Disclosure relating to experiments

Kluwer Patent Blog
December 4, 2017

Brian Cordery, Rachel Mumby (Bristows)

Please refer to this post as: Brian Cordery, Rachel Mumby, 'Disclosure relating to experiments', Kluwer Patent Blog, December 4 2017, http://patentblog.kluweriplaw.com/2017/12/04/disclosure-relating-experiments/

Whilst many in show business have long lived by the adage "*never work with children or animals*" for fear of what might ensue, patent litigators in the UK have long been known to take a similar approach to experiments, avoiding them if at all possible for fear of the results. Indeed, Laddie J noted once that "*experiments frequently prove to be a waste of time and effort*." However, sometimes needs must and experiments become a key part of a case. In the recent judgment of Daniel Alexander QC sitting as a Deputy High Court Judge in **Magnesium Elektron Limited v Neo Chemicals & Oxides and Ors** [2017] EWHC 2957 (Pat) (see here), guidance has been provided on the thorny issue of the scope of disclosure which may then be ordered relating to such experiments.

There are many different types of experiments which can be carried out in patent cases, many of which are often bespoke and designed for the particular case. In designing experiments, experimental protocols are put together which usually require some sort of validation, often resulting in testing a series of samples and then modifying the protocols to improve their ability to deliver reliable results. Sometimes "dry runs" are carried out to check the equipment is working, sometimes multiple runs with the same or different samples or controls are carried out, sometimes "dry runs" are actually "real runs", the incorporation of which can affect the statistical significance of the final results. In many cases experiments are carried out as a step in the trial timetable, pursuant to an order for a Notice of Experiments. In other cases experiments are conducted, for example, such as in the present case, as a pre-action step to prove there is a prima facie case for infringement in order to obtain permission to serve a defendant out of the jurisdiction. However, once the finalised results have been collated, a party seeking to rely on experiments will usually serve these results together with the

protocol for the experiments and set out the facts which that party is trying to establish using the experiments. They will not usually unilaterally provide the associated back story to these experiments i.e. the "work-up".

In **Mayne Pharma v Debiopharm** [2006] EWHC 164 (Pat), which was a case where the purpose of the experiments was to show anticipation by inevitable result, the late Pumfrey J held that the "work-up" for those experiments should also be disclosed. This was on the basis that legal professional privilege attaching to documents relating to work-up experiments had been waived by service of the Notice of Experiments.

Following **Mayne Pharma** it was not totally clear whether experimental work-up was disclosable in all types of cases, or only in inevitable result cases. This question was answered in in April 2017, in an unreported judgment from a case management conference (**Magnesium Elektron Limited v Molycorp Chemicals & Oxides and Ors** [2017] EWHC 1024 (Pat)), when Birss J held that the principle "*is concerned with the question of work-up of experiments in general... irrespective of the legal conclusion on which they are being deployed to prove.*"

The present judgment is a follow-on from that judgment (the Defendants had in the interim changed their name). It relates to an application made by the Defendants once the **Mayne Pharma** disclosure had purportedly been provided. Whilst the circumstances are complex and beyond the scope of this summary, in essence permission to serve out had been given by Birss J in 2015 based on preliminary results of the experiments, then once the experiments had been finished, the Claimants agreed to provide the finalised protocols and results for the Experiments, details of the instructions to the experts and expert reports on the experiments, but the Defendants sought Mayne Pharma disclosure as well. This was provided following Birss J's April 2017 judgment (see above). However, despite a "formidable" amount of information having been disclosed, the defendants contended that Mayne Pharma disclosure covered more. The Judge in the present case therefore considered the precise scope of **Mayne Pharma** disclosure.

After a detailed review of the law of privilege and waiver of privilege, analysis of the process of carrying out experiments for litigation and the variety of types of such experiments, and consideration of the rules surrounding disclosure, the Judge held that no further disclosure was required. In particular, he refused to order that

legal advice relating to the experiments and drafts of expert reports on the experiments be disclosed (the raw data as well as iterations of protocols and witness statements about the design of the same had already been provided).

In his analysis the Judge differentiated between cases in which the **Mayne Pharma** approach of disclosing materials which show the preliminary investigation leading to the experiments forming the subject matter of the Notice of Experiments can be clearly and easily applied, and other cases. He placed "inevitable result" and "completeness of data" cases in the first category. This was on the basis that in these cases it is important to be able to show that, for example, it is inevitable that experiments would be selected and undertaken in the manner alleged, that the experiments are repeatable (and therefore in relevant cases inevitably have the results alleged) and/or do not exhibit significant variation in results.

He held that in relation to "other" cases (which included the case in hand), the Court should adopt a relatively cautious and restrictive approach to waiver of privilege in material relating to experiments and to whether disclosure should be ordered (standard or otherwise). This was because it might be less clear that earlier or related material can be properly described as "workup" or "directly" related to the particular experiment, or that there would be any cherry picking in not disclosing it. Interestingly, the Judge appeared to place emphasis on the fact that a party seeking disclosure can make requests for further information pursuant to Part 18 of the Civil Procedure Rules (CPR), or put written questions to the experts pursuant to Part 35.6 of the CPR as "*additional ways in which a case supported by experts may be interrogated and challenged prior to trial*" and that this may be a more appropriate and proportionate way of seeking information in these "other" cases.

The judgment also considered a second application, beyond the scope of this summary, relating to testing on confidential samples and whether, and on what terms, to admit further experts to a confidentiality club.

It is clear that the circumstances of the present case were unusual and multifaceted, but the combined effect of this judgment together with Birss J's judgment of April 2017 is that anyone carrying out experiments can now approach them with at least some greater certainty about what is likely to be disclosable, and not just in inevitable results cases. It has taken over ten years since **Mayne**

Pharma to get this additional clarification, presumably because in many cases the parties do not have the appetite to fight such an application in Court at a time when they are often busy preparing other aspects of the case. As noted in a postscript to the judgment, hopefully this will “assist in resolving future disputes on these issues”, although there will inevitably be further debate about exactly where to draw the line.