



Claire Phipps-Jones

The secret's out – or is it?

Claire Phipps-Jones of Bristows LLP discusses the new Disclosure Pilot Scheme and how it will affect the disclosure obligations of practitioners and clients seeking to litigate patent claims in the UK Courts in the coming years.

On 1 January this year, a new set of rules governing disclosure in civil litigation cases (including patent cases) was introduced in the UK High Court. The new rules will apply for at least two years and possibly permanently. So, what does this mean for you? Well, if your case is a “normal” patent case, i.e. not including competition claims, being heard in the High Court rather than the Intellectual Property Enterprise Court (which is usually for simpler, lower value claims) and not part of the shorter or flexible trials scheme, you should be aware of the following key changes.

First, there are broader pre-action obligations regarding document preservation. The duty is similar to that which previously existed, namely that parties must take reasonable steps to preserve documents that may be relevant to any issue in the proceedings, including suspending document deletion or destruction processes. However, now there are explicit rules regarding written notifications. For example, it is necessary for parties to notify employees and former employees of their obligations, take reasonable steps vis-à-vis third parties that may have documents in their control, confirm in writing to their legal practitioner that they have done so, and confirm the same in writing when serving their statements of case.

There are some new obligations regarding Initial Disclosure. Previously, when filing their statement of case, parties only had to provide documents expressly referenced therein. Now, unless the parties agree to dispense with Initial Disclosure or fall within some narrow exceptions, they must also provide key documents relied on in support

of their claims/defenses and documents necessary for the counter-parties to understand the claims made against them. This does not include a duty to search but must include documents and details of any searches that have already been conducted. This appears to be a broad obligation, but whether it is actually treated that way in practice remains to be seen. It does, however, mean that parties considering UK litigation may wish to seek advice prior to conducting any document searches. It is also incumbent on litigants to provide known adverse documents at an early stage: the rules say that this must happen “once proceedings have commenced”, regardless of any order for disclosure made, unless the documents concerned are privileged.

It was previously the case that any necessary disclosure was usually ordered at the case management conference. This included standard disclosure (where a party was obliged to search for and disclose all documents which adversely affected his or another party's case, or those which supported another party's case), an order for no disclosure, or something more specific. In recent years, the Patents Court had been moving away from ordering disclosure on the issue of validity, noting that it was often disproportionate and rarely probative, particularly for issues such as obviousness or insufficiency (unless, for example, a party was relying on the inventors' difficulty in achieving his objectives).

Now, parties have to consider whether they wish to request Extended Disclosure shortly after the final statement of case is filed. There are 5 models to choose from, which

Résumé

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Claire specialises in contentious IP at Bristows and works in a variety of sectors including pharmaceuticals, medical devices, chemicals and consumer electronics. In addition to patent and trademark infringement and revocation actions, she has assisted with applications for interim and summary relief, pre-action and third-party disclosure and permission to appeal in a number of courts including the High Court, Court of Appeal, Supreme Court and Intellectual Property Enterprise Court.

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vary widely. Two require no searches to be conducted but do require that (i) known adverse documents (for which the parties have an express obligation to disclose in any event), or (ii) documents relied on and necessary to understand the case be disclosed. The remaining three require searches and disclosure of increasing magnitude. The rules note that the most onerous obligations are only to be ordered in exceptional cases. It seems likely that, whilst the process has changed somewhat, the new rules will be interpreted by the Patents Court in line with the general trend towards more limited disclosure on validity.

The new rules do not affect the Court’s approach to disclosure on infringement, namely that a product and process description may be provided in lieu of disclosure.

The intention of the new rules seems to be to maintain the UK’s widely favored system of disclosure (as compared to the more limited

disclosure available in most other European jurisdictions), providing parties with a mechanism to obtain documents that are, in all likelihood, relevant and necessary to fairly determine proceedings. The new rules also appear to encourage a “cards-on-the-table” approach to litigation with disclosure of known adverse documents and initial (supportive) disclosure at a very early stage. Whether such early disclosure is appropriate or effective in patents cases remains to be seen. It is common for the issues to develop slowly in patent cases and expert input may be required in order to form a view as to whether any particular document is a help or a hindrance.

It is clear that one of the main thrusts of the new rules is to limit unnecessary and disproportionate costs, particularly in an increasingly digital world where searching vast quantities of documents is possible, so as to avoid the expense of a US-type system. That fits with the direction of travel in patents cases, at least from the case law in recent years, to more limited and issue-specific disclosure. But whereas some practitioners had interpreted that case law to mean that in certain types of patent cases the most appropriate order was for no disclosure whatsoever, it remains to be seen whether the Patents Court really does require some measure of early disclosure of adverse and supportive documents in all cases.

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