



Neutral Citation Number: [2022] EWHC 2429 (Ch)

Case No: HP-2021-000045

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

Royal Courts of Justice
The Rolls Building
7 Rolls Buildings
London, EC4A 1NL

Date: 19th July 2022

Before:

MRS JUSTICE FALK

Between:

OPES CORPORATION OY

Claimant

- and -

REPUBLIC TECHNOLOGIES (UK) LIMITED

Defendant

MR M KEAY appeared for the **Claimant**

MR J MOSS appeared for the **Defendant**

APPROVED JUDGMENT

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2nd Floor, Quality House, 6-9 Quality Court, Chancery Lane, London WC2A 1HP.
Telephone No: 020 7067 2900. DX 410 LDE
Email: info@martenwalshcherer.com
Web: www.martenwalshcherer.com

MRS JUSTICE FALK :

1. I have concluded that the Defendant should give disclosure in accordance with paragraph 7 of the CMC order made by Zacaroli J on 12 May 2022. My reasons for that approach are as follows.
2. Zacaroli J was persuaded to order model D disclosure, so the ship really has sailed on the argument that, in principle, the Defendant is simply an importer rather than a manufacturer, and for that reason should not have to give disclosure.
3. The Defendant points out that Zacaroli J referred to the disclosure having to be reasonable and proportionate. Zacaroli J was quite right to do so. I have looked at the relevant portion of the transcript and I agree with that what he said. However, Zacaroli J nevertheless did see fit to approve a budget which included a figure of £45,000 for that element.
4. Particularly with the modifications we have discussed, the true cost of disclosure should come in well under that figure, but I am also not prepared to allow what would in effect be a re-think of Zacaroli J's decision.
5. I understand that the disclosure that Zacaroli J ordered was in relation to the integers of the claim that were not admitted, but interpreting that, as the Defendant has, as only allowing a search of words that precisely correspond to words used in those integers, is clearly insufficient. As the Claimant says, it does not cover misspellings, but it also does not cover alternative ways of expressing the same thing, such as 'dissolved in', as opposed to 'solvent'.
6. I take account of the fact that the list of search terms that is set out at Schedule 1 of the Claimant's draft order, which is the list that I am proposing to adopt, was initially agreed by the parties. I appreciate that that was only for the purposes of conducting initial searches, so the Defendant's real point must be around proportionality in terms of the number of documents answering to those searches.
7. I accept that some of the search terms are pretty wide. Although Mr Keay points out that (for example) references to 'flavour cards' would be expected to appear in a list of ingredients, the difficulty is that those broader terms could occur in many other documents.
8. From what I have heard it seems to me that the best way of addressing that point is to add in exclusionary terms. We have discussed potential exclusionary terms by reference to paragraph 14 of Mr Vienne's witness statement. The parties should use their best endeavours to agree a suitable, but not, if I may say, "over the top", list of exclusionary terms.
9. In doing so the parties should take account of the fact that another element of my guidance is that the first pass review really must be undertaken by a much more junior person than previously contemplated. That person should be able to remove, for example, promotional material and artwork that for whatever reason is not excluded by the use of exclusionary terms. I would anticipate that that would be a fairly quick exercise and if that first pass, and possibly even second pass, review were done by more junior staff, then the costs would be reduced significantly.

10. Overall, I think that approach is the best way of reflecting Zacaroli J's decision and ensuring that disclosure is conducted on a reasonable and proportionate basis. However, the parties must cooperate for that purpose.

This judgment has been approved by the Judge.