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Gemalto’s UK appeal dismissed

Brian Cordery, Naomi Hazenberg (Bristows) · Friday, October 24th, 2014

Appeal (Ref [2014] EWCA Civ 1335) has upheld Birss J’s decision last year in HTC v Gemalto (Ref [2013] EWHC 1876 (Pat)) but has found that he erred on a point of construction. The appeal concerned just one of the patents considered at first instance (EP (UK) 0932865) which relates to using higher level programming with a microcontroller. Only claim 3 (and its dependent claims) survived the attack on validity at first instance and HTC’s devices were held not to infringe.

At first instance, the judge needed to construe the term “microcontroller”. As it was not an expression used in ordinary English, expert evidence was admissible. The meaning in the context of the specification was also considered as it was recognised that the term could have been used in the patent in a specific context or in totally different sense altogether. Considering the use of this term in the art, Birss J held that the use of the term did not extend to a chip that had no “on-chip” memory. Despite Gemalto’s attempt to give examples to the contrary, the Court of Appeal found that this conclusion was correct. It was noted the judge was better placed to make a finding of that type than the Court of Appeal and that, unless it was clear that evidence was ignored or erroneously considered or that the conclusion was plainly wrong, a finding of this type should not be interfered with.

However, in considering the term in the context of the patent, the Court of Appeal found that too wide a construction was given to the term when it was found to extend to a microprocessor that may able to access “off chip” memory provided that there was at least some “on-chip” memory. As the patent was aimed at providing a microprocessor system that worked within the constraints of the memory that could be accommodated in the integrated circuit, allowing it to encompass an essentially unconstrained amount of “off-chip” memory was not the type of minor variant that would be read into the scope of the claim. Having adopted the a construction that required all of the microprocessor’s memory to be “on-chip”, the Court of Appeal found that HTC’s devices did not infringe the patent.

The final point to consider was whether claim 3 of the patent was entitled to priority. The priority document disclosed a particular method of compacting an application program, called namespace mapping. The question for the court was whether this disclosure was sufficient to support a claim that was broad enough to encompass all compaction methods or whether, by an intermediate generalisation, this fell foul of the rules on priority. The Court of Appeal confirmed that what must be considered in the priority document is what was disclosed to the skilled person, rather than what was obvious in light of the common general knowledge. However, the priority document should not be read in a vacuum. The knowledge and background of the skilled person can be considered in

determining what is disclosed. Taking this into consideration, the Court of Appeal confirmed Birss J's decision that the skilled person would not feel, given their knowledge of many compaction methods, that they had strayed from the teaching of the priority document by using a method other than namespace mapping. Indeed, the priority documents common theme of space and time efficiency was such that it taught a principle of general application that was reflected in the granted claim.

This contextualisation of the disclosure of the priority document seems to provide a slight respite for patentees to the strict application of the law on priority that was seen as a theme throughout many of the recent cases.

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