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Case No: HC 11 C 04556

IN THE HIGH COURT OF JUSTICE
CHANCERY DIVISION
PATENTS COURT

The Rolls Building
7 Rolls Buildings
Fetter Lane
London EC4A 1NL

Date: 09/01/2014

Before:

MR. JUSTICE ARNOLD

Between:

(1) STARSIGHT TELECAST, INC.
(2) UNITED VIDEO PROPERTIES, INC.

Claimants

- and -

(1) VIRGIN MEDIA LIMITED
(2) VIRGIN MEDIA PAYMENTS LIMITED
(3) TiVo Inc.

Defendants

MR. JAMES ABRAHAMS (instructed by **Powell Gilbert LLP**)
appeared for the **Claimants**.

MR. JAMES WHYTE (instructed by **Marks & Clerk Solicitors LLP**)
appeared for the **Defendants**.

APPROVED JUDGMENT

(Computer-aided transcript of the Stenograph Notes of Marten Walsh Cherer Ltd., 1st Floor,
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MR. JUSTICE ARNOLD :

1. This is an application by the defendants, Virgin Media Ltd, Virgin Media Payments Ltd and TiVo Inc. (“Virgin Media”) for partial summary judgment dismissing the claim by the claimants, Starsight Telecast Inc. and United Video Properties Inc. (who I will refer to, in common with the parties, as “Rovi”) for infringement of European Patent (UK) No. 1 734 234 (“the Patent”).
2. The Patent relates to parental control mechanisms for a TV system for an electronic programme guide (“EPG”). The core inventive concept of the Patent is described by counsel for Rovi as follows in his skeleton argument:

"It was known at the priority date for TV system to have a facility to lock channels so the live video and/or audio content of those channels could not be viewed without entering a PIN code. Furthermore, EPG systems were under development which would have such a facility. In the prior art relied on by Virgin Media, this would be implemented by having a padlock symbol appear on the EPG next to the name of a locked programme; when the user tried to view that programme by tuning to the relevant channel or selecting it from the EPG, a prompt would appear to enter the PIN code. Unless the user could enter the PIN code, they could not watch the programmes on the blocked channel. In this way, parents could prevent their children from watching programmes on inappropriate channels. [The Patent] takes a different approach: it removes blocked programmes from the EPG altogether, so that they do not even appear in the programme listings, with the consequence that programmes cannot be selected from the EPG. This has a number of advantages - not least is that children will not even see that a forbidden programme is on and so will not be encouraged to crack the PIN code or otherwise circumvent the blocking mechanism."

3. The Patent, which it may be observed was granted on a divisional application, is under opposition in the European Patent Office. In October 2012 the EPO Opposition Division held that the claims as granted were not valid, but upheld the validity of the Patent with amended claims. Rovi are appealing to the Technical Board of Appeal to reinstate the claims as granted. In case that appeal fails, on 21 December 2012 Rovi made a conditional application in these proceedings to amend the claims to match those that were allowed by the Opposition Division.
4. Claim 1, as upheld by the Opposition Division and as conditionally proposed to be amended in these proceedings, is in the following form (broken down into integers as proposed by Virgin Media):
 - “[A] A method for using an electronic program guide to restrict access to program schedule information displayed on a television, the method comprising:

- [B] receiving and storing in memory television program schedule information in a database,
 - [C] including a record for each program containing a field corresponding to a rating, program content identifier or channel;
 - [D] providing a user with the ability to set parental control options based on the rating, program content identifier or channel;
 - [E] receiving a user command to display stored television program schedule information; and
 - [F] restricting the ability to view program schedule information for a program on the television based on the parental control options by checking the appropriate field in the record for the program for a match,
 - [G] wherein restricted program schedule information is displayed when a code is received from the user in response to a prompt displayed on the television,
 - [H] which prompt is displayed in response to the user command when it requests display of restricted program schedule information.”
5. The infringement claim relates to two classes of allegedly infringing device marketed by Virgin Media: first, the TiVo set-top box and, secondly, the VHD and V+ HD set-top boxes.
 6. The present application relates solely to the claims as conditionally proposed to be amended. It is Virgin Media's contention that it is simply unarguable that the claims as proposed to be amended are infringed by dealings in either of the two classes of allegedly infringing device.
 7. The principles applicable to summary judgment applications were conveniently summarised by Lewison J (as he then was) in the frequently-cited passage from his judgment in *Easyair Ltd v Opal Telecom Ltd* [2009] EWHC 339 (Ch) at [15], which was cited with approval by the Court of Appeal in *AC Ward & Son Ltd v Catlin (Five) Ltd* [2009] EWCA Civ 1098, [2010] Lloyd's Reports IR 301 at [24].
 8. Summary judgment in patent cases is rarely appropriate even on issues as to claim construction and infringement for the reasons which were explained by Dillon LJ in *Strix Ltd v Otter Controls Ltd* [1991] FSR 354 at 357-358 and Aldous LJ in *Monsanto & Co v Merck & Co* [2000] RPC 77 at 92.
 9. Counsel for Virgin Media accepted that, as a matter of generality, that was so. He nevertheless submitted that, in the present case, the issues on claim construction were sufficiently clear that the court could see now that Rovi have no real prospect of succeeding in their infringement claims based on the claims as proposed to be amended. Furthermore, he submitted that, even though this application has been made

only very shortly before the trial of these proceedings, which has been set for a window starting on 24 February 2014, there would be real value in granting partial summary judgment even at this late stage.

10. Against that background, I turn to briefly set out Virgin Media's arguments as to why the claims cannot possibly be construed in a manner which reads on to the alleged infringements. Both of the two of the classes of alleged infringing devices have a function called "Hide Adult Listings" which Rovi say fulfills the requirements of claim 1 as proposed to be amended. The VHD and V+ HD set-top boxes have an additional function conveniently referred to as the "Alternative Adult Listings Display" which Rovi also claim fulfills the requirements of claim 1 as proposed to be amended.
11. The argument for present purposes focuses, in the case of the Hide Adult Listings function, on integers E, G and H of claim 1 and, in the case of the Alternative Adult Listings Display, on integer F.
12. So far as integers E, G and H are concerned, Virgin Media contend that it is plain from the wording of the relevant integers of the claim, and supported by the description, in particular at paragraphs [0095], [0111] and [0112], that what happens is that the user asks to see programme schedule information, the relevant database field is checked, and, if the options show that the information is restricted, a prompt is displayed. If the user correctly enters a code, then the schedule information is displayed.
13. By contrast, so Virgin Media contend, the way in which the Hide Adult Listings function works is, in summary, as follows. The user may request to access a menu called the "Parental Controls" menu in the case of the TiVo, and the "Locked Channels" menu in the case of the VHD and V+ HD. Before being allowed access to that menu, the user must correctly enter a PIN. The menu then allows the user, if he or she so chooses, to make various selections of options which include an option to hide or not hide listings of adult channels entirely from the TV guide whenever it might, in the future, be requested. This option is called "Hide Adult Channels" in the TiVo and "Hide Adult listings" in the VHD and V+ HD.
14. Virgin Media say that the user command which appears to be relied upon by Rovi as fulfilling the requirements of integer E of the claim is the request to enter the Parental Controls menu or the Locked Channels menu as the case may be. Virgin Media's argument is that, while these may indeed be user commands, they are user commands to display the Parental Control menu from which the user may or may not choose to alter the Parental Control options. Virgin Media say that what they are certainly not is requests to display programme schedule information. Under no circumstances, say Virgin Media, can the result of making these selections be the display of stored television programme schedule information as required by integer E. All that they do is to bring up the PIN prompt and then the menu.
15. Similarly, Virgin Media say that integer H is not fulfilled either. While there is a prompt to enter a PIN, it is not a prompt displayed in response to the user command when it requests display of restricted programme schedule information. It is a prompt displayed in response to a user command to enter a menu.

16. Furthermore, Virgin Media say that it follows that integer G is not fulfilled either. The result of the PIN being entered correctly is that the user is simply taken into the Parental Controls menu. No programme schedule information is displayed when the code is received.
17. Turning finally to the Alternative Adult Listing Display feature of the VHD and V+ HD set-top boxes, the way in which this works may be summarised as follows. From the TV guide menu, the user can select the option “Adult”. If the option to “Hide Adult Listings” has not been activated, listings for the adult channels are displayed. If the option has been activated, however, the user is prompted to enter a PIN. If the PIN is entered correctly, listings for the adult channels are displayed.
18. Virgin Media's contention is that it is clear that this functionality does not fulfill the requirements of integer F of claim 1. When the user selects “Adult”, there is no check for a field in the listings database, let alone a field in a record for the programme. The software simply checks the state of a variable. The variable records whether or not the “Hide Adult Listings” option is activated. If it is, a PIN is requested. Thus there is no restriction on viewing of schedule information based on the Parental Controls options by checking the appropriate field in the record for the programme for a match as required by the claim.
19. In my view, these are powerful arguments which may well lead the court at trial to the conclusion that claim 1 of the patent as proposed to be amended is not infringed by any of the allegedly infringing devices. In my judgment, however, it does not follow that this is an appropriate case in which to grant partial summary judgment for the following reasons.
20. As was explained in *Strix v Otter* and *Monsanto v Merck*, the reason why it is difficult to grant summary judgment in patent cases is that, in order to determine even issues of claim construction and infringement, it is necessary for the court to adopt the mantle of the person skilled in the art. For that purpose, the court needs to receive expert evidence as to the common general knowledge in the art in question at the relevant date.
21. Counsel for Virgin Media sought to argue that that difficulty was not an obstacle in the present case because Rovi have now served an expert's report from its designated expert, Mr. Peter Vogel. Counsel for Virgin Media took me through the sections of Mr. Vogel's expert report in which he deals with the issue of infringement. He submitted that, upon analysis, it could be seen that what Mr. Vogel said in those parts of his report was either, in the case of one paragraph, factually wrong or, in the case of the remainder, essentially assertion with no technical analysis or reasoning to substantiate it.
22. I can see the force of that submission. Nevertheless, the fact remains that Mr. Vogel's approach to the question of infringement in that part of his report is predicated upon his earlier evidence as to the common general knowledge at the relevant date and his understanding of the inventive concept of the patent.
23. Counsel for Virgin Media also made the point that it does not appear to be suggested on behalf of Rovi that any of the relevant words in the claim are technical terms of art as to which expert evidence was required to determine their meaning. That appears to

be correct; but it does not detract from the basic problem that, in order to construe the claim, the court needs to be put in possession of the common general knowledge of the person skilled in the art in order to have a proper understanding of the inventive concept and the way in which the person skilled in the art would understand the integers of the claim having regard to the common general knowledge and the inventive concept.

24. Notwithstanding the able submissions made by counsel for Virgin Media, I do not feel that this case is any exception to the general rule enunciated in *Strix v Otter* and *Monsanto v Merck*. Accordingly, notwithstanding the cogency of Virgin Media's arguments as presented to me today, I am not persuaded that they lead to the conclusion that Rovi have no real prospect of succeeding in their claims for infringement of the proposed amended claims. On the contrary, it seems to me that, as is the case with most patent actions, this is a dispute which requires a trial for its proper resolution.
25. Furthermore, even if I had been persuaded that Rovi have no real prospect of succeeding in their claims for infringement of the amended claim, it seems to me that there is another compelling reason why summary judgment should not be granted in this case. This is due to the lateness of the present application.
26. The claim was commenced as long ago as 29 December 2011. The amendment application was launched as long ago as 21 December 2012. The present application was only launched on 20 December 2013. Even then, the application was technically defective because it was not supported by the evidence relied upon by Virgin Media. The evidence was only served on the 31 December 2013. It was only as a result of obtaining from me an order earlier in this hearing permitting the application to be made on effectively less than the required 14 days' notice that Virgin Media have been able to make their application today (9 January 2014) at all, otherwise the matter would have had to await a hearing sometime next week. In the result, as I have already observed, the application comes on only a short time before trial. Furthermore, in the intervening period, expert evidence has been exchanged.
27. Counsel for Virgin Media sought to defend the lateness of the application by saying that, if the application had been made earlier, it would have been met with the response that it was premature until expert evidence was served. I am unconvinced by that explanation, given that it is Virgin Media's contention on this application that expert evidence cannot make any difference. I also observe that in fact the application was launched prior to the exchange of expert evidence.
28. But what I regard as most important is that, if I were to grant partial summary judgment in favour of Virgin Media, it is inevitable that Rovi would seek to appeal the matter to the Court of Appeal. It seems to me that it is also inevitable that, even if I refused permission to appeal, the Court of Appeal would grant permission to appeal. Accordingly, one would arrive at the difficulty that, if the Court of Appeal did not expedite the matter, the appeal would still be pending at the date of the trial. The inevitable consequence of that would be that all of the issues which Virgin Media contend could be avoided by granting summary judgment today would in fact still have to be gone into. I cannot assume that the Court of Appeal would see fit to expedite the hearing of the appeal in those circumstances given that, as can be seen

from the chronology I have outlined, Virgin Media have waited for at least a year before making the present application.

29. For all of those reasons, this application is dismissed.

(See separate transcript for proceedings after judgment)