

- 6 The patent agent acting for the applicants, David Williams of Page White & Farrer (“PWF”), responded by telephone, requesting a date for a hearing. The date of 9 August 2004 was set. Mr Williams subsequently contacted the office by e-mail explaining that he did not wish to attend the hearing but requested a decision on the basis of the papers on file.

Detailed history

- 7 The application was filed in the name of Lucent Technologies Inc (“Lucent”), and according to the Register Lucent are still the applicants. However, Mr Williams has kindly provided a “Summary of Facts”, which while unsworn I shall take to represent the facts in an accurate manner. From this summary, it is clear that the proprietorship of the application has progressed in a complex fashion.
- 8 Ownership of the application was transferred, at an unknown date but evidently prior to 1 April 2002, to Agere Systems Inc (“Agere”) as a result of a “spin-off” of Agere from Lucent. Agere were represented in the United States by the law firm of Hitt Gaines.
- 9 On 1 April 2002, Hitt Gaines sent a fax to PWF instructing them not to respond to the examination report, and, (lest possibly that the date carried some significance?) PWF confirmed the instructions to Agere in a letter dated 11 April 2002.
- 10 The ownership of the application was transferred in a portfolio of an unspecified number, said to be large, to another company, which appears from the summary to be either TriQuint Technology Holding Co or TriQuint Semiconductor Inc (“TriQuint”) by an assignment dated 2 January 2003. TriQuint’s patent matters were handled by a law firm, Ater Wynne LLP, and specifically by Sean Fitzgerald.
- 11 The files for all the applications in the portfolio were passed to Mr Fitzgerald, including a so-called master file, believed to be a spreadsheet, which identified a family, known as “Akulova 1” of which the application was a part. This master file listed the application as “inactive/abandoned” in the UK, and also in Taiwan, while the equivalents in the US, Korea and Japan were listed as “pending”.
- 12 Prior to the assignment, in December 2002, Mr Fitzgerald is reported to have held a telephone conversation with a senior patent counsel for Agere, Scott McLellan, during which Mr McLellan is said to have said that “Akulova 1” was “an important case”, which may suggest that the whole family was important. The file for the “Akulova 1” family transferred from Agere to Mr Fitzgerald are said to have been marked “pursue vigorously”. I have however no direct evidence of this.
- 13 On 7 March 2003, PWF were advised by Hitt Gaines that all further instructions relating to the application would come from Mr Fitzgerald. They contacted Mr Fitzgerald by letter on 13 March 2003, advising him that the application was abandoned according to their records, and that an outstanding examination report existed the response to which had been due on 7 May 2002. A basis was allegedly given on which TriQuint could attempt to continue with the application. Mr Fitzgerald appears to have taken no action in response to this letter, presumably since his records indicated that the application was “inactive/abandoned”.

- 14 On 23 April 2003. PWF wrote again to Mr Fitzgerald advising that no further action would be taken in relation to the application in the absence of positive instructions.
- 15 On 1 December 2003, Joseph Pugh joined TriQuint as an in-house attorney, and received the files for the portfolio.
- 16 PWF received the letter from the Office warning of the approaching expiry of the period for setting the application in order for grant on 17 May 2004, and faxed the letter on 2 June 2004 to Mr Fitzgerald, who faxed it immediately to Mr Pugh. On 6 July 2004, Mr Pugh gave instructions to PWF to take action to secure the maintenance of the application.

The law

- 17 Section 18(3) of the Patents Act 1977 requires a response to an examination report within a specified period. It reads:

“If the examiner reports that any of those requirements are not complied with, the comptroller shall give the applicant an opportunity within a specified period to make observations on the report and to amend the application so as to comply with those requirements (subject, however, to section 76 below), and if the applicant fails to satisfy the comptroller that those requirements are complied with, or to amend the application so as to comply with them, the comptroller may refuse the application.”

- 18 This specified period may be extended at the discretion of the comptroller, but it is a well-established matter of practice that in order for the comptroller to exercise such discretion in favour of the applicant he must be satisfied that there has been a continuing underlying intention on the part of those responsible for its prosecution to proceed with the application. This maxim is clearly set out in *Heatex Group's Application [1995] RPC 546*.

Conclusion

- 19 On the evidence before me, I can see no indication of a continuing underlying intention to proceed. Indeed, the evidence appears to point the other way, that those responsible for prosecution of the application in April 2002 made the positive decision not to proceed with the application and communicated that decision to the UK patent agents by instructing them not to respond to the examination report. I am aware that I have not been shown a copy of the letter so instructing the agents, and have no sworn evidence, but there has been no suggestion that the summary of facts is at all inaccurate.
- 20 There is an apparent paradox between the instructions not to proceed and the reported opinion of the applicants that the “Akulova 1” family related to an important invention. However there is nothing in the actions of the applicant that confirms this opinion. Even when given reminders of the status of the application, no action was taken, and when finally expiry of the application loomed and those responsible were so informed in June 2004 it still took a month for any action to be taken.
- 21 I therefore decline to grant the extension requested to the period for reply to the examination report dated 5 November 2001, and under section 18(3) of the Patents Act 1977 refuse the

application.

Appeal

- 22 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

M G WILSON

Deputy Director acting for the Comptroller