

**OPINION UNDER SECTION 74A**

Patent	EP1891571
Proprietor(s)	Glasswall (IP) Limited
Exclusive Licensee	
Requester	Olswang
Observer(s)	HGF Ltd, on behalf of Glasswall (IP) Limited
Date Opinion issued	30 January 2017

**The request**

1. The comptroller has been requested to issue an opinion as to whether EP1891571 is infringed by two products described in the request by Olswang. Observations were filed by HGF Ltd on behalf of Glasswall (IP) Limited, and observations in reply followed from Olswang. Those observations deal both with the subject matter of the request and whether the request is allowable.
2. The request describes two products, which it refers to as MIMESweeper version 4.2 and EMAC Filter. The Office sought initial clarification of whether the request was intended to be a request for an infringement opinion in relation to both of these documents, as the request suggests that the MIMESweeper product was available for some 5 years before the request. That confirmed that the intention was to seek an infringement opinion on both products. The other part of that clarification was that no opinion was sought on Mailstreet or Macro Checker.
3. This leads onto a line of argument in the observations over the nature of the request, and I should therefore first turn to the question of the allowability of the request. In the observations from HGF Ltd suggest that the case is the subject of litigation in the US and earlier discussion between the parties in negotiations. They go on to suggest that Clearswift have had other opportunities, for example to have considered an EPO opposition, to challenge the patent. This is the first point for me to consider.
4. The second point on the allowability of the request, is as HGF assert, that is not sufficiently well defined for a sensible opinion to be reached. In this respect it is worth noting the passage on page 4 of the request which states:

“For the purposes of this request, we focus on claim 1 of the Patent, on which all further method claims are dependent.... Whilst we consider that a number of the integers of claim 1 are not satisfied by either of the products, we request specific clarifications regarding integers 1d, 1e, 1f, 1h.”

5. Indeed, the request in analysing most of the features of the claim, asks that “solely for the purposes of this opinion please assume this integer is satisfied.” This is certainly not the usual starting point for an infringement request, as the request asserts that the products it refers to as MIMESweeper version 4.2 and EMAC Filter do not infringe the claim.

6. Section 74A(3) of the Patents Act 1977 states:

*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.*

7. The relevant rule, is rule 94, which reads:

*(1) 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.*

8. I must therefore consider whether the request is frivolous or vexatious, as a result of what HGF suggest Clearswift’s position at the EPO and the US might be. I note however, that there was no opposition filed in the EPO before the time period expired. I also imagine that the nature of litigation in the US, means that the full range of features in claim 1 will be explored in litigated proceedings, with all that that entails.

9. Firstly, I should say that the US proceedings are not related to this specific patent (as patents are territorial) with the consequence that it is always possible that particular issues may be dealt with in different ways in different jurisdictions. I do therefore believe that there may be some legitimate reasons why the requestor might wish to have the opinion of an examiner on what might be the position on a limited subset of questions in a different jurisdiction, and it does not seem to me that the overlap is such that it can be said that this question has been covered in relevant proceedings. I do not therefore believe that the request can be said to be frivolous or vexatious, or that it has or is likely to be covered by relevant proceedings.

10. However, that does not quite complete the picture. It is of course worth remembering at this point that an opinion is not based on the outcome of fully litigated proceedings. Rather, it is based on whatever material the requester and the observer have chosen to put before the Office. Furthermore I note that the opinion service was introduced to help parties resolve disputes without the need for litigation or if litigation was commenced to help the parties better focus their arguments. As such the IPO has attempted where possible to reach an opinion (which is a non-binding opinion) when requested to do so. So for example, it is permissible to ask for an opinion as to whether a hypothetical product would infringe a product.

11. In this case the requester has accepted that certain features of the claim are not satisfied by the particular products however it then in effect goes on to request an opinion of whether hypothetical products having the features of these two products

and also those additional features of the claim that it acknowledges are not satisfied by the product would infringe the claim. That is in my view a legitimate basis for requesting an opinion and I will proceed on that basis..

12. Finally, I note that HGF make two further points on this issue. First that is that the features 1d, 1e, 1f and 1h should not be read in isolation. Secondly, they suggest that the information provided is too limited to come to a sensible opinion. However, in order to analyse that, I shall need to turn in more detail to the invention of the Patent itself, and then the information provided.

## The Patent

13. The Patent was granted on 4 September 2013, and continues to be in force in the UK.
14. The Patent relates to a method of reducing the risk of spreading unwanted code and data, by examining the data format of content. This is based on the knowledge that the majority of files that are imported onto a computer are in standardised file formats, as a result of proprietary programs. However, the need to exchange data between different proprietary programs means that some generic formats also exist. However, all of these formats conform to rigid standards in order to be widely read. These mean that there are certain characteristics that can be used to recognise normal acceptable files.
15. In the description, the Patent suggests that data which falls outside such normal ranges, can be sent to a threat filter, which bases an assessment, of whether to allow that data through, on the sender and data file type.

## Claim construction

16. 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.
17. The request breaks claim 1 up as follows:

1a	A computer implemented method of resisting the spread of unwanted code and data in an electronic file, the method comprising:
1b	receiving an incoming electronic file wherein the incoming electronic file is an email having plural parts from a sender,

1c	each part of said file containing content data in a pre-determined data file type
1d	each data file type having an associated set of rules
1e	said rules including the rules making up the file type specification
1f	and additional rules constraining the values and/or ranges that content and parameters can take on determining a purported predetermined data file type of each part
1g	parsing the content data of each part in accordance with the rules associated with the purported predetermined data file type;
1h	determining if the content data of each part does conform to the rules associated with purported predetermined data file type;
1i	regenerating the conforming parts of parsed content data,
1j	upon a positive determination from the determination means, to create a substitute regenerated electronic file in the purported predetermined data file type,
1k	said substitute regenerated electronic file containing the regenerated content data;
1l	blocking the parts of the parsed content data that do not conform to the rules associated with the purported predetermined data file type so as to block them from inclusion in the substitute regenerated electronic file,
1m	storing a list of file types and sources associated with said file types that are not considered a threat;
1n	forwarding the non conforming parts to a threat filter;
1o	determining by the threat filter for each non conforming part whether that non conforming part is to be allowed through on the basis of the stored list and the sender of the file and the data file type; and
1p	allowing a nonconforming part to by pass the blocking and including the by passing non-conforming part in the substitute regenerated electronic file it determined to be allowable.

18. Neither the request nor the observations suggest that there is any particular difficulty in construing the claims. Though the requester notes paragraphs 38-42 might be of some assistance in understanding the terms “associated set of rules” and “additional rules.” These paragraphs set out that there are rules for making up a particular file

specification for a predetermined format. The additional rules are further qualified in the claim as being those that constrain the values and/or ranges that content and parameters can take on determining a purported predetermined data file type of each part. The description of these additional rules in these paragraphs is consistent with this.

19. It is worth noting that these additional rules are only referred to once in part f of the claim. The remaining references in the claims are to determinations made on the basis of the “associated set of rules.” However, I do not think that there are any particular complications in construing the claim.

## **The Products**

20. The request refers to two products, and I shall take these in turn. I have not been provided with either of these products, nor specific evidence of how they work. However, the request does give a description of these products, and whilst the observations do suggest that the information is limited, it does not suggest that the information provided is factually incorrect.
21. First, the Mimesweeper version 4.2, of November 2000, as described in the request. This is described as being a tool for comparing an email against a predetermined standard, such as “plain text only” and then creating a regenerated file which conformed to that standard, for example by removing html tags, content known to be potentially malicious such as active content, macros or Javascript. The email may have had several different parts (using html formatted text, macros, URLs and hyperlinks.)The request goes on to make comparisons to other products, and suggests that the method use is “fundamentally the same as” a content filter which screens emails for words and removes pre-identified tags, scripts or html comments and attributes.
22. This is a somewhat limited description, in HGF’s view, so much so that it is insufficient to come to an opinion. In terms of the parts of the claim I am asked to consider:

- d) each data file type having an associated set of rules*
- e) said rules including the rules making up the file type specification*

23. The claim therefore requires that “each file type [in the incoming electronic file of 1b] has associated sets of rules”. In contrast, in the description provided of MIMESweeper 4.2, it is suggested that what might be received are emails, which may have various features within it. In the description provided in the request, only email format files are considered, and then the content assessed against it. I note that in the description of the EMAC Filter that it is implied that MIMESweeper does not deal with attachments, and it is stated that EMAC works on a broader range of file types. As such this only states that email format as a “file type” is dealt with. This falls short of being explicit that in MIMESweeper each file type has an associated set of rules, and that those rules including making up the file type specification. So I cannot be sure that MIMESweeper provided this feature, based on the limited information provided.

*f) and additional rules constraining the values and/or ranges that content and parameters can take on determining a purported predetermined data file type of each part*

*h) determining if the content data of each part does conform to the rules associated with purported predetermined data file type;*

24. Again, the information provided does not make clear that values and/or ranges are provided for the content and parameters. Rather, it is suggested that some types of content might be removed. In the request, this is described as positively identifying proscribed content from a defined list corresponding to desired business policies. It does not therefore seem to me that the information on MIMESweeper provided can clearly be read onto these parts of the claim.
25. Secondly, to turn to the EMAC Filter, of 2013, as described in the request. This is described as a next generation product of MIMESweeper, which includes a feature which operates in a similar manner to MIMESweeper but across a broader range of file types. It is suggested that the EMAC Filter was also able to check attachments such as PDFs according to a predetermined standard set by the customer, such as “no active content”. This it is suggested means that there is no threat analysis done on macros, for example on a statistical analysis of the removed content, the file, or commonly occurring data or parameters of the file type. The request suggests that this means if a PDF is checked by EMAC filter, it does not check whether the content of threat PDF corresponds to commonly occurring content or parameters of PDF files.
26. HGF argue that it is simply not possible to meaningfully assess whether this satisfies integers 1f and 1h, as the request states that the EMAC filter is based on a predetermined standard set according to a business decision by a customer, and that the EMAC filter does not differentiate between, for example, “good macros” or bad “macros” when regenerating files.
27. This is a somewhat limited description, in HGF’s view, so much so that it is insufficient to come to an opinion. In terms of the parts of the claim I am asked to consider:
  - d) each data file type having an associated set of rules
  - e) said rules including the rules making up the file type specification
28. Here, I think it is clear that the EMAC filter in dealing with different file types, and it seems to me that it is implicit that this involves employing some rules to determine the specification or format of the file type.
  - f) and additional rules constraining the values and/or ranges that content and parameters can take on determining a purported predetermined data file type of each part
  - h) determining if the content data of each part does conform to the rules associated with purported predetermined data file type;
29. Again, the description of the EMAC filter is not clear on how the process of

processing files for example to deal with a user request for “no active content” will be implemented. This again falls short of showing whether additional rules provide particular values or ranges that content and parameters can take on, or what alternative mechanisms could be used. Even if the result appears to be that, for example, parts (containing data in a particular file type) which do not conform, by having active content, are determined, and only non-active content is implemented.

30. It does not therefore seem to me that the information on EMAC filter provided can clearly be read onto these parts of the claim.

## **Infringement**

31. 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.*

32. As I have already highlighted above, there are a couple of limitations to the scope of this opinion, in that the request asserts that the products concerned do not infringe the claim, and in terms of the evidence provided. Perhaps in part for this reason, there seems to be no real debate about whether the MIMESweeper or EMAC products referred to were or are available in the UK. It is of course also noted by both sides that the MIMESweeper product described appeared several years before the Patent concerned.
33. I have also already noted that this opinion is based on the description provided in the request of these products. I can only also conclude to the extent that the limited description of these products reflects the full process of what I imagine are detailed software products.
34. I therefore conclude in relation to the question of whether features 1d, 1e, 1f and 1h (as requested) are provided in the two products as described.

## **Opinion**

35. My opinion, based on the information provided, is that neither of the products described shows all of the features 1d, 1e, 1f and 1h required by claim 1. So for a product which would also meet the remaining requirements of the claim, I do not believe that either product, as it is described here, would infringe the claim.

## **Application for review**

36. 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

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## **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.*