The Court of Appeal has handed down judgment in the case of [IPCom v HTC] (UK) (2015) in which the issue of infringement turned on the construction of two phrases: "access class information" and "access class bit", which were part of a UK division of a German division. The patent was the subject of EPO opposition proceedings. For the purposes of this decision, readers should note that on 7 March 2013 the EPO Technical Board of Appeal held that a proposed amendment overcame the Opposition’s Division’s objections, and on 24 April 2013 the Opposition Division had found against the proposed amendment.

The question of the admissibility of prosecution history also reared its head in relation to HTC’s submission that the patent was invalid (as amended) but not infringed by HTC’s UMTS mobile phones. In turn, HTC had cross-appealed, challenging the judge’s construction and also asserting that the patent (as amended) was invalid for added matter.

In dismissing their cross-appeal, the Court endorsed Birss J’s finding that IPCom’s averred intention was to obtain a claim which was equivalent in scope to that of the TBA-approved German claim. In doing so, the Court found that the teaching of the embodiment was sufficiently general to make it clear that the skilled person would have understood the claim to encompass variants which had no material effect on the way the invention worked. Whilst the amended claim did not require features of a single bit pattern or a single access class bit, neither did the combination of features that were included in the claim.

The Court reiterated their view that what happened at the TBA was not a legitimate translation of the German claim, and that Birss J had relied on the evidence of a translator which had been coloured by events before the TBA. The Court also rejected Birss J’s finding that the amendment did not require features of a single bit pattern or a single access class bit, and that the claim as amended was invalid for added matter.

Parallel proceedings before the TBA

IPCom filed for an appeal to the TBA. At first instance, the issues of infringement turned on the construction of two phrases: “access class information” and “access class bit”. In the event, the Court found that the amended claim was valid (as amended) but not infringed by HTC’s UMTS mobile phones. In turn, HTC had cross-appealed, challenging the judge’s construction and also asserting that the patent (as amended) was invalid for added matter. In any event, the amendments should have been rejected on a discretionary basis.

In allowing their appeal, the Court held that, although it was regrettable that Birss J was not specifically directed to the relevant point of evidence, it should not act as a bar to success on appeal where the relevant point of evidence was unchallenged. HTC’s cross-appeal on the construction of “access class bit” did not require features that were not of significance to the way the invention was carried out by the embodiment. The Court found that the teaching of the embodiment was sufficiently general to make it clear that the skilled person would have understood the claim to encompass variants which had no material effect on the way the invention worked. Whilst the amended claim did not require features of a single bit pattern or a single access class bit, neither did the combination of features that were included in the claim.

The Court also rejected Birss J’s finding that the amendment did not require features of a single bit pattern or a single access class bit, and that the claim as amended was invalid for added matter.