

**BETWEEN****RANBAXY LABORATORIES LIMITED, RANBAXY EUROPE LIMITED AND RANBAXY IRELAND LIMITED****PLAINTIFFS****AND  
WARNER-LAMBERT COMPANY****DEFENDANT****Judgment of O'Sullivan J. delivered the 8th June, 2005****Introduction**

1. The plaintiffs claim a declaration that a product to be manufactured by them does not infringe the defendant's Irish patent (No. 6014) which protects a product known as LIPITOR and is the world's most widely prescribed drug reducing the level of bad cholesterol in the blood.

2. The defendant's Irish patent has a number of corresponding foreign patents, namely, a US patent ("the 893 patent"), a European patent and a Danish patent. A further US patent ("the 995 patent") is claimed by the defendant to cover LIPITOR but is the subject of a claim of invalidity in that country. A further patent in the U.K. corresponding to the 995 patent is also the subject of an invalidity claim and an Irish patent corresponding to the 995 patent is the subject of challenge and revocation proceedings are to be commenced here.

**The proceedings**

3. These proceedings commenced by plenary summons dated 2nd September, 2004, and by order of 8th September, they were entered in the commercial list.

4. In the statement of claim the plaintiffs allege that the defendant's Irish patent covers only certain (50/50) mixtures of the relevant chemical compounds. This is contested in the defence which asserts protection for a wider range of mixtures. In reply the plaintiffs refer to a number of communications made by the defendant including with the United States patent and trade marks office, the European patent office, the Danish patent office and to averments made by the defendant's own employees in patent litigation in the United States where the language used supports the plaintiff's interpretation of the scope of the Irish patent. In a rejoinder to that reply the defendant pleads that those latter matters are not relevant to the issues before the court and in particular not relevant to the correct construction of the Irish patent and are inadmissible in the present proceedings.

5. The plaintiffs submitted a request for voluntary discovery (as did the defendant) which was rejected by the defendant on the ground that the documents sought were irrelevant to the sole issue before the Irish court which, they agreed was "...the interpretation of the patent and the scope of the claims...".

6. The dispute on discovery came before Finlay Geoghegan J. on 8th April, 2005 when she made an order that an issue be tried as to whether the matters set out at para. 7 of the reply or other evidence of a similar type is admissible in evidence in these proceedings. The learned judge also made an order that the plaintiffs write a further letter setting out their request for discovery.

7. I understand that the second of those orders referred to the fact that when the matter was debated before Finlay Geoghegan J. a point was made on behalf of the defendant that the then current plaintiffs' request for discovery gave as a typical reason for requesting the documents sought that the sole issue in the case had been the subject of representations (recorded in the documents sought) by the patentee on that very issue, but that in the course of argument the plaintiffs sought to rely, in addition, on the principle that the documents sought might put them on a legitimate train of enquiry and also upon the principle that the documents contained admissions against interest made by the defendant. Because these latter two grounds were not included in the first request I understand an order was made directing a further request and this was made on 22nd April, 2005 and is the request for discovery under consideration in this judgment. The reasons now relied on do contain reference both to admissions or statements against interest and also reference to the train of inquiry principle.

8. Before proceeding to describe more closely the factual (stereochemical) context in which the revised request for discovery is made I should make it clear what this judgment does and more particularly what it does not do. In it I am dealing only with the question of admissibility of the documents sought by the plaintiff and not with other issues, such as necessity, which will arise when the full question of discovery will be dealt with.

**Factual context**

9. In an affidavit sworn by Patricia McGovern, solicitor on behalf of the plaintiffs, the factual background is set out, the deponent having taken her client's instructions and having been informed that the account is accurate. This contention was not challenged in the hearing before me. The following is her description:-

"Stereochemistry is an important subfield in the broader field of chemistry, which focuses on the three dimensional structure of organic molecules in space. An Isomer is one of several species, or molecular entities, that have the same atomic composition (molecular formula) but different stereochemical formulae and hence different physical and/or chemical properties. Stereoisomers are compounds that have the same atoms and the same connectivity pattern of the atoms or groups of atoms, but are different in the way the atoms or group of atoms are arranged in three-dimensional space. An asymmetric or chiral centre is an atom, such as a carbon atom, which has four distinct groups bounded to it...

One asymmetric centre in a molecule gives rise to two possible enantiomers. Enantiomers are stereoisomers that are non super-imposable mirror images of each other. Enantiomers have identical physical properties, including solubilities and melting points, with the exception of their interactions with chiral matter and plane-polarised light. A racemate is a one to one mixture of two enantiomers, such that it contains 50% of one enantiomer and 50% of its opposite enantiomer. Racemates and enantiomers are distinct compounds and, in general, have different physical properties, such as solubilities and melting points. Optical activity is the ability of a compound to rotate plane-polarised light. A pure enantiomer rotates plane-polarised light in only one direction to the maximal amount permitted by that molecule. An unequal mixture of two opposite enantiomers is optically active and the degree of optical rotation will reflect the percentage of each enantiomer present in the mixture.

In a racemate, which is an equal mixture of two opposite enantiomers, the optical rotations of the enantiomers cancel each other out and the compound is not optically active.

There are a set of rules that are accepted by chemists for naming and describing racemates and enantiomers. In a molecule containing one asymmetric centre, one enantiomer is designated the R-enantiomer, and its opposite enantiomer is designated the S-enantiomer. Because a racemate contains equal amounts of the R and S-enantiomers, the racemate is designated the R S structure.

There are other accepted ways by which chemists designate racemates and enantiomers. Single enantiomers are optically active compounds in that they rotate plane-polarised light in either the clockwise or the counter clockwise direction. The clockwise direction is designated using a "plus" symbol and the counter clockwise direction is designated using a "minus" symbol. Chemists frequently refer to an enantiomer based on the direction of the rotation plane-polarised light. Because a racemate is not optically active, chemists indicate a racemate using a "±" designation. The use of the stereodescriptors "R", "S", "+", or "-" in a chemical name or in connection with a chemical structure unambiguously designates the compound as an enantiomer. The use of these symbols were common conventions in May, 1986, when the US patent (namely US patent No. 4,681,893, known as the "893 Patent") corresponding to the Patent was filed.

The "R" and "S" nomenclature describe absolute stereochemistry. The common way to indicate the absolute stereochemistry of a chiral centre in a molecule is to place a stereodescriptor below the chiral centre in the structure. The use of the stereodescriptor "±" in a chemical name or in connection with a chemical structure unambiguously designates the compound as a racemate, and the use of the stereodescriptor "±" was a common convention in May, 1986.

In chemical nomenclature, "trans" is used to define the relationship of two groups to one another and indicates that two substituents are at opposite sides of a plane in a chemical structure. In chemical nomenclature, "cis" is used to define the relationship of two groups to one another and indicates that two substituents are on the same side of a plane in a chemical structure. The "cis" and "trans" nomenclature describes relative stereochemistry. When a compound has two asymmetric carbon atoms in a ring structure, there is a possibility of four isomers; R-trans, S-trans,

R-cis and S-cis. Typically, when a compound synthetically in a laboratory, it is made as a racemate, unless one intentionally applies a chiral synthesis. When a chemist synthesises an organic compounds that has two asymmetric centres, unless the chemist selects very specialised techniques, the method will produce a mixture of two racemates. When introducing a chiral centre into a compound, if one uses a-chiral starting material and reactants, one will produce only a racemic compound. Historically most pharmaceutically active compounds made through the early 1990's were made as racemates. In the last decade there has been a focus in synthetic organic chemistry to develop methodology to make single, pure enantiomers at large scale which are commercially viable. Isolating the enantiomers from a racemate is known as "a resolution". In May, 1986, it was a common convention to represent a racemate by depicting one of its constituent enantiomers."

10. Having digested the foregoing I found it useful to adopt the following conceptual shorthand suggested by Mr. Collins.

11. Where the patent description uses the description TRANS there is an issue between the sides as to what it means. Does it mean the racemate (i.e. the equivalent of "TRANS ±") as contended for by the plaintiff, or does it mean all enantiomers and combinations of the enantiomers (i.e. TRANS +; TRANS - ; and TRANS ±) as contended for by the defendant? This is an issue of conventional nomenclature – and will arise against a background of an increasing interest in the individual enantiomer variations during the lifetime of the patent. The documents sought will it is claimed show that in circumstances sufficiently similar to the present ones the defendants used the word "TRANS" to mean only the racemate, that is "TRANS ±" and explicitly disavowed the further meanings now contended for and the documents are as such admissible as relevant to the issue before the court.

12. Ms. McGovern's affidavit went on to state that the defendant's drug (LIPITOR) consists of a single enantiomer, the compound atorvastatin. The deponent then referred to the plaintiffs' intention also to market a drug for the treatment of cholesterol which will consist of a single compound which is atorvastatin. In these proceedings the plaintiff claims that the defendant's patent protects only racemic mixtures as distinct from single enantiomers. The plaintiffs' product, atorvastatin calcium, comprises the single optically pure enantiomer, atorvastatin, and hence it is claimed does not infringe the defendant's patent which protects, it is claimed, only racemates and processes that produce racemates. The defendant on the other had asserts that the patent protects enantiomers and the racemate and the mixtures of those enantiomers. The plaintiffs in the present context assert that this latter contention made by the defendant (that their patent covers enantiomers and not just racemates) runs counter to representations made by the defendant, its servants or agents over a number of years to the effect that the foreign patents which correspond to the Irish patent were limited to the racemate. Accordingly the plaintiff contends that the documents containing those representations are now relevant to the sole issue before the court which is the construction of the Irish patent and are admissible and should be discovered.

#### **The documents sought**

13. The documents sought comprise all documentation passing to and from the European patent office relating to the scope of the patent, the same in relation to the Danish patent office and any other Danish patent or regulatory authority relating to the scope of the patent and any extension thereof; the same in relation to the US patent office and any other US patent or regulatory authority including relating to the scope of the patent and extension thereof and, further, all documentation relevant to the scope of the US patent put in evidence in proceedings in the US concerning that patent including all depositions relevant to the interpretation and scope of that patent. A further class of documents sought is all documentation relating to the construction of, or interpretation by the patentee of the scope of the patent including all internal memoranda and minutes.

14. The order of Finlay Geoghegan J. identifying the issue which I am now trying refers to whether the documents set out at para. 7 of the reply or other evidence of a similar type are admissible in evidence in these proceedings. At para. 7 of the reply there is in addition to references to the categories of documents already mentioned reference (para. (d)) to the defendant's own employees, agents and or executives having consistently referred to the corresponding US patent as "the racemate patent" and having consistently recognised that patents corresponding to the patents in suit are confined to the racemate and do not include a claim in respect of the individual enantiomer. In light of that paragraph included in para. 7 of the reply I consider that the last mentioned class of documents relating to the construction of, or interpretation by the patentee of the scope of the patent including all internal memoranda and minutes is also a class which falls to be considered by me in this judgment which deals exclusively as to whether such documents are admissible in evidence.

#### **The statutory background**

15. Section 45 of the Patents Act, 1992 provides where relevant as follows:-

"45(1) The extent of the protection conferred by a patent or a patent application shall be determined by the terms of the claims; nevertheless, the description and drawings shall be used to interpret the claims.

... (3) In the interpretation of this section, the Court shall have regard to the directions contained in the Protocol on the interpretation of Article 69 1(a) of the European Patent Convention and set out in the *Second Schedule* to this Act.

The *Second Schedule* provides as follows:

'Section 45 should not be interpreted in the sense that the extent of the protection conferred by a patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and the drawings by a person skilled in the art, the patentee has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties'."

16. As I will be referring to UK jurisprudence it is relevant to note that Article 69 of the European Patent Convention was introduced into the UK by the Patent Act, 1977 in that country. Accordingly, since that time the statutory context in that country can be taken for present purposes as the same as it is in this.

### **Construction of a Patent by the Court**

17. I will set out first the classic statement of the status of a patent claim in U.K. (and I believe Irish) law by Lord Russell of Killowen in *Electric Musical Industries v. Lisen Limited* [1938] 4 AER 221 at 224 as follows:

"The function of the claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers. Their primary object is to limit, and not to extend, the monopoly. What is not claimed is disclaimed. The claims must undoubtedly be read as part of the entire document, and not as a separate document. Nevertheless, the forbidden field must be found in the language of the claims, and not elsewhere."

18. I do not intend to set out the general principles of construction of a patent claim by the court. These will readily be found in any of the standard text books. I confine myself to referring to two principles of construction which are immediately relevant to the present application and which I do not understand to be in controversy between the parties. They are as follows:-

(a) Construction is a question of law for the judge: accordingly evidence as to what a patent means is inadmissible and in particular evidence as to what the inventor or patentee (or his representatives) intended it to mean is inadmissible.

Support for the above could be found in any one of a dozen authorities. The following passage from the judgment of Staughton L.J. in *Glaverbel S.A. v. British Coal Corporation and Anor* [1995] RPC 225 at p. 268 is one of them:-

"The interpretation of a patent, as of any other written document, is a question of law. That does not mean that the answer to it will necessarily be found in our law books. It means that it is for the judge rather than the jury to decide, and that evidence of what the patent means is not admissible. In particular, evidence of the patentee as to what he intended it to mean should not be admitted, nor indirect evidence which is said to point to his intention. Compare the rule that the parties to a deed or contract cannot give evidence of what they intended it to mean."

(b) Evidence will be received from witnesses "skilled in the art" concerned. In *Cathick v. Hill and Smith* [1982] RPC 183 at 242 FF Lord Diplock said that a patent specification is "addressed to those likely to have a practical interest in the subject matter of his invention (i.e. 'skilled in the art')", being persons "with practical knowledge and experience of the kind of work in which the invention was intended to be used".

Aldous L.J. in *Lubrizol v. Esso Petroleum* [1998] RPC 727 at 738 put it this way:-

"Patent specifications are intended to be read by persons skilled in the relevant art, but their construction is for the court. Thus the court must adopt the mantle of the notional skilled addressee and determine, from the language used, what the notional skilled addressee would understand to be the ambit of the claim. To do that it is often necessary for the court to be informed as to the meaning of technical words and phrases and what was, at the relevant time, the common general knowledge; the knowledge that the notional skilled man would have."

### **The submissions in outline**

19. Mr. Collins S.C. relied on the latter of the above two principles on behalf of the plaintiff. He submitted that the documents sought indicated what persons "skilled in the art" understood the patent or patents sufficiently comparable to mean. The fact that they may have been made by representatives of the patentee and have arisen in the context of prosecuting or litigating those patents does not have the effect of causing them to become inadmissible if they are admissible in principle. Mr. Collins submits that they are so admissible. They are in fact highly relevant and admissible because they show what persons skilled in the art understood the claims and specifications to mean in a non-contentious context and are therefore clearly likely to be of great materiality to the court when it adopts the mantle of the notional skilled addressee and determines what such an addressee would understand to be the ambit of the claims. They are particularly relevant if they can assist the plaintiff in showing a conflict between what the defendant contends is the meaning of the Irish patent now and what was contended on its behalf in earlier non contentious settings in respect of the same or sufficiently similar claims and descriptions.

20. A second, subsidiary point, is that these representations can be seen as made against interest in that, Mr. Collins contends, the defendant now seeks to resile from them because it is not in his interest to accept them in the present case.

21. Mr. O'Donnell S.C. on behalf of the defendant submits that the proper description of the documents now sought is that they

express the thoughts and interpretation of the patentee or representatives of the patentee as to the meaning of the patent and as such are clearly inadmissible and irrelevant to the sole issue (of construction) before the court. Furthermore he insists that the scope of documentation sought is extremely – indeed innovatively – wide and if the plaintiff's application is to succeed the result will be a vast expansion of the range of discovery in these cases. In fact he goes further: he says that if such documentation, which is necessarily less precise than the documentation claiming and describing the patent itself is introduced to explain what the latter would have conveyed to a skilled addressee, then the court will necessarily have to embark on a second quest attempting to identify the meaning of those, secondary and less precise representations made in a different context and in different countries and with diminishing returns for increased labour. With Lord Hoffman in *Kirin-Amgen* he says "life is too short".

22. In regard to the subsidiary point that these representations were made against interest and are therefore admissible, Mr. O'Donnell S.C. submits that that principle, itself an exception to the hearsay rule, simply has no application to the present case.

### The authorities

23. In the course of his submissions in reply Mr. Collins said that the principal issue before me comes down to one point, namely, what is the limiting principle by which the relevant evidence of the skilled addressees referred to in the sought for documentation can be ruled inadmissible. The main case he relies on is *Rohm and Haas Co. v. Collag Ltd.* decided in the Court of Appeal on 29th October, 2001 and reported at 2002 FSR 28 at p. 445. It appears that the precise point had not arisen before.

24. This was a case where the patent was unclear as to its inventive purpose. In response to official observations made by the European Patent Office during the prosecution of the patent application, the claimant had carried out certain experiments and informed the patent office by letter of the results of those experiments which information was addressed to the apparent lack of clarity. That letter was attached to the outside of the file, and was accessible to the public. It did not, however, form part of the wording used in the claims or part of the description or drawings. Nonetheless the Court of Appeal held that had it been necessary for the judge to take account of the latter in order to resolve the issue of construction he would have been entitled so to do.

25. In the course of his judgment Robert Walker L.J. noted that there seemed to be no clear English authority on the point even at first instance. Further that Jacob J. in *Bristol-Myers Squibb Co. v. Baker Norton Inc.* [1999] RPC 253 had given a useful summary of the problems associated with taking account of what he called the prosecution history – that is, the vicissitudes of an application file's progress through the official system – as an aid to construction of the final specification. However, he had not decided the point. Then Robert Walker L.J. went on:-

"This court was shown a decision of the Supreme Court of the Netherlands, *Ciba-Geigy v. Oté Optics* (January 13th, 1995) which contains a helpful statement of principle. In explaining that the Court of Appeal had gone too far in excluding all reference to the file, the Supreme Court said:

'Article 69, paragraph 1 of the EPC as interpreted in accordance with the Protocol relating thereto does indeed purport (among other things) to ensure reasonable certainty for third parties, but it does not follow that the information from the granting file that is available to third parties may never be used in support of the interpretation given by the patentee to his own patent. The requirement of reasonable certainty for third parties does, however, call for restraint in using arguments derived from the granting file in favour of the patentee. Consequently, a court will only be justified in using clarifying information from the public part of the granting file, when it holds that even after the average person skilled in the art has considered the description and the drawings, it is still open to question how the contents of the claims must be interpreted. In this connection one must also take into consideration that the risk of any ambiguities due to careless wording of the patent specification must in principle lie with the patentee'."

26. Robert Walker L.J. treated the foregoing as persuasive guidance. He went on to say:

"The letter to the European Patent Office did not have the same status as published prior art identified in the specification, which is readily admissible. But it did contain objective information about and commentary on experiments which were conducted in response to official observations, and it could be of assistance in resolving some puzzling features of the specification. Although the prosecution process may sometimes superficially resemble a process of negotiation between the applicant and its advisors and the officials who scrutinise the file, it is not the sort of commercial negotiation which is still rigidly excluded in the construction of a written contract... Had it been necessary for the judge to take account of the letter in order to resolve the issue of construction, I consider that he would have been entitled to do so."

27. That case appears in the list of authorities submitted to the House of Lords in *Kirin Amgen* but not in the list of cases referred to in the opinion.

28. Mr. Collins also relied on *Liposome Company Inc. v. Vestar Inc.*, a decision of the United States District Court for the District of Delaware. In those proceedings, also, the defendant sought to rely on a letter sent by the patentee to the European Patent Office which put forward a proposition contrary to that being advanced by the patentee in the United States proceedings. The analysis of the Delaware Court is set out in the plaintiff's written submission and it acknowledges that there is some authority under a doctrine of "judicial estoppel" to show that courts will find a party estopped from obtaining relief based on alternative and inconsistent positions taken in litigation to prevent a party from "playing fast and loose" with the courts and to protect the essential integrity of the judicial process. On the other hand, however, a party will not be so estopped unless the party opposing the subsequent position demonstrates either personal reliance on the earlier decision, prejudice in the current litigation by reason of the prior decision or a patent holder's apparent misuse of the court.

29. The judgment, as quoted in the written submissions, proceeds as follows:-

"Vestar's better argument on the significance of Ostro's letter and a statement before the European Patent Office is that they are relevant as evidence of how TLC had in fact read the words of the claim at a time when it was not looking at them as a necessary step in building a claim for relief that moves from complaint to recovery. TLC's prior statements are also relevant as they are some evidence of how one skilled in the art would read the words in the patent."

30. To support the argument that the documents sought for comprise statements made against interest the plaintiff relied on *Furr v. C.D. Truline (Building Products Limited)* [1985] FSR 553 where Faulkner J. accepted at the interlocutory stage that representations made by a patentee during the course of a patent application could be admitted as statements against interest. The patentee in that case put forward the document on the file itself in evidence on the motion and relied upon them in relation to the scope of the claim.

In doing so Faulkner J. acknowledged that the document was a public document because it was on the patent office file and relied also on the fact that the plaintiffs themselves had put the material in evidence and that it was therefore evidence against interest which prohibited the plaintiffs then to contend for a wider construction than the documents admitted.

31. Mr. O'Donnell S.C. relied primarily on the judgment of Mummery J. in *Glaverbel S.A. v. British Coal Corporation* (2)(Ref.) which deals with the point arising in the course of the trial and was not, at least formally, dealt with on appeal. He also relies on the decision of the Court of Appeal in the same case on the substantive judgment reported at 1995 RVC 225. In the former judgment Mummery J. was dealing with an objection which arose in the course of cross-examination of one of the inventors by counsel for the defendant. Defence counsel put to the witness the plaintiff's corresponding United States patent for the same process. Both US and UK patents had a common source in a convention application filed in Luxembourg. The suggestion put to the witness (one of the inventors) by defence counsel was that the description of the invention in the United States patent was in substantially the same words as the patent in suit but that in the first claim in the United States patent words were added which had the effect of limiting those claims. Those words did not appear in the United Kingdom patent.

32. Counsel for the plaintiff objected submitting that the line of questioning was irrelevant because the English Court does not decide questions as to why claims in foreign patents have been granted in a different form. He submitted that the English Court was solely concerned with the UK patent which is not construed by reference to a foreign patent document. Therefore the evidence relating to the U.S. patent was inadmissible on the question of construction.

33. The argument advanced by defence counsel as to why he wished to pursue that line of cross-examination is instructive in the present circumstances. Mummery J. described it as follows:-

"Counsel for the defendant said that he wished to pursue this line of cross-examination because comparison of the two specifications for the same process was evidence of the thoughts of the plaintiff, and its advisors about the invention at the relevant time. There was evidence of a subsequent change in attitude and interpretation on the part of the plaintiff about the United Kingdom patent. He wished to show that the plaintiff had for several years been advancing a different interpretation of the United Kingdom patent from that which appeared from the description of the process in the United States patent specification and later patents granted to the plaintiff. This, he submitted, was relevant material for the construction of the specification."

34. Mummery J. called for and got full argument on the relevant principles of construction. After hearing these he gave his judgment, portion of which reads as follows:-

"A relevant expert is entitled to give evidence of what the specification would have taught him and whether what is described in the specification could be carried into effect by workers skilled in the Art..."

There are, however, clear limits to the evidence which the court will admit in aid of construction of a patent specification or of any other document. The meaning of the specification must be ascertained from the particular language in which it is expressed, as seen in its objective factual setting. Consistently with this approach, the courts have refused to admit the following evidence either to enlarge or restrict the ordinary meaning of the language of the specification.

(a) Direct evidence of the subjective intentions, thoughts and opinions of the inventor and his professional advisors and agents. Even pre-existing documentary evidence of those intentions and opinions, such as might be found in the Patent Office file (see *Bowden Brake Co Ltd v. Bowden Wire Ltd* [1913] 30 RPC 561) or in correspondence passing between the inventor's patent agent and the Comptroller-General (see *Poseidon Industri AB v. Cerosa Ltd* [1975] FSR 122 at 123), or in documents relating to the applications for corresponding foreign patents (see *Schering Agrochemicals Ltd v. ABM Chemicals Ltd* [1987] RPC 185), is not regarded as relevant for the purpose of discovery of documents or as admissible for the construction of the specification. The reason for excluding that evidence is the same as the reason for excluding evidence of prior negotiations leading to a contract, which is not admissible to construe a contract (see *Prenn v. Simmonds* (*supra*)). Such evidence is not regarded by the court as helpful or relevant in ascertaining the meaning of the language in which the inventor and his advisors have described the invention.

(b) *A fortiori*, the courts will not admit for the purposes of construction evidence of conduct subsequent to the document to show how the document was in fact acted upon and understood...

(c) The opinion of expert witnesses on the construction of the specification (or of any other document) will not be admitted by the court. The position was stated as clearly as it can be by Lord Tomlin in *British Celanese Ltd v. Courtaulds Ltd*, (1935) 52 RPC 171 at p. 196] in these terms:

'He (that is, an expert witness) is not entitled say nor is counsel entitled to ask him what the specification means, nor does the question become any more admissible if it takes the form of asking him what it means to him as an engineer or as a chemist.'

The cases constantly emphasise that it is for the court, and not for an expert witness, to construe the specification and the ambit of the claims made in it."

35. Mr. O'Donnell S.C. also relies on the Court of Appeal's decision in the same case, albeit that that was an appeal not from the decision just referred to which arose in the course of the hearing itself, but from the judgment of Mummery J. on the substantive case.

36. In the course of that judgment Staughton L.J. set out a number of general principles of construction which are, I think, worth quoting at this point as follows:-

"The propositions which were common ground or are in my opinion well founded are these:

1. The interpretation of a patent, as of any other written document, is a question of law. That does not mean that the answer to it will necessarily be found in our law books. It means that it is for the judge rather than a jury to decide, and that evidence of what the patent means is not admissible. In particular, evidence of the patentee as to what he intended it to mean should not be admitted, nor indirect evidence which is said to point to his intention. Compare the rule that the parties to a deed or contract cannot give evidence of what they intended to mean. A

patent is construed objectively, through the eyes of a skilled addressee.

2. The Court may, and indeed should, have regard to the surrounding circumstances as they existed at the date of the publication of the specification (or perhaps the priority date). Those circumstances, sometimes described as "the matrix" in a commercial context, would include common general knowledge. I imagine that they would not include circumstances known only to the patentee or a limited class of persons, since every skilled addressee should be able to know what the patent means and therefore have equal access to material available for interpretation.

3. The Court should admit evidence of the meaning of technical terms. It may be that expert evidence can go somewhat further than that in aid of interpretation; but I need not decide that in the present case.

4. The whole document must be read together, the body of the specification with the claims.

5. The Court must adopt: 'a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge.' (*Catnic Components Ltd v. Hill and Smith Ltd* [1982] RPC 183 by Lord Diplock at p. 243).

6. Subsequent conduct is not available as an aid to interpretation...

7. A claim must not be construed with an eye on prior material in order to avoid its effect..."

37. Mr. Collins S.C. sought to distinguish *Glaverbel*, and in particular the judgment of Mummery J., on the basis that what the Judge was there concerned with was a challenge to the admissibility of evidence dealing with the question as to why claims in foreign patents have been granted in a different form from the equivalent claims in the United Kingdom, whereas in the present instance the issue is whether evidence from skilled addressees making representations at the relevant time and which are therefore in principle admissible can be made inadmissible merely because they were made on behalf of the patentee.

38. With regard to the subsidiary point the defendant submits that *Furr* is readily distinguishable from the present case in that it clearly related only to a document on the patent office file, was made on an interlocutory application and the evidence had already been introduced by the patentee in aid of the construction of the patent in suit.

39. Moreover in more general terms the doctrine of admission against interest, which is an exception to the hearsay rule, has no obvious application to the present case.

#### **"File Wrapper" Estoppel**

40. In the course of submissions there was an interesting discussion about the US doctrine of "file wrapper" estoppel and, in particular, the relationship if any it bears to the plaintiff's instant application.

41. File wrapper estoppel arose as a judicial brake on the scope of a patentee's claim for his patent given that in US law the grounding principle is that the words of a patent are the source of a claim (and therefore capable of legitimate extension). The doctrine of file wrapper estoppel sought to put a check on the potential of that principle by holding that if concessions were made by the patentee acknowledging a limitation on the patent he could not subsequently resile from that acknowledgment. This involved, of course, a consideration of what was in the file to see whether such concessions were made which would bind the patentee and accordingly evidence of what was within the wrappers of the file became admissible for this purpose in the US.

42. The plaintiff submitted, correctly I think, that his contention on the present application did not amount to a bid to introduce the doctrine of file wrapper estoppel into our law. He submitted, moreover, that his instant contention was far narrower than covered by that doctrine because he was merely seeking an application of the existing principle that evidence of a skilled addressee was admissible and covered the documents sought. The defendant, on the other hand, submitted that the plaintiff's submission was in fact far wider in its application than would be the principle of file wrapper estoppel because it sought to establish as admissible evidence from a patentee's representative no matter where it came from, regardless of whether it was to be contained in the file (meaning the Irish file) or from any other source whatsoever.

43. In my view the discussion, summarised above, is of merely tangential relevance to the point I have to decide in this judgment and I therefore refer to it only in the brief way which I have just done.

#### **Conclusions**

44. In regard to the principal point my views are as follows:

One of the reasons given by Mummery J. for ruling inadmissible the evidence under consideration in *Glaverbel* was because he held direct evidence of the thoughts of the inventor and his professional advisors and agents were not relevant and therefore inadmissible. The representations sought by the plaintiff to be discovered in this application fall into that category and in my opinion that is their primary description even if the plaintiff can say that his purpose for relying on these documents is not to indicate the intentions, thoughts and opinions of the inventor and his professional advisors or agents as to what they intended the patent to mean, but rather so as to show the court what skilled addressees (were the authors of these addressees in the relevant sense?) understood the patentee to have intended it to mean in the sought for documentation.

In my view the representations sought to be discovered are inadmissible because they are representations which came into existence and were made for the purpose of indicating the thoughts, intentions and opinions of the inventor and his relevant agents and as such are inadmissible because they are irrelevant to the sole issue before the court in these proceedings namely the construction of the defendant's patent. That was clearly held to be the case by Mummery J. in *Glaverbel S.A.* and in my opinion that decision states the law in this country on that point. Furthermore in the Court of Appeal the principles enunciated by Staughton L.J. include at No. 1 that "in particular, evidence of the patentee as to what he intended it to mean should not be admitted nor indirect evidence which is said to point to his intention."

45. Again in my view that is also a principle of law in this jurisdiction.

46. What of *Rohm and Haas*?

47. I do not accept that it is a decision which governs the issue in the present case. Having referred to the decision of the Supreme

Court of the Netherlands in *Ciba-Geigy* Robert Walker L.J. in the crucial part of his judgment on this point went on to say with regard to the letter attached to the European Patent Office file that:-

"...it did contain objective information about and commentary on experiments which were conducted in response to official observations, and it could be of assistance in resolving some puzzling features of the specification."

48. The letter was not a representation made by the patentee or its relevant agents as to what the patent meant or what they intended it to mean but only gave objective information in relation to the results of experiments which were conducted in response to an official representation from the Patent Office. The important word in the passage cited above in my view is "objective". The letter contained "objective information about and commentary on experiments" conducted in response to a query from the Patent Office. The Court of Appeal was prepared, it seems to me, to accept that in the particular circumstances of that case the description of the experiment could be treated as if it were truly objective and therefore free of any bar to its admissibility on the ground that it came from the mouth of the patentee. It could be treated, in other words, as if it had come from the mouth of a truly independent skilled addressee rather than from an agent of the patentee. As such I think that *Rohm and Haas* is probably an exception on its own facts to the general rule that such information is inadmissible for the purpose of interpreting the patent. Even if it is not an exception it is clearly a decision which turns on its own very narrow facts and those are facts which in no way in my view can justify the elevation of the particular decision in *Rohm and Haas* to the status of a general principle which has application to the documents sought to be discovered in the present case.

49. Clearly there is force in the reasoning of the Court in *Vestar* and in particular, in my opinion, in the latter part of the judgment which I have quoted.

50. Nonetheless in my view the statements in the *Vestar* case and those sought now to be discovered are statements indicating what the patentee or its representatives thought the patent meant or intended it to mean. As such their admission would run counter to the first proposition set out as either common ground between the parties or as well founded by Staughton L.J. in the Court of Appeal decision in *Glaverbel* where he said "in particular, evidence of the patentee as to what he intended it to mean should not be admitted, nor indirect evidence which is said to point to his intention."

51. It is also worth noting that the attitude of the courts in the US is what the plaintiff has described as "more open minded". This attitude springs from a difference between the approach taken by the courts in the United Kingdom (which some had regarded as too literal and which has changed with the introduction of the principle of purposive construction (by Lord Diplock in *Catnic Components Limited v. Hill and Smith Limited* [1982] RPC 183) and, now of course under the influence of Article 69 and the protocol) on the one hand, and on the other in the United States where (as it was put by Hoffman L.J. in *Kirin-Amgen Inc.* at p. 682):-

"In the United States, where a similar principle is called the 'doctrine of equivalence', it is frankly acknowledged that it allows the patentee to extend his monopoly beyond the claims."

52. The reference in the above to the "similar principle" is to the development in England of a doctrine of the "pith and marrow" of the invention (in an effort, in that country, to counter the then perceived over literalism in the authorities: the English "pith and marrow" doctrine did not seem to get very far and was ultimately, I think, overtaken by the introduction of the purposive interpretation, principle and, now, of course the European Patents Convention).

53. The relevance of these considerations is, as far as I am concerned, to put in context the approach of the Delaware Court in *Vestar*. It comes from within a different tradition and one which has itself yielded problems in that country so that the federal Court of Appeal in *Festo Corp. v. Shoketu Kinzoku Kogyo Kabushiki Co. Ltd.* [2000] 234 F3d 558 declared the law to be arbitrary and unworkable. Lourie J. said (596) "the only settled expectation currently existing is the expectation that clever attorneys can argue infringement outside the scope of the claims all the way through this Court of Appeals."

54. By this short discussion I do not wish to detract from the value of *Vestar* but only to explain that if following it means abandoning a well developed and well established principle of patent law on this side of the Atlantic, which I think it would do, then I am not prepared to take that step.

55. If the plaintiff is correct then it seems that any evidence and any documents coming from no matter what quarter and no matter what source and no matter what country, and which were generated by the representatives of the patentee are all in principle admissible notwithstanding that they came into existence, unambiguously it may be, to show the thoughts and intentions of the patentee and its representatives. It is difficult if this proposition is correct to see what documents and statements are excluded by the well established principle that direct evidence of the subjective intentions, thoughts and opinions of the inventor and his professional advisors and agents including pre-existing documentary evidence of those intentions and opinions or correspondence passing between the inventor's patent agents and the controller general or in documents relating to applications for corresponding foreign patents is not admissible for the construction of the claim and specification (see Mummery J. in *Glaverbel S.A.* (p. 94)).

56. I would not wish to conclude this portion of my judgment without acknowledging the masterly discussion of the above topics in the speech of Hoffman L.J. in *Kirin-Amgen*, particularly from para. 27 and following.

57. With regard to the second, subsidiary, point I accept the submission of Mr. O'Donnell S.C. that the principle of admissions made against interest have no application in the present context. No authority justifying the application of those principles to representations made by a patentee in circumstances under consideration here was cited by Mr. Collins in support of his submission. There is, on the other hand, a very considerable body of authority dealing with such representations in the context of patent cases. It would be strange indeed if a principle such as that now contended for by the plaintiff which constitutes an exception to the hearsay rule and depends upon the non availability because of his death of the relevant witness before it has any application, could somehow operate to set at nought the well-developed and topic specific jurisprudence on the point.

58. Lastly a submission was made by Mr. Collins to the effect that if I reached the foregoing decision I should indicate that the documents sought should nonetheless be treated as admissible and discovered *de bene esse* as was done by Mummery J. in *Glaverbel* with the apparent blessing of the Court of Appeal (see observations of Staughton L.J. at p. 268).

59. In my opinion it is for me to deal only with the question of admissibility and leave over to whichever of my colleagues is dealing with the application for discovery proper any further question including the question whether notwithstanding my ruling as to admissibility the documents should be discovered *de bene esse*. I refer to the point at all, because Mr. Collins indicated to me that if I took the view which I do and said nothing about this point, he would be disabled from submitting that the documents should be discovered despite the instant ruling. I make reference to the point, therefore, because I do not intend my decision on admissibility to

curtail Mr. Collins in making whatever submission he deems appropriate when moving the discovery motion proper.