

SOUTH AFRICA / JUDGMENT

Multichoice South Africa (Pty) Ltd v Barron and Another (P2002/10346) [2014] ZACCP 4; 2014 BIP 121 (CP) (3 December 2014)

[2014] ZACCP 4

COURT

Court of the Commissioner of Patents

BEFORE

J W Louw

CASE / FILE NUMBER

P2002/10346

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IN

THE COURT OF THE COMMISSIONER OF PATENTS

FOR

THE REPUBLIC OF SOUTH AFRICA

S.A. PATENT No. P

2002/10346

DATE HEARD: 17 NOV.

2014

DATE DELIVERED: 3

DECEMBER 2014

In the matter

between:

MULTICHOICE

SOUTH AFRICA (PTY)

LTD.....Applicant

and

IAN

BARRON.....First

Respondent

JAN

FREDERICK

VERSTER.....Second

Respondent

JUDGMENT

J W LOUW J

- [1] The first and second respondents are the co-patentees of South African Patent no. 2002/10346 Entertainment System and Method. The patent was filed on 20 December 2012 and the earliest priority date claimed is 4 October 2001.
- [2] The applicant applies, in terms of s 61 of the Patents Act 57 of 1978 ("the Act"), for the revocation of the patent on the grounds of lack of novelty, insufficiency, lack of inventive step and lack of fair basis. Save for lack of fair basis, the attacks turn on the interpretation of the claims of the patent.
- [3] The patent has two independent claims, being claim 1 and claim 17. Claim 1 reads as follows:

An entertainment system, including

- (i) a data storage means containing a plurality of entertainment programs;
- (ii) control means operably connected to the data storage means, the control means being operable to provide a menu of the entertainment programs stored on the data storage means and to selectively retrieve and transmit a stored entertainment program from the data storage means on receipt of a predetermined user-initiated signal;
- (iii) a communications channel operably connected to the control means and connectable to a plurality of display means for displaying the menu and programs transmitted by the transmitting means; and
- (iv) a plurality of selection means operably connected to the communications channel each selection means being operable by a user of the system to select a program from a menu displayed on a respective display means and to transmit a signal representative of the said selection to the control means;
- (v) characterised in that the control means is operable on demand by a respective user to transmit a program selected by that respective user from the displayed menu from a beginning of the said program, independently of the selection of programs by other users of the system.¹

- [4] Claim 17 is a method claim and reads as follows:

A method for providing entertainment by means of an entertainment system, the method including the steps of

- (i) providing a data storage means containing a plurality of entertainment programs;

(ii) displaying, via a plurality of display means/ a menu of the programs contained on the data storage means;

(iii) receiving from a user of the system, via a user-operated selection means, a user-initiated signal representative of a program selected by the user from the menu of the programs displayed on a respective display means; and

(iv) transmitting on demand by the respective user a program selected by that respective user, from a beginning of the said program, for display means of that user, independently of the programs selected by the other users of the system.²

[5] The applicant contends that what is claimed in claims 1 and 17 of the patent is a standard video on demand (VOD) system which was well known at the priority date of the patent. The parties agree that a VOD system is a system which allows subscribers to request videos when they wish ("on demand") and watch them in real time or download them for later viewing.

[6] In support of the attack based on lack of novelty and obviousness, the applicant relies on three US patents and three publications, all of which were published before the priority date of the patent. The respondents admit the existence of the prior art on which the applicant relies and further admit that all of the integers of claims 1 and 17 are to be found in such prior art, save that they contend that the patent teaches a unique method in which the relevant data is transmitted directly from a central data storage base to the end user and not, as in the case of the prior art, where the data is first downloaded to a device, a so-called set-top box or "intelligent centre", prior to it being transmitted to the end user. In this regard, the respondents allege that the menus which are generated on a user's

television set and which allow the users to interact with the entertainment system, are stored on a central server, located remote

from the user, and are displayed directly on the user's television screen without the use of a set-top box, allowing the user to

interact directly with the central server by using the user's remote control. Prof. D. Schonfeld, who deposed to an affidavit on behalf of the applicant and whose expertise was not challenged, explained in his affidavit why it is technically impossible to make such a system work.

[7] The suggested limitation of direct interaction is also not to be found in claims 1 or 17. There is no reference in either of the claims to direct interaction between the central server and the user's remote control. Integer (iv) of claim 1, properly interpreted,

simply means that the selection means (i.e. the remote controls) must be operably connected to the communications channel to select a program from the menu displayed on the user's television screen and to transmit a signal

representative of the selected program to the control means (i.e. the central server). The words "operably connected" do not exclude the use of some device, such as a set-top box, to achieve the connection between the remote control and the central server.

- [8] In the absence of the alleged limitation, it follows that claims 1 and 17 are anticipated by the prior art on which the applicant relies, the existence of which is admitted. It further follows that, having regard to the same prior art, the claimed invention would have been obvious at the priority date of the patent.
- [9] The method by which the direct interaction is achieved, is also not explained in the specification. Figure 1 of the specification³ does not indicate any set-top box or other device between the remote controls shown (numbered 6) and the television sets shown (numbered 5) or between the television sets and the central (computer) server (numbered 2). The following is, however, stated in the description of the invention on page 7 of the specification with reference to the drawings:

"Associated with each TV set 5 is a remote control device 6 of a conventional type. Further, each TV set 5 has an associated decoder module (not shown). The remote control devices are in communication with the decoder, which are (sic), in turn, connected to the cable network and associated TV sets."

And on p. 8 of the specification, the following is stated:

"On activation of the remote control unit 6f a signal is transmitted from the decoder of the TV set 5 to the computer server 2, requesting the transmission of a specific entertainment program. The server 2 retrieves a copy of the program in the database 7 of the file server 3 and initiates transmission of the program in a suitable format via the cable network 4 to the respective decoder and TV set 5."

- [10] Contrary to the suggestion that the patent teaches direct interaction between the central server and the remote controls of users, the above passages indicate that the interaction between the central server and the remote controls of users is achieved by means of a decoder. The interaction between the central server and the remote controls of users is therefore not direct.
- [11] It was submitted on behalf of the respondents that a decoder is not a settop box or an "intelligent centre". If that were to be accepted, the difficulty which the patentees face is that the specification does not describe how the invention is to be performed by a person skilled in the art. Sec. 61(l)(e) of the Act provides that application for the revocation of a patent may be made on the ground that the complete specification does not fully describe, ascertain and, where necessary, illustrate or exemplify the invention and the manner in which it is to be performed. The summary of the invention in the specification largely mirrors the claims of the patent. The "Detailed Description with reference to the Drawings" only sets out what the basic building blocks for the claimed system and method are without any explanation of how the direct interaction between the central server and the remote controls of users is

achieved. It is explained that the system of the invention comprises a control means, being a computer server 2, which is operably connected to a storage means comprising a file server 3 having a data base 7 and also to a TV transmitter (not shown). The system further has a communications channel 4 such as a cable TV network. A plurality of TV sets 5 is connected to the computer server and TV transmitter via the cable network. The only other description of the system to be found in the specification is on page 8 thereof, where it is stated that, instead of the file server, a dedicated "black box" may be provided for each user of the system which may have a removable storage device containing a full complement of available

programs stored thereon. It is stated that such a system may conveniently be used in an outlet such as a video shop or in a condominium complex. The claims of the patent are, however, not limited to such use.

- [12] The specification does therefore not fully describe, ascertain, illustrate or exemplify the manner in which the claimed invention is to be performed to enable a person skilled in the art to carry out the invention. It follows that the applicant's attack on the ground of insufficiency must succeed.
- [12] The last ground of attack is that claims 7 and 8 are not fairly based on the matter disclosed in the specification (s 61(l)(f)(il) of the Act). Claims 7 and 8, which were introduced later by way of an amendment to the specification, are directed at educational uses for the system described in the patent. There is no reference to any educational use of the system in the patent specification. The argument advanced on behalf of the respondents was that all entertainment programs fall within the specification, including those that have an educational bent. The argument does not address the issue of whether claims 7 and 8 are fairly based on the matter disclosed in the specification and is without merit. The specification is silent on any educational use of the claimed invention. Claims 7 and 8 are accordingly not fairly based on the disclosure contained in the specification.

[13] In the result, I make the following order:

- (a) South African Patent no. 2002/10346 is revoked.
- (b) The respondents are ordered to pay the applicant's costs of the application, including the qualifying fees of the applicant's expert witness, Prof. D. Schonfeld.

Applicant's counsel: Adv. G. Marriott

Respondents'counsel: Adv. J. Moorcroft

Applicant's attorneys: Adams & Adams, Pretoria

Respondents' attorneys: Richards Attorneys, Pretoria

JOHN & KERNICK

FOR THE APPLICANT

- 1 My numbering of the integers of the claim
 - 2 My numbering of the integers of the claim.
 - 3A copy of Figure 1 is attached to the judgment.
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