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# UK disclosure is a powerful tool in patent litigation

## The disclosure process under English law creates powerful opportunities during patent litigation. Careful use of disclosure can reduce costs and speed up proceedings across Europe, as shown in recent litigation between Danisco and Novozymes.

### What is disclosure?

During patent litigation under English law, the claimant and defendant are often each obliged to disclose information which adversely affects its case or supports the other party's case. A party may request disclosure and in doing so may allow access to information held by another party which would otherwise be unavailable.

Not all disclosed documents can be inspected by the opposing party, for example, some will be protected by legal privilege. In patent cases, disclosure is usually limited to documents which were created two years before or after the claimed priority date of the patent, but the court has discretion to waive this requirement where appropriate.

The principle underlying disclosure is that the parties should be aware of information which is relevant and could reasonably be provided by the other parties. In the absence of disclosure, parties could benefit by withholding relevant information.

The process of requesting information during litigation is known as "disclosure" under English law, whereas the US courts have a similar (although more wide-ranging) process known as "discovery".

A party may request disclosure if it suspects relevant information is being withheld and a court may sometimes specifically require information to be disclosed. A request for disclosure is assessed by the courts following a balancing of the need for disclosure with the needs of the party who is being asked to provide the new information.

### How widely can the information be used?

Disclosed documents are not available to use automatically in other proceedings without permission from either the party who disclosed them or the court that ordered disclosure.

However, a document made available by using disclosure in the UK may change the outcome of the case across Europe. Recently, in *Danisco v Novozymes*, documents made available using litigation in England were used to help revoke Novozymes' patent across Europe.

### *Danisco v Novozymes*

Novozymes' patent claimed a method for making animal feed which contained useful enzymes. Danisco applied for revocation of the patent and alleged that Novozymes' method was obvious because it provided no improvement over known methods. Novozymes disagreed and argued that its method was not obvious because the method increased the stability of the enzymes.

Novozymes' patent included a number of examples which showed that their patented method did provide improved enzyme stability. Danisco appears to have suspected that the patented method would not always work and that the results presented by Novozymes had been "cherry picked" to avoid publishing negative results.

It seems that Danisco suspected that Novozymes had tested the patented method extensively, as Novozymes was planning to launch a product made using the patented method in the near future. Therefore, Danisco requested disclosure of experiments conducted by Novozymes when testing its patented method, which Novozymes eventually provided.

As Danisco expected, Novozymes' results showed that sometimes the patented method provided improved enzyme stability and sometimes it did not. This finding was important, as, in order to argue that a new method is not obvious because it provides an improvement, the improvement should occur reliably and not just in certain specific circumstances.

As Novozymes' negative results showed that the improved enzyme stability did not always occur with the patented method, Danisco hoped that the courts would now decide that the method was obvious.

## Danisco's strategy

Danisco was attempting to revoke Novozymes' patent in the UK, Germany, Denmark and the Netherlands as well opposing it centrally at the European Patent Office (EPO).

The EPO acts as a central patent-granting authority for Europe and a European opposition can lead to the patent being revoked in all European states. Therefore, Danisco decided to try to use Novozymes' negative results to support its opposition at the EPO.

However, in order to use Novozymes' negative results in the EPO, Danisco needed permission from the English court. The court initially refused to release the negative results, but reversed its position when the hearing date for the trial was delayed by Novozymes so that it fell after the final hearing at the EPO.

Thanks to the evidence from disclosure, the EPO considered that the patented method was obvious, in part because the improved enzyme stability did not always occur with the patented method, and therefore the patent simply claimed an obvious alternative method. The patent was revoked by the EPO, which automatically led to revocation in the UK, Germany, Denmark and the Netherlands.

## Key points

In Europe, only the UK has a comprehensive system for requiring disclosure of relevant documents during patent litigation and so it may be useful to start proceedings in the UK specifically to obtain access to certain documents.

Where a business believes that a competitor is in possession of information which damages the competitor's position, an action in the UK might allow access to this information. Once useful information has been identified using disclosure, the opposing party can ask for permission to use this information in other jurisdictions. As a result, actions in the UK can affect the course of proceedings in other jurisdictions.

A business may decide to identify documents which could become available to its competitors owing to disclosure in the UK, in order to brief its legal team accordingly. Novozymes' representatives at the EPO made statements which were said to be contradicted by the negative results which emerged as a result of the disclosure in the English courts.

To conclude, disclosure through the English courts creates powerful opportunities during litigation, especially patent litigation. These opportunities can be important when there is litigation in multiple jurisdictions, as the information disclosed in the English courts may sometimes be used in other jurisdictions.

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## Need advice?

For more information, please contact: email@carpmaels.com.

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