

THE HIGH COURT

[2020/1219 P]

BETWEEN

**EVALVE INC., ABBOTT CARDIOVASCULAR SYSTEMS INC., AND ABBOTT MEDICAL
IRELAND LIMITED**

PLAINTIFFS

AND

**EDWARDS LIFESCIENCES IRELAND LIMITED, EDWARDS LIFESCIENCES CORP. AND
EDWARDS LIFESCIENCES LLC.**

DEFENDANTS

JUDGMENT of Mr. Justice Brian O'Moore delivered on the 1st day of July, 2020.

1. On the 12th of June 2020 I commenced hearing two motions for discovery in these proceedings. On the 18th of June the hearing of these motions concluded. During the course of the two days of hearings, I was kept informed of the progress that the parties were making in either agreeing categories of discovery or narrowing the issues between them where such agreement could not be reached. Even after the conclusion of the hearings, the parties continued discussions and, on the 22nd of June I was informed that further categories of discovery had been agreed.
2. This ruling gives my decision on the categories of discovery which remain in dispute. As I have done in respect of an earlier motion in these proceedings, the ruling which carries the neutral citation [2020] IEHC 266, my decision on the issues will be followed by a more detailed judgment.
3. The categories ultimately in dispute in the motion brought by the Plaintiffs (Abbott), and my decision on them, are as follows.
 - A. Category 1.**
4. The difference between Abbott and the Defendants (Edwards) is confined to whether discovery should be made of the plans of Edwards with regard to the future manufacture of the impugned product (PASCAL) in Ireland, notably manufacture at a new manufacturing plant being constructed by Edwards at Castletroy, County Limerick. I have decided that such discovery should be made. However, I agree with Mr. Newman (Counsel for Edwards) that the word "plans" in this context is a broad and somewhat imprecise term to use in defining Edwards' discovery obligations. While Mr. Cush (Counsel for Abbott) effectively accepted that some reformulation of this aspect of the discovery request would be helpful, no such reformulation was proposed by either side. I have decided that this discovery should be ordered because I think it is relevant and necessary having regard to the dispute about whether equitable relief should be ordered against Edwards in the event that Abbott succeeds in its claim. The documentation to be provided to Abbott should therefore capture any projections by Edwards as to the quantities of PASCAL to be produced in Ireland, notably at the new Castletroy plant. Other plans with regard to the future manufacture of PASCAL in Ireland seem to me not to have the required relevance to these proceedings; for example, the identity of the makers of the equipment for the production of PASCAL or the budget for such equipment may well fall within the category as originally drawn but have nothing to do with the legal dispute. The

parties should agree a reformulation of the discovery request to be found at Category 1(d) which would give effect to my decision and the reasoning behind it. If the parties cannot agree, I will revise the wording of Category 1(d).

B. Category 2.

5. Edwards has offered the following revised wording of Category 2:-

“All documents related to the intention and/or plans to offer and/or put on the market and/or use of PASCAL in Ireland after the date of commencement of these proceedings.”

6. The sole issue between the parties is the time limitation. Abbott want the discovery to catch documents from the 1st of February 2019, the date on which PASCAL was launched in the EU; Edwards propose that the relevant date should be the 14th of February 2020. The reason why Abbott seeks discovery from the earlier date is to deal with Edwards’ defences of delay, laches and acquiescence. It is put this way by Mr. Cush:-

“[...] the gist of what has been suggested against us is that we had enough information and we delayed. Now, to that we say no, you were being evasive. We didn't have enough information.”

7. I do not think that Abbott need discovery of documents to establish what information they had at any given time before the institution of these proceedings.

8. Mr. Cush went on to argue that these documents could show that Edwards were being evasive in the course of the pre-litigation correspondence. However, the evasiveness (if any) of Edwards will be established by the correspondence sent on their behalf at the time. In addition, the pleadings of Abbott do not assert that the evasiveness of Edwards is in any way to be taken into account in assessing the allegations of delay, acquiescence or laches on the part of Abbott. Finally, the reasons given by Abbott's solicitors for this category of discovery (in their letter of the 8th of May 2020) refer nowhere to the need to have these documents in order to deal with the defences of delay, acquiescence and laches. This would have been given as a reason if the discovery was truly required for that purpose.

9. The discovery ordered in respect of this category will therefore refer to the later date of the 14th of February 2020.

C. Category 3.

10. Edwards has offered the following revised wording for Category 3:-

“Documents sufficient to show whether and, if so, in what form PASCAL is imported into the State and/or stocked in the State for the purpose of making or using PASCAL.”

11. I agree with Mr. Cush that the form of the PASCAL device is not the critical issue here; it is the quantities in which it is imported into the State. As with category 1(d) of the requested discovery, the plans for the import of the impugned product are both relevant

and necessary from the perspective of Abbott. While the table recording the level of agreement between the parties (circulated for the hearing on the 18th of June 2020) suggested that the form of words proposed by Edwards was acceptable to Abbott (except for the disputed issues of quantity and plans), the last eight words of the Edwards reformulation of Category 3 make no sense if the word "form" is replaced with the word "quantity".

12. There is some possible overlap between the discovery ordered in this category and the documents as to (a) manufacture and (b) inventory provided in respect of Category 1. However, Category 1 does not capture the planned importation of PASCAL into the State and, for that reason alone, the need for Category 3 is made out by Abbott.

13. The discovery ordered in respect of this category will therefore be:-

"Documents sufficient to show whether and, if so, in what quantity PASCAL is, and is planned to be, imported into the State or stocked in the State."

D. Category 4.

14. This category relates to the export of PASCAL from Ireland.

15. Mr. Newman correctly submits that export, in itself, is not an infringing act and no claim is made in these proceedings that the export of PASCAL from Ireland violates any entitlements of Abbott in the State. However, the plea at paragraph 10 of the Defence and Counterclaim does make relevant the fact and quantity of export of PASCAL from Ireland; by that paragraph, Edwards plead that in other EU jurisdictions there would be harmful, disproportionate or oppressive effects if Abbott secure injunctions against the manufacture of PASCAL in Ireland. In order to meet this plea, Abbott must know the other EU states to which PASCAL is exported, and the quantities in which it is exported.

16. The compromise of Category 1 provides that Edwards will furnish, on Affidavit, a table setting out "the number of units sold in each European country on a month by month since February 2019 [...]." In addition, Mr. Newman has confirmed that the only relevant territory for the purposes of the plea at paragraph 10 are those listed at Paragraph 3(h) of the Replies to Particulars dated the 22nd of April 2020. However, it is not clear that these countries are supplied entirely from Ireland with the PASCAL product. The issue raised by paragraph 10 is whether the termination of production in Ireland will cause the harm asserted by Edwards. In addition, the information to be provided under Category 1 does not include planned supplies to these specific territories; the argument put up by Edwards in this regard would be very different if, for example, they had decided for financial or logistical reasons to terminate supplies of PASCAL to Germany or Austria six months after the trial.

17. I will therefore order discovery in respect of Category 4 as follows:-

"Documents sufficient to show whether and, if so, in what quantity PASCAL is, and is planned to be, exported from Ireland to each of Austria, Denmark, Finland, France, Germany, Greece, Italy and/or Spain."

18. I note that the parties have agreed that discovery of this category can be done by way of a table.
19. I will now deal with the remaining disputes in respect of the discovery sought by Edwards.

E. Category 2.2.

20. This category relates to items of prior art considered by Abbott. Similar discovery was ordered by Kelly J. in *Medtronic Inc. & Ors. v. Guidant Corporation & Ors.* [2007] IEHC 37. In *Medtronic*, Kelly J. had reservations about the ordering of discovery in respect of two categories (including the category relating to prior art). I share those reservations. In particular, even if the disclosure of items of prior art (other than the pleaded items) is relevant, it is by no means certain that it is necessary given that Edwards will have the benefit of expert evidence as to the prior art and common general knowledge, no doubt supplemented by searches of considerable breadth and sophistication to discover any piece of prior art which could be used to challenge the patent. However, following *Medtronic*, I will order discovery in respect of this category. I will vary the terms of the category to exclude the reference to "possible prior art" as this concept is unclear, to use the wording of Finlay Geoghegan J. in *Schneider (Europe) GmbH v. Conor Medsystems Ireland Ltd.* [2007] IEHC 63. Again, the parties can agree wording which puts into effect my ruling on this category; if that cannot be done, I will provide the text of this part of the Order.

F. Category 4.1.

21. This category of discovery broadly relates to any analysis by Abbott of the Edwards product (PASCAL). There is agreement on its terms, subject to the requirement of Abbott that Edwards make reciprocal discovery. The parties have, in the context of Category 7(b) of the discovery sought by Abbott, agreed that each will make discovery of documents relating to the analysis of the Abbott product ("MitraClip").
22. The objection by Edwards to a reciprocal discovery order in respect of Category 4.1 is that the inputting of the search terms "MitraClip" and "TriClip" is, in Mr. Newman's words "just going to produce thousands of documents". In the agreed position paper prepared for the subsequent hearing on the 18th of June, the Edwards position was that:-

"The Defendants take issue with the condition regarding reciprocity in circumstances where inputting the search terms "MitraClip" and "TriClip" will produce a large number of documents."

23. No issue is raised by Edwards about the appropriateness in principle of ordering this reciprocal discovery. I am told that the only issue is the use of the two search terms. The evidence before me does not support the submission of Edwards that such reciprocal discovery should exclude the relevant terms "MitraClip" or "TriClip". On that basis, I will therefore order that Edwards makes such reciprocal discovery, and that the search terms "MitraClip" and "TriClip" are each used for the purpose of making that discovery.

G. Category 7.2.

24. Unlike Category 4.1, Edwards do not accept that any reciprocal discovery should be made in respect of this category, which relates to the features of, praise for, and performance characteristics of the Abbott products. Abbott consent to the discovery sought by Edwards, but this consent is conditional on Edwards making reciprocal discovery.
25. Firstly, I am satisfied that the documents sought by Edwards in Category 7.2 should be disclosed; the category meets all the requirements of the rules on discovery. It is also unlikely, in this hard fought case, that Abbott would have agreed to such discovery if it was not warranted but that is not a material factor in my decision.
26. Secondly, in the light of that decision the condition sought to be imposed by Abbott need not be satisfied by Edwards in order for discovery in this category to be ordered.
27. Thirdly, Abbott have themselves sought discovery in respect of the very same issues in the pleadings. They have done so in Category 5 of their request for discovery; Category 5 was agreed by Edwards. That category is very carefully crafted, and presumably reflects what Abbott themselves feel is needed in order to deal with the relevant issues. I see no reason why, as a condition of ordering discovery to which Edwards is entitled, I should direct that Abbott receive a further tranche of discovery in respect of matters where Abbott are already getting discovery in the precise terms they initially sought. Indeed, it is accepted by Abbott, through their Counsel, that very similar documents could well be thrown up by Category 5 and Category 7.2.
28. I am therefore not going to order reciprocal discovery in favour of Abbott in respect of this category. I will order that Abbott make discovery in terms of Category 7.2.

H. Categories 7.3 to 7.9.

29. The only issue between the parties in respect of these categories is the terms (search terms 14 and 15) to be applied.
30. I have decided that the two disputed search terms are to be applied for the purpose of the discovery to be made in respect of these categories. I do so for a number of reasons, including the relevance of the terms, the lack of any convincing evidence that the use of these search terms would give rise to any disproportionate or oppressive burden (indeed, the evidence is to the contrary), and the striking change of position of Edwards on this topic. It is difficult for me to accept a submission by Edwards that the search terms are too broad, when their Senior IP Counsel has sworn that the proposed search terms "are too narrowly-drawn and would likely fail to return a sufficiently-complete set of relevant documents".
31. As I have done with other categories, I will ask the parties to put together the precise wording for categories 7.3 to 7.9, in the light of my ruling.
32. I propose to list this matter for mention at 10.30 am on Thursday the 9th of July to deal with any outstanding matters. If that causes difficulties for any of the parties, they should liaise with each other and with the Commercial Court Registrar to arrange another date or time.