

Rovi v Virgin

The procedural and legal complexities which can result from differing decisions handed down by the EPO and UK courts was illustrated recently in a judgment from the UK Patents Court.

The UK Patents Court recently handed down its judgment (see [here](#)) in one of a number of actions between Starsight Telecast Inc. and United Video Properties Inc. (collectively referred to as Rovi) and Virgin Media Limited, Virgin Media Payments Limited and TiVo Inc. (collectively referred to as Virgin). The action related to an alleged infringement of two of Rovi's European (UK) patents (EP1763234 and EP0821556) by three different TiVo and Virgin devices, and a counter claim from Virgin that the two European (UK) patents were invalid.

The two classes of alleged infringing devices were a TiVo set-top box and two Virgin HD set-top boxes (VHD and V+HD), which were collectively referred to as VHD. The VHD devices were said to offer a further functionality of Alternative Adult Listing Display, which was said not to be available on the TiVo device. In its judgment, the UK Patents Court found that the two patents were invalid and that only the variation of Alternative Adult Listing Display of the VHD device infringes the granted claims of EP1763234.

The first patent, EP1763234, related to electronic program guides, and is currently awaiting the outcome of an appeal at the EPO following a decision of the Opposition Division to maintain the patent in amended form. In its appeal at the EPO, Rovi requested that the patent be maintained as granted and included an auxiliary request to maintain the patent based on a combination of granted claims 1, 2 and 4. Therefore, the UK Patents Court had to consider both of these

sets of claims, in addition to the upheld claims from the opposition proceedings (referred to as the EPO claims). The UK Patents Court found that only the claims upheld during the opposition proceedings did not add subject matter, but that all the claims were obvious.

In the judgment, an allegation that the subject matter of the various claim sets was excluded from patentability was considered, since the claims related to displaying programme schedule information. The contribution of granted claim 1 and the combination of granted claims 1, 2 and 4 was deemed to be non-technical and to relate to a display of information. The allowed EPO claims on the other hand were found to make a technical contribution, since the contribution related to the specific methodology by which the scheduled information is restricted and displayed. The judgment thus provides an interesting demonstration of the way in which excluded subject matter is being considered by the courts in the UK.

In addition, a notable comment in the judgment was that having to consider many sets of claims does no credit to the European patent system, and the Court suggests that consideration should be given to expedite the appeal at the EPO in the event that the decision of the UK Patents Court is appealed.

The second of the two patents, EP0821556, was said to relate to the delivery of television signals from a plurality of sources. The situation before

the court was more straightforward, since there was no ongoing action at the EPO. During opposition proceedings at the EPO, the patent had been upheld in amended form and the decision of the Opposition Division was not appealed. The UK Patents Court found that the claims of this patent added subject matter, and were not new and obvious. Only the VHD devices were alleged to infringe, and the court found that these devices did not infringe.

This judgment shows the procedural and legal complexities which can result from differing decisions handed down by the EPO and UK courts.

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