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European Intellectual Property Review

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Robert George Murray (patentee and applicant for infringement) and Vodacom (Pty) Ltd (1st defendant); Vodacom Service Provider Company (Pty) Ltd (2nd defendant)
The Court of the Commissioner of Patents (JD Murphy sitting as Commissioner of Patents)
March 3, 2008

Facts: Robert George Murray, the Patentee of South African Patent 2002/1924 (“the patent”), launched patent infringement proceedings in the Court of the Commissioner of Patents, against the first defendant Vodacom (Pty) Ltd and the second defendant Vodacom Service Provider Company (Pty) Ltd. The first defendant constructs and maintains a GSM cellular network in South Africa. The second defendant is a cellular service provider that utilizes the first defendant’s cellular network. They shall both herein after be referred to collectively as “Vodacom”.

The patent relates to a communication systems. The opening paragraph of the specification declares:

“In particular, it relates to a method of, and a system for, enabling use of a communication network by a subscriber. It also relates to a method of dispensing enabling codes to a cellular telephone user.”

The specification then proceeds to outline the closest prior art that was regarded as the “pay as you go” or prepaid system that has accompanied the proliferation in the use of cellular telephones (“cellphones”). In that system, a user or subscriber purchases airtime to a selected value from a service provider in advance. The purchase of the airtime allows the subscriber to use a cellphone to communicate via the provider’s cellular network to a predetermined extent. The specification continues:

“In order to initiate use of the network, the user or subscriber typically purchases a voucher of a particular value. The voucher provides an enabling or personal identification number (PIN) code that is fed into the network via the cellphone thereby to enable use for the selected value. Once the cumulative use of the network by the user reaches the value of the purchased airtime and the voucher has been depleted, use of the network by the user is terminated and a further voucher must then be purchased.”

The patentee alleged that Vodacom had infringed claims 1 to 13 (except claims 6 and 8), claim 14 to 22 and claims 22, 24 and 25 of the patent. The independent claims are set out hereunder:

Independent claim 1, divided into the following essential integers, reads as follows:

- (a) A method of enabling use of a communication network by a subscriber, the method including:
- (b) remotely identifying the subscriber;
- (c) verifying subscriber details with reference to the subscriber details stored in a subscriber data base; and
- (d) selectively providing the subscriber with an enabling code,
- (e) which, when fed into the network, provides the subscriber with airtime credit which allows communication via the network to a predetermined extent.

Independent claim 14, divided into the following integers, reads as follows:

- (a) A method of dispensing an enabling or PIN code to a cellular telephone user which includes the steps of:
- (b) remotely identifying the user;
- (c) verifying user details with reference to user details stored in a user data base; and
- (d) selectively providing the user with an enabling or PIN code.

Lastly, independent claim 15, divided into the following integers, reads as follows:

- (a) A system for enabling use of a communication network by a subscriber, the system including:
- (b) a database including data on a plurality of subscribers requiring use of the communication network;
- (c) identification means for remotely identifying the subscriber;
- (d) verification means for verifying subscriber details with reference to the database; and

- (e) a stock of enabling codes from which an enabling code is selectively dispensed to the subscriber,
- (f) the enabling code being operatively fed into the network to a predetermined extent.

In particular, the patentee put forward as evidence of patent infringement two instances in which the patentee purchased airtime from Vodacom, both instances comprising methods by which the patentee obtained airtime. The methods are referred to in the judgment as the "Autocharge System" and the "Hybrid or Pre Paid Top Up System" (hereinafter referred to as the "Hybrid System"), which systems are discussed hereafter. The two instances of alleged infringement were as follows:

- (a) The use or exercise of the method or the system used in providing airtime credit in the amount of R29- to telephone number 072 097 2049 under password 397758, the "details of which were sent to it" by telephone number 082 009 9972 on February 22, 2006 on or about 09H17—the Autocharge system.
- (b) The use or exercise of the method or the system used in providing airtime credit in the amount of R135 to telephone number 082 444 4293 on February 28, 2006 at or about 20H04—the Hybrid system.

The Autocharge system, following registration of a user, operates in the following manner, described from the point of view of the subscriber. The subscriber phones the system; is met with a voice response unit (VRU) and enters their PIN obtained during the registration process. Once the PIN is verified the subscriber is prompted to select a specific amount of airtime; if the subscriber has sufficient credit the subscriber's credit card is debited with the selected amount and the subscriber's airtime account on the network is credited with the same amount. A short message service (SMS) is then sent to the subscriber confirming the success of the exercise, the recharge value and the updated balance of airtime available.

It is important to note that the Autocharge system as described above was operated by Cointel (Pty) Limited on behalf of Vodacom since 1998.

On the other hand, the Hybrid system provides for regular airtime credits to be provided in respect of the telephone number that is the subject of the contract. The subscriber concludes a fixed-term contract (with a period of two years or more) with the provider for the provision of a certain amount of airtime to be credited to the subscriber's airtime account on the network against a monthly debit of the same amount to the subscriber's bank account. This usually, if not always, occurs on the first day of the month. Should the airtime be depleted by the subscriber before the next automatic recharge on the first of the next month, the subscriber may top-up the airtime by purchasing a voucher, or at a bank ATM, or by using the credit card recharge Autocharge system.

In response to the patentee's allegations of alleged patent infringement, Vodacom counterclaimed for the revocation of the patent on the basis that the invention as claimed in the patent was not novel and/or inventive, that the subject matter of the invention was not patentable in that it consisted of a scheme, rule or method for performing a mental act, which subject matter is excluded from patentability in terms of the South African Patent's Act 1978 act 57, and that the claims were not fairly based on the matter disclosed in the specification.

Held: Stare decisis.

Judge Murphy, acting as the Commissioner of Patents, wrote the judgment that spans over 90 pages, considering the manner in which each system operated in great detail. Some of the technical details are unavoidably repeated herein.

Patent infringement—the Autocharge system

On the last day of trial, the patentee abandoned its case for patent infringement based upon Vodacom's Autocharge system. Counsel for the patentee stated that the reason for abandoning its case was simply that the Autocharge system did not embody all the integers of the independent claims, the presence of which is necessary for patent infringement to occur. Further, counsel for the patentee indicated that since there were only c.a. 59,000 subscribers to the Autocharge system, it was not commercially worthwhile to proceed with its case in respect of the system.

Despite the patentee abandoning the above leg of its attack, the Court proceeded to consider the manner in which the Autocharge system operated, its operation being important to the counterclaim for revocation of the patent, which is discussed herein.

Patent infringement—the Hybrid system

In reaching the decision that the Hybrid system did not infringe the patent, the Court had to decide upon two factors, namely the interpretation to be given to the term “enabling code” and whether it was necessary to exercise the method as claimed in the independent claims in the sequential order of the integers set out above or whether, for example, integers (e) and (d) of claim 1 could precede chronologically integers (b) and (c) of claim 1.

“Purposive Construction”

The Court stated that it is well-known that the South African law of interpretation has moved beyond an overly literalist approach and that:

“... more recently Courts construing patents have evolved the contextual methodology to a more extensive purposive approach to interpretation, which seeks to discover what was intended to be the essential elements, or the essence, of the invention, which is not to be found by viewing each word in isolation but rather by viewing them in the context of the invention as a whole.”

It was stated by the Court that the dispute between the parties could be narrowed to the construction to be given to the term “enabling code” as used in the integers of claim 1, 14 and 15 (as well as some of the dependent claims) and the added dimension to the argument put forward by the patentee, particularly that integers (d) and (e) of claim 1 should not be construed to mean that the enabling code needs first to be sent to the subscriber and that the subscriber should feed the enabling code into the network in order to obtain airtime credit (a system or method the patentee described for convenience as a “triangular code system”). It was the patentee’s submission that it was not necessary for the enabling code to be returned to the subscriber and for the subscriber to feed it into the network to be provided with airtime but that the enabling code could be sent directly to the subscriber’s account on the intelligent network (IN)—described by the patentee for convenience as a “linear code system”.

Quoting from the judgment of Murphy J:

“... the [sic] defendants submitted on the contrary that a proper interpretation of claim 1 revealed that the claim provided for a sequence of steps in the method of enabling use of a communication network to which the claim relates. The first step, integer (b), is that the subscriber must be remotely identified; the second, integer (c), requires there to be verification of the subscribers details stored in a database; the third, integer (d) requires selectively providing the subscriber with an enabling code with the function provided for in integer (e); and the fourth step requires that the enabling code, after having been provided to the subscriber, must when fed into the communication network (clearly by the subscriber who has been provided with the enabling code), provide the subscriber with airtime which allows communication via the network to a predetermined extent, such extent corresponding to the value of the enabling code. The defendants thus submitted that the enabling code must be a value carrying enabling code which the subscriber can feed into the communication network.”

Counsel for the patentee contended that there was nothing in the specification of the patent to support Vodacom’s construction and that reference should be had to dictionary definitions of *enable* (“to make able”) and *code* (“a system used for brevity or secrecy of communication, in which arbitrary chosen words, letters or symbols are assigned definite meanings”).

In response to the above arguments Murphy J. stated that:

“Excessive peering at the language in this way in the present case, to my mind, divorces the claim from its context. The immediate textual context of the concept of an enabling code, as used in claim 1, is found in claims 10–12, being subsidiary claims to claim 1. They include the obtaining of enabling codes from a supply of enabling codes (claim 10), including selecting a voucher from a stock of vouchers on which the enabling codes are provided (claim 11), or from enabling code dispensing means which has a stock in electronic form (claim 12).”

Murphy J. then proceeded to consider the purpose of the invention and had the following to say:

“... the final paragraph of the specification clarifies the object or purpose of the invention to be: ‘an enhanced method of, and system . . . for enabling use of a communication network by a subscriber. The method enables dispensing of enabling codes or vouchers to a cellular telephone user remotely without the need for the subscriber physically to obtain

a voucher from a service provider.' What the invention aims at is the substitution of the voucher by the provision of the same information to the subscriber by different means. The idea that came to the plaintiff was to find a method whereby the need to stop and purchase a voucher could be obviated. His idea was that the information to be fed into the network could be transmitted to him by other means. Both the body of the specification and the other claims (10-12) substantiate that. There is no reason why guidance may not properly be obtained from a subordinate claim (as part of the textual context) on the true construction of the antecedent claims to which it is appended - *Glaverbel SA v British Coal Corporation and Another* 1995 RPC 255 (CA) at 281."

In applying the purposive construction of the claims to the patent, Murphy J. stated that it would be permissible to have regard to the manner in which the patentee implemented his invention as part of the extra-textual context, or background circumstances, demonstrating the purpose of the patent. The judge reached the conclusion that the patentee considered the enabling code of his invention to be an enabling code of the kind linked to an airtime voucher, i.e. a 12-digit PIN recorded on a voucher or scratch card and not of the kind the patentee was now trying to argue.

Having regard to the above, Murphy J. concluded that no enabling code was fed into the network for the Hybrid system and stated:

"Finally, whereas I am prepared to accept that the communication of the message containing the data of the MSISDN (telephone number/credit card relationship on a tandem computer system), the TID (transaction identification) and the airtime value comprises the transmission of enabling data with obvious functionality, I do not believe that such is the enabling code intended to be conveyed in the specification."

As a result, the Court held that integers (d) and (e) in claim 1, integer (d) in claim 14 and integers (e) and (f) in claim 15 were not present in the Hybrid system and thus did not infringe the patent.

Insofar as the interpretation to be given in respect of the order in which the integers of the claims were to be exercised, Murphy J. stated that he had been persuaded that the patentee changed the evidence regarding the sequence of the steps for the purpose of "shoe-horning" the Hybrid system into the ambit of the claims. Having regard to the manner in which the Hybrid system operates, the judge stated that the specification read as a whole conveyed the impression that remote identification and verification occurs with each request for a recharge and is for the purpose of providing the enabling code. The Hybrid system, on the other hand, operates automatically and can take place even while the cell phone is switched off. The judge concluded that this means that there is no simultaneous remote identification and verification on each monthly renewal, that the information is not interrogated by the system at the time of recharge and that the entire transaction is generated within the system and involves no action by or interaction with the subscriber. As a result, it was also held that integer (b) and (c) of claims 1 and 14 and integers (c) and (d) of claim 15 were not present in the Hybrid system.

In the light of the above findings, the patentee's action for infringement was dismissed.

Counter application by Vodacom for the revocation of the patent

Vodacom abandoned its grounds for revocation based on the fact that the subject matter of the patent was not patentable in that it involved a scheme, rule or method of performing a mental act and that the claims of the patent were not fairly based on the subject matter of the patent.

In support of the allegation that the patent was not new and/or was obvious as at the priority date for the invention, Vodacom relied on:

- (i) the system and method of recharging airtime used commercially by Cointel (Pty) Ltd and Vodacom from about June 1998 ("the Autocharge system");
- (ii) South African patent 99/0794, referred to in evidence and argument as the "I Touch" patent;
- (iii) the "pay as you go" or prepaid voucher system used in South Africa by Vodacom from about 1994;
- (iv) WO 98/47112, referred to as the "Miller" patent; and
- (v) WO 96/41462, referred to as the "EDS" patent.

The Autocharge system posed an interesting dilemma for the patentee in that if integers (d) and (e) of claim 1, the enabling code, were found in the Hybrid system, such being allegations with which the patentee persisted, and accepting the evidence of Vodacom that the message transaction between the computing elements is the same message in all recharges, i.e. the Hybrid system and the Autocharge system,

an infringement by the Autocharge system could have been established by virtue of all the integers being present, but a finding of invalidity on the basis of anticipation would have followed. It will be recalled that the Autocharge system was operated by Cointel on behalf of Vodacom before the priority date of the patent.

It was common cause between the parties that integers (a), (b) and (c) of claim 1 were present in the Autocharge system. However, since integers (d) and (e) were not found to exist in the Hybrid system, and thus, by virtue of the fact that the same computing elements are present in the Hybrid system and the Autocharge system, that elements (d) and (e) of claim 1 are not present in the Autocharge system, the Court held that the system did not anticipate the patent.

The I-Touch patent relates to a method of assessing electronically the status of a client device as a prelude to charging the client with a store of resources enabling it to operate, in particular as a member of a network of such devices. In particular, it relates to the clearance, for online electronic charging, of a pre-paid cellular number. Pre-paid vouchers are available for purchase by users of services such as those of cellular telephony, electricity and other utilities. In regard to cell phones, printed vouchers are dispensed by sales agents to their customers. The agent requires clearance from a principal before it may dispense valid vouchers. The Court found that the I-Touch patent constituted an anticipation of the patent and, based on the test for obviousness, found the invention of the patent to be obvious. The test for obviousness involves the following four questions:

1. What is the inventive step said to be involved in the patent in suit?
2. What was, at the priority date, the state of the art (as statutorily defined) relevant to that step?
3. In what respect does the step go beyond, or differ from, that state of the art?
4. Having regard to such development or difference, would the taking of this step be obvious to the skilled man?

The Miller patent was stated to relate to a method for electronically vending pre-paid value including the steps of offering pre-paid value for sale to a purchaser on an electronic network, the network enabling communication electronically between the purchaser, an independent financial institution and computerised managing means for managing the sale of pre-paid values. Analysing the specification of the Miller patent in detail, the Court came to the conclusion that it too anticipated the patent and rendered the invention thereof obvious.

Lastly, the EDS patent may be described with reference to its abstract, which reads as follows:

"A system and method for electronic purchase of prepaid telephone services is provided. An initiating terminal (110) receives input of a customer's request to purchase a specified amount of prepaid telephone services and receives input of the customer's designation of a financial account from which to electronically debit the price of such purchase. A central terminal (140) receives these inputs from the initiating terminal to, in turn, print on a receipt and provide to the customer. This receipt is then used instead of a telephone card to obtain telephone services up to the specified amount. Such receipt may also detail instructions and an authorization number, such as a personal identification number or PIN, to initiate the prepaid telephone service. The system and method of the present invention also preferably transfers the funds from the appropriate demand or credit account to pay for the purchased telephone services. An additional, separate Regulation E-type receipt is preferably also printed reflecting the financial transaction."

Having regard to the body of the specification, the court concluded that the above patent anticipated the patent and rendered the invention obvious.

In the light of the above, the Court ordered the revocation of the patent, however suspended the order of revocation for a period of three months to allow the patentee an opportunity to amend its patent.

Comment: In the case of *Vari Deals 101 (Pty) Ltd v Sunsmart Products (Pty) Ltd* [2007] SCA 123, the Supreme Court of Appeal confirmed that purposive construction forms part of South African law and the Court a quo in the present matter followed the Supreme Court of Appeal in applying a purposive construction of the claims of the patent. It, like the Supreme Court of Appeals, did not however take the opportunity to clearly set out the extent to which "purposive construction" has supplanted the "normal rules" of interpretation of claims.

It is also an interesting point to note that it would appear that the present case is one of the first cases wherein "purposive construction" has assisted the alleged infringer in avoiding the claims of a patent rather than aiding the patentee to bring an act of infringement within the spirit and scope of the claims of a patent.

PATENTS*Interim injunction—application for correction/amendment*

LT Amendments; Interim injunctions; Patent claims; Pharmaceuticals; South Africa

A Lundbeck AS (patentee and first applicant); Lundbeck SA (Pty) Ltd (second applicant) and Cipla Medpro (Pty) Ltd (respondent) The Court of the Commissioner of Patents (B.R. Southwood sitting as the Commissioner of Patents
May 23, 2008

Facts: An application for an urgent interdict to restrain Cipla Medpro (Pty) Ltd (“Cipla”) from infringing South African Patent 89/4476 (the patent), entitled “Enantiomers and their Isolation”, was launched by the first applicant and patentee, Lundbeck AS, and the second applicant, Lundbeck SA (Pty) Ltd, as the wholly owned subsidiary in South Africa of the first applicant (collectively hereinafter referred to as Lundbeck).

The patent covers a blockbuster antidepressant drug sold by Lundbeck under the trade mark CIPRALEX, of which the active ingredient has the trivial name escitalopram, being the (+) enantiomer of the citalopram racemate, and salts thereof as well as methods for preparing the enantiomer.

The motivating factor for the application for an urgent interdict was a letter sent to Lundbeck by Cipla’s attorneys stating, inter alia, that Cipla intended to place a generic of escitalopram on the market as soon as a regulatory approval was obtained from the South African Medicines Control Council. The letter stated that Cipla was aware of the patent, however it was also aware of the fact that the corresponding patent in the United Kingdom had been held to be invalid. In the light of the initial decision concerning the corresponding United Kingdom patent, Cipla therefore regarded the South African patent as being invalid.

The latter statement was however made prior to the Chancery Division Patent Court’s decision being overturned on appeal, the Appeal Court ultimately finding the corresponding United Kingdom patent to be valid.

Lundbeck also applied for the correction of errors, alternatively an amendment of the patent in respect of claims 6 and 7.

Held: It will be apparent from the following summary of the Court of the Commissioner of Patent’s decision that the crucial aspect of Lundbeck’s case was whether it would be allowed to correct or, alternatively, amend, its claims. The rationale behind the importance of this aspect is due to the fact that in terms of South African patent law, an invalid claim in a patent, until amended or corrected, is an insurmountable obstacle to the grant of relief for infringement of a patent. In fact, it was common cause as between the parties that if a claim in a patent is invalid no interim relief may be granted on the patent.

The application for the correction (or amendment) of the claims was opposed by Cipla on the following grounds:

- There had been culpable delay on the part of Lundbeck in seeking the correction/amendment of the patent.
- Lundbeck was not seeking to correct clerical errors in terms of s.50 of the South African Patents Act No.57 of 1978 and they were actually seeking amendments of the patent in terms of s.51 of the Act.
- The Court did not have jurisdiction to hear the application for amendment of the patent because there were no proceedings pending in respect of the patent.
- Lundbeck had not made out a proper case for an amendment in terms of s.51 of the Patents Act and that they have not complied with the procedural requirements prescribed by the section.
- The amendments of the patent sought in respect of claim 6 and 7 were in conflict with subsections 51(6) and (7) of the Patents Act as they would either introduce a claim not fairly based on matter disclosed in the specification before amendment or not wholly within the scope of a claim included in the specification before amendment.

Ground of objection: culpable delay

Counsel argued, on behalf of Cipla, that there was culpable delay on the side of the patentee in seeking to correct, or alternatively amend, its claims, and that this culpable delay should be taken into account by the Court in exercising its discretion against the allowance of the correction or amendment.

More particularly, it was argued by Cipla’s counsel that Lundbeck’s evidence dealt with how they became aware of the errors as a result of re-issue proceedings for the corresponding United States patent but that it did not address why it took some 14 years to amend the patent. It was further argued that the evidence did not give any explanation as to why the patent had not been amended prior to bringing the application for interim relief.

The Court, in stating that the issue of culpable delay is applicable to the exercise of its discretion in granting either a correction or an amendment, found that the evidence provided by Lundbeck concerning the issue of delay was “disingenuous and unconvincing”. The Court however did not take the question of culpable delay further and did not make a finding on whether indeed it would exercise its discretion against

Lundbeck on the basis of delay. Instead, the Court turned to the issue of whether Lundbeck had established that they indeed sought the correction of clerical errors, the reason being that different considerations apply to the correction of clerical errors when compared to amendments.

The Court pointed out that correction of a clerical error may be permitted which would materially alter the scope of the patent, whereas in respect of amendments it would not be possible to include a claim not fairly based on the matter disclosed in the specification before amendment and it would further not be possible to include a claim that does not fall wholly within the scope of a claim prior to amendment.

Ground of objection: not a correction

Purely from an evidentiary point of view, the Court held that it was clear that the deponent on behalf of Lundbeck in the founding affidavit had no personal knowledge of how the errors had occurred. It was assumed by Lundbeck that the errors had occurred as a result of:

- an unfamiliarity with or poor choice of nomenclature by the patent agent; or
- a shortcoming in communication between inventors and agents; or
- otherwise inexplicable.

The Court agreed with counsel for Cipla that the first two errors above are amendable errors, and not clerical errors. It further found that Lundbeck had not provided any facts to indicate how the errors came about and had thus failed to establish that the errors were clerical errors. As a result, the Court stated that it was necessary to consider Lundbeck's application as one for the amendment of the claims.

Ground of objection: jurisdiction to hear the application for amendment

Section 51(9) of the South African Patents Act No.57 of 1978 (Patents Act), which section is set out below for ease of reference, regulates an application for an amendment whilst proceedings in respect of a patent are pending:

"Where any proceedings relating to an application for a patent or a patent are pending in any Court, an application for the amendment of the relevant specification shall be made to that Court, which may deal with such application for amendment as it thinks fit but subject to the provisions of subsections (5), (6) and (7), or may stay such pending proceedings and remit such application for amendment to the registrar to be dealt with in accordance with subsections (2), (3) and (4)."

Cipla argued that having regard to the word "pending" and the use of the participle, it is clear that the proceedings mentioned in the section must be extant when the application for amendment is made to Court. In the present case, Cipla argued, there were no pending proceedings relating to the patent.

The Court rejected the above argument, stating that there was no reason to construe the word "pending" in a narrow fashion and cited case law to the effect that the term "any" is a "word of wide and unqualified generality". Accordingly, the Court held that the moment proceedings relating to a patent are instituted in a Court, and until they have been concluded, there are such proceedings pending. In other words, it is indeed possible to bring an application for the amendment of the claims of a patent simultaneously with an application for interim relief.

Ground of objection: non-compliance with procedural requirements

Cipla argued that urgent relief under the sections regulating amendments in the Patents Act is inappropriate and that Lundbeck had to comply with the procedural requirements under the Patents Act wherein a full explanation regarding the amendment had to be provided to the Registrar of Patents and wherein the amendment had to be advertised so as to give interested parties an opportunity to oppose the amendment.

The Court held against Cipla in this regard in that s.51(9) provides the Court with a discretion in respect of the procedure to be followed. It was held that an urgent application for amendment would not exclude this discretion and that in any event when an applicant applies to the Court for amendment the application for amendment would disclose the nature of the amendment sought and the reasons therefor.

Ground of objection: the amendments in respect of claims 6 and 7 of the patent are in conflict with ss.51(6) and 51(7) of the Patents Act

The above sections read as follows:

“Section 51(6): No amendment of a complete specification which becomes open to public inspection after the publication of the acceptance of the specification in terms of section 42, whether before or after it so becomes open to public inspection, shall be allowed if—
 (a) the effect of the amendment would be to introduce new matter or matter not in substance disclosed in the specification before amendment; or
 (b) the specification as amended would include any claim not fairly based on matter disclosed in the specification before amendment.”

Section 51(7) reads as follows:

“No amendment of a complete specification which has become open to public inspection after the publication of the acceptance of the specification in terms of section 42 shall be allowed if the specification as amended would include any claim not wholly within the scope of a claim included in the specification before amendment.”

The amendments sought by Lundbeck and the effect thereof may be described as follows:

Claim 6

Claim 6 is a method claim which essentially claims the preparation of a (+)-citalopram by stereoselective conversion of the (+)-enantiomer of the specified intermediate (or optical sign thereof). Lundbeck sought to amend the claim by the inversion of the optical sign of the intermediate. This amendment would result in the claim covering a method whereby (+)-citalopram is produced by the (-) intermediate.

The Court held that this would cover a different process, namely the (-) intermediate to (+)-citalopram, rather than the (+) intermediate to (+)-citalopram as the claim currently read. The Court concluded that the patent as amended would therefore include a claim not wholly within the scope of a claim before amendment and rejected the amendment.

Claim 7

Claim 7 is a product claim to the (+)-enantiomers of compounds of the illustrated formula. Lundbeck sought to amend the claim firstly by deleting the phrase “of F” and substituting it with the word “or” and secondly by substituting “(+)” in the claim with “(-)”. The amendment of the optical sign would have the effect of claiming the (-)-intermediate, the opposite enantiomer to that which was presently claimed.

The Court held that the (-)-intermediate did not fall within the scope of any claim of the patent prior to amendment and accordingly rejected the application for the amendment to claim 7.

In light of the above, the Court concluded that both amendments offended s.51(7) of the Patents Act and dismissed the application for correction/amendment as well as the application for interim relief.

Comment: The case is important in that even though the Court did not make a decision based on culpable delay, it is clear that in the situation in which an error is found to exist in the claims of a corresponding patent and is so rectified, the same corrections should be carried out in respect of the South African patent as soon as possible and certainly before launching proceedings for relief, be it interim or final relief. Since the South African Patent and Trade Mark Office do not examine patent applications as to novelty and inventiveness, it is prudent to amend the claims of a South African patent to the claims as granted in an examining jurisdiction.

A further important factor that can be gleaned from the case is that a patentee should only apply for the correction for an error if the patentee is satisfied that it can show how the error came about and importantly that the error is indeed a clerical error. Errors resulting in the incorrect use of nomenclature or arising as a result of a misunderstanding between agent and patentee do not classify as clerical errors.

Lastly, and very significantly in terms of the development of South African patent law on the subject of urgent interlocutory injunctions, the case confirms the procedure adopted in the case for interim relief between *Pfizer Ltd and Cipla Medpro (Pty) Ltd*, unreported, March 24, 2005, namely that one can bring an application for urgent interim relief while simultaneously applying for the correction or amendment of the claims of the patent in order to cure the patent from being partially valid and unenforceable in such a state.