

Kluwer Patent Blog

“Sleeping” features and patent infringement

Markus Lenssen (Rospatt Osten Pross) · Wednesday, September 16th, 2015

In its decision *Digitalblock* (digital block) the Higher Regional Court of Düsseldorf (Oberlandesgericht Düsseldorf) has discussed the question whether “sleeping” features of a device can cause patent infringement (judgement of 19 February 2015, docket No. I-15 U 39/14). The case was about set-top boxes for receiving free-to-air and encrypted television signals. The patent concerned a specific form of encryption using a specific algorithm and the device claim at stake required various features of such a device including inputs, logic means and a special algorithm. The attacked set-top boxes did not perform this special algorithm but contained freely available program libraries in their firmware that were capable to perform the special algorithm. However, the special algorithm needed to be activated by calling a certain program function by the user. There was no documentation about this function or just the fact that the special algorithm was (sleepingly) included in the firmware.

Even though the algorithm was included in the firmware the court did not find for direct patent infringement. At first, it had to be regarded that the set-top boxes could be used as intended (for free-to-air and for encrypted pay-TV likewise) without using the special algorithm.

Secondly, as it was not known to the user that the special algorithm was included in the firmware at all. Therefore, it could not be assumed that the user would use the function to activate the algorithm at all. Using the function to activate the algorithm required manipulation of the firmware which could not be expected by normal users. In addition, the defendant has not instructed or otherwise lead the users to the special algorithm.

Under these circumstances the court found that if one of the features is missing and needs to be “added” by the users there is only room for direct patent infringement if the circumstances give reason to assume that the users will certainly perform the missing features. In this case however, it could only be assumed that at best a small amount of users that have special knowledge in computer science or that intentionally want to get illegal access to encrypted media would actually activate the special algorithm.

The court also negated indirect infringement of the patent as the set-top boxes – although in principle capable to perform the special algorithm – were clearly not intended to do so. The set-top boxes could well be used in a way not infringing the patent.

In essence, a device that does not show all features of a patent claim can be regarded as directly infringing the patent nevertheless if the user will naturally and certainly change the device in an unsubstantial way so that all features will be fulfilled. For instance, this could be the case if the

user is lead to such an alternation by the supplier. However, if it is not known that such an alternation is possible and if some special knowledge is required to do so there is no room for patent infringement even though the feature is included in the device but deactivated and sleeping.

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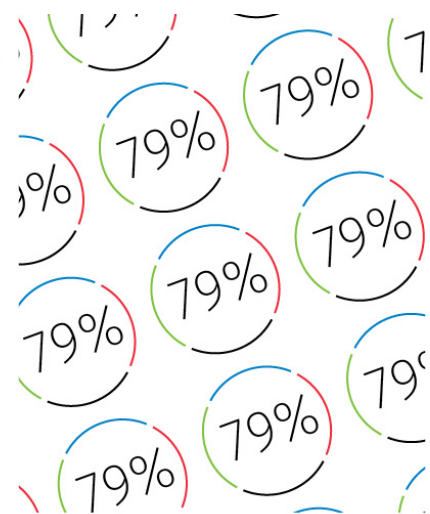
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