EXTRA JUDICIAL ENFORCEMENT: CROSSING BORDERS

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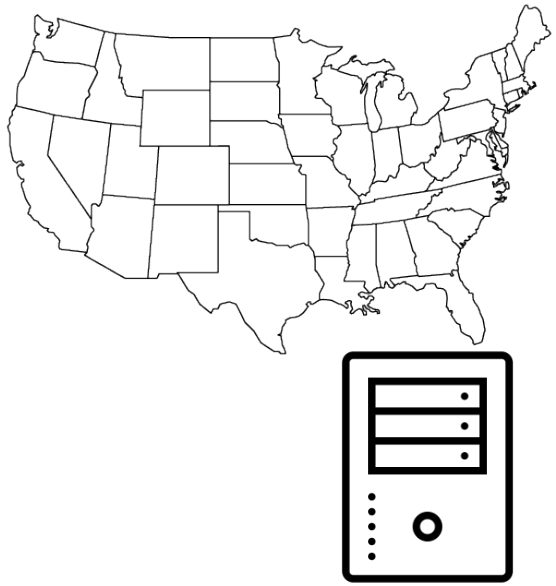
THE BASIC SCENARIO



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DIRECT INFRINGEMENT

UK Patents Act 1977 as amended:

Section 60

(1)Subject to the provisions of this section, a person infringes a patent for an invention if, but only if, while the patent is in force, he does any of the following things in the United Kingdom in relation to the invention without the consent of the proprietor of the patent, that is to say—

(a)where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise;

(b)where the invention is a process, he uses the process or he offers it for use in the United Kingdom when he knows, or it is obvious to a reasonable person in the circumstances, that its use there without the consent of the proprietor would be an infringement of the patent;

(c)where the invention is a process, he disposes of, offers to dispose of, uses or imports any product obtained directly by means of that process or keeps any such product whether for disposal or otherwise.

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INDIRECT INFRINGEMENT

UK Patents Act 1977 as amended:

Section 60

(2) Subject to the following provisions of this section, a person (other than the proprietor of the patent) also infringes a patent for an invention if, while the patent is in force and without the consent of the proprietor, he supplies or offers to supply in the United Kingdom a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the United Kingdom.

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HOW DOES THE UK APPROACH DIFFER FROM THE US APPROACH?

1. Extraterritorial acts

Supplying in/from the US components of a patented invention for combination abroad can infringe a US patent if combining them in the US would infringe the patent (35 U.S.C. 271(f)(1)/(2); Life Technologies Corp. v. Promega Corp.)

UK law has no corresponding provision addressing combining components abroad

Could draft a claim to a "kit of parts" (components in uncombined form), which would make disposing (including exporting) of the kit an act of infringement

But not easy to draft – could you satisfy an EPO Examiner that such a claim was clear?!

And section 60(2) covers only supply of a component to a person in the UK for putting the invention into effect in the UK (with knowledge) – it won't help catch an exporter of anything less than the full set of components

Only option is to draft a claim to the individual component – but would such a claim be novel?

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HOW DOES THE UK APPROACH DIFFER FROM THE US APPROACH?

1. Extraterritorial acts (cont'd)

But the provision which makes it an infringement of a UK patent directed to a process to deal in the direct product of the patented process is not limited to processes carried out in the UK and covers dealing in the direct product of a process carried out anywhere

(PA1977, as amended, s. 60(1)(c)) – 35 U.S.C. 271(g) is similar

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HOW DOES THE UK APPROACH DIFFER FROM THE US APPROACH?

2. Method claims and system claims

Section 271(a) is drafted quite generally and just refers to a "patented invention" with no distinction between inventions which are products and inventions which are processes: "whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent therefor, infringes the patent".

But in NTP v. RIM the Court declared the concept of "use" of a patented method or process is fundamentally different from the use of a patented system or device for the purposes of section 271(a)

A process cannot be used "within" the US as required by section 271(a) unless each of the steps is performed within the US

The same didn't apply to a system, which could be used "within" the US even when an element of the system was located outside the US

UK case law does not appear to treat methods and systems differently: in principle, a method can be "used" in the UK even if a step is performed outside the UK

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MENASHE BUSINESS MERCANTILE V WILLIAM HILL

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A SYSTEM WITH A SERVER OUTSIDE THE UK CAN BE USED IN THE UK

Per Aldous LJ:

"If the host computer is situated in Antigua and the terminal computer is in the United Kingdom, it is pertinent to ask who uses the claimed gaming system. The answer must be the punter.

Where does he use it? There can be no doubt that he uses his terminal in the United Kingdom and it is not a misuse of language to say that he uses the host computer in the United Kingdom. It is the input to and output of the host computer that is important to the punter and in a real sense the punter uses the host computer in the United Kingdom even though it is situated in Antigua and operates in Antigua.

In those circumstances it is not straining the word 'use' to conclude that the United Kingdom punter will use the claimed gaming system in the United Kingdom, even if the host computer is situated in, say, Antigua.

Thus the supply of the CD in the United Kingdom to the United Kingdom punter will be intended to put the invention into effect in the United Kingdom."

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DRAFTING CONSIDERATIONS

A gaming system for playing an interactive casino game, comprising:

a host computer,

at least one terminal computer forming a player station,

communication means for connecting the terminal computer to the host computer, and

program means for operating the terminal computer, the host computer and the communication means,

wherein:

the terminal computer has program means for: … generating a simulation output appropriate to a game including an account status of a player playing the game; …

the host computer has program means for: …

characterised in that:

- processing is distributed between the host computer and the terminal computer such that a game result and an account status are processed at the host computer and the simulation output is processed at the terminal computer so that only the minimum relevant information is transmitted between the host and terminal computers; …

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DRAFTING FOR DIRECT INFRINGEMENT – THE TERMINAL COMPUTER BY ITSELF

A terminal computer, connectable by communication means to a host computer to form with the host computer and the communication means a gaming system for playing an interactive casino game, the host computer having program means for: …, the terminal computer having:

terminal program means for: … generating a simulation output appropriate to a game including an account status of a player playing the game; …

characterised by:

terminal processing means, co-operable with host processing means of the host computer when the gaming system is in use, to distribute processing between the host computer and the terminal computer such that a game result and an account status are processed at the host computer and the simulation output is processed at the terminal computer so that only the minimum relevant information is transmitted between the host and terminal computers; …

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DRAFTING FOR DIRECT INFRINGEMENT - THE PROGRAM FOR THE TERMINAL COMPUTER

A computer program, adapted to be loaded into a terminal computer connected by communication means to a host computer to form with the host computer and the communication means a gaming system for playing an interactive casino game, the host computer having program means for: …, the computer program having:

instructions for: … generating a simulation output appropriate to a game including an account status of a player playing the game; …

characterised by:

instructions which cause terminal processing means of the terminal computer to co-operate with host processing means of the host computer when the gaming system is in use, to distribute processing between the host computer and the terminal computer such that a game result and an account status are processed at the host computer and the simulation output is processed at the terminal computer so that only the minimum relevant information is transmitted between the host and terminal computers; …

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DRAFTING FOR DIRECT INFRINGEMENT - THE PROGRAM FOR THE TERMINAL COMPUTER

NESTED FORMULATION REFERRING TO TERMINAL COMPUTER CLAIM (or even to the system claim)

2. A computer program which, when loaded into a computer, causes the computer to become the terminal computer of claim 1.

BIT LAZY! WHAT WILL AN INFRINGEMENT COURT MAKE OF SUCH A CLAIM?

CLAIMING THE PROGRAM IN ALL ITS FORMS (don't try this in the USA…)

3. A computer program according to claim 2, carried by a carrier medium.
4. A computer program according to claim 3, wherein the carrier medium is a storage medium.
5. A computer program according to claim 3, wherein the carrier medium is a transmission medium.

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FOR DISCUSSION…

Q1. What if the program for the terminal computer was downloadable, e.g. from the host computer, rather than supplied on the CD-ROM?

- Does "means relating to an essential element of the invention" have to be something physical?
- If not, why not a downloaded program?
- And what about a webpage, esp. one displaying certain messages and accepting certain inputs?

Q2. What about indirect infringement of a method claim?

- Does anything preclude indirect infringement of a method or process by supply of means relating to an essential element of the [method or process] invention?
- What is the "means" in this case? A step of the method that is carried out in the jurisdiction? Or – maybe more likely – a program or other thing supplied to someone in the jurisdiction for putting the [method or process] invention into effect in the UK?

Q3. What if Menashe had sued a punter for direct infringement in the UK, i.e. for using the gaming system in the UK?

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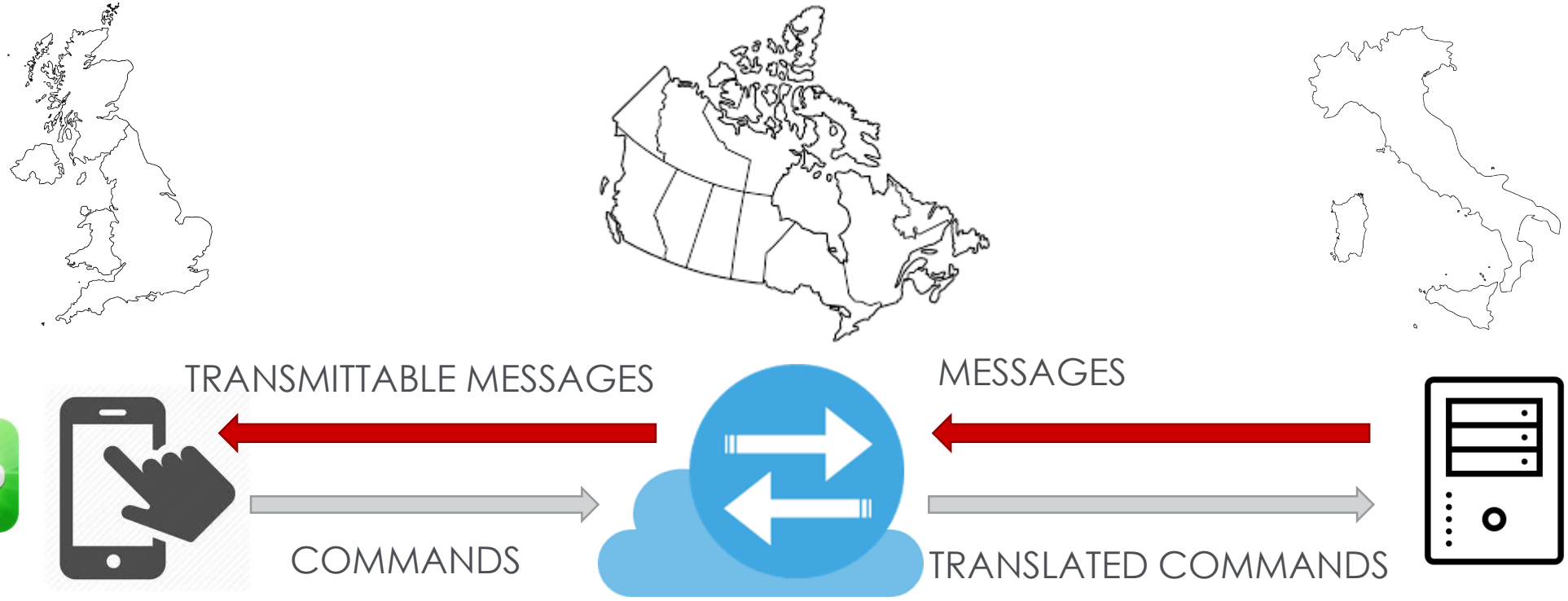
RIM V MOTOROLA



SUBSCRIBER DEVICE
(WITH APP)

MESSAGING
GATEWAY SYSTEM

REMOTE MESSAGING
SYSTEM

RIM V MOTOROLA

A method of operating a messaging gateway system (20)

operable to receive messages from a remote messaging system (30),

and to construct transmittable messages including portions of the messages received from the remote messaging system,

the method characterised by the messaging gateway system (20):

receiving a set of commands from a wireless subscriber device (28) using an RF transmission system;

translating the set of commands into a protocol understood by the remote messaging system; and

transmitting the translated commands to the remote messaging system such that a user of the subscriber device can control the operation of the remote messaging system utilizing commands transmitted to the remote messaging system.“

Per Arnold J: *“I agree with RIM that asking and answering Aldous LJ's questions in [Menashe] leads to a different answer. Who uses the method of operating a messaging gateway system that has the claimed features? The answer is RIM. Where do they operate it? The answer is in Canada”.*

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RIM V MOTOROLA – COULD WE DO BETTER?

The effect or benefit of the invention seems to be that "a user of the subscriber device can control the operation of the remote messaging system utilizing commands transmitted to the remote messaging system".

Would the outcome have been different if the method claim was directed to a method of controlling a remote messaging system (30) instead of a method of operating a messaging gateway system (20)?

This shifts the focus to the user:

- The remote messaging system is in the possession or control of the user (not the operator of the messaging gateway system)
- A user in the UK benefits – in the UK - from the claimed method by being able to control the remote messaging system from there, even if the remote messaging system is not in the UK

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RIM V MOTOROLA – COULD WE DO BETTER?

A [user-performed??] method of controlling a remote messaging system (30) comprising:

using a messaging gateway system (20), which is operable to receive messages from the remote messaging system (30) and to construct transmittable messages including portions of the messages received from the remote messaging system, to:

receive a set of commands from a wireless subscriber device (28) using an RF transmission system;

translate the set of commands into a protocol understood by the remote messaging system; and

transmit the translated commands to the remote messaging system such that a user of the subscriber device can control the operation of the remote messaging system utilizing commands transmitted to the remote messaging system.

Would this lead to different answers to the questions the judge asked:

Who uses the method of controlling a remote messaging system that has the claimed features? The answer is the user ~~RIM~~. Where do they use ~~operate~~ it? The answer is in the UK ~~Canada~~".

But to catch RIM they have to supply the user in the UK with means relating to an essential element of the invention – a smartphone ("the subscriber device") or at least an smartphone app

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RIM V MOTOROLA – COULD WE DO EVEN BETTER?

A [user-performed??] method of controlling a remote messaging system (30) comprising:

using a messaging gateway system (20), which is operable to receive messages from the remote messaging system (30) and to construct transmittable messages including portions of the messages received from the remote messaging system, to co-operate with control means of a wireless subscriber device to :

receive a set of commands from the ~~a~~ wireless subscriber device (28) using an RF transmission system;

translate the set of commands into a protocol understood by the remote messaging system; and

transmit the translated commands to the remote messaging system such that a user of the subscriber device can control the operation of the remote messaging system utilizing commands transmitted to the remote messaging system.

Now the means relating to an essential element (a control means of the subscriber device, which co-operates with the messaging gateway system) is recited positively in the claim

Could also have a dependent claim reciting that the control means comprises a processor which executes a program or an app

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Means relating to an essential element

SUBSCRIBER DEVICE (WITH APP)

MESSAGING GATEWAY SYSTEM

REMOTE MESSAGING SYSTEM

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OTHER EUROPEAN COUNTRIES & BEYOND

	France	Germany	Netherlands	Sweden	Japan
Likely to follow approach in Menashe ?	✓ (but for process all steps in France?)	✓	✓	✘	? – but for process all steps in Japan so far
Considerations	Who uses the system? Is the system used in France? Is the location of the server relevant? Does the accused actor target persons in France? (ECJ: Football Dataco v. Sportsradar)	Are the actions outside of Germany wilfully intended to have a direct impact on the national German market? ("Prepaid Telephone Card" Decision of the Higher Regional Court Düsseldorf)	Who applies the system? Where is it being used? Where is the system controlled? Where are its benefits enjoyed?	Territorial effect of the patent law means activities abroad cannot contribute to SE infringement. No Swedish patent case law on this, In a design case, activities abroad could not contribute to a Swedish infringement.	JP courts don't want to be seen as an outdated jurisdiction in the eyes of corporations so could follow Europe & US

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THANK YOU!