EIP

Court of Appeal ends anticipation for InterDigital's 3G Standard Essential Patent by revisiting claim construction

This Update deals with an interesting determination of the Court of Appeal before Lord Justices Lewison, Asplin, and Arnold where they overturned a finding of anticipation (lack of novelty) made by Justice Mellor in the High Court.

The Patent

The appeal was for Technical Trial B, one of a number of trials between the parties relating to standard essential patents (SEPs) and FRAND. The patent in suit (European Patent (UK) No. 3,355,537) related to a procedure for selecting an upper limit on the amount of data transmitted by a mobile device. Mellor J held that the claimed invention mapped to the 3G standard[1] and was therefore essential and infringed by Lenovo.

Claim 5 was a method claim, including the step of

"limiting [data multiplexed into a data unit], to the largest [one of a group of pre-set sizes] that is smaller than [an amount of] data allowed by [grants] and available for transmission"

Claim 1 was an apparatus claim, directed to a "means for" performing the limiting, the limiting being described using the same language as claim 5. The use of 'means for' language in a patent claim is now relatively uncommon due to the very narrow

construction applied in the US. In this UK case, it was common ground at appeal that this should be interpreted as means "adapted for" or "programmed to".[2]

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The Prior Art

The prior art ("Filiatrault") was a proposed revision to the then-current version of the technical standard (TS) 25.309 v6.2.0 and alleged by Lenovo to anticipate the claims. Although, in certain circumstances, the processing described in Filiatrault would result in the same outcome (amount of data) as the claimed procedure, Filiatrault did not select a pre-set size in arriving at a limit.

Anticipation and Claim Construction

At first instance, it was held that the claims lacked novelty over Filiatrault based on a construction of 'means for' in the apparatus claim (and the corresponding method step) which required only the outcome to match: Mellor J stated that "it is satisfied by any means which bring about the stated result".[3] He found that it was therefore not necessary that the outcome was reached using the specific approach recited in the claim, and the claim was therefore anticipated by the scope of the disclosure of Filiatrault.

The Court of Appeal decided two key issues as follows:

1. 'Means for'

First, the language 'means for' did not require the means to be used all the time because "the method claims plainly cover use of the method some of the time even if it is not used at other times, and … it follows that the apparatus claims should be interpreted in the same way".[4]

At first instance, it was determined that the method of claim 5 is not used all the time, meaning that the data limit specified by the standard would not always match the data limit determined according to claim 5. Thus, as at first instance, the assessment of this "temporal issue"[5] was answered by reference to the method claim.

2. Same construction for method and apparatus claims

Second, agreeing with InterDigital, both the apparatus and method claims should be construed to require that the particular one of the pre-set sizes is selected and used in the limiting: "it is not sufficient that, at the end of a process, the … data happens to fit within the [pre-set size selected according to the claim]" . On the contrary, the claim requires "the [pre-set size] to be identified (or selected or chosen) and used to limit the … data".[6]

Lenovo had argued that this construction involved writing words into the claim. It further argued that it would make sense to direct the claim only to the result and not the specific manner in which it was obtained, because the standard specified only what was ultimately transmitted over the air (i.e. the result), and the patentee would not have wanted to restrict the scope of the claim to a particular method. These arguments were not persuasive. Rather, the Court of Appeal pointed to

a. the words of the claim, which indicate that the limiting is positively based on the selected pre-set size, and
b. the inventor's purpose, to ensure that the selected pre-set size acted effectively as a limit.[7]

The Court of Appeal also found it helpful to refer to the principle set out in Virgin Airways Ltd v Premium Aircraft Interiors UK Ltd,[8] that where prior art is acknowledged in the patent (in this case, by reference to the standard on which Filiatrault was based), "the court should lean against a construction"[9] which would cover that prior art.

On this construction, Filiatrault (which only 'incidentally' arrived at the correct result, some of the time) was found not to anticipate the claims, thus overturning the first instance decision of Mellor J. The Court of Appeal noted in particular that at first instance, Lenovo's expert witness confirmed that, in Filiatrault, "the UE would limit the amount of [data] to be within the [size]". This was considered to be "a sleight of hand in the cross-examination",[10] as the expert was not asked whether the size was used to limit the amount of data.

Infringement/Essentiality

Holding that the first instance decision on Infringement/Essentiality was based on a claim construction not materially different from this claim construction, the Court of Appeal confirmed that, if valid, the patent was infringed and essential.

Court Entitled to Revisit Claim Construction

There was a dispute as to whether the construction advanced on appeal by InterDigital (which required the pre-set size to be selected) was a new one or not. InterDigital contended that it was not new, and relied on the report and cross-examination of Lenovo's expert at first instance, which was said to be consistent with the construction relied upon at appeal.

Construction is a matter for the court, and expert evidence on construction per se is not admissible. However, as Arnold LJ explained "[i]t is nevertheless often appropriate, and indeed necessary, for the experts to set out their understanding of the meaning of the claims, because the opposing side and the court need to know the interpretation upon

which the expert's evidence as to issues such as novelty and obvious[ness] is premised" . [11]

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Upon the finding that Lenovo's expert had understood the claim in a manner consistent with InterDigital's construction, it was held that the construction was not new and that Lenovo could not be prejudiced by it being advanced on appeal.

The Court of Appeal therefore affirms in this decision that it is entitled to revisit a claim construction issue, by reference to evidence given at first instance and without the need for further evidence.

Link to judgment: InterDigital v Lenovo [2023] EWCA Civ 105

[1] TS 25.309

[2] [74]

[3] [2022] EWHC 10 (Pat) at [184]

[4] [62]

[5] [86]

[6] [82]

[7] [84]

[8] [2009] EWCA Civ 1062, [2010] RPC 8 at [13] per Jacob LJ

[9] [95]

[10] [88]

[11] [69]