

PATENTS ACT 1977

IN THE MATTER OF an application
under section 27 of the Act to amend
Patent No EP(UK)0804763 in the name of
Intel Corporation and an opposition
thereto by Via Technologies Inc

DECISION

Introduction

- 1 Intel Corporation (“Intel”), have filed an application to amend patent No EP(UK) 0804763 under section 27 of the Patents Act 1977. The amendments they seek were originally proposed under section 75 of the Act in a validity action in the High Court, but that application was discontinued when the action was settled in June 2000. The present application to amend was subsequently filed on 18 September 2000 under section 27 together with a statement of reasons for the request. The proposed amendments were advertised in the Patents and Designs Journal on 21 February 2001.
- 2 Via Technologies Inc (“Via”) filed a notice of opposition on 20 April 2001 and a statement of opposition on 4 May 2001. The statement included grounds of opposition relating to added subject matter, extension of the scope of the patent and the question of the amended patent’s validity over the prior art, the so called validity issues. The statement also referred to the allowability of the amendments in view of the patentee’s conduct, the so called discretionary issues. Via immediately wrote a second letter on 4 May saying they wished to withdraw the grounds relating to validity and oppose only on the grounds relating to discretion. They wished to avoid the expense of an action on the validity issues, which they said was unnecessary at this stage since Intel was not currently asserting the patent. However Via were concerned that by withdrawing the validity grounds, they might be estopped from pursuing them in future. They asked the comptroller to make a ruling which would allow them to pursue the discretionary objections now but reserve their position on the validity points.
- 3 In order to determine the way forward, a procedural hearing was held on this issue. It resulted in an Order by consent dated 6 September 2001 that Via be excluded from bringing the validity issues raised in their statement of opposition in these proceedings.
- 4 Intel then filed a counterstatement on 18 September 2001, relating of course only to the discretionary issues. Via were due to file the first round of evidence but wrote at that time, on 21 November 2001 requesting a) full disclosure of relevant documentation by the patentee before the evidence rounds, and b) a reversal in the order in which the parties should file evidence so that the patentee had to file theirs first. I issued a second procedural decision on 31 January 2002 denying Via their request for disclosure but granting the request that Intel be obliged to file their evidence first. The decision also set a timetable for the evidence rounds.

- 5 Intel filed evidence on 2 April 2002 and 16 April 2002 including a witness statement of a Dr Neuhauser. The opponents objected that Dr Neuhauser's statement consisted largely of evidence relating to validity, not to discretion. A third procedural hearing decided this matter and my decision of 4 July 2002 ordered that paragraphs 22 to 37 and subparagraphs ii) and iv) of para 38 of Dr Neuhauser's witness statement (which related to validity issues) be treated as struck out. This decision also ordered Via to confirm whether they wished to file evidence since they had foreshadowed that they may not need to do so. A letter from Via of 17 July 2002 in response to that Order confirmed that Via did not wish to file evidence.
- 6 Via's letters of 20 September and 4 October 2002 proposed, and Intel's letter of 4 October 2002 agreed, that the substantive decision should be made on the papers. A timetable for the exchange of submissions by a first appointed date and responses by a second date was agreed between the parties and the Office. Via wrote on 27 and 28 November 2002 requesting an extension of time to file their submissions. Intel opposed the request and I issued a fourth procedural decision on 28 November 2002 refusing to allow an extension.
- 7 Submissions and subsequently responses from each of the parties were then duly filed and the application has come before me to be decided on the papers. My decision is in relation to the discretionary issues only, in accordance with my earlier Order.

Evidence and other documents submitted

- 8 Before summarising the evidence and other documents that have been submitted, I should explain that in addition to the High Court action in the UK, Intel and Via were at the same time involved in an infringement, validity and opposed amendment action over the corresponding Singapore patent. Indeed it is in the Singapore action that prior art allegedly relevant to validity was first raised. Some of the material which has been put forward in the present proceedings by Intel was previously put forward in the Singapore action.
- 9 Intel's statement of reasons were accompanied by the following attachments which are the items of prior art introduced by Via in the Singapore action :

The IBM Technical Disclosure Bulletin, Volume 36 No 10, 1 October 1993, pages 187 to 191, entitled "Micro Channel Data Streaming and Input/Output Snooping Facility for Personal Computer Systems" ("IBM TD").

Single Chip PCI Bridge and Memory Controller for PowerPC Microprocessors" by Michael J. Garcia and Brian K Reynolds. ICCD '94 Proceedings IEEE, pages 409 to 412 ("Garcia").

"PCI System Architecture" by Tom Shanley, PC System Architecture Series, volume 4, published in 1993 by MindShare Inc, especially Part III, Chapter 16, "Snoop-Ahead Feature" pages 239 to 240 ("Shanley").

Particulars of alleged prior use relating to the Bridge Chip manufactured by VIA Technologies Inc integrated circuit number VT82C505 (“505 IC”).

10 Intel’s evidence was filed on 28 March 2002. This comprises:

- a) A Witness Statement of Peter William Ward, a solicitor at Bird and Bird acting for Intel who introduces statutory declarations made in the Singapore action by three of the four inventors, Ali Serhan Oztaskin, George Richard Hayek, and Brian Langendorf. He also introduces witness statements by Jo-Ann See, the solicitor acting for Intel in the Singapore action, and by James H Salter, a US patent attorney for Intel.
- b) Witness Statements from three attorneys at or working for Intel: Isabella Fu, an attorney at Intel, Joseph Bond, a patent attorney at Intel, and Francis Wombwell, a patent attorney who prosecuted the present EP application.
- c) A Witness Statement of Michael Dowler, another attorney acting for Intel, who gives evidence concerning the fourth inventor, Bruce Young.
- d) The Witness Statement of Charles J Neuhauser, an expert witness, now amended to exclude paragraphs 22 to 37 and sub-paragraphs ii and iv of 38 as ordered in my earlier decision.

Apart from Dr Neuhauser, all the witnesses mentioned above are key individuals concerned with making the invention, or with the prosecution of the US and EP patents or with the Singapore action.

11 As I have said, the parties have agreed to a decision on the papers, with no oral hearing. That effectively means Via have elected not to cross examine any of Intel’s witnesses. They rightly point out that had they insisted on an oral hearing, with 9 overseas witnesses to be cross examined the costs would have been prohibitively high. However they also stress that their agreement to dispense with an oral hearing should not be construed as meaning they accept Intel’s evidence. Intel, on the other hand, say that because Via have chosen neither to cross examine nor file evidence of their own, Intel’s evidence stands uncontradicted.

12 Intel are largely right on this. Whilst Via are to be commended for not insisting on their right to an oral hearing, that does mean they can only challenge the truth of what Intel’s witnesses have said if they can point to inconsistencies or the like which are apparent on the face of the written evidence (including the prior-art documents) made available to me. Absent such inconsistencies, I must take what the witnesses have said to be true. Of course, whether Intel’s evidence is sufficient to discharge the onus that rests on them is another matter entirely.

13 There is one other point to be noted on the evidence. One of the inventors, Bruce Young, no longer works for Intel. An American attorney working for Intel, Mr Dowler, contacted Mr Young by telephone and asked him about his knowledge at the material time of the above-mentioned prior art. Mr Young answered his questions and then agreed to assist Intel by deposing to an affidavit. Mr Dowler prepared a draft for

the affidavit on the basis of the conversation and sent it to Mr Young for consideration and completion, but even though Mr Young apologised to Mr Dowler on a number of subsequent occasions for not having returned the affidavit, Mr Young never did return it. Mr Dowler has therefore explained in his own evidence what Mr Young told him. This is obviously much less satisfactory than a statement from Mr Young himself and I can only attach limited weight to this secondhand report of Mr Young's knowledge at the relevant time. Nevertheless I do accept that Intel have made a genuine attempt to get evidence from Mr Young. For the purposes of the present proceedings, I do not feel they could reasonably have been expected to do more.

The requested amendments

14 Claim 1 of the patent reads as follows. I have inserted the additions that Intel wish to make to the claim as shaded text (or red text in an electronic version of this decision) and indicated the deletions they wish to make by a line through the relevant text:

1. A bus bridge and memory controller circuit (16) enabling data streaming operations in which a plurality of memory access transactions to sequential memory addresses are performed, said bus bridge and memory controller circuit for use in a computer system having a processor (12) and cache memory (14), each coupled to a first bus (24), and a bus agent (20) coupled to a second bus (26), the bus bridge and memory controller circuit (16) coupled to the first bus (24) and the second bus (26), the computer system further including a main memory (18) coupled to the bus bridge and memory controller circuit (16), the bus bridge and memory controller circuit characterised by:

state machine circuitry (40) for enabling read and write access to the main memory (18) from the first bus (24) and the second bus (26) and for initiating and performing a plurality of snoop ahead transactions to the cache memory (14) over the first bus (24) prior to corresponding memory access transactions ~~and during memory access transaction~~ and during memory access transactions originated over the second bus (26) and targeted for the main memory (18);
buffer circuitry ~~(42)~~ **which includes a peripheral write buffer (46)** for buffering write data received over the second bus (26) and targeted for the main memory (18); **and a write buffer (42) for buffering write data received over the first bus (24) and write data received from the peripheral write buffer (46)** and
circuitry for storing, for each of the plurality of snoop ahead transactions, a snoop status indication for indicating if a respective one of the plurality of snoop ahead transactions corresponding to a respective one of the memory access transactions has completed.

15 The request also seeks to introduce an entirely new independent claim 2 which reads precisely as claim 1 (apart from inclusion of the word "a" at one point which has no material effect on the meaning) but is further limited by the requirement that the buffer

circuitry must include a multiplexer with certain specified characteristics. Entirely new dependent claims 3 to 6 each introduce further limitations which I do not need to detail. Old claims 2 and 3 become new claims 7 and 8 according to the request, with consequential amendments to adjust their dependency and deletion of the final clause of old claim 2. Old claim 4 is deleted, the subject matter now being incorporated into the proposed amendment to claim 1.

16 It is also proposed to correct the word “issues” to “issued” in column 5 line 39 of the description.

17 Intel say in their statement of reasons that the deletion of the words “and during memory access transaction” in claim 1 and the change from “issues” to “issued” are to correct typographical errors. They say that the deletion of the last clause of claim 2 is to obviate an objection of lack of disclosure made by Via in the previous court action, and they say the remaining, substantive amendments are to distinguish or more clearly distinguish the invention over the cited prior art.

The law

18 The power to allow the specification of a patent to be amended is set out in section 27(1) of the Act:

“Subject to the following provisions of this section and to section 76 below, the comptroller may, on application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit.”

Subsection (5) then gives other parties the right to oppose the application to amend, as Via have done here.

19 The parties have referred me to a number of important precedents going to the discretionary nature of the power in section 27(1). First, the Court of Appeal underlined the continued existence of discretion in *Kimberly-Clark v Procter & Gamble* [2000] RPC 422. In this case Aldous LJ confirmed the principles he set out in the earlier case of *Smith Kline & French v Evans Medical* [1989] FSR 561. *Smith Kline & French* was decided under the Patents Act 1949, the predecessor to the present Act, but Aldous LJ affirmed its application to decisions under the 1977 Act. The *Kimberly-Clark* case related to an application to amend made under section 75 during the course of litigation, but sections 27 and 75 have similar wording and the judgment made clear that the considerations also applied to amendment under section 27.

20 The five principles enunciated in *Smith Kline & French* are worth reciting in full. I have numbered them for convenience:

(1) First, the onus to establish that amendment should be allowed is upon the patentee and full disclosure must be made of all relevant matters. If there is a failure to disclose all relevant matters, amendment will be refused.

(2) Secondly, amendment will be allowed provided the amendments are permitted under the Act and no circumstances arise which would lead the court to refuse the amendment.

(3) Thirdly, it is in the public interest that amendment is sought promptly. Thus in cases where the patentee delays for an unreasonable period before seeking amendment, it will not be allowed unless the patentee shows reasonable grounds for his delay. Such includes cases where a patentee believed that amendment was not necessary and had reasonable grounds for that belief.

(4) Fourthly, a patentee who seeks to obtain an unfair advantage from a patent which he knows or should have known should be amended, will not be allowed to amend. Such a case is where a patentee threatens an infringer with his unamended patent after he knows or should have known of the need to amend.

(5) Fifthly, the court is concerned with the conduct of the patentee and not with the merit of the invention.

21 I should add that, as I ruled in my second procedural decision, “disclosure” in paragraph (1) does not mean disclosure in the modern legal sense of the word, ie it does not mean disclosure in accordance with part 31 of the Civil Procedure Rules. It simply means disclosure in the ordinary dictionary sense of the word, ie the patentee must tell the full story. The onus is nevertheless heavily on the patentee to make a full and open disclosure of the circumstances surrounding the application to amend and of their conduct in pursuing the amendment and in asserting or refraining from asserting the patent, and Intel accept that.

22 Via referred me to a number of further precedents and prior decisions of the comptroller. Some are ones I have already considered in my second procedural decision when construing the meaning of “disclosure” as discussed above, and I do not need to go over them again now, save to observe that in *Oxford Gene Technology Limited v Affymetrix [2001] RPC 18* at p317, Aldous LJ emphasised that:

“The obligation of good faith requires the patentee to put forward correct reasons for the amendment.”

Others largely just reinforce the *Smith Kline & French* principles, and since Intel do not dispute those principles, I do not really need to go into those precedents now either. There were one or two others which put a little more detail on the *Smith Kline & French* principles, and I will come back to these later.

23 Finally, it is worth remembering the point that formed the subject of the first procedural hearing. Section 74 of the Act sets out the proceedings under the Act in which the validity of a patent may be put at issue, and section 27 proceedings are not among them. Consequently an opposition under section 27 cannot become a wholesale investigation into validity. Nevertheless, in order to exercise my discretion, it may be necessary to touch on validity to the extent that dealing with a possible challenge to validity is - as in the present case - one of the reasons put forward for requesting the amendments.

Issues raised

- 24 In their original statement of opposition, Via presented their objections to the amendments under four headings, but in their submissions prior to this decision they presented them under three headings, I presume because they had rightly recognised that there was overlap between two of their original headings. I shall adopt the three-heading approach in this decision. Further, during the course of these proceedings they have dropped some aspects of their objections, so I no longer need to deal with those.
- 25 Via call the first of their headings “knowledge of the prior art”. This is to do with an assertion that Intel knew, or should have known, about one of the prior art documents long before even the Singapore proceedings. They have, say Via, no reasonable grounds for waiting so long before applying to amend, and by pursuing Via for infringement in the interim they sought to obtain unfair advantage from a patent that they should have known was invalid. Linked in with this point is an assertion that Intel haven’t done enough digging to uncover the full history of events. This allegation seems to me to relate to principles (1), (3), (4) and (5) of *Smith Kline & French*.
- 26 Via call the second of their headings “failure to give proper reasons”. This is to do with an allegation that the reasons given are not self-consistent and do not tally with what they said in the Singapore action. This relates to principle (1) and the comment quoted above from *Oxford Gene*.
- 27 Their third heading is “culpable delay”. This is about an allegation that once the relevant prior art had been brought to Intel’s attention in the Singapore proceedings, they deliberately waited until Via had served a description of its own allegedly-infringing product before applying to amend so they could ensure their amendments would still allow them to maintain the allegation of infringement. This, say Via, was improper use of documents provided in the course of legal proceedings and justifies a refusal of the amendments. This allegation relates to principles (3), (4) and (5).
- 28 Most of these objections go to the main body of amendments that Intel have requested to distinguish or more clearly distinguish the invention over the cited prior art. Via have also objected under the second heading alone to the deletion of the last clause of claim 2. They have rightly made no objection to the two amendments which merely correct obvious errors. I shall now consider these allegations in more detail, taking each heading in turn.

Knowledge of prior art

- 29 Intel say they only became aware of Garcia, Shanley and 505 IC when that prior art was introduced into the Singapore action in March 2000. Intel say they, or Mr Wombwell and Mr Salter at least, were aware of IBM TD from the EPO examination process when it was included in the EPO search report of January 1998 and in the EPO examination report of June 1998. However they say that as the examination process was completed in the knowledge of IBM TD they had no reason to believe that any

further amendment might be necessary in light of it.

30 Via are not challenging Intel's submission in respect of 505 IC or IBM TD and they have dropped their challenge in respect of Garcia, so in respect of Via's first heading I do not need consider these items further. However, Via maintain the objection in respect of Shanley because, they say, Intel must have known of this publication much earlier.

31 Before looking at their objection in detail, a word of explanation about this publication may help. Shanley is the fourth of a series of books about the architecture of PC systems, published by an organisation called Mindshare Inc. I think Shanley may have been the author or co-author of some of the other books in the series, but when I refer to 'Shanley' in this decision I mean specifically this fourth book. In the introduction to the book, Mindshare claim to teach PC system architecture to staff at a number of major manufacturers of PCs and PC components, specifically naming IBM, Compaq, Dell and - most significant from our viewpoint - Intel.

32 Shanley is concerned with the architecture of the PCI (peripheral component interface) bus, that is, the second bus of the present claim 1. The book has approaching 300 pages and there have been a number of editions. There is an acknowledgement at the beginning of the book that is very significant in the context of these proceedings:

“This book would not have been possible without the input of the PCI development and marketing people at Intel. Much of their collective input was in the form of brutally honest technical editing, resulting, I hope, in a much better product.”

What makes this significant is the fact that there is an explanation on pages 239-240 of the first edition of a snoop-ahead feature in the context of the Intel 82420 chip set. Now this chip set did not, in fact, incorporate a snoop-ahead feature, but Intel's own witnesses admit that they investigated this feature whilst they were developing the 82460 and then dropped it. In the light of this, Via suggest that Shanley must have learned about the investigation of the snoop-ahead feature from Intel's own staff during the development phase and put it in the book without realising it had been dropped from the final product. I agree with Via that the evidence points inescapably to this conclusion.

33 Whether the snoop-ahead feature disclosed in Shanley meets the requirements of the unamended claim 1 in the present patent is another matter, which would doubtless have been explored in great detail in the High Court action had that not been compromised. The crucial point, say Via, is that one of the reasons Intel give for wanting to make the present amendments is to distinguish more clearly from Shanley, and they challenge Intel's assertion that they only became aware of Shanley during the Singapore action. Via say the acknowledgement I have quoted above clearly implies that staff at Intel would have known all about the contents of Shanley before the book was even published.

34 Via accept that for knowledge of Shanley to be significant in the present proceedings, it must be by Intel personnel connected with the application for the present patent. That

must be right. Intel employ over 70,000 people, and it is quite possible some of them knew of the disclosure of the snoop-ahead feature in Shanley, but that cannot form the basis of an allegation that Intel acted improperly if those who knew of the disclosure had nothing to do with the patent application. However, Via say the subject matter of Shanley is so similar to the patent that the inventors and other personnel concerned with the patent application must have known about it.

- 35 Intel's evidence establishes that of the four inventors, Mr Oztaskin and Mr Young were initially involved in the so called "Saturn" project developing the 82420 chipset featured in Shanley, and they investigated the snoop-ahead feature that was eventually dropped. The other two, Mr Langendorf and Mr Hayek, were not involved in the Saturn project and worked on the Pentium™ chipset known as "Triton" to which the present patent relates. All the inventors assert in their witness statements that they were generally aware that such a book existed, although not necessarily that it was associated with Shanley. However, all say they were not aware of the disclosure in it of the snoop-ahead feature. More specifically, Mr Oztaskin says explicitly that he never read or used Shanley. Mr Langendorf (who is mis-quoted by Via) says he had used Shanley but was sure he was unaware that it referred to snoop-ahead until it was drawn to his attention by Intel's legal advisers during the Singapore litigation. He explains that he may have used a later edition that no longer refers to snoop-ahead. Mr Hayek says he had never had or referred to a copy of Shanley. Finally, Mr Dowler reports that Mr Young told him he could not recall ever consulting it or using it, and whilst, as I have explained, I cannot attach very much weight to this report, I note that it is in line with the evidence of Mr Oztaskin, who had been a co-worker with him on the Saturn project.
- 36 Via criticise the evidence of the inventors in that none of them specifically deny speaking to Shanley or to anyone who may have spoken to him. I do not understand the point Via are making. Even if they had spoken to him, that in itself would not point to bad faith on Intel's part. What matters is whether the inventors knew Shanley had published the snoop-ahead feature in his book, and they have all specifically denied being aware of that. Via also try to cast doubt on the veracity of what the witnesses have said. However, as I said earlier, they have chosen not to cross examine the inventors and their evidence must therefore be taken as true unless Via can point to inconsistencies in it. This they have failed to do.
- 37 In her evidence, Isabella Fu says she tried to find out who in Intel assisted Shanley, but failed because the people who might have been able to give her first hand assistance have since left Intel's employ. She speculates that it may have been the PCI architecture team rather than the chipset team and indicates that they worked separately. She suggests that it is unlikely that anyone in the chipset team had contact with Shanley since if they did, he would not have made the error of saying the 82420 chipset had the snoop ahead feature.
- 38 Via say this is not credible; they say Intel have not provided sufficient explanation or evidence to rebut the presumption - raised by the inventors' admitted general knowledge of Shanley and by the presence of the acknowledgement in Shanley - that they would have been aware of the disclosure in it of the snoop-ahead feature. I disagree. To my mind, the evidence from the four inventors is entirely plausible, especially when one considers the nature of the publication. It is a textbook to help

train aspiring experts, so it would hardly be compulsive reading for the existing experts who actually provided the technical information that helped Shanley write the book. Moreover, bearing in mind that this was just one of a series of books, if an existing expert had felt the need to refer to it, they are unlikely to have read it from cover to cover and most probably would just have dipped in to look up a specific issue. Mr Langendorf, of course, acknowledges that he did use the book, though we are not sure which edition, but even if he did use the first edition, as the snoop-ahead feature occupies less than a page it is entirely possible that he would not have bumped into this passage.

- 39 Via make another point, though. They say that given the onus on Intel, Ms Fu has not made sufficient enquiries because there are still possible avenues of enquiry that she could pursue. She has not, for example, identified who in Intel did speak to Shanley about the snoop-ahead feature. They refer me to an unreported previous decision, *Rosemount Engineering Company Limited v Johnson Matthey & Company Limited* BL O/6/86 in which the comptroller indicated that a patentee who chose to remain behind a wall of silence cannot expect discretion to be exercised in his favour if there are unanswered questions about what they knew and when they knew it. Moreover, they complain, the statements on which Intel are relying are out-of-date because they were originally prepared in January 2001 for the Singapore action, and this is another reason for making fresh and further enquiries.
- 40 The question of how far the patentee needs to go in demonstrating the history of events was, as I mentioned earlier, in part explored in the second procedural hearing in these proceedings, in which I gave a decision on 31 January 2002. In that decision I found that while it was necessary for the patentee to make a full disclosure of all the circumstances surrounding the application to amend the patent, as established in *Smith Kline & French* and succeeding cases, such full disclosure did not demand disclosure in the modern sense, unless there were unusual circumstances. As I said in that decision; “The obligation of the patentee to give “full and frank disclosure” in the *Smith Kline & French* sense is primarily met in the first instance by the statement of reasons, not by ordering modern style “disclosure”.
- 41 The requirement for full and frank disclosure must be interpreted against what is reasonable in the circumstances and proportionate. It is not in my view a requirement that absolutely no possible avenue of enquiry should be left uninvestigated, but rather that the explanation of the events needs to be open and complete in the sense that no relevant information is withheld either deliberately or because of lack of reasonable diligence. Yes, the onus is heavily on Intel to show they have acted in good faith in applying for these amendments, but the obligation on them should not be taken to extremes. There is a balance to be struck as to what is proportionate.
- 42 What Intel have provided in the present proceedings is not just a statement of reasons. They have also provided a witness statement introducing a very large stack of evidence from the Singapore proceedings - it must run to at least 1800 pages - plus five further witness statements made specifically for the present proceedings. They have enquired of many relevant people inside and outside Intel. In my view, Intel have done all that could reasonably be expected of them. They have clearly set out the reasons for the amendments they are seeking in their statement of reasons and in the supporting

evidence and submissions. They have given a detailed timetable of the circumstances in which the perceived need for amendment arose and how the amendments have been pursued. They have explained how they came to be aware of the prior art. They have carried out fairly extensive investigations and filed a body of evidence to refute Via's proposition that relevant staff in Intel must have been aware of Shanley earlier than they admit.

43 True, they have not established who in Intel was aware, at the time, that Shanley had included the snoop-ahead feature in his book, but since even Via concede that only knowledge by Intel personnel connected with the application for the present patent is relevant, I cannot see what purpose would be served by requiring Intel to make exhaustive enquiries of all its staff, and indeed its ex staff. What matters is that they have enquired of the staff who were involved with the present invention and the application for the patent and that, Ms Fu says in her evidence, she has done. I have found that the information and explanations they have supplied are plausible, and that distinguishes the present case from *Rosemount v Johnson Matthey*, where there were holes in the explanations which Johnson Matthey made no attempt to fill. I do not therefore believe it would be right to demand even more extensive enquiries. Further, I do not accept that the Singapore evidence should have been updated since I can see no reason for the recollections of the relevant witnesses to be better now than it was then. The only possible exception is Mr Young, where Via say Intel should have tried yet again to get a statement from him. However, it is clear Mr Dowler had tried very hard to achieve this during the Singapore action and failed, and against that background, I do not feel Intel can be criticised for not banging their head on this brick wall yet again.

44 Accordingly Intel have, in my judgment, fulfilled their obligation and have provided an open and complete disclosure of the circumstances. In reaching this conclusion I have borne in mind the possibility that a wily patentee could throw up a smoke screen by producing an impressively large volume of material that made it look as though it had done a very thorough job but actually diverted attention from the fact that there were serious gaps or weaknesses in its position. However from the substance of Intel's evidence I do not believe that has happened here. I am satisfied they have made a genuine attempt to investigate the history of events properly.

Failure to give proper reasons

45 I now move on to the question whether Intel have furnished proper reasons for the amendments. Via say that the reason given by Intel for the substantive amendments - to distinguish or more clearly distinguish the claimed invention over the prior art raised in the earlier court action - is not a proper reason since Intel's position on whether the prior art invalidates the unamended claims is contradictory. In short, they cannot in one breath say the prior art does not invalidate the unamended claim and then in the next breath say they want to amend in order to avoid it. Intel say that while they do not think the prior art invalidates the patent, that has not been tested in court and a court might find that it does. They say in those circumstances that it is prudent to amend in order to distinguish or more clearly distinguish from the prior art. This is not, they submit a contradictory position and constitutes a clear and proper reason for

amendment.

- 46 Because of the agreement (and indeed, my order) that validity issues be kept out of these proceedings, neither side has made any submissions at what I might call a technical level on whether or not Shanley does invalidate the unamended claims, and if so, whether the proposed amendments cure the defect. In those circumstances, it would be wrong for me to form my own view on this issue, and it would probably be unhelpful anyway. I can only work on the presumption that there is a possibility Shanley may invalidate the unamended claims, but it is not certain one way or the other. That is not an unreasonable presumption, because deciding whether or not a claim is valid is often not a simple matter. There can be scope for argument, and there may be a need for the opinions of experts. It also, quite frankly, does not strike me as an unreasonable assumption on the basis of a quick glance at the unamended claim 1 and Shanley. I hardly need lengthy submissions from each side to see that there is scope for argument as to whether Shanley discloses the last part of claim 1, nor do I need such submissions to see that the proposed amendments are at least an attempt to bring in additional features that are not immediately apparent in Shanley.
- 47 Against that background, I do not find the reasons advanced by Intel for seeking to make the main amendments to be improper or unreasonable. For a patentee to say that they do not believe certain prior art invalidates their claims but they nevertheless want to amend to make sure would only be unreasonable and improper if it were manifestly beyond doubt that the prior art did (or, for that matter, did not) invalidate the claims, and I have no evidence that this is the case here. I consequently find that Via have not made out their case relating to lack of proper reasons for the substantive amendments.
- 48 Via, though, have another angle to their argument. In the Singapore action, Intel were ordered to disclose certain categories of documents. In resisting this order, Intel relied on an affidavit from Isabella Fu stating that such disclosure was not required because Intel were not amending the Singapore patent on grounds of invalidity. This, say Via, is inconsistent with the reasons Intel are advancing for their present application to amend. Even assuming the amendments in the Singapore proceedings were on all fours with the amendments now before me -and I have not looked into that - I do not believe there is any inconsistency, because in the present proceedings Intel are taking the same line in that they are not accepting that the unamended claims are invalid.
- 49 There is one other small point I must deal with in relation to whether Intel have given proper reasons. In their statement of opposition, Via say that Intel have given no reason for the deletion of the final clause of claim 2. Intel point to paragraph 3 of their statement of reasons which says that this amendment was introduced to obviate an objection of lack of disclosure which was made by Via in the previous High Court action. Via's amended particulars of objection from the earlier action, which have been provided by Intel, allege that the patent "... claims, but in relation to read transactions it does not provide an enabling disclosure of, a snoop status indication as so claimed." While Intel do not accept the position Via set out in this statement, they say that they nevertheless sought to address it by proposing this amendment. I am not entirely sure whether Via are still maintaining their objection, but in case they are, I will say that the amendment seems to me to have been undertaken in good faith and the reason for it advanced by Intel to be reasonable and acceptable.

Culpable delay

- 50 In their objection under this heading, Via are not saying there has been a long period of time in which Intel could have sought amendment and omitted to do so either through lack of diligence or through a wish to assert what they knew to be an invalid patent. Their point is that Intel first gave notice of its intention to amend the Singapore patent and the present patent, in the court actions then in progress on the 4 and 5 April 2000 respectively. On 14 April, Via was ordered in the Singapore action to produce a description of the product which Intel alleged to be infringing, which they did on 24 April. Intel did not finalise its amendments until 27 April, and these amendments are now substantially incorporated in the present application. The delay is therefore no more than a few days but Via say that by waiting until they had sight of Via's product description, Intel were able to tailor their amendments in order to maintain the allegations of infringement against Via. By the albeit very short delay, so Via asserted in their original objections, Intel had placed themselves in a position to benefit unfairly.
- 51 Intel do not really deny that they took account of the product description when framing the amendments, but Via have now shifted their position somewhat, because they now appear to concede that it is acceptable for Intel to propose amendments with a view to maintaining an infringement position. They say to suggest otherwise would not be sensible or commercial. However they now say that it is improper to use disclosure given in one action for any purposes other than that action. Thus using the product description served in the Singapore action to frame the amendments for the UK patent is, Via say, an abuse of the disclosure procedure in Singapore.
- 52 In my view Via are right to concede that it was not intrinsically improper for Intel take account of the product description in formulating their amendments. It might have been a different matter if Intel had deliberately delayed for months whilst they spent time fishing for the product description, but that is not what happened. There was barely a month's gap between Via first drawing to Intel's attention in the Singapore action most of the prior art on which they intended to rely and Intel formulating their amendments. If they did wait a few days to see the product description that Via had been required to produce, I do not think they can be criticised for so doing.
- 53 However, I also have difficulty with their argument that Intel have abused the disclosure order in the Singapore proceedings. Part of my difficulty is that Via simply haven't given me enough information about the circumstances in which the disclosure of the product description was ordered and whether it was subject to any conditions. More fundamentally, though, there seems to be a touch of unrealism in acknowledging that it was OK for Intel to wait until they had seen the product description before finalising their amendments in the Singapore proceedings, but not OK to use their knowledge of Via's product in framing the amendments to their UK patent. The logical consequence of Via's argument is that Intel could not requested the same amendment in the UK proceedings as they had requested in the Singapore proceedings. Since the amendments were being offered to deal with exactly the same problem, that proposition is absurd. Indeed, it is worse than absurd: had Intel offered different amendments in the UK proceedings, I have no doubt Via would have been the first to accuse them of lack

of good faith by proposing one set of amendments in the Singapore proceedings and a different set in the UK proceedings.

- 54 Via put forward *Instance v CCL Label* [2002] FSR 27 as an example of a case where delay although not long was found to be culpable. In that case the delay identified by Pumfrey J was 14 months. He was also influenced by the fact that the patentee had initiated infringement proceedings during that period without informing the defendant that one of the independent claims was thought to be invalid, and by the fact that the patentee did not frankly explain to the Patents Court the use that had been made of the patent. I do not see any blameworthy conduct of this sort by Intel in the present circumstances and the *Instance* case does not displace my view that Intel's actions in formulating their amendments were comfortably within the bounds of what is acceptable.
- 55 In short, I do not consider Intel to be guilty of lack of good faith or culpable delay in relying on Via's product description, if they have done so, when formulating their amendments or of pursuing them under section 27 after the court cases were compromised.

Conclusion

- 56 I am satisfied that Intel's request for amendment meets all the principles set out in *Smith Kline & French* and that none of Via's objections are sound. Accordingly I allow the amendments requested by Intel.

Costs

- 57 Costs were held over in the first and second procedural hearings. The first procedural decision resulted in an order by consent, but achieved the purpose Via were seeking and which Intel had opposed, so Via were successful in the first round. In the second hearing, Via lost on their application for disclosure but succeeded on having the order of evidence rounds reversed, so honours were even. Intel were ordered to pay costs of £400 relating to the third procedural decision. Via lost the fourth round when I refused to allow an extension, although by agreeing to a decision on the papers the costs to the parties was kept low. In the procedural hearings therefore, each party has succeeded and failed to an approximately equal degree if I exclude the costs already paid in the third hearing. Consequently, in assessing costs of the present substantive element of the proceedings, I do not intend to make any adjustment for those earlier hearings.
- 58 As to the present decision, Intel have succeeded on every point. Via argue in their response to Intel's submissions for this decision, that they have actively tried to reduce the costs of the action for both parties, for example by eliminating the technical grounds of opposition and by proposing a decision on the papers rather than by an oral hearing. I accept that, but I have already taken the first of these points into account in the preceding paragraph, whilst on the second if I calculate costs on the comptroller's usual scale, there will be an automatic reduction to reflect the fact that there was no hearing on the substantive issues.

- 59 Via also say they are entitled to costs whatever the outcome as it is Intel who are seeking indulgence in applying for amendment of the patent. I do not agree, because that would suggest anyone could raise a whole host of completely spurious objections to any application to amend, putting the patentee to a great deal of expense, with complete impunity. Intel have been put to considerable trouble by Via to deal with objections that I have found to be ill founded. In these circumstances, it would be unjust in my view for Intel not to get the usual contribution to their costs.
- 60 Accordingly, and in line with the comptroller's usual scale of costs, I order Via to pay Intel £1000. This should be paid within 7 days of the expiry of the appeal period, though the period for payment should be treated as stayed should an appeal be lodged.

Appeal

- 61 Under rule 52.4 of the Civil Procedure Rules, the appeal period is 14 days unless I direct a different period. I can see no reason to do so in the present case, and accordingly any appeal must be lodged within 14 days.

Dated this 2nd day of April 2003

PETER HAYWARD
Divisional Director acting for the Comptroller

THE PATENT OFFICE