

IPCom v Vodafone: The Excuse? Crown Use!

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by Ben Millson

IPCom's latest foray into standard essential patent litigation has reached a surprising outcome at first instance; its patent was held valid, essential and infringed in amended form by Recorder Douglas Campbell QC, sitting as a judge of the Patents Court, in a judgment dated 28 January 2020. However, Vodafone succeeded in relying upon the defence of Crown use in respect of several of its uses.

The patent in issue is a member of the same family as the IPCom patent which has been litigated in the past against Nokia and HTC, but this is the first case in which a member of that patent family has been litigated in the context of 4G rather than 3G, and against a network infrastructure provider rather than a handset provider.

IPCom's patent relates to a method for controlling whether a particular mobile device is granted authorisation to access a given telecommunications channel at a given time. All mobile devices are assigned a class number by their SIM card, with ordinary consumer commercial devices being randomly assigned a class between 0 to 9. Further classes numbered 11 to 15 also exist, and each of these classes contains only devices belonging to a certain group of end-users. For example, class 12 contains only devices which belong to the security services, and class 14 contains only devices which belong to the emergency services.

IPCom's claimed method enables the network to send out an authorising bit which differentiates a group of "ordinary" device classes from a group of "special" device classes. This differentiation then allows the base station to authorise only devices in the special group to immediately access the channel, thereby giving them priority access. Any remaining devices in the ordinary group must conduct a lottery to determine whether or not they can access the channel. This is particularly beneficial if an emergency incident occurs, as devices used by the emergency services can then be given priority access to the telecommunications network in that area.

In the UK, the government has created the Mobile Telecommunications Privileged Access Scheme ("MTPAS") for just such prioritisation in emergency situations. Under MTPAS, a request that emergency responders be given priority access to the network is sent from a relevant senior police officer to mobile network providers, such as Vodafone.

Following parallel opposition proceedings at the EPO, IPCom asserted two claim sets, an unconditionally amended set of claims filed in May 2019 following the preliminary decision of the EPO, and a further set of conditionally amended claims filed in the course of the oral hearing. The Judge held unconditionally amended claim 1 to be bad for added matter, but held the conditionally amended claim set to be both valid and essential.

However, the real point of interest in the judgment is that Vodafone successfully pleaded that its use of the relevant LTE access control mechanism when responding to an MTPAS request was covered by the defence of Crown use. The Crown use defence arises pursuant to s.55 of the Patents Act 1977 when a government department, or any person authorised in writing by a government department, infringes a patent without the proprietor's consent for the purposes of services of the Crown. S.56 includes a list of three circumstances which are to be considered Crown use (foreign defence purposes; the production or supply of specified drugs and medicines; and the production of, use of, or research into atomic energy), and s.59 includes a further list of special provisions which constitute Crown use during an emergency. In addition to submissions on Crown use from the parties during the trial, following the provision of an initial draft judgment to the parties the Judge received written submissions from the Comptroller, who had been invited to make observations on the basis the applicability or otherwise of the Crown use defence in the case involved a point of public interest. Subsequent to this, the parties then made further written submissions and the Judge revisited the draft judgment prior to handing it down.

It was common ground between the parties that Vodafone had written authorisation from the Crown to provide priority access to its network to the emergency services under the MTPAS scheme. However, the parties disputed three main points:

1. Whether using the claimed invention in response to an MTPAS request fell within the scope of "for services of the Crown";
2. Whether testing or keeping the equipment necessary to respond to an MTPAS request is an infringement of the patent irrespective of whether the operation used to respond to an MTPAS request itself benefits from a Crown use defence; and
3. Whether an authorisation to do a specific act implied an authorisation to infringe a patent not mentioned within that authorisation.

IPCom contended that s.56(2) provides an exhaustive list of the activities which may constitute "for services of the Crown", as if not there was little utility in the further list at s.59. Both Vodafone and the Comptroller argued that the use of the word "includes" in the statute indicated that the list was open ended. The Judge agreed that the list was non-exhaustive, and that the further list at s.59 did not impliedly limit s.56. The Judge held further that it did not follow that Crown use had to be directly for the benefit of the Crown, but that use by or for the protection of the Crown services, such as the armed forces, in the course of their duties was sufficient. He therefore concluded that the operation of the system to fulfil an MTPAS request is use "for the services of the Crown", because it is triggered by a request from a senior police officer operating under Cabinet Office authority, and it operates for the purposes of enabling the emergency service responders to better serve the public and to protect those responders themselves.

It followed that testing and keeping the equipment required to fulfil an MTPAS request was also within the scope of the Crown use defence, as they were ancillary acts and to exclude them from the scope of the defence would be illogical.

The final question to be answered was whether the authorisation under MTPAS to provide priority access to the network for the emergency services amounted to an authorisation for Vodafone to infringe IPCom's patent, even though the authorisation made no mention of any particular patents and the evidence before the Court was that it was not necessary to use the patent in order to comply with the scheme. S.55 is silent on how the authorisation should operate. IPCom and the Comptroller argued that (as a minimum), although it need not expressly identify a specific patent, the authorisation must require that the patent in question is necessarily infringed. Vodafone argued that not only did the authorisation not need to expressly identify the specific patent, in any event it did not need to be necessary to infringe the specific patent to carry out the authorised act for the defence of Crown use to arise. On a review of the case law the Judge found that there was no binding judicial opinion, and that it was open to him to choose between the argued positions.

The Judge agreed with Vodafone's proposition, and held that where a written authorisation identifies a specific act, then there is an implied right for the recipient of that authorisation to infringe any given patent in the course of conducting that act, irrespective of whether or not it is possible to do the authorised act without infringing that patent. He found so on the basis that he considered this to be the more natural reading of s.55, and that, in terms of operability, Vodafone's position was more functional than that of IPCom and the Comptroller, which would require "a raft of secondary questions as to whether it was also 'necessary' to infringe patent X", and create difficulties in scenarios such as where two methods to conduct an authorised act were available, but each route infringed a different patent owned by a different proprietor - in which case the defence of Crown use would fail in the event of using either method. Finally, he considered that as a point of policy the ultimate burden should fall on the person authorising the acts rather than the person conducting them.

Until now, Crown use has been rarely considered in UK patents cases. The pages on this topic, in otherwise well-thumbed practitioner textbooks, are invariably in pristine condition. It remains to be seen how often and in which circumstances Crown use will be in issue in telecommunications cases. However, there are already signs that Crown use may be relied upon in cases involving medicines, the major purchaser of which in the UK is often the government.

Please note that this judgment is not yet on Bailii, but we will update this post with the link once it is available.