



Neutral Citation Number: [2023] EWHC 2769 (Pat)

Case No: HP-2020-000024

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

Rolls Building
Fetter Lane
London, EC4A 1NL

8 November 2023

Before :

MICHAEL TAPPIN KC
(sitting as a Deputy Judge of the High Court)

Between :

SAINT-GOBAIN ADFORS S.A.S
(a company existing under the laws of France)

Claimant

- and -

3M INNOVATIVE PROPERTIES COMPANY
(a company existing under the laws of Delaware, United States)

Defendant

JAMES ABRAHAMS KC and MICHAEL CONWAY (instructed by Powell Gilbert LLP)
for the Claimant
HENRY EDWARDS (instructed by Bristows LLP) for the Defendant

Hearing date: 1 November 2023

Approved Judgment

I direct that no official shorthand note shall be taken of this judgment and that copies of this version as handed down may be treated as authentic.

This judgment was handed down remotely at 10.30 am on 8 November 2023 by circulation to the parties' representatives by email and release to The National Archives.

The Deputy Judge:

1. I have before me cross-applications by the Claimant (“SG”) and the Defendant (“3M”) in a claim which came before me for trial between 30 March and 5 April 2022 and in which I gave judgment on 9 May 2022 with neutral citation [2022] EWHC 1018 (Pat) (“my trial judgment”). On these applications SG was represented, as it was at trial, by Mr Abrahams KC and Mr Conway instructed by Powell Gilbert. 3M was represented by Mr Edwards instructed by Bristows; Mr Edwards did not appear at trial and Bristows replaced 3M’s former solicitors in September 2023.
2. The claim concerned the validity of European Patent (UK) 2 373 755 (“the Patent”) in the name of 3M. The grounds of invalidity asserted by SG included lack of novelty and lack of inventive step over a 3M patent application known as Rowenhorst as well as uncertainty-type insufficiency. In the event, I rejected those grounds of invalidity, but held the Patent invalid for insufficiency on the basis that the Patent did not enable the skilled person to perform the invention across the breadth of the claim. At the form of order hearing on 28 June 2022 I rejected an application by 3M for permission to apply to amend the Patent and refused permission to appeal – see neutral citation [2022] EWHC 1666 (Pat). There has been no appeal by 3M.
3. The applications before me today concern electronic documents referred to as the CT Scan Files.
4. SG was aware, when issuing these proceedings in July 2020, that 3M had in its possession particles which are said to have been produced by Mr Rowenhorst of 3M in the 1990s in accordance with the teaching of the Rowenhorst prior art. SG sought discovery of those particles through the §1782 procedure in the United States but in the event 3M agreed, in May 2021, to provide two samples of the particles (“the Rowenhorst particles”). It did so on the basis that they would be treated as if they were disclosure documents and so subject to the provisions of CPR 31.22 and that they, and any data or images derived from analysis of the particles, would only be provided to certain classes of individuals involved in these proceedings. 3M also reserved the right to make an application under CPR 31.22(2) in respect of the Rowenhorst particles and any data or images deriving therefrom even where CPR 31.22(1)(a) applied. SG agreed to treat the Rowenhorst particles as disclosure documents and to treat the particles, and data and images deriving from them, as confidential on a *pro tem* basis, but reserved the right to argue that they were not in fact confidential.
5. SG arranged for a company called OR3D to produce computed tomography (“CT”) scans of particles from each of the two samples. The product of that process was the CT Scan Files. These are digital files which allow 3D representations of the particles to be viewed using special software. Using those files it is also possible to take measurements of the particles in question. It is also possible to use the files to generate 2D images of the particles from any angle.
6. On 22 October 2021 SG served a number of documents on 3M. One was a Notice of Models/Images giving notice that SG intended to rely on images of 30 particles from each of the two samples, as set out in certain exhibits to the first expert report of Professor Atkinson also served on that day, and on images of two additional particles, as set out in the annex to the Notice of Experiments again served on the same day. SG also provided 3M with the CT Scan Files. The images which were included in the exhibits to Professor

Atkinson's report were 2D images derived from the CT Scan Files, rather than the CT Scan Files themselves. The annex to the Notice of Experiments contained more detail derived from the CT Scan Files relating to two of the Rowenhorst particles, namely the images which were included in paragraph 124 of my trial judgment, and close ups of certain regions of those particles, together with measurements.

7. At the PTR on 10 March 2022 I made an order by consent in the following terms:

“Until the first day of the trial of these proceedings or pending further order in the meantime the Claimant may only use the Protected Documents for the purposes of these proceedings notwithstanding that any of the Protected Documents may have been read to or by the court or referred to at a hearing which has been held in public or put in evidence at a hearing held in public.”

8. The Protected Documents were defined as the annex to the Notice of Experiments, the exhibits to Professor Atkinson's first report in which the images of the Rowenhorst particles were set out, the annexes to Professor Atkinson's first report and to the first report of Dr Schwabel for 3M in which the experts considered those images and the annex to the Notice of Experiments, certain extracts from 3M technical notebooks and *“the parts of any transcripts of any hearing held in public and any skeleton arguments or other documents provided to the court for any hearing held in public which directly or indirectly reproduce material from”* the other Protected Documents.
9. Shortly before trial the parties each produced scaled-up 3D printed models of certain of the particles, based on the CT Scan Files, and agreed that those models could be used at trial. Measurements of one of those particles were also introduced at trial by SG without objection from 3M.
10. On 29 March 2022 (the day before the trial started) SG's solicitors sent me a letter, copied to 3M's solicitors, enclosing a USB stick containing the CT Scan Files. The letter referred to the images relied on by SG, as referred to in the Notice of Models/Images, and to the 3D printed models that were to be used at trial. It then stated that the USB stick containing the CT Scan Files was being provided so that I could see the shape of all the particles and provided a link from which software could be downloaded to enable that.
11. In the run up to trial the parties had been corresponding in relation to the confidentiality of the materials covered by the order which I had made at the PTR and whether that order should be extended beyond the first day of trial. On 25 March 2022 3M's solicitors indicated that an order would only be sought in relation to the 3M technical notebook extracts and any documents which reproduced materials therein. SG agreed to such an order being made pending the final order following trial. At the start of the trial I was asked to make such an order and duly did so. A permanent order in relation to those documents was included in the final order which I made on 28 June 2022. There was therefore no order made at or after trial in respect of the CT Scan Files or, indeed, any of the documents which included images or measurements derived from the CT Scan Files.
12. Following the trial, SG took the view that, as a result of events at the trial which I will discuss below, it was under no restrictions on the use of the CT Scan Files. It therefore provided them to its external US lawyers and to its European patent attorneys, Zimmermann and Partners. Zimmermann and Partners have filed images and measurements derived from the CT Scan Files (which were not images or measurements

themselves deployed at trial) on the publicly accessible EPO register as part of submissions made by SG in three sets of opposition proceedings against various 3M patents. The first submission was filed on 24 January 2023, the second on 21 March 2023 and the third on 12 July 2023. 3M also made use of measurements derived from the CT Scan Files in a responsive submission filed with the EPO on 29 August 2023 in the third of those oppositions.

13. On 3 August 2023 3M's previous solicitors wrote to SG's solicitors to complain about SG's use of data from the CT Scan Files in the EPO oppositions. Correspondence between the parties' solicitors did not resolve the dispute and on 6 September 2023 SG issued the first application before me, seeking declarations that the CT Scan Files were read by the Court or were referred to within the meaning of CPR 31.22(1)(a) at the trial, that SG's use of the CT Scan Files in the EPO opposition proceedings does not contravene CPR 31.22(1) and that SG is free to use the CT Scan Files in any other proceedings. 3M responded with its application dated 18 September 2023 seeking an order pursuant to CPR 31.22(2) prohibiting SG from using the CT Scan Files for purposes other than these proceedings, in the EPO opposition proceedings or otherwise. Accordingly I need to decide whether CPR 31.22(1)(a) applies to the CT Scan Files and, if so, whether an order should be made under CPR 31.22(2).

CPR 31.22(1)(a)

14. CPR 31.22(1) provides:

“A party to whom a document has been disclosed may use the document only for the purpose of the proceedings in which it is disclosed, except where –
 (a) the document has been read to or by the court, or referred to, at a hearing which has been held in public;
 (b) the court gives permission; or
 (c) the party who disclosed the document and the person to whom the document belongs agree.”

15. Only (a) is relied on by SG – it says that the CT Scan Files were read by the court and/or referred to at a public hearing. I shall start by considering whether the CT Scan Files were referred to at trial within the meaning of CPR 31.22(1)(a).
16. SG relies on the following instances:

- (1) In paragraph 13 of its opening skeleton argument 3M said this:

“There was an issue mentioned at the PTR as to whether 3D scans (and materials reproducing the scans) taken from two samples of abrasive particles provided by 3M to SG for the purposes of this case should be subject to a confidentiality order. 3M has decided not to seek a confidentiality order in respect of these materials.”

- (2) At the outset of SG's opening submissions the following exchange took place, just before I was invited to make the *pro tem* confidentiality order in respect of the 3M notebook extracts:

MR. ABRAHAMS: Also, your Lordship has received a USB stick containing all the CT scans of the individual particles that are debated in the evidence.

THE JUDGE: Yes. I have not looked at that yet I am afraid but no doubt you can direct me to anything in particular I need to look at.

MR. ABRAHAMS: Absolutely. What you have there is CT scans of two batches of Rowenhorst particles which are exhibited and the batch of Cubitron II particles, all of which is in the CONF bundle. So the CONF bundle has Annex 2 to the Notice of Experiments, Annex C to Atkinson 1, three of his exhibits, AA-6, 10, 11 and Annex B to Schwabel 1. None of that is confidential but we are just going to keep it in this bundle.

- (3) Later in his opening submissions, counsel for SG twice stated that I had the CT files so I could look at the Rowenhorst particles from any angle I wanted and then said this, in the context of a discussion about 3D printed models which had been produced by 3M and measurements which had been made from them by SG:

“Just to be clear, the CT cans [sic] were all annexed to our notice of experiments. We got these [the 3D models] on Monday afternoon, just to be precise. The CT scans were all annexed to the notice of experiments, so this is just taking measurements from the CT scans. I do not know whether, with the CT scans, I could produce the measurements, but here are the CT scans with all the data on it and it is just measuring those.”

- (4) Professor Atkinson said this in paragraph 4 of annex C to his first report (which he verified orally at trial) about the first sample of Rowenhorst particles:

“I am informed the sample vial shown above was provided to a company, OR3D, who provided high-resolution computed tomography scans of 30 randomly selected particles from the vial.”

He then went on to refer to the images in his exhibit AA-10. Then at paragraph 10 he said much the same about the second sample of Rowenhorst particles and went on to refer to the images in his exhibit AA-11.

- (5) Dr Schwabel said this in paragraph 241 of his first report (which he verified orally at trial):

“Paragraph [0022] of the Patent envisages that the Tc and Ti measurements could be made using an optical microscope and Ti could be identified by looking at the translucency of the particle. While other more advanced methods could be used, such as the computed tomography scans considered by Professor Atkinson, the Patent does not suggest that this is necessary.”

He also referred, in paragraph 3 of Annex B to his first report, to the reference in paragraph 4 of Professor Atkinson’s Annex C to scans of 30 randomly selected particles.

- (6) Mr Rowlatt of SG’s solicitors provided a short witness statement about the experiments referred to in the Notice of Experiments and was cross-examined on it briefly. In re-examination the following exchange took place:

MR. ABRAHAMS: If 3M wanted measurements of the other particles, did they have them available to do them with the material that you provided them with?

MR. ROWLATT: Yes, my Lord, we provided the underlying CT scan. In fact, my Lord, the USB drive that was delivered to your Lordship was based upon the FTP large file transfer we sent to Wiggin at the same time as serving the notice of experiments in [sic] Professor Atkinson's report.

(7) In 3M's closing submissions at paragraph 8 it said:

"A remarkable feature of this case is that SG chose not to adduce any experimental evidence other than the 3D scans of some particles and the measurements made of some of the particles."

It also, in paragraph 147, quoted Dr Schwabel's paragraph 241 (see above).

(8) In his oral closing submissions counsel for SG said that I could *"eye ball them on the USB stick to see that there is a range"* and later that 3M *"had the CT files so they could, of course, measure them if they wanted to make any point"* and that I could *"eye ball the particles to see the level of variation"* and *"get them up and look at them in 3D and see that there is a wide range of variation"*.

17. I am not persuaded that instance (1) is a reference to the CT Scan Files. While one might think that "3D scans" was a reference to the CT Scan Files, the context was that SG was speaking about what had happened at the PTR. At the PTR an order had been made under CPR 31.22(2) in respect of various documents containing images of the Rowenhorst particles and documents reproducing material from those documents. 3M was explaining that while an order in respect of those materials had been sought at the PTR, it was not seeking such an order at trial. Further, the correspondence between the parties' solicitors regarding confidentiality of the materials covered by the PTR order did not clearly relate to the CT Scan Files and the evidence of Mr Medved, who instructed 3M's former lawyers, is that it was not in his contemplation at the time that the CT Scan Files would feature at the trial. Indeed, 3M's opening skeleton was submitted before the USB containing the CT Scan Files was provided to me with the letter of 29 March 2022. In my judgment, the reference to "3D scans" was a rather clumsy way of referring to the images in the documents specified in the order made at the PTR.
18. I am also not convinced that the reference to "3D scans" in instance (7) assists SG. There 3M was referring to what was in the annex to the Notice of Experiments. 3M does not suggest that any restriction does or should apply to the contents of the annex to the Notice of Experiments.
19. However, the other instances relied on by SG clearly concern the CT Scan Files. 3M's submission is that nonetheless the CT Scan Files were not "referred to" at trial within the meaning of CPR 31.22(1)(a).
20. Mr Edwards submitted that in order for a document to be "referred to" within the meaning of that paragraph, it was necessary to paraphrase or allude to part of the contents of the document. He referred me to *SmithKline Beecham Biologicals SA v Connaught Laboratories Inc* [1999] EWCA Civ 1781 where Lord Bingham CJ said (in a case governed by RSC Ord 25 r 14A):

"Public access to documents referred to in open court (but not in fact read aloud and comprehensibly in open court) may be necessary, with suitable safeguards, to

avoid to wide a gap between what has in theory, and what has in practice, passed into the public domain.”

I can see no support in that passage for Mr Edwards’ proposition. Mr Edwards also referred me to *The SL Claimants v Tesco plc* [2019] EWHC 3315 (Ch) at [41]-[42]. However, the question in that case was whether a document should be disclosed notwithstanding Tesco’s claim to privilege because (it was said) confidentiality in the document had been lost as a result of events at a previous hearing. That case was not addressing the issue of what amounts to a reference for the purpose of CPR 31.22(1)(a).

21. In my judgment there is no reason to place any gloss on the wording of CPR 31.22(1)(a). The extent and nature of a reference to a document is instead relevant to an application under CPR 31.22(2), which I will discuss below. In my judgment that is consistent with the judgment of the Court of Appeal in *Lilly Icos Ltd v Pfizer Ltd (No. 2)* [2002] EWCA Civ 2. In that case the only reference at trial to the relevant document (a page of a schedule, which contained details of advertising expenditure) was in a single sentence in a witness statement (see [15]):

“I understand that details of sales of sildenafil citrate, broken down into the USA and the rest of the world, together with advertising and promotional expenses, on a month-by-month basis to August 1999 have been provided to the claimant’s solicitors in confidence.”

That was regarded by the Court of Appeal as a reference within CPR 31.22(1)(a) even though the document was *“unnecessarily, referred to in passing by the patentee’s deponent”* (see [26]). There was no suggestion that it was necessary to paraphrase or allude to part of the contents of the document. In any event it is notable that all that the witness statement revealed about the contents of the document was at a very high level, namely that it contained *“advertising and promotional expenses, on a month-by-month basis to August 1999”*.

22. In my judgment the instances listed in (2)-(6) and (8) in paragraph 16 above are references to the CT Scan Files within the meaning of CPR 31.22(a). Even if I were to have accepted Mr Edwards’s submission that a reference needs to allude to the contents of the document, in my judgment those instances, taken together, reveal that the CT Scan Files contain data relating to a number of Rowenhorst particles from which it is possible to derive 2D images showing the particles from different angles (including those shown in Professor Atkinson’s exhibits) and to derive measurements of the particles (such as those shown in the annex to the Notice of Experiments), and using which it is possible to view the particles from any angle. That, in my judgment, is an allusion to the contents of the CT Scan Files, and indeed rather more of an allusion to the contents of the documents than achieved by the reference to the advertising schedule in *Lilly Icos*.
23. I therefore conclude that CPR 31.22(1)(a) applies because the CT Scan Files were “referred to” at the trial. It is therefore not necessary to decide whether the CT Scan Files were also “read by” the court. It was common ground between the parties that the question of whether a document is “read by” the court is to be determined as a matter of inference from the transcript and other documents (such as any request for the judge to read a document) rather than by enquiry of the judge as to whether he or she has in fact read the document, and that the onus is on 3M to show that the CT Scan Files had not been read by the court (the parties cited *Lilly Icos* at [8] and *Barings plc v Coopers & Lybrand*

[2000] EWCA Civ 148 at [53]). Therefore, if this matter should go further, the Court of Appeal will be in as good a position to carry out the exercise as I am.

CPR 31.22(2)

24. CPR 31.22(2) provides:

“The court may make an order restricting or prohibiting the use of a document which has been disclosed, even where the document has been read to or by the court, or referred to, at a hearing which has been held in public.”

25. Mr Abrahams submitted that the court should not make an order under CPR 31.22(2) unless the application was made, at the latest, at the hearing at which the document is referred to in open court (or, perhaps, at an adjourned hearing of an application in relation to documents referred to at the earlier hearing). His submission was founded on observations by Sir Nicholas Browne-Wilkinson V-C in *Derby & Co Ltd v Weldon (No. 2)*. However, that was a case under the pre-CPR regime when restrictions on use of disclosure documents arose under an implied undertaking on the part of the recipient. RSC Ord 24 r 14A provided that the undertaking ceased to apply to a document which had been referred to in open court unless the court “has ordered otherwise”. The Vice-Chancellor reasoned that, once an undertaking had come to an end because the document had become public, the court could not reinstate it, and that the language of RSC Ord 24 r 14A supported that view.

26. I can see nothing in CPR 31.22(2) to restrict the power of the court in the way suggested by Mr Abrahams. On the contrary, the language of the rule seems clearly to encompass an order being made after the event. Mr Edwards pointed out that in *Rawlinson & Hunter Trustees SA v Serious Fraud Office* [2015] EWHC 266 (Comm) Eder J made orders under CPR 31.22(2) in respect of documents that had been read or referred to at hearings a year or two earlier. Mr Abrahams observed that the point that no retrospective application could be made had not been taken in that case. However, if the point had any merit, I am sure that it would have occurred to the extremely experienced and eminent counsel instructed by the respondent to the application in that case.

27. Mr Abrahams also submitted that I should apply the approach to applications to vary or revoke previous orders of the court under CPR 3.1(7) in *Tibbles v SIG plc* [2012] EWCA Civ 518 at [39]. In particular, he submitted that the discretion to make an order under CPR 31.22(2) in relation to documents which were not covered by a previous order should only be exercised where there has been a material change of circumstances since the previous order was made or where the facts on which the original decision was made were misstated.

28. I am not persuaded that the approach taken in *Tibbles* to applications under CPR 3.1(7) is applicable to a case such as the present. *Tibbles* identifies a principled approach to the exercise of discretion on such applications in order to promote finality in decision making, avoid litigants having two bites at the cherry, and avoid undermining the principle of appeal by judges reviewing their previous orders. At trial, and at the form of order hearing, I was not asked to decide whether an order under CPR 31.22(2) should be made in respect of the CT Scan Files. 3M did not seek such an order and so I did not refuse one. I am not being asked to revisit a decision I made previously. I do not regard this as an application to vary the order that I made, but an application for a further order. For those

reasons, I do not regard this application as subject to what Rix LJ called the principled curtailment of the discretion under CPR 3.1(7).

29. However, Mr Abrahams also referred me to the more general observations of Rix LJ in *Tibbles* at [41]-[42] about the need for promptness in making applications and that “[w]ith the passing of time is likely to come prejudice for a respondent who is entitled to go forward in reliance on the order that the court has made”. I agree that the court should take into account, when considering whether to make a further order under CPR 31.22(2), whether the application has been made promptly and any prejudice to the respondent arising out of a delay in making the application and its reliance on the state of affairs that has prevailed since the order was made.
30. The approach to the exercise of the discretion to make orders under CPR 31.22(2) was considered by the Court of Appeal in *Lilly Icos*. The following considerations set out by the Court at [25] are particularly pertinent:

“(i) The court should start from the principle that very good reasons are required for departing from the normal rule of publicity [referring to Lord Diplock in Home Office v Harman]...

(ii) When considering an application in respect of a particular document, the court should take into account the role that the document has played or will play in the trial, and thus its relevance to the process of scrutiny referred to by Lord Diplock. The court should start from the assumption that all documents in the case are necessary and relevant for that purpose, and should not accede to general arguments that it would be possible, or substantially possible, to understand the trial and judge the judge without access to a particular document. However, in particular cases the centrality of the document to the trial is a factor to be placed in the balance.

...

(iv) Simple assertions of confidentiality and of the damage that will be done by publication, even if supported by both parties, should not prevail. The court will require specific reasons why a party would be damaged by the publication of a document. Those reasons will in appropriate cases be weighed in the light of the considerations referred to in sub-paragraph (ii) above.”

31. Mr Edwards referred me to cases such as *Tassilo Bonzel & Schneider (Europe) AG v Intervention Ltd* [1991] RPC 43 (a pre-CPR case) in which it was said that special circumstances were required for a party to whom documents had been disclosed to be released from their undertaking. He also referred me to *Rawlinson & Hunter*. In that case Eder J said at [85]:

“I fully accept Lord Pannick’s submissions as summarised above. In particular, I fully accept the general and very high importance of open justice in proceedings. This was also accepted by Mr Segan on behalf of the SFO. I also fully accept that the test or approach of the court under CPR 31.22(2) is different from the test or approach of the court under CPR 31.22(1)(b). In particular, whereas under CPR 31.22(1)(b) it is for the applicant seeking to obtain the permission of the court to use the documents for a collateral purpose to persuade the court that there are special circumstances which constitute a cogent reason to justify the court making such order, the position under CPR 31.22(2) is not merely that the burden is on the

applicant to justify the restriction/prohibition being imposed but also that the applicant who wishes to restrict or prohibit the use of documents which have been read out or referred to in court must show “very good reasons” for overriding the principles of open justice and transparency. The words “very good reasons” appear in the judgment of Buxton LJ in Lilly Icos. Again, this was, as I understood, uncontroversial between the parties i.e. it was, in effect, common ground between Mr Segan and Lord Pannick that this was the relevant test on these applications.”

32. Eder J continued at [86]-[87]:

However, in exercising the discretion under CPR 31.22(2), I do accept Mr Segan’s further submission that the significance or otherwise, as regards the proceedings as a whole, of a reference to a document in open court is potentially relevant in deciding whether to make an order. In that context, Mr Segan drew my attention to a passage in the judgment of Bean J in NAB v Serco Ltd & another [2014] EWHC 1225 (QB):

*“... the rule governing the present application is CPR 31.22(2), the power to restrict the use of a document referred to at a public hearing, rather than CPR 31.22(1)(b), the power to give permission to use disclosed documents not referred to in public. **But it would be curious if in a case like this, where the reference to the document at the public hearing was marginal and gratuitous, there were to be any great difference between the proper approach under the two rules. There is force in Mr Johnson’s submission that the difference between the two is only one of the burden of proof and that it is unlikely that the burden of proof would be the basis of my decision in this case.**” (emphasis added)*

Lord Pannick submitted that this approach to CPR 31.22(2) was erroneous. In particular, he submitted that Bean J failed to recognise that there is a strong presumption that documents referred to in open court should be disclosed, and failed to recognise why there is such a presumption as Buxton LJ explained in Lilly Icos at paragraphs 7-9 and 25(i). I do not accept that submission. In my view, Bean J was merely stating the obvious in relation to circumstances where the reference to the document at the public hearing was “marginal and gratuitous”. Be that as it may, the test is as I have stated above.”

33. Mr Edwards sought to use this to align the test under CPR 31.22(2) with the “special circumstances” test under CPR 31.22(1)(b) in cases where the reference was “marginal and gratuitous”. However, Eder J identified the test under CPR 31.22(2) in [85], contrasted it with that under CPR 31.22(1)(b), and reaffirmed that as being the test having considered what Bean J had said in *NAB v Serco*. In my view, what he was recognising was that in cases where the reference was “marginal and gratuitous”, the document may well not have played a central role in the trial and may therefore be less relevant to the process of scrutiny, as explained in consideration (ii) in *Lilly Icos*, and that accordingly it will be easier to justify an order under CPR 31.22(2). In any event, Mr Edwards agreed that I had to apply the approach set out in *Lilly Icos*.
34. Mr Edwards also referred me to *J.C. Bamford Excavators Ltd v Manitou UK Ltd* [2023] EWCA Civ 840, in which Arnold LJ emphasised the importance of protecting material which is properly characterised as technical trade secrets and said that where it is necessary to protect trade secrets the principle of open justice must give way to the principle of justice itself.

35. I shall start by considering the role that the CT Scan Files played at the trial. They constituted the raw data from which other material which had some prominence at trial was created, namely the images in the exhibits to Professor Atkinson's first report, the images and measurements in the annex to the Notice of Experiments, and the 3D models and measurements thereof, some of which were referred to in paragraphs 123-128 of my trial judgment. However, the CT Scan Files themselves were by no means central to the trial. On the other hand, I would not accept that the references to the CT Scan Files at trial were "marginal and gratuitous", as 3M suggested. They were being referred to because they underlay the material which had been derived from them and to support submissions being made by SG.
36. I shall next consider the claim to confidentiality in the CT Scan Files and the damage that it is said would be done by their use or disclosure. Mr Medved explained that detailed information about dimensions of the Rowenhorst particles can be derived from the CT Scan Files that cannot be derived from the 2D images shown in the exhibits to Professor Atkinson's first report. While SG disputed that, it seems to be self-evident when comparing the level of detail shown in those 2D images with that in the annex to the Notice of Experiments and in the submissions made by SG to the EPO (it is notable that SG has used the CT Scan Files to derive the information in those submissions rather than the 2D images). While SG pointed out that more detailed information about some of the Rowenhorst particles is in the public domain in the form of the annex to the Notice of Experiments and the 3D models (and now in the EPO submissions), that only relates to a few of the particles. I therefore accept that the CT Scan Files contain information about the Rowenhorst particles which is not otherwise present in the public domain.
37. SG also suggested that the CT Scan Files could not be confidential because they reproduce the Rowenhorst particles in digital form, the Rowenhorst particles are the result of implementing the Rowenhorst prior art and it was open to anyone to follow the method described in Rowenhorst. The problem with that is that, as I held in my trial judgment at paragraph 132, the teaching of Rowenhorst allows for variation in its implementation. The evidence did not establish that the Rowenhorst particles were the inevitable result of implementing the teaching of Rowenhorst.
38. However, as SG pointed out, the CT Scan Files represent particles which were produced 30 years ago, as part of a laboratory project which was terminated and was never taken forward into commercial application. Mr Medved said in his statement that nonetheless the CT Scan Files contained "*information that could assist a competitor to fill in knowledge gaps concerning 3M's laboratory and manufacturing capabilities*". He continued:

"Access to complete digital models of 3M's confidential laboratory prototypes allows examination of specific geometric irregularities, which suggest specific details of confidential equipment and processes, which in turn suggests specific challenges 3M faced, both in Rowenhorst's time and later when 3M sought to improve and commercialize shaped abrasive particles."

Then, after explaining 3M's launch of the Cubitron II range of products in 2009, he said that the CT Scan Files "*provide competitive insight into 3M's confidential research and development journey that led to this point.*"

39. SG had a number of responses to this evidence. First, it noted that Mr Medved was assistant chief IP counsel at 3M rather than a technical person, had not explained how he was qualified to give the evidence that he did, and had not identified any source for the facts stated in this part of his statement. Secondly, it observed that Mr Medved had not identified any equipment or processes that could be identified from the CT Scan Files but not from the material in the public domain, and pointed out that in any event the evidence at trial was that equipment and processes used in the laboratory were different from those used in commercial production. Thirdly, it questioned the suggestion that it would be possible to derive information about equipment and processes used to make the particles from the CT Scan Files. Fourthly, it made the point that anyone was free to purchase Cubitron II grain and produce digital files of those particles which could (on the assumption that its third point was wrong) be analysed to derive information about equipment and processes used to make 3M's current commercial product. If so, Mr Abrahams asked forensically, why would a competitor be interested in what 3M had done in the laboratory in a project 30 years ago which had been abandoned?
40. Further, SG submitted that 3M must have taken a positive decision not to seek an order under CPR 31.22(2) in respect of the CT Scan Files either at trial, or at the form of order hearing. It relied on that not only to support its argument that no such order should be made now (see below) but also as support for its argument that the CT Scan Files could not contain any information which was worth protecting – if they did, why would 3M have decided not to seek an order in respect of them? It is notable that Mr Medved's statement does not explain why no such order was sought by 3M. He explains that, at the time that I was sent the USB stick containing the CT Scan Files, the 3M team were highly occupied and that 3M had no reason to believe that the CT Scan Files formed any part of SG's case, but does not explain why 3M did not seek an order at any point during the trial, or at the form of order hearing, despite the events at trial identified in paragraph 16 above. Mr Edwards suggested that there was no need to do so because those events did not amount to references within the meaning of CPR 31.22(1)(a), but there was no evidence to suggest that this was 3M's reasoning at the time, and in any event there was plainly a risk that such an analysis would prove to be incorrect.
41. I do not believe that it is possible to come to a conclusion about whether 3M took a positive decision not to seek an order under CPR 31.22(2) in respect of the CT Scan Files or whether its failure to do so was inadvertent. However, in my view if 3M had regarded the CT Scan Files as containing valuable commercial information it would have sought the order that it said, in May 2021, it reserved the right to seek in respect of "data or images deriving from" the Rowenhorst particles if there was any chance of the CT Scan Files falling into the public domain as a result of what happened at the trial. So while it is possible that the need to do so was overlooked, it would surely not have been overlooked if the information in the CT Scan Files was regarded as valuable.
42. Further, SG points out that information from the CT Scan Files was first used in EPO opposition proceedings in January 2023, and then again in March 2023. Yet it took 3M until August 2023 to complain about such use, and until September 2023 to make its application (prompted by SG's own application). Mr Medved says that it was not clear that the material filed in January 2023 was derived from the CT Scan Files but he does not explain why 3M did not ask SG about the source of that information, nor why 3M took no action after the filing was made in March 2023. I agree with SG that that is not

the normal behaviour of a party who fears that its valuable commercial information is being used and disclosed.

43. For these reasons, I am very sceptical about 3M's claim that the CT Scan Files would be of value to a competitor. However, that is not really what this application is about. Mr Abrahams made it clear that SG had no interest in using information derived from the CT Scan Files in its business operations, and no interest in publishing the CT Scan Files or otherwise making them more widely available. What 3M is really seeking by its application is to prevent SG making use of information derived from the CT Scan Files in proceedings in the EPO or elsewhere.
44. However, 3M did not suggest that the kind of use that has been made of the CT Scan Files to date (in these proceedings and in the EPO) has allowed a competitor to discern the information which Mr Medved said 3M was concerned about (see paragraph 38 above). No doubt that is why no application for an order under CPR 31.22(2) was made at or after trial in respect of the documents containing material derived from the CT Scan Files which had been covered by the order made at the PTR. 3M suggested that such use could eventually lead to all the information in the CT Scan Files being made public, but I regard that as theoretical rather than realistic.
45. Instead, 3M's complaint was that SG's use of information from the CT Scan Files in the EPO proceedings has caused (and will cause) 3M expense in filing submissions in response to address submissions made by SG. However, 3M also made it clear that its principal response to any submission made by SG based on information in the CT Scan Files had been (and would be) that there was no evidence that the Rowenhorst particles were the inevitable result of practising the Rowenhorst prior art. 3M pointed out that in *Bonzel & Schneider* the fact that costs would be incurred in EPO proceedings was regarded as a factor against releasing a party from the implied undertaking. But it does not seem to me to be a weighty factor when considering whether to make an order under CPR 31.22(2) 19 months after trial. Mr Edwards also referred me to considerations (v) and (vi) in *Lilly Icos*. However, if 3M had sought an order under CPR 31.22(2) in respect of the CT Scan Files at trial, it would still have been possible for the trial to have taken place in public without revealing any of the details which Mr Medved says are confidential.
46. In my judgment it is appropriate to take into account, when considering whether to make an order under CPR 31.22(2), the facts that the CT Scan Files have been in the hands of SG without restrictions on their use for 19 months now, and that 3M has not acted promptly in seeking this order, or even in raising its concerns with SG, once SG started to make use of them. The result of that is two-fold. First, SG has reasonably, and in my judgment correctly, believed that it was free to use the CT Scan Files in other proceedings, and has in fact done so, and had no reason to think that there was any dispute about that until six months after it first made such use. Secondly, as between 3M and SG, any confidentiality in the CT Scan Files has been lost, and what 3M is seeking is an order re-imposing a restriction which ceased 19 months ago. As I have explained above, this application is really about whether SG can continue to make the same kind of use of the CT Scan Files as it has been making, legitimately in my judgment, to date. 3M's argument boils down to a submission that I should stop SG doing what it has been doing because that causes 3M to incur costs in responding.

47. I should add that 3M made it clear that the order it sought in its application notice was intended to prevent SG not only from making further submissions using material from the CT Scan Files, but also from using, in the EPO oppositions, the submissions it has already made in those oppositions. Mr Abrahams pointed out that no mechanism for withdrawing material from an EPO opposition had been identified and in response, after the hearing, Mr Edwards indicated that no order was sought in respect of materials which were already on the EPO file (or had been used in the trial of these proceedings).
48. However, weighing up all the matters I have referred to above, in my judgment I should not make an order under CPR 31.22(2) to prevent SG continuing to use the CT Scan Files in other proceedings. That is not necessary to prevent the kind of damage to which Mr Medved refers in his statement, as set out in paragraph 38 above. In my view the interests of 3M in avoiding the expense of dealing with submissions based on material derived from the CT Scan Files do not justify imposing a restriction on the use by SG of documents which it has held, and used, free of any restriction for 19 months.
49. While SG maintained its position that I should simply make an order containing the declarations set out in its application notice, after the hearing it offered, by way of fall back, to provide an undertaking to give 3M 21 days' notice of any intention to use the CT Scan Files for any purpose other than legal proceedings. It said that it had no such intention, but offered that undertaking to alleviate any fears in that regard. It pointed out that if SG ever changed its mind, that would allow an orderly application to be made, supported by evidence focussed on the actual intended use. In my judgment that undertaking addresses the concerns expressed by Mr Medved and set out in paragraph 38 above, and I will make the order sought by SG and accept its proposed undertaking. For the avoidance of doubt, I will give 3M liberty to apply in the event that SG gives notice pursuant to its undertaking.