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Disclosure in English Patent Cases – Time for Reform?

Brian Cordery (Bristows) · Monday, July 9th, 2012

In 2007 in Nichia v Argos* the UK's most senior full-time patents judge at the time, Jacob LJ, held that disclosure should no longer be available as a matter of course on standard issues such as obviousness in patent cases. This came as a breath of fresh air to many IP practitioners in the UK who had long seen the disclosure exercise in patent cases as serving only to increase cost with little or no resulting benefit in terms of shedding light on the substantive issues at trial. Unfortunately, Jacob LJ found himself in the dissenting minority as the two other judges on the panel held that standard disclosure should still apply in patent cases but that the parties should have regard to the pervasive principle of proportionality.

Disclosure has become more complex with the advent of the digital age. Whereas 15 years ago, disclosure might have involved retrieving laboratory notebooks and minutes of committees, today vast amounts of email and other electronic documents must be obtained and scoured for potentially disclosable material. The Civil Procedure Rules which prescribe the procedure for civil litigation (including patents and other IP) in England and Wales, contain a specific Practice Direction relating to Electronic Disclosure which confirms that email is included within the scope of disclosure including email stored on servers and back-up systems and whether deleted or not. Parties are obliged to co-operate about the key words to be used for the electronic search and in a reasonably recent judgment, a party was openly criticised for not co-operating and ordered to undertake a further search**. Of course when negotiating with an opponent about key word searches, it is almost inevitable that a wider search will be requested and then the disclosing party is left with the dilemma of whether to ask the Court to rule on the issue, thus increasing still further the costs of the exercise, or just get on with the search.

There is no doubt that electronic disclosure has increased the cost of disclosure in patent cases. This is because the results of the key word searches will inevitably throw up large numbers of completely irrelevant documents which have to be reviewed and discarded. The author recently conducted a disclosure exercise in a relatively straight-forward patent case which generated tens of thousands electronic documents including recipes, weekend dog walking plans and lots of jokes. Several hundred thousand pages had to be reviewed. Eventually, less than 1% of the documents thrown up by the electronic search documents were disclosed to the other side.

One of the highlights of the IP conference circuit is the Fordham Conference which is held every year in New York in the week after Easter. This year, as with every year, the conference was attended by most of the English IP judges and the views openly expressed at the conference were that disclosure was generally not particularly probative in patents cases which usually turn not on

what the inventors did but on what the skilled person would have done. But, until the rules are changed, the Judges have no option but to follow them.

The author considers that the time has come for the Patents Court to adopt the procedure of the Patents County Court and replace automatic disclosure with a procedure whereby disclosure of specific categories of document can be ordered by the Court provided that the Court is satisfied that the exercise would be proportionate in all the circumstances. There is no doubt that the Court is well placed to deal with specific disclosure requests as was aptly demonstrated in the recent judgment of Arnold J in Danisco v Novozymes***.

* [2007] FSR 38
** Digicel v Cable & Wireless [2008] EWHC 2522
*** Judgment of 14 June [2012] EWHC 1641

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