

OPINION UNDER SECTION 74A

Patent	GB 2384390
Proprietor(s)	Mr Henry McGuire
Exclusive Licensee	Semitel Limited
Requester	Semitel Limited, on 11 August 2009
Observer(s)	Skype Communications S.A.R.L
Date Opinion issued	28 October 2009

The request

1. The requester Semitel Ltd seeks an opinion as to whether the Skype communications system and graphical user interface infringes UK patent GB2384390 B. The request is accompanied by statements arguing the case for infringement and 7 items of evidence as follows:

E1 - A Wikipedia document containing a summary of the Skype communications system.

E2 – Screenshots of the Skype graphical user interface (GUI).

E3 – Screenshots of the Skype GUI during a call.

E4 – Additional information on the features of the Skype communications system taken from the website www.skype.com.

E5 – Skype user guides and other information taken from the website www.skype.com.

E6 – A list of references to the patent relating to “claim 12 infringement possibilities”.

E7 – Information from the website www.skype.com as evidence of commercial use within the UK.

Observations

2. Observations in response to the request were received from Page, White & Farrer on behalf of Skype Ltd. The observations comprise a refutation of the case for infringement and the following further arguments:

- (i) The patent is not novel or inventive based on 4 prior art patents,

US5907604 (HSU), EP1024643 (DERMLER), US5999599 (SCHAFFER) and EP0802661 (LA PORTA).

- (ii) The invention is excluded from patentability according to S.72(1)(a) and S.1(1)d of the Patents Act.
 - (iii) The description with regard to claim 1 is insufficient according to S.72(1)(c) of the Patents Act.
 - (iv) There is added matter in claim 1 according to S.72(1)(d) of the Patents Act.
3. The observer has requested an opinion confirming non-infringement of the patent “on the basis of both its invalidity and the non-infringing nature of the respondent’s actions”.

Observations in reply

4. Observations in reply were received from the requester comprising arguments countering non-infringement, lack of novelty and inventive step, excluded matter, insufficiency and added matter. The observations include the International PCT filing details and the UK application filing details. The requester has asked the Comptroller to issue a further opinion finding the patent to be valid based on these filing details, the priority document and observations in reply. The requester has asked for an additional opinion finding the effective date for the patent to be the filing date of the priority document.

Matter to be considered by this opinion

5. Section 74A provides for the procedure where the comptroller can issue, on request, non-binding opinions on questions of validity relating to novelty or inventive step, and on questions of infringement. Any observations should be confined to the issues raised by the request and should not broaden the scope of the opinion by raising new issues. The opinion service is intended to be quick and cheap. Consequently if an observer wishes to explore validity issues concerning novelty or inventive step not raised by the requester then they must file a separate request. Other issues relating to patentability, sufficiency and added matter are beyond the scope of the opinions service.
6. I will therefore not consider issues relating to novelty, inventive step, patentability, sufficiency or added matter raised by the observer. I will also not issue a further or additional opinion on the validity or effective date of the patent as requested in the observations in reply. This opinion will accordingly only consider whether the Skype communications system and GUI infringes UK patent GB2384390 on the assumption that the claims of that patent are valid.

The Patent

7. The patent was filed on 24 October 2001 with a priority date of 24 October 2000. It was granted on 16 March 2005 and remains in force.
8. The patent relates to an advanced caller identification service for a telecommunications network. Prior art caller identification systems are said to be limited to automatic identification of the caller's telephone number at the receiver. The invention allows a caller to select and forward identification information and other information to the receiver. The information can include name, address, telephone number, email address etc. and can include graphics and sound. There are 12 claims, the first of which is independent as follows:

A method of providing caller selected identification information to a called party's receiver, wherein the method comprises the steps of:

- 1) Caller selects graphical and/or audio identification information to be transmitted.*
- 2) Caller's phone produces a Caller Identification signal for transmission that incorporates the selected identification information.*
- 3) Caller Identification signal being conveyed to the receiver.*
- 4) Called party deciding on desired response to call, prior to answering based on the selected identification information incorporated within the Caller Identification signal.*
- 5) Caller interchanging the selected information contained within the Caller Identification signal within the duration of the call.*
- 6) Receiver storing selected identification information incorporated within the Caller Identification signal.*

The Skype communications system

9. According to evidence E1, the Skype communications system is a software application that allows users to make voice calls over the Internet using a proprietary peer-to-peer voice over IP (VOIP) network called the Skype protocol. Its initial release was August 2003. Numerous upgrades and versions have been released since that date. The observer has not disputed that the patent pre-dates the establishment and launch of the Skype communications system or that it is in commercial use in the UK.

Claim Construction

10. In order to determine whether the Skype communications system and GUI infringe the patent I must first construe the claims of the patent following the usual approach set out in *Kirin-Amgen Inc v Hoescht*

Marion Roussel Ltd [2005] RPC 9. For the most part claim 1 is straightforward. However the observer argues that the claim is restricted to a particular type of industry standard caller identification signal. The observer cites the response to the second pre-grant examination report and the context of claim 1 as evidence, namely that “identification information” distinguished as a separate element incorporated in a “Caller Identification signal” means that the “Caller Identification signal” must be the industry standard signal. I disagree with this construction. Firstly, the pre-grant response is not relevant to how the skilled person would interpret the claims. Following *Kirin-Amgen* this must be done in light of the description and drawings alone. Secondly, although the invention is discussed as an improvement on a standard prior art caller identification service, the language of the claim does not specify a particular type and the description states that the invention is not restricted to any particular phone system. Therefore I believe the skilled person would understand the claim to cover any system in which identification information is transmitted in a signal to a called party’s receiver.

11. The requester states that the term “caller interchanging the selected information contained within the Caller Identification signal within the duration of the call” means that the caller can continue to select identification information during the call for transmission to the receiver. The observer argues that this interpretation “does not acknowledge the recited limitation of a Caller Identification signal”. However with the broader construction I have adopted, I consider the skilled person would understand the term to mean what the requester has stated.

Does the Skype system Infringe?

12. The requester has asserted that the evidence E2 to E5 shows that the Skype communications system and GUI infringes claim 1 and that the GUI itself may infringe claim 1. The observer argues that there can be no direct infringement of a method claim by the GUI since it does not execute step 1 of claim 1. Furthermore the observer states that the evidence is merely superficial evidence of visible user-interface features with no information about the underlying signaling mechanism or how it reads onto the claims.
13. I agree with the observer that the GUI itself cannot infringe for the reason stated. To see if the GUI and system as a whole infringes when in use I will go through claim 1 step by step to see if there is a corresponding feature in the evidence.
14. Step 1 recites: *Caller selects graphical and/or audio identification information to be transmitted*. E2 screenshots show a Skype GUI for a

user, having a list of contacts and drop down menus with “edit your profile”, “change your picture”, “change sounds” and “add video to your mood” options. A screenshot of a “Profile” window displays “Details that all people on Skype will see” and this includes name, address, gender, birth date and other information a user can presumably select or input. E4 suggests that this information is stored in a profile in a Skype directory which is searchable by other users. There is no clear indication that this information is selected for transmission in a caller identification signal. An E2 screenshot of a live video call pre-answer shows two different faces in a menu screen which may be the caller and called party. E4 and E5 suggest that these pictures are taken from a stored contact list. E3 comprises a sequence of 7 screenshots of caller and called party screens during a live Skype to Skype voice call. These show a “Semitel 01” image then a “Semitel 02” image on the caller screen pre-answer. The called party screen shows the name of the caller and a “Semitel 02” image pre-answer. E5 states that caller identification is available such that a caller’s number is displayed to the called party. The E3 screenshots show that caller identification information including an image is displayed at the receiver pre-answer. It is not clear that this is identification information selected by the caller to be transmitted. E4 describes a feature called “RingJam™” that allows Skype users to customise and push video, song or sound as a ringing signal to the receiver when calling. This does satisfy the requirement of step 1 if the customisation is unique to the caller.

15. Step 2 requires: *Caller’s phone produces a Caller Identification signal for transmission that incorporates the selected identification information.* The evidence does not clearly show how a user’s identification information is transmitted to another user. The live video pre-answer screenshot suggests that either the caller or called party may view a picture of the other party before answering a call but the pictures appear to come from a stored contact list rather than the caller’s phone. E3 screenshots show that the caller’s name and an image “Semitel 02” are displayed at the receiver pre-answer. It is not clear whether they are transmitted from the caller’s phone or are from some other source such as a contact list. The E4 description of pushing content as a ringing signal does not show that the caller’s phone produces a caller identification signal incorporating this content.
16. Step 3 requires: *Caller Identification signal being conveyed to the receiver.* The E3 screenshots show that the caller’s name and image are displayed at the receiver pre-answer but again the mechanism for achieving this is not clear. The customised ringing signal described in E5 however is “pushed” to the called party satisfying step 3.

17. Step 4 requires: *Called party deciding on desired response to call, prior to answering based on the selected identification information incorporated within the Caller Identification signal.* There is no information on the called party's actions but I assume that they have the option to answer the call or not based on the displayed caller's name and image or customised ringtone thus satisfying step 4.
18. Step 5 requires: *Caller interchanging the selected information contained within the Caller Identification signal within the duration of the call.* According to the requester the E3 screenshots show the caller can interchange selected information during the call. The called party screens show an image "Semitel 02" then "Semitel 03" pre-answer, and an image "Semitel 04" during the call with a message "Personal call altered (2)". The requester argues that these show step 5 occurring. However I am not persuaded by this. It seems to me that there are many ways in which these screen changes could occur and the evidence is not strong enough for me to say that step 5 is fulfilled. There is also no evidence that the "RingjamTM" feature for pushing video, song or sound as a ringing signal to the receiver when calling allows the caller to interchange this information during the call either before or after the call is answered.
19. Step 6 requires: *Receiver storing selected identification information incorporated within the Caller Identification signal.* The purpose of this step according to the description is to allow the called party to retrieve the information at a later date if they wish to contact the caller. The evidence does not show this step.
20. In summary then, the evidence E1 to E5 does not clearly show all the features of claim 1. E1 to E5 show that the Skype system does have a caller identification service which displays a caller's number and image at a receiver pre-answer and also a caller selected video/sound ringing signal. However it is difficult to infer with any certainty, from the evidence provided, the underlying mechanisms of these features. In particular there is no clear disclosure that the caller's phone produces a caller identification signal incorporating caller selected identification information which is transmitted to the receiver or that the caller can interchange this information during the call. Storing the information at the receiver for future use is also not shown. The evidence also relates to many other user interface features, tools and applications but the way in which these operate cannot be easily discerned from static screenshots and accompanying guides. It is possible that the Skype communications system does infringe claim 1 but the evidence does not convincingly show this. Therefore on balance I must conclude that claim 1 is not infringed by the Skype communications system. Dependent claims 2 to 12 are consequently not infringed.

Opinion

21. I conclude that from the evidence in front of me, the Skype communications system and GUI do not infringe GB2384390 B.

Application for review

22. Under section 74B and rule 98, the proprietor may, within three months of the date of issue of this opinion, apply to the comptroller for a review of the opinion.

NOTE

This opinion is not based on the outcome of fully litigated proceedings. Rather, it is based on whatever material the persons requesting the opinion and filing observations have chosen to put before the Office.

Gareth Griffiths
Examiner

