Patents Act 1977 **Opinion Number** **27/14**

OPINION UNDER SECTION 74A

Patent	GB2498499
Proprietor(s)	Cachebox TV Limited
Exclusive Licensee	
Requester	Cachebox TV Limited
Observer(s)	Sky Media
Date Opinion issued	11 February 2015

The Request

1. The comptroller has been requested by Alistair Kelman on behalf of Cachebox, to issue an opinion as to whether certain acts might infringe GB2498499, a system for providing improved facilities in time-shifted broadcasts. This patent was filed on 18 November 2011 and granted on 22 October 2013 and is currently in force.

2. Observations have been filed by Brian Hanlon on behalf of Sky Media and observations-in- reply then followed from Alistair Kelman of Cachebox.

Infringement

3. Section 60 Patents Act 1977 governs what constitutes infringement of a patent; Section 60(1) reads:

> *Subject to the provision 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.*

Allowability of the request

4. Sky in their observations, suggest that I should refuse the request. Section 74A of the Patents Act states:

> *74A.- (3) The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so –*
> *(a) in such circumstances as may be prescribed, or*
> *(b) if for any reason he considers it inappropriate in all the circumstances to do so.*

5. The corresponding Rule 93 of the Patents Rules 2007 provides that:

> *The comptroller shall not issue an opinion if—*
> *(a) the request appears to him to be frivolous or vexatious; or*
> *(b) the question upon which the opinion is sought appears to him to have been sufficiently considered in any relevant proceedings.*

6. This means Opinions requests will be refused if they are frivolous or vexatious, have been previously considered or lack sufficient information for any reasonable view to be established.

7. Neither Cachebox nor Sky has indicated that there is any current or past litigation on the question posed.

8. The observations assert that Sky's current service does not infringe the Patent, and indeed the request suggests that this is accepted by the requester. The requester further accepts that it is not clear to him how AdSmart might work in detail, and the promotional background provided does not go into those details. Rather, he uses three Patent documents from Sky to infer what a system might be.

9. It is worth pausing at this point, to make one point clear, the result is that the request invites me to find (at least) one described embodiment that necessarily falls within the scope of the claims. For clarity's sake, I shall state the inverse result; it means that the request already accepts that there are embodiments of the proposed system in the Exemplar patents that do not fall within the scope of the Cachebox Patent.

10. Opinions are limited to the information provided. This means I believe that I am asked to come to an opinion on whether the full implementation of a system set out in the Exemplar patents GB2473306, GB2472264 and GB2484877 would necessarily infringe the patent.

11. Sky further suggest that I should not come to an opinion on a hypothetical case and one on which no evidence is provided. Rule 93 further states:

> *Request for an opinion under section 74A*
> *93.*
> *(6) The prescribed matters for the purposes of section 74A(1) are as follows—*
> *(a) whether a particular act constitutes, or (if done) would constitute, an infringement of the patent;*

12. It is therefore clear to me, that Rule 93 means I can come to a view on a hypothetical situation (if done). Moreover, I think that it is perfectly possible to come to a view in an Opinion on whether or not the implementation of a system as set out in the Exemplar patents would infringe (if done), under Section 60 without making any finding of whether that has occured, is occurring or will occur.

13. I do not therefore consider that the request is entirely frivolous, nor is it vexatious.

14. Sky in their observations suggest further, that the Exemplar patents and particularly GB2473306 do not set out how they might operate in cases whether the TV watershed is to apply to catch-up and time shifted viewing. I shall return to this question later, as it is goes to the centre of any opinion I may come to.

The Patent

15. As set out in the opening paragraphs of the description:

> *This invention relates to a system for supplying viewers of time-shifted programmes, previously broadcast on television or on radio, with improved facilities during an advertising break, and relates especially to a system which includes the supply of interactive advertisements, and optionally the provision of a loyalty points system.*
>
> *In many countries there are regulations laid down by the broadcasting authorities which specify the minimum time between advertising breaks in programmes, the maximum length of an advertising break, the maximum number of seconds of advertising which can be broadcast within an hour's viewing. In addition, the time of day at which some adverts may be shown may also be strictly controlled. In the UK for example, if the advertisement is advertising alcoholic drinks containing more than 1.2% alcohol and the advertising regulator responsible is OFCOM then under the Broadcast Committee of Advertising Practice Rules on Scheduling of Television Advertisement the advertisement may not be shown at a time when children under 10 are likely to be viewing - i.e. before 7.30pm, sometimes referred to as the "watershed". A feature of advertising charging is that certain slots are more valuable than others, eg shortly after 7.30pm, and premium prices for use of those slots can be charged.*

16. The Patent has a single independent claim, and 9 further dependent claims. The independent claim 1 reads:

> *A system for automating compliance with local broadcasting regulations applicable to advertisements, said advertisements being provided during timeshifted viewing/listening comprises:*
> *programme supply means to supply broadcast digital video/audio programmes having therein periodic breaks for the insertion of advertisements;*
> *advertisement supply means to supply advertisements within the periodic breaks, each advertisement having associated therewith a header related to a local broadcasting time regulation which restricts the time of day*

at which said advertisement may be shown;
rules database means containing rules relating to said local broadcasting regulations;
clock means to supply a real-time clock signal; and
control means arranged to read said headers and said clock signal and said rules database and to apply said local broadcasting time regulation to each advertisement before it is shown.

Claim construction

17. Before considering the documents put forward in the request I will need to construe the claims of the patent following the well known authority on claim construction which is *Kirin-Amgen and others v Hoechst Marion Roussel Limited and others* [2005] RPC 9. This requires that I put a purposive construction on the claims, interpret it in the light of the description and drawings as instructed by Section 125(1) and take account of the Protocol to Article 69 of the EPC. Simply put, I must decide what a person skilled in the art would have understood the patentee to have used the language of the claim to mean.

18. In this case, the person skilled in the art would be someone working in the field of managing advertising for broadcast content, who would be well aware of the need to ensure compliance with broadcasting regulations. It seems to me, either that he would have the necessary skills to program software to implement rules, or would consult a programmer in order to implement rules that he sets out.

19. That said, I do not think that claim 1 presents any particular difficulty, and is straightforward to construe.

20. However, it is perhaps worth pausing momentarily to set out what the claim means by the word header. Headers are one form of metadata. The term header would in my view be understood clearly at the time of filing to be supplemental data placed at the beginning of a block of data. Indeed, the Cachebox Patent suggests in Table 1 (on pages 7 and 8) that the header consists of a particular series of fields.

21. I also note what is said in Halliburton Energy Services Inc v Smith International (North Sea) [2006] RPC 2 at paragraph 68:

> *(g) It follows that if the patentee has included what is obviously a deliberate limitation in his claims, it must have a meaning. One cannot disregard obviously intentional elements. Hoffmann LJ put it this way in STEP v Empson [1993] RPC at 522:*
> *"The well known principle that patent claims are given a purposive construction does not mean that an integer can be treated as struck out if it does not appear to make any difference to the inventive concept. It may have some other purpose buried in the prior art and even if this is not discernible, the patentee may have had some reason of his own for introducing it."*

22. Thus, the claim limits itself to a header, and I must correspondingly consider the invention so limited.

The Exemplar patents

23. GB 2472264 is used as a priority document by the two other documents listed in the request, GB2473306 and GB2484877 (the UK reproduction of WO 2011/012909). Perhaps as a result, the three documents share similar descriptions. The claimed inventions, for what in practice are adverts, are respectively, around aggregating attributes; splicing of audio and video content having different frame rates; and the selection of adverts according to constraints associated with other adverts.

24. All three relate to systems which allow the replacement of particular adverts, principally in order to better target adverts, and for the large part in broadcast arrangements. However, all three also make reference to playing back recorded or video on demand programming, as an alternative embodiment.

25. The request singles out GB 2473306 for particular attention, referring me to paragraphs 15-22, 26-28, 34-38 , 48-52 and 58-62. Having read all of the documents in detail that seems to me to be a good place to start. I shall therefore consider whether these passages provide the required features of the claimed invention in the Cachebox Patent. If it turns out that they do not, then I will need to look for these other features in the rest of these documents.

Analysis

26. So to take the features of claim 1 in succession:

> *A system for automating compliance with local broadcasting regulations applicable to advertisements,*

27. Paragraphs 48 and 49 suggest that a clash code may be used to implement advert restrictions imposed by regulators and restriction codes for watershed times for an advert. So this part of the claim is present.

> *said advertisements being provided during timeshifted viewing/listening comprises:*
> *programme supply means to supply broadcast digital video/audio programmes having therein periodic breaks for the insertion of advertisements;*
> *advertisement supply means to supply advertisements within the periodic breaks,*

28. The selected passages do not specifically make reference to time shifting. However, paragraphs 95-96 provide an embodiment for recording and playback, where programs and media (adverts) are recorded and substitutional items (alternative adverts) and may be selected based on updates to profile, campaign metadata and/or substitutional items. There is therefore an embodiment that meets these parts of the claim.

> *each advertisement having associated therewith a header related to a local broadcasting time regulation which restricts the time of day at which said advertisement may be shown;*

29. Paragraph 50 for example, states that individual copies of the media items have their own set of attributes or metadata. It goes on to suggest that this includes restriction codes, such as those relating to the watershed.

30. However, this part of the claim of course requires something more than that. It requires that the advertisement has an associated header, related to time restrictions. The only reference in GB2473306 to headers is in paragraph 109, and that is to transport headers (there is a similar reference in paragraph 160 of WO2011/012909), which is not directly related.

31. This presents a further problem, and may in part lie behind the assertion in Sky's observations that I am being asked to speculate. Nonetheless, as I have already indicated, headers may be one way to enact metadata, but it is not the only way.

32. I note that GB2473306 envisages that media items (adverts) might be aggregated in some way, with attributes grouped into a set for that group. These attributes and the profile data for the user are analysed to determine what schedule of adverts to provide. In so doing, campaign metadata may also be acquired by the receiver, and transmitted over a separate hidden channel with the profile ID. The campaign data might include clash or restriction codes that prevent certain adverts from being displayed before the watershed. None of this clearly points to how the metadata is acquired by the receiver so as to entirely rule out it being in a header, but nor does it seems to me that it rules out the metadata being provided in another way, such as in a separate file. I therefore conclude that GB2473306 does not specifically provide this feature. Nor can I find this feature in the other Exemplar Patents.

33. I have not been presented with any evidence on how the skilled man would have implemented what is proposed in the Sky patents. My opinion is of course limited to the evidence provided.

> *rules database means containing rules relating to said local broadcasting regulations;*
>
> *clock means to supply a real-time clock signal; and*
>
> *control means arranged to read <u>said headers</u> and said clock signal and said rules database and to apply said local broadcasting time regulation to each advertisement before it is shown.*

34. The listed paragraphs listed do not specifically require a clock signal, nor specifically describe the use of a rules database. I note that paragraphs 124 and 125 of GB2473306 make reference to the use of a clock signal in the splicing process, rather than in determining effect of regulations.

35. I have not been presented with an argument that the rule database, and the clock signal are either implicit, nor that the skilled man would or indeed could implement the Exemplar patents in this way. At the very least, that means that there is some doubt about what particular method might be taken in order to implement broadcasting time regulation. However, I have already concluded that the listed documents do not specifically require headers to be used, so I do not I think need to go further.

36. I therefore conclude that neither GB2473306, nor the other Exemplar patents specifically provide this feature.

37. My opinion is limited to the evidence provided, and though I have read the observations in reply in detail, it does not seem to me that the request or these observations in reply, provide any further evidence of how the skilled man might in practice implement the Exemplar patents, nor of Sky's specific plans or activities. Thus, to answer the direct question posed in the request "if and when sky enables the SKY ADsmart service so as to remove or swap out advertisements in pre-recorded programmes which would not be permitted to be broadcast at the time of viewing because their broadcasting would be in breach of Ofcom's watershed regulations...will [Sky] be infringing", I would say based on the evidence provided that this is not the case. It might or might not be the case that the Exemplar patents might be compatible with such an implementation, but I have not been provided with any evidence that would support that. I therefore believe that neither the Exemplar patents, nor the other details provided on "Sky Adsmart" services, provide all of the features or require all of the features of the claim.

38. I note that the requester does not ask me specifically to look at the dependent claims, nor is any argument provided on them. Indeed, having reached the conclusion that the Exemplar patents do not provide all of the features of the independent claim, I do not think that I need to turn to the dependent claims.

Opinion

39. It is my opinion, based on the evidence before me that the system provided in the Exemplar Patents (GB 2472264, GB2473306 and GB2484877), when used to remove or swap out advertisements in pre-recorded programmes, do not provide (or require) all of the features required by the claim. Consequently, the disposal, making of an offer to dispose, use, import or keeping such a product or process within the UK would not necessarily amount to an infringement of GB2498499.

Application for review

40. 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.

Robert Shorthouse
Examiner

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.