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Abuse of Process – Patentee does not have to assert all known means of infringement

A decision from Mr Justice Birss inAdaptive Spectrum And Signal Alignment Inc v British Telecommunications Plc[2014] EWHC 4194 has introduced additional complications for parties found to infringe a patent who then seek to work around the same. In essence that party cannot simply sit back and assume that the only feature to address is that which was successfully attacked by the patentee. Instead that party must now consider whether their product or system might infringe in other ways (and work around the same as well).

The judgment stems from an infringement action brought by Adaptive Spectrum And Signal Alignment Inc. (ASSIA) against BT for infringement of two of its patents. BT's "Next Generation Access" (NGA) broadband access network was found (first instance and appeal) to have infringed ASSIA's patent EP (UK) 1,869,790.

Following the first instance ruling BT altered the NGA system with a view to rendering it non-infringing. Without delving into detail, BT argued that a particular table (the Cap Level Table) was no longer used in a particular loop routine, which (for various reasons) was said to take the NGA system outside of the patent. ASSIA however pointed to a different table in the NGA system (the so-called Service Profile Table) which it said did still perform a relevant function and thus the NGA system continued to infringe despite BT's adaptations.

In addition to a consideration of the infringement arguments (which I shall not consider here – use of the Service Profile Table did give rise to infringement) Mr Justice Birss had to consider whether ASSIA's reliance upon the Service Profile Table (which had been in

the NGA product at the time of the initial infringement action but which had not been relied upon by ASSIA) was an abuse of process.

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Repeating the principles set out by Lord Bingham in Johnson v Gore Wood [2002] 2 AC 1 that:

· "a party should not be vexed twice in the same matter";

· "bringing a claim which should have been raised in earlier proceedings may, without more, amount to abuse";

· "it is wrong to hold that because a matter could have been raised in earlier proceedings it should have been, so as to render raising it in later proceedings necessarily abusive; and.

· "the correct test was a broad merits based judgment focusing on whether a party is misusing or abusing the court's process"

Mr Justice Birss went on to find that, despite proceeding on the assumption that ASSIA could have advanced the Service Profile Table infringement case as part of the earlier trial, there was no reason for ASSIA to have run that argument (presumably because the Cap Level Table infringement was enough):

"The crucial point is that the system alleged to infringe at trial was one thing whereas the system being considered now is another different one. ASSIA established that the original NGA system infringed. That was not a warrant that a different system did not. If the infringement case at trial had been concerned only with distinct and clearly separable adjunct to the NGA system and, after a finding of infringement by that adjunct, the defendant removed it, then I can see that a defendant in such a case might have grounds to complain about abuse of process if the patentee turned round and said for the first time - oh well the system without the adjunct still infringes."

As noted at the start of this piece, this finding undoubtedly complicates the process of designing any work-around. A party found to infringe a patent not only needs to consider how to modify the known accused elements of the product/system but it will also want to identify whether there are any non-accused elements that could fall within the scope of the claims in order to work around those as well. Failure to do so, while then implementing the work-around of the known infringing aspects, could well create a 'new' product/system and enable the patentee to issue a further attack under the same patent against the pre-existing feature. As the judgment also makes clear that further points of construction can be considered at the time when the patent is re-asserted, this is not necessarily a straightforward task. It will also be interesting to see how unsuccessful

patentees try to rely upon this decision when assessing their options after a first (and normally final) unsuccessful trial/appeal.

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