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Court refuses request for disclosure of evidence in foreign proceedings: Abbott Laboratories v Medinol

Brian Cordery (Bristows) · Tuesday, September 7th, 2010

Under the UK's standard duty of disclosure, each party is required to disclose the documents on which it relies, the documents which adversely affect its or another party's case and the documents which support another party's case. In patent disputes, disclosure relating to infringement of a product or process can be avoided by the provision of full particulars of the alleged infringing product or process. Disclosure relating to the validity of a patent is restricted to documents created within two years either side of the earliest claimed priority date. The English Patents Judges are aware that disclosure can add significantly to the cost of litigation and generally seek to contain its scope. Despite this, in 2007, the Court of Appeal overturned (by a majority) the Patents Court's decision that disclosure should not normally be required in relation to obviousness (*Nichia Corp v Argos Ltd* [2007] FSR 38]). The four-year 'window' for disclosure on obviousness therefore remains the standard.

The courts may also order specific disclosure on the application of a party. The court will consider the relevance of the requested documents and whether granting the request would enable the court to deal with the case justly (the 'overriding objective').

In *Abbott Laboratories v Medinol* [2010] EWHC 1731 (Pat) the court was recently asked by Abbott to make an order for specific disclosure of all fact evidence given by a Dr Richter and all expert evidence given by a Dr Snyder in a number of proceedings in the US relating to patents from the same family as the patent in dispute in the UK. Drs. Richter and Snyder were also giving evidence for Medinol in the UK proceedings. Abbott contended the disclosure sought was relevant to the UK action because a number of points of construction were in issue, including the meaning of "meander pattern" and "loops", which also appeared in the claims in the US proceedings. Medinol resisted the application and gave evidence on the extent of the disclosure exercise that would result should Abbott's request be granted: the expert reports, depositions and trial transcripts would likely run to 15-20 lever arch files and it would be necessary to consider them in the context of further documents such as the relevant pleadings, the opposing side's evidence and exhibits, written submissions and records of all arguments and submissions; to comply with such an order and then have legal teams for Abbott and Medinol reviewing them would be extremely costly.

Mr Justice Kitchin rejected Abbott's request. He noted that the particular terms relied upon were not "terms of art". The meaning of the terms would be a matter for the court. The proceedings before the US courts must have involved different stents and been decided according to different substantive and procedural laws. Abbott was looking to identify inconsistency between the

evidence in the US actions and the evidence given in the UK proceedings but no such inconsistency had come to light as yet. Kitchin J. was “extremely doubtful” that the evidence was admissible in the UK in any event. Further, the question of ‘commercial success’ in the UK was not going to be answered by considering evidence given in other proceedings. The documents requested therefore did not satisfy the requirement of relevance. Kitchin J. noted as confirmation of this view that Dr Snyder had also given evidence in proceedings in the Netherlands and Germany, but it had never been suggested that this was inconsistent with his evidence in the UK. Kitchin J. also concluded that the disclosure sought would be wholly disproportionate to any conceivable benefit that the documents might bring to the proceedings. Abbott’s application was therefore refused.

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