

ADA

Provincial Division).
Provisiale Afdeling).

POWER STEEL CONSTRUCTION CO (Pty) LTD. Appellant,

versus

Am. & British ^{versus} (INSTRUCTION (774)) LTD Respondent.

Respondent's Attorney

Prokureur vir Respondent

Respondent's Advocate

Advokaat vir Respondent

Op die rol geplaas vir verhoor op

Monday - Tuesday

23-24/5/55

1, 2, 3, 4, 5

— 12.45 — 12.50,

2.13 - 4.0
Tuesday, 24/5/55

$$\begin{array}{r} 9.45 - 12.50 \\ 2.15 - 3.55 \end{array}$$

5.15 - 3.55 - CAV

Appendix.

Appeal allowed, - judgment of the
I.P.D. set aside and the decision of the Com-
missioner of Patents, restored, - The 12 of 1. to
pay the costs occasioned in both branches
of the Supreme Court.

*Hoffman, C. Schreiner
and others, Hinton & Taylor*

Shelton
Ripston

Originals

IN THE SUPREME COURT OF SOUTH AFRICA

(APPELLATE DIVISION).

In the matter between:-

POWER STEEL CONSTRUCTION
COMPANY (PROPRIETARY) LIMITED
Appellant

and

AFRICAN BATIGNOLLES CONSTRUCTIONS
(PROPRIETARY) LIMITED.
Respondent

Coram:- Centlivres, C.J., Schreiner, van den Heever,
Hoexter et Fagan, JJ.A.

Heard:- 23rd May, 1955.

Delivered:-

8 / 9 / 1955.

VAN DEN HEEVER, J.A.

J U D G M E N T

Respondent Company is the proprietor
of two unexpired patents, Nos. 9323 and 10802, the second
being a patent of addition. Both are entitled "An
improved method of, and means for casting in situ concrete
structures, particularly reinforced concrete cooling towers".
Both patents were granted under the provisions of Act
9 of 1916. In the complete specification of the main
patent both method and means are set out in great detail
and illustrated by drawings. Having "particularly described
and ascertained the nature of our said invention, and in what
2/ manner

manner it is to be performed" the patentee proceeds
 and claim 21
 to make 22 claims. The first five claims₄ are method
 claims. Of these the first and widest claim asks for
 protection for a method of casting in situ concrete structures,
 particularly reinforced concrete cooling towers,
 characterised in that the method involves seven steps.
 The other four method claims contain subordinate integers
 of the method.

Claim 6 opens the "means" claims and
 is prefaced by the phrase "For carrying out the method
claimed in any of the preceding claims, means comprising
". All the subordinate "means" claims
 save No. 22 are integrated by reference directly or indirectly
 with ~~the~~ No. 6. Claim 22 reads:-

"Means for use in casting in situ concrete structures,
 particularly reinforced concrete cooling towers,
 constructed, arranged and adapted to be used or to
 operate, substantially as described and illustrated
 in the accompanying drawings."

One of the "means" claimed - I
 do not at present consider the scope of the claim -

is a hoist-tower carrying a radial arm adjustable as to length and height and chutes for depositing concrete on the structure being built. [Patent No. 10892 purports to disclose "an improvement in or modification of the invention set forth in our patent No. 9323". The first claim reads:-

"An improvement in or modification of our invention set forth in our patent No. 9323 comprising in combination, a tower which is adapted to be heightened at will, e.g. by making additions to the top thereof etc etc."

The 12th claim reads:-

"An improvement in or modification of the invention set forth in our patent No. 9323, constructed, arranged and adapted to be used substantially as herein described and illustrated in the accompanying drawing."

Appellant company averred that it had invented a method of constructing cooling towers and had designed equipment for that purpose. Disclosing the nature of its alleged invention it called upon respondent of Act 37 of 1952 in terms of Section 56 (1) (a) for an acknowledgment that execution and use of the method and equipment invented

by appellants would not be an infringement of respondent's patents Nos. 9323 and 10802 or either of them. Upon this request being refused appellant applied to the Commissioner's Court in terms of Section 56 of Act 37 of 1952 for a declaration that use of the method and apparatus particularised in appellant's confidential disclosure would not constitute an infringement of Union patents 9323 and 10802, or either of them.

In their petition appellants admit that in the use of its method and apparatus

"the hoist-tower to pour the concrete mix will in all material particulars be identical with that described in the specification of patent No. 10802."

It disavowed infringement, however, on the following grounds:-

"(a) As to claims 1 to 5 and 21 of patent number 9323, your petitioner's method does not make use of the fourth and fifth steps listed in the method claimed in claim 1 (on which claims 2,3,4 and 5 are dependent); and which steps are inherently included in claim 21," (i.e. the usual final method claim," substantially as hereinbefore described with reference to the accompanying drawings").

(b) As to claims 6 to 18 of patent No. 9323, claim 6 (on which claims 7 to 18 are all dependent) is limited

to use in (~~xxxxxxx~~) carrying out the method claimed in any of claims 1 to 5. Your petitioner does not and will not use its apparatus for carrying out a method that falls within the scope of any of claims 1 to 5.

- (c) As to claims 19 and 20 of patent No. 9323, these claims are integrated with claims 6 to 18, which your petitioner, for the reason set out in (b) above, does not and will not infringe.
- (d) As to claim 22 of patent No. 9323 your petitioner's apparatus is not arranged and adapted to be used or to operate substantially as described in the specification of that patent and as illustrated in the drawings annexed thereto.
- (e) As to patent No. 10802, all claims are specified as improvements in or modifications of the invention set forth in patent No. 9323. The claims relate only to a hoist tower. They must therefore be read and be integrated with claims 19 and 20 of patent No. 9323. These claims, as stated in (b) and (c) above, are limited in scope to the method claimed in any of claims 1 to 5, which claims are not and will not be infringed by your petitioner's method."

In order "to dispose of the technical issues in this initial stage", i.e. "only on the question whether or not Trapp's case" (infra) "is good in South African Law" the parties made reciprocal admissions. Appellant

admitted "that their shuttering infringes claims 6 and 7
"of patent 9323, in so far as these claims are directed to
"structure only, irrespective of the use to which that
"structure is put." It also admits, again without
prejudice, that its hoist tower infringes claims 19 and
20 of patent 9323 considered as structure independent of
use. To the same end and also without prejudice
respondent admitted that appellants' method as set forth
in its petition will not infringe claims 1 to 5 of
patent 9323.

Section 56 (3) of Act 37 of 1952

provides :-

"The validity of a claim in a specification shall not
be called in question in proceedings for a declara-
tion brought by virtue of this section, and the
making or refusal of such a declaration shall not
be deemed to imply that the patent is void."

Since the parties desired a preliminary
point of law to be decided, no evidence was adduced. The
Commissioner made the declaration asked for, but his
decision was reversed on appeal to the Transvaal Pro-
vincial Division. Hence this appeal.

In/.....

In all three courts this case was contested on the basis that, because of the formal admissions, it was unnecessary to examine appellant's alleged inventions; that the Court was required only to construe respondent's specifications, and particularly the phrase which I have italicised in quoting the 6th claim of the specification of patent No. 9323. The matter to be decided therefore lies within a narrow compass inversely proportional to the difficulties which arise. If one pegs a claim in Plato's hyperuranian world of ideas, it is to be expected that it would be no easy matter to locate the beacons. That however is not the only difficulty. Owing perhaps to conflicting considerations of industrial policy the decided cases abound with distinctions more subtle than those that occur in other fields of law and the cases are hard to reconcile with each other. In spite/.....

spite of many judicial pronouncements that - subject
to the interpreter being mindful of the objects of a
specification and its several parts - a specification
should be construed like any other document, it is
clear that the way of an inventor is thorny.

A method of drawing specifications
which evolved in practice has been made obligatory by
statute. Section 16 (3) of Act No. 9 of 1916 reads:-

"A complete specification must fully describe and
ascertain the invention and the manner in which it is
to be performed and must end with a distinct statement
of the invention claimed."

In Harrison v. Anderston Foundry
Company, (1 A.C. 574, 581) it was said:-

"The office of a claim is to define and limit with
precision what it is which is claimed to have been
invented and therefore patented.

Where a claim is clearly and distinctly made,
there can be no necessity for a patentee to distinguish
between what is disclaimed and what is claimed.
It is enough to say in answer to Lord Gifford's
suggestion that everything which is not claimed is
disclaimed." (Ibid. p. 580).

In Electrical and Musical Industries

Q/ v. Lissen

v. Lissen, (56 R.P.C. 23, 39) Lord Russell of Killowen

remarked:-

"The function of the claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will ^{be} trespassers. Their primary object is to limit and not to extend the monopoly. What is not claimed is disclaimed. The claims must undoubtedly be read as part of the entire document, and not as a separate document; but the forbidden field must be found in the language of the claims and not elsewhere. It is not permissible, in my opinion, by reference to some language used in the earlier part of the specification, to change a claim which by its own language is a claim for one subject-matter into a claim for another and a different subject-matter, which is what you do when you alter the boundaries of the forbidden territory. A patentee who describes an invention in the body of a specification obtains no monopoly unless it is claimed in the claims

A claim is a portion of the specification which fulfils a separate and distinct function. It, and it alone, defines the monopoly; and the patentee is under a statutory obligation to state in the claims clearly and distinctly what is the invention which he desires to protect."

In regard to these remarks Lord Simmonds in Raleigh Cycle

10/ Company

Company Ltd. and Another v. H. Miller and Company Ltd.,

(65 R.P.C. 141, 149) observed:-

"In truth he said nothing new, but his long experience in the trial of patent actions lends emphasis to the importance which he attached to the rules for the construction of claiming clauses which he there repeats."

It follows that a patentee has only himself to blame if the extent of the protection afforded by a patent is not co-extensive with that which he intended to claim or could have claimed by virtue of his invention.

Now claims 1 to 5 of patent No. 9323 are "method" claims and it is common cause that they will not be infringed if appellant's method is put into practice. *as I have stated,* Claim 6₁ opens with the words "For use in carrying out the method claimed in any of the preceding claims, means comprising" The patentee must be deemed to have inserted the fourteen words I have italicised for some purpose. The Commissioner held that they constituted a qualifying phrase which

"is capable only of the construction that the means specified in claims 6 to 18 and in claim 22 are, for the purposes of monopoly, restricted to the

methods of use claimed in claims 1 to 5 and to no other."

~~(That conclusion seems to me inescapable)~~ It is not to be assumed that the patentee did not have sound reasons for so restricting ~~his~~ its claim. The draftsman of a claiming clause must steer his course between two dangers. If the claim is too wide, it may be invalid or may not be accepted; if too narrow, it may open the door to infringement. Consequently there is always the temptation to maintain subsequently that a claim is wider than the area from which the public is "warned off".

In Walker on Patents (6th Ed. Vol. 1 p. 310) there is a passage which reads:-

"The phrase 'for the purpose set forth' is never implied in a claim, because an inventor is entitled to the exclusive use of his invention for all purposes, whether he sets them all forth in his specification or not. And such a phrase ought never to be expressed in a claim, because it cannot impart validity to a claim otherwise void, and because it may enable persons to avoid infringement who would otherwise infringe." (My italics).

It is not necessary for present purposes to consider whether the ^{italicised} reason stated in that passage is not too wide, but the meaning indicates the restrictive effects of such a phrase. If the intention was to make an article claim per se the adage applies: expressa nocent.

The Transvaal Provincial Division in coming to a different conclusion regarded all the equipment mentioned in the specification as a single machine and considered that "appellant's" (now respondent's) "claims must prima facie be construed as claiming a patent in relation to the invention as a whole, that is, machine plus method of operation." Mr. Blacklockst ^{who appeared for the respondents,} did not support that proposition. What the patentee intended to claim is immaterial. The provision that a patent shall be granted for one invention only was invoked, but I do not think ^{much} reliance can be placed upon it by appellant. It is merely a command directed to the Patent Office (Cf. Section 27 Act 37 of 1952). A patentable machine may consist of old parts, but if a patentee desires protection in respect of its subordinate parts he

must point out "what are the subordinate parts which also
"he asks singly and respectively in themselves" (my italics)
"to have protected" (Clark v. Adie, 2 A.C. p.315).

In the Transvaal Provincial Division
de WET J., who delivered the judgment of the court, con-
sidered the judgments in Adhesive Dry Mounting Company Ltd.
v. Trapp and Company (27 R.P.C.341), the Air Liquide case
(49 R.P.C. 428) and Raleigh Cycle Company v. Miller and
Company (63 R.P.C. 113 and 65 R.P.C. 141) and regarded
them as authority "for the view that the words 'for use
' 'in carrying out the method' need not necessarily be read
"as limiting or narrowing the claim."

It is enlightening to consider the
issues involved in Trapp and Co.'s case. It was an action
for infringement. The plaintiff was the owner of a
patent in which the claims were :

1. A dry process of mounting photographs, engravings, or
the like, consisting in interposing, between the two parts
to be united, a thin layer of material made in the manner
above described and capable of becoming adhesive under the
action of heat, and then applying heat and pressure there-
to, substantially as described.

2. For carrying into practice the process hereinbefore described, a pellicle which is adhesive when hot and consists of a thin sheet of paper or other carrier immersed in a solution of gum lac or other gum-resin, in such a manner that the adhesive material is incorporated in the carrier and covers the two faces thereof, substantially as described."

The alleged infringement was that the defendants had "manufactured, sold, supplied and offered for sale or "supply.....adhesive material for mounting photographs" etc. Plaintiffs claimed an injunction. The defence was inter alia that the invention claimed was not new.

It was held that the process claim had been anticipated. The question then arose whether the second claim was an article claim or merely the use of the pellicle in the process claimed in the first claiming clause. If it was an article claim ~~was~~ and the patent was valid the defendants had infringed by merely selling the article. But as an article the invention claimed had been anticipated. If it was merely the new use of the article in a process which was claimed, the plaintiffs could not obtain an injunction on the ground merely that defendants had sold the article; they would have to establish the

defendants! /.....

defendants' responsibility for the wrongful user by another. PARKER J. held that the second claim was an article claim, as otherwise "the second claiming clause "is already included in the first." This becomes clear if one reads the first claim in the light of the specifications, for the process required "a thin layer of material "made in the manner above described" and the application of heat and pressure.

The Air Liquide case (supra) arose out of opposition to an application for the grant of a patent. Claim 1 was a claim to a specified process. Claim 2 was a claim to specified apparatus and was prefaced by the words "An apparatus for carrying out the process "as claimed in claim 1....." That, too, was a case in which it was held that the words quoted above did not restrict the claim to the apparatus when used in a particular manner. It is difficult to gather the reasons for this/.....

this decision from the report. The decision in Trapp and Company's case was followed but with what justification one can only surmise. In his ~~and~~ decision the Assistant-Comptroller remarked:

"It is obviously undesirable that the claim should issue in a form which leaves that issue in doubt, if it is possible for me to remove such uncertainty by some amendment of the claim."

as such
When it was found that the apparatus₄ had been anticipated, the Assistant-comptroller gave applicants an option to amend the opening words of claim two to read:-

"An apparatus when used for carrying out the process as claimed in claim 1"

wise
or other~~wise~~ narrowing it, which - with respect appears to me to be one of those subtle distinctions to which I have alluded. In the result, however, that decision supports my concept of the effect of such a limitation.

I see no point in adducing such phrases wrenched from their context as precedents. In each case their significance can be gathered only when read in their contexts. The principle of

construction adopted in the pellicle case seems to me to weigh against respondent. Upon respondent's construction the fourteen introductory words in claim 6 would be meaningless. It was contended that they served to "describe and ascertain the nature of the invention and in what manner it is to be performed," but one asks oneself why words used to that end have been allowed to stray into a claim. Upon appellant's interpretation the apparatus claims would not be meaningless but would give the patentee protection when the apparatus is used in the patented process.

I now turn to the patent of addition, No. 10802. It was granted under the provisions of Section 52 of Act 9 of 1916, which contemplates the grant of such a patent "in respect of any improvement in or modification of the invention". A hoist-tower is referred to in claims 19 and 20 of patent No. 9323. As we have seen they are not article claims per se. In the later specification the

invention is said to relate to "an improvement in or modification of the invention set forth in our patent No. 9323". The object of the additional invention

is stated to be "to provide an improved construction of tower and service bridges which will enable

etc". Assuming that a patent of addition may have a wider claim than that of the main patent (See Terrell and Shelley on Patents, 9th Edition p. 52), I can find nothing in the specification of patent No. 10802 to indicate that the scope of the protection claimed was widened. If an improvement in or modification of an integer protected only in combination with a process is claimed, it seems to me to follow logically, in the absence of express words to the contrary or words which by necessary intendment convey a contrary meaning, that the improvement or modification is claimed only in that combination and not per se.

For these reasons the judgment of the Transvaal Provincial Division is set aside and the decision of the Commissioner restored, respondent

to pay the costs occasioned in both Divisions of the
Supreme Court.

J. H. Hever

~~Centlivres, C.J.~~
~~Schreiner, J.A.~~
~~Noxton, J.A.~~
~~Egan, J.A.~~

IN THE SUPREME COURT OF SOUTH AFRICA

(Appellate Division)

In the matter between :-

POWER STEEL CONSTRUCTION CO.(PTY)LTD. Appellant

and

AFRICAN BATIGNOLLES CONSTRUCTIONS(PTY)LTD. Respondent

Coram: Centlivres C.J., Schreiner, van den Heever, Hoexter
et Fagan, JJ.A.

Heard: 23rd and 24th May, 1955.

Delivered: 8-9-55

J U D G M E N T

SCHREINER J.A. :- The definition of invention in section 6 of Act 9 of 1916, which applies to the present matter, is, so far as relevant, "any new and useful art, "process, machine, manufacture or composition of matter." You can thus have patentable inventions that are processes and patentable inventions that are machines. (It is unnecessary to consider whether all inventions covered by the definition can be brought under one type or the other, or whether, if so, any change has in this respect resulted from the altered definition in section 1 of Act 37 of 1952). Your specification must, in terms of section 15 of Act 9 of 1916, not only describe the invention but must also

describe/.....

describe the manner of performing it. If your patent is for a process or, as it is also called, for a method, ^{you} normally describe your manner or means of performing it by setting out the details of a machine or apparatus by which the method or process can be put into operation. In section 10(3)(b) of Act 37 of 1952 the word "method" is apparently used, perhaps somewhat confusingly, as equivalent to the manner or means of performance.

If on the other hand your invention consists of a machine and your patent is consequently a machine or article patent, your obligation to describe it and the manner of performing it requires, in addition to a setting out of the details that show exactly what the machine or article is, a description of its purpose, informing the public what it aims at achieving and how it works.

The description of the means of putting the method or process into operation in the one case and the description of the purpose and functioning of the machine or article in the other tends, rightly or wrongly, to overflow from the body of the specification into the claims, and this may create difficulty. It can happen that
the/.....

the description of a method with its means may look rather like the description of a machine with its purpose and functions; which is the true view in any particular case is a question of interpretation. The Commissioner held that the patents in this case were for a method, as improved, and not for a machine, as improved. The Transvaal Provincial Division took a different view - it came to the conclusion that the invention was for the "machine plus method of "operation", or, as it is put elsewhere in the judgment, for "the machine and method as one invention." The latter form of expression I find somewhat confusing. It seems to me that for the proper decision of the case ^{it} ~~is~~ was necessary to see (a) whether there were, possibly, two inventions covered by the one patent, including, for present purposes, the patent of improvement, and (b) whether, if there was only one invention, it was a method or process invention or a machine or article invention. Taking the ~~sp~~ specifications as they stand it seems to me, for the reasons developed by my brethren, that the proper interpretation is that there was only one invention and that that invention was a method invention, with a description of means for carrying it out.

The judgment of the court a quo deals with the cases of Adhesive Dry Mounting Coy. Ltd. v.

Trapp/.....

Trapp and Coy (27 R.P.C. 341) and L'Air Liquide S.A. Georges Claude's Application (49 R.P.C. 423), where words somewhat similar to the words "For use in carrying out the method claimed in any of the preceding claims" were regarded as being consistent with the view that the claims in which they appeared were claims for an invention of a machine or article. The court a quo, of course, appreciated that these cases do not furnish any sound reason for concluding that whenever words of that kind are found in a claim they show or tend to show that the claim in question is a claim for a machine or article. But once that is recognised the cases lose almost all importance for present purposes. This case had to be decided upon the proper meaning and effect of the particular specifications in question. I am satisfied that the words in claim 6 preface means claims in a method patent and not claims for a machine invention. Subject to the above comments I agree with the reasons of my brethren, and accordingly I agree that the appeal should be allowed.

Jagan I.A. Concurs.

Note The Chief Justice took no part in the preparation of the judgment owing to illness.

D. Schurman
7.9.55