

**THE HIGH COURT****Record No. 2015 No.2537P.**

**GLAXO GROUP LIMITED  
AND  
GLAXOSMITHKLINE (IRELAND) LIMITED T/A ALLEN & HANBURYS**

**Plaintiffs**

**– and –  
ROWEX LIMITED**

**Defendant**

**JUDGMENT of Mr Justice Max Barrett delivered on 25<sup>th</sup> May, 2016.**

**Part 1****Overview**

1. Two companies within the Glaxo group have sued Rowex, a company within the Sandoz group. Certain Sandoz group entities incorporated and located abroad have volunteered to make information available to the Glaxo companies that they are not obliged to provide. This offer is made subject to the requirements of local data protection law. The Glaxo companies are not satisfied with what has been offered and have raised their concerns with the court. Separately Rowex is seeking discovery against the Glaxo companies. Both applications are made under O.31, r.12 of the Rules of the Superior Courts (1986), as amended.

**Part 2****Some Background Facts****A. The Plaintiffs.**

2. The two Glaxo companies that are the plaintiffs in these proceedings are members of the GlaxoSmithKline group of companies. The Glaxo Group is a global healthcare group engaged in the research and development of a broad range of products in the pharmaceutical, vaccine and consumer healthcare sectors. The first-named plaintiff, Glaxo Group Limited is a company incorporated under the laws of England and Wales and is a wholly-owned subsidiary of GlaxoSmithKline plc, the parent company of the Glaxo group. It is also a trade-mark holding company within the Glaxo Group. The second-named plaintiff, GlaxoSmithKline (Ireland) Limited, trading as 'Allen & Hanburys', is a company incorporated under the laws of Ireland. It is another wholly-owned subsidiary of GlaxoSmithKline plc. It is also the Irish marketing authorisation-holder for a number of Glaxo group products and carries out the distribution, sale and promotion of Glaxo products in Ireland.

**B. The Seretide Inhaler.**

3. Glaxo sells a respiratory inhaler for the treatment of asthma and chronic obstructive pulmonary disease known colloquially, and referred to hereafter, as the 'Seretide Inhaler'. The Seretide Inhaler is what is known in the drugs industry as a 'blockbuster' product. This is a term reserved for any pharmaceutical product that had sales of over \$1bn globally and has been handsomely surpassed by the Seretide Inhaler which has grossed sales of over \$62bn worldwide, making it the fourth best-selling pharmaceutical product of all time. In Ireland it has yielded gross income of €40m, €36m, and €34m in 2012, 2013 and 2014 respectively. Since the Seretide Inhaler was launched in Ireland in 1999, it has been packaged, marketed and advertised, in a purple get-up. Glaxo maintains that it has invested considerable time, effort and money in developing the goodwill and reputation of the Seretide Inhaler and, more especially, the colour purple as a distinctive feature of its get-up. In the 17 years or so since it was first launched in Ireland, doctors and pharmacists have been extensively and consistently provided with a significance amount of Seretide marketing in which the colour purple has taken a central role.

**C. The Defendant.**

4. Rowex Limited, a company incorporated under the laws of Ireland, is a member of the Rowa group of pharmaceutical group of companies. It is a joint venture between Rowa Pharmaceuticals Limited and Hexal AG, the latter of which is a member of the Sandoz group of companies. Rowex was established in Ireland primarily to produce and sell medicinal products which have been deemed by the relevant regulatory authority to be equivalent to an original medicinal or 'reference' medicinal product. Such products are commonly known as 'generic' or 'therapeutically equivalent' products.

**D. The Mainstay of These Proceedings.**

5. The proceedings of which the present discovery applications are part relate to claims for:

(a) trade mark infringement of Glaxo Group Limited's European Union Trade Mark (EUTM) 003890126 registered on 19th December 2008 in class 10 of the Nice Classification System for particular shades of the colour purple (pantones 2587C and 2567C) applied to inhalers of any shape;

(b) passing off of goods not belonging to, owned and/or licensed by the plaintiffs as and for such goods, in particular by Rowex's use of various shades of purple, including pantone colour 2573C on the packaging, labelling and representation of the AirFluSal Inhaler; and

(c) unlawful interference with the plaintiffs' economic interests by the deliberate introduction, sale, distribution and marketing of the AirFluSal Inhaler on the Irish market, in purple colouring and/or in reckless indifference to the fact that the colour and get-up of the AirFluSal Inhaler were so close to the colour and get-up of the Seretide Inhaler as to constitute an infringement of Glaxo's EUTM and/or passing off and/or were such as to enable Rowex to 'piggyback' on the plaintiffs' intellectual property rights in such colouring and get-up.

6. The EUTM is used by Glaxo on the Seretide Inhaler. The plaintiffs allege, inter alia, infringement of the EUTM on the basis of likelihood of confusion (Type II infringement) and taking unfair advantage and detriment of the EUTM given its reputation (Type III infringement). This is on the factual basis that Rowex launched its AirFluSal Inhaler in Ireland in March 2015, in the colour purple pantone 2573C, a pantone between the two pantones of Glaxo Group Limited's EUTM.

7. As part of the wider battle between the two sides over the Seretide/AirFluSal inhalers and the use of the colour purple, in August 2014 an application for a declaration of invalidity and a revocation of Glaxo's EUTM was filed with OHIM, now EUIPO, by a member of the Sandoz/Novartis group of companies, of which Rowex is a member. This has recently been followed by a further cancellation action. It is the plaintiffs' position that the EUIPO invalidity/revocation proceedings are a tactical manoeuvre in the context of the

overall battle being waged between the parties.

### Part 3

#### Some Issues Arising

##### A. Overview.

8. The parties exchanged letters seeking voluntary discovery commencing in the autumn of 2015. Some issues of concern arising for the plaintiffs from that correspondence are the limited definition of the 'Sandoz Group', i.e. the corporate bodies that may be the subject of any discovery order. Also of concern to the plaintiffs was a passing reference that had arisen in the correspondence as to the potential constraining effects of German data protection law as regards any discovery that might fall to be made to them. Of concern to the defendant was the form of undertaking that the plaintiffs have sought of it as the 'price' for accepting a constrained form of discovery and the proposed limitation on the entities and individuals who would make discovery.

##### B. Limitations on Discovery and Undertaking Sought.

9. In the discovery-related correspondence between the parties, the plaintiffs suggested that as a result of Rowex's affiliation with the Sandoz group and the arrangement whereby Rowex markets and distributes the AirFluSal Inhaler in Ireland, Rowex should be in a position to obtain all the documents of which voluntary discovery had been sought that were in the possession, power or procurement not only of Rowex but also the Sandoz group. This is a proposal that, to borrow a colloquialism, has 'gone down like a lead balloon' on the Rowex side. An extract from a letter of 9th October, 2015, sent by Rowex's solicitors gives a clear sense of the nature of the issues then, and now, perceived to arise in this regard, these being (1) Rowex's proposed limitations on the corporate entities and individuals who would make discovery on its side, (2) German data protection law, and (3) the undertaking requested by the plaintiffs:

*"No definition of 'Sandoz Group' has been provided in your letter. The fact that Hexal[Hexal AG, a shareholder of Rowex] forms part of a complex corporate structure consisting of 383 companies employing over 26,000 people worldwide does not give the Defendant any legal right to obtain documents from any of these companies or to procure any documents from companies within that corporate structure.*

*Requesting that such a large number of companies review a potentially enormous number of documents (many of which may not even be in English) on the speculative basis that some documents may potentially fall within the categories of discovery sought is, in our view, entirely inappropriate and unreasonable. Third parties cannot be expected to engage in such an unnecessarily broad, indiscriminate and disproportionate exercise over a short period of time.*

*Notwithstanding the above, the Defendant is willing to facilitate, to the extent that it can, a fair, cost-effective and expeditious trial. Accordingly, inquiries have been made as to whether Hexal or any other entities may have any documents relevant to these proceedings in their possession, power or procurement.*

*Clearly it is not feasible or reasonable to investigate every company that could potentially be seen to fall within the same corporate structure as Hexal. However, in the course of making the inquiries referred to in the above paragraph, it became apparent that, in so far as it is relevant to the matters in dispute in these proceedings, only an extremely limited number of companies within the complex corporate structure of which Hexal forms a part had any input whatsoever into the design and launch of the AirFluSal...product. Even within those limited number of companies, it has become apparent that only certain individuals were involved in the design and launch of the AirFluSal...product. It must be borne in mind that the corporate structure of which Hexal forms part has a portfolio of over 5,900 products in Germany alone.*

*Given the fact that only Rowex Limited has been named as a Defendant in these proceedings, the limited time available to the Defendant to make discovery if the Plaintiffs wish the case to proceed in an expeditious manner, the fact that all of the companies in the corporate structure of which Hexal forms part are located outside of the jurisdiction, the cost of searching through the millions of documents in the power, possession and procurement of 383 companies all over the world, the fact that it is likely that a very significant amount of those documents will not be in the English language and the fact that in many of these companies only certain individuals will have any documents of relevance to these proceedings, we would submit that for all of these reasons it is necessary to agree a more reasonable and proportionate level of discovery.*

*We are instructed that certain companies within the corporate structure of which Hexal forms part would be willing to make limited discovery, subject to the Plaintiffs agreeing to the amendments to the categories of discovery outlined later in this letter.*

*We would therefore propose that the term 'Sandoz Group', for the purpose of discovery, be defined as consisting solely of the following entities:*

*Hexal*

*Aeropharm GmbH; and*

*The Global Respiratory Department of Sandoz International*

*In addition, discovery by the Sandoz Group (as defined in this letter) would be limited to documents contained in the electronic and/or physical files of the following [16 named] individuals [including six ex-employees]...to the extent that such documents are 'in the possession, power or procurement' of the Sandoz Group. We are instructed that the lawful access by employers to files and data of employees, in particular former employees, as well as the transfer of this data to third parties may be limited or even excluded due to German data protection legislation. Accordingly the obligations of each of the entities in the Sandoz Group (as defined in this letter) to make discovery will be subject to its obligations to comply with German law.*

*The above are the individuals who have been identified thus far as having any responsibility for the design and launch of the AirFlusal Inhaler....and if [during the course of the discovery process] relevant documents are identified originating from an employee or former employee of the Sandoz Group (as defined in this letter) who is not listed above, it is intended, subject to its obligations to comply with German law, to also search the electronic files and physical files of that person."*

10. In what they claim is a bid to facilitate, to the extent that they could, a fair, cost effective and proportionate approach to discovery, the plaintiffs indicated that they would be satisfied to the limitations on the numbers of corporate entities and individuals of whom discovery would be required, provided that:

(1) someone for Rowex swore on affidavit that (a) the 16 named individuals and (b) Rowex, Sandoz International GmbH and Aeropharm GmbH are the only persons and companies, of which Rowex is currently aware, that hold documents relevant to the categories of documents requested by the plaintiffs; and

(2) in addition to searching the files of the 16 named individuals, that Rowex/Sandoz Group would search the physical and electronic files of certain respiratory and other departments of Sandoz GmbH, any Hexal companies involved in the design, labelling and branding and/or marketing of the AirFluSal Inhaler, and Aeropharm GmbH.

## Part 4

### An Attempted Synthesis of Applicable Principle

#### A. Overview.

11. Four cases appear to the court to describe sufficiently the law relevant to the particular issues that this case presents, viz. the decisions of the Supreme Court in *Fusco v. O'Dea* [1994] 2 IR 93, *Johnston v. Church of Scientology* [2001] 1 IR 682, and *Thema International Fund plc v. HSBC Institutional Trust Services (Ireland) Limited and Ors* [2013] 1 IR 274, and the decision of the High Court in *Thema International Fund plc v. HSBC Institutional Trust Services Ireland & Ors* [2012] 3 IR 528. The various principles established and/or confirmed by those cases can perhaps be summarised as set out in Part B below.

12. In passing, the court notes that O.31, r.12, as considered by the Supreme Court in *Johnston*, has since been changed, so that it refers to "possession, power or procurement" and not "possession, custody or power". However, the effect of the Supreme Court's decision in *Thema* is that the change of terminology has not affected the ambit of discovery, so as a consequence *Johnston* continues to be good law. Indeed, Clarke J. says as much in his judgment for the Supreme Court in *Thema* stating, at 287:

*"The position adopted in most of the common law jurisprudence to which reference has been made and also adopted under the former rule in this jurisdiction under Johnston...has, in my view, the considerable merit of certainty. A party either has documents in its possession or has the legal entitlement to require possession. In those circumstances the document must be discovered. In all other circumstances, the document does not have to be discovered. Subject to the argument, to which I will now turn, concerning whether the addition of the word 'procurement' to the rule has altered the situation I do not see any basis in principle for deviating from the law as required."*

13. As Clarke J. goes on to conclude that the ambit of the pre-existing law as to discovery had not been changed, despite the change in terminology, the effect of the foregoing is that *Johnston* remains good law and that what Denham J., for the Supreme Court, has to state about the cumulative phrase "possession, custody or power" in *Johnston*, can be read as applying with equal strength to the mutated cumulative phrase "possession, power or procurement", i.e. despite the mutation, no 'mutatis mutandis', it seems, is required, at least as regards the cumulative effect of the revised phrase.

#### B. Some Principles Identified.

##### I

##### General

14. [1] In relation to the discovery of documents, the law evokes three concepts, possession, custody and power [now "possession, power or procurement", but the cumulative effect of the phrase, per the Supreme Court in *Thema*, is unaltered]. (*Johnston*, 700).

15. [2] No material change in the scope of discovery was brought about when the rules committee reformulated O.31, r.12 in 2009 and inserted the word "procurement". For that reason the law as discovery remains as stated in *Johnston*. (*Thema* (SC), para.53).

16. [3] A document is within the power of a party if he has an enforceable legal right to obtain the document from whoever actually holds the document, without the need to obtain the consent of anyone else. (*Johnston*, 700).

17. [4] A document to be discovered must be in the possession, custody or power (in accordance with the enforceable legal test) of a party [now "possession, power or procurement", but the cumulative effect of the phrase, per the Supreme Court in *Thema*, is unaltered] (*Johnston*, 700). The applicable test for a document to be discovered has been reformulated by Clarke J., for the Supreme Court in *Thema* (at para.39) so that a document must be discovered if a party either has documents in its possession or has the legal entitlement to require possession. In all other circumstances, Clarke J. continues, a document does not have to be discovered.

Note: Although Clarke J., in his conclusion as to the cumulative effect of the phrase "possession, power or procurement", appears to rob the word "procurement" of having any varying effect, on pre-existing law, when used in that cumulative context, this Court does not understand him to mean that the word "procurement" in and of itself has no meaning in this context. Could there be situations in which the particular meaning of the word "procurement" (as opposed to its effect in the context of the cumulative phrase "possession, power or procurement") might carry import? Two possible situations spring to mind. First, there is the still- (if just-) surviving line of case law represented by *Northern Bank Finance Corporation* and *Yates* (considered later below) that allows in limited circumstances for discovery to be ordered where a party neither has documents in its possession nor has the legal entitlement to require them but can procure them. In that context, notwithstanding *Thema*, the notion of 'procurement' appears to have some separate meaning, presumably its ordinary English meaning. Second, one also sometimes encounters in practice a party swearing, in the face of an order that refers to 'possession, power or procurement', an affidavit of discovery that she has no documentation in her 'possession, power or control'. Does that party mean to deviate from the order of discovery or is she innocently substituting one word for another? One surely needs to have regard to the plain-English meaning of the words 'procurement' and 'control' in order to determine this. In this context the notion of 'procurement', notwithstanding *Thema* appears again to have some separate meaning, presumably its ordinary English meaning.

18. [5] To the general rule as to discovery stated at [4], there may be rare exceptions. However, those rare exceptions are examples of a judge in her discretion making a determination on the facts.

Note: For examples of exceptional instances, see Northern Bank Finance Ltd. v. Charlton (Unreported, High Court, Finlay P., 26th May, 1977) and Yates v. Ciba Geigy Agro Ltd. (Unreported, High Court, Barron J., 29th April, 1986). Both were cases where a single or small number of documents, known to exist, were directed to be disclosed in circumstances where the court was satisfied that there was no reason to believe that any difficulty would be incurred in securing the documents concerned. It is perhaps possible to discern a slight cooling of the Supreme Court as regards Northern Bank Finance Corporation and Yates. Thus Clarke J., for the Supreme Court in Thema, states, at para. 54 that "Whatever may be the case in the sort of situation where there is a single or small number of readily identifiable documents in respect of which there is good reason to believe that production may be procured...", a form of wording which might perhaps be read as suggesting that this is an aspect of matters which the Supreme Court may wish to re-visit in the future – though it may be that this Court is reading the runes wrongly in this regard.

19. [6] Only in extreme cases will the court dismiss a claim or defence for discovery failures. (Thema (HC), 541).

## II

### The Obligations on Those Making Discovery

20. [7] The basic obligation on any party is to comply, to the best of its ability, with any order of discovery made. (Thema (HC), 539).

21. [8] Parties have general obligations which go beyond formal compliance with court orders. Where it is likely that the scale of discovery which will be required to be made is significant and so likely to be lengthy and costly, there is an obligation on a party to consider how best it can meet any likely obligation to make discovery in a way which (a) does not unduly delay the trial of the proceedings and (b) does not add unnecessarily to the scale of the costs likely to be incurred. (Thema (HC), 539).

22. [9] A party which has failed to take reasonable steps to put itself in a position to comply, once an order is made, with its discovery obligations, may find the court less sympathetic to any plea which it might make concerning the burden of having to meet an onerous discovery obligation in a short period of time. (Thema (HC), 540).

23. [10] The court is entitled to assume and expect that a party will have taken reasonable steps, in advance of the term of discovery being fixed either by agreement or by court order, to put itself in a position where it can comply with the obligations arising in an expeditious way. (Thema (HC), 540).

24. [11] There is no reason why assembly of the 'universe' of materials and the uploading of those materials where possible (together with the assembly of any documents that must be kept in hard copy form) cannot go ahead on the basis of a reasonable assumption as to the broad parameters of discovery which is likely to be ordered. (Thema (HC), 540).

Note: The reasonableness of this proposition seems directly related to the functionality of the system of discovery which, at this time, seems somewhat dysfunctional, grounded in principles little-changed since the Victorian Age and ill-suited to an Information Age when discovery costs so much money, time and resources, typically unleashes a sea of documentation which contains only a limited number of documents that are of central focus at the later trial, and rarely if ever results in a 'Eureka!' moment in which discovered documentation entirely resolves the issues arising. As Hogan J. recently observed in IBB Internet Services Ltd & Ors v. Motorola Ltd [2015] IECA 282, para.10:

*"[E]xperience has regularly shown that the practical benefits of...discovery is often entirely outweighed by the costs and delays in the entire process. How often is it the case that even in complex litigation only a relatively small number of documents prove to be the important ones, despite the generation of thousands of documents in the course of the discovery process, most of which are never used or deployed in court?"*

25. [12] Where it can reasonably be anticipated that documents held abroad are likely to be within the scope of discovery, it is incumbent on a party who may have an obligation to make discovery of such documents to take any necessary and appropriate preparatory steps it can (in advance of discovery being agreed or ordered) to ensure any procedures or applications necessary to permit the lawful release of the relevant materials can be put in place in a timely fashion. There may be consequences in costs if a party does not. (Thema (HC), 542).

## III

### Corporate Groups

26. [13] Parent companies and related companies are entitled to stand on their rights and not make documents available to connected companies involved in litigation in Ireland. However, if they do so without good cause, they may well place the related company which is involved in litigation in Ireland in a difficult position if, as a consequence, the trial judge is of the view that there are pieces of the jigsaw missing and no legitimate explanation as to why that may be so. (Thema (SC), para.59).

27. [14] In a situation where one corporation works towards a common end with another, but without a principal-agent relationship existing between the two, there is no enforceable legal right on the part of the putative principal to obtain the documents in question and they are not, therefore, in its power. (Johnston, 701).

28. [15] In large corporate groups, companies will frequently delegate (formally or informally) certain of their functions to other group members. Strictly speaking, the delegating party may not always have a legal right to require documents produced on foot of such delegation. However, it would be surprising and require explanation if a company were to delegate functions without retaining an entitlement to obtain documents or materials related to the carrying out of the delegated functions. A party who places reliance on any such lack of legal right needs to understand and address the possible consequences of placing such reliance. (Thema (SC), para.56).

29. [16] While, strictly speaking, a party would be entitled to require its opponent to bring an application for third party discovery in the event that its opponent wished to obtain disclosure of relevant documents held by a related (non-party) company, a party that imposed such a cumbersome procedure on its opponent, could find the court would be unsympathetic in applying the usual costs regime which exists in respect of true third party discovery against entities with no connection to the parties. (Thema (SC), para.55).

30. [17] It would be an abuse of process for a party to decline to make discovery of documents held by another company within the same group on the basis of not having a power to obtain the documents concerned and then seek, without having given prior disclosure of the relevant documents, to place reliance on those documents at the trial. (Thema (SC), para.57).

31. [18] Where a party intends to place reliance on documents in respect of which it does not have a legal entitlement but which it hopes to be able to secure, there is an obligation on that party to make all appropriate inquiries as to the availability of such documentation in advance of swearing its affidavit of discovery so that any documents which are going to be relied upon are included in the affidavit of discovery even though such documentation may not, originally, have been in the possession, power or procurement of the party concerned. (Thema (SC), para.57).

#### IV

##### Third-Party Discovery

32. [19] Third party discovery is available against any company which is amenable to the jurisdiction of the Irish courts. (Thema (SC), para.55)

33. [20] The court does not have jurisdiction to order discovery which would require a third party (even where that third party is a related company of a party to the proceedings) to itself engage in what would be a form of delegated discovery. (Thema (SC), para.54).

*Note: In Thema, Thema had sent an original request for discovery to HTIE. In that request, Thema defined the term 'defendant' (by reference to which discovery was sought) to include not just HTIE but also any other HSBC entities. In response, HTIE refused to agree documents held by any other HSBC entity. Subsequently it made discovery of documents that it had obtained from four other HSBC entities. It also indicated that these were the only companies to which it had delegated functions/roles within the HSBC group and that there could be no obligation on it to make discovery of any documents held by other entities within the HSBC group.*

34. [21] Order 31, rule 29 is an unusual provision in that it requires a stranger to an action to make discovery. Accordingly it should be construed strictly and in the absence of express provision should not be read as conferring extra-territorial jurisdiction on the Irish courts, in addition to that conferred by Order 11. (Fusco, 104).

35. [22] When it comes to O.31, r.29, the onus is on the applicant to satisfy the court that the documents sought are in the third party's power or possession. If it does not do so the court has no jurisdiction to make the discovery order sought. (Fusco, 102).

36. [23] An order under O.31, r.29, is in the court's discretion; it is not available as of right. (Fusco, 102).

37. [24] Order, 31, rule 29, must be read in the light of O.11 which provides for service of a summons outside the jurisdiction. (Fusco, 102).

38. [25] Parties outside the jurisdiction are only to be made amenable to the Irish court's jurisdiction in specified circumstances. To proceed otherwise would be to circumvent O.11. (Fusco, 102).

39. [26] The normal territorial limitations apply to discovery. (Fusco, 103).

40. [27] Where a foreign state has submitted to the jurisdiction of the courts, e.g., by initiating proceedings as plaintiff, it must be prepared to make discovery. Discovery against a foreign state will not lie otherwise. (Fusco, 103).

#### V

##### Confidentiality and Data Protection

41. [28] The requirement that justice be administered fairly will trump any obligation of confidence in ordinary circumstances so that confidentiality will not, ordinarily, provide a basis for the non-disclosure of materials which are of real relevance in this regard. (Thema, (HC), 539).

Note: Care is obviously required in this regard. Notwithstanding s.2A(1)(b)(iii) and s.2A(1)(c)(i) of the Data Protection Acts 1988 and 2003, it is patently the intention of our elected lawmakers, informed by the requirements of European Union law (and so the wider sense of the European legislator, and hence indirectly the European populace, as to what is appropriate in terms of intrusions on privacy) that individuals should enjoy a high level of protection when it comes to personal data. In doing justice to the parties before them, courts need ever to be careful to seek not do an injustice to those who are not. The blunt tool of a discovery order needs to be sharpened as much as possible if the requirements of proportionality are to be satisfied and inappropriate disclosures of personal data are not to be authorised; for once authorised, the afore-stated protections of the Data Protection Acts take effect.

42. [29] Subject to [28], just as the court must pay attention to the principle of proportionality in deciding on the breadth of discovery to be ordered, proportionality can play a role in relation to the disclosure of confidential information, at least where highly confidential documents are sought to be disclosed which are confidential (in particular, where the confidence of third parties is involved) and where the relevance of the documents concerned is at best marginal. (Thema (HC), 539).

#### VI

##### Proportionality

43. [30] Proportionality is a relevant consideration when the court has to determine the way in which a party is to comply with its discovery obligations. A court, in considering the length of time which a party should be given to comply with a discovery obligation should have regard to what might be considered an acceptable length of time having regard to the need for a case to come to trial with reasonable expedition, but also to the costs that such greater expedition might yield, and then to strike an appropriate or proportionate balance. (Thema (HC), 539-540).

#### VII

##### Cost of Discovery

44. [31] A party is obliged to give significant consideration to adopting the cheapest method for complying with its discovery obligations unless there is good reason for adopting a more expensive method by reason, e.g., of a greater likelihood of accuracy or some other factor of like weight. Cost must be viewed not just from the perspective of discovery but also from the perspective of the likely cost of litigation as a whole. (Thema (HC), 541).

45. [32] It should not be assumed that a party who adopts an unnecessarily expensive means of complying with its discovery

obligations can recover the additional costs of making discovery (should it win and have costs awarded to it) which go beyond the amount that would have had to be paid if a less expensive but equally effective means of complying with its obligations had been utilised. (Thema (HC), 541-542).

46. [33] In cases involving much material, especially e-material (or material readily capable of conversion to electronic format), the foregoing observations as to costs apply with even greater rigour. If a party fails to use reasonably available IT methods which would have the effect of reducing the overall costs of litigation, such a party may find itself unable to recover the extra costs thereby arising. (Thema (HC), 542).

### **VIII**

#### **Corrective Role of Trial Judge**

47. [34] A party, as referred to in [18], might be selective as to those of the documents held by related companies which it sought and obtained and, thus, was obliged to discover. This difficulty cannot be remedied at the discovery stage. A party is only obliged to discover documents within its possession, power or procurement including such documents as it may be able to secure from related companies and on which it wishes to place reliance. (Thema (SC), para.58).

48. [35] It will always be open to a trial judge to take whatever steps are appropriate, in all the circumstances, to deal with the situation where the trial judge feels that a selective view of the documentary record is being placed before the court by virtue of the fact that a party has chosen to secure some but not all of a relevant set of documents from associated corporate entities. (Thema (SC), para.58).

49. [36] It would be open to a trial judge, in an appropriate case and in the light of all relevant facts, either to decline to admit in evidence a selective part of a relevant documentary record or, while admitting such documents in evidence, to draw any appropriate inference from the absence of the remainder of the same set of documents. (Thema (SC), para.58).

50. [37] It would be necessary, in considering what, if any, course of action to adopt, for the trial judge to pay appropriate regard to any explanation tendered for the selective nature of the documents produced. (Thema (SC), para.58).

51. [38] It is open to a trial judge to draw any inference which may be appropriate in all the circumstances from any failure to make documents, which it is established are likely to exist and of significant relevance to the case, available for consideration at the trial. (Thema (SC), para.59)

52. [39] If the evidence on which a case is presented is incomplete, and the trial judge views any explanation for its lack of completeness as inadequate, then, in an appropriate case, adverse inferences may be drawn. (Thema (SC), para.60).

### **Part 5**

#### **Application of Principle**

53. Applying the principles identified in Part 4 to the issues identified in Part 3 concerning Rowex, the court has reached the following conclusions:

*Principle No(s) Court Response.*

[1]–[3]. Noted.

[4]. There is no indication before the court that the documents which the Sandoz companies have volunteered to provide are documents that are in the possession of Rowex or documents of which it is entitled to require possession. Such documents are the only documents that Rowex is, or can be, required to discover.

[5]. Both Northern Bank Finance Corporation and Yates were cases where a single or small number of documents known to exist were directed to be disclosed in circumstances where the court was satisfied that there was no reason to believe that any difficulty would be incurred in securing the documents concerned. In this case, one has entered very different territory: there is a large number of costs and securing them is a matter that would require significant cost and trouble.

[6]. Noted.

[7]. There is no suggestion that either side to these proceedings will do otherwise.

[8]. It appears to the court that both sides have sought conscientiously to do this.

[9]. Noted. The court is not aware that either side has so failed.

[10]–[11]. Noted.

[12]. The court is not aware that either side to these proceedings has documents abroad. The facts here are that they are related to other companies that may have documents abroad, a very different matter.

[13]. It seems to the court that, to borrow a colloquialism, this is the rock on which many of the plaintiffs' contentions perish. They have commenced their proceedings against Rowex. If they wish to join other parties, that is something they may wish to consider. However, a consequence of the decision to sue Rowex is that they can seek discovery against it. Just because Rowex is a member of a group of companies does not render the documents of those other companies immediately discoverable. (The issue of third party discovery is considered later below).

[14]. There is no such principal-agency relationship presenting here.

[15]. There is no such delegation here.

[16]. The court considers third party discovery later below.

[17]. There is no suggestion here that either side proposes so to do.

[18]. This does not appear to arise as an issue at this time. Clearly, it is for the parties to exercise due care in this regard.

[19]. Third party discovery is not available against corporate entities that are not party to the proceedings and which are incorporated and situate abroad.

[20]. Noted.

[21]–[24]. No application has been made under O31, r.29.

[25]. No such circumstances present here.

[26]. Noted.

[27]. Not relevant.

[28]. The issue of data protection that had been perceived to arise appears largely to have resolved itself in these proceedings as most of the 16 individuals nominated from within the Sandoz group have been satisfied to grant the consent sought of them. By way of general note, however, the court would note that save as is otherwise provided by German law, the individuals approached for such a consent could have elected, and in the case of any outstanding members of the group of 16 may yet elect – for good reason, bad reason or no reason – to consent or to decline to consent to the release of personal data that is theirs and theirs alone. There is nothing that this Court can do about that; nor would this Court have matters otherwise.

[29]. Noted. As stated, the issue of data protection that had been perceived to arise appears largely to have resolved itself.

[30]. Noted.

[31]–[33]. These are matters for the parties to take on board at this time.

[34]–[39]. This Court is not the trial court and thus has no comments to make in this regard.

54. When it comes to Rowex, the discovery order made in respect of it pursuant to this judgment is subject to the application of law undertaken by the court in this Part 5. In other words, if the court, in this Part 5, has indicated that something is or is not required of Rowex, then no order that issues from the court pursuant to this judgment should be taken as requiring something contrary of Rowex. Every and any such order comes subject to this Part 5.

## **Part 6**

### **The Current State of Play Between the Parties**

55. The court identifies in Parts 7 to 9 the discovery that it will order of the defendant and the plaintiffs respectively. A particular consequence of the conclusions reached in the preceding Part is that the court cannot make an order of discovery against the Sandoz parties that are neither a party to the proceedings nor incorporated in Ireland nor situate in Ireland. If the parties continue to negotiate some form of voluntary discovery and the court can facilitate matters by accepting certain undertakings then, subject to those undertakings being undertakings that it considers that it can properly accept in the circumstances presenting, the court will be satisfied to do so. When it comes to any continued negotiation of voluntary discovery between the parties, which is of course a private matter for them, the parties may or may not wish to note the following:

(1) as regards the plaintiffs, the court considers it is entirely reasonable of the Sandoz entities that are not parties to the proceedings, to seek an undertaking of the plaintiffs that they will bear the costs of discovery, should Rowex succeed at trial. It appears to the court that such an undertaking is necessary because unless the Sandoz side secure this undertaking now, they will not be entitled to recover any of the costs that they have incurred in making non-party discovery, should Rowex be successful at trial.

(2) as regards the defendant, the court notes that the only assurance that Rowex is (or the Sandoz entities are) willing to give regarding the 16 individuals is that they are the only persons identified thus far as having any responsibility for the design and launch of the AirFluSal Inhaler. However, so far as the plaintiffs are concerned, the most pertinent issue arising in this regard is (a) not whether these are the sole persons who appear to have had any responsibility for the design and launch of the AirFluSal Inhaler (and not all the categories of documents sought relate in any event to the design and launch of the AirFluSal Inhaler), but rather (b) whether these 16 individuals are the only people who can be identified at this time as having documents relevant to the categories of discovery sought. It appears to the court that the plaintiffs are right to be concerned and in this regard the court would make the following observations:

(i) assurances regarding the involvement of the 16 individuals, in the design and launch of the AirFluSal Inhaler are not sufficient when the plaintiffs are being asked to agree to limit the search for relevant documents to the electronic and physical files of 16 individuals from within the Sandoz group;

(ii) the offer made by Rowex necessarily entails a real risk that relevant material will remain undiscovered unless Rowex can aver that the 16 individuals are the only individuals known to date potentially to have documents relevant to the categories of discovery requested by the plaintiffs. As such an averment will in any event be made 'to the best of the knowledge and belief' of the person swearing, the court must admit to some surprise that such an averment is perceived by Rowex to be so objectionable;

(iii) tellingly, Rowex has given no real information as to what efforts it has made to ascertain if those 16 individuals are the only individuals who may have relevant documentation (again an entirely separate issue from whether the said 16 are the sole persons who appear to have had any responsibility for the design and launch of the AirFluSal Inhaler);

(iv) the court does not accept that the plaintiffs' proposal involves a 'chicken and egg' style situation in which to give the averment sought would negate the agreement to limit the discovery because it would require all the files of the Sandoz group of companies to be searched, this being precisely the form of search that Rowex has been seeking to avoid. If the court looks to the plaintiffs, they have already sent out custodian questionnaires to all persons in the UK and Ireland who are still employed by the Glaxo group and who were involved in the Seretide Inhaler over the course of its lifetime and hope thereby to be in a position accurately to limit on a truly rational basis which of the plaintiffs' files should fall to be

searched. There is no reason why the Rowexside cannot do likewise, and good reason why it should; and

(v) the court is not clear as to how assiduously this is maintained but the defendant contends that a separate affidavit would have to be sworn for each company (and so separate individuals) within the affected companies. This problem seems more imagined than real: if the number of affected companies is small, then the number of affidavits required will be small; and it is difficult to believe that there will be no overlap of personnel among the various companies, further reducing the demands arising.

## **Part 7**

### **Principles Applicable to Discovery Generally**

56. Aside from the matters considered above, there is no dispute between the parties as to the well-settled principles of discovery that fall to be applied by the court when determining which categories or elements of the categories of discovery sought in their respective discovery applications, the court ought to order. The key principles applicable have been succinctly re-stated by the Court of Appeal in its recent judgment in *BAM PPP PGM Infrastructure Cooperatie UA v. National Treasury Management Agency & Anor* [2015] IECA 246, at para.29, viz:

- "1. The primary test is whether the 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.*
- 2. Relevance is determined by reference to the pleadings. O.31, r.12 specifies discovery of documents relating to any matter in question in the case*
- 3. There is nothing in the Peruvian Guano test which is intended to qualify the principle that documents sought on discovery must be relevant, directly or indirectly, to the matter in issue between the parties on the proceedings.*
- 4. An application for discovery must show it is reasonable for the court to suppose that the documents contain relevant information.*
- 5. An applicant is not entitled to discovery based on speculation.*
- 6. In certain circumstances a too wide ranging order for discovery may be an obstacle to the fair disposal of proceedings rather than the converse.*
- 7. As Fennelly J. pointed out in Ryanair plc v. Aer Riantacpt [2003] 4 I.R. 264, the crucial question is whether discovery is necessary for 'disposing fairly of the cause or matter.'*
- 8. 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 trial.*
- 9. Discovery could become oppressive and the court should not allow it to be used as a tactic in war between parties."*

## **Part 8**

### **Categories of Discovery Sought By the Plaintiffs**

#### **A. General.**

57. Each of the categories of discovery sought by the plaintiffs in their notice of motion is identified below and the court's conclusions identified immediately thereafter. In each instance where discovery is ordered it is because the court considers such documentation as will be ordered to be discovered satisfies the tests of relevance, necessity and proportionality; further comment is occasionally added below but should be read as supplementary to the foregoing.

#### **B. Category I.**

58. The court refers to Category I, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents relating to the design, labelling, branding, advertising and/or marketing of the AirFluSal Inhaler in the colour purple (including, in particular, but without limitation, pantone code 2573C). Without prejudice to the generality of the foregoing, this category includes all documents (a) relating to the reason(s) why the colour purple (including, in particular, but without limitation, pantone code 2573C) was chosen for use in connection with the AirFluSal Inhaler; and/or (b) relating to the design brief(s) for the AirFluSal Inhaler, its packaging and promotional materials for Ireland; and/or (c) which touch upon or make reference to the colour of other inhalers on the market including but not limited to the Seretide Inhaler."*

59. The court will order discovery of: all documents relating to the design, labelling, branding, advertising and/or marketing of the AirFluSal Inhaler in the colour purple (including in particular, but without limitation, pantone code 2573C). Without prejudice to the generality of the foregoing, this category includes all documents (a) relating to the reason(s) why the colour purple (including, in particular, but without limitation, pantone code 2573C) was chosen for use in connection with the AirFluSal Inhaler and/or (b) relating to the design brief(s) for the AirFluSal Inhaler, its packaging and promotional materials for Ireland.

60. Counsel for Rowex contended that the wording "design brief(s)" should be changed to "colour brief(s)". However, although the general emphasis throughout the statement of claim is on colour, there is reference in the statement of claim, at para.17 to "get up" and thus it seems to the court that the reference to "design brief(s)" seeks documentation that is relevant and necessary and not disproportionate in scale. The court has, however, deleted sub-category (c) as it appears irrelevant to a case in which the objection is to Rowex's selection of the colour purple, not about what other parties put on their inhalers.



### **C. Category II(a).**

61. The court refers to Category II, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents created since January 2006 (a) concerning the launch of the AirFluSal Inhaler and/or its design, packaging and/or marketing materials that contain any reference to the words 'Seretide', 'Advair', 'Viani', and/or 'purple inhaler' and/or".*

62. The court will order the discovery sought, subject to the replacement of "and/or" with "and". Otherwise it appears that an abundance of entirely irrelevant material will be unearthed; the variation will better ensure that relevant documentation is produced; or at least that less irrelevant documentation is produced.

### **D. Category II(b).**

63. The court refers to Category II, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents created since January 2006 (b) exchanged as between (I) the Defendant and any entity(ies) within the Sandoz Group (including without limitation Aeropharm GmbH); (II) any entity(ies) within the Sandoz Group (including without limitation Aeropharm GmbH) and any other entity(ies) within the Sandoz Group (including without limitation Aeropharm GmbH); (III) the Defendant and Vectura Group plc or any other entity(ies) involved in the design of the AirFluSal Inhaler; and/or (IV) any entity(ies) within the Sandoz Group (including without limitation Aeropharm GmbH) and Vectura Group plc or any other entity(ies) involved in the design of the AirFluSal Inhaler, concerning a) the choice to use the colour purple (including, in particular, but without limitation, pantone Code 2573C) on the AirFluSal Inhaler, its packaging and promotional materials; b) the change of colour of the GyroHaler (as originally designed by Vectura Group plc referred to in the exhibit "2JG2" referred to in the affidavit of Joanne Greene sworn on 27th April, 2015 and all phases of development of this GyroHaler are included in this category) from green to purple; and/or c) any alternative colour/designs considered for the AirFluSal Inhaler;"*

64. The court will order the discovery sought, save that (III) shall be limited to the Defendant and Vectura Group plc, and (IV) shall be limited any entity(ies) within the Sandoz Group (including without limitation Aeropharm GmbH and Vectura Group plc). Rowex has already identified that these are the entities centrally involved and it seems to the court to be entirely burdensome to add the other entities referred to above without good reason for so doing – and it does not appear that there is any. Counsel for Rowex objected, inter alia, to the inclusion of the word "designs". Although the general emphasis throughout the statement of claim is on colour, there is reference in the statement of claim, at para.17 to "get up" and thus it seems to the court that the reference to "designs" ought therefore to remain.

### **E. Category II(c).**

65. The court refers to Category II, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents created since January 2006 (c) exchanged as between (I) the Defendant and the relevant regulatory authority in Sweden and/or Ireland regarding the colour of the AirFluSal Inhaler; and/or (II) any entity(ies) within the Sandoz Group (including without limitation Aeropharm GmbH) and the relevant regulatory authority in Sweden and/or Ireland regarding the colour of the AirFluSal Inhaler; and/or (III) all documentation exchanged as between the Defendant and/or any entity within the Sandoz Group (including without limitation Aeropharm GmbH) and the relevant regulatory authority in the United Kingdom concerning the reason(s) why the AirFluSal Inhaler is to be licensed in the UK (i) only for Chronic Obstructive Pulmonary Disease (COPD) and not asthma, (ii) only for the higher dose and (iii) only for use in adults and/or the circumstances in which such restriction came to pass; and/or (IV) all documentation exchanged as between the Defendant and/or any entity within the Sandoz Group (including without limitation Aeropharm GmbH) and the relevant regulatory authority in Germany concerning the reason(s) why the AirFluSal Inhaler is licensed in Germany only for higher dosages in the treatment of asthma and/or the circumstances in which such restriction came to pass; and/or"*

66. This category of discovery is refused. The market authorisation/regulatory approval process in foreign jurisdictions is not relevant to the issues at hand. The function of regulators in this regard is patient safety, which is not an issue in these proceedings, and not intellectual property rights, which are at issue in these proceedings. Consequently, this entire category is not relevant.

### **F. Category II(d).**

67. This category of discovery has been agreed between the parties.

### **G. Category III.**

68. The court refers to Category III, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents relating to or evidencing any assessments, opinions, investigations or discussions (including but not limited to those of third parties) regarding the colour purple being distinctive of GSK or the Seretide Inhaler within the field of inhalers, including but not limited to documents referring to the colour purple being central or important to the brand identity of the Plaintiff's Seretide Inhaler, limited to documents (a) relating to market research, focus group reports/notes, consumer research and surveys conducted in respect of healthcare professionals (including without limitation doctors, nurses and pharmacists) in relation to the 'get-up' and colour of the AirFluSal Inhaler and/or the Seretide Inhaler, and/or either of their packaging and marketing materials; (b) relating to market research, focus group reports/notes, consumer research and surveys conducted in respect of consumers and/or patients and/or their families in relation to the 'get-up' and colour of the AirFluSal Inhaler and/or the Seretide Inhaler; and/or either of their packaging and marketing materials; and/or (c) relating to the discussions/thinking and correspondence, whether internal or otherwise concerning the 'get-up' and colour of the AirFluSal Inhaler, and/or either their packaging and marketing materials and/or the change of colour of the GyroHaler from green to purple of the Defendant's and/or any entity(ies) within the Sandoz Group (including without limitation Aeropharm GmbH) and/or Vectura Group plc and/or any other entity(ies) involved in the design of the AirFluSal Inhaler and/or between the Defendant and/or any entities within the Sandoz Group (including without limitation Aeropharm GmbH) and/or Celon or Cipla."*

69. The court will order discovery of all the documentation sought.

70. There was some dispute between the parties regarding category (c). It appears that, so far as the plaintiffs are concerned, the desire for the documentation referred to in sub-category (c) is prompted by a belief that there was historical engagement, e.g., between Rowex and Celon and/or Ciplawhich yielded a collusive effort to create the mirage that there is or has been a colour code for inhalers. Counsel for Rowex contended in this respect that because a recent decision of the Norwegian courts (the latest court decision in the ongoing international Seretide-Airflusal 'war' between Glaxo and Rowex, of which the present Irish 'battle' is but part) did not suggest there to be any such historical engagement, sub-category (c) ought to be varied. The court has every regard for decisions of the Norwegian courts and is mindful of that comity of purpose which exists between the courts of this jurisdiction and those of our sister nations in Europe and further afield. Even so, the court would respectfully note that a decision of the Norwegian courts is not in any way dispositive of the issues arising in these proceedings. Nor does the fact that such a court did not find a particular set of facts to pertain a matter that the court considers to bear on its reasoning and conclusion as to whether a particular category of documentation meets the standard of relevance, necessity and proportionality by reference to the pleadings before it – and the court is satisfied that in a case, where colour is at the very heart of matters, these tests are satisfied.

71. For the avoidance of doubt, lest the parties think that it has gone missed, neither is the court satisfied to amend the final "and/or" before "(c)" to "and", as was sought by Rowex. To make this amendment would be to narrow the category of discovery in a wholly unrealistic manner.

#### **H. Categories IV and V.**

72. These categories of discovery have been agreed between the parties.

#### **I. Category VI.**

73. The court refers to Category VI, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents relating to or evidencing any assessments, opinions, investigations or discussions by or on behalf of the Defendant and/or any entity(ies) within the Sandoz Group (including without limitation Aeropharm GmbH) and/or Vectura Group plc and/or any other entity(ies) involved in the design of the AirFluSal Inhaler, in respect of the validity of the CTM, including without limitation the timing of a challenge to the validity of the CTM."*

74. Counsel for the plaintiffs indicated at the hearings that they "didn't seek [via this category of discovery] to get documents from attorneys or lawyers or experts", an assurance which allays concerns that this category would otherwise have prompted on the part of the court. The court will therefore order discovery of this category, save that the words "including...CTM" shall be excluded as entirely irrelevant: Rowex is entitled to challenge the trade mark, such a challenge is, to borrow a colloquialism, a 'bog standard' claim in the context of proceedings such as those now presenting, and it is irrelevant to these proceedings what happened in another jurisdiction in the context of the timing of a challenge there to the EUTM.

#### **J. Category VII.**

75. The court refers to Category VII, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents relating to any strategy or intention by or on behalf of the defendant to design, label, brand, advertise and/or market the AirFluSal Inhaler so as to cause an association in the minds of health care professionals' and patients' (and/or their families) between it and the Seretide Inhaler. Without prejudice to the generality of the foregoing, this category includes all documents relating to any approach/strategy by the Defendant as to labelling, branding, advertising and/or marketing of its generic and/or hybrid products in 'get up' that is similar to that of the originator brand."*

76. At the hearing of the within applications, counsel for the plaintiffs indicated that they (the plaintiffs) were satisfied not to persist with the "Without prejudice..." limb of the above-quoted text.

77. The court is satisfied to order the discovery sought, subject to the deletion of the "Without prejudice..." limb and the substitution therefor of the text "The foregoing is subject to the caveat that any documents which merely state or provide that AirFluSal is a competing product to Seretide are not to be interpreted as causing an association and hence do not fall within this category." This caveat is necessary because Rowex, in the ordinary conduct of its business, will likely have any number of innocuous documents that make the bland reference stated and which need to be excluded if the tests of relevance, necessity and proportionality are to be satisfied.

78. The court notes in passing that a similar point was made in respect of this category, as is referred to elsewhere above, concerning the relevance of "design". Again, while the general emphasis throughout the statement of claim is on colour, there is reference in the statement of claim, at para.17, to "get up", and thus it seems to the court that the reference to "design" ought to remain.

### **Part 9**

#### **The Categories of Discovery Sought By the Defendant**

##### **A. General.**

79. Each of the categories of discovery sought by Rowex in its notice of motion is identified below and the court's conclusions identified immediately thereafter. In each instance where discovery is ordered it is because the court considers such documentation as is being sought to be relevant and necessary and to satisfy the test of proportionality. Where necessary further comment is added.

##### **B. Category 1.**

80. The court refers to Category 1, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents evidencing or otherwise relating to the devising of the name Seretide and the selection of the colour purple for use on and in relation to Seretide (including but not limited to the selection of different shades of purple for different dosages of Seretide)."*

81. The "(including...Seretide)" text is now agreed. Clearly the colour purple as a whole, not just the specific pantones used, is in issue, with the plaintiffs asserting an effective monopoly in the colour purple. The devising of the name 'Seretide' is not an issue on

the pleadings so that limb of the category must be excised. To order the category as sought would offend the principle of proportionality; as proposed by counsel for Rowex at the hearings, the court will limit the category to documentation up to end-1998, the year of launch. On a related note, the plaintiffs have done a preliminary scoping exercise which suggests that for the court not to impose a geographical limit on this category of discovery could result in a cost to the plaintiffs of millions of euro and potentially end the litigation. Discovery is supposed to be a crutch that aids in determining the truth, not a crucifix on which efforts to arrive at the truth die a death. Given that this Court is functioning as an EUTM court, and that the focus of the proceedings is Ireland and the European Union (it cannot be treated as just a fight in Ireland because a right has been invoked that extends beyond Ireland), the court will order the discovery of all documents created in any of the member states of what is now the European Union on or prior to 31st December, 1998, and evidencing or otherwise relating to the selection of the colour purple for use on and in relation to Seretide (including but not limited to the selection of different shades of purple for different dosages of Seretide).

### **C. Category 2.**

82. The court refers to Category 2, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"One colour sample of each item of advertising, marketing and promotional material utilised anywhere in the world in respect of Seretide during the period commencing one year prior to the launch in Sweden in 1998 and one year following that launch."*

83. Although the plaintiffs make reference in their statement of claim to the fact that Seretide has built up a reputation globally, the focus of this case (before what is an EUTM court) is Ireland and the European Union. The court will therefore order the discovery sought save that it will substitute "utilised anywhere in the European Union" for "utilised anywhere in the world". The temporal limit contained in the category as ordered further satisfies the test of proportionality.

### **D. Category 3**

84. The court refers to Category 3, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"One colour copy sample of each item of advertising, marketing and promotional material utilised in Ireland in respect of Seretide since its launch in 1999."*

85. As passing off for the entire period since 1999 is claimed, the court will order the discovery sought.

### **E. Category 4.**

86. The court refers to Category 4, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"One colour copy sample of each item of Seretide advertising, marketing and promotional material provided to doctors and pharmacists in which the colour purple has taken a central role."*

87. This category of discovery is so generally phrased as to be almost certainly unworkable in practice: how is one to decide whether the colour purple has taken "a central role"? In respect of Ireland, this category appears to be covered in any event by the more focused terminology of Category 3 and there is overlap with Category 2 also. Given that the scope of the proceedings is Ireland and the European Union, the court will, to satisfy the tests of relevance, necessity and the need for proportionality, and mindful of the discovery ordered in respect of Category 3, order discovery of one colour copy sample of each item of advertising, marketing and promotional material utilised in respect of Seretide during and/or since 1999 in any state that is now a member state of the European Union, other than Ireland.

### **F. Category 5.**

88. The court refers to Category 5, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents, relating to the Irish market, recording the comments of healthcare professionals and patients evidencing or otherwise relating to the Seretide Inhaler being referred to as the 'purple inhaler'."*

89. This material appears, in truth, inextricably linked to the substance of the within proceedings, most especially as regards the issue of goodwill. The court will order the discovery sought. The court notes in passing that an assurance, sought by Rowex, that the plaintiffs will rely only on evidence relating to the Irish market in this regard, and not elsewhere, has been provided.

### **G. Category 7.**

90. The court refers to Category 7, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents which concern or refer to instances of confusion or association between the CTM/the Seretide Inhaler and the AirFluSal Inhaler (including but not limited to attempts on the part of the Plaintiffs to identify such instances)."*

91. Instances of confusion or association are clearly relevant to the question of whether or not there has been infringement. However, as worded, this category of discovery appears to impose a disproportionate, if not unworkable level of discovery. To satisfy the need for proportionality and better ensure relevance, the court will order discovery of all documents which concern or refer to instances of confusion or association between the CTM/the Seretide Inhaler and the AirFluSal Inhaler in every state that is now a member state of the European Union in which the AirFluSal Inhaler has been sold which were reported to sales representatives or which came to the attention of the Plaintiffs' respiratory management staff in that period. No temporal limit is necessary as the category is effectively self-limiting by reference to when AirFlusal went on the market in particular jurisdictions.

### **H. Category 8.**

92. The court refers to Category 8, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents which concern or refer to assessments that there is little or no likelihood of confusion or association between the CTM/the Seretide Inhaler and the AirFlusal Inhaler."*

93. This category of discovery is refused. It seems hopelessly burdensome, being subjective in nature and without temporal or geographical limitation. In truth, the court is not satisfied that this category of documentation would be susceptible to any proper form of search in practice. In any event, it appears to the court that any material to be discovered under Category 8 would be caught by the refined version of Category 7.

#### **I. Category 9.**

94. The court refers to Category 9, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents which concern or refer to instances of detriment to the alleged distinctive character and reputation of the CTM caused by the Airflusal Inhaler (including but not limited to attempts on the part of the Plaintiffs to identify such instances)".*

95. The court understands from the hearings that Rowex would be satisfied for the court to order discovery of all documents which refer to the alleged inferior design and/or alleged inferior efficacy of the AirFluSal Inhaler made by third party healthcare professionals and patients in Ireland, Germany, Denmark, Sweden, the Netherlands, Estonia, Latvia, Portugal, Austria, Bulgaria, the Czech Republic, Croatia and Norway, including but not limited to attempts on the part of the Plaintiffs to identify such instances. As the court is functioning as an EUTM court, as the focus of the proceedings is Ireland and the European Union, and as the parties have already completed the Norwegian limb of their global fray, the court will excise Norway from the list of countries named and include the United Kingdom (which the court understands was omitted in error from the list of countries placed before the court). To satisfy the need for proportionality and better ensure relevance, the court will also delete the "(including..." limb of this category of discovery. The court will therefore order discovery of all documents which refer to the alleged inferior design and/or alleged inferior efficacy of the AirFluSal Inhaler made by third party healthcare professionals and patients in Ireland, Germany, Denmark, Sweden, the Netherlands, Estonia, Latvia, Portugal, Austria, Bulgaria, Czechia, Croatia and the United Kingdom. The court notes in passing that the plaintiffs have confirmed that when it comes to showing alleged detriment to the distinctive character of the EUTM, they intend to rely solely on those documents they are discovering and which refer to the alleged inferior design and/or alleged inferior efficacy of the AirFluSal Inhaler made by third party healthcare professionals and patients in the countries to the countries just mentioned.

#### **J. Category 12.**

96. The court refers to Category 12, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents which concern or refer to the issue of validity of the CTM which have been shown to, provided to, sent to or received from any expert, consultant or in-house counsel and/or trade mark attorney and/or lawyer who are or were retained by the Plaintiffs in respect of such issue".*

97. Exception was taken by the plaintiffs to this category on the basis that the documentation involved would be "manifestly privileged". There seems to be little question that the material is relevant and necessary (which it is). Moreover, even if some of the documentation is privileged (and the court does not accept that all of this category of documentation would necessarily be privileged), even the listing of the documentation in the privilege section of the affidavit of discovery may afford a basis for a particular line of cross-examination. The court will order this category of documentation as sought.

#### **K. Category 14.**

98. The court refers to Category 14, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents which concern or refer to the use of colours (including but not limited to codes – whether ad hoc or otherwise – pertaining to the use of colours) to indicate the type and purpose of the active ingredients within an inhaler regardless of the identity of the manufacturer."*

99. The court considers that a geographical limit is required to ensure proportionality. The focus of these proceedings is Ireland and the European Union; that gives the basis for a geographical limit. The court will therefore order the discovery sought, save that to satisfy the need for proportionality it will limit this to documents created or used in any state that is now a member state of the European Union. The court understands, and the parties should read its order in this regard, to embrace the use of colour on an inhaler and/or on packaging.

#### **L. Category 15.**

100. The court refers to Category 15, as identified in the notice of motion and also in the submissions handed into court during the hearings indicating what further agreement had been reached between the parties. Discovery is sought of:

*"All documents containing or evidencing consideration given by the Plaintiffs to the adoption or alteration of colouring on an inhaler and/or its packaging, or decisions regarding such adoption or alteration, referable to the type and purpose of the active ingredients within an inhaler".*

101. This category of discovery is refused. It appears to the court that the documentation sought is caught by the refined version of Category 14 due to be ordered.

### **Part 10**

#### **Conclusion**

102. The court will order such discovery as it has identified above. In the case of Rowex, such order of discovery shall come subject to the caveat identified in para.54 above.