patent and requested an enquiry into damages. The judgment of the Supreme Court of Appeal was handed down in March 2008. Ausplow brought this application on 24 April 2008. It emerged some time later (in the answering affidavit of Northpark) that since 17 September 2004 the third and fourth respondents, Marais Engineering (Pty) Ltd and Marais Steyn ("Marais Engineering" and "Steyn"), and not Northpark, were making and selling the *Voorplanter*. An interlocutory application for joinder was brought. On 5 June 2009 Southwood J granted

judgment joining Marais Engineering and Steyn as parties in the main application.

23. In substance the amendments now sought by Ausplow aim to amend original claim 1 by limiting the scope of the claim to include a second mounting means, which is adjustable for adjustably attaching the ground engaging means to the tube and closing tool thereby enabling the ground engaging means to effect the height adjustment, which limitation is claimed in original claim 13. The amendments then propose to delete original claims 13,14 and 15. Then a new claim 13 is proposed, which relates to a combination of a plough tine having a lower extremity to which there is attached a digging blade, a fertiliser tube and a seeding assembly with the additional limitations that the first mounting means is adapted to be attached to the tine in order to be attached to the frame (claimed in original claim 7); that the digging blade, fertiliser tube, closing tool, seeding tube and ground engaging means are aligned in that order in the intended direction of travel (claimed in original claim 8); that the digging blade, closing tool and ground engaging means each have an operative width, with the operative width of the digging blade being narrower than the operative width of the closing tool and with the operative width of the closing tool being narrower than the operative width of the ground engaging means; and that the seeding assembly is directly attached to the tine, so as to be movable relative thereto to provide the height adjustment, claimed in the original claim 11. Ausplow has referred to various parts of the specification as the basis for the proposed amendments.

24. The reason put forward for the proposed amendments is that they introduce additional limitations to the original claim 1 to render the proposed independent claim 1 and 13 inventive over the prior art cited against the Ausplow patent in the original claim, and to delete the redundant original claims 13 to 15.

25. After amendment the proposed claim 1 can be divided into the following integers.
"A seeding assembly to be used with a plough frame supporting at

least one plough tine, said assembly comprising:

(E) a seeding tube

(i) to extend downwardly into a slot formed in a soil layer by the tine,

(ii) said tube having a lower extremity through which seed is delivered into the soil layer;

(F) a closing tool

(i) fixed with respect to said lower extremity and

(ii) having a leading surface forward thereof relative to the normal direction of travel of the frame over the soil layer,

(iii) said closing tool being aligned in said direction with respect to said lower extremity so that it engages soil adjacent said slot

(iv) to dislodge the soil to partly close the slot and

(v) provide a seed bed onto which seed leaving said lower extremity is delivered:

(G) a first mounting means

(i) to attach the tube and closing tool to the frame

(ii) to permit height adjustment of the tube and the closing tool with respect to the frame:

(H) ground engaging means

(i) operatively associated with the tube and closing tool

(ii) to engage the soil layer to cause said height adjustment and

(D1) a second mounting means,

(i) which is adjustable

(ii) for adjustably attaching the ground engaging means to the tube and closing tool

(iii) thereby enabling said ground engaging means to effect said height adjustment.

26. The scope of the proposed claim 1 will be limited therefore by the introduction of the integers of the original claim 13 into claim 1, as well as the dependant claims 2-12.

27. After amendment the proposed new claim 13 can be divided into the following integers.

"In combination,

(Al) a plough tine having a lower extremity to which there is attached a digging blade,

(A2) a fertilizer tube and

(A3) a seeding assembly to be used with a plough frame supporting at least the plough tine, said assembly comprising:

(A) a seeding tube

(I) to extend downwardly into a slot formed in a soil layer by
the tine,

(ii) said tube having a lower extremity through which seed is delivered into the soil layer;

(B) a closing tool

(i) fixed with respect to said lower extremity and

(ii) having a leading surface forward thereof relative to the normal direction of travel of the frame over the soil layer,

(iii) said closing too! being aligned in said direction with respect to said lower extremity so that it engages soil adjacent said slot

(iv) to dislodge the soil to partly close the slot and

(v) provide a seed bed onto which seed leaving said lower extremity is delivered;

(C) a first mounting means

(i) to attach the tube and closing tool to the frame

(ii) to permit height adjustment of the tube and the closing tool with respect to the frame;

(iii) wherein said first mounting means is adapted to be attached to the tine in order to be attached to the frame;

(D) ground engaging means

(i) operatively associated with the tube and closing tool

(ii) to engage the soil layer to cause said height adjustment:

(DA1) wherein the digging blade, fertilizer tube, closing tool, seeding tube and ground engaging means are aligned in that order in the intended direction of travel;

(DA2) wherein said digging blade, closing tool and ground engaging means each have an operative width,

(i) with the operative width of said digging blade being narrower than the operative width of said closing tool and
(ii) with the operative width of said closing tool being narrower than the operative width of said ground engaging means;

(D1) a second mounting means,

(i) which is adjustable
(ii) for adjustably attaching the ground engaging means to the tube and closing tool

(iii) thereby enabling said ground engaging means to effect said height adjustment; and

(D2) wherein the seeding assembly is directly attached to the tine,

(i) so as to be movable relative thereto
(ii) to provide said height adjustment.

28. The respondents have raised various grounds of opposition to the application for amendment. These are:

a) the applicant's alleged culpable delay in applying for the amendment;

b) the continued invalidity of the patent should the amendment be allowed;

c) the amendments seek to introduce new matter or matter not in substance disclosed in the specification before amendment contrary to section 51 (6)(a) of the Act, and

d) the applicant's alleged reprehensible conduct in seeking to enforce the patent whilst aware of the invalidity thereof and in the absence of

an application to amend the specification of the patent.

29. Besides that they have raised various preliminary issues that can be considered and determined at the outset.

30. As mentioned, the application originally sought not only an order amending the specification but also orders restraining the respondents from infringing the patent, an inquiry into damages and the delivering up of the offending seeding assemblies.

31. In its heads of argument Ausplow opted to narrow the relief sought to the application for an amendment and requested that the issue of the alleged infringement of claim 1 and 13 (as amended) be referred to trial. The respondents counter that the applicant is in any event non-suited in respect of the infringement because the relief sought is premature.

32. Ausplow justifies its changed stance in relation to the infringement issue on the basis that it only became aware of the possible infringement of the patent by the *Voorplanter Mark 2* when Northpark filed its answering affidavit, and also the fact that the *Voorplanter Mark 1* has not been manufactured since March 2008. It accepted that it is no longer appropriate to seek an interdict and an order for delivering-up. It submitted that it is sensible for the issue of infringement by the *Voorplanter Mark 2,* which was not subject to examination in the original trial, to be referred to trial and adjudicated upon in such proceedings. It concedes that motion proceedings are not appropriate to resolve the disputed issues.

33. The respondents raised the foreseeability of the disputed facts in relation to the infringement issue and an alleged consequent abuse of process as the basis for dismissing the application for an interdict. There was no finding of infringement of old claim 13 by either the court *a quo,* or the Supreme Court of Appeal, in the previous action. The inevitability of a dispute of fact as to whether the proposed new claim (incorporating old claim 13) is infringed by the *Voorplanter Mark 1* was thus clearly foreseeable. There is merit

in that submission.

34.However, in my view, the issue should be determined on a different basis. As explained earlier, paragraph 2 of the order of the Supreme Court of Appeal revoked the patent but in terms of paragraph 3 of the order it did so provisionally. The respondents have submitted, correctly in my view, that until such time as the amendment is allowed, and the provisional revocation discharged, no rights exist under the patent which would permit fresh infringement proceedings in respect of the patent as sought to be amended. It helps not to argue, on the basis of the Supreme Court of Appeal's reference to section 68, that the revocation was suspended or postponed. The substance of the order makes it plain that it is a provisional order of revocation. Such orders have been made in the past in terms of section 61(3). In the present instance the order appears to have been made in terms of the inherent jurisdiction of the Supreme Court of Appeal. Considering that the jurisdictional pre-requisites for an order in terms of section 68 were not present, and having regard to the terms of the order itself, it is best to regard the reference to section 68 in the judgment of Nugent JA as *per errorem et incuriam.* The learned judge of appeal clearly did not intend to postpone or suspend the revocation. His intention was to revoke the patent, albeit only provisionally, and to allow the lower court to confirm or discharge the provisional order. That being the case, the patent was invalid from the date of the order of the Supreme Court of Appeal and would remain so until validated by the discharge of the provisional order by the lower court granting the amendment. A provisional revocation order is akin to an interim interdict or a provisional sequestration order, which is of full force and effect and is operative until discharged. Accordingly, the respondents submitted, no infringement proceedings could be Instituted on the patent until amended. I agree. I differ with the respondents about whether such a finding should lead to the dismissal of the infringement application. Without question the issue was not ripe for trial. But Ausplow fails not on a point which goes to the merits of the infringement dispute. The appropriate relief should be a decree of absolution from the instance on the

ground that the patent allegedly infringed had been provisionally revoked.

35. The respondents raise another point also arising from the peculiar scope and nature of the order of the Supreme Court of Appeal. Paragraph 3 of the order by implication grants Ausplow leave to file notice of an application to amend the patent. The order is silent regarding the authority or person to whom the application for amendment should be made. It is evident though from the terms of the order that the decision to make the provisional order "fully operative" or final is a matter for the body to whom the application to amend the patent is made or is to be made.

36. Section 51 of the Act provides that an application for amendment to a patent specification should be made in the first instance to the Registrar of Patents. In terms of section 51(3) when an application for amendment is opposed the application shall be referred to court to be dealt with by the commissioner who shall determine whether and on what conditions the amendment ought to be allowed. Section 51(9) permits an exception to this procedure. It provides that 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.

37. Ausplow did not make application for amendment of the patent to the Registrar in terms of section 51(1). It launched the proceedings directly in this court. The respondents have submitted that at the time the application was launched, there were no proceedings pending before any court as envisaged in section 51(9). They contend that the previous proceedings for infringement were brought to finality by the Supreme Court of Appeal and hence it cannot be argued that those proceedings are still pending, and there is accordingly no basis for the procedure followed by Ausplow.

38. Ausplow has responded that because the order of the Supreme Court of Appeal expressly stipulated that "it shall be decided at the hearing of such application whether or not the revocation order is to be put into operation", it had to institute the application in this

court. This would seem to be correct. The Registrar of Patents does not have jurisdiction to put a revocation order made by the Supreme Court of Appeal into effect. The determination of whether the patent should be revoked finally is a question that is undecided and awaiting decision. That proceeding relating to the patent is accordingly pending. And thus the procedure in section 51(9) is appropriate. While the previous infringement action and the counterclaim for revocation on the grounds of anticipation were finally decided by the Supreme Court of Appeal, the counterclaim for revocation on the grounds of obviousness was not. The final determination of that issue was left pending, subject to the determination of an appropriate application for amendment to cure the lack of inventiveness. Accordingly, there is no merit in the preliminary point.

39. The application therefore should be determined in terms of section 51(9) of the Act, which Ausplow argues does not allow for consideration of questions of validity beyond those referred to in section 51. Section 51(9) provides that the court may deal with the application for amendment "as it thinks fit" but subject to the provisions of subsections (5), (6) and (7). Subsection (5) deals with the amendment of a provisional specification and is accordingly not applicable in this case. The other subsections provide that no amendment shall be allowed if the effect of the amendment would be to introduce new matter or matter not in substance disclosed in the specification before amendment; the specification as amended would include any claim not fairly based on matter disclosed in the specification before amendment; or the specification as amended would include any claim not wholly within the scope of a claim included in the specification before amendment.

40. In *Deton Engineering (Pty) Ltd and Another v JP Mckelvey and Others* 1997 BIP 113 (C), van Dijkhorst J commented on the discretion of the Commissioner when considering amendments. He said (at 117A):

> "It is evident that the Commissioner, when deciding

> whether to grant or refuse an amendment, will have regard to the efficacy of the amendment. Where an amendment would obviously serve no purpose as it would not prune the dead branch from the otherwise healthy tree it should not be granted. The commissioner will not participate in an exercise in futility."

These *dicta* are predicated upon "strong authority" for the proposition that any ground for revocation of the patent may be advanced in opposition to a proposed amendment of the patent. Thus, in *Bendz Ltd and Another v South African Lead Works Ltd* 1963 BP 409 (A) at 412 B-C the then Appellate Division stated:

> "No purpose can in any event be served by amending a patent which, as will appear later, will even after amendment be subject to revocation."

The same point was made more fully in *Water Renovation (Pty) Ltd v Gold Fields of South Africa Ltd* 1993 BP 493 (A) at 502 B-D as follows:

> "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 an alleged invalidity), and whether the patent after amendment would be otherwise valid."

41. However, in *Deton Engineering* van Dijkhorst J saw advantage in departing from this general approach in exceptional cases. In this regard he said (at 117H-118A):

> "Obviously the formal requirements have to be complied with and the absence of compliance therewith may be raised as an objection, but the absence of a reference in section 51(6) to the normal grounds for revocation of a patent lends weight to the view that it was not intended that a full scale revocation hearing would replace relatively simple amendment proceedings."

He went on immediately to qualify this view by saying:

> "However that may be, in terms of the Appellate Division authority a respondent is entitled to join battle on fronts much wider than that part of the specification covered by the amendment."

In that case, unlike the present, there were proceedings pending in another forum in which the validity of the patent had been attacked. The learned judge was reluctant to "tangentially multiply the issues" and accordingly ruled that the issues of continuing invalidity, lack of novelty etc., raised by the respondents as defences to the application for amendment should be heard and decided in the separate revocation proceedings which were pending between the parties.

42. Mr Ginsberg SC, on behalf of Ausplow, urged me to adopt a similar approach. In my opinion, it would be folly to do so. The aim of the Supreme Court of Appeal when it made the provisional order of revocation was to stay the final order in order to afford Ausplow a last opportunity to remove the invalidity on grounds of obviousness by means of amendment. The rationale of the Supreme Court of Appeal's order is for this court to conduct an enquiry into whether after any proposed amendment, and after evaluating the amended invention against the prior art, there will be any difference. Should there be no difference there will be no subject matter; and likewise if there is a difference which calls for no inventive ingenuity to bring it about, then also there will be no subject matter or inventive step. The process mandated by the Supreme Court of Appeal by necessity requires an assessment of whether the want of subject matter can be cured by the proposed amendments. To that extent it is notably different from the situation that pertained in *Deton Engineering*.

43. The respondents do not challenge the novelty of the new claims. The challenge of continued invalidity is that proposed new claim 1 remains invalid for want of inventive ingenuity and that the

amendment should be disallowed principally for that reason. Other grounds of invalidity raised by the respondents are that the invention cannot be performed or does not lead to results and advantages set out in the specification (section 61(1)(d)); and that the claims are not clear or fairly based on the matter disclosed in the specification (section 61(1)(f)).

44. The question has arisen regarding the sufficiency of the evidence before the court for the purpose of determining the issue of obviousness. Ausplow initially suggested that the expert evidence in the earlier proceedings could be relied upon. The respondents countered that such evidence would be inadmissible hearsay. In argument before me Mr Ginsburg submitted that the evidentiary issues alone justified granting the amendment and avoiding the revocation issues which would better be left for trial in infringement proceedings.

45. The fourfold investigation into obviousness requires determination of the inventive step said to be involved; what the state of the art relevant to the step was; in what respect the step goes beyond or differs from the state of the art; and whether, having regard to such development or difference, the taking of the step would be obvious to the skilled man. The technical evidence of expert witnesses is admissible with regard to the first three matters but is inadmissible in respect of the fourth - *Schlumberger Logelco Inc v Coflexip* 2003 (1) SA 16 (SCA). The role of the expert was succinctly explained in the English case *British Celanese Ltd v Courtalds* /.ft* (1935) 52 RPC 171, as follows:

> "He is not entitled to say nor is counsel entitled to ask him what specification means, nor does the question become any more admissible if it takes the form of asking him what it means to him as an engineer or chemist- Nor is he entitled to say whether any given step or alteration is obvious, that being a question for the court."

46. Southwood J, in the earlier action, after finding that most of the expert evidence was inadmissible, concluded (in paragraph 60) that

the essential evidence in respect of obviousness is common cause. Nugent JA, on appeal, (in paragraph 13), remarked:

> "Though expert evidence might be necessary in some cases - at least to educate a court in the technology involved - that will not always be so."

Similarly, I am unpersuaded that additional expert evidence is required for present purposes.

47. It will be recalled that the Supreme Court of Appeal, having had regard to the background to and object of the invention as recorded in the specification, held "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". In the summary of the invention (and claim 1) the seeding assembly is defined to comprise a seeding tube; a closing tool; mounting means to attach the tube and closing tool to the frame to permit height adjustment; and ground engaging means operatively associated with the tine and closing tool to engage the soil layer to cause the height adjustment. The seeding assembly is thus separate from, and, in terms of the summary of invention and claim 1, is "to be used with a plough frame supporting at least one plough tine". Thus, as Nugent JA saw it, the claimed invention was the linkage of the assembly and tine in such a way that the assembly is able to move in a vertical plane so as to follow the profile of the soil. That capacity provides the means to overcome the "difficulty in penetrating soil deeply whilst at the same time maintaining accurate placement of seed and fertilizer", which difficulty is caused by undulating ground conditions making it difficult to maintain seed depth, resulting in seed and fertiliser being placed together on a hard impenetrable barrier causing poor seed germination, loss of plant vigour, low yields, poor water infiltration, waterlogging, fertiliser toxicity and greater incidence of disease.

48. As explained earlier, the court *a quo* considered the

combination of the various components of the assembly (including the mounting means and ground engaging means allowing height adjustment relative to the frame) to be the inventive step. The court held that the combination of the integers of the invention was different from any in the prior art. The inventiveness of the invention thus was seen to be "the combination of the various means together with the dedicated closing tool fixed to the lower extremity of the seeding tube whose location, size and shape enables it to engage and dislodge the soil adjacent the slot to partly close the slot and provide a seed bed onto which the seed is delivered", (paragraph 72).

49. Although Nugent JA did not explain in what respects he considered that Southwood J may have erred, his interpretation of the Dreyer specification left him in no doubt that the claimed invention did not involve an inventive step going beyond or differing from the state of the prior art. The relevant passage of the *Summary of the Invention* in the Dreyer patent reads:

> "The object of the present invention is to attain a reliably separated deposit of two materials, such as seed and fertilizer, even in heavy soils and especially in zero tillage.
> This object is attained in accordance with the invention in that an expansion structure that extends down into the furrow is positioned in the vicinity of the rear outiet of each sowing share, in that the expansion structure is at least somewhat wider than the ripping structure, and in that the bottom end of the expansion structure is higher than the bottom of the point of the ripping structure. The expansion structure on the sowing share between the forward and rear outlet ensures that the material deposited in the furrow through the first outlet will be covered with soil in such a way that the fertilizer and seed will be separated by a layer of soil even when the soil is very heavy or a lot of soil is thrown up. The expansion structure always pushes at least a little soil ahead, forcing it over the material deposited in the furrow from the first outlet. The material coming from the rear outlet on the sowing share will then always fall

on top of the soil covering the first material."

50. The passage can be read together with the following paragraph in the *Background of the Invention:*

> "A seed drill of this type is known from US Pat No 4,417,530 and from German OS No 3 216 375. The sowing share of this seed drill, which is intended for zero tillage, draws a V-shaped furrow in the uncultivated soil. The initial material, either seed or fertilizer is deposited in the base of the furrow in the narrow cross-section at the point of the V. Once the material has been deposited, the expelled soil flows back into the furrow and covers the material. The second material is then deposited in a ribbon or in two rows in the soil that has flowed back into the furrow. Finally, the soil in the furrow and hence the seed and fertilizer is packed down with a smooth pressure roller."

From the perspective of the Dreyer patent, the disadvantage of the prior art was stated to be:

> "The drawback to this machine is that it is impossible to pack the material initially deposited in the furrow tightly enough against the soil or to pack down the soil in the furrow firmly enough in the vicinity of the seed. Furthermore, it is impossible, especially if the soil is heavy, to ensure satisfactory separation of the two materials because the soil does not flow back into the furrow fast enough, so that either very little soil separates them or they are deposited together."

51. These extracts from the Dreyer specification make it clear that the object of the Dreyer invention was to place seed and fertiliser separately and accurately to avoid poor seed germination. It is furthermore evident from other parts of the specification that the components of the assembly attached to the frame are organised separately along the direction of travel, with the tine (sowing share/ripping structure) being narrower than the closing tool (expansion structure) to engage the soil. Although the Supreme Court of Appeal made no specific finding, contrary to the finding of

Southwood J, that the "unique" combination and arrangement of the assembly components was part of the prior art disclosed in Dreyer, one can safely assume it was of that opinion, albeit for reasons not entirely certain.

52. The judgment makes it plain that integer (A)(i) of claim 1 did not constitute an inventive step. As appears from the passages of the judgment cited above, Nugent JA considered that because the specification is silent as to any benefits that are to be achieved by extending the outlet of the seeding tube into the slot, it added nothing (was immaterial) to achieving the proclaimed object of the invention, namely the vertical plane movement of the assembly relative to the tine to follow the profile of the soil and thereby overcome the difficulty caused by the undulating ground. However, what the judgment neglects to do is to explain why the linking of the seeding assembly to the tine in a way that the assembly was capable of moving in a vertical plane to follow the profile of the soil was not inventive. Clearly, as I have just said, the court of appeal did not consider it to be inventive, but it did not state in what respects this step did not go beyond or differ from the state of the art or would be obvious to the skilled man acquainted with the prior state of the art.

53. In the *Detailed Descriptions of the Preferred Embodiments* (column 6 and 7) of the Dreyer specification we find the following:

> "Sowing shares 1 in the form of chisel shares are mounted in such a way that they can move in a vertical plane on parallelogram mount 2 on the frame 3 of a seed drill. Each parailelogram mount 2 has an upper strut 4 and a lower strut 5 articulated at the front to frame 3 and supporting a share holder 6 at the rear. Behind sowing share 1 is a *depth-guide* or pressure roller 7. Roller 7 determines how deep the share can penetrate soil 8. Parallelogram mount 2 is also attached to central controls 9 for varying the depth of penetration of share 1. Upper strut 4 is mounted on a pivoting lever 10 that can be pivoted by means of spindle 11. The movement

> of pivoting lever 10 pivots upper strut 4 and hence share holder 6, varying the position of roller 7 in relation to showing share 1 in order to set different depths of penetration,"

Further in the description it is stated:

> "The roller 7 illustrated in Figs 1 and 2 is positioned behind sowing share 1 and has a wide bearing surface 35 that rolls along soil 8 above and between furrows 32. Roller 7 accordingly determines how deep sowing share 1 penetrates into the soil and hence the depth of the furrow 32."

If we substitute the words "tine" for "a sowing share", "mounting means" for "parallelogram mounts"; and "ground engaging means" for "roller", the means for moving the assembly in a vertical plane to vary depth of penetration to obtain uniformity of seed and fertiliser position in undulating ground conditions would seem to be exhibited in the Dreyer patent. Hence, the inventive step in the Ausplow patent, as identified by Nugent JA, does not go beyond or differ from that which already existed in the prior state of the art. Alternatively, any variation of the means by the patent in suit may have been obvious to the skilled person versed in the art. Why that would be so is not stated in the judgment. Accordingly, given the lack of certainty, it is perhaps best to assume that the court of appeal considered there to be no difference and therefore no subject matter.

54. As explained earlier, the proposed amendments seek to amend claim 1 by adding an additional integer, taken from the original claim 13, thereby limiting the scope of the claim to include a second mounting means. Thus integer G will provide:

> "a first mounting means
>
> (i) to attach the tube and closing tool to the frame
> (ii) to permit height adjustment of the tube and the

closing tool with respect
to the frame."

Integer (D1) will provide:

"a second mounting means,

(i) which is adjustable
(ii) for adjustably attaching the ground engaging means to the tube and closing tool
(iii) thereby enabling said ground engaging means to effect said height adjustment-"

Original claim 1 (integer (C)) referred only to "mounting means" to attach the tube and closing tool *to the frame* to permit height adjustment relative to the frame. That function would now be performed by a *first* mounting means. The second mounting means would be for adjustably attaching the ground engaging means (the roller in Dreyer) *to the tube and closing tool* enabling the ground engaging means to effect the height adjustment. Both before and after amendment (integer (D)(i) of old claim 1 and integer (H) of amended claim 1), the ground engaging means are operatively associated with the tube and closing tool to engage the soil layer to cause said height adjustment.

55. New claim 13 combines a tine (to which is attached a digging blade), a fertiliser tube and a seeding assembly (a seeding tube, closing tool, first mounting means, ground engaging means and secondary mounting means). Integer (DA1) provides for the digging blade, fertiliser tube, closing tool, seeding tube and ground engaging means to be aligned in that order in the intended direction of travel; while integer (DA2) provides for the digging blade, closing tool and ground engaging means to have an operative width narrower than the tool behind. Integer (D2) provides for the seeding assembly to be directly attached to the tine so as to be movable relative thereto to provide the said height adjustment.

56. In support of its assertion that new claims 1 and 13 are inventive over prior art planters or seeding assemblies, Ausplow reiterated the

deficiencies of the prior art. In particular it mentioned the following:

"a) The failure to create a deep root bed;
b)The failure to create a compacted seed bed directly above the root bed;
c) The failure to create the seed bed at a relatively constant depth;
d)The failure to effect precision placement of the seed on the seed bed directly above the root bed;
e) The failure to effect closing of the seed with soil of a relatively constant depth;
f) The failure to compact the soil around the seed;
g)The failure to allow for independence in the working depth of the tine and the depth at which the seed is placed;
h) The failure to allow adjustment of the seeding depth independently from the working depth of the tine;
i) Having broad faced working tools which increase drag and caused wide and unnecessary soil disruption; and
j) The failure to create a deep root bed, a seed bed, the precision placement of seed and the closing of the seed with soil which is compacted around the seed, at a relatively constant depth in a single operation."

With regard to new claim 13, Ausplow pointed to the following shortcomings evident in prior art planters:

"a) The failure to cause the breakup of a deep hard pan soil layer in the soil at an independent depth from the operative depth of the seeding assembly;
b)The failure to effectively separate fertilizer in the root bed from seed which is placed vertically and directly above the fertilizer;
c) The failure to ensure effective and constant closing of the root bed followed by effective and constant closing of the seed; and
d) The failure to align all working implements (digging blade, closing tool and wheel) and fertilizer and seed exits directly behind one another."

57. Ausplow contended that new claim 1 is inventive over the prior

art because of integers (A)(i) and (D1). By (A)(i) I take it to mean amended (E)(i), being the integer providing for a seeding tube to extend downwardly into a slot formed in a soil layer by the tine. (D1) is the integer providing an adjustable second mounting means for attaching the ground engaging means to the tube and closing tool to effect the height adjustment. These, Ausplow submits, address the failure of the prior art to ensure consistent and precision placement of seed on a compacted seed bed, at a controlled and adjustable depth and to ensure direct vertical separation between fertiliser in the root bed and the seed. It also claimed that the prior art planters failed to consistently close the slot and to compact the seed to ensure planting at a controlled and even depth with proper physical contact between the seed and the soil. Precision placement is achieved through the seeding tube extending into the slot (integer (A(i)) and by ensuring that planting depth can be set independently from the working height of the frame and the working depth of the tine and the depth of the root bed. Independent working and seeding depth adjustments, it maintains, are achieved through the combination of the first mounting means and the second mounting means, with the first mounting means ensuring that the closing tool forming the seed bed moves independently from the frame and the tine, as it follows the ground contour as a result of the operatively associated ground engaging means moving over the ground causing height adjustment of the closing tool; while the second mounting means attaching the closing tool to the ground engaging means allows the adjustment of the working depth of the closing tool and hence the planting depth.

58. The inventiveness of claim 13, Ausplow maintains, is found partly in the order of operation. The components (digging blade, fertiliser tube and seeding assembly) are aligned in the order of direction ensuring that the slot and root bed are formed first by the tine and digging blade, that fertiliser is deposited into the slot and root bed before the seed bed is created to separate the fertiliser and the seed which is placed onto the seed bed and for the ground engaging means to close the seed and to compact soil around the seed. This order of operation results in the vertical arrangement

with the root bed and fertiliser directly below the seed bed and the seed being covered with soil compacted around it. The operative width of the implements arranged as they are ensures effective dislodging and compacting of the soil. In my opinion, the order of operation and the operative width of the implements are features that are disclosed in the description of the invention in Dreyer. There is nothing inventive in the arrangement in the Ausplow patent. Therefore, the fact that the assembly is directly attached to the tine (the means by which this is done is not evident, because the first mounting means attaches the assembly to *the frame)* with the supposed advantage of allowing constant and automatic variations in the working depth of the tine at which the seed bed is created by the closing tool, the depth at which the seed is placed from the seeding tube, and the depth of the soil which is used to cover the seed by the ground engaging means, may be the most relevant aspect pointing to a step beyond the prior art.

59. In other words, the inventive step claimed remains the combination allowing for a single, once-through operation which creates a seed bed at a relatively constant depth as a result of the height adjustment action and allows for the precision placement of seed on the seed bed directly above the root bed as a result of the seeding tube extending below the soil level and into the slot created by the tine. Ausplow argues that this inventive step goes beyond the Dreyer invention (being the only prior art planter remaining in contention) because Dreyer did not disclose integer (A)(i) of old claim 1 or D1 of new claim 1. It is also alleged that Dreyer does not disclose integers (A1) (digging blade), (A)(i) (a seeding tube extending downwardly into the slot), (DA1) (the order of alignment), (DA2) (the operative width), (D1) and (D2) (the second mounting means and attachment to the tine) of new claim 13.

60. The respondents contend that new claims 1 and 13 do not overcome the prior art in the Dreyer patent if the claims are construed properly and compared with the impact and disclosure of the prior art. The respondents make the important point that many

of the advantages Ausplow claims the invention has over the prior art are not referred to in the specification. Thus there is no reference to precision placement of seeds, the consistent closing of the slot, the compacting of the seed to ensure planting at a controlled and even depth, the extending of the seeding tube into the slot to avoid dispersement and the decreasing of drag by use of better implements. To read these advantages into the specification would be to introduce new matter not in substance disclosed in the specification before amendment. Additionally, and decisively, the benefit of integer (A(i)) was found by the Supreme Court of Appeal to be immaterial to the object of the invention. Moreover, as I have said, the passages of the *Summary of the Invention* and the *Background of the Invention* (cited in paragraphs 49 and 50) above describe an operation that exhibits an order of operation and arrangement of implements in accordance with their operative width that defeats any claim to uniqueness on that score.

61. The integer related to the second mounting means, attaching the closing too! to the ground engaging means allowing for the adjustment of the working depth of the closing tool and hence the planting depth, is therefore key to the inventive step claimed by Ausplow. It is reflected in the second embodiment of the invention shown in Figures 2-9 of the specification. It is discussed in the specification at pages 4-5 as follows:

> "The seeding assembly 20 includes a central bracket 51 to which there is a fixed seeding tube 52 having a lower end 73 through which the seed is delivered to a prepared seed bed 72. Pivotally attached to the centre bracket 51 is a parallelogram mechanism including two pairs of parallel linkages 53 and 54 (the first mounting means). The forward end of the linkages 53 and 54 are pivotally attached to the tine 21 by means of pivot point 55. The rear portions of the linkages 53 and 54 are pivotally attached to the centre bracket by pivot pin 56.....
>
> The seeding assembly 20 includes a wheel assembly 60 having a pair of trailing arms 61 having their forward ends pivotally attached to the centre bracket 51 by

> means of a pivot pin 62. The wheel assembly 60 includes a wheel 63 which preferably has a rubber surface, and may be inflatable (ground engaging means). One or more braces 64 extend between the trailing arms 61 and the centre bracket 52 (second mounting means) to locate the wheel 63 at the desired height relative to the seed bed" - *(the words in parentheses are supplied by me)*
>
> It appears from the drawings and the explanation of the embodiment that the closing tool is attached to the seeding tube which is attached to the centre bracket to which two mounting means are attached.

62. The respondents argue that integer (D1) of the proposed new claim 1 providing for a second mounting means for attaching the ground engaging means to the tube and closing tool to enable height adjustment by the ground engaging means does not add to the inventiveness of claim 1 or overcome the lack of inventiveness of claim 1 as determined by the Supreme Court of Appeal. They say that when reference is had to column 6 and 7 of the *Detailed Descriptions of the Preferred Embodiments* of the Dreyer patent (cited above), this integer is obvious and clearly disclosed, in that the roller 7 (the ground engaging means) is adjustably mounted relative to the sowing share 1 (tine) to allow the roller to be set at different vertical positions relative to the showing share, thereby to determine how deep the sowing share penetrates into the soil, and hence the depth of the furrow (the slot). In my opinion, this aspect alone does not defeat the inventiveness of integer (D1) because the latter is not aimed only at the depth of the slot caused by the furrow. Integer (D1) allows for the ground engaging means to adjust the operating height of the closing tool for the purpose of forming the seed bed and hence the planting depth to ensure an effective separation of the seed bed from the root bed into which the fertiliser is placed. However, the Dreyer invention achieves the vertical adjustment of the closing tool, and thus planting depth in appropriate alignment with the land contour, by other but similar means. Mr van der Westhuizen, for the respondents, pointed out that the Dreyer patent discloses the "second mounting means" in the

form of pivoting lever 10 which adjusts the height of the sowing share (tine). As the sowing share is integrally formed with its seeding tube and closing tool (expansion structure), the roller (ground engaging means) is inherently vertically adjustable relative to the closing tool as well. It follows that because such was disclosed in the Dreyer prior art, integer (D1) is not a step forward and hence lacks inventiveness. The only inventive feature in amended claim 1 would be integer (E)(i), integer (A)(i) in old claim 1, which provides for the seeding tube to extend downwardly into the slot. The Supreme Court of Appeal, as explained more than once, ruled unequivocally that this did not constitute an inventive step because it was immaterial or not essential to achieving the proclaimed object of the invention and was not in any event disclosed in the specification.

63. In paragraph 15 of the Supreme Court of Appeal judgment, Nugent JA outlined that the inventive step sought by the patent in suit lay in linking the seeding assembly to the *tine* in such a way that the assembly is capable of moving in a vertical plane relative to the tine. Integer G of proposed claim 1 provides a first mounting means to attach the assembly to the *frame* to permit height adjustment with respect to the frame. When the closing tool and the tine are integrally formed, as in the Dreyer patent, vertical adjustment of the closing tool relative to the frame does not necessarily imply automatic vertical adjustment relative to the tine. Accordingly, the inventive step identified by the Supreme Court of Appeal is not embodied in the proposed new claim 1.

64. Ausplow has emphasised that the planting depth can be set independently from the working depth of the tine and stated in its founding affidavit that the first mounting means ensure that the closing tool forming the seed bed moves independently from the frame and the tine. However, as just explained, the amended claim 1 does not include in integer G height adjustment of the assembly relative to the tine. Thus, there would be continued invalidity in terms of section 61 (1)(d) of the Act because the invention as illustrated or exemplified in the complete specification does not

lead to the results and advantages set out in the specification.

65. In the result, therefore, the amendments ought not to be granted because they would not remedy the continued invalidity of claim 1.

66. Having reached that conclusion, principally on the grounds of continued invalidity for want of subject matter, I do not consider it necessary to determine the other objections raised by the respondent, namely: invalidity on grounds of lack of clarity in terms of section 61(1)(f)(i); a lack of fair basis in terms of section 61(1){f)(ii); culpable delay; and reprehensible conduct. Suffice it to say in regard to the lack of clarity that I share the scepticism of the respondents about whether proposed new claims 1 and 13 are sufficiently clear as to how the second mounting means enable the ground engaging means to effect height adjustment of the tine. Added to that is the problem that the specification makes no reference to a "first mounting means" or a "second mounting means", nor are these specifically identified or exemplified in the drawings as linked to any other components. There is accordingly merit in the argument that the claims are not fairly based on the matter disclosed in the specification.

67. Much time was spent in argument on Ausplow's application for condonation for the late filing of its replying affidavit and supplementary replying affidavit. The time delays (if a rule 6 procedure is followed) were not insubstantial. Ausplow's explanation for the delays, being that there were logistical problems arising from the fact the applicant is based in Australia, the documentation was voluminous and difficulties associated with the attempts to inspect the *Voorplanter Mark* 2, are not particularly compelling. However, I do agree that the late filings do not appear to have caused any material inconvenience to the respondents, nor have the respondents made out a cogent case that they were prejudiced in any significant or consequential way. Having regard also to the ultimate result, there can be no injustice resulting from the grant of condonation. Considering the somewhat thin grounds upon which condonation was sought, as well as the degree of

lateness (13 weeks), I am not inclined to award the applicant its costs in the application for condonation.

68. The respondents have asked for a costs order on an attorney and own client scale principally because of the prolixity of the record resulting from the needless inclusion of the appeal record, the transcript of the argument in the joinder application and evidence from the earlier action proceedings to which limited reference was made. I am not persuaded such an order should be granted. The parties have been involved throughout in some way. Little or no prejudice could have resulted from the inclusion of the documents which may have proved of assistance to the court, which was directed appropriately through the heads of argument to that which was relevant.

69. The following orders are issued:

a) The application for condonation of the late filing of the replying affidavit and the supplementary replying affidavit is granted.

b) The respondents are granted absolution from the instance in respect of prayers 2, 3, 4 and 5 of the notice of motion.

c) The application to amend the specification of South African Patent No 95/0812 is dismissed.

d) The provisional order of the Supreme Court of Appeal in *Northpark Trading 3 (Pty) Ltd v Ausplow (Pty) Ltd* (Case no 278/07 [2008]
ZASCA 46 (31 March 2008) is confirmed and South African Patent No 95/0812 is finally revoked.

e) The applicant is ordered to pay the costs of the respondents in respect of the application in its entirety, such costs to include the costs of employing two counsel.

f) There is no order as to costs in respect of the application for condonation.

JR MURPHY
JUDGE OF THE HIGH COURT

Date Heard:2 & 3 December 2009
For the ApplicantAdv P Ginsberg SC, Adv DR Harms, Johannesburg Instructed By: Adams & Adams, Pretoria

For the Respondent: Adv C van der Westhuizen SC, Adv RD Engela, Pretoria Instructed By:Dr Gernholtz Inc., Pretoria