

Kluwer Patent Blog

A (not so) Wii decision from the English High Court

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Computer games enthusiasts will be interested in this decision from the English High Court in which it was found that the Nintendo Wii and Wii U systems infringe two patents owned by Philips. And for those with World Cup Football fever... one of Philips' experts had previously done research which showed that in Geoff Hurst's controversial goal in the 1966 World Cup Football final, the whole of the ball did not cross the whole of the line.

There were three patents in issue. The first (EP'484) relates to "*modelling a virtual body in a virtual environment*" i.e. Wii games where the player stands/runs on a "Balance Board" in order to control movement on the screen (for example cycling games). The second and third patents (EP'498 and EP'650) relate to a hand held pointing device used to control electrical apparatus i.e. Wii games where the player swipes a handheld remote in order to control movement on the screen (for example tennis games). EP'650 is a divisional from EP'498.

Construction

One point of contention arose in relation to the construction of claims to computer apparatus. It was noted that "*virtual body modelling apparatus*" would ordinarily be construed as "*apparatus for virtual body modelling*", but the debate related to the meaning of the word "*for*". Nintendo argued that it merely meant "*suitable for*" whereas Philips disagreed, pointing to the EPO Guidelines for Examination which state that the data processing/computer field provides an exception to this general rule and that instead "*for*" means "*adapted to carry out the relevant steps/functions*". Noting that the EPO and UK Courts appear to have offered slightly different solutions, the trial judge, Birss J, emphasised that "*the fact that a general purpose computer can be programmed to become a virtual body modelling apparatus does not mean that a general purpose computer is a virtual body modelling apparatus nor is it an apparatus suitable for virtual body modelling*". He did, however, observe that this finding may have an effect on what could be held to be a means relating to an essential element of the invention for the purposes of indirect infringement.

Added matter

Philips had applied conditionally to amend certain claims of each of the patents. Whilst the principles to be applied in relation to added matter were not in dispute, even the judge acknowledged that application of these principles can be tricky.

In relation to EP'484 the Judge noted that the fact an amendment is a generalisation does not

necessarily mean it is unallowable. The judge ultimately rejected all of the added matter arguments in relation to this patent, but in doing so he noted (citing *AC Edwards v Acme*) that “*although the language in claim 9 is a generalisation as compared to what has been disclosed expressly and by necessary implication in the application as filed, the patent as amended does not disclose any method or apparatus which is not disclosed in the application. It is capable of covering things which are not disclosed, but that is not the test for added matter.*”

In relation to EP’498 and EP’650, claim 1 as granted included the words “*at least one room localisation beacon*” (these beacons are used to analyse what the pointing device held by the user is pointing at in the room). Birss J observed that the skilled addressee would know that the primary purpose of claims is to delineate the monopoly and define the invention but they are also part of the disclosure of the document. He held that claim 1 as granted did add matter as the skilled team would get the idea from the disclosure of claim 1 that one of the things the skilled addressee could build if they put the ideas in the document into practice was a system with a single beacon in it (rather than multiple beacons as had been disclosed in the application).

In contrast, Birss J held that the proposed amendment to claim 1 did not add matter. In doing so he noted that whilst the question of whether there is any added matter has to be decided by considering the disclosure to a skilled person in the light of the CGK, the CGK cannot be used to add to the disclosure, even if it would be obvious to the skilled person that a part of the disclosure had been missed.

Double patenting

The Judge considered the UK and EPO case law in detail in order to define exactly what double patenting is, and derived seven key principles (at paragraphs 302 – 309). He found that as a matter of UK law, a post-grant amendment should only be refused on double patenting grounds in circumstances where: (i) the two patents have the same priority dates and are held by the same applicant/successor in title; (ii) the claims are for the same invention (same subject matter and scope); (iii) the claims are independent claims; (iv) if the objection arises in the Patents Court in which both patents are before the Court then it can be cured by amendments to either patent; and (v) if the patentee has a legitimate interest in maintaining both claims then the amendment should not be refused. In the circumstances he found there was no double patenting.

Infringement

The judge rejected Philips’ argument that a Wii console in the state it is sold directly infringed any of the patents. This was on the basis that to be within the claims a disk carrying relevant software at least has to have been inserted into the Wii unit (and for EP’484, a Balance Board connected). For both patents, he held that there was infringement if the relevant software (different for EP’484 than for EP’498 and EP’650) was being played.

Philips also argued that Nintendo indirectly infringed the patents, the question being what constituted the “*means essential*”. The Judge concluded that a hardware package sold bundled with a Balance Board and a disk carrying relevant software amounts to the supply of a means relating to an essential element for putting the invention of EP’484 into effect (similarly for the other patents, but which did not require the Balance Board). The trickier question was whether the hardware without a disk of relevant software, or the Balance Board) is a means essential. The judge held that a Wii console alone is a means essential in that it is suitable for putting the invention into effect

when married up with the balance board (for EP'484 only) and disk of relevant software. Moreover, the Wii console alone is a critical part of the combination.

Novelty and Obviousness

All of the claims of EP'484 were found to be obvious over the prior use of a Nintendo NES console when used in conjunction with a device called the Power Pad of Bandai to play a computer game called World Class Track Meet (WCTM).

The judge found EP'498 and EP'650 as amended to be novel and inventive. Although both patents were granted with broader claims, those broader claims were generally invalid.

It is not yet known if Nintendo will apply for permission to appeal against the decision.

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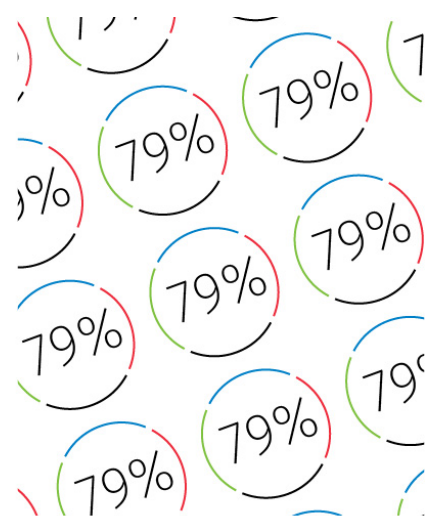
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