Neutral Citation Number: [2013] EWCA Civ 1613

Case No: A3/2013/0301

IN THE COURT OF APPEAL (CIVIL DIVISION)
ON APPEAL FROM HIGH COURT OF JUSTICE
CHANCERY DIVISION
PATENTS COURT (Mr Justice Arnold)

Royal Courts of Justice
Strand, London, WC2A 2LL

Date: Thursday 11th December 2013

Before:
THE CHANCELLOR OF THE HIGH COURT
LORD JUSTICE JACKSON
and
LORD JUSTICE KITCHIN

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BETWEEN:

MICROSOFT CORPORATION

Claimant/Respondent

- and -

MOTOROLA MOBILITY LLC.

Defendant/Appellant

AND BETWEEN:

(1) MOTOROLA MOBILITY LLC.
(2) MOTOROLA MOBILITY INTERNATIONAL LIMITED

Part 20 Claimants/Respondents

- and –

(1) MICROSOFT CORPORATION
(2) MICROSOFT LUXEMBOURG S.A.R.L.
(3) MICROSOFT IRELAND OPERATIONS LIMITED

Part 20 Defendants/Appellants

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-(Transcript of the Handed Down Judgment of
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Official Shorthand Writers to the Court)
- - - - - - - - - - - - - - - - - - -

Richard Meade QC and James Abrahams (instructed by **Bird & Bird LLP**) for the

Claimant/Respondents

Daniel Alexander QC and **Tim Powell (Solicitor Advocate)** (instructed by Powell Gilbert LLP) for the **Defendant/Appellant**

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Judgment

The Chancellor of the High Court, Sir Terence Etherton:

1.   This is an appeal from the order of Arnold J dated 25 January 2013 revoking European Patent (UK) No. 0 847 654 ("the Patent") and dismissing the claim of the appellants ("Motorola") for infringement of the Patent.

2.   The Patent relates to the synchronisation of multiple mobile devices, specifically status synchronisation as distinct from, for example, synchronisation of the content of a message.

3.   The Judge held that the claims of the Patent were invalid either for lack of novelty over prior art or for obviousness over the common general knowledge of paging or prior art or, in some cases, for both lack of novelty and obviousness. He further held that, if, contrary to his conclusion, the Patent was valid, it was infringed by the system of the respondents ("Microsoft") for synchronising emails and other messages but that, in relation to some infringements, Microsoft had a defence by virtue of a licence agreement with Google Inc ("Google").

4.   Motorola contends that the Judge was wrong in his interpretation of the Patent, in his interpretation of and approach to the prior art and in his interpretation of the Google licence. The appeal is limited to claim 1 in the Patent ("Claim 1"), which the Judge held to be invalid for obviousness over the common general knowledge of paging and three items of prior art.

5.   In the event, this appeal has turned solely on the issue of the proper interpretation of Claim 1.

<u>The Patent</u>

6.   The Patent is entitled "Multiple pager status synchronization system and method". It has a priority date of 31 August 1995.

7.   Under the heading "Field of the Invention" the specification states at [0001] that the invention "relates generally to the field of two-way communication devices and, in particular, to information managed therein".

8.   The specification contains the following statements about the background of the invention, including, in particular, the problem which the invention seeks to solve and what is needed to provide the solution.
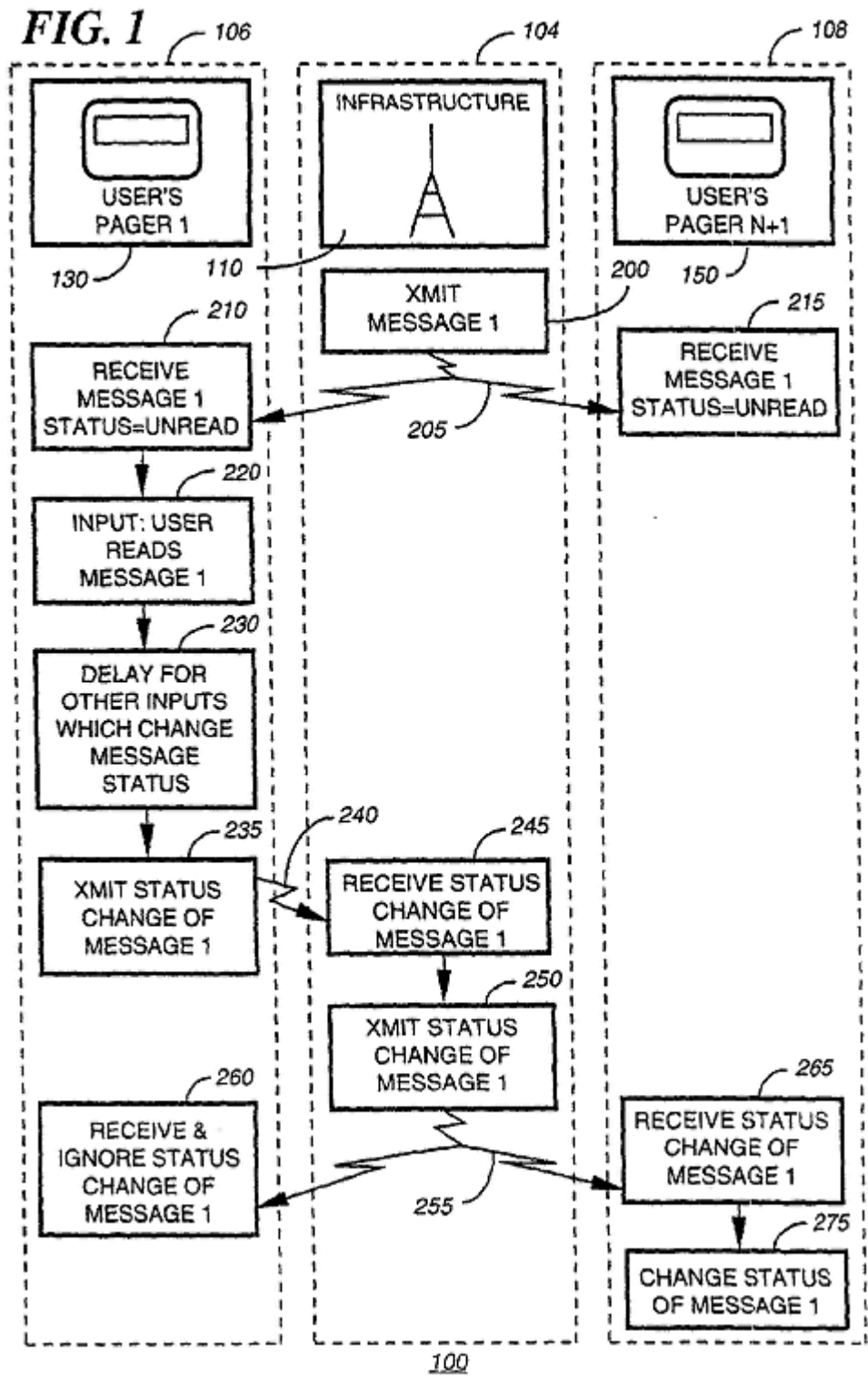
> "[0002] As the acceptance of selective call communications devices, or pagers, including two-way pagers, continues to grow, and as their affordability continues to improve, some users are acquiring pagers which have a same selective call address. Pagers come in different … colors to complement a user's attire. Thus the user carries one pager at one time with one apparel outfit and another pager at another time with another outfit. For example, a neon coloured belt worn pager is used for a day at the beach, and a black and gold pen pager with a business suit is used for an evening business meeting."

"[0004] However, a problem arises when the user has multiple pagers which are left continuously on. For example, messages received by a pager carried by a user are also received by the user's other pagers which are not carried at that time. Disadvantageously, with known pagers, message status changes made by the user on the carried pager are not made on the user's other pagers. If a user reads, deletes, or protects a message on the carried pager, the message remains as an unread message on the user's other pagers. Thus, when the user changes attire and corresponding pagers, the user is faced with a different pager having messages with an unread status, which are identical to messages previously read, deleted or protected on another pager. Thus, the user must again read and decide the status of each message received on the other pager. This additional tedious task required after each change of a pager poses an inconvenience to the user that could deter a user from acquiring a number of pagers in different form factors and colors. Thus, what is needed is a way to have message status changes made on any one of the user's pagers automatically made on the user's other pagers."

9. The specification goes on to note at [0005] that a similar problem arises when the user has multiple pagers and the user changes configuration information stored in one of the pagers. Examples given of this are the time of a daily alarm or the type of alert produced when a message arrives from a certain user or having certain content, such as changes in the value of a financial instrument or a key word indicative of a news item. The specification then states at [0007]:

> "… what is needed is a way to have status changes to a pager configuration made on any one of a plurality of the user's pagers automatically made on the other one or ones of the plurality of the user's pagers."

10. There follows a summary of the invention and then a description of the preferred embodiment. The embodiment corresponding to Claim 1 is shown schematically in Fig. 1, which is as follows:

FIG. 1

USER'S PAGER 1 — 106, 130

INFRASTRUCTURE — 104

USER'S PAGER N+1 — 108, 150

110

200

XMIT MESSAGE 1

210 — RECEIVE MESSAGE 1 STATUS=UNREAD

205

215 — RECEIVE MESSAGE 1 STATUS=UNREAD

220 — INPUT: USER READS MESSAGE 1

230 — DELAY FOR OTHER INPUTS WHICH CHANGE MESSAGE STATUS

235 — XMIT STATUS CHANGE OF MESSAGE 1

240, 245 — RECEIVE STATUS CHANGE OF MESSAGE 1

250 — XMIT STATUS CHANGE OF MESSAGE 1

260 — RECEIVE & IGNORE STATUS CHANGE OF MESSAGE 1

255

265 — RECEIVE STATUS CHANGE OF MESSAGE 1

275 — CHANGE STATUS OF MESSAGE 1

100

11. As Arnold J explained (at [28]), in this embodiment the wireless messaging infrastructure 110 sends a first message 205 to the user's pagers 130 and 150 in step 200. On receipt, the pagers assign the status "unread" to the first message in steps 210 and 215. The user reads the first message on pager 130 in step 220, which causes the status of the first message to change from "unread" to "read". After a delay to allow for other inputs which change the status of the first message (for example, an instruction by the user to delete the message) at step 230, pager 130 transmits a second message 240 to the infrastructure indicating the change in status of the first

message at step 235. The second message is received by the infrastructure in step 245, whereon the infrastructure sends a third message 255 to the pagers indicating the change in status of the first message at step 250. On receipt of the third message at step 265, pager 150 changes the status of the first message in step 275.

29. As the specification states at [0021]:

> "Thus the status of messages received by pagers 130 and by all pagers 150 will be identical after execution of step 275. Thus if a user reads and deletes a message on pager 130, it will also be identified as being read and deleted on pager 150. Consequently, when the user changes from pager 130 to 150 in response to changing attire, or otherwise, the status of messages in both pagers will be substantially identical. This has the advantage of alleviating the inconvenience of changing the status of unread messages in pager 150."

12. Arnold J broke down Claim 1 into the following integers, which have not been criticised on this appeal:

> "[A] A method of synchronizing message information among a plurality of transceivers comprising the steps of:
>
> [B] transmitting by a wireless messaging infrastructure a first message having a first status;
>
> [C] in one transceiver of the plurality of transceivers, changing the first status of the first message to a second status responsive to an input to the one transceiver, and
>
> [D] transmitting a second message indicative of the second status;
>
> [E] in the wireless messaging infrastructure, receiving the second message;
>
> and characterised in that the method includes the steps of
>
> [F] in the wireless messaging infrastructure, responsive to receiving the second message, transmitting a third message indicative of the second status; and
>
> [G] in at least one other transceiver of the plurality of transceivers, receiving the third message, and
>
> [H] responsive to receiving the third message, changing the first status of the first message to the second status."

13. Although only Claim 1 is in issue on this appeal, it is relevant to my reasoning below to reproduce claim 3 of the Patent ("Claim 3"), which is as follows (with reference numbers omitted):

> "A method of synchronizing a status of a plurality of transceivers comprising the steps of:

in a first transceiver,

changing the status of the first transceiver from a first status to a second status as a result of an input from a user, and transmitting a first message indicative of the second status;

in a wireless messaging infrastructure,

receiving the first message, characterised in that the method includes the steps of, in the wireless messaging infrastructure,

transmitting a second message indicative of the second status; and

in a second transceiver

receiving the second message, and changing a status of the second transceiver to the second status in response thereto."

Principles of Interpretation

14.   The principles for interpreting patents have been subject to considerable judicial analysis and refinement over time and are now well established. Although they share many of the same elements as the principles of interpretation in other areas of law, they have the special feature of being subject to the overarching provisions of section 125 of the Patents Act 1977, which itself is intended to give effect to Article 69 of the European Patent Convention ("the EPC") and its Protocol.

15.   So far as concerns the case law, in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2004] UKHL 46, [2005] RPC 9, the House of Lords approved Jacob LJ's summary of the principles of interpretation applicable to patents in *Rockwater Ltd v Technip France SA* [2004] EWCA Civ 381, [2004] RPC 46, at [41] subject to one reservation. In *Virgin Atlantic Airways Ltd v Premium Aircraft Interiors UK Ltd* [2009] EWCA Civ 1062, [2010] RPC 8, at [15] the Court of Appeal approved the following distilled version of that summary, taking account of what had been said in *Kirin-Amgen* and with some other minor amendments. Having observed that the task of the court is to determine what the person skilled in the art would have understood the patentee to have been using the language of the claim to mean, the Court of Appeal set out the following principles:

"(i) The first overarching principle is that contained in Article 69 of the European Patent Convention.

(ii) Article 69 says that the extent of protection is determined by the claims. It goes on to say that the description and drawings shall be used to interpret the claims. In short the claims are to be construed in context.

(iii) It follows that the claims are to be construed purposively - the inventor's purpose being ascertained from the description and drawings.

(iv) It further follows that the claims must not be construed as if they stood alone - the drawings and description only being used to resolve any ambiguity. Purpose is vital to the construction of claims.

(v) When ascertaining the inventor's purpose, it must be remembered that he may have several purposes depending on the level of generality of his invention. Typically, for instance, an inventor may have one, generally more than one, specific embodiment as well as a generalised concept. But there is no presumption that the patentee necessarily intended the widest possible meaning consistent with his purpose be given to the words that he used: purpose and meaning are different.

(vi) Thus purpose is not the be-all and end-all. One is still at the end of the day concerned with the meaning of the language used. Hence the other extreme of the Protocol - a mere guideline - is also ruled out by Article 69 itself. It is the terms of the claims which delineate the patentee's territory.

(vii) 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.

(viii) It also follows that where a patentee has used a word or phrase which, acontextually, might have a particular meaning (narrow or wide) it does not necessarily have that meaning in context.

(ix) It further follows that there is no general 'doctrine of equivalents.'

(x) On the other hand purposive construction can lead to the conclusion that a technically trivial or minor difference between an element of a claim and the corresponding element of the alleged infringement nonetheless falls within the meaning of the element when read purposively. This is not because there is a doctrine of equivalents: it is because that is the fair way to read the claim in context.

(xi) Finally purposive construction leads one to eschew the kind of meticulous verbal analysis which lawyers are too often tempted by their training to indulge."

Arnold J's judgment

16.   The Judge gave a comprehensive and careful judgment. It is not necessary to set out his analysis in detail. It is sufficient to mention the following few points about his reasoning and conclusions on Claim 1, which is the only claim in issue on this appeal.

17.   He rejected the argument of Motorola that the expression "responsive to" in integer [F] of Claim 1 means that the wireless messaging infrastructure transmits the third message to the second transceiver solely as a result of the receipt of the second message from the first transceiver, that is to say it excludes methods of synchronising the status of messages in which the second transceiver requests updates from the infrastructure. In the language of the relevant technology, the Judge rejected the argument that the Patent provides for changes in message status to be synchronised only by a "push" system rather than also by "polling".

18.   In the light of that interpretation, that is to say giving Claim 1 a wider reach than Motorola contended for, the Judge held that Claim 1 was obvious over the common general knowledge of paging and was also obvious over three items of prior art, namely US Patent No 5,221,838 ("Gutman"), PCMAIL and IMAP4.

19.   The common general knowledge as at 31 August 1995 on which the Judge based his conclusion of obviousness was the common scenario in which one-way pagers were employed where an organisation needed to send an urgent message to a group of people, specifically where a hospital would send a message to a group of doctors requesting that one of them attend an emergency. Once that message had been received and acknowledged by one doctor, a further message would be sent in order to inform the other doctors that they no longer needed to attend.   In that situation, each pager typically had its own unique address.

20.   As regards the prior art on which the Judge based his conclusion of obviousness, Gutman related primarily to an electronic wallet and banking information. Its aim was to facilitate financial transactions by removing the need for a user to carry multiple financial cards, a cheque book and cash and by making it easier for a user to keep track of their account balance. PCMAIL and IMAP4 were protocols for email systems for personal computers which, among other things, enabled synchronisation of changes in the status of messages.

The German proceedings

21.   There are parallel proceedings between both Motorola and Microsoft and Motorola and Apple Sales International ("Apple") in Germany.

22.   In infringement proceedings between Motorola and Apple the Mannheim Regional Court held on February 3 2012 that Apple had infringed claim 1 of the German counterpart of the Patent.

23.   Both counsel for Microsoft and counsel for Motorola submitted to the Judge that the Mannheim Court's construction of "responsive to" was consistent with their respective interpretation of the Patent. The Judge said (at [72]) that it was more consistent with Microsoft's interpretation than with Motorola's. On this appeal Motorola disputes that conclusion of the Judge.

24.   Following the handing down of the Judge's judgment, on July 9 2013 the Bundespatentgericht (German Federal Patent Court) issued a preliminary opinion, in validity proceedings to which Motorola, Microsoft and Apple were all parties, which supported the Judge's interpretation. In paragraphs 3 and 8 of its opinion the Federal Patent Court said as follows:

> "3. … The sub-features in 1.6a [1[F]] in claim 1 … that <u>responsive to</u> receiving the second message … the transmission of a third message takes place, are understood by the person skilled in the art in the sense that the reception of the second message is a necessary but not sufficient condition for transmission of the third message, ie at a time not further specified after the reception of the second message a third message is transmitted. …"

> "8. … The Division's current viewpoint is as follows: first of all, the adjective 'automatic' is not part of the wording of claim 1. There is also doubt about whether an automatic push synchronisation is implicitly disclosed to the person skilled in the art from the sub-feature 1.6a, that the transmission occurs 'responsive to receiving the second message'. With claim 1, a method is claimed that includes the steps indicated there; however all methods with these steps that comprise further additional steps therefore also fall under the claimed subject matter. …

> The Division currently feels that the chosen claim wording "responsive to" … is not suitable to distinguishing between push and polling synchronisation methods."

25. On August 29 2013 the Karlsruhe Higher Regional Court issued a judgment on appeal from the Mannheim Regional Court staying enforcement of the Mannheim court's ruling on infringement and for an injunction and the rendering of accounts on the grounds that it was "overwhelmingly likely" that the patent in suit would not survive the nullity proceedings. The Karlsruhe court said that it had "no reason to doubt" the Federal Patent Court's assessment on the main interpretation issue was correct.

26. A final hearing in the Federal Patent Court took place on 13 November 2013. It made its decision on that day to revoke claim 1 but to accept as valid, pursuant to an auxiliary request, a narrowed down version, namely a version which contains the feature of a delaying transmission of status changes so as to cut down the number of status change transmissions. Mr Daniel Alexander QC, for Motorola, told us that the Federal Patent Court said that they "could not unambiguously conclude that poll synchronisation was excluded". That court's detailed reasoning, however, will not be apparent until delivered in writing in due course. Mr Richard Meade QC, for Microsoft, accepted that it was not possible, in the absence of a written statement as to the court's reasoning, to state definitively that, in reaching its decision, the court must have rejected Motorola's interpretation of claim 1. That is because the decision of the Federal Patent Court is not logically inconsistent with claim 1 of the German counterpart of the Patent being invalid over the prior art, whatever its proper interpretation. There is a right of appeal from the decision of the Federal Patent Court.

27. Bearing in mind the respect which is due to decisions of the German courts on issues of patent validity and infringement, it would have been of considerable value to know the detailed reasoning of the German Federal Patent Court in reaching its decision on 13 November 2013. In the present absence of that detailed reasoning, however, I do

not consider it is safe for either side or this Court to rely on the German proceedings as to the correct outcome of this appeal. For that reason I shall not refer to them again in this judgment.

The appeal

28. Motorola can only succeed on this appeal if the scope of Claim 1 is more limited than the Judge decided was the case. That is essential if Motorola is to be able to challenge the Judge's conclusions on the invalidity of the Patent for obviousness over the common general knowledge of paging at the priority date and also the prior art.

29. Mr Alexander gave as the context for the Patent that it was in the early stage of pager communication when paging technology was in its infancy.

30. Mr Alexander laid particular emphasis on the following parts of the Patent specification as supporting the restriction of Claim 1 to a method of updating the second transceiver without any prior request for an update being made by that device, that is to say as excluding systems in which the device polls the wireless infrastructure for updates. First, Motorola rests its case on the expression "responsive to receiving the second message" in integer F. In an exchange with Kitchin LJ Mr Alexander said that the expression "responsive to" in integers [C] and [H] support the connotation of immediacy and automaticity conveyed by the same expression in integer [F]. Secondly, Mr Alexander emphasised that Figures 1, 2, 3 and 4 do not contain any step by which the second device polls for an update. In Mr Alexander's language, they show the additional device as a passive recipient, that is to say it sits in a state of readiness to receive the message instigated by the first device about message status changes on the first device. Thirdly, Mr Alexander pointed out that [0015] of the Patent specifically envisages that one of the additional devices may be a receive-only pager, and so incapable of sending any message to the wireless infrastructure.

31. In what appears to be a change from the position taken before the Judge, Mr Alexander did not place any independent reliance on the word "automatically" in the statement in [0004] that "what is needed is a way to have message status changes made on any one of the user's pagers automatically made on the user's other pagers" and a similar statement in [0007]. He accepted that the word "automatically" could encompass a poll command. He described the use of the word "automatically" in those parts of the Patent as "the starting point of the argument" and not its end-point.

32. Furthermore, Mr Alexander did not regard the statement at the beginning of [0004] to the problem arising when the user has multiple pagers "which are left continuously on" as having any material bearing on the dispute as to interpretation.

33. Mr Alexander's argument was that, in the light of the indications which he emphasised and I have mentioned above, the confinement of Claim 1 to a push rather than a polling system of updating additional devices is the most natural reading of the language of the Patent, consistent with the background and purpose of the invention set out in [0002] to [0007] of the specification and also the relatively early state of pager communication technology at the date of the Patent's publication. He submitted that to give Claim 1 another meaning, encompassing a polling system of command, by reference to the general background and objectives set out in [0002] to [0007] would be taking a purposive approach too far.

34.   Motorola wishes to advance a further argument on interpretation if it should fail on its principal argument that Claim 1 is to be confined to push communication to the additional devices rather than polling commands by them. The further argument is that Claim 1 should be confined to non-manual commands from the additional device, that is to say commands for updates generated periodically by the second device itself rather than by manual initiation by the user of the additional device.

35.   Motorola has several other grounds of appeal from the Judge's order. As I have said, it is common ground that, if Motorola fails on both its principal and its subsidiary interpretation arguments, those other grounds of appeal do not arise and the appeal must be dismissed. At the conclusion of the oral submissions, we announced that we had reached a clear view that we did not accept Motorola's principal point of interpretation and that we would not permit the subsidiary interpretation argument to be run. We did not, therefore, hear any oral submissions on the other grounds of appeal.

Discussion

36.   The words in Claim 1, on which Motorola principally relies – "responsive to receiving the second message" in integer [F] – are not individually or as a composite expression a term of art. Taken in isolation, those words are perfectly consistent with communication by polling as well as push. Their natural meaning is not confined to a response to a single trigger or causative influence. The expression "responsive to" in integers [C] and [H] do not take the matter any further. Those words cannot be restricted to an immediate automatic update of the additional device because, as Mr Meade pointed out, there may be a number of possible interventions which would prevent that happening since the wireless infrastructure always controls which messages are passed on.

37.   As I have said, Mr Alexander laid particular store on the absence of any step in Figures 1, 2, 3 or 4 featuring a polling command by the additional device. The preferred embodiment of an invention is certainly relevant to the interpretation of the claims in a patent. That does not mean, however, that Figures 1, 2, 3 and 4 are, of themselves, determinative of the interpretation issue. An illustration of the invention does not, of itself, operate as a limitation. The critical issue always remains the proper meaning of the claim.

38.   Nor is Motorola's interpretation argument materially advanced by the express recognition in the Patent that one of the additional devices may be a receive-only pager. It is Motorola's case, which the Judge accepted (at [55] – [56]), that the "transceivers" mentioned in Claim 1 are any devices which can both transmit and receive. It follows that, on Motorola's own case, Claim 1 requires at least two devices capable of polling. The fact that a third may be a receive-only pager is not, therefore, inconsistent with an interpretation of Claim 1 which encompasses polling.

39.   As I have said, Mr Alexander accepts on this appeal that it is not conclusively in favour of Motorola's interpretation of Claim 1 that [0004] and [0007] of the specification stipulate the need for message status changes on one pager to be made "automatically" on the user's additional devices. Not only does that word not appear in Claim 1 but Mr Alexander is also plainly right to acknowledge that the word

"automatically" is not inconsistent with a polling command, at least if generated by the device itself rather than by manual input.

40.   It follows that there is nothing in the Patent itself which clearly points to any intention to limit the expression "responsive to receiving" in integer F, and hence Claim 1, to push communication of updates. By contrast, there are compelling reasons for holding that Claim 1 does not exclude the possibility of poll commands. In the first place, that would be entirely consistent with the background and purpose of the invention disclosed in [0002] to [0007]. The purpose was quite simply to enable a person who has a number of transceivers with the same call address to have the message status changes on one device automatically carried through to all his or her other devices, that is to say without having to go through the "additional tedious task" (in the words of [0004]) of reading and deciding the status of each message on the other device. That purpose is achieved whether the updates are obtained by the additional device on the initiative of the wireless infrastructure or only after the second transceiver has requested the updates.

41.   Secondly, as the Judge found and Motorola accepts on this appeal, the word "transceiver" in Claim 1 includes a device for sending and receiving emails. As the Judge said (at [45]), it follows that the Patent is directed to both a paging engineer and an email engineer. As the Judge found (at [20]), at the time of the publication of the Patent the standard operation of email was on a polling basis, that is to say the client sent requests to the server, and the server then sent responses to the client. That would have formed part of the common general knowledge of the person skilled in the art, namely an engineer with expertise in email systems. Accordingly, that forms part of the background against which Claim 1 must be interpreted.

42.   I do not accept a submission made by Mr Alexander that, because the primary focus of the Patent was on pagers, common general knowledge of the poll system of emails (which he described as a different "sub-branch") should be ignored in interpreting Claim 1. The common general knowledge in question was not some fine technical point. It was about the standard operation of emails. To ignore it completely would be inconsistent with the Judge's finding that the person skilled in the art, to whom the Patent was addressed, includes an email engineer. The common general knowledge to which I have referred inevitably has the consequence of severely undermining Motorola's principal case on interpretation. The Patent does not contain any clear indication that it is necessary, in the case of email, to depart from the then paradigm of polling. The Patent does not identify any problem with synchronisation methods which involve polling or a manual request by the user. Indeed, it does not refer to such methods at all.

43.   Thirdly, Claim 3 does not include the expression "responsive to". Specifically, it is absent at the analogous point in the characterisation in Claim 3 to integer [F] of Claim 1 (viz. the sending of the second message upon receipt of the first message). Mr Alexander submitted that it is not legitimate to interpret Claim 1 by reference to Claim 3. He observed that Claim 3 (which is concerned with changes such as alarm times, alert melody or silent mode) is not strictly a sub-claim of Claim 1 but an independent claim. I agree that Claim 3 cannot operate to limit Claim 1 but that does not mean to say that the language of Claim 3 may not be of relevance to the interpretation of language in Claim 1. I agree with Mr Meade that, if it was the intention in the present case that the Patent should be confined to a method of

updating status changes on a number of devices which does not include polling for the updates, it is very surprising, to say the least, that the words of limitation relied upon in relation to Claim 1, namely "responsive to", are not to be found at the point in Claim 3 where one would expect by analogy with Claim 1.

44.   Those matters provide a clear and compelling case for rejecting Motorola's principal argument that Claim 1 is limited to push technology and excludes commands for updates by polling. I do not accept Mr Alexander's submission, with particular reference to *Kirin-Amgen* at [33] and [34], that to do so involves an impermissible widening of the actual language of Claim 1 by reference to the general advantage to be put into effect by the invention as described in the Patent contrary to Article 69 of the EPC, the Protocol and case law. On the contrary, it is an interpretation entirely in accordance with the principles approved in *Kirin-Amgen*.

45.   I turn to Motorola's subsidiary alternative argument on interpretation, namely that Claim 1 is restricted to non-manual initiated commands for updates. Motorola did not advance before the Judge an argument that, if it failed in its principal submission on interpretation, a distinction should nevertheless be made between polling by manual command by the user and intermittent polling generated by the device itself. It was in the context of the absence of any such argument that the Judge accepted Microsoft's argument (recited at [65]) that integer [F] is satisfied in a case where the second transceiver has requested an update, whether done periodically or only when specifically commanded by the user.

46.   As I understand it, the reason why Motorola wishes to exclude from Claim 1 manually initiated commands is to enable it – notwithstanding the rejection of its principal argument on interpretation - to attack the Judge's finding that Claim 1 was obvious over PCMAIL and IMAP4. It would do so on the basis that, in changing PCMAIL and IMAP4 to a wireless network at the priority date, synchronisation of message status changes would have been achieved by being initiated by the user rather than by way of polling commands generated by the additional devices themselves.

47.   I agree with the submission made by Mr Meade that this alternative subsidiary point of interpretation is not raised in the Grounds of Appeal. Those parts of the Grounds of Appeal dealing with the Judge's findings of obviousness over PCMAIL and IMAP4 are expressly stated to be conditional on Motorola's construction of Claim 1. The Grounds of Appeal dealing with Motorola's construction are in paragraphs 2 to 12 and make no mention of the alternative subsidiary point of interpretation now sought to be advanced. There is no reference to the Judge's acceptance of Microsoft's submission recorded in paragraph [65] of the judgment.

48.   I would in any event refuse Motorola permission to advance this new argument of interpretation for another reason. As I have said, it is only sought to be advanced to provide a gateway to attack the Judge's findings of obviousness over PCMAIL and IMAP4. That attack itself depends on factual and expert evidence as to how PCMAIL and IMAP4 would have been implemented wirelessly at the priority date. There was some evidence before the Judge on that aspect but it was given in the absence of the point of interpretation now sought to be advanced. Further evidence and other lines of cross-examination might have been pursued had the new argument on interpretation been advanced below. Mr Meade pointed out, for example, that

PCMAIL includes both machine and user-generated poll commands for synchronising message changes and that in IMAP4 there is a periodic machine generated poll for status updates. Furthermore, and unsurprisingly, there has been no finding by the Judge as to whether or not, if PCMAIL and IMAP4 had been implemented wirelessly at the priority date, synchronisation would have been initiated by the user.

49.   I am satisfied in those circumstances that it would be wrong to allow this new point of interpretation to be advanced on the appeal since it would be quite wrong to permit Motorola to advance the linked and consequential attack on the Judge's findings of obviousness over PCMAIL and IMAP4.

50.   As I have said, Mr Alexander accepted that, if he failed in his arguments on interpretation, the remainder of the Grounds of Appeal fall away.

Conclusion

51.   For the reasons I have given, I would dismiss this appeal.

Lord Justice Jackson

52.   I agree.

Lord Justice Kitchin

53.   I also agree.