

19<sup>th</sup> October 2010

**PATENTS ACT 1977**

Semitel Ltd  
(Exclusive Licensee)

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**PROCEEDINGS**

Request under section 74B of the Patents Act 1977  
for a Review of Opinion 33/09 issued  
on patent N<sup>o</sup> GB 2384390B

HEARING OFFICER      Stephen Probert

Mr Henry McGuire (patent proprietor) appeared in person

Hearing date: 23<sup>rd</sup> September 2010

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**DECISION**

- 1 This decision relates to a request for a review of opinion 33/09 (“the opinion”) under section 74B of the Patents Act. The opinion was requested by Semitel Ltd (“Semitel”), and considers whether a specific method of telecommunication infringes patent GB 2384390B. The patent is owned by Mr Henry McGuire, and Semitel Ltd is an exclusive licensee. The opinion issued on 31 March 2010, and concluded that there was no infringement of the patent.
- 2 The exclusive licensee, Semitel, has now requested a review of the opinion under section 74B. (Semitel is entitled to apply for a review of the opinion as the patent holder, because rule 92 defines “patent holder” as the proprietor of the patent and any exclusive licensee of the patent.)
- 3 No observations were filed in relation to the opinion (33/09) itself, and no counterstatement has been filed in relation to Semitel’s request for a review of the opinion.

**The Law**

- 4 The law governing reviews of opinions is set out in section 74B and rules 98 to 100. Rule 98 in particular says:-

## Review of opinion

98. — (1) The patent holder may, before the end of the period of three months beginning with the date on which the opinion is issued, apply to the comptroller for a review of the opinion.

(2) However, such proceedings for a review may not be brought (or if brought may not be continued) if the issue raised by the review has been decided in other relevant proceedings.

(3) The application must be made on Patents Form 2 and be accompanied by a copy and a statement in duplicate setting out the grounds on which the review is sought.

(4) The statement must contain particulars of any relevant proceedings of which the applicant is aware which may be relevant to the question whether the proceedings for a review may be brought or continued.

(5) The application may be made on the following grounds only—

(a) that the opinion wrongly concluded that the patent in suit was invalid, or was invalid to a limited extent; or

(b) that, by reason of its interpretation of the specification of the patent in suit, the opinion wrongly concluded that a particular act did not or would not constitute an infringement of the patent.

- 5 As can be seen from rule 98(5)(b) above, the grounds on which an application for a review of an opinion on infringement can be made are quite narrowly defined. The following explanation for this restriction was given in *Lundberg v ZGP*<sup>1</sup>:—

“... in most circumstances where a party feels aggrieved by an opinion, there will be a clear route for addressing that grievance. For example a party who is deemed by an opinion to be infringing a patent can seek a declaration of non-infringement. Equally where an opinion has concluded that no infringement is taking place and the patent proprietor disagrees, he may sue for infringement. This could include the circumstances where the patent proprietor disagrees with the way that the claims have been construed. But suing for infringement is not possible if the opinion was sought on a potential or hypothetical act, and in such circumstances it would be unfair to deny the patent proprietor a chance to overturn an infringement opinion based on a construction of the claims which is adverse to him. Thus the rules allow a review of an infringement opinion but only if the opinion came to a wrong conclusion on infringement as a result of how it interpreted the specification of the patent in suit.”

- 6 So I cannot set an opinion on infringement aside just because it is wrong. I can only set it aside if it is wrong because of (or “by reason of”) the interpretation of the specification of the patent.
- 7 It is also well established by now that a review of an opinion is not a rehearing; neither is it an opportunity for a hearing officer to provide a second opinion (as initially sought by Semitel in its application for a review).

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<sup>1</sup> Lundberg & Son VVS-Produckter AE v ZGP Limited - BL O/080/10 dated 5 March 2010.  
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## **The request for a review**

- 8 In this case Semitel requests a review of the opinion on several grounds, which may be conveniently grouped into two classes:
- i) the examiner misconstrued the patent in suit, and
  - ii) the examiner misunderstood how the alleged infringing product operates.
- 9 The second of these classes does not qualify under rule 98(5) as a ground for applying for a review, for the reasons previously stated in *Lundberg v ZGP*<sup>1</sup>. However, the former clearly does. I am therefore satisfied that there are at least some permissible grounds for a review.

## **Should the opinion be set aside?**

- 10 I have carefully considered the grounds indicated by Semitel in support of its assertion that the examiner reached the wrong conclusion on infringement due to an incorrect interpretation of the patent in suit. I have also had the benefit of some very helpful submissions from the inventor and patent proprietor, Mr Henry McGuire, at the hearing. Although I do not accept all of the grounds indicated in the request for a review, there is at least one ground that succeeds, and therefore I am setting the opinion aside.
- 11 The patent concerns an advanced caller identification (ACI) service for a telecommunications system. It involves equipment at the caller's end producing an identification signal that is transmitted to the 'other' end. Although the method of the invention may be employed across a wide range of wireless or wired communication systems (eg. including land-lines, mobile phones, WAP phones, personal digital assistants etc.), it is specifically an advantage of the invention that it does not require information contained within the advanced caller identification to be pre-stored in a central database accessible by the receiver; all the necessary information is contained within the signal transmitted from the caller's equipment.

### First Ground — Is it only peer-to-peer?

- 12 Mr McGuire submitted that the opinion wrongly concluded that the Skype peer-to-peer communication system<sup>2</sup> (and the JoltID application that supports it) does not constitute an infringement of the patent because of an incorrect interpretation of the specification of the patent. More specifically he says, in relation to his first permissible ground, that the opinion interpreted the patent as being limited to peer-to-peer communication systems, when in fact the invention works equally well in traditional "client-server" environments (eg. using a network server).
- 13 I have read the patent and the opinion through several times, and I do not think that the opinion misinterprets the patent in the way that Mr McGuire suggests.

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<sup>2</sup> "The Skype communication system is a software application that allows users to make voice calls over the Internet using a peer-to-peer voice over IP (VOIP) protocol." — Paragraph 7 of the opinion.

14 Towards the end of paragraph 19 the examiner has noted (as I have in paragraph 11 above) that one of the advantages of the invention is that there is “*no requirement for a database of stored identification information*”. But it doesn’t follow from this that the examiner must have construed the claim as excluding embodiments operating on client-server networks — simply that a central network server is not essential to the invention. (To be clear, I accept that Mr McGuire’s invention will work in both peer-to-peer and client-server environments.)

15 One reason why there is no need for a central database of stored identification information is that this information is transmitted by the equipment at the caller’s end. This is seen clearly in claim 1; step 2 of which says:—

“Caller’s phone produces a Caller Identification signal for transmission that incorporates the selected identification information.”

16 All the claims of the patent are subject to this limitation by virtue of their dependency on claim 1, and therefore I agree with the opinion that the patent would not be infringed by a system where the caller identification signal is produced by a central network server. The technically-informed reader may be wondering about the significance of this issue of interpretation given that the opinion acknowledges that Skype uses a peer-to-peer protocol (as distinct from a client-server protocol). Mr McGuire presented some very cogent arguments along these lines at the hearing, but I am unable to consider them because they do not fall within the permitted grounds for requesting a review of an opinion.

Second ground — When is a phone not a phone?

17 Mr McGuire was also concerned that the opinion had interpreted the term “caller’s phone” in the claims (eg. step 2 of claim 1) too narrowly. More specifically he submitted that the examiner had construed it to mean a conventional telephone handset, when in fact it must be an ACI enabled phone. In practice, as explained in the description of the patent, this would normally be a combination of the user’s existing (conventional) telephone handset and a separate ACI adapter unit.

18 I explored this point at some length with Mr McGuire at the hearing, and I have come to the conclusion that he has a valid point. In order to run his point, Mr McGuire needed to take me to the construction placed on the same patent in an earlier opinion (26/09). The earlier opinion is not the subject of this review. Nevertheless, in the opinion that is the subject of this review (33/09) the examiner says, in a paragraph entitled “Claim construction”, that he is construing claim 1 as he did in the earlier opinion (26/09). Therefore I agree that it is appropriate for me to consider the construction placed on the patent in opinion 26/09.

19 At paragraph 15 of the earlier opinion (26/09), the examiner refers to the images transmitted during a Skype call and says:

“It is not clear whether they are transmitted from the caller’s phone or are from some other source such as a contact list.”

20 Mr McGuire argued that the opinion incorrectly regards “the caller’s phone” and “a contact list” as two mutually exclusive alternatives, and therefore concludes (wrongly in Mr McGuire’s submission) that if the identification information is

coming from a contact list, then it cannot be coming from the caller's phone. This is very important because if the identification information is not coming from the caller's phone (however that term should be interpreted) then there is no infringement. Taking the specification as a whole, I am satisfied that the term "caller's phone" in claim 1 should be understood to mean either an ACI enabled phone or a combination of a conventional telephone handset and a separate ACI adapter unit. See for example figure 3 and the corresponding text.

- 21 There is not enough detail in either this opinion (33/09) or the earlier opinion (26/09) for me to be satisfied that the examiner has construed "caller's phone" correctly. And furthermore, there is significant reason to suppose that he may not have appreciated that there must necessarily be a contact list (or a source of caller identification) in the caller's phone in order for the invention to work as described. Therefore, given that the conclusion reached in the opinion hinges on the location from which the identification signal originates, I think Mr McGuire has done enough to persuade me that it is by reason of its interpretation of the specification of the patent in suit, that the opinion wrongly concluded that the JoltId application does not constitute an infringement of the patent.

### **Conclusion**

- 22 This application for a review of opinion 33/09 is successful, and the opinion is hereby set aside in whole.

**S PROBERT**

Deputy Director acting for the Comptroller