

PATENTS ACT 1977

IN THE MATTER OF an application
by Intel Corporation to amend
European Patent (UK) No EP0804763
and opposition thereto by Via
Technologies Inc.

PROCEDURAL DECISION

- 1 These proceedings relate to an opposition by Via Technologies Inc (“Via”) to an application by Intel Corporation (“Intel”) to amend European Patent (UK) No EP0804763. The proceedings have had a troubled history in the sense that this is the third time I have had to make a procedural decision, though to be fair to the parties, some of the difficulties have arisen because each side is desperate not to put a foot wrong for fear of prejudicing their position in the event of further litigation at a later date.
- 2 The issue now at stake is whether or not I should admit certain evidence filed by Intel. In a nutshell, Via say it is irrelevant, but that if I admit it, that will force them to file masses of evidence to counter it so as not to jeopardise their position, and will also necessitate cross examination. Intel say that if I do not admit it, I will be prejudicing their ability to discharge the burden that rests on them.
- 3 I must first explain the background. In my first procedural decision, on 6 September 2001, I made an order that: “Via Technologies be excluded from bringing the issues of paragraphs 2, 3 and 5 of their statement of opposition in these proceedings.” Those paragraphs relate to validity issues and that order therefore has the effect of excluding validity issues from consideration in these proceedings. That leaves what the parties have loosely referred to as discretionary issues, ie whether Intel’s conduct has been such that it would be proper for me to exercise my discretion to allow the amendments. Intel have now filed their evidence in chief, and that includes a witness statement of Charles J Neuhauser, which Via say includes matters relevant to validity.
- 4 Intel say that this particular evidence is intended to assess the relevance of the prior art which has been cited against the patent in earlier validity proceedings (which have now terminated without any finding as to validity) and that the relevance of the prior art is pertinent to the discretionary grounds which remain. Their view is that the evidence also serves to fulfil Intel’s obligation to make a full and frank disclosure of the circumstances leading to the application to amend. They also say that the Neuhauser witness statement draws on evidence filed in the earlier proceedings and, since Intel has been first to file evidence and is not yet fully apprised of the issues it may have to address, it should not have to particularise matters more closely until any evidence from the opponent is filed. It also says the witness statement is in part a safety precaution because they don’t quite understand two of the points pleaded (in paragraphs 7 and 13 of Via’s statement of case) and so want to make sure they have covered everything.

- 5 Via accept that some technical information is appropriate to assess the relevance of the prior art, but say that Dr Neuhauser's statement goes beyond that requirement and provides his opinion as to the validity of the claims *as proposed to be amended*. Via say this evidence should either be excluded entirely or limited by omitting certain paragraphs, or alternatively that I should confirm that "the Opponent is not required to serve any evidence to reply to the opinions of Dr Neuhauser or to undertake any cross examination on the issue of the validity of the amended patent."
- 6 The parties have agreed that I should decide the matter without an oral hearing on the basis of the submissions they have made in writing, conveniently summarised in their respective letters of 28 June 2002.
- 7 Having looked through Dr Neuhauser's witness statement, it seems to me that it can be divided into three parts. Paragraphs 1 to 7 and paragraph 38 save for subparagraphs ii) and iv) are background to these proceedings and to Dr Neuhauser himself. Some of it, eg parts of paragraphs 5 and 6, are remote hearsay of dubious probative value, but I doubt whether that would matter simply because I doubt whether any of this background is disputed. Paragraphs 8 to 21 are essentially a technical primer for the technology involved. I do not yet know whether I will need to get immersed in the details of the technology in order to decide these opposition proceedings. If I do, this primer could be useful; if I don't, it would simply sit on file unused. Finally, paragraphs 22 to 37 and the rest of paragraph 38 assess the validity of the claims as proposed to be amended against certain prior art. It is mainly this third part which troubles Via.
- 8 I have carefully considered Intel's arguments in the light of what the third part of Dr Neuhauser's evidence actually contains and in the light of the discretionary issues that are pleaded in Via's statement of case, and have come to the conclusion that their arguments are unsound. The third part of Dr Neuhauser's evidence goes solely to the question of whether the patent *as amended* would be valid. If Via were still pleading that discretion to make the amendments should be refused because the patent as amended would still be invalid, the third part would indeed be relevant. However, Via are not because this is one of the pleadings I struck out in my first decision.
- 9 I accept that the relationship between the prior art and the *unamended* claims could be relevant to some of the discretionary issues, and in particular to the question of whether Intel had delayed unreasonably in seeking leave to make the amendments, but I cannot see how the third part of Dr Neuhauser's evidence can possibly help with this because he does not address the unamended claims. Besides, even for this it I would not be prepared to allow the proceedings to be drawn into what amounted to a detailed consideration of validity. To do so would undermine the whole point of my first order and is not necessary for Intel to discharge the onus that rests on them. They can discharge the onus in a number of ways without embarking on a detailed examination of whether or not the unamended claims are valid, for example by showing that having become aware of the citations, they took proper advice and were advised no amendment was necessary.
- 10 The other arguments advanced by Intel do not seem to me to carry much weight. Intel are concerned about what surprises Via might throw at them, but as Via are

constrained by what they have pleaded, I cannot see what Intel need to be worried about. Besides, if Via did throw in some surprises in evidence (and assuming I allowed them), Intel would be allowed to deal with them in reply. As for their specific concerns about paragraphs 7 and 13 of the statement of case, I cannot see any likelihood of the third part of Dr Neuhauser's statement helping them deal with these paragraphs. They are also concerned about making a full and frank disclosure, but that obligation cannot be divorced from the issues in dispute, and the validity of the *amended* patent is, as I have said, not in dispute.

- 11 I am doubtful about the value of the first and second parts of Dr Neuhauser's evidence, but Via do not seem to be taking any great exception to them and since there is a possibility they might be useful, I will allow them to remain. Accordingly, I hereby order that paragraphs 22 to 37 and subparagraphs ii) and iv) of paragraph 38 of Dr Neuhauser's witness statement dated 27 March 2002 be treated as struck out. I have said "treated as struck out" because I do not feel it is necessary for Intel to file a fresh version of the witness statement with these paragraphs omitted - for the purpose of these proceedings, these paragraphs can simply be ignored.
- 12 Via indicated in their letter of 8 May 2002 that they did not anticipate filing any evidence but reserved the right to do so if Dr Neuhauser's statement was not withdrawn. Accordingly I order Via to confirm within 14 days of the date whether they wish to file evidence. If they do not, the dispute will proceed straight to the substantive hearing. If they do, they should file any evidence within four weeks of the date of this decision - I have set a four week period in view of the time they have already had to think about their evidence.
- 13 So far as this procedural decision is concerned, Via have won and are entitled to a contribution to their costs. I see no reason for departing from the comptroller's standard scale and accordingly, bearing in mind that no oral hearing was necessary, I order Intel Corporation to pay Via Technologies Inc £400 towards their costs in dealing with the question of the admissibility of Dr Neuhauser's evidence. This sum should be paid within 7 days of the expiry of the appeal period mentioned below, though the period for payment will be suspended if an appeal is lodged.
- 14 As this is a matter of procedure, any appeal should be filed within 14 days of the date of this decision.

Dated this 4th day of July 2002

P HAYWARD

Divisional Director, acting for the comptroller

THE PATENT OFFICE