



Neutral Citation Number: [2023] EWHC 1098 (Pat)

**IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS
OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)
PATENTS COURT**

Claim No. HP-2021-000042

The Rolls Building
7 Rolls Building
Fetter Lane
London EC4A 1NL

Wednesday, 10 May 2023

BEFORE:

MR CAMPBELL FORSYTH
Sitting as a Deputy Judge of the High Court

BETWEEN:

SAFESTAND LIMITED

Claimant

- and -

(1) WESTON HOMES PLC
(2) WESTON (LOGISTICS) LIMITED
(3) WESTON GROUP PLC

Defendants

Hearing date 20 April 2023

MR. HENRY EDWARDS (instructed by DLA Piper LLP) appeared for the Claimant.

MR. JEREMY REED KC (instructed by Birketts LLP) appeared for the Defendants.

APPROVED JUDGMENT

MR CAMPBELL FORSYTH:

Introduction

1. This is a hearing dealing with two applications:
 - (i) The Defendant's have by an Application Notice dated 14 April 2023 ("the Defendants' Application") requesting permission to reply on various experiments set out within its Re-Amended Notice of Experiments ("ANOE").
 - (ii) The Claimant by its Application Notice dated 13 March 2023 ("the Claimant's Application") requests specific disclosure of documents and data relating to experiments in the ANOE.
2. Together the two applications were originally estimated to take 2 ½ hours . In the end the hearing lasted a day. Counsel for the Defendants confirmed his view that this was always at least a day's hearing, with half a day for reading. It is important for parties to liaise and update the court if, as matters develop, the time the court requires to read into and hear a matter is considerably longer than originally anticipated and listed.
3. These applications arise in relation to a claim for infringement of three patents and three re-registered design rights (the name given to UK comparable registered design rights granted to holders of Community Registered Designs under Schedule 1A of the Registered Designs Act 1949 due to Brexit). The Claimant is seeking various forms of relief including damages and an injunction. In turn, the Defendants have claims for the revocation of each of these patents based on their validity, are running a Formstein defence and pleads non-infringement of each of the patents in dispute. Additionally, the Defendant's claim the revocation of each of the re-registered design right and non-infringement.

Procedural History

4. The context of the present applications is of some relevance, in particular due to the timing of the current application for specific disclosure and the proximity of trial.
5. At the CMC Mann J ordered as part of the directions that where a party seeks to establish any fact by experimental proof, including an experiment conducted for the purposes of the litigation or otherwise (not being an experiment conducted in the normal course of research), that party must serve on all other parties a notice stating the facts which it seeks to establish and giving full particulars of the experiments proposed to establish them (sealed order 25 May 2022) . Further to an order by consent sealed on 1 December 2022 the time for filing a Notice of Experiments was extended to 22 November 2022. The Defendants served their Notice of Experiments ("NOE") on 22 November 2022 comprising Experiments 1 to 6. The Defendants' ANOE was served on 14 February 2023. The Defendants have applied to rely only on experiments 1 to 3 ("the Experiments") as set out in its ANOE.
6. The order of Marcus Smith J on 23 December 2022 noted in the recitals that witnessed repeats of the Defendants experiments would take place on 23/24 January 2023 and provided that any Notice of Experiments in Reply be filed by 3 February 2023. The Claimant and the Defendants witnessed repeats of the Experiments on 23/24 January 2023 ("the Repeats"). The Defendants provided a report of the repeats of the Experiments on 14 February 2023 ("the Report of the Repeats"). No experiments in Reply were served.
7. The Claimant's Application was made on 13 March 2023. Expert reports were exchanged on 22 March 2023. The Defendants' Application was made on 14 April 2023.
8. The Claimant does not oppose the Defendants' Application. There was some discussion regarding the court placing potential conditions relating to the Claimant's Application on its consent to the Defendant's Application.
9. Responsive expert reports were exchanged on the 19 April 2023, immediately before the hearing of these applications. I was not provided with this further expert evidence. The pre-trial review in this case is in a window for a hearing between 16-18 May 2023. The trial is due to take place over a 7 day hearing in the window 7-21 June 2023. I was informed the matter was valued at less than £10m and therefore is cost budgeted. This is useful guidance for proportionality. However, this is clearly a significant and complex case.

The patents and case on infringement

10. Two of the three asserted patents in this case are relevant to these applications, being GB2378978 ("978") and EP(UK)1660738 ("738") together conveniently referred to as "the Trestle Patents". For the purpose of this decision, the references below focus on issues in dispute relevant to the Trestle Patents unless stated otherwise. The Trestle Patents both relate to trestles for supporting workman platforms used on building sites. The claims for infringement/non-infringement are both to a normal construction and under the doctrine of equivalence and both under s.60(1) and s.60(2) of the Patents Act 1977. There is a dispute over the scope of the inventions and in particular the meaning of the term "builder's trestles". This term appears in claims asserted for both Trestle Patents (as granted or as proposed to be amended).
11. The relevant general authorities and issues underlying these applications are not really disputed by the parties. Rather, it is the application of the law to the issues. In order to understand the context of these applications it is useful to consider a summary of some of the relevant background.
12. The Amended Particulars of Claim dated 2 September 2022 at paragraph 7 define the Defendants' "Kwik Kage System" ("KKS") said to infringe the Trestle Patents. The Amended Defence and Counterclaim, and in particular paragraphs 16A-16C, detail grounds upon which infringement of the Trestle Patents is disputed – whether as a matter of normal construction or by way of equivalents. The statement of case explains that the KKS does not infringe because the main frames of the KKS attached to their starter plates ("Frames") are not (or does not include) "trestles". Such working platforms would need to have sufficient longitudinal stability to ensure they are safe in use and that without certain adaptations (cross-braces) the KKS would not be safe for use as a working platform as it would not have sufficient longitudinal stability.
13. The Reply and Defence to the Counterclaim has further relevant sections on these issues, in particular at paragraphs 3A, and 4A. In paragraph 3A.3 and in correspondence the Claimant denies that the degree of longitudinal stability of the Frames (with or without cross-braces) is relevant to the question of what constitutes a trestle or bandstand. However, the Claimant's made clear in submissions that regardless, this issue needed to be addressed to deal with the Defendants' case. There are also a number of requests for information that have been made under CPR Part 18 which include requests and responses relating to the inventive concepts of the Trestle Patents, the trestle stands and longitudinal stability.

14. The Re-Amended Product and Process Description re-re-served 24 February 2023 ("PPD") provides details of two different sized Main Frames. The Standard Main Frame with a 'short' vertical length of 1498mm ("Standard Main Frame KKS") and a shorter version with a vertical length of 589mm ("KK 600"). Both sized Frames are alleged to infringe the Trestle Patents, albeit the KK 600 is said to be part of a shorter production run and has been discontinued (although remains in use).

15. The Defendants' expert, Dr Lewis Santos, considers in his first report dated 13 April 2023 ("Santos") under the section headed Patent Infringement how a skilled person would understand the meaning of the term "builder's trestle" from the Trestle Patents (Dr Santos deals with the 978 patent in the paragraphs set out below and later cross refers to this at [369] when considering integer 1A of the 738 patent).

"333. Integer 1A claims "A modular system comprising a plurality of builder's trestles". In my view the skilled person would consider that this is not present in the Kwik Kage System. That is so because the skilled person would understand that a builder's trestle is a self-standing support for a platform which will (with other trestles) support the platform in normal use without the need for any additional structural support.

334.The skilled person would also understand that the feet of a trestle would extend a sufficient distance as a proportion of the height of the platform in order to provide the longitudinal stability necessary for the platform to be used normally and safely for tasks such as bricklaying or blockwork."

16. Santos explains the KKS is alleged to infringe the Trestle Patents in the above context [328]. However, later in Santos the term KKS appears to be used sometimes only for the Standard Main Frame KKS. At paragraph 486 Santos explains his earlier evidence in the report related to the 'full-size' KKS (another way of referring to the Standard Frame KKS). If there is any imprecision in the use of the KKS definition between the Defendant's documents it does not impact on the assessments below as; (1) Santos in his analysis of infringement KK 600 does not identify any elements of the later analysis that differ from that earlier evidence on how the skilled person would understand the terms 'trestle', and (2) the term KKS in the statement of case and allegations of infringement covers the relevant products in the PPD.

17. The Defendants' skeleton confirms the dispute on these issues succinctly:

"27. The core points are whether D's Main Frame fitted with Starter Plates is a "builders' trestle" (integer 1A), and whether planks/boards on those devices can be "supported in use to make a platform" (integer 1B). The wording of integer 1A and 1B differs very slightly between the 978 and 738 Patents, but raises substantially the same issue in each case.

28. Put simply, D's case is that its Frames (i.e. Main Frame fitted with Starter Plates) are not builders' trestles, and they are not "builders trestles" that can support planks in use to make a platform. Furthermore, again put simply, Ds' case on equivalents is that its Frames are not functioning in the same way as builders' trestles – stability is achieved by an entirely different mechanism, that it to say by the addition of two cross-braces between all adjacent Frames, thereby connecting them, stabilising them, and fixing the distance between them. Ds say that the stability in the trestle / trestle system is provided by the feet of the trestles (which must have sufficient size and rigidity), and that this is not the case with the D's system."

18. The above does not attempt to comprise all the information provided and considered in relation to the noted matters and these applications. Rather, it is useful to understand with more specificity the issues which the Experiments are said to assist with when this is considered further below.

The experiments

19. The Experiments are designed to support the Defendants' case that the Kwik Kage System does not infringe Integers 1A and 1B of the Trestle Patents. There is dispute about whether the Experiments support the non-infringement of the KK600 (there is no issue on this as regards the Standard Frame). Broadly, the Experiments compare aspects of performance of Standard Frame KKS with trestles said to be standard 'bandstands' ("the Trestle"). The Trestle is explained to be made such that it was based on aspects of the Trestle Patents and to make the Trestle top cross member and the KKS Frame cross member the same height.

20. Santos explains the aim of the Experiments as:

"442. The tests aimed to quantify differences or similarities in performance of a "Kwik Kage Frame" and Trestle, and a Kwik Kage System and a Trestle Platform, from the initial application of the forces through to the maximum longitudinal force resisted by each item or arrangement in each test. Experiment 3 also included testing of a changed version of the Kwik Kage System with all the cross-braces removed."

21. In outline, the Experiments were described in Santos as the following comparisons [444]:
- (i) "**Experiment 1** – A **single** modified Trestle ("Trestle") compared with a Kwik Kage Frame with Starter Plates ("Frame"), both unweighted.
 - (ii) **Experiment 2:** A **single** Trestle compared with a Frame, both weighted (252Kg). (Experiment2)
 - (iii) **Experiment 3:** A **three-bay** Trestle Platform, a three-bay unbraced Kwik Kage System and a three-bay Kwik Kage System. Each bay was weighted with 252Kg. These systems were as follows:
 - (a) **Trestle Platform** – comprising three-bays and four Trestles fitted with removable uprights, front and end handrails (top and bottom), anti-flip brackets and scaffold boards.
 - (b) **Unbraced Kwik Kage System** – comprising three bays and four unbraced Kwik Kage Frames fitted with starter plates, removable uprights, front and end handrails (top and bottom), anti-flip brackets and scaffold boards (no cross-braces).
 - (c) **Kwik Kage System** – comprising three bays and four frames, (except for the absence of Kickboards) fitted with starter plates, removable uprights, front and end handrails (top and bottom), anti-flip brackets, scaffold boards and six cross-braces."
22. The ANOE sets out various facts it asserts are proved by the Experiments. These facts relate in general terms to: (i) how much horizontal force needs to be applied to topple the frame/system, and (ii) the initial resistance to displacement/movement of the frame/system (explained by the Defendants as indicating steadiness, stability or safety in use).
23. Counsel for the Defendants confirmed the Defendants' expert is aware of any experiments conducted for the litigation, including the Experiments.
24. There was disagreement between the parties regarding the approach taken by the Defendants' expert in his first report. The Defendants' position is the Experiments are only relied on by their expert in support of their non-infringement arguments on Integers 1A and 1B regarding the Trestle Patents and the Standard Frame KKS only. The Claimant's counsel argued it was either express or implicit in the way the Defendants' expert report was written that he had relied on these Experiments also for the KK 600 non-infringement position.

25. I was taken through the relevant parts of Santos in considerable detail by both counsel. What Dr Santos may have had in mind regarding his understanding of the Experiments, the Repeats (and any other experiments designed and conducted in the case) and how he applied that information (if at all) is not necessarily apparent on the face of his report. Santos does at least appear to have been drafted with the intention of carving out the Experiments for the non-infringement arguments on the Standard Frame KKS.
26. Experiments 4 to 6 from the original Notice of Experiment which went to issues in relation to kickboard brackets are no longer relied upon in the case.

The Defendants' Application

27. The Claimant does not oppose the Defendants' application to rely on the ANOE, or more specifically to rely on Experiments 1 to 3 to prove the facts set out therein (and the consequent Report of the Repeat Experiments). The Experiments in the ANOE are said to demonstrate "the stability and resistance to displacement of individual trestles and frames ... to form the Kwik Kage System that is alleged to infringe ..." the Trestle Patents.
28. The Experiments have long been foreshadowed both in the directions for the case and in the ANOE originally served in materially the same form in the original Notice of Experiments on 22 November 2022. They have been the subject of witnessed repeats and addressed by the parties' experts in their reports. The Claimant says the Experiments in the ANOE go to, amongst other issues, the issue of the technical meaning of the term 'trestles' in the construction of the claims of the Trestle Patents. It says these Experiments are therefore not material to the case. While I take no view on the importance of these Experiments to the points for trial they appear on their face to have probative value to the issues in the case. In the circumstances, I am satisfied the Defendants may rely on Experiments 1 to 3 to prove the facts in the ANOE.
29. Counsel for the Claimant appeared to take a position that in considering the Defendants' Application I should do so in the context of comments from the *Mayne Pharma Pty Ltd v Debiopharm SA* [2006] EWHC 164 (Pat) decision ("*Mayne Pharma*") where it was expressed that permission could be given conditional on the party wanting to rely on certain experiments providing disclosure on those experiments.
30. As set out later in this decision, I have decided to order certain specific disclosure in relation to the Claimant's Application. In the circumstances, the question of any conditional approach to the Defendants' Application is largely irrelevant. However, regardless, I would not have found any need for such a condition under CPR r3.1(3) or otherwise in this case. In my view, the

Defendants' Application was satisfied based on the evidence and circumstances under which the ANOE is relied upon in the case. There is not any linkage to the Claimant's Application which would come close to justifying any such condition.

The Claimant's Application

31. The Claimant's Application is for specific disclosure of a relatively well defined class of documents. The Defendants broadly oppose the application on the basis that; (1) the Defendant's privilege has not been waived in respect of the documents (or parts of documents) sought (to the extent they exist), and (2) the disclosure sought is not necessary for the just disposal of the claim, nor is it reasonable or proportionate. However, it is accepted that if the requested disclosure is ordered this a case where it is straightforward to provide and it could be done quickly and efficiently.
32. The Claimant's Application is of a form known as *Mayne Pharma* disclosure – named after the decision of Pumfrey J where the Judge held that any legal privilege in documents relating to work-up experiments for the experiment relied on in the Notice of Experiments in that case was waived due to the deployed Notice of Experiments.

Jurisdiction to order specific disclosure

33. The Claimant's Application is made under either paragraph 18.1 of PD57AD or the court's inherent case management jurisdiction (expressly preserved under paragraph 20 of PD57AD – the Claimants Application refers to PD57AC but this is clearly in error). The parties were not aware of any other *Mayne Pharma* style application for specific disclosure that had resulted in a decision of the Court since the introduction of PD57AD (or presumably the Disclosure Pilot from 1 January 2019). In the circumstances, the question of the basis for the jurisdiction of the court in the context of the requested disclosure was explored. Both parties did not take any point on jurisdiction.
34. PD57AD has applied to proceedings before the Business and Property Courts since the Commencement Date on 1 October 2022. The Practice Direction can apply to existing proceedings (paragraph 1.2). However, this practice direction shall not disturb an order for disclosure made before the Commencement Date, unless that order is varied or set aside. This case was commenced during the Disclosure Pilot Scheme. Therefore, either the Disclosure Pilot or PD57AD applies to these proceedings. As regards the Claimant's Application, nothing turns on any difference between these two regimes.

35. PD57AD provides at paragraph 1.5 a modification to Extended Disclosure in a patent case:

"In the Patents Court, PD63 paragraphs 6.1 to 6.3 will continue to apply under this Practice Direction with the following modification: unless the court expressly orders otherwise, no provision in this practice direction nor any disclosure order made under this Practice Direction will take effect as requiring disclosure wider than is provided for in PD 63 paragraph 6.1. "

36. The relevant part of paragraph 6.1 of Practice Direction 63 states:

"6.1 Standard disclosure does not require the disclosure of documents that relate to-

- (1) the infringement of a patent by a product or process where –
 - (a) not less than 21 days before the date of service of a list of documents the defendant notifies the claimant and any other party of the defendant's intention to serve-
 - (i) full particulars of the product or process alleged to infringe; and
 - (ii) any necessary drawings or other illustrations; and
 - (b) on or before the date of service the defendant serves on the claimant and any other party the documents referred to in paragraph 6.1 (1)(a);"

37. As part of the case directions on 25 May 2022 Mann J ordered disclosure under PD63 6.1 in lieu of disclosure under the Disclosure Pilot Scheme. The Defendant's rely on a PPD in these proceedings. Paragraph 1.5 of the practice direction provides for circumstances where the court may make an order for disclosure wider than is provided for in PD63 6.1. In making such an order the considerations set out in paragraph 6 of PD57AD would be considered.

38. PD57AD 18.1 provides for varying an order for Extended Disclosure which includes making an additional order for disclosure of specific documents or a narrow class of documents relating to a particular issue for disclosure.

39. When considering varying an order for Extended Disclosure (PD57AD 18.2) the court must be satisfied the variation is necessary for the just disposal of the proceedings and is reasonable and proportionate (as defined in paragraph 6.4). The provisions of paragraph 6.4 which need to be taken into account when making any order for specific disclosure are:

"6.4 In all cases, an order for Extended Disclosure must be reasonable and proportionate having regard to the overriding objective including the following factors—

- (1) the nature and complexity of the issues in the proceedings;
- (2) the importance of the case, including any non-monetary relief sought;

- (3) the likelihood of documents existing that will have probative value in supporting or undermining a party's claim or defence;
- (4) the number of documents involved;
- (5) the ease and expense of searching for and retrieval of any particular document (taking into account any limitations on the information available and on the likely accuracy of any costs estimates);
- (6) the financial position of each party; and
- (7) the need to ensure the case is dealt with expeditiously, fairly and at a proportionate cost."

40. The purpose of paragraph 18 appears, at least in part, to address the removal of CPR 31.12 which previously provided the court with jurisdiction to make orders for specific disclosure. Whether the modification of PD57AD under paragraph 1.5 for patent cases is a modified form of Extended Disclosure or a further alternative mechanism for Extended Disclosure it seems clear based on the wording both of paragraph 1.5 and paragraph 18 of PD57AD that provision of a PPD in proceedings would not fetter the court's jurisdiction to make any relevant order for specific disclosure under PD57AD 18 as appropriate. The court therefore has jurisdiction to make an order under paragraph 18 in these circumstances.

41. For completeness, if there is any issue regarding the court's jurisdiction under paragraph 18, I briefly consider the court's jurisdiction under its case management powers, including CPR Part 3. The courts general case management powers are expressly preserved under paragraph 20 PD57AD. In this regard counsel for the Claimant referred to *White Winston Select Asset Funds LLC v Mahon* [2019] EWHC 1014 (Ch). This case considered the court's jurisdiction to order specific disclosure in the context of the Disclosure Pilot in a case where Extended Disclosure had not been ordered. The Deputy Judge found for the reasons noted in his decision (for example, that if a party had not complied its standard disclosure obligations it would be a strange position for the rules to fail to allow the court to order specific disclosure to deal with the situation) that the court has jurisdiction under these general case management powers to make an order for specific disclosure which would be at least equivalent to an order that could previously have been made under CPR r.31.12. It makes no difference that the situation in this case is considered under PD57AD rather than the Disclosure Pilot Scheme.

42. The court therefore has jurisdiction to make the order for specific disclosure in the Claimant's Application under its case management powers. I do not believe it makes any difference to the availability of the jurisdiction under the courts case management powers whether in this case it is considered formally that Extended Disclosure or an equivalent in lieu had been ordered.

43. This Claimant's Application involves discussion where it appears the alleged potential experimental disclosure sought could be adverse documents to the Defendant's case or supportive of the Claimant's position. Therefore, before leaving these new procedural rules on disclosure it is worth considering the rules on disclosing certain adverse documents. PD57AD 3.1 (2) states:

"by no later than the time(s) set out in paragraphs 9.1 to 9.3, to disclose known adverse documents, unless they are privileged. This duty exists regardless of whether or not any order for disclosure is made;"

44. Paragraphs 3.3. and 9.3 of the PD require this obligation to an ongoing duty during the proceedings, regardless of any other order for disclosure. As set out below in this decision, I have decided there is waiver of privilege in certain material resulting from the Defendants' reliance on its ANOE. The Defendants' argue that in these circumstances, the court should not order specific disclosure. I deal with that point later in this decision. However, regardless of my decision on whether specific disclosure should be ordered, if that was not correct for some reason, it would still be necessary to consider whether any documents identified where privilege was waived would need to be disclosed as adverse documents within the meaning of 57AD 2.7.

The legal principles underlying *Mayne Pharma* disclosure

45. The Claimant's Draft Order sets out at paragraphs 1.1 and 1.3 to 1.5 the material sought under its *Mayne Pharma* application. As required by CPR PD63 7.1 the Defendants rely on their ANOE to establish facts by experimental proof. The Claimant's Application arises from the Defendants' reliance on the voluntary disclosure of the ANOE. The relevant authorities and principles applicable to this application were set out and considered in considerable detail by the Deputy Judge in *Magnesium Elektron Limited v Neo Chemicals & Oxides (Europe) Ltd (No.2)* [2017] EWHC 2957 (Pat) ("*Elektron*") at paragraphs [37] to [82]. This deals with the relevant principles of; (i) legal privilege, (ii) waiver of privilege, and (iii) disclosure relating to experiments in patent cases (*Mayne Pharma* disclosure). In these paragraphs the Deputy Judge sets out the material sections of the underlying authorities and how the principles are applied, in particular with a focus on cases involving experiments. I do not reproduce them in the body of this decision but I adopt the analyses and set out the relevant paragraphs in full in Annex A to this decision. I also refer to some passages of particular relevance below.

46. For completeness, I note I was also referred to the recent decision of the Court of Appeal in *Civil Aviation Authority v Jet2.Com Ltd, R. (on the Application of)* [2020] EWCA Civ 35 [111] which briefly re-states the relevant principles on collateral waiver of privilege in respect of a

set of documents otherwise non-disclosable, as the result of the voluntary disclosure of other privileged documents. Relevant sections are reproduced below:

"111. The relevant principles are uncontroversial. Although the voluntary disclosure of a privileged document may result in the waiver of privilege in other material, it does not necessarily have the result that privilege is waived in all documents of the same category or all documents relating to all issues which the disclosed document touches. However, voluntary disclosure cannot be made in such a partial or selective manner that unfairness or misunderstanding may result (Paragon Finance plc v Freshfields [1999] 1 WLR 1183 at page 1188D per Lord Bingham CJ).

112. Collateral waiver of privilege allows for documents and other material that would otherwise be non-disclosable on public interest grounds, to be required to be disclosed even though the individual with the right to withhold disclosure objects. The courts have therefore imposed certain constraints on collateral waiver.

113. The starting point is to ascertain "the issue in relation to which the [voluntarily disclosed material] has been deployed", known as the "transaction test" (General Accident Fire and Life Assurance Corporation Limited v Tanter [1984] 1 WLR 100 at 113D per Hobhouse J), waiver being limited to documents relating to that "transaction" subject to the overriding requirement for fairness. The "transaction" is not the same as the subject matter of the disclosed document or communication, and waiver does not apply to all documents which could be described as "relevant" to the issue, in the usual, Peruvian Guano sense of the term as used in disclosure (Compagnie Financière et Commerciale du Pacifique v Peruvian Guano Company (1882) 11 QBD 35).

114. ... The purpose of the voluntary disclosure, which has prompted the contention that privilege in other material has been collaterally waived, is therefore an important consideration in the assessment of what constitutes the relevant "transaction" (see also Dore v Leicestershire County Council [2010] EWHC 34 (Ch) at [18]-[19] also per Mann J)."

47. The parties do not appear in principle to disagree on the relevant legal principles, rather how they are applied on the facts of this case. The scope of waiver of privilege being a question of fact to be determined in each case. As the Deputy Judge in the *Elektron* case noted at [83]:

"Patent cases are no different to any other cases in that documents recording activity undertaken for the purpose of litigation attract privilege. Until they are deployed, they remain privileged. Once deployed, the question as to the extent to which, if at all, the effect of doing so is also to

waive privilege in any other documents or material. In patent cases, as in any other, the opposite party and the court must have the opportunity of satisfying themselves that "what the party has chosen to release from privilege represents the whole of the material relevant to the issue in question"."

The problem is how to define the boundaries of the material that is relevant to the issue put in question.

48. At paragraphs [84] to [88] the Deputy Judge discusses *Mayne Pharma* – a key case dealing with these issues. In that case Pumfrey J concluded 'work up' experiments (being preliminary investigations leading to the experiment relied upon in the Notice of Experiments) should be disclosed as reliance on the Notice of Experiments "waives the privilege in work up experiments for that experiment."

49. Pumfrey J provides some helpful reasoning at [15] of his Judgment that;

"Experimental evidence is intended to prove a degree of objective confirmation or corroboration of the subjective views of the experts. It may provide, and from time to time does provide, a fixed point against which the experts may themselves be assessed. It is the one place in litigation of this class where an appeal to scientific technique is directly made. It is employed because it trumps the experts, however cogent their views may be."

50. In my view the Judge is making a statement here of general application, which I respectfully adopt, about the nature of this type of evidence. For example, as a consequence, that 'work up' experiments should not be limited to preliminary investigations leading to the experiment relied upon but could encompass other related litigation experiments which provide materially relevant contextual information on the experiments relied upon. This is an issue which distinguishes cases relying on experiments as evidence proving facts from other cases. Defendants' counsel addressed me to the Judge's statement at the end of [16]. I agree that here the Judge is dealing with the specific situation he was addressing – the workup experiments of an experiment in a validity case dealing with 'inevitable result'. These are a 'genus' of case specifically referenced and explained by the Deputy Judge in *Elektron* [93] and [94]. Such a case brings some specific features which are not relevant to this application. At the end of [16] Pumfrey J made clear that he did not want to be taken to be expressing a view in any other context at all and at [21] the Judge confirmed he makes no broader comment stating that "Whether it [waiver of the workup experiments of the particular experiment in the Notice] extends further, I am more doubtful and I will not express a view.". However, Defendant's

counsel, correctly in my view, accepted the reasoning in *Mayne Pharma* was not limited to cases of inevitable result.

51. At [89] to [91] of *Elektron* the Deputy Judge identifies out some of the difficulties that can arise in the practical application of assessing the boundaries of workup experiments in cases with experiments "which have multiple components or stages and may be run multiple times in different ways."

52. In [90] the Deputy Judge draws some conclusions from his discussion of the general authorities referenced and specifically with regards to *Mayne Pharma*:

" In my view, in the light of the restrictive approach from the general authorities and in the light of *Mayne Pharma* itself, the disclosure required to be given does not extend beyond materials recording preliminary investigation leading to the particular experiment which is deployed in evidence and does not extend to other parts of an overall experimental programme even if the design of the experiment in question may have drawn on earlier experiments. That narrow approach is consistent with the authorities above and which treat implied waiver of privilege restrictively in the general law."

53. Legal professional privilege is a "fundamental condition on which the administration of justice as a whole rests" but it may be eroded or destroyed by waiver. I do not believe the parties disagree with the general authorities on this issue and or with the Deputy Judge - that there should be a careful restrictive approach to disclosure required to be given in circumstances where there has been a waiver. However, to the extent the Defendants suggest this reasoning of the Deputy Judge fetters the court or that the Deputy Judge was making a general statement which somehow requires patent cases to be treated differently than the general authorities on these issues, I would not agree. The principles the courts have developed to address issues of reliance on partial disclosure are of general application. This view is borne out when considering the Deputy Judge's next paragraph [91] which reflects the complex nature of the fact specific analysis needed when approaching any disclosure required where litigation experiments are put in issue:

"The lesson from the above discussion is clear. There is often no wholly incontestable way of treating one aspect of an experimental programme as completely separable from another. The present case is a good example of such a situation. Some aspects of an overall programme in a complex case may involve deciding what experiments to undertake and what criteria to employ. Some aspects involve undertaking experiments. Some involve interpreting the results. In such a case it can be much harder to identify even what would constitute unfair "cherry picking".

Cases before this court may be unusual in which the experimental programme is completely straight forward. In many cases of which this case is, again, an example, it is rarely as easy to say whether there would be real unfairness in preserving privilege in part of a complex multifactorial programme of development of litigation experiments as it is in a simple case where privilege is asserted in test runs 1-9 of a standard test when only test run 10 is deployed. In a complex case, what is "workup" and what is not and what is "directly" related to experiments ultimately deployed may be terminology over which there can be such legitimate disagreement that an order to provide that gives rise to under -or - over disclosure."

54. The Deputy Judge goes on in *Elektron* to assess two classes of patent cases where the issue of identifying the boundaries of the material that is relevant to the issue put in question is usually more straightforward.
55. The first relates to cases of "inevitable result" which I mentioned above. It is a specific situation where experiments are deployed on the basis they would inevitably be selected and undertaken as described and would invariably give the results identified. The second type of case described at [95] and [96] is "completeness of data". This relates to a category of case where the repeatability of an experiment and any significant variation in result means it may be critical to have information about that issue. The failure to provide the full relevant data set may lead to unfairness. This class of case is really dealing with a specific experiment and runs of the same protocol for that experiment. What is meant by unfairness, by 'the experiment' and where the boundary lies on "completeness of data" are in issue in the Claimant's Application.
56. The Deputy Judge deals with this established principle of selective deployment in *Elekton* in the referenced section on the general authorities. This includes at [43] a reference to the case *Nea Karteria Maritime Co v Atlantic & Great Lakes Steamship Corporation* [1991] ComLR 138, 139 (Mustill J) ("*Nea Karteria*"). This is an important statement of the principles. It is worth repeating the classic passage relating to the deployment of documents at trial and how that may result in a waiver of privilege in collateral material the case:

"The general rule is that:

Where a person is deploying in court material which would otherwise be privileged, the opposite party and the court must have the opportunity of satisfying themselves that what the party has chosen to release from privilege represents the whole of the material relevant to the issue in question. To allow an individual item to be plucked out of context would be to risk injustice through its real weight or meaning being misunderstood."

57. In *Mayne Pharma* the Judge commented on Mustill J decision in *Nea Karteria* at page 139, "...holding that there was a waiver of privilege in matters collateral to the material which had already been disclosed ... in my judgment, strongly supports the argument of waiver, at least in respect of material directly associated with or underlying the evidence sought to be adduced."
58. The position taken by the Claimant in this application is that this is a case of "incomplete data". It became clear at the hearing that this was really just a term used by the Claimant to explain the potential absence of relevant data from other alleged associated experiments which may have been conducted which relate to the Experiments. The difference here is that the workup experiments requested are not restricted to experiments using the same protocol as the experiments in the ANOE. This serves to demonstrate that the approach to these issues always needs careful analysis of the underlying principles and the facts of the specific case.
59. The *Elektron* decision goes on at [97] and [98] to discuss approaches to cases where experiments are deployed (other than the two classes of case noted above). In general, the Deputy Judge calls for a more "cautious and focused approach ... " to the question of scope of waiver of privilege and to the question of whether disclosure (standard or otherwise) should be ordered or whether other instruments are better suited. I was referred in particular to the Deputy Judge's statement that [98] in the context of the Defendants' submissions that the court needs to take a cautious and narrow approach.
- "... I do not believe that the court should treat such a situation as one of implied or consequential waiver of privilege in a quantity of precursor or surrounding material, on the basis that later material relating to experiments has been disclosed and can be described as "relevant", "directly" relating to or "underlying" in some sense. That is so even where it may be possible to find the answers to some potential questions about the validity of the material actually deployed by rummaging around in the earlier material. That thinking is reinforced by the modern approach to disclosure and the move towards more bespoke solutions to the provision of information of which disclosure is only one way."
60. Counsel for the Defendants argues the Deputy Judge's comments mean the approach of; (1) assessing any waiver, and (2) applying the test of necessity, is not the approach he would recommend. Rather, it is going to be very difficult to find the limits of waiver and a more 'holistic' approach is needed in the context of the new disclosure rules. From the reference in the Deputy Judge's statement this was directed towards experiments relating to validity. The experiments in the current case go to infringement, although they may also be deployed in relation to equivalents. The nature of the issues any litigation experiments address are part of

the factual matrix to consider when making any decision assessing any waiver of privilege. In context, I do not agree the Deputy Judge intends this paragraph to be given such a restrictive interpretation as suggested. The general authorities outlined on waiver of privilege and the referenced cases focused on experiments – *Mayne Pharma* and *Elektron* – do not, in my view, create any differences of principle when addressing experiments deployed in relation to infringement. Of course, there may be differences on the relevance and impact of experiments on the case of underlying or related workup experiments but that is a question of applying the principles to the particular facts.

61. Having considered the context, my view is the Deputy Judge was confirming there should not be some form of accepted broad-brush approach to providing disclosure of workup/associated experiments which were created around the penumbra of the deployed experiments in any Notice of Experiments. I would agree, such a broad disclosure model for workup experiments would not fit with the careful restrictive approach required in assessing any waiver or the disclosure principles under PD57AD. The Deputy Judge repeats the point at [114] which is in line with the move to a more considered and limited approach to disclosure. This is an approach which fits well with the new regime under PD57AD. What I do not believe this means is that in cases deploying experiments (other than the two straightforward classes identified) there should not be disclosure of appropriate workup/associated experiments. The proposition is that it is incumbent on the parties to try to narrow the issues so that the court can properly consider any disclosure request which is necessary to deal with the case justly and at proportionate cost. These overriding principles help guide the court on an application for specific disclosure.

62. In the context of narrowing these issues the Deputy Judge in *Elektron* considered how a party may find out relevant information about their opponent's case. The process and/or responses may assist in any fairness assessment considered in the context of waiver of privilege and partial information in the *Nea Karteria* sense and also to the approach the court takes in considering a disclosure application. Examples referred to at [104] – [108] are to CPR Part 18 Requests for Information, Part 35 - asking questions of an opposing party's expert, statements of case, rival experiments. The impact such an approach could have is summarised at [115]:

"Finally, if the matter is approached in that way, greater and more specific attention can be given to the precise scope of implied or consequential waiver in the materials provided and for what purpose they are deployed."

63. Taking into account the general authorities on the approach to waiver of privilege and the cases focused on this issue in relation to experiments in patent cases and the approach to disclosure

under PD57AD and the overriding objective I now turn to addressing the Claimant's Application.

The Claimants Application for Specific Disclosure

64. The relevant provisions of the revised draft Order sets out the disclosure sought by the Claimant.

- 1.1 an unredacted copy of Section 1 and Appendix A of the report provided by the National Research Facility for Infrastructure Sensing ("the NRFIS Report") of 18 November 2022;
- 1.2 a copy of Section 2 of the NRFIS Report and/or any other section that removes redactions relating to non-confidential materials on the kickboard experiments, disclosed to the Claimant in the original Notice of Experiments or otherwise;
- 1.3 any data provided by the NRFIS in relation to the Experiments described in the NRFIS Report in Section 1 or Appendix A;
- 1.4 any report or data relating to any experiments or tests carried out to test the longitudinal stability or initial resistance to displacement of the KK 600 Main Frames described in the Re-Amended PPD; and
- 1.5 any report or data relating to any experiments or tests carried out in respect of the longitudinal stability or initial resistance to displacement of any builders' trestle which is shorter in height than the Trestle described in the Notice of Experiments.

65. The Defendants conducted all its litigation experiments at the National Research Facility for Infrastructure Sensing ("NRIFS"). There were some initial experiments conducted in 2022 ("the Initial Experiments"), some of which the Defendants rely on in their original Notice of Experiments and now in the ANOE. The Defendants also provided the original report from NRIFS relating to the Repeats. Following the Repeats the Claimant's solicitors made a request for disclosure of any underlying workup experiments to the Experiments. This request for disclosure was cast broadly. The Claimant's letter dated 31 January 2023 asks for disclosure of "any and all documents and data relating to any and all experiments carried out by your clients in connection with these proceedings." and effectively included any litigation experiments conducted by the Defendants, including experiments where the protocols differed from those relied on in the Notice of Experiments. The breadth of the request can be explained in part by the fact the Defendants had not yet decided to withdraw reliance on experiments 4 to 6 in its Notice of Experiments.

66. In the context of the Claimant's Application and correspondence between the parties the Defendants have now; (i) confirmed there were not runs, workups (being runs using an identical experimental protocol), test runs and or trials (with or without limitation) in relation to any of the Experiments relied on in its ANOE, (ii) provided a redacted copy of the NRFIS report from the Initial Experiments (Initial NRFIS Report) and (iii) Excel spreadsheets with corresponding graphs in relation to experiments from the Initial Experiments to the extent they relate to the Experiments in the ANOE.

The Parties positions on disclosure of any workup experiments

67. Broadly, the Claimant's position is that this is a case of selective disclosure by the Defendants. It argues the deployment of the ANOE is a partial disclosure of the evidence about the relevant stability of the scaffold platforms in issue. It believes there is a wider body of evidence of what appears to be tests involving the application of horizontal load to different configurations on the scaffold platforms.

68. The Claimant relies on the disclosed NRFIS Report and the estimated 23 sets of tests listed in the table in that document and to which privilege is claimed by the Defendants. The Claimant also relies on the NRFIS Report's unredacted sections which refer to the experiments relied upon in the ANOE, as well as ones where privilege is asserted, as all being tests where a horizontal load is applied. It asserts that as the table of these experiments in the document has a column to set out the height of the frame, this could mean there are variable heights – not just the Standard Frame KKS noted in the unredacted sections, which are part of the protocol of the experiments undertaken in the case. For example, the Claimant says the KK 600 may be being tested for the same types of stability as the Standard Frame. The Second statement of Rebecca Lawrence ("Lawrence") explains why the Claimant believes the alleged KK 600 experiments are essentially the same as the experiments relied upon in the ANOE, except for the height of the frame and are therefore "alternative runs" of the deployed experiments. A reason these "alternative runs" are relevant is that the Claimant expert's reported view is "... *the shorter KK600 Frames would be more stable than the taller Standard frames and the trestles...*". The Defendants argue that both of its products in its PPD are less stable than "trestles" as referenced in integers 1A and 1B of the Trestle Patents and are therefore not "trestles" or equivalents of "trestles" and therefore do not infringe. Lawrence reports that the Claimant's expert, Mr Lohmann, expects the shorter KK 600 Frames to be more stable than the Standard Frame KKS "by some margin". The explanation discussed stability in the context of geometry – width of base, height of frame, weight and force applied. The resulting assessment being that if such experiments exist and show this result the non-infringement argument would fail.

69. The Defendants explain there are other arguments set out by Dr Santos in his report which explain why this analysis is not right and, perhaps more fundamentally, that they do not rely on their Experiments in relation to the KK 600. In other words, the Experiments in the ANOE are severed from any other experiments as they are only relied on in relation to infringement and the Standard Frame KKS. The argument that the Experiments in the ANOE was deployed for the specific purpose of non-infringement of the Standard Frames was initially persuasive. However, upon consideration of all the information before me, including the details of the expert evidence and statements of case, I do not believe there is support for such a narrow assessment. The position taken by the Defendants on how the technical term 'trestle' is understood by the skilled person and in turn whether such a term properly construed is therefore infringed are part of a chain of reasoning with the issue of the Experiments and relevant longitudinal stability necessary for the platform to be used normally and safely at its fulcrum. For example, Santos continues to expand on his initial comments noted above on how the skilled person would understand the term 'trestle' in the context of the 978 (Dr Santos later confirms the reasoning is the same for the 738) at [334]:

"The skilled person reading the '978 Patent would understand that builder's trestles have been used for many years in the context of low level working platforms, The skilled person would understand that a typical builder's trestle will have rigid "feet" at the base of each of its two uprights extending outwards from the trestle in the longitudinal direction (i.e. the direction along the platform), and that those feet will be braced with a diagonal base support to ensure that they have sufficient rigidity. The skilled person would also understand that the feet of a trestle would extend a sufficient distance as a proportion of the height of the platform in order to provide the longitudinal stability necessary for the platform to be used normally and safely for tasks such as bricklaying or blockwork."

70. It was explained by the Defendants' counsel that the expert duties under Part 35 would modify any risk from their expert's knowledge of any other experiments (if they exist). The Claimant argued it may be possible for the Defendants to justify such positions in their evidence where an opposing party, with knowledge of the same information, may take a different view.

71. Counsel for the Claimant, assessed against the transaction test, argue the purpose of the ANOE relied on by the Defendant's in the case is "to demonstrate that trestles with a triangular support (like the ones illustrated in the figures of the Patents) have a greater longitudinal stability than the Defendants' flat-based frames. The difference in performance characteristics is alleged to

be relevant to construction." It says the meaning of 'trestle' in the claims of the Trestle Patents is in issue and any proposed definition/technical meaning of such a term should be "workable and capable of consistent application". If the Defendants have experimental data from the NRFIS experiments on, for example, how height of a relevant frame impacts on this stability it could be material to the way the technical meaning of the term is construed by the court within the claims. The example given was that a frame may or may not be a trestle depending on its height and therefore this would in turn impact on whether any particular product infringes. To that end the Claimant says the Defendant's rely on the ANOE regarding non-infringement of the KK600 from the arguments of their expert, Dr Santos.

72. The Defendants took me in some detail through the sections of Santos where it is contested his reasoning on non-infringement relies of the KK 600 relies on the Experiments. My view is that the report appears to be carefully drafted not to expressly refer to the Experiments in the context of the infringement section on the KK 600 frame. Following this review it is not possible to determine with any satisfactory certainty whether there is any risk of an implicit link in the expert's infringement assessment of the KK 600 frame and its stability as considered by the skilled person and his appreciation of what is demonstrated by the Experiments in the ANOE. Although Part 35 provides considerable comfort, it is unclear how the expert, being aware of all the experiments conducted at the NRFIS, approached his knowledge of any experiments not in the ANOE in preparing his evidence. It may be as indicated above, that if there are such experiments, the expert simply dismissed them as being irrelevant in his view. With regards to this application I consider this point is peripheral.

73. In the Third statement of Maria-Christina Peyman ("Peyman") the Defendants' evidence is that if (which is not admitted) any experiments carried out at the NRFIS were not disclosed, these are not relied upon and are privileged. Peyman acknowledges the position that reliance on a Notice of Experiments may waive privilege in workup experiments but that here there are no relevant workup experiments. All data from all runs of each of the Experiments has been disclosed. In this context the Defendants assert workup experiments should go no further than other identical runs of the experiments set out in the ANOE. More particularly, if any experiments were conducted involving the KK 600 these would be different to the experiments relied on in the ANOE (which relate to the Standard Frame KKS). Further, that such experiments would not be relevant as the Defendants' expert has only relied on the Experiments in relation to the Standard Frame KKS. The Defendants also rely on the Claimant's knowledge of the details in the Experiments and that it had the opportunity to prepare responsive experiments. Also, regarding repeatability, the Defendants offered 'unlimited' repeats at the witnessed Repeats. It appears there is some debate about whether there was or was not time for

these Repeats to go beyond the two days over which they took place. Due to the information provided by the Defendants on all the runs of the Experiments using the same protocol I have not considered the repeatability of the precise protocol for the Experiments as significant in my assessments in this decision. Whether more time was available for further witnessed repeats is therefore not material.

74. These are a composition of some of the arguments from the parties. I have considered all the arguments and relevant documents in considering the Claimant's Application.

Assessment of the Claimant's Application

75. In considering my decision on this application I have taken into account the authorities I have been addressed on by the parties on privilege, waiver of privilege, waiver of privilege in documents relating to experiments, the alternative mechanisms in the CPR for approaching these issues and the modern approach to disclosure.

76. This application is emblematic of the issues that arise in a request for *Mayne Pharma* disclosure in a case other than the most straightforward type of case. The Claimant has gone to some considerable effort to try to evidence the fact there may be other related relevant experiments which have been conducted and have not been disclosed. In many cases (such as *Mayne Pharma*) there may be no information at all on whether any relevant underlying experiments may have been conducted. This is not a case like *Elektron*, where a narrative had been provided detailing relevant experiments. The current situation is more likely the usual one a party would experience where experiments are deployed. The opposite party will not unilaterally know what other relevant experiments may have taken place. The Deputy Judge in *Elektron* pre-empted this issue in part by discussing other CPR mechanisms which may be available in proceedings to identify relevant information in this context. These mechanisms could be used to try to identify if there are any other experiments which may be relevant. However, as is the case here, where a party asserts that, if there were any other experiments that information is privileged, there is a limit to what such mechanisms can elicit.

77. One way the assessment of these types of applications for specific disclosure could be assisted is for a party requesting permission to rely on experiments to be required to record the issues in the case the experiments and the facts are said to address. This would be a useful starting point for any subsequent application for specific disclosure. It may reduce the need for speculation on whether other experiments had actually taken place and rather focus on the purpose of the relevant disclosure which can then be considered in the context of that case.

78. In order to assess this application for disclosure it is necessary to first decide what, if any, waiver of privilege has taken place as a result of the Defendants' reliance on its ANOE. This is a case of voluntary disclosure and the court is therefore concerned with implied or consequential waiver of privilege. In these circumstances, it is important to take a 'relatively cautious and restrictive approach' to waiver of privilege in documents not deployed and that any waiver of privilege in such material should only be to the limited extent necessary. In order to assess the boundaries of any waiver of privilege I need to consider the issue in question the ANOE is deployed to address, also sometimes considered as identifying the underlying 'transaction'. This requires considering in the context of a case what the Defendants are seeking to disclose and what implied or express representations are relied on based on the facts it is said to evidence. This is a fact sensitive exercise.
79. Understanding what a 'trestle' is in the context of integers 1A and 1B of the Trestle patents is an important issue of dispute in the case. It has been the subject of debate in Part 18 requests and in the expert reports. It is explained that the construction of the meaning of this word in the context of these claims could determine non-infringement. The Defendants' expert provides his view to the court in his report, Santos, on the technical meaning of the term in this context to the relevant skilled person. For example he states at Santos [333] "the skilled person would understand that a builder's trestle is a self-standing support for a platform which will (with other trestles) support the platform in normal use without the need for any additional structural support." His report goes on to explain what he means by this in [334] onwards and in the context of his non-infringement analysis. His expert evidence, in explaining how the skilled person would understand the technical meaning of this term, goes to non-infringement on either the KK 600 or the Standard Frame KKS. This issue and the evidence on the technical meaning of the term 'trestle' within the claims is therefore argued by the Claimant to be tied-up with the deployed Experiments. That is, in adopting that meaning for construction, if there is experimental information that shows it is arbitrary or ambiguous in application i.e. it only works for Frames of a certain height, it is material that is required to be disclosed to avoid unfairness or misunderstanding of the results in the Experiments relied on by the Defendants. In my view, the purpose (or transaction) of the deployment of the ANOE is therefore to evidence the Trestles have a greater longitudinal stability than the Defendant's products in the PPD (the Standard Frame KKS and the KK600). The difference in the stability these Experiments are said to demonstrate is material to this point on construction. Therefore any other associated experiments which deal with the consistency of the relative stability of the triangular support Trestle said to be designed based on the Trestle Patents and the Defendants' products in issue

in the PPD (or variations on those) – is part of the express or implied purpose of the deployment of the ANOE.

80. To establish the technical meaning for 'trestle' relevant for construction of the claims the difference noted in longitudinal stability would need to be seen consistently in different conditions. Therefore, evidence on the relative differences of longitudinal stability in experiments with conditions varying the Frame size could be relevant to the proposition asserted by the Defendants' expert on the technical meaning of the term 'trestle's' and therefore to construction and infringement. In these circumstances, the current disclosure could potentially risk the "real weight or meaning being understood" on this point if there are any other experiments which were undertaken as noted. Having considered the evidence, the issue the deployment of the ANOE addresses has a scope which encompasses these additional experiments conducted at the NRFIS (if they exist).
81. In the circumstances, it is my assessment the Defendants' reliance solely on the Experiments in the ANOE could be a partial or selective disclosure from this underlying transaction. If there are experiments which, for example, under different conditions (height of the Frame) demonstrate different/reduced relative stability to the Trestle this could be information which is material to properly understanding the issue in question arising from the deployment of the ANOE. In considering this point I am conscious of the comments of Pumfrey J in *Mayne Pharma* relating to the particular role of objective experiment evidence. The nature of experimental evidence is that it can be an 'anchor' in uncertain waters. Its influence can be critical and therefore the partial disclosure of experiments which are part of the same 'transaction' or go to the same 'issue' can create particular prejudice. That is not to say experiments deployed in an infringement case invariably lead to disclosure of this type. The assessment on any waiver of privilege would depend on the facts of the case.
82. In considering the issue of any selective disclosure and fairness in the *Nea Karteria* sense some relevant factors I have considered are the extent the request for disclosure is suitably circumscribed, issue-specificity and the availability of alternative proportionate mechanisms to address any potential unfairness in the conduct of the trial arising from the disclosure. This is an example of a case where requests made for relevant workup/associated experiments have been narrowed to a relatively constrained issue and set of alleged experiments conducted at the NRFIS with a particular design. The Defendants' response to the requests for the disclosure are that it would not admit any such experiments exist but if they did they would be privileged. In the circumstances, there are limited options available to the Claimant other than this application. The Defendants assert that questions could have been asked of their expert on the

issue under Part 35 and/or in cross-examination. I am not convinced this would have resolved the matter or moved it further forwards. Where the Defendants' expert and its representatives rely on the substantive right of privilege in response to any such questions that is likely the end of the matter. There is also no guarantee the Defendants would not argue such questions may not be of a form permissible under Part 35. There was discussion that such responses could create an adverse inference from the court. It is possible, but in most circumstances I would not expect any specific adverse inference to arise simply from a refusal to answer a question due to privilege.

83. In *Fulham Leisure Holdings Limited v Nicholson Graham & Jones* [2006] EWHC 158 (Ch) at [7] Mann J references *R v Secretary of State for Transport Ex parte Factortame* [1997] EWHC Admin 445 (7 May 1997). In that case the Judge found it was not a partial disclosure, rather one of severability, where the Secretary of State relied on disclosed legal advice prior to a specific date to explain his conduct but did not seek to take unfair advantage of this disclosure after that date. However, the Judge indicated this behaviour may give rise to suspicion and adverse inference. This is not a case of a comparable nature. This case is closer to the situation that the Experiments have been relied on for one purpose (non-infringement) but if 'plucked' from a group of relevant linked experiments could create unfairness by partial disclosure. Even if this was somehow a severance situation, which it is not in my assessment, there would be little to guide any court on whether reliance on privilege should attract any adverse inference in answer to allegations that there may be other relevant experiments .

84. The Defendants also assert the Claimant could have run responsive experiments on the same issue as they seek disclosure. There is some strength in this point. However, bearing in mind the cost of experiments and the proportionality of the specific disclosure exercise compared with further experiments, I do not believe this significantly impacts on my assessment of the potential partial disclosure here.

85. It is therefore my judgment, taking all these circumstances into account and for the reasons stated, that the Defendants' reliance on the ANOE is an implicit or consequential waiver of privilege in the material in which disclosure is sought from any experiments dealing with relative longitudinal stability of the PPD products (or variants) and the Trestle.

86. The Claimants also argued the issue of any waiver of privilege in this material could be justified in the alternative where the 'transaction' identified was limited to the Defendants' reliance on the ANOE for non-infringement of its Standard Frame KKS.

87. In considering this alternative position it initially appeared a more finely balanced issue. However, once I had the opportunity to consider all the relevant materials the issue seems to come back to effectively the same point on the consistent application of the technical meaning of the term 'trestle' in the context of the claims of the Trestle Patents.
88. On this argument, the Experiments in the ANOE are ostensibly deployed for the stand-alone issue of demonstrating non-infringement of the Standard Frame KKS. The argument is they can be assessed solely on the basis of the empirical information in the ANOE (really the Repeats) and that any issues concerning repeatability/reliability of the protocols for the Experiments have been dealt with by disclosure of any identical runs and the offer of 'unlimited' repeats. As I mentioned earlier, it appears Santos has been prepared such that the expert does not try to expressly rely on the Experiments in relation to his arguments for non-infringement of the KK 600. If there are associated experiments conducted at the NRFIS on the longitudinal stability of the KK 600 which may go to the issue of non-infringement the Defendants have chosen not to deploy them in the case and their position is they therefore remain privileged.
89. The Defendants' expert was asked to prepare experiments that help quantify differences or similarities in performance between the "Kwik Kage Frame" and the "Trestles" (Santos [425]). The Experiments were carried out on the Standard Frame KKS as referred to in the PPD (Santos [429]). The Experiments provided information on Resistance to Displacement (Santos [448]). Dr Santos goes on to explain that the information on the Resistance to Displacement may suggest levels of steadiness, stability or safety in use. This does not appear to be a statement specific to the Standard Frame. He follows this with a statement that [451] "... the skilled person would consider it important to have a work platform that is sufficiently steady...", that [480(5)] the Frames (Standard Frames) "... do not function as Trestles, either individually or as a set of four because Trestles have substantially greater stability in the longitudinal direction.", [481] "Experiments 1 to 3 support each of these conclusions, and confirm my opinion that this is what the skilled person would have concluded. The Frame, whether weighted or unweighted, has substantially less longitudinal stability than the Trestle.", and at [483] "The Frames are not providing the minimum stability that would be expected of a trestle...".
90. In my assessment, the Experiments link what Santo's says is the correct technical understanding of the term 'trestle' in the claims to the relative longitudinal stability of the Standard Frames to the Trestles. Dr Santos is aware of all the experiments undertaken by the Defendants – he designed them for the purpose noted. This would therefore include any experiments in the redacted 23 noted in the NRFIS Report. The definition used to explain what physical tests

Santos designed (Santos [425]) appears to mean either he designed these experiments only for the Standard Frame KKS or for Kwik Kage Frames with varying parameters. If there are other underlying experiments (the NRFIS document indicates these would all be tested 'applying a horizontal load' in the same way as for the Experiments) for Standard Frame KKS or for Kwik Kage systems with other parameters but again for assessing the Defendants products in the PPD (or variants) for longitudinal stability against Trestles these could provide material information on the meaning of the technical term 'trestle' and its consistent application and therefore also for infringement. For example, if the height of the Frame is varied in the protocol for the Experiments and the relative stability to the Trestle changed how would that impact on the arguments in the case with only the ANOE deployed? It is not necessary to reach any conclusion. It seems to me there is a real risk in these circumstances that disclosure of any such associated experiments are needed so that the court has the complete material to make a fair assessment. Dr Santos appears to have designed the litigation experiments for the purpose of helping him assess the noted stability in the context of his understanding of how the skilled person would understand the term 'trestle'.

91. The requested specific disclosure in this application of these related experiments which could inform the understanding of the non-infringement assessment (if they exist) is not in the class of 'rummaging around' to answer some potential questions on the validity of material actually deployed. This analysis serves to confirm the interlinked nature of these issues. If there are other experiments conducted which demonstrate there is a risk there is not a significant disparity between the lateral stability of the Defendants' products in the PPD or products with similar parameters (i.e. different Frame heights) and the Trestles these would be potentially relevant to the consistency of the technical meaning of the term 'trestle' and/or the weight given to the Experiments in the ANOE. Therefore, if there are related tests on Frames going to the issues noted on longitudinal stability then the deployment of the ANOE for the non-infringement arguments on the Standard Frame KKS would in these circumstances be part of that same broader transaction as identified above. Any other experiments conducted by the NRFIS in this matter on the Frames on the issue of lateral stability in the Experiments extend to any other experiments going to the same issue, even where the protocol is not identical. I have already considered the issues on fairness and necessity above. These apply equally here.

92. Therefore, considering the information in the matter from this alternative perspective, I still come to the conclusion taking all these circumstances into account, for the reasons stated, the Defendants' reliance on the ANOE is an implicit or consequential waiver of privilege in the material in which disclosure is sought from any experiments dealing with relative longitudinal stability of the PPD products (or variants) and the Trestle. I do not repeat my considerations of

the other factors set out above but confirm they remain equally relevant to this alternative consideration.

93. This is the position under normal construction. I arrive at the same conclusions for the same reasons on the basis of the Defendants' deployment of the ANOE for non-infringement under the doctrine of equivalence. The Defendants' case on non-infringement by equivalents deals with the relevance of the meaning of 'trestle' (Dr Santos [407]) where it is the basis for his assertion the Kwik Kage System does not achieve substantially the same result as the inventive concept (of each of the Trestle Patents) "...because the Kwik Kage System does not include a trestle with an integral upward extension and a removable upright.". At [408] Dr Santos confirms in this context again that:

"As I explained above in my analysis of normal infringement in the context of the '978 Patent, in my view, the skilled person would consider that the words "supported in use to make a platform" would require that the platform supported by the trestle has acceptable levels of longitudinal stability in the manner described above in the discussion of integer 1A of the '978 Patent: see paragraphs 333-355 above. The skilled person would further understand that the builder's trestle referred to at integer 1B would provide minimum acceptable levels of such stability."

94. In considering the application for specific disclosure under PD57AD I need to also consider whether to order specific disclosure of the material (if it exists) that no longer attracts privilege. Paragraph 18.2 of PD57AD requires the variation to the order for Extended Disclosure to be "necessary for the just disposal" of the proceedings. The disclosure must also be reasonable and proportionate (as defined in paragraph 6.4). The disclosure requested is 'at a high level of specificity' and limited to experiments (where they exist) with a specific purpose. The potential probative value where the experiments noted exist, the importance to the case, relative ease of the disclosure exercise and the context in this significant case and the limited nature of the disclosure together all militate toward this being a reasonable and proportionate exercise in the circumstances. In any event, the parties do not dispute the disclosure could be dealt with quickly and efficiently. However, there will likely be consequential costs, including potential supplemental expert reports.
95. In coming to my views above an assessment has been undertaken that, where the noted associated experiments exist, these should be disclosed as part of the material relevant to the issue in question that has been identified. The necessity of the disclosure is apparent from the same assessment. The just disposal of the case here requires the noted disclosure to avoid any

potential risk of injustice where all the relevant material to the issue identified is not before the court.

96. In summary, for the reasons given, I regard the deployment of the ANOE by the Defendants as an implicit or consequential waiver of privilege in any experiments conducted and recorded in the NRFIS Report which go to the relative longitudinal stability of the Trestle and the Defendants' products in issue in the PPD (or variants of those, for example height of the Frame).

Unredacted Section 2 of the NRFIS Report

97. The Claimant's Application also requests disclosure of Section 2 of the NRFIS Report and any other sections of that document which relate to non-confidential material on the keyboard experiments (paragraph 1.2 and 2 of the draft Order). The Notice of Experiments contained experiments 4 to 6 which dealt with keyboard brackets and are no longer relied on by the Defendants.

98. This request is a technical one. The Defendants have voluntarily disclosed the NRFIS Report. PD57AD provides at paragraph 16 that – as far is relevant here - a disclosed document can only be redacted where information is irrelevant and confidential or it is privileged. No point is taken that there is any distinction made under PD57AD 16 between documents disclosed voluntarily or under a court order. It appears to be accepted that to the extent the redacted information relates to experiments 4 to 6 from the Notice of Experiments the information is irrelevant. The point made is that where the redacted information is not confidential as between the parties in the proceedings it should not be redacted. The Defendants rely on this exercise being disproportionate and unnecessary because of its irrelevance. The Claimant says this is a mandatory provision and the Defendants should comply.

99. The Claimant separately submits that elements of the document have been redacted which relate to matters of general application on how the experiments in the document were conducted. It says these relate to all the experiments in Section 1 of the document – including the Experiments relied on by the Defendants and that these sections should therefore not be redacted as it does not understand how they can be privileged or irrelevant. Finally, the Claimant is concerned that other parts of the document have privilege claimed without appropriately detailed explanation of the basis (PD57AD 16.2). The Defendants say a high level explanation of the privileged sections has been given – see Peyman.

100. The relevant document is about 15 pages long. Two of those pages relate to these disputed redactions (purple redactions). Most of the remainder of the document is redacted for the

sections where privilege is asserted. The explanations on privilege are very high level. This is a complex and significant case. The work needed is minimal in context to comply with the requirements of PD57AD 16 where the redactions cover only a couple of pages. The Defendants did not assert the material (or much of it) was confidential. Based on the proportionality of this matter in this context and the need to comply with the court rules it is my decision that the Defendant's should provide a compliant version of the NRFIS Report that removes redactions of material which is irrelevant and is not confidential.

101. I also agree with the Claimant's position that an appropriately detailed explanation of any privileged sections remaining in the NRFIS report should be provided to the Claimant. However, based on my finding in the Claimant's Application on waiver of privilege it seems sensible to revisit the document on this point once any elements where privilege has been waived are identified.

102. I will address the parties on the form of order and directions at the consequential hearing of this decision.

Annex A

Reproduced paragraphs [37] – [82] from *Magnesium Elektron Limited v Neo Chemicals & Oxides (Europe) Ltd (No.2)* [2017] EWHC 2957 (Pat)

LAW

Principles

37.

The principles applicable to this case lie at the intersection of several areas of procedural law: (i) privilege (ii) waiver of privilege (iii) waiver of privilege in material relating to experiments pursuant to *Mayne Pharma* (iv) disclosure and alternatives. It is therefore necessary to say something about each of these areas in turn since they each have an impact on the approach that should be taken to Birss J’s order. In doing so, I have drawn for illustrative examples on some of the additional authorities not specifically mentioned by the parties but cited in the text of which extracts were provided or in other cited cases.

(i) Privilege

38.

As counsel for MEL submits, legal professional privilege is a fundamental right, which has long been regarded as essential for the purposes of the rule of law and access to justice (see *Three Rivers District Council v Bank of England (No. 6)* [2004] UKHL 48, [2005] 1 AC 610, [23]-[34] (Lord Scott of Foscote) and *General Mediterranean Holdings SA v Patel* [1999] EWHC 832 (Comm), [2000] WLR 272, 280F-291E (Toulson J) where the principles were summarised.

39.

Lord Taylor of Gosforth CJ said in *R v Derby Magistrates’ Court ex parte B* [1996] AC 487, 507:

“The principle which runs through all these cases, and the many other cases which were cited, is that a man must be able to consult his lawyer in confidence, since otherwise he might hold back half the truth. The client must be sure that what he tells his lawyer in confidence will never be revealed without his consent. Legal professional privilege is thus much more than an ordinary rule of evidence, limited in its application to the facts of a particular case. It is a fundamental condition on which the administration of justice as a whole rests”.

40.

Legal professional privilege also extends to communications with a third party for the purposes of litigation because it is a single privilege encompassing both legal advice privilege and litigation privilege (see *Three Rivers (No. 6)* at [105] (Lord Carswell)). The strength of the principle is reinforced by the fact that, although legal professional privilege can be abrogated by statute, that can only be done by clear words (see *General Mediterranean*). It is not possible for the court to create exceptions to it.

41.

In addition to its substantive importance, these principles also inform the interpretation of provisions said to affect privilege. The House of Lords has held that construction of a statute needs to be done against the background of these principles where a proposed interpretation

may place them in jeopardy. Thus, in *Special Commissioner and Another, Ex P Morgan Grenfell & Co Ltd, R v.* [2002] UKHL 21 (16th May, 2002), Lord Hoffmann said:

“7. Two of the principles relevant to construction are not in dispute. First, LPP is a fundamental human right long established in the common law. It is a necessary corollary of the right of any person to obtain skilled advice about the law. Such advice cannot be effectively obtained unless the client is able to put all the facts before the adviser without fear that they may afterwards be disclosed and used to his prejudice. The cases establishing this principle are collected in the speech of Lord Taylor of Gosforth CJ in *R v Derby Magistrates Court, Ex p B* [1996] AC 487 . It has been held by the European Court of Human Rights to be part of the right of privacy guaranteed by article 8 of the Convention (*Campbell v United Kingdom* (1992) 15 EHRR 137; *Foxley v United Kingdom* (2000) 31 EHRR 637) and held by the European Court of Justice to be a part of Community law: *A M & S Europe Ltd v Commission of the European Communities* (Case 155/79) [1983] QB 878 .

8. Secondly, the courts will ordinarily construe general words in a statute, although literally capable of having some startling or unreasonable consequence, such as overriding fundamental human rights, as not having been intended to do so. An intention to override such rights must be expressly stated or appear by necessary implication. The speeches of Lord Steyn and myself in *R v Secretary of State for the Home Department, Ex p Simms* [2000] 2 AC 115 contain some discussion of this principle and its constitutional justification in the context of human rights. But the wider principle itself is hardly new. It can be traced back at least to *Stradling v Morgan* (1560) 1 Pl 199.”

42.

The same must apply to construction of an order of the court and should inform what order a court should make in future. As to the approach to construction generally, that set out by the Privy Council in *Sans Souci Ltd v VRL Services Ltd (Jamaica)* [2012] UKPC 6 (7 March 2012) namely that a judgment may be used to construe an order is applicable in principle but is not of great assistance because Birss J did not address the specific point in issue here in his judgment.

(ii) Waiver of privilege

43.

While privilege is to the extent described above an absolute right, it may be voluntarily eroded or destroyed by waiver. The circumstances in which privilege is to be treated as waived is one of the age-old questions in civil litigation and often gives rise to difficulties. No less troublesome is the issue of scope of waiver of privilege: the effect of waiver of privilege in one document or part of a document on the privilege attaching to other documents or parts of them. An illustration of this comes from the treatment of the subject in *Matthews & Malek on Disclosure*, 5th Edition (2017) (“Matthews & Malek”) which says at para. 16.40 that where waiver of privilege before trial is concerned there is a conflict of authority “as to whether waiver is confined to the document or documents concerned...or goes wider [extending to “all material dealing with the transaction the subject of the documents concerned”]. It is well established that deployment of a document at trial may result in a waiver of privilege in other related material (see *Nea Karteria Maritime Co v Atlantic & Great Lakes Steamship Corporation* [1991] ComLR 138, 139 (Mustill J)). The correct approach, derived from *Nea Karteria*, in such cases was summarised in *Matthews & Malek* in an oft cited passage:

“The general rule is that:

Where a person is deploying in court material which would otherwise be privileged, the opposite party and the court must have the opportunity of satisfying themselves that what the party has chosen to release from privilege represents the whole of the material relevant to the issue in question. To allow an individual item to be plucked out of context would be to risk injustice through its real weight or meaning being misunderstood.

The key word here is “deploying”. A mere reference to a privileged document in an affidavit does not of itself amount to a waiver of privilege, and this is so even if the document referred to is being relied on for some purpose, for reliance in itself is said not to be the test. Instead, the test is whether the *contents* of the document are being relied on, rather than its *effect*. The problem is acute in cases where the maker of an affidavit or witness statement has to give details of the source of his information and belief, in order to comply with the rules of admissibility of such affidavit or witness statement. Provided that the maker does not quote the contents, or summarise them, but simply refers to the document's effect, there is apparently no waiver of privilege. This benevolent view has not been extended to the case where the maker refers to the document in order to comply with the party's need to give full and frank disclosure, e.g. on a without notice (*ex parte*) application”.

44.

This passage has been regularly approved including by the Court of Appeal. For example, in *Dunlop Slazenger International Ltd v Joe Bloggs Sports Ltd* [2003] EWCA Civ 901 at [11] (Waller LJ) and it was said to be “a convenient summary of the principle and the effect of former cases” in *Lucas v Barking, Havering & Redbridge Hospitals NHS Trust* [2003] EWCA Civ 1102, [2004] WLR 220, [19] (Waller LJ).

45.

The passage nonetheless merits additional comment.

46.

First, notwithstanding the strength of the rule protecting legal professional privilege, once there has been deployment of some otherwise privileged material, the courts are reluctant to permit selective deployment. But, the passage gives no specific guidance as to what further material is required or a formula to determine precisely how the scope of the waiver is to be determined.

47.

Second, it has been repeatedly held (or it is implicit) that deployment of a document does not automatically open a floodgate to a wide destruction of privilege more broadly. The approach of *Nea Karteria* prevents individual documents or parts of documents from being put before the court so as to avoid the document deployed not being seen in its proper context. It is not, however, a rule which provides that, once a privileged document is deployed, all privileged documents related in some general way to that document or which can, in a general sense, be described as “relevant” to the issue must also be disclosed even if they deal directly with the subject matter in hand. That appears from Mustill J’s consideration of two categories of documents in the *Nea Karteria* case itself. On one side were the questions put by a lawyer of which the answers were deployed so as to waive privilege in the answers: held - privilege waived in the questions as well. On the other side were instructions to the lawyer: held - privilege not waived in these documents forming part of the “prior history”. Moreover,

Mustill J referred to the proposition in the commonly cited passage as the principle “underlying the rule of practice exemplified by *Bucknell v. British Transport Commission*” [1956] 1 QB 187. In that much earlier case, a witness for the plaintiff was under cross-examination when counsel for the defendant asked him whether he had said X or Y in a statement. The witness agreed that he had. Counsel for the plaintiff then called for the statement but the defendant’s counsel declined to provide it saying it retained its privilege. Production was ordered by Sellars J and the whole statement was put in evidence. The Court of Appeal unanimously dismissed an appeal. Denning LJ said at 190:

“...although this statement may well have been privileged from production and discovery in the hands of the [defendant] at one stage, nevertheless when it was used by cross-examining counsel in this way he waived privilege, certainly for that part which was used; and in a case of this kind, if the privilege is waived as to the part, it must, I think be waived also as to the whole. It would be most unfair that cross-examining counsel should use part of the document which was to his advantage and not allow anyone not even the judge or opposing counsel, a sight of the rest of the document, much of which might have been against him.”

48.

The “whole” was the whole witness statement in that case. There was no suggestion that deployment of that statement would open up a range of other documents on the basis that privilege had been waived in them as well because they were directly related to the issue.

49.

However, in some cases citing the *Nea Karteria* passage, waiver of privilege in a document has been held to extend not just to the document as a whole but to other documents forming part of the transaction or communication in question. In *Dunlop*, where the rule was described as one designed to avoid “cherry picking”, privilege was held to be waived in the whole of the communications, not just the whole of a single document. Thorpe LJ referred to “the whole of the privileged document or conversation which the contents have revealed” namely “documents relating to the communications surrounding the key date in February 2003 and redacting any advice to the defendants” at [19], although the court specifically excluded “advice from the solicitor i.e. client solicitor advice” (see e.g. at [17]). In one sense, of course, *Nea Karteria* was itself such a case of waiver of privilege in additional material but it was perhaps better seen as a situation in which a full set of both questions and answers was ordered to be disclosed in circumstances where a party was seeking to deploy the answers.

50.

It is at this point that difficulties set in with applying the proposition in *Nea Karteria*. As soon as it is accepted that privilege may have been waived in other documents forming part of a transaction or communication where one of the documents of that transaction or overall communication is deployed, the principle of implied or consequential waiver has broken loose from its narrow origins in *Bucknell* or *Nea Karteria*. Once it is free from the bounds of a document (or a question/answer session), working out precisely how it should be limited is not easy. That is made more challenging by reflecting on the fact that what is contemplated is an *implied* or consequential waiver of an absolute right which is otherwise regarded as particularly strong.

51.

The scope of this implied or consequential waiver is described in the case law in terms of potentially flexible meaning related to avoidance of unfairness. These terms have included:

“unfair” to avoid parts of a document which might have been “against” the deployer being seen (*Bucknell*); “relevant to the issue... risk injustice...through real weight or meaning being misunderstood” (*Nea Karteria*); preventing “cherry picking” (*Dunlop*); “avoid unfairness or misunderstanding” (*Fulham* - cited below, relying on *Paragon* also cited below) and various other ways in which the scope of waiver has been defined in the cases. Of course, what may be required to avoid unfairness in any given case is itself open to debate: one person’s cherry picking may be another person’s reasonable and proportionate putting forward of only that which is relevant.

52.

It is not possible to avoid these difficulties altogether by reference to waiver of privilege taking place in the “transaction” as a whole, since that begs a related question of how the boundaries of the “transaction” are to be determined. There is, as Matthews & Malek acknowledges at para. 16.40, “room for argument in any given case as to what constitutes the “transaction” in question” and whether, even if that can be determined, the boundaries of implied or consequential waiver of privilege are limited to that.

53.

A helpful illustration of these issues comes from the judgment of Mann J in *Fulham Leisure Holdings Ltd v. Nicholson Graham & Jones* [2006] EWHC 158. Although it was not discussed by the parties before me, the passage in Matthews & Malek which refers to it was not suggested to be wrong in summarising the issues by reference to this authority. It is more useful to reproduce an extract from the case itself, since it contains a review of other cases in which the principle is discussed and applied. Mann J said:

“11. Based on the authorities which I am about to refer to, it seems to me that the relevant process should be as follows:

- i) One should first identify the "transaction" in respect of which the disclosure has been made.
- ii) That transaction may be identifiable simply from the nature of the disclosure made – for example, advice given by counsel on a single occasion.
- iii) However, it may be apparent from that material, or from other available material, that the transaction is wider than that which is immediately apparent. If it does, then the whole of the wider transaction must be disclosed.
- iv) When that has been done, further disclosure will be necessary if that is necessary in order to avoid unfairness or misunderstanding of what has been disclosed.

That chain is not articulated in terms in the authorities to which I am about to refer, but it seems to me that it is apparent from it.

12. The starting point to me seems to me to identify what Hobhouse J called the "transaction" in *General Accident Fire and Life Assurance Corp Ltd v Tanter* [1984] 1 WLR 100. In that case Hobhouse J was dealing with a wide ranging request for disclosure and inspection of otherwise privileged documents (covered by legal professional privilege), on the basis of use of one note at a trial. Hobhouse J refused to order that disclosure, and in the course of his judgment he considered the then existing authorities on the point. At page 111, he cited part

of the judgment of Cotton LJ in *Lyell v Kennedy* 27 Ch D 1, which he described as "the cardinal quotation":

"There was this contention raised, which I have not forgotten, that the defendant had waived his privilege, and therefore could not claim it at all. That, in my opinion, was entirely fallacious. He had done this, he had said 'Whether I am entitled to protect them or not I will produce certain of the documents for which I had previously claimed privilege – I will waive that and I will produce them' but that did not prevent him relying on such protection with regard to others which he did not like to produce. It is not like the case of a man who discloses part of a conversation and then claims protection for the remainder, and we think there is no ground for the contention that there has been here a waiver of privilege."

13. It is apparent from that that it is open to a party to disclose some but not all of the documents falling within a privileged category. If further authority for that proposition is required, it is to be found in *Paragon Finance v Freshfields* [1990] 1WLR 1183 at p.1188D where Lord Bingham of Cornhill CJ said:

"While there is no rule that a party who waives privilege in relation to one communication is taken to waive privilege in relation to all, a party may not waive privilege in such a partial and selective manner that unfairness or misunderstanding may result."

14. The question therefore arises as to where the boundaries of the waiver are, or are taken to be. The first boundary is defined by reference to the "transaction" in relation to which disclosure is made. In the course of his judgment in *Tanter Hobhouse J* summarised various principles which applied and they included the following (at pp.114 – 5):

"Sixth, by adducing evidence at a trial one does get involved in potential further waiver. The underlying principle is one of fairness in the conduct of the trial and does not go further than that. The fact that this principle does not arise unless you adduce the evidence at the trial is clearly stated in the judgment of Mustill J [in the *Nea Karteria* case] and it was clearly raised by the facts in the *Doland* case and it was likewise raised by the facts in the *Great Atlantic* and *Burnell* cases. Further, if the evidence is adduced, then the extent of the waiver relates to the transaction to which that evidence goes. The extent of the transaction has to be examined and where it is what somebody said on a particular occasion, then that is the transaction. It is not the subject matter of those conversations. It does not extend to all matters relating to the subject matter of those conversations." Hobhouse J's principles, including that one, were cited with approval by the Court of Appeal in *Tanap Investments (UK) Ltd v Tozer* (unreported, 11th October 1991, Balcombe and Taylor LJJ). It is from his sixth principle that the need to identify the transaction is apparent. It is the first means of ascertaining what limits there are to the waiver that has been made.

15. Earlier passages in Hobhouse J's judgment shed light on what he means by the "transaction". At page 113 he considers the judgment of Mustill J in the *Nea Karteria* case and says:

"Furthermore, he applies what for convenience can be called a single transaction test. He looks to see what is the issue in relation to which the material has been deployed. He held that the issue was what was said at the meeting between the lawyer and the Greek seaman, and the correct evaluation of that meeting, but he did not accept that it extended to other matters which did not form part of the transaction.... Furthermore, it is central to Mustill J's

judgment that you must define what is the subject matter with which you are concerned. He did not treat the subject matter as all the things about which the seaman spoke, but he merely treated as the subject matter what had been said on that occasion." At page 114C, applying his principles to the facts of his case (which involved the disclosure of information about one conversation) he said: "What will have happened is that the putting into evidence of that document will have opened up the confidentiality of that transaction. It has not opened up the confidentiality of later privileged communications....."

That process enables the parties and the court to identify how far the disclosing party has gone (it being that party's right to limit waiver if he wishes to do so).

16. A similar approach can be detected in the judgment of Auld LJ in the *Factortame* case, though he uses different language. In that case (of which only an unpaginated transcript was made available to me) he started his analysis by referring to the:

"...classic judicial statement of principle...of Mustill J in *Nea Karteria* at 139: 'Where a party is deploying in court material which would otherwise be privileged, the opposite party and the court must have an opportunity of satisfying themselves that what the party has chosen to release from privilege represents the whole of the material relevant to the issue in question. To allow an individual item to be plucked out of context would be to risk injustice through its real weight or meaning being misunderstood.'" The most obvious application of that principle is in relation to a single document, where a party waives privilege as to part of it but seeks to withhold the rest of it..... It also extends to attempted partial waiver of privilege in respect of certain of a number of documents relevant to the same issue or transaction. Of course, the scope for unfairness depends on the breadth of the matter in issue or their severability if more than one, and on the exact relationship and/or relevance to such issue(s) of the documents respectively disclosed and sought to be withheld. It may or may not be that partial disclosure of documents going to a matter or matters in issue, say in an exchange of correspondence with legal advisers, would be unfair." Much depends on whether the party making partial disclosure seeks to represent by so doing that the disclosed documents go to part or the whole of an 'issue in question', the expression used by Mustill J in the passage from his judgment in *Nea Karteria* that I have cited. The issue may be confined to what was said or done in a single transaction or it may be more complex than that and extend over a series of connected events or transactions. In each case the question for the court is whether the matters in issue and the document or documents in respect of which partial disclosure has been made are respectively severable so that the partially disclosed material clearly does not bear on matters in issue in respect of which material is withheld. The more confined the issue, for example as to the content of a single document or conversation, the more difficult it is likely to be to withhold, by severance, part of the document or other documents relevant to the document or conversation."

17. In that passage, Auld LJ refers to the "transaction" but he also uses the expression "issue", which was the word used by Mustill J in *Nea Karteria*. He is apparently using the same concept as that deployed by Hobouse J.

18. What those citations show is that it is necessary to bear in mind two concepts. First of all, there is the actual transaction or act in respect of which disclosure is made. In order to identify the transaction, one has to look first at what it is in essence that the waiving party is seeking to disclose. It may be apparent from that alone that what is to be disclosed is obviously a single and complete "transaction" – for example, the advice given by a lawyer on

a given occasion. In respect of disclosure before a trial that may be all that the non-disclosing party has to go on, because a wider context may not yet be apparent (or at least not until the exchange of witness statements). This may explain the contrast that Hobhouse J drew between disclosure before a trial and deployment at trial. However, in order to ascertain whether that is in fact correct one is in my view entitled to look to see the purpose for which the material is disclosed, or the point in the action to which it is said to go. That explains at least some of the references to the "issue" or "issues" in the judgments of Auld LJ and Mustill J. Mr Croxford submitted that the purpose of the disclosure played no part in a determination of how far the waiver went. I do not agree with that; in some cases it may provide a realistic, objectively determinable definition of the "transaction" in question. Once the transaction has been identified, then those cases show that the whole of the material relevant to that transaction must be disclosed. In my view it is not open to a waiving party to say that the transaction is simply what that party has chosen to disclose (again contrary to the substance of a submission made by Mr Croxford). The court will determine objectively what the real transaction is so that the scope of the waiver can be determined. If only part of the material involved in that transaction has been disclosed then further disclosure will be ordered and it can no longer be resisted on the basis of privilege.

19. Once the transaction has been identified and proper disclosure made of that, then the additional principles of fairness may come into play if it is apparent from the disclosure that has been made that it is in fact part of some bigger picture (not necessarily part of some bigger "transaction") and fairness, and the need not to mislead, requires further disclosure. The application of this principle will be very fact sensitive, and will therefore vary very much from case to case, as Auld LJ observed in the first paragraph of his judgment cited above. It is in this sense too that the disclosure may be partial. It is part of some greater whole, not necessarily part of some larger individual transaction. I confess, with all due respect, to having had some difficulty in understanding precisely what he meant in the last sentence of the citation, but I think that my analysis is consistent with his judgment.

20. I think that the point can be illustrated by how the principles worked in the *Factortame* case itself. One of the issues in that case was whether or not the United Kingdom's infringement of community law was intentional or reckless. The government had received advice from time to time on the legality of the legislation, and that went to the issue I have just referred to. The Secretary of State waived legal professional privilege in respect of legal advice up to a date in October 1987, but did not waive it for advice given after that date. That limitation was challenged, and it was said that in the light of the way that it took place, there should "in fairness" also be disclosure for a later period. The Court of Appeal held that the limitation of disclosure was not inconsistent with principle. The Secretary of State expressly stated that he would not suggest at the trial that his conduct after the October date was governed by the disclosed legal advice received before that date. Auld LJ held that in the light of that:

"It is not a case of partial disclosure in relation to his conduct throughout the period in issue, but one of clear severability over two periods within it and of the disclosed and undisclosed documents relating respectively to each period. If the Secretary of State keeps to Mr Richards' word, I can see no unfairness to the applicants.... If the Secretary of State does not seek to take an unfair advantage of his partial discovery at the trial, whether as a matter of evidence or argument, the applicants would be entitled to invite the trial judge to reopen the matter and determine whether there should be further disclosure." Auld LJ did not at that point identify what the particular transaction was for these purposes, but it is to be inferred that it

was one of two things. It was either the giving of advice on each relevant occasion, or, more likely, the giving of advice on the legal issue in question across the period in question, which presumably comprised several events. I say that the latter is more likely, because Auld LJ took the advice across the period as in effect one entity. One can only do that if one looks to some extent at the purpose of the disclosure, that is to say the reliance that would be placed on it in the proceedings. Since advice was only being relied on in order to support the government's case on its mental state for a certain period, that both defined and limited the transaction in question. However, if it were to transpire that use was to be made of the discovery outside that period and purpose, then it might transpire that that use would be unfair and that further matters would be opened up. Whether that is because the waiver would be taken to have been extended by virtue of the unfairness of limiting it, or whether it is because there is a separate principle of unfairness operating alongside or concurrently with the extent of the actual waiver, does not matter for these purposes. That is how the scheme seems to me to operate.”

54.

As can be seen from this extract, Mann J did not find it wholly straightforward to reconcile the various authorities relating to this issue but drew from them an approach that involved identifying, first, the transaction and considering, second, whether there was any separate principle of unfairness operating alongside or concurrently.

55.

It is also useful to refer to one more case discussed by Mann J and referred to in Matthews & Malek to illustrate a further aspect of the application of *Nea Karteria*. In *Fulham* at [7], Mann J cited *R v Secretary of State for Transport Ex parte Factortame* [1997] EWHC Admin 445 (7 May 1997). In that case Auld LJ referred to *Nea Karteria* and said (in the passage following that cited in the judgment of Mann J above):

“28. As Mr Richards observed, all or most of the reported cases deal with narrow issues of that sort. See e.g. the *Great Atlantic*, per Lord Templeman at 536D-F; *Konigsberg*, per Peter Gibson J at 1265C-G; and *Derby v. Weldon (No 10)*, per Vinelott J at 918a-b.

In *Konigsberg* the matter in issue was a transfer of land and the question was whether it was a gift or a sale. Peter Gibson J held that the party asserting that it was a sale and who had waived privilege in respect of a letter from her solicitor apparently supporting her case, could not claim privilege in respect of an affidavit sworn by him doubting it. Where the issue is broad, or there are several of them, or where the history giving rise to the litigation is long and/or complicated, partial disclosure which is clearly confined in its impact to one aspect of the case may well not require the all or nothing approach. In such a case it is not, in my view, apt terminology to ask whether a series of connected events or matters is a single "transaction" or series of separate "transactions" for this purpose. Where a party's conduct over a period of time is in issue the effect of partial disclosure of documents must depend on the particular facts of the case, usually as seen before trial in the pleadings and in other interlocutory battle-lines drawn by the parties.

29. As I have said, on this application Mr Richards has stated that the Secretary of State will not suggest at the trial that his conduct after 29th October 1987 in relation to the enactment and implementation of the 1988 Act was governed by the disclosed legal advice that he received before that date. It is not a case of partial disclosure in relation to his conduct throughout the period in issue, but one of clear severability of two periods within it and of the disclosed and undisclosed documents relating respectively to each period. If the Secretary of

State keeps to Mr Richards' word I can see no unfairness to the applicants. The applicants and the Court know his stance, that of a party prepared to reveal the legal advice that he received as to his conduct over one period but not over another, with all the suspicion and adverse inference that that may engender. If the Secretary of State does seek to take an unfair advantage of his partial discovery at the trial, whether as a matter of evidence or argument, the applicants would be entitled to invite the trial judge to re-open the matter and determine whether there should be further disclosure.”

56.

Mann J noted that Auld LJ said that this authority justified resolving the situation by reference to the principle of “fairness”. *Factortame* is a further illustration of the issue, discussed in *Nea Karteria* and canvassed in argument on the present application, that one of the most relevant factors in determining whether privilege should be treated as impliedly or consequentially waived is the purpose for which the document in question was deployed and the consequences which may flow if privilege is asserted. *Factortame* is also a good example. The Court of Appeal extracted a heavy price from the Crown in its attempt to preserve privilege in later legal advice. The Secretary of State was, in effect, forced to disavow any intention of arguing that the more favourable advice given earlier represented the position at a later, and arguably more relevant, time. Moreover, the Court of Appeal recognised that asserting privilege may engender “suspicion and adverse inference”.

Implied or consequential waiver

57.

One other point to emerge from *Nea Karteria* and illustrated elsewhere is that the court should treat the scope of waiver as determined in part by the scope of deployment. Again, *Factortame* provides a convenient illustration. Despite having disclosed the earlier privileged opinion, the Secretary of State was able to avoid disclosure of later privileged opinions by disavowing reliance on the earlier opinion as governing the later position. This shows that the approach to implied or consequential waiver is not necessarily a “once and for all” position where the court is required to determine, as a matter of quasi-historical fact, what the scope of waiver was. To the contrary, the law operates an element of consequential procedural control following deployment of a document where the scope of waiver is a function of the contents of the document and the nature of its deployment: “if you are going to rely on privileged document A to contend that it shows X, the scope of waiver is S(A,X); if you are going to rely on A to contend that it shows Y, the scope of waiver is S(A,Y) – which may not be the same”. That is one reason why I have preferred to use the term “implied or consequential” waiver in this judgment.

58.

The authorities subsequent to *Nea Kerteria* are therefore consistent with this somewhat more sophisticated approach to implied waiver which does not depend on mere deployment alone but takes account of (a) the material of which the deployed document forms part and (b) the representations express and implied made by the act of deploying the document. Moreover, they recognize that the potential unfairness of selective disclosure can be mitigated in the possibility that adverse inferences in certain cases may (and I emphasise, may) be drawn if privileged material is not disclosed. Moreover, some of the authorities are consistent with an approach that says that the scope of waiver will depend on what use is ultimately sought to be made of the material deployed which may not be self-evident before trial (see *Factortame* and to some extent in a different context *Lucas v. Barking* – see at [38]).

Blanket waiver in classes of documents on the footing that part of the class has been deployed is not appropriate save in cases where, for example, a client is suing a solicitor and thereby putting the whole of the relationship in issue (see for example per Lord Bingham CJ for the Court of Appeal in *Paragon Finance plc v Freshfields* [1999] 1 WLR 1183 at 1188 and per Auld LJ in *Facortame* cited in *Fulham* above).

Relevance to specific contexts of waiver

59.

In my view, the general approach of the law to the issue of waiver of privilege discussed above should inform the approach taken to the key issues on this application: (a) interpretation of Birss J's order and (b) the extent to which further disclosure should be ordered. Just as the approach to protection of privilege informs the interpretation of provisions said to abrogate it, the approach to treating privilege as waived restrictively and, in particular, only in so far as necessary, should inform interpretation of provisions relating to that subject (see *Morgan Grenfell* above). That is, in my view, all the more so since, in cases of this kind, the court is concerned not with express but with implied or consequential waiver of privilege which takes place by a combination of a party's voluntary act of deployment and the operation of law in treating other matter as also subject to the waiver. This is a situation in which the limitation of a fundamental right of privilege by the voluntary act of a party should in my view only be implied to the extent necessarily consequential upon that act to achieve the *Nea Karteria* purposes.

60.

It is against that background of approaching the question of waiver of privilege narrowly and specifically in the general law that I turn to *Mayne Pharma* and the application of the principles to cases concerning experiments conducted for litigation.

(iii) *Mayne Pharma* disclosure relating to experiments in patent cases

61.

Before dealing with *Mayne Pharma* disclosure, it is necessary to make some preliminary observations about experiments and how they differ from other kinds of documents which may be deployed in litigation. In the case of experiments, identifying something analogous to a transaction and identifying unfair "cherry picking" can be a quite different exercise from that involved in determining whether additional documents in a commercial transaction should be disclosed. That said, experiments are not so different in kind to any other evidence adduced in litigation that an analogous approach to that taken with other documents should not apply.

The varieties of experiment

62.

Experiments are as diverse as the science that gives rise to them. The stereotype of a litmus test is far removed from the kinds of experiments normally deployed in patent proceedings. Such experiments can involve multiple stages and can be undertaken to test multiple propositions, including, quite frequently, the validity of the experimental protocol itself. Moreover, experiments in patent cases are often bespoke devised specially for the purpose of the case. Of course, in some situations, experiments can involve a standard say HPLC, NMR or mass spectrometer run using conventional equipment, but in many cases that is not so.

Even where standard equipment is used, there may be many options available for testing a particular hypothesis including different ways of setting up and calibrating the equipment, different ways of preparing a sample under test, different test conditions, different approaches to interpretation of the results. Often where a suite of experiments is comparative as in this case, it may not be straightforward to devise a suitable test which may additionally involve identifying and sometimes producing for the first time reference standards, involving positive and negative controls, to ensure that a sample under test will be sensitively and specifically be identified as positive if and only if it has the relevant characteristics; in this case, having been produced by a specific process.

63.

All experimental protocols require some degree of validation. Sometimes this comes from material “external” to the experiments or is not in question: proof that HPLC equipment is suitable for separating substances of a given kind may not be provided by the experiments themselves but by the fact that this is a technique known for years. However, sometimes this comes from material “internal” to the experiments where an experimental protocol is validated or calibrated by running a series of samples with a known characteristic through the test to establish a single or multiple controls. Sometimes both. It is frequently the case that test protocols are modified or adjusted to improve their ability to deliver reliable results.

64.

Moreover, tests are usually run multiple times. In some cases, these are pure “dry runs” to check that the equipment is working and that the samples can in principle be analysed in that way. In other cases, they are multiple runs of the same experiment with the same sample, different samples, the same control different controls and so on. Some might be “trial runs”. In some cases, it can be quite difficult to decide what is a “trial” run and what is a “real” run and, in cases where statistical validation may be required, what “n” is taken to be relevant may be of real significance. Test results are often analysed for statistical significance or even if that is not done formally, error bars are commonly produced from a set of variable results. It is not uncommon for a suite of test data from different individual sub-experiments to be aggregated in some way for the purpose of demonstrating a proposition. The question of what data should be aggregated can be a matter of legitimate scientific debate with arguments over whether doing so compounds or reduces errors, and so on.

Illustrations from the present case

65.

The present case presents a good example of the diversity of issues experiments can raise and the number of different stages involved in producing results. I describe this in general terms because of the confidentiality issues involved, without identifying any specific characteristics of the Experiments, samples or results but I have taken into account the greater detail from which this higher level summary is derived in the later application of the law to the facts.

Sample preparation

66.

Before getting to the nub of the Experiments themselves, there is a sampling protocol which has to be done and in this case was apparently designed to ensure among other things that the sample is not affected by powder loss, moisture ingress or contamination. There was a compositional analysis by X-ray fluorescence providing composition to a decimal place

percentage. There was an analysis of specific surface area indicating some change after further calcination at a specific elevated temperature for a specific period. There was crystallographic analysis, which may or may not be open to different interpretations, as to whether or the extent to which calcination may or may not make a difference that is in any way significant to the characteristics and whether other calcination conditions may result in different characteristics.

67.

For the actual Experiments, there were decisions to be made as to whether Raman spectroscopy, TIE and H₂-TIR were appropriate tests at all for distinguishing routes of manufacture by reference (for example) to the different physical and chemical characteristics of the molecular structure including, specifically, that of the oxygen sub-lattice, the kinetics of oxygen exchange, and the redox characteristics, including the kinetics, of the final material. These are more sophisticated tests than those described in the Patent, which refers to X-ray crystallography for determining whether or not there is a single or twin crystalline phase in the material produced. Assuming that the basic premise of the experimental programme is correct namely that these analyses of the micro-structure and physical chemistry of the product can show up real differences in methods of manufacture in sufficient detail and with sufficient reliability, there are then further questions as to whether they are suitable for revealing specifically whether a method claimed in the Patent has been used or not.

68.

Once one gets into the experimental protocols themselves, other issues arise including, at the most basic level, the choice and method of creation of comparative reference samples as well as test sample preparation (such as calcination conditions). For example, in the Experiments, some samples used as comparators for the purpose of evaluating TP1 were made in accordance with the patented process but were additionally made in accordance with a set of other more specific conditions which are not described in the Patent and which are said to be highly confidential (samples S1, S2, S4 and S5 – details of which are themselves confidential). One of these comparative samples is described as “optimized product”. Other samples were made using the patented process or processes that differed from the patented process to a greater or lesser degree. Again the extent to which there are or might be differences between these samples other than those specifically claimed in the Patent may be uncontroversial but may be a matter for considerable debate.

69.

That may be particularly the case with respect to one of the main comparative samples relied on, S8, which was made in accordance with an earlier process employed by MEL, used before the patented process was developed. In the Experiments, samples S3, S6, S7 and S8 were samples said not to be within Claim 1 of the patent (see e.g. Confidential Witness Statement of Martinez Arias 1, para. 3.69). So questions arising out of the Experiments may include whether TP1 was more or less similar in which test and by reference to what criteria than products said to be within or without the claims of the Patent respectively and the extent to which differences in methods of preparation other than those claimed could account for the differences/similarities.

70.

If the action proceeds, these may be matters for trial. I would emphasise that I am not saying that these are points which would inevitably arise although counsel for Neo drew attention to

these issues in general terms particularly by reference to the criteria of similarity and dissimilarity employed in the expert reports relating to the Raman spectroscopy. I use them merely as illustrative of the kinds of points which could arise on the substantial range of Experiments of this kind, which produced data filling multiple lever arch files.

71.

Examination of the protocols, the expert evidence relating to them and the comments from the peer review experts recorded in the mass of material describing how the protocols were developed indicates that there were real choices to be made and that, for some of the tests, differences could be expected as a result of the type of preparation method employed and from changing parameters within the same method. It is also evident from the statements of the experts who conducted the tests that there was a dynamic exchange between a number of individuals providing technical input involving peer review experts and lawyers in developing and validating the protocols.

72.

One characteristic of the evidence before the court at this stage including the witness statements of the experts and Bould 5 is that there is, if anything, an unusually high degree of transparency as to how the experimental regime was developed, what was done, how it was refined and in some cases, candid discussion about the issues that may arise with respect to it. It therefore provides a useful insight into the issues that often arise in these cases.

73.

The upshot of this brief review is that trying to evaluate, in the terms of the existing case law, what exactly is “workup” or “preliminary” for what and how the boundaries between the various parts of the programme as a whole should be drawn is not straightforward.

Procedural aspects of experiments and the avenues for challenging them

74.

Next, the procedural rules governing experiments deserve mention. Experiments conducted for the purpose of litigation fall into two categories: those done and deployed pursuant to an order for service of a notice of experiments and those which are deployed but not subject to that procedure. Experiments falling into the latter category tend to be those conducted for preliminary purposes (such as preliminary injunctions or applications, as in this case, for permission to serve a defendant out of the jurisdiction). In the case of experiments subject to a notice of experiments, there is a procedure established under the CPR Practice Direction under Rule 63 of which the primary provision is as follows:

7.1 A party seeking to establish any fact by experimental proof conducted for the purpose of litigation must, at least 21 days before service of the application notice for directions under paragraph 7.3, or within such other time as the court may direct, serve on all parties a notice—

- (1) stating the facts which the party seeks to establish; and
- (2) giving full particulars of the experiments proposed to establish them.

75.

That does not apply to experiments not done under the notice procedure (as is the case here for the Experiments) but commonly parties will state what facts the experiments are sought to

establish and there is no reason why the principles relevant to *Mayne Pharma* disclosure should not be the same.

Requirement to state facts to be established

76.

As to this requirement, the person seeking to adduce experimental evidence has to state in its notice what facts it seeks to establish by the experiments. In some cases, even with experiments subject to the notice procedure, in addition to explicitly stated facts, the party relying on them may seek to use the experiments to prove facts which may not be explicit but which may be important or essential to the evidential value of the experiments. Experiments sought to establish that practising the teaching of the prior art inevitably leads to something falling within the claims and therefore invalidates the claims of an asserted patent by anticipation are paradigm cases. Deployment of such experiments can involve two propositions: (i) that undertaking the prior art inevitably and straightforwardly produces a product falling within the claims and (ii) that the experiment or the precise conditions under which the experiment is run would inevitably be chosen by a person skilled in the art from the prior art. There may be further implicit facts involved. For example, in the case of an experiment which is run multiple times but which gives variable results, it may be implicit in deploying a given set of runs that the variation is not significant (albeit not always in a formal statistical sense) and that the set of data which has been provided for the purpose of the notice of experiments is fairly representative of all results obtained from experimental runs of that kind. Another example may be that the criteria employed to determine whether the experiment has “worked” are appropriate criteria. There are many other possibilities.

Right to repetition and to serve responsive notice

77.

For experiments subject to the notice procedure, an opposing party has a right to have the experiment repeated and to witness repetition (see CPD Practice Direction 63, para. 7.2). An opposing party also has a right to undertake and seek to adduce evidence of its own experiments, including experiments in reply to those done by the other side. That also applies to experiments not subject to a notice done for preliminary purposes.

78.

Undertaking and witnessing the repetition of experiments is often a costly exercise. If it can be shown at the outset that the experiment relied on has not (for example) been sufficiently validated, an opposing party may reasonably decide not to undertake that exercise but may, instead, criticise the experiments as not being probative for that reason. There are therefore good reasons for having complete information about this at as early a stage as possible.

79.

However, conversely, precisely because experiments are subject to challenge and often formal repetition, they are very different from (for example) a single document put forward as evidencing the nature of a transaction as a whole. Even if full data relating to an experiment is not put forward, there is often nothing to stop an opposing party running the same experiment and showing that it produces different results. Experiments are, to this extent, inherently more transparent than a good deal of other evidence.

Court control of experiments

80.

The courts have in the past given experiments in patent cases mixed reviews. On the one hand, in *Electrolux*, there was extended discussion of the often limited value of experiments (“...experiments frequently prove to be a waste of time and effort” per Laddie J at [1996] FSR 595 at 613). On the other in *Mayne Pharma*, Pumfrey J referred at [15] to experiments as potentially providing “a fixed point against which the experts may themselves be assessed”. Whatever view one takes of experiments in general, in order to have value, experimental evidence should be as solid as possible and criticisms of protocols and their significance should ideally be revealed and ironed out well before trial.

81.

The court will exercise control over the admission of experiments (see CPD Practice Direction 63, para. 7.3): the freedom of a party to rely on any experiments it may have chosen to do is not unlimited. The court can refuse permission to rely on experiments if they are not likely to be of sufficient probative value. Again, if it can be shown that the experiments are unlikely to have significant value because the experimental protocol employed has not been adequately validated in important respects that may affect the court’s decision as to whether evidence of them should be admitted at all given their value.

82.

The consequence of all these points about experiments, substantive and procedural, is that what it is fair and unfair to reveal or disclose – and what constitutes “cherry picking” has to be seen against a different background from that which arises in many other cases concerned with waiver of privilege.