

**THE HIGH COURT
COMMERCIAL**

**[2006 No. 1930 P]
[2006 No. 57 BOM]**

BETWEEN

SCHNEIDER (EUROPE) GMBH

PLAINTIFF

**AND
CONOR MEDSYSTEMS IRELAND LIMITED**

DEFENDANT

Judgment of Ms. Justice Finlay Geoghegan delivered on the 2nd day of February 2007.

1. The plaintiff is the proprietor of a European and Irish patent no. 0650740 ("The 740 patent"). The subject of the patent is an interventional catheter.

2. The defendant manufactures, markets and sells in Ireland a product known as the "CoStar product" which includes and comprises an interventional catheter. The plaintiff alleges that the defendant in so doing infringes the 740 patent. The defendant denies infringement and has counterclaimed for invalidity of the 740 patent on the basis of obviousness and lack of novelty.

3. Particulars have been sought and delivered; interrogatories raised, answered and the defendant has made certain admissions. Certain of these are relevant to the applications the subject of this judgment.

4. The plaintiff and defendant have each brought motions for discovery. The plaintiff also has brought a motion for further interrogatories. This was not pursued by reason of admissions made by the defendant on the morning of the hearing of these applications. Further by reason of those admissions the defendant's motion for discovery was heard first and it is proposed to deal with the motions in the same order in this judgment.

Defendant's Motion for Discovery

5. At the hearing, the defendant pursued its application for discovery of three categories of documents. The first category as stated in the notice of motion was revised and limited. The categories as pursued at the hearing are:

"Category (1)

Such documents relating to patent applications filed with the US Patents and Trademarks Office in respect of the product which is the subject-matter of EP 0650740 as disclose the state of the art (including but not limited to the two prior art documents pleaded) prior to the priority date of the European Patent.

Category (2)

All documents howsoever described concerning the conception, development and reduction to practice of the subject matter disclosed or claimed in the 740 Patent including (but not limited to) all laboratory notebooks of the named inventor, Gerhard Kastenhofer, and his laboratory technicians, correspondence, files, memoranda, notes, calendars, models, research and prototypes of the named inventor and any co-worker who assisted him with regard to the subject matter of the 740 Patent in respect of each feature of the Patent.

Category (3)

All documents which disclose or evidence the consideration (if any) given by the inventor of the 740 Patent, European Patent No. 0650740 and any other equivalent patent and by or on behalf of the Plaintiff to the prior art referred to or related to that listed in the Particulars of Objections delivered on behalf of the Defendant on 24 July 2006 or to any other documents considered but deemed by the inventor and/or by or on behalf of the Plaintiff not to be prior art including any documents disclosing or evidencing any consideration or evaluation by or on behalf of the Plaintiff as to the potential effect of any such alleged prior art on the patentability of the subject matter disclosed in the 740 Patent, in European Patent No. 0650740 or any other equivalent patent."

General Principles

6. The parties are in agreement that the general principles according to which these applications for discovery should be determined are those set out by Kelly J. in *P.J. Carroll and Co. v. The Minister for Health and Children* (Unreported, High Court, 9th December, 2005). In the judgment of Geoghegan J. in the same case (Unreported, Supreme Court, 1st June, 2006) it is recorded at p. 6 that the parties in that case conceded that the learned High Court judge in his judgment had set out the correct principles to be applied.

7. Those principles are set out by Kelly J. at pp. 34 – 40 of his judgment in the following terms:

"Applicable Legal Principles

Order 31, r. 12 of the Rules of the Superior Courts as amended requires an applicant for discovery to demonstrate that the documents sought are both relevant and necessary for the fair disposal of the case or to save costs.

The *locus classicus* on relevance is to be found in the judgment of Brett L.J. in the *Peruvian Guano* Case [1882] 11 Q.B.D. 55. That judge described as relevant-

"Every document relating to the matters in question in the action, which not only would be evidence upon any issue, but also which, it is reasonable to suppose contains information which may – not which must – either directly or indirectly enable the party requiring the affidavit either to advance his own case or to damage the case of his adversary."

That statement was considered by Murray J. (as he then was) in *Aqua Technolgie v. NSAI* (Supreme Court, 10th July, 2000) where he said:-

"... There is nothing in that statement which is intended to qualify the principle, that the document sought on discovery must be relevant, directly or indirectly to the matters in issue between the parties in the proceedings. Furthermore, an applicant for discovery must show it is reasonable for the court to suppose that the documents contain information which may enable the applicant to advance his own case or to damage the case of his adversary. An applicant is not entitled to discovery based on mere speculation or on the basis of what has been traditionally characterised as a fishing expedition."

In *Framus v. CRH Plc* [2004] 2 I.L.R.M. 439, the Supreme Court approved of the approach of McCracken J. in this court in *Hannon v. Commissioner of Public Works* (Unreported, 4th April, 2001) where he set forth the appropriate approach to relevance as follows:-

"(i) The court must decide as a matter of probability as to whether any particular document is relevant to the issues to be tried. It is not for the court to order discovery simply because there is a possibility that documents may be relevant.

(ii) Relevance must be determined in relation to the pleadings in the specific case. Relevance is not to be determined by reasons of submissions as to alleged facts put forward in affidavits in relation to the application for further and better discovery unless such submissions relate back to the pleadings or to already discovered documents. It should be noted that Order 31, r. 12 of the Superior Court Rules specifically relates to discovery of documents 'relating to any matter in question therein'.

(iii) It follows from the first two principles that a party may not seek discovery of a document in order to find out whether the document may be relevant. A general trawl through the other parties' documentation is not permitted under the rules.

(iv) The court is entitled to take into account the extent to which discovery of documents might become oppressive, and should be astute to ensure that the procedure of discovery is not used as a tactic in the war between the parties."

There is much recent authority on the second part of the test which an applicant for discovery must satisfy. Such an applicant must show that the discovery sought is necessary for disposing fairly of the cause or matter or for saving costs. The burden of proving that the discovery falls within this rubric rests with the applicant for discovery. This is not "a mere formalistic requirement" (see *Ryanair Plc. v. Aer Rianta Cpt* [2003] 4 I.R. 264.)

In that case Fennelly J. dealt with the issue as to what is meant by this concept of necessity by reference to my decision in *Cooper Flynn v. Radio Telefis Eireann* [2000] 3 I.R. 344 where I had adopted the following statement of Lord Bingham M.R. in *Taylor v. Anderton* where he said:-

"The crucial consideration is, in my judgment, the meaning of the expression 'disposing fairly of the cause or matter.' Those words direct attention to the question of whether inspection is necessary for the fair determination of the matter, whether by trial or otherwise. The purpose of the rule is to ensure that one party does not enjoy an unfair advantage or suffer an unfair disadvantage in the litigation as a result of a document not being produced for inspection. It is, I think, of no importance that a party is curious about the contents of a document or would like to know the contents of it if he suffers no disadvantage by not seeing it and would gain no litigious advantage by seeing it. That, in my judgment, is the test."

Fennelly J. having referred to that passage went on to say:-

"It may not be wise to substitute a new term of art 'litigious advantage', for the words of the rule. Nonetheless, the discussion gives guidance as to the context in which the matter has to be considered. Within that context, the court has to reach a conclusion as to the likely effect of the grant or refusal of the discovery on the fair disposal of the litigation.

The change made to Order 31, r. 12, in 1999, exemplifies, however, growing concern about the dangers of unnecessarily costly and protracted litigation and, in particular, the burdens on parties and the courts arising from excessive resort to automatic blanket discovery. The public interest in the proper administration of justice is not confined to the relentless search for perfect truth. The just and proper conduct of litigation also encompasses the objectives of expedition and economy.

The court, in exercising the broad discretion conferred upon it by Order 31, r. 12(2) and (3), must have regard to the issues in the action as they appear from the pleadings and the reasons furnished by the applicant to show that the specified categories of documents are required. It should also consider the necessity for discovery having regard to all the relevant circumstances, including the burden, scale and cost of the discovery sought. The court should be willing to confine categories of documents sought to what is genuinely necessary for the fairness of the litigation. It may have regard, of course, to alternative means of proof, which are open to the applicant. These may, no doubt, include the possible service of notices to admit facts or documents. But there are two sides to litigation. The behaviour of the opposing party is relevant. That party may, for example, have made or may offer to make admissions of facts, and thus persuade a court that discovery on some issues is not necessary. This is, perhaps, axiomatic. Those facts will no longer be an issue."

This approach has been maintained by the Supreme Court in *Taylor v. Clonmel Healthcare Limited* [2004] 1 I.R. 169, where Geoghegan J. stated:-

"The purpose of the amendment (to Order 31, r.12) was so that the Master or the court as the case may be and the respective parties would focus on what documents were really needed for the purpose of advancing the case of the moving party or defending as the case might be."

Again in *Framus v. CRH Plc.* Murray C.J. said:-

"It seems to me that in certain circumstances a too wide ranging order for discovery may be an obstacle to the fair disposal of proceedings rather than the converse. As Fennelly J. pointed out the critical question is whether discovery is necessary for 'disposing fairly of the cause or matter'. I think it follows that there must be some proportionality between the extent or volume of the documents to be discovered and the degree to which the documents are likely to advance the case of the applicant or damage the case of his or her opponent in addition to ensuring that no party is taken by surprise by the production of documents at a trial. That is not to gainsay in any sense that the primary test is whether documents are relevant to the issues between the parties. Once that is established it will follow in most cases that their discovery is necessary for the fair disposal of those issues."

It is these principles which I intend to apply on this application for discovery.

In accordance with the judgment of McCracken J. in *Hannon v. Commissioner of Public Works* I must turn to the pleadings to see whether the documents sought are relevant to the issues to be tried."

8. The documents sought by the defendant herein are alleged to be relevant to its counterclaim for revocation of the 740 patent. The particulars of objections to the validity of the 740 patent allege want of novelty and inventive step having regard to the state of the art as of the priority date. Such state of the art is alleged to have comprised the following matters available to the public:-

"(a) United States Patent No. 4,960,410 (Pinchuk 1) published on 2nd October 1990.

(b) EP 0 476 855 A1 (Pinchuk 2) published on 25th March 1992.

(c) Common general knowledge, to extent that it may not be set out in any of the above."

Category (1)

9. In the letter seeking voluntary discovery of the 19th September, 2006 and in the motion issued herein the defendant sought a much broader category of documents in category (1). The broader category included document passing between the plaintiff and the Irish and European Patent Offices in respect of applications for the 740 patent and the European patent no. 0650740. The plaintiff agreed to discovery of documents within that category "without prejudice to the strict relevance or necessity of such documentation" and also without prejudice to a request for clarification on the documents sought within category (1).

10. The category as originally drafted also sought documents relating to applications with other foreign patent offices (in addition to US) and in relation to "any other equivalent patent". At the commencement of the hearing of this application counsel for the defendant indicated that he accepted that the category then sought was too wide and indicated that the application was being confined to certain documents passing with the US Patents and Trademarks Office ("USPTO") in relation to patent applications filed in respect of a product with identical description and claims to that the subject matter of EP0650740 as disclosed the state of the art prior to the priority date of the European patent as in the revised wording set out above.

11. These documents are sought on the basis that they are likely to disclose analysis of the extent to which the product the subject matter of the 740 patent was novel or comprised an inventive step having regard to the prior art and therefore relevant.

12. The justification for seeking documents relating to an application to the USPTO, having regard to the agreement to furnish the documentation relating to applications to the Irish and European Patent Offices is by reason of the differences in approach of those offices as set out in the affidavit of Anne Ryan a European Patent Attorney sworn on the 14th November, 2006. In that affidavit at paragraph 5 and 6 she states:

"5. There is no obligation on the part of an applicant for a European patent to bring to the attention of the European Patent Office prior art of which the applicant is or becomes independently aware. An application may be examined solely by reference to prior art cited by the EPO itself. The EPO may therefore be unaware of information showing that the invention was actually in use or otherwise in the public domain prior to the priority date of the invention, or of prior art for which it did not search.

6. The situation prevailing when applying for a patent in the US Patent and Trademark Office is very different. There the applicant is obliged to disclose all material information, including prior art and prior public use, of which the applicant (including inventors, patent attorneys, agents, their representatives and/or anyone involved in the prosecution and obtaining of the patent application on behalf of the applicant) is aware which affects the patentability of the claims to the authority. Thus the applicant will be obliged to disclose prior art, even if it was not searched by the EPO or was not otherwise known to the EPO. It is also relevant to point out that in the US patent system the invention for which patent protection is sought may be used for a period of one year prior to application being made without destroying the novelty of the invention; while in the European system generally any use prior to filing destroys the novelty of the invention."

13. The defendant relies upon the decision of Whitford J. in *Vickers PLC v. Horsell Graphic Industries Limited* [1988] R.P.C. 421 That decision concerned the obligation of a plaintiff to disclose certain documents on file and open to public inspection in connection with what is referred to as a "comparable United States application". The English proceedings included a claim to the validity of the English patent. Whitford J. in considering the relevance of the documents on the US application file to the English proceedings stated at p. 423:

"My opinion as regards documents is this. I go no further than saying that quite plainly vast numbers of documents are filed in connection with foreign applications, and mostly they are going to be irrelevant. I entirely accept that opinions which may have been expressed or experiments which may have been conducted in connection with foreign applications are at the end of the day not necessarily likely to be conclusive and may indeed prove to be of only limited importance, but they do assist a defendant. They disclose the line which may be taken in connection with the defence to the attack

upon the validity which is going to be put forward. They disclose the approach to the issue of infringement.”

14. The plaintiff objects to an order being made even in the reduced form now sought. It objects primarily on the basis that this is in reality a “fishing exercise” by the defendant particularly having regard to its failure to identify a US patent with identical or almost identical description and claims. It also submits that the defendant has failed to establish that the order sought is necessary as even if such documents may be considered as relevant, such documents should be available to the defendant from the USPTO. This latter submission is not based upon evidence as to the public availability of documents filed with the USPTO. The plaintiff distinguishes the decision in *Vickers* as it related to an identified US patent application.

15. I have concluded that the Court should not make an order for discovery as sought in to this category. In accordance with the general principles set out above the onus is on the party seeking discovery to establish relevance and necessity. Where as in this application the defendant seeks documents furnished by an unspecified applicant to the USPTO in relation to a patent which is not the subject matter of the proceedings but which may be an identical or an almost identical patent such as to make the documents of application relevant, it appears to me that it must, in the absence of special circumstances, at minimum identify the relevant US patent.

16. The defendant submits that in its letter of request of the 19th September, 2006, as part of its reasons for the discovery of the documents in category (1) it stated: “Furthermore, there are equivalent or closely related United States Patents” and that there was no denial of the existence of such patents. Whilst it is true that the plaintiff did not expressly deny the existence of such patents it did seek clarification of the documents being sought in category (1). Where as in this instance both the plaintiff and the defendant are members of multinational groups of companies and it is not alleged that the plaintiff itself filed for an equivalent United States Patent, it appears to me that the onus must be on the defendant to identify the relevant patent in respect of which it seeks documentation before this Court should make an order for discovery of some or all the relevant documentation. In the absence of such identification it appears to me that the application is properly described as “a fishing exercise”. Further, an order for discovery in the terms sought without identification of the relevant patent or indeed the applicant for the patent may be considered oppressive as that term was used in particular by McCracken J. in *Hannon v. Commissioners of Public Works* and referred to in the extract from that judgment cited by Kelly J. and set out above.

17. In the event that the defendant identifies a US patent which is considered to be identical or almost identical and the applicant is a person whose documents may be considered to be within the power or procurement of the plaintiff in these proceedings then the defendant may be entitled to pursue a more precise application.

Categories 2 and 3

18. The primary documents as sought in categories 2 and 3 are what were referred to in argument as the “inventor’s notebooks”. This generic description covers the entire of what is sought in category (2). No distinction was made in submission between the documents of the inventor and those working with him. In category (3) some distinction was made between the documents disclosing assessment by the inventor and those disclosing assessments by other persons on behalf of the plaintiff. It is proposed firstly to deal with those documents within categories 2 and 3 which come within the description of inventor’s notebooks.

19. The defendant submits that such documents are both relevant and necessary for the fair disposal of this case. It relies in particular upon the decisions of the Court of Appeal of England and Wales in *SKM SA v. Wagner Spraytech (U.K.) Limited* [1982] RPC 497; the High Court of Australia in *Wellcome Foundation Limited v. BR Laboratories (Australia) Limited* [1982] RPC 343 and the Supreme Court of Canada in *Eli Lilly and Company v. Apotex Inc.* [2006] FCR 104. In each of those decisions orders for discovery of inventors’ notebooks were made.

20. The plaintiff disputes the relevance and necessity of the documents sought. It submits that this Court is not bound by the above decisions and that having regard to the decisions of the Supreme Court and High Court in *Ranbaxy Laboratories Limited v. Warner Lambert Company* [2006] 1 IR 193 (Supreme Court) and (Unreported, High Court, 8th June, 2005) and the decision of Laddie J. in the Patent Court in *Hoechst Celanese Corporation v. BP Chemicals Limited and Another* [1997] FSR 547 that this Court should now upon a consideration of the matter from first principles refuse the order sought primarily as not being relevant.

21. The plaintiff’s submissions in part are based upon the issues which will have to be determined by the court at the hearing of the defendant’s counterclaim and the probable primary evidence. These matters were not in dispute.

22. The test for novelty is purely objective. Section 11 of the Patents Act 1992 provides:

“(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise everything made available to the public (whether in the State or elsewhere) by means of a written or oral description, by use, or in any other way, before the date of filing of the patent application.

(3) Additionally, the content of a patent application as filed, of which the date of filing is prior to the date referred to in subsection (2) and which was published under this Act on or after the date, shall be considered as comprised in the state of the art...”

23. The proper approach to determining the issue of inventive step or obviousness is as set out by Oliver L.J. in *Windsurfing International Inc. v. Tabur Marine (Great Britain) Limited* [1985] RPC 59 and is as follows:

“The first [step] is to identify the inventive concept embodied in the patent in suit. Thereafter, the court has to assume the mantle of the normally skilled but unimaginative addressee in the art at the priority date and to impute to him what was, at the date, common general knowledge in the art in question. The third step is to identify what, if any, differences exist between the matter cited as being “known or used” and the alleged invention. Finally, the court has to ask itself whether, viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to the skilled man or whether they require any degree of invention.”

24. The Court was also referred to the decision of the Court of Appeal in *Mölnlycke AB v. Proctor & Gamble Limited* [1994] RPC 49. Having regard to the similarity of ss. 9, 11 and 13 of the Patents Act 1992 with the U.K. statutory code under consideration in that decision it appears relevant. The Vice-Chancellor delivering the judgment of the court at p. 112 stated:

“Under the statutory code (. . .) the criterion for deciding whether or not the claimed invention involves an inventive step

is wholly objective. It is an objective criterion defined in statutory terms, that is to say whether the step was obvious to a person skilled in the art having regard to any matter which forms part of the state of the art as defined in section 2(2).

...

The Act requires the court to make a finding of fact as to what was, at the priority date, included in the state of the art and then to find again as a fact whether, having regard to that state of the art, the alleged inventive step would be obvious to a person skilled in the art.

In applying the statutory criterion and making these findings the court will almost invariably require the assistance of expert evidence. The primary evidence will be that of properly qualified expert witnesses who will say whether or not in their opinions the relevant step would have been obvious to a skilled man having regard to the state of the art. All other evidence is secondary to that primary evidence.

...

In the nature of things, the expert witnesses and the court are considering the question of obviousness in the light of hindsight. It is this which may make the court's task difficult. What with hindsight, seems plain and obvious, often was not so seen at the time. It is for this reason that contemporary events can be of evidential assistance when testing the experts' primary evidence... A particular inventor may have been aware of some aspect of the state of the art as defined in section 2(2), and may therefore have genuinely taken what was actually an inventive step, but nevertheless be unable to claim a patentable invention since the step was, in the terms of the statute, obvious.

...

Secondary evidence of this type has its place and the importance, or weight, to be attached to it will vary from case to case. However, such evidence must be kept firmly in its place. It must not be permitted, by reason of its volume and complexity, to obscure the fact that it is no more than an aid in assessing the primary evidence."

25. The primary evidence at the hearing will be expert evidence. The Court is not determining in this application the admissibility of secondary evidence of the inventor as to steps taken by him or what he was or was not aware of at the relevant time. However, it is important in this application to note that the plaintiff has not indicated that the inventor will not be called and on the authorities referred to (albeit from England and Wales, Australia and Canada) it appears, at least possible that such evidence may be admitted. In any event the need to see this documentation for the purpose of cross-examining the inventor if called was only relied on as a subsidiary basis for the relevance and necessity of the inventor's notebook. The primary ground upon which it is contended that the documents are relevant and necessary is that they may lead to a line of inquiry and may assist the defendant to advance its own counterclaim in that they will disclose the actual experiments and other steps taken by the inventor and his consideration of such of the prior state of the art as was known to him. It is submitted that such information will be of assistance to the defendant in that it will enable it obtain its own expert opinion as to whether the steps actually taken by the inventor in achieving the invention were steps which would have been obvious to the hypothetical person skilled in the art. Further, that it will be of assistance to the defendant in cross-examining the plaintiff's expert witnesses by reference to what at least one person admittedly skilled in the art (i.e. the inventor) actually did.

26. The above grounds are very similar to those advanced on behalf of the applicant for discovery in *SKM SA and Another v. Wagner Spraytech (U.K.) Limited and Others* [1982] RPC 497.

27. *SKM* concerned an appeal against an order for discovery of the inventor's notebooks in infringement proceedings with a counterclaim for revocation by reason of obviousness and false suggestion.

28. The submissions made in that case as to the lack of relevance of the documents ordered to be discovered are very similar to the submissions ably made by counsel for the plaintiff in these proceedings. The judgment did concern in some respects the admissibility of evidence of what was done by the inventor. However, it also considered the question of discovery independently of potential evidence from the inventor. In considering grounds similar to those advanced on behalf of the defendant herein Oliver L.J. at p. 508 stated:

"Again, although they do not intend to call the inventor, the case is clearly not going to be fought without the presence of expert witnesses on both sides. Knowledge of the inventor's experiments will assist the defendant in two respects. He can obtain his own expert's opinion upon whether the steps taken by the inventor were the steps were no more than steps which would or should have been obvious to any skilled man; and he can, as was suggested in the Australian case, utilise any knowledge which he acquires regarding the inventor's experiments or researches in cross-examination of the plaintiffs' technical witnesses by reference to what an admittedly skilled man actually did.

These, I think, were all clearly matters which the learned judge must have had in mind in deciding to follow and to adopt the reasoning of the Australian decision. I confess to having been, at first, very much impressed by Mr. Gratwick's argument and indeed to some extent sympathetic to it, for I can see, as Whitford J. saw in the *Halcon* case, that the practice of ordering this type of discovery in patent cases can lead to delay, expense and a substantial addition to the documentation in actions which already tend to be overburdened with paper. I have, however, in the end been persuaded that the argument which he so attractively put before us is one which tends to confuse discovery and admissibility, and speaking for myself I am not prepared to differ from the conclusion at which the learned judge arrived that the discovery sought may be of assistance to the defendant, either offensively or defensively, on the issue pleaded. I would not therefore disturb the order which he made and on the view which I take it is unnecessary to consider the further matters raised by the respondents' cross-notice."

29. The Australian decision referred to by Oliver L.J. is the decision of the Federal Court of Australia in *Wellcome Foundation v. V.R. Laboratories (Australia) Pty. Limited* [1981] R.P.C. 35. That decision was subsequently heard on appeal by the High Court of Australia and the appeal dismissed. Judgment in the High Court was delivered by Aickin J. with whom the other members of the court agreed. The judgment of Aickin J. considers the admissibility of evidence of the research and experiments of the inventor leading up to the claimed invention and concluded that it is generally admissible though not always likely to be helpful. On the question of discovery of documents Aickin J. stated that the test was wider than the test of admissibility and referred to an Australian decision of *Temmler v. Knoll Laboratory (Aust) Pty Limited* noted in [1969] 43 A.L.J.R. 363 of Windeyer J. It appears from the citation given at p.357 of the judgment of Aickin J. that the test for relevance is very similar to that set out by Kelly J. following the decision in *Cie Financiere et*

"The cases to which I have referred appear to show that some discovery in respect of the work done by a patentee in arriving at his invention has been given as a matter of course and that the disputes have been as to the extent of discovery. Since evidence of such work may in some cases be relevant to the issue of obviousness it must follow that discovery should generally be given, even if only on the basis that the documents discovered may suggest a line of inquiry worth investigation."

30. The Federal Court of Canada considered whether an order for discovery should be made of inventor's notebooks in *Eli Lilly & Company v. Apotex Inc.* [2006] 4 FCR 104. The issue was considered in a slightly different procedural context and it appears from paragraph 27 of the judgment that the actual decision to order discovery was made by reason of a contest to the identity of the inventors and/or the assignment of the patent. However, the judge in additional comments made considered the inventor's notebooks to be discoverable. At paragraph 36 Aronovitch P. stated (in a passage which I think must be considered obiter):

"Discovery is not to be confused with admissibility. The fact that the test for the determination of a ground of invalidity is objective, and that the knowledge or opinion of the inventor may not be relevant in the sense that it cannot be relied upon to construe the patent, does not imply that the facts of the process of invention cannot be collaterally relevant to the issues or that they will not be considered by the Court, whatever their ultimate probative value. Moreover, documents, relating to the inventive process may be discoverable on the basis that they can contain relevant facts or ones leading to a line of inquiry that will be helpful to advance the case of one of the parties to the suit – for example, prior art references that may not be known to the party pleading invalidity."

31. The plaintiff has relied upon obiter statements of Laddie J. in *Hoechst Celanese Corporation v. BP Chemicals Limited and Another* [1997] F.S.R. 547 at 565 which undoubtedly raises questions as to the wisdom of the approach to discovery in the above decisions. In the passages relied upon Laddie J. refers to the evidence given by the inventor, Dr. Hilton, and to a number of authorities which suggest that such evidence is irrelevant to the issue of obviousness. He expresses the view that this is particularly so if as in that case the inventor did not have before him the prior art relied upon by the defendants in their challenge. He expresses a conclusion that:

"All the historical evidence of what individuals did or have thought to have done at or about the priority date is of no assistance in determining whether or not Dr. Hilton's development was obvious."

32. Laddie J. then indicates that extensive discovery was made but very little referred to in court and that even that small number of documents took the case no further. He makes it clear that he is not seeking to blame the lawyers by reason of the prior decisions including that of the Court of Appeal in *SKM SA v. Wagner Spraytech (U.K.) Limited* [1982] RPC 497 and then states at p. 566:

"However, there is much pressure now to reduce the cost of litigation in general and patent litigation in particular. Parties and the court must be astute to prevent the expenditure of time, effort and money on the filing and challenging of unnecessary evidence and discovery. As the Vice Chancellor said in *Mölnlycke*, secondary evidence on the issue of obviousness must be kept firmly in its place. If the evidence is of no weight it should be excluded from the outset. Evidence that others in the art did or did not make essentially the same development at or before the priority date of the patent should not be given unless it can be shown that those others were starting from or had brought to their attention all or some of the prior art pleaded in the case or the evidence is in some other way really relevant to the issues in dispute. Similarly, although the *SKM* case provides that documents relating to the inventor's research and development are discoverable, it may well be that that blanket approach needs refinement. It seems to me that there may well be strong arguments for holding that discovery should not be given of research or development work carried out by the inventor or anyone else if that work did not start from or involve consideration of the pleaded prior art. This is a matter which may need to be considered properly in some future case."

33. I have as requested by counsel for the plaintiff considered this application from first principles. The decisions cited are not binding on me but of course all deserving of great respect. Whilst I would agree with the views expressed by Laddie J. of the importance of reducing the cost of litigation it appears to me that applying the agreed principles in relation to relevance in this jurisdiction, that for reasons very similar to those stated by Oliver L.J. in *SKM SA v. Wagner Spraytech (U.K.) Limited* cited above the defendant has established as a matter of probability that the inventor's notebooks in this case are relevant to its counterclaim upon the grounds that they contain information which may enable it advance its own case or damage that of the plaintiff both in the manner of instructions which it will permit them to give to their own expert and advice which they may obtain from such expert leading to his or her evidence and in preparation for the cross-examination of the plaintiff's experts.

34. I have also formed the view that the discovery of such documents is necessary for the fair disposal of these proceedings. This is information which is available to the plaintiff. The plaintiff is in a position to use this information in briefing its own expert witnesses. Further it will be able to brief its lawyers with the relevant information for the purpose of cross-examining the defendant's experts. In such circumstances the documents having been relevant it appears to me that it is necessary for the fair disposal that they be discovered.

35. I have considered the plaintiff's submissions in reliance upon the decisions of the Supreme Court and High Court in *Ranbaxy Laboratories Ltd. v. Warner Lambert Company* [2006] 1 IR 193. Those decisions do not appear to me to assist the plaintiff in its defence of this application.

36. The decisions were given on a preliminary issue in a patent action in which the principal issue is the proper interpretation of the claims in the defendant's patent. The plaintiff had brought a motion for discovery of documents which comprised correspondence between the patent agents of the defendant and the European Patent Office and Danish Patent Office. That correspondence was alleged to express a view on the proper construction of the Irish patent. The defendant objected to discovery on the basis that the documents would not be admissible in evidence in the proceedings. A preliminary issue was then set down on the admissibility of such documents in evidence in the substantive proceedings.

37. It is important to note that this was the only basis upon which discovery was sought. It was not contended that the documents were relevant or necessary as leading to a "line of inquiry" as was submitted in these proceedings. It is also important to note that the issue in the substantive proceedings in *Ranbaxy Laboratories Ltd. v. Warner Lambert Company* is quite different from the issues in these proceedings. It concerned only the proper interpretation of the claims in the patent. This is agreed to be a matter of law. The test is what the claim means to an expert in the field to which it relates.

38. On the preliminary issue the documents were determined both by the High Court and the Supreme Court to be inadmissible in evidence in the proceedings.

39. The documents sought were determined by the Supreme Court to be submissions made on the defendant's behalf to the patent offices and in reality expressions of opinion of the patentee as to the construction of the claims and as such inadmissible in evidence.

40. In these proceedings, the court may well have to interpret certain of the claims in the plaintiff's claim for infringement. However, this application for discovery in the 740 patent relates to the defendant's counterclaim for invalidity. The issues which the court will have to determine include questions of fact in relation to which the primary evidence will be the expert evidence referred to above. For the reasons already set out the documents sought by the defendant appear to me to be relevant and necessary to the determination of those issues on the counterclaim.

41. The final issue on the defendants' application relates to that part of category (3) which seeks documents which disclose certain considerations given by or on behalf of the plaintiff by persons other than the inventor.

42. The parties in their submissions did not highlight any distinction between the inventor and other persons who gave such considerations by or on behalf of the plaintiff. Objection is made in the written submissions on behalf of the plaintiff to a lack of clarity insofar as in this category the defendant seeks documents which disclose or evidence consideration given to matters other than the prior art referred to in the particulars of objections. It is alleged that it is unclear what is meant by consideration of "any other documents considered but deemed by the inventor and/or on behalf of the plaintiff not to be prior art." This objection appears well founded.

43. Subject to the above I have concluded that insofar as the defendant seeks documents which disclose or evidence the consideration (if any) given by or on behalf of the plaintiff to the prior art referred to in the particulars of objections in the context of the application for the 740 patent including any documents disclosing or evidence any consideration or evaluation by or on behalf of the plaintiff as to the potential effects of any such alleged prior art on the patentability of the subject matter disclosed in the 740 patent or in the European patent no. 0650740 that the defendant is entitled to an order for discovery of such documents.

44. I have so concluded as it appears to me that such documents may disclose a line of enquiry which the defendants may wish to pursue with their expert witnesses and which may advance its counterclaim or damage the plaintiff's defence to that counterclaim. It further appears that the discovery of such documents is necessary for the fair disposal of the pleadings for the same reasons as set out above.

45. Accordingly, on the defendant's application I will disallow the documents sought at category (1); allow in full the documents sought at category (2) and allow in category (3) the following:

Category (3)

All documents which disclose or evidence the consideration (if any) given by the inventor of the 740 Patent, European Patent No. 0650740 and any other equivalent patent and by or on behalf of the Plaintiff to the prior art referred to or related to that listed in the Particulars of Objections delivered on behalf of the Defendant on 24 July 2006 including any documents disclosing or evidencing any consideration or evaluation by or on behalf of the Plaintiff as to the potential effect of any such alleged prior art on the patentability of the subject matter disclosed in the 740 Patent, in European Patent No. 0650740 or any other equivalent patent.

Plaintiff's Motion

46. The plaintiff pursued an application for discovery of a revised paragraph 1 to its notice of motion. The revised order sought is in the following terms:

"1. An Order that the Defendant make discovery on oath of the following categories of documents (the numbering used in the Plaintiff's letter seeking voluntary discovery dated 18 September 2006 is retained for ease of reference):

(a) All documents and materials relating to the following design features of the Defendant's Co-Star Paclitaxel-Eluting Coronary Stent System ("the CoStar Product") including but not limited to, documents and materials relating to the inception, design, composition, creation, development, testing and certification and/or regulatory approval, including CE marking and manufacture:

(i) of the inner tubes comprised in the CoStar Product, the nature, composition (including the materials from which they are manufactured) and securing together of any layers or surfaces of the same, and their mechanical properties including friction co-efficients;

(ii) any balloon comprised in the CoStar Product, its composition, and positioning in relation to any catheter tube and its connection with and securing to any catheter tube(s);

(iii) of the layers or surfaces of the inner catheter tube, including any relationship or connection between each layer or surface, including the positioning of the layers or surfaces in relation to one another and/or the attachment together of them, including for example, extrusion of such layers or surfaces and extrusion parameters;"

47. The defendant has agreed to discover the documents and materials relating to the composition, testing, certification and/or regulatory approval, including CE marking in relation to the above matters. What is in dispute is the application for the documents and materials relating to the inception, design, creation, development and manufacture of the above aspects of the CoStar Product.

48. The plaintiff submits that in particular documents and materials relating to the design and manufacture of these aspects of the product are relevant and necessary for the fair disposal of its claim of infringement.

49. The defendant submits that such documents are not relevant or necessary having regard to the nature of the claims in the 740 patent; the answers already given to interrogatories; the admissions made on the 30th November, 2006, and its agreement to discover the documents and materials relating to the composition of its product.

50. The claims made in the '740 patent are as follows:

1. An interventional catheter comprising a catheter tube (1) having two superposed layers (2,3) of material secured in relation to one another and with mechanical properties differing from one another, a longitudinal lumen (12) in said catheter tube for the sliding fit of a guide wire (11), and a balloon (4) with a proximal end (6) and a distal end (5), whereby the distal end (5) sealingly surrounds said catheter tube (1), whereby the catheter tube (1) has an inner layer (2) forming the longitudinal lumen (12) and an outer layer (3) forming the outer surface of the catheter tube (1), and the inner layer (2) is formed of a material with lower friction coefficient than the material forming the outer layer (3), characterised in that the inner layer (2) forming the longitudinal lumen (12) of the catheter tube (1) is a polyethylene, the outer layer (3) is made of a polyamid, and the distal end (5) of the balloon (4) is welded to the outer polyamid layer (3) of the catheter tube (1).
2. An interventional catheter according to claim 1, wherein the two layers (2, 3) of the catheter tube (1) are produced by extruding the outer layer (3) over the inner layer (2).
3. An interventional catheter according to Claim 1, wherein the inner layer (2) forming the longitudinal lumen (12) of the catheter tube (1) is a high density polyethylene.

51. The particulars of infringement alleged by the plaintiff at para. 5 of the statement of claim are:

"The Defendant, its servants or agents have been manufacturing in Ireland, selling, offering and stocking the CoStar Product which includes an interventional catheter which infringes each of claims 1, 2 and 3 of the '740 Patent.

An analysis of the Defendant's CoStar Product shows that its catheter includes all of the following features of Claim 1 of the '740 Patent:-

- (a) an interventional catheter comprising a catheter tube having two superposed layers of materials secured in relation to one another and with mechanical properties different from one another,
- (b) a longitudinal lumen in said catheter tube for the sliding fit of a guidewire, and;
- (c) a balloon with a proximal end and a distal end whereby the distal end sealingly surrounds the catheter tube;
- (d) the catheter tube has an inner layer forming the longitudinal lumen and an outer layer forming the outer surface of the catheter tube;
- (e) the inner layer of the catheter tube is formed of a material with a lower friction coefficient than the material forming the outer layer;
- (f) the inner layer forming the longitudinal lumen of the catheter tube is made of a polyethylene;
- (g) the outer layer is made of a polyamide, and
- (h) the distal end of the balloon is welded to the outer polyamide layer of the catheter tube.

Further, and in breach of Claim 2 of the '740 Patent, the two layers of the catheter tube of the defendant's CoStar Product are produced by extruding the outer layer over the inner layer.

Further, and in breach of Claim 3 of the '740 Patent, the inner layer of the catheter tube of the Defendant's CoStar Product forming the longitudinal lumen of the catheter tube is a high density polyethylene.

The Plaintiff reserves the right to provide further particulars of infringement up to and including the trial herein."

52. The defendant in its defence denies each and every particular of infringement.

53. The issues in the proceedings will include issues as to whether the defendant's product includes the features alleged in the particulars of infringement save insofar as the defendant may already have made admissions in the statement of admissions of 30th November, 2006, or in the answers to interrogatories.

54. It is unnecessary to set out in full here the answers to the interrogatories. They are not straight forward. The defendant, as it is entitled takes the view that certain of the terms in the patent require to be interpreted by the court and pending such interpretation has not answered in a clear manner the interrogatories put.

55. I have formed the view that the plaintiff has established that the documents relating to the design and manufacture are as a matter of probability relevant and necessary to the resolution of the issues arising from certain of the alleged particulars of infringement. I accept that many go to the composition of the defendant's product. However, it appears to me that certain of the particulars may involve a consideration of the design and process by which the defendant's product is manufactured and hence the plaintiff is entitled to the documents sought.

56. I refer by way of example to the allegation that the defendant's product is an interventional catheter comprising a catheter tube having two superposed "layers of materials ...". In the replies to interrogatories the defendant has indicated that it is unable to confirm or deny that the catheter tube has an "inner layer" or "outer layer". It contends that the terms "layer" or "inner layer" or "outer layer" require a construction by the court. This may well be correct. Nevertheless following such construction it may be necessary for the court to determine whether those parts of the defendant's product are "layers" within the meaning of the claim as construed. The precise design and/or specification for this part of the product may be relevant to that determination.

57. A further feature included in the alleged particulars of infringement at paragraph (h) is that "the distal end of the balloon is welded (emphasis added) to the outer polyamide layer of the catheter tube". Again in relation to this the defendant contends that the term "welded" or "welding" requires construction by the court. It is admitted that the distal end of the balloon is attached to the outer

polyamide layer of the catheter "by the application of heat and pressure". It appears probable that when the term welded is construed by the court the precise process (including amount of heat and pressure) by which this attachment takes place may be relevant to the question as to whether it is welded within the meaning of the claim of the patent.

58. The above are not intended to be exhaustive but are simply two examples given of the reasons for which I have formed the view that the plaintiff has established that notwithstanding the answers to interrogatories and admissions that documents and materials relating to the design and manufacture of those aspects of the product listed in paragraphs (i) to (iii) of paragraph 1(a) of the amended notice of motion are relevant and necessary for the fair disposal of these proceedings. There are further probable similar issues having regard to particulars of infringement in issue, even taking into account replies to interrogatories and admissions.

59. I have concluded that documents and materials relating to the inception, creation and development of the product are not relevant or necessary. The plaintiff has not established that such documents are relevant to the issues raised by the claim in these proceedings. The infringement alleged relates to the final product.

60. Accordingly, the plaintiff is entitled to an order for discovery in the revised form of paragraph 1 of the notice of motion subject to the deletion of the words, inception, creation and development in paragraph (a).