

IN THE HIGH COURT OF JUSTICE
COURT OF APPEAL (CIVIL DIVISION)
ON APPEAL FROM THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
PATENTS COURT
The Hon Mr Justice Mann
[2009] EWHC 3068 (Ch)

Royal Courts of Justice
Strand, London, WC2A 2LL

Date: 29/03/2011

Before:

THE RT HON LORD JUSTICE LAWS
THE RT HON LORD JUSTICE JACOB
and
THE RT HON LORD JUSTICE PATTEN

Between:

(1) Gemstar-TVGuide International Inc
(2) Starsight Telecast Inc
(3) United Video Properties Inc
- and -
(1) Virgin Media Ltd
(2) Virgin Media Payments Ltd

Claimants/
Appellants

Defendants/
Respond-
ents

Mr Daniel Alexander QC and Mr Douglas Campbell (instructed by Bird & Bird LLP)
for the Claimants/Appellants
Mr James Mellor QC and Mr Andrew Lykiardopoulos (instructed by Marks & Clerk)
for the Defendants/Respondents

Hearing dates: 22 and 23 February 2011

Judgment

Lord Justice Jacob:

1. Gemstar (as I call all the claimants) sued Virgin (as I call all the defendants) for infringement of three EP UK patents, Nos. 0969662, 1377049 (“Favourites”) and 1613066 (“Transfer”). Virgin denied infringement and counterclaimed for revocation. The trial judge, Mann J, held that all three patents were invalid. Gemstar originally appealed in respect of all three patents but in the end confined their appeal to the Favourites and Transfer Patents.
2. The Judge found the Transfer Patent lacked novelty over a prior published patent application of Toshiba (10-03905) published on April 10th just before the priority date of the Transfer Patent, namely 17th September 1998. It was agreed to hear the argument about anticipation first and only proceed to hear other points in the appeal if we had not formed a clear view that he was right. In the event we did, with the result that we heard no argument about any other points.
3. The Judge found the Favourites Patent lacked novelty over prior art called SuperGuide. His finding of anticipation turned on his construction of claim 1. Before us it was agreed that unless the Judge was wrong on construction, the appeal would fail. So again it was agreed that we should hear just the arguments about construction first and only proceed to hear other arguments if we had not formed the clear view he was right. Again in the event we did.
4. The parties were told of our decisions. These are my reasons for them.

General Background

5. Mann J described this in a manner uncriticised by either side so I borrow with gratitude:

[2] At the heart of these three patents is the concept of an EPG - an electronic programming guide. In the past 30 years or so the number of television broadcasting stations (including cable and satellite stations) has increased enormously in many countries (and in particular in the US). Each broadcaster wishes the consumer to know what programmes are being or are to be broadcast. Until the advent of electronic means of broadcasting this information was disseminated principally in paper form, of which the best known English publication was (and is) the Radio Times. The listing information took various forms. It could be lists of programmes (with supporting information about those programmes) listed by broadcasting channel, and by time within each channel, in the form of an elaborate chronological list. That form will be familiar to anyone who has used the Radio Times or the independent television equivalent, the TV Times. It could be a listing by start times, with each programme starting at a given time appearing by that start time, and then by channel within the start time. Or it could be by way of a grid, with start times on one axis and the channel on the other, with each cell representing the particular programme being broadcast in the

cell (and bearing the name of that programme). In that last form the cells would be of irregular length, because not all TV shows are of the same duration. The left and right hand borders of the cell represent the start and finish times when read against the time axis. Each of those methods of listing has its benefits, and a choice between them will depend on the preferences of the information providers and/or the subscribers to the lists. Sometimes one sees both formats in one publication - I was shown US guides which had both a grid (which enables more of an overview) and start time listings (which allows for a little more detail for each programme). Written listings also contain some notes about the programmes in question, sometimes by the actual listing, and sometimes separately on the page.

[3] The increase in the number of channels means that the size of the listings has increased, making their survey, and choice from them, more difficult. One answer to this problem is to provide lists electronically to the subscriber of the TV service so that it can be viewed on the screen. The information can be transmitted by various means, but now the most common is over the air by one or more service providers. By calling up the relevant list, and looking up the relevant day, time and channel, the viewer can see what programme is being broadcast at the relevant time. Background information about that programme (type, cast list and so on) can also be broadcast and accessed. The guides thus produced are called EPGs – electronic programme guides. For the purposes of this action I can distinguish between two sorts of EPGs - those which merely provide information to the consumer, and those which go further and provide that information and at the same time use software and hardware links to control the television, typically switching to the relevant programme directly from the EPG screen. In a typical case the EPG is controlled by a handheld selector, which controls a selecting highlight on the screen, and a programme would be “selected” by highlighting it and pressing a selection button, at which point an operation is carried out in relation to that programme – for example providing more information about it, or switching the TV receiver to receive it. Two of the patents in suit represent the former category (information only); the third has elements of the second (information plus switching) as well.

The Transfer Patent: Anticipation by Toshiba

(a) Applicable Law

6. There was no dispute as to the principles applicable to anticipation. In summary:
 - i) If the prior inventor's publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim will

have been shown to lack the necessary novelty...*per* Sachs LJ in *General Tire v. Firestone* [1972] RPC 457, 485-486.

- ii) To anticipate the patentee's claim the prior publication must contain clear and unmistakable directions to do what the patentee claims to have invented...A signpost, however clear, upon the road to the patentee's invention will not suffice. The prior inventor must be clearly shown to have planted his flag at the precise destination before the patentee, *ibid*.
- iii) One has to consider how they [i.e. cited items of prior art] would be understood on their date of publication .. by the notional person skilled in the art. There is no reason why such a person, just as in the case of a real person, must find a meaning. In real life there are documents which have no clear meaning, documents so obscure that one throws up one's hands saying "I have no idea what this author was really trying to say." The notional skilled reader can do likewise, and if he or she does, the document is not novelty-destroying. It is not "clear and unambiguous," *per* Jacob LJ in *EMGS v. Schlumberger* [2010] EWCA Civ 819 at [163] – [165].

7. EPO Board of Appeal cases are to the same effect, e.g. T0793/93.

(b) The Transfer Patent

8. There was no dispute about what this teaches or as to the meaning of claim 1, upon which it was agreed anticipation turned. I can therefore go directly to it breaking it down into elements

A method for transferring programs to a secondary storage device, the method comprising:

[A] using an interactive television program guide implemented on user television equipment to cause a first display in a display screen of at least one program listing related to at least one program;

[B] using the interactive television program guide to enable a user to select a program listing from the at least one displayed program listing;

[C] using the interactive television program guide to cause the program related to selected program listing to be recorded on a digital storage device;

[D] using the interactive television program guide to cause a second display in the display screen that includes at least one recorded program listing for at least one program recorded on the digital storage device, wherein the at least one recorded program listing includes a recorded program listing for the program recorded on the digital storage device;

[E] using the interactive television program guide to enable the user to select the recorded program listing to transfer

the recorded program from the digital storage device to a secondary storage device; and

[F] using the interactive television program guide to transfer the recorded program from the digital storage device to a secondary storage device.

9. The “heart of the invention” as Mr Alexander QC put it for Gemstar lies in element [E]. The transfer of recorded programs is done without any further user input. In other words, the user can set up a transfer request for any number of programs and super-programs and the system will execute that request without the user needing to stop playback, select another program, start playback of the new program, etc.

(c) *Toshiba*

10. The key question is whether [162] of Toshiba discloses this idea clearly and unmistakably. Gemstar contends that it does not: that either it discloses a different idea or that it is simply without clear meaning at all – a case of the skilled man throwing his hands up.
11. Before I come to the document itself I must say a word about the disputes over translation. For there have been several translations. A lot of expense and time was wasted because of this. I do not go into the detail. In principle, whenever a party relies on a document in a foreign language, the translation should be sorted out at an early stage. Ideally the party relying on the translation should send it to the other(s) with an express request for agreement within a reasonable time. If the document is quite long the key passages relied on should be identified so that the other side can concentrate on these. If the translation is agreed, well and good. But if not, the Court at the case management stage should normally insist upon agreement or early resolution of the translation dispute, if necessary by a hearing for that purpose.
12. In the end, but only at trial, a translation was settled upon. It is that which must be construed – through of course the eyes of the skilled man. But, and this is an important but, the question of construction is one for the court, not for expert witnesses. Their job is to give the court the necessary understanding of the technology. Whilst it does not matter much if they opine in their witness statements on the meaning of the document, it is really their reasons which matter. It is worth bearing this particularly in mind when it comes to cross-examination – for otherwise the cross-examination can descend into pointless discussion about the meaning. In the present case, for instance, each side may have been somewhat guilty of that, and there has been reliance by both sides on the opinions as to meaning of the experts. I do not intend to go down that path, focussing instead on Toshiba itself.
13. It is important to understand its structure, for the meaning of the key passage must be understood in context. Mr Mellor QC for Virgin provided a helpful breakdown:

[1-39] - Initial description and summary of the invention

[40-55] - Recording and playback

[56-86] - Search and display

[87-148]- Programming (including by date, genre, child friendly).

[149-64]- Editing the index of stored information

[165-169]- Effect of the invention (effectively a final summary).

Followed by a “brief explanation of the drawings” and “key to figures”.

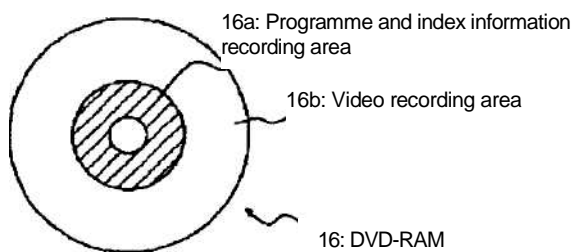
14. Of particular importance is that [162] must be read in the context of “editing” – the heading of the passage from [149-164].

15. The whole of that section is concerned with editing of programmes already recorded. Thus [149] reads:

When editing genre categories, programme types, titles, synopses, and the dates and times of recording from a DVD-RAM 16 (refer to Fig. 5) on which video and still images are recorded, it is useful to use the index information (refer to Fig. 6) recorded in programme and index information recording area 16a in said disk.

16. Figure 5 is as follows:

Fig. 5



Part of the DVD-RAM is for the actual recording and part is for the programme and index information. Moreover it was common ground that in any digital storage system there is a directory which tells the system where to find the data. The index information cannot be separated from the recorded programme. For otherwise the system could not find the programme.

17. Figure 6 is as follows:

	Recording 1	Recording 2
Programme title	Live night-time game	Toshiba Sunday Theatre
Type	Sports	Drama
Recording date and time	July 20, 1998	July 21, 1998
Recording start position	LN1000	LN5000
Recording length (minutes)	120	80

It shows information about recorded programmes, actually identifying the start positions and recording length. Clearly [149] is talking about material which has already been recorded.

18. [153] again is clearly concerned only with editing already recorded programmes:

When DVD-RAM 16 is placed in an image output device equipped with editing functions, as shown in Fig. 25, the titles of all recorded programmes are automatically displayed on display device (television) 10, arranged by their index information, for example by genre, such as movie, sports, music, cartoons, cooking, news, weather forecast, drama, and so on. At this point, a user can edit by selecting any title of any genre with an input device such as a mouse, keyboard, or remote control and copying it onto the editing screen by dragging or clicking.

19. Similarly [155] and [156] are concerned with already recorded programmes:

[0155]

At this time, as shown in Fig. 27, a detailed listing of the programme content can be displayed, for example, synopsis of a drama, details about the performers, date and time of recording, and channels recorded. A user can use input device 14 such as a remote control, keyboard, or a mouse to select the title or number of the video and still images he wishes to edit from any of the display screens. He can also edit and record on the same disk or on a separate recording medium.

[0156]

As an example of editing, if titles selected from the menu display screen are copied into editing screen 88 by dragging them or clicking on them with a mouse and the "Edit" button 89 is then selected, the recorded information is edited and re-recorded in the order in which the titles were copied.

20. [158] is again about editing information about a recorded programme:

[0158]

As shown in Fig. 2, a variety of other information such as synopses of TV programmes, TV programme trailers and profiles of performers normally distributed at key stations 22 such as convenience stores, bookshops, or kiosks at train stations can be recorded on DVD-RAM 16 as programme and index information in addition to the information distributed by the TV station 21, the playback of this information allowing the recorded content of a programme to be easily grasped at a glance, as explained under the "Search/Display" and "Programming" sections above.

What this is saying is you can add to the "programme information" distributed by the TV station things like trailers. They become part of the "programme information" – not the programme itself ("the recorded content of a programme").

21. [159] brings in idea of using a second memory disk:

[0159]

The editing results can be organised on the same disk when a high-capacity disk like the DVD-RAM 16 is used, but can also be transferred to and edited on a different disk in an image recording playback output device which allows multiple disks to be loaded separately.

22. [160] goes on to say that one of the advantages of a second disk are that you can put all the programmes of a genre (e.g. East Enders) onto a single disk.

[0160]

In such a case, the user can prepare a separate disk for each genre, in other words a separate disk for movies, music, or drama. In the case of a drama series, the user can prepare a disk just for that series, and record all episodes on one disk.

23. [161] then describes the case where there is editing and recording on the same disk:

[0161]

When editing and recording on the same disk, index information for the programme content the user wishes to edit, and address information indicating the actual image recording area, are recorded in part of index recording area 16a (refer to Fig. 5.)

24. It is in that context that the skilled reader would come to [162]. It says:

[0162]

On the other hand, when recording the results of editing on another disk, both the edited index information and playback data for video and the like may be transferred and recorded.

25. Virgin says the meaning of this is fairly plain. It is saying that if you are using a second disk, as contemplated in [160], where you have edited the programme information (as contemplated in [158]) you transfer *the results of editing along with the already recorded programme* together with appropriate address information to another disk. The latter is what, in context *playback data for video and the like* must mean. Nothing else would make sense to the skilled man: the edited index information must accompany the recorded programme along with address information so it can be found. You are simply making another disk like that shown in fig. 5. The technical teaching is clear and unmistakeable. If that is right, feature [E] is disclosed and there is anticipation.
26. I accept this argument and reject Gemstar's counter-arguments, which I must now explain. Gemstar says that if [162] were talking about the recorded programme it would have said so – the patentee uses *recorded programmes* when he means that in many other places (e.g. [153]) and would have done so in [162] if he had meant it there. Instead he uses the phrase *playback data for video and the like*. That must have a different meaning – or none at all à la *Schlumberger*.
27. I am not convinced by this. First it is the kind of meticulous verbal analysis which lawyers are too often tempted by their training to indulge (*per* Lord Diplock in *Catnic v Hill & Smith* [1982] RPC 183) and must give way to purposive construction. Secondly and in any event what must be transferred to a second disk is not only the edited programme information and the recorded programme but also information about the address of that recorded program. *Playback data* is apt to cover both.
28. Gemstar's suggested meaning is set out in Mr Alexander's skeleton argument at [57]:

[162] is all about the recording of programme information – not transferring recordings of the programmes themselves. Moreover, if, contrary to *EMGS* the Court tries to force a meaning out of [162], it turns out to be something quite straightforward and not what the Judge held it to show.

Toshiba uses a disk of TV listings information, which is obtained from a “key station”, and the relevant information is stored in a particular area of that disk known as 16a1.

Toshiba also explains that you can have a single disk system (i.e. using the disk you obtained from the key station) or a multiple disk system (whereby you have other disks as well). The attraction of a multiple disk system is, for instance, that you can use additional disks on which to record programmes in the same genre – e.g. successive episodes of a series; or sports programs; or feature films - all without filling up the original disk with a mixture of genres.

If you want to create a recording list, the relevant information is written into area 16a2 of the listings disk in a single disk system and into the relevant area (16a`, perhaps) of a new disk in a multiple disk system. The user then records off-air on to the single disk, or on to one of the multiple disks, in accordance with the relevant recording list.

That is it.

29. I am unable to accept that. It makes no technical sense, and it means that [161] (the single disk case) and [162] (the two-disc case) are talking about different things. And it does not fit with [163] which covers both cases. It reads:

[0163]

When playing back edited recorded information on a particular disk, the index information is automatically displayed on a TV screen when that disk is placed in an image output device. The display format for the index information in this case is of course a layered structure, and the data is arranged so that the synopsis of the programme and details of the cast can easily be retrieved and displayed. In other words, as described above, a user can easily play back a programme of his choice by selecting the desired programme from the desired menu by using input device 14 such as a remote control, mouse, or keyboard.

This paragraph clearly contemplates that the *edited recorded information on a particular disk* has the *desired programme* on it. In the case of a second disk that can only be so if both the edited information and the programme have been transferred to it.

30. So, like Mann J, I conclude that anticipation has been established.

The Favourites Patent.

31. Claim 1 reads:

A method for allowing a user to select favorite channels in an electronic program guide, the method comprising:

providing a display (116) of a plurality of cells (124) representing a corresponding plurality of channels available for viewing by the user, wherein each cell comprises a channel number and a program service name for a particular channel of the plurality of channels;

allowing the user to use the display to select a channel among the plurality of channels;

changing a status of said selected channel to that of a favorite channel in response to the user selection;

displaying in cells corresponding to the favorite channels a visual indication that the selected channels are favorite channels; and

providing program guide information for the subset of channels having said favorite status in response to a user indication to view the program guide information.

32. The Judge held that on his construction of the claim, it lacked novelty over some prior art called SuperGuide. Gemstar contends the Judge was wrong on construction. If he was right, it is accepted that SuperGuide anticipates.

33. The Judge summarised the rival contentions at [155]:

The last point turns on the meaning and effect of “channels available for viewing by the user” (emphasis supplied). Gemstar says that this means all channels which can be received at the system level (whether or not the viewer has actually subscribed to them), and does not include any channels which cannot be received; in other words, it means “all channels which can be received for viewing, and no other channels”. Virgin disputes this construction, and says it means “at least all channels available for viewing”.

34. The claim must of course be construed in context. The Judge described its aims accurately:

[6] The second patent (the “049” or “Favorites patent”) deals with perceived problems arising out of the sheer number of channels that would appear on an EPG which sought to list all programmes available to a subscriber. It enables the user to filter out channels which he or she would not wish to be informed about, leaving him/her with “favourites”. This is done by scrolling down a displayed list and pressing a button to “mark” those which the viewer wishes to have listed for the future. By selecting (electronically, on a controller) to view just the favourites, the non-favourites are filtered out of the view, and the list is more manageable.

35. The dispute is essentially this: from what list does the user select programmes to be “favourites”? A list of the programmes his or her equipment can actually receive, or a list of programmes sent to the users’ equipment whether or not the user can actually receive the programmes?

36. The answer is obviously the latter once one reads the specification and its drawings. I do not think it is necessary to go to much.

37. I start with fig 20. This is said to be “a diagrammatic representation of a channel customization screen display of the user interface for the system and process of the invention.” [69] says:

Figure 20 shows a Channel Customization screen 116. The screen 116 allows the user to customize channels to match viewing interest, providing a compact listing as well as eliminating undesired channels during up down scanning. During schedule update, a list of all cable channels available at the subscriber's cable system (or broadcast stations for over-the-air subscribers) is also delivered to the VCR. This unabridged set of channels may be customized using screen 118.

38. Figure 20 itself shows a screen headed Channel Customization. Channels 2 to 37 are identified in three columns by number. For instance Channel 2 is KTVU-2. On the left is a column headed "My". The user can select which channels are "My", i.e. favourites.

39. The important thing for present purposes is the source of the channels listed on the screen. [69] makes this absolutely clear – it is provided by a "schedule update." Schedule updates are the channel listing information sent to the user's machine by the operator of the listing system. The list sent does not depend on whether the user can actually receive any particular channel. That is fairly apparent from [69] alone, but [77] makes it explicit:

Listing information and other support information, such as cable channel assignment date, will be transmitted ...by one or more local stations or cable channels several times a day or continuously.

40. Once one appreciates therefore that the selection of My channels is from a list of programmes sent to the user's machine and is wholly independent of whether the user's apparatus will in fact receive them, it is evident that "channels available for viewing" in the claim must mean the list sent to the apparatus. These are described in [69] as *available at the subscriber's .. system*. That is what is meant by *available for viewing by the user* in claim 1.

41. Were that not so, then the claim would not cover what is specifically described. It would also cover that which is not described (i.e. how to get a list of only those channels which the user's apparatus can receive). It would also produce the absurd results referred to by the Judge at [159]:

This is reinforced by an absurdity point. If Gemstar were right in its construction, then anyone seeking to implement the underlying discovery of the patent (the selection of Favourites) could simply avoid infringement by adding one extraneous, non-receivable station to the EPG list. Mr Birss accepted that that would be the case. That would be a very odd effect. While avoidance of infringement is an uncertain guide to construction, I think that it is a legitimate point to make in this case. There is another oddity. A map showing the satellite footprint in about 1990 showed that someone with a smaller dish in Florida would not be able to receive all the broadcast satellite channels, while someone with a big dish could. If Gemstar were right,

someone using a system like SuperGuide which broadcast all systems would infringe (assuming all integers were present) if he used his big dish (because he would get listings of all channels available to him) but could fix the problem by going out and buying a smaller dish so that he could not receive all the channels that were listed. That, again, points up the oddity of Gemstar's interpretation.

42. I think the point is very clear indeed. The Judge was plainly right.
43. It is for the above reasons that the appeal should be dismissed.

Lord Justice Patten:

44. I agree.

Lord Justice Laws:

45. I also agree.