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Smart card patents that were not so smart

In HTC Corporation v Gemalto SA and HTC Corporation v Gemalto NV [2013] EWHC 1876 (Pat), Mr Justice Birss ruled upon the validity and infringement of two telecommunications patents concerning smart/chip card technology. The Claimant came to the High Court of England and Wales seeking revocation of the patents; the Defendant counterclaimed for infringement.

The 865 patent

The 865 patent, entitled 'Using a High Level Programming Language with a Microcontroller', was said to relate to using a high level programming language with a smart card or microcontroller. Gemalto contended that claims 1, 3, 8, 9, 15 and 18 were independently valid, and save for claim 9, they were all infringed by the HTC's smartphones. In particular, HTC's use of the Google Android system was the subject of those infringements.

The claims all refer to a "microcontroller" and perhaps the key argument on construction was whether the mobile devices in issue had microcontrollers at all. HTC argued that the "microcontroller" was simply a single chip which contained a CPU and had all of its memory on the chip. Gemalto contended that the microcontroller in the context of the claims was "a dedicated system". It further argued that the memory did not have to be on the same silicon substrate as the CPU. On HTC's construction one simply had to look at the chip to determine whether it was a microprocessor, on Gemalto's construction one looked at the system as a whole.

Mr Justice Birss rejected Gemalto's construction finding that the language of the specification favored HTC. On this basis he found that the HTC devices did not contain a "microcontroller" inside them and therefore did not infringe any of the claims of the

patent. In any event, a lack of priority resulted in a finding that claims 1, 8, 15 and 18 were obvious over an intervening publication "Cyberflex", with claims 1 and 15 additionally lacking novelty.

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The 9062 patent

The 9062 patent, entitled 'Smart Card Reader', was said to relate to the communications between a reader (in this instance, the HTC smartphone itself) and a smart card (the SIM card in the HTC smartphone). HTC contended the patent lacked novelty and/or was obvious a European Patent Application (Diehl) and "GSM 11.PQ"; a standard for SIM - Mobile Equipment interfaces.

Diehl did not appear to trouble the court a great deal, and Mr Justice Birss dismissed the obviousness attack that this art was said to present. GSM 11.PQ, was a different story as Gemalto argued that GSM 11.PQ did not form part of the state of the art.

On the facts, Mr Justice Birss found that GSM 11,PQ was never regarded as "confidential" by those handling it, was in effect "public", and was thus available for novelty purposes. On Gemalto's construction of claim 1, GSM 11.PQ did not anticipate because although the equipment it described was capable of generating different sequences of requests and reports, that did not always happen. Birss J did not agree with this construction and instead concluded that it was irrelevant that the equipment (in GSM 11.PQ) "does other things" – it clearly generated the request and response messages called for. Birss J accordingly held that the 9062 patent was invalid over his art. Had it been held valid, the HTC smartphones would have infringed.

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