Patents Act 1977 **Opinion Number** **01/18**

OPINION UNDER SECTION 74A

Patent	EP2003466
Proprietor(s)	Eryk Szweryn, Lukasz Strzalkowski
Exclusive Licensee	
Requester	ip.access Ltd
Observer(s)	
Date Opinion issued	28 March 2018

The request

1. The comptroller has been requested to issue an opinion as to whether EP(UK)2003466 (the patent) is infringed by a femtocell presence sensor product manufactured by ip.access Ltd (the requester). Accompanying the request are several attachments describing the product and details of correspondence with the proprietors.

Observations

2. Observations were received from the proprietors. These observations provide some history of their dealings with the requester, some general arguments relating to infringement of the product and refuting some arguments made in the request.

Observations in reply

3. No observations in reply were submitted.

The patent

4. The patent was filed on 12 June 2008 and granted on 19 February 2014. Following a period in which the patent lapsed through failure to pay the renewal fee, it was restored and is now in force. It relates to a method for localization of a mobile telephone. Essentially, when the mobile telephone enters the coverage area of a low power mini base station (mini BTS) and detects the mini BTS, the position of the mobile telephone can be inferred from the known position of the mini BTS. The patent has two claims, the first of which is independent as follows with clauses numbered for ease of analysis:

1. A method for localization of a mobile phone with the aid of a cellular network, wherein the cellular network comprises a set of high power-level BTS (3) and a set of low power mini BTS (4) used for localization and having identifiers assigned to them, the method comprising the steps of:

   (i) -saving location data of each mini BTS (4) in at least one database in at least one exchange;

   (ii) -introducing a mobile phone (7) into a coverage area of a low-power mini BTS;

   (iii) -measuring by said mobile phone the signal strength received from the low-power mini BTS (4);

   (iv) -registering by said mobile phone the signal strength received from the low-power mini BTS (4) which is comparable with the strength of signals comprised on a current list of the strongest signals received by said mobile phone (7)

   characterized in that said method further comprises the steps of

   (v) -determining a change in a list of the strongest signals received by said mobile phone (7);

   (vi) -informing a program (11) operating on a SIM card (12) of the mobile phone (7);

   (vii) -checking by said programme (11) if there is a new base station on said list;

   (viii) *-carrying out a localization event;*

   -said localization event included the step of checking by said programme (11) if *an* identifier of said new base station is comprised in a range of identifiers assigned to a mini BTS (4) used for localization;

   (ix) -informing an exchange (1) about *said* localization event;

   (x) -reading the location of said mini BTS (4) from said database;

   (xi) -assigning the location of said mini BTS (4) to said mobile phone (7).

The femtocell presence sensor product

5. The femtocell presence sensor product is described by the requester as a device which acts like a closed access femtocell (that is a low power BTS which restricts access to certain devices). However it uses a different location area code (LAC) to that of nearby macrocells. A mobile phone enters the coverage area of the product and performs idle mode cell reselection to it according to standard 3GPP behaviour.

The different LAC causes the mobile phone to perform a standard 3GPP location update procedure. The product rejects the mobile phone as “unauthorised” by sending a “location update reject” message to the mobile phone causing the mobile phone to return to the macrocell. During the procedure the product captures the identity of the mobile phone. The product does not connect into a core network of a cellular network but can provide the identities of mobile phones which “pass by” the product to third parties. An example use is for monitoring footfall at a shop entrance.

Infringement

6. Section 60 of the Act states that:

(1) Subject to the provisions 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.*

> *2) Subject to the following provisions of this section, a person (other than the proprietor of the patent) also infringes a patent for an invention if, while the patent is in force and without the consent of the proprietor, he supplies or offers to supply in the United Kingdom a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the United Kingdom*

7. In the Supreme Court in *Actavis UK Limted and others v Eli Lilly and Company [2017] UKSC 48* Lord Neuberger stated that the problem of infringement is best approached by addressing two issues, each of which is to be considered through the eyes of the notional addressee of the patent in suit, i.e. the person skilled in the relevant art. Those issues are:

> *(i) does the variant infringe any of the claims as a matter of normal interpretation; and, if not,*

(ii) does the variant nonetheless infringe because it varies from the invention in a way or ways which is or are immaterial?

8. If the answer to either issue is “yes”, there is infringement; otherwise there is not.

9. Neither party has submitted a definition of the person skilled in the art but I consider that person to be a technician or engineer working in the field of mobile communications with particular knowledge of standard mobile phone locating methods.

10. I shall start by considering whether the product infringes the patent as a matter of normal interpretation. This means interpreting the claims in the light of description and drawings. Simply put, I must decide what a person skilled in the art would have understood the language of the claims to mean. I shall do this by considering each part of claim 1, taking account of any arguments on each side. I note however that the observations are general in nature and do not address any specifics of claim 1.

Does the product infringe as a matter of normal interpretation?

11. Claim 1 requires a method for localization of a mobile phone with the aid of a cellular network. As described by the requester, and as outlined in paragraph 5 above, the product works in the context of a macrocell environment and so the product does localize mobile phones with the aid of a cellular network. The product, which can be described as a mini BTS, will implicitly have and assigned identifier.

12. Clause (i) of the method requires saving location data of each mini BTS in at least one database in at least one exchange. The requester argues that the product does not infringe because it does not “effect the actual implementation of the ‘saving of location data of each mini BTS in a database in at least one exchange’”. I agree that the product itself does not do this based on the evidence provided. However, the requester’s comment suggests that such saving of location data may be effected by some other entity.

13. The requester argues that clauses (ii) to (ix) are performed by a mobile phone and therefore are not infringed by the product. The requester stresses that ip.access Ltd does not manufacture or sell mobile phones or SIMs that perform these operations. I agree that the product does not directly infringe according to Section 60(1). Furthermore, the method that the product uses to localize a mobile phone is very different to that of claim 1. When the product localizes a mobile phone, the phone does not perform any of the steps (ii) to (ix). Also the claimed invention does not require anything other than a conventionally operating mini BTS. Therefore I do not consider that the product is a means, relating essential element of the invention, for putting the invention of the patent into effect in accordance with Section 60(2). In other words, there is also no indirect infringement.

14. Clauses (x) and (xi) require reading the location of the mini BTS from a database and assigning it to the mobile phone. I agree with the requester that the product does not do this.

Does the product infringe because it varies from the invention in a way or ways which is or are immaterial?

15. According to *Actavis UK Limted and others v Eli Lilly and Company [2017] UKSC 48* this is the second issue to address when considering whether there is infringement. The Court in *Actavis* provided a reformulation of the three questions in *Improver [1990] FSR 181* to provide guidelines or helpful assistance in connection with this second issue. These reformulated questions are:

    (i) Notwithstanding that it is not within the literal meaning of the relevant claim(s) of the patent, does the variant achieve substantially the same result in substantially the same way as the invention, i.e. the inventive concept revealed by the patent?

    (ii) Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, that it does so in substantially the same way as the invention?

    (iii) Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?

16. In order to establish infringement in a case where there is no literal infringement, a patentee would have to establish that the answer to the first two questions was “yes” and that the answer to the third question was “no”.

17. According to the evidence provided by the requester, the product operates in a substantially different way to the method of the invention as specified in claim 1. Therefore it is my opinion that the answer to the first two questions in “no”.

Opinion

18. It is my opinion that the femtocell presence sensor product does not fall within the scope of the claims as a matter or normal interpretation, nor does it vary from the patent in a way that is immaterial. Accordingly it is my opinion that the product does not infringe EP(UK)2003466 B1.

Application for review

19. 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.

GARETH GRIFFITHS
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.