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Claim No: HP-2023-000030

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

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

Date: 20 June 2024

Before :

DAVID STONE
(sitting as a Deputy High Court Judge)

Between :

SALTS HEALTHCARE LIMITED

Claimant

- and -

PELICAN HEALTHCARE LIMITED

Defendant

Mr Douglas Campbell KC and Mr Tim Austen (instructed by **Shakespeare Martineau**)
for the **Claimant**

Mr Richard Davis KC and Ms Laura Adde (instructed by **Murgitroyd**) for the **Defendant**

Hearing date: 13 June 2024

APPROVED JUDGMENT

I direct that pursuant to CPR PD 39A para 6.1 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 is to be handed down by the deputy judge remotely by circulation to the parties' representatives by email and release to the National Archives. The date for hand-down is deemed to be 20 June 2024.

David Stone (sitting as Deputy High Court Judge) :

1. This is my judgment on two applications before the Court in these proceedings brought by Salts Healthcare Limited (**Salts**) against Pelican Healthcare Limited (**Pelican**) for infringement of UK patent GB2569212 for an ostomy appliance (the **Patent**). Because the hearing of the two applications ran over the time estimated by the parties, there was not sufficient time for me to give *ex tempore* judgments. As expert reports are currently due to be exchanged on 19 July 2024, this judgment has been prepared over the course of the weekend to enable the parties to continue their preparations and so as not to jeopardise the trial date in November.

Background

2. The background to the action is set out in the judgment of Meade J given at the CMC of the matter on 17 January 2024 ([2024] EWHC 354 (Pat)). As Meade J noted at paragraph 2 of his judgment, the matter was transferred out of the IPEC by HHJ Hacon, who had concluded that the case was a relatively simple one, but it was not being rendered as simple as it could be, in particular, as a result of Salts' approach to the litigation. Meade J agreed with those sentiments. On the basis of the evidence before me, I also agree.
3. I gratefully adopt Meade J's further explication of the nature of the Patent and the allegations of infringement. Relevantly for present purposes, it is necessary only to note that Salts claims infringement of claims 5, 8 and 20 of the Patent on the basis of a normal construction and, further, on the basis of the doctrine of equivalents. Salts' case for infringement by equivalents is as follows:

“The inventive concept of the claims of the patent as granted is the use of weld portions forming part of the peripheral weld in an ostomy appliance of the type specified in each of the claims asserted, such as an ostomy pouch, in preventing bulging and/or sagging of the appliance during use when it contains waste and/or ensuring that the force acting on the appliance is distributed relatively evenly along the length of the appliance.”
4. The procedural applications before me all concerned whether various ostomy appliances bulge and/or sag when filled with waste and/or how they ensure that the force acting on the appliance is distributed relatively evenly along the length of the appliance. For the purposes of this judgment, I will use “bulging, sagging and/or distribution” to encompass all three concepts, except where it is necessary to distinguish between them.
5. Mr Douglas Campbell KC and Mr Tim Austen instructed by Shakespeare Martineau appeared for Salts. Mr Richard Davis KC and Ms Laura Adde instructed by Murgitroyd appeared for Pelican.

The Applications

6. Salts' application was filed on 2 May 2024 by way of an application notice. The application sought:
 - (a) an order permitting Salts to rely on the results of various experiments that it had conducted; and
 - (b) an order for further disclosure by way of an amended product description (**PPD**) and/or documents in the possession, custody or control of Pelican.
7. The order permitting reliance on Salts' experiments was not resisted by Pelican, and so, having satisfied myself that the order was appropriate, I made that order at the hearing. The order for further disclosure was vigorously resisted by Pelican.
8. Pelican's application was made by way of an application notice filed on 24 May 2024. It, too, sought permission to rely on the results of various experiments that it had conducted. Salts consented to the admission of the experiments in relation to some but not all of the tested products: the remainder were a live issue before me.

Pelican's Application in Relation to Experiments

9. Although it was heard second, it is convenient to deal with Pelican's application first.
10. Since the CMC before Meade J, both sides have conducted similar experiments, although Pelican says its were "more extensive". The aim of the experiments was to model the bulging, sagging and/or distribution of various ostomy bags in use. This was done by each side by filling various bags with liquid (to mimic liquid waste) or a solid material (such as plaster of Paris) (to mimic solid waste). The issue before me was the nature of the ostomy bags that Pelican had chosen to test.
11. Salts did not object to Pelican's reliance on experiments on Pelican's allegedly infringing product – the ModaVi ostomy bags (the **ModaVi Products**). Further, Salts had no issues with Pelican's experiments on re-creations of the ModaVi Products (described in Court as analogues) or re-creations of the ModaVi Products with assorted variations. I am satisfied that it is appropriate to grant permission for Pelican to rely on these experiments, and I will make that order.
12. Salts did, however, object to three other types of ostomy bags which Pelican tested, namely:
 - (a) Salts' own ostomy bag, which is said to embody the Patent, as well as re-creations and modifications of it;
 - (b) re-creations of the bags which form the prior art and the common general knowledge (**CGK**) for the purposes of Pelican's attack on the validity of the Patent; and

- (c) a bag said to be an embodiment of the Patent with prior art modifications.

13. I deal with each in turn.

Embodiments of the Patent, including re-creations and modifications

14. I do not need to set out here in any detail the doctrine of equivalents – it is sufficient to note the submission of counsel for Pelican that the first step in the *Actavis* test for equivalence is the consideration of whether “the variant achieves substantially the same result in substantially the same way as the invention”. Pelican’s counsel submitted that it was therefore relevant when assessing bulging, sagging and/or distribution to understand how the invention of the Patent works. Pelican’s counsel further submitted that the Patent does not illustrate the inventive concept – so Pelican submitted that experiments conducted on Salts’ products, which are said to fall within the scope of the claims in suit, will cast light on how the invention of the Patent performs when filled, particularly in relation to bulging, sagging and/or distribution.
15. Counsel for Salts conceded that the tested Salts products embody the Patent – but claimed that they are not part of the CGK, and are not relevant to either validity or infringement. Further, counsel for Salts took me in some detail to the difference in volume between the actual Salts products on the one hand, and the re-created, analogue versions on the other hand. It should be remembered that both sides tested re-created or analogue versions of ostomy appliances.
16. I reject Salts’ submissions. In testing re-creations of Salts’ bags, it is not necessary for the analogue bags either to fall within the CGK or to recreate exactly the Salts appliance – they only need fall within the claims of the Patent. For it is the invention of the Patent that is said to be being tested, not the Salts bags by virtue of their being Salts’ bags. In my judgment, Pelican is entitled to rely on the experiments relating to bags which are admitted to be embodiments of the Patent – and the experts can opine, if needed, on whether the re-creations and modifications take them outside.
17. As noted above, Pelican has conducted experiments on re-creations of various prior art citations. Pelican submitted that either (a) this art, being CGK, informs the characterisation of the inventive concept and/or (b) invalidates the Patent.
18. Counsel for Salts took a different approach to his objections to the experiments on these bags. In relation to the ConvaTec Esteem+ Soft Convex bag, he submitted that Pelican had tested the wrong product, by reference to the product codes. In response, counsel for Pelican submitted that there was no evidence on this point – and it could be dealt with by the experts in any event.
19. In relation to the Hollister Moderma Midi, this is said to correspond to a prior art citation described as Hannan. Counsel for Salts submitted that experiments had been conducted to try to make up for some perceived deficiency with the disclosure of Hannan itself (a 2011 US patent application). Salts’ skeleton argument noted “either Hannan itself contains the information or it does not”. Similar product code arguments were also submitted.

20. In relation to products said to be within the CGK (Pelican Platinum, Coloplast Sensura Mio, Dansac Novalife 1), counsel for Salts submitted that the Hollister Moderma Midi (see above) and the Dansac Novalife 1 were previously relied on by Pelican as prior art citations, but have since been removed from the prior art list. Salts' counsel said that these experiments were an attempt "to smuggle in material which would not be obvious from a mere inspection of the products". Further, Salts submitted that Pelican is extending the knowledge of the skilled person as to the existence of such products to an understanding of how they might perform once filled.
21. Further, Salts submitted that only six products from the ostomy market had been submitted by Pelican, without any visibility for Salts on how many were in fact tested, and whether Pelican "simply cherrypicked a small selection of product that give results it likes". Finally, Salts submitted that it does not know whether the products tested are pre-priority products, and what condition they were in when tested, or whether they were purchased more recently.
22. I reject all these submissions. From my own review of the photographs resulting from these experiments, it seems to me clear that how relevant bags (and I shall come back to that point) perform once filled will assist the trial judge. For example, reading Hannan will tell the trial judge what Hannan discloses, but seeing a filled appliance made to that invention will provide a real world embodiment of what is written in the specification and claims. In making this observation I do not suggest that a working example will supplant the primacy of the words of the disclosure, but it will provide a context for understanding. I therefore consider these experiments to be both relevant and helpful. Earlier in this paragraph I mentioned "relevant bags". I consider each of the bags tested to be potentially relevant – whether they are or not ultimately will be a matter for the trial judge, with the assistance of the expert evidence and the submissions of the parties. Now is not the time to try to work that out, particularly given there is as yet no expert evidence before the Court. The product code arguments, if they are still pressed, can be resolved at the appropriate juncture. For completeness, in the absence of evidence to the contrary, I also reject the suggestion that Pelican has cherrypicked the results that suit it. As I understand it, Pelican has tested the prior art bags and CGK bags it has been able to re-create. To the extent it has "cherrypicked" prior art and the CGK, then that allegation can also be levelled at its experiments. But parties are required to narrow the prior art on which they rely and to define the CGK, which inevitably requires a choice to be made as to what is in and what is out.

Embodiment of the Patent with prior art modifications

23. Both sides have tested the allegedly infringing ModaVi Products, along with re-creations of that product, including re-creations with variations where the weld portions referred to in the Patent have been varied. This, in both cases, aimed to show the effect of the weld portions on bulging, sagging and/or distribution. As noted above, Pelican has also tested modifications of products made to the Patent. In this final modification, to which Salts also objects, Pelican has removed the finger-shaped weld portions which are shown in the drawings in

the Patent, and replaced them instead with spot welds. This is said to be an attempt to recreate the prior art citation known as Wheaton. Wheaton uses spot welds (rather than peripheral welds as referred to in the Patent) which are said to be in the same position as the end of the “fingers” shown in the Patent. Pelican therefore says that this experiment casts light on the effect of the Wheaton prior art on bulging, sagging and/or distribution. Wheaton was introduced late into the proceedings – and after it was pleaded by Pelican, Salts amended its inventive concept to add a requirement that the weld portions form part of the peripheral weld. Pelican therefore says it obtains a squeeze defence if it can show that the Wheaton spot welds work in the same way as the Patent.

24. Salts submits that this is cheating – claiming that Pelican has used hindsight knowledge of the invention to redesign where the spot welds should go. Salts’ counsel has provided the Court with diagrams showing where the spot welds appear in the prior art, and where, instead, Pelican’s experiment has located them.
25. I also reject this submission. Both sides have performed modifications. In each case, they will need to back that up using expert evidence, and to explain why the use of the particular modifications is fair, and what each shows. If, as Pelican submits, it can benefit from the squeeze it asserts, it is, in my judgment, entitled to try to do so.
26. Counsel for Salts urged me not to admit the experiments because doing so would “simply generate satellite disputes which are out of all proportion to the alleged value they add, and would require detailed, time-consuming and costly discussion in expert reports and at trial”. In reaching my conclusions to give permission for Pelican to rely on these experiments, I have had in mind that these are comparatively simple products, and that the Patent is a comparatively simple one. Similarly, the experiments are comparatively simple (involving filling the bags and photographing them), and there has been before me no criticism of how that has been done. It does not seem to me that it will take significant time for the experts to grapple with the results of the experiments, nor will their admission into proceedings have any negative impact on the trial, unless Salts continues, as Pelican submitted, “to take every point”. It seems to me that any satellite disputes will likely be at Salts’ behest – and I would urge Salts to resist that temptation.
27. I add for completeness that counsel for Pelican asked me to take into account Salts’ lack of co-operation on the experiments. Having reviewed some of the inter-partes correspondence, it does seem to me that greater co-operation could have been forthcoming. But the experiments are either relevant and proportionate or they are not, and so I have not taken that issue into consideration in reaching my conclusions.
28. In conclusion, in the exercise of my case management discretion, I will give Pelican permission to rely on its experiments.

Disclosure

29. I need to set out some further background prior to determining Salts' disclosure application.
30. At the CMC, Meade J was asked to order disclosure, but declined, and in a tightly reasoned *ex tempore* judgment, set out why. In summary he concluded that PPDs are usual in patent cases for very good reasons and there was no good reason to depart from that position in this case. Where there are perceived inadequacies with a PPD, the answer is to try to fix the PPD, rather than to order documentary disclosure. Concluding, the judge said this:
- “I have made clear to the parties that if an intransigent problem with the PPD arises then a further resort – in general I think it would be a last resort – would be to order disclosure on top of the PPD. But in this initial round of discussion about its nature and contents, which I have found useful, the court should be very slow to resort to disclosure in the first instance. I am not going to do that.”
31. As a result, Meade J made orders requiring Pelican to amend its PPD on a number of basis, including as to “the effect of the features of the product on bulging, sagging and the distribution of force acting on the appliance as a result of the waste”. Meade J also ordered the parties to set out in writing what they meant by each of bulging, sagging and/or distribution, because there was a disagreement before him as to the meaning of those words.
32. Relevantly, Meade J also ordered disclosure of known adverse documents within the meaning of paragraph 2 of PD57AD.
33. Following Meade J's orders, Pelican made some amendments to its PPD, which I discuss in more detail below. Since the CMC, various pleadings have also been amended.

What Salts seeks

34. Salts now makes two requests. The order sought at paragraph 2 of its proposed draft order is as follows:

“The Defendant shall within [7] days serve upon the Claimant an Amended Product Description giving full particulars of the functionality of the weld portions of the ModaVi Products alleged to infringe the Patent. Such Amended Product Description to include full particulars of the functionality of the weld portions in:

- a. ensuring that the force acting on the appliance as a result of the waste is distributed relatively evenly along the length of the appliance;
- b. preventing uneven distribution of the load across the mounting plate;

c. channelling the contents of the ModaVi Products to the centre of the collecting bag;

d. channelling the contents of the ModaVi Products to the centre by the concave valley region formed by the first and second weld portions,

such particulars to state whether the functionality of the weld portions in the above respects is known or not known by the Defendant.”

35. But that did not seem to me to be Salts’ primary aim – its primary position seemed to be that Pelican had already had one attempt at redrafting its PPD, and that having failed to do so properly (in Salts’ submission) Pelican ought now give documentary disclosure under Model D as follows:

“On or before [date] the Defendant shall make and serve on the Claimant a Disclosure Certificate in accordance with Appendix 4 to Practice Direction 57AD and an Extended Disclosure List of Documents (the “List of Documents”) setting out the documents in its possession, custody or control which relate to:

a. the functionality identified at paragraphs 2.a to 2.d above of the weld portions of the ModaVi Products relied on;

b. the functionality of the equivalent weld portions found in the product shown at Figure 4 of the Eakin Patent insofar as it relates to the distribution of force acting on the appliance as a result of the waste and the channelling of the contents;

c. the basis for the statements regarding the functionality of the equivalent weld portions set out at paragraphs [0057]-[0061] of the Eakin Patent;

d. the basis for the statements regarding the functionality of the “smart structure”, including the “smart lobe” at the bottom of the pouch in the ModaVi Products, set out in the BJJ Article.”

Pelican’s procedural arguments

36. Before discussing the substance of Salts’ submissions, I should first deal with a procedural argument raised by Pelican. Pelican’s counsels’ skeleton argument submitted that Salts was asking the Court to re-open an interim decision, and that Salts had not pointed to a material change of circumstances, nor had it suggested that the facts on which the original decision was made were (innocently or otherwise) misstated (citing *Tibbles v SIG plc* [2012] EWCA Civ

518). Pelican's submission was that Salts should instead have appealed Meade J's order rather than seeking to re-argue it now before me.

37. I have read carefully the full transcript of the hearing before Meade J and the judgments he gave. It is clear to me from having done so (and having read and listened to both parties' submissions) that Salts is not seeking to re-argue Meade J's order in as far as it related to bulging, sagging and/or distribution, and that Meade J did not rule out a further application for disclosure based on an inadequate PPD. As I read his judgment, Meade J considered that documentary disclosure would be a last resort – but he did not rule it out. I therefore do not consider Salts' application to be an appeal in a different guise. Salts has brought an application based on Pelican's amended PPD, and I have jurisdiction to deal with it.

The meaning of bulging and sagging

38. There was before me disagreement on the meaning of bulging and sagging, on which some progress was made during the course of the hearing. The issue arose because Pelican's definition, given pursuant to Meade J's order, referred to Pelican's understanding of what Salts' definition is. Salts criticised that approach.
39. Pelican says that it has two definitions:
- (a) for the purposes of Salts' inventive concept, Pelican must meet Salts' case, and so what matters is how Salts defines bulging and sagging – thus Pelican's definition sets out Pelican's understanding of what Salts means by these expressions; and
 - (b) for the purposes of a normal construction, Pelican submits that it is entitled to try to convince the Court of what bulging and sagging mean – and in doing so it is not restricted to what Salts says the terms mean.
40. This debate was at best arid. At the hearing before me, I did not understand Salts' counsel to demur from Pelican's position that it was entitled to run two definitions. Those two definitions were clarified in Court. I therefore propose to say nothing further. This appeared to me to be an issue that could readily have been sorted out between the parties without the Court's intervention.

Salts' position on Pelican's PPD

41. Salts says that the following aspects of the Amended PPD are inadequate:
- (a) paragraph 2.5.4 of the Amended PPD says that "the" purpose of the lobe sections of the ModaVi Product is to control the folding of the lower edge as the bag fills, and to pull the lower edge forwardly to avoid contact with the skin. Salts says this may be true, but the PPD does not set out the impact of the lobe sections on bulging, sagging and/or distribution;

- (b) rather, paragraph 2.5.5 of the Amended PPD says that the lobe sections “are not understood to affect” bulging, sagging and/or distribution – Salts is critical of the “not understood” language, noting that Meade J’s order was to set out a description of the effect of the features of the product on bulging, sagging and/or distribution;
 - (c) similarly, paragraphs 2.7.2 to 2.7.4 of the Amended PPD assert that “the” purpose of the waist of the ModaVi Product is to facilitate comfortable folding of the pouch, but does not set out the impact of the waist on bulging, sagging and/or distribution; and
 - (d) again at paragraph 2.7.4 of the Amended PPD, it is said that the waist is “not understood” to affect bulging, sagging and/or distribution.
42. Salts therefore submitted that the Amended PPD does not address the inventive concept on which Salts relies.
43. I raised with counsel for Pelican my own concern with the use of the word “purpose”. Whilst a feature may aim at achieving something (its purpose), it is more important for the Court to know whether it actually achieves that aim/purpose. This was further emphasised later in the hearing when counsel for Pelican offered to reformulate aspects of the PPD by setting out what was described as the subjective intention relating to the feature, only for counsel for Salts to say that that was irrelevant, and unwanted. Therefore, it seems appropriate to me that the PPD at least be reformulated without the word “purpose”, instead focussing on what the effect of each feature actually is.
44. Salts submitted that the failure properly to describe the impact of the waist and lobe features is demonstrated clearly by three documents:
- (a) a recently disclosed marketing presentation (the **Presentation**) on the ModaVi Products;
 - (b) a US patent application filed by a company related to Pelican (the **Eakin Patent**); and
 - (c) an article in the British Journal of Nursing which refers to the ModaVi Products (the **BJN Article**).

Salts says that each of those three documents suggests that the lobe features of the ModaVi Products have a positive impact on bulging, sagging and/or distribution, which is inconsistent with the “not understood” wording of the PPD.

The Presentation

45. Excerpts from the Presentation were provided by Pelican to Salts shortly before the hearing. Pelican says it is clearly a marketing rather than a technical

document. Oddly, Pelican also claimed that the document was confidential, a notion with which I struggled given it had been demonstrated in front of members of the public in order to try to sell the ModaVi Products, without any evidence that there was a duty of confidentiality. It was a sales promotion meeting – no doubt intended to spread its message far and wide. But in any event, Pelican submitted that the document is irrelevant to the proceedings.

46. Salts, on the other hand, sought to rely on the Presentation as demonstrating that the PPD is inaccurate and/or incomplete. The Presentation talks of the “cutting edge design” of the ModaVi Products. The Presentation mentions that the ModaVi Products “will keep [their] form, structure and shape – even when filled” in order to address users’ needs for a pouch that “filled up evenly and didn’t bulge or sag”. The “smart lobe” “provides even more structure to the pouch” and is said in the Presentation to be patent protected (presumably a reference to the Eakin Patent).
47. I have some difficulties with a situation whereby the PPD takes the position that “the” (that is, the only) purpose of the lobes of the ModaVi Products is to assist with folding in circumstances where Pelican is actively promoting the lobes as assisting with structure so that the bags fill up evenly, and do not bulge or sag. Counsel for Pelican quite rightly submitted that this is a matter for cross-examination of whomever Pelican puts forward at trial in relation to the PPD. But for Salts to be able to do so, it needs to have the relevant documents to put to the witness. I consider the Presentation to be such a document. In my judgment, it falls within the definition of a “known adverse document” as that expression is understood for the purposes of disclosure, and as disclosure of known adverse documents was ordered by Meade J, I consider that the Presentation should be disclosed under the terms of Meade J’s order. I do not accept Pelican’s counsel’s argument that the Presentation is mere advertising puff – as I read it (but without reaching a concluded view on the issue – that may be a matter for the trial judge), the Presentation, which on its face aimed to promote and sell the ModaVi Products, makes claims as to the functions of different aspects of it, including the lobes which are in issue in these proceedings. Those claims are said to be patent protected. I also reject Pelican’s counsel’s argument that the statements made in the Presentation are too vague – I do not consider them to be so. I consider Salts is entitled to disclosure of the document so that it can put the statements in it to Pelican’s witness should it wish to do so.
48. Counsel for Pelican submitted that if disclosure of the Presentation was ordered as a known adverse document, Pelican would have no difficulties disclosing other documents like it. Pelican should do so as soon as possible and in any event within seven days of the handing down of this judgment.
49. There was also an argument before me as to the various corporate entities which surround Pelican, and whether or not they could be compelled to provide disclosure. Meade J’s order for disclosure of known adverse documents extends in the usual way to any documents under Pelican’s care, custody and control, whether or not they originate from and/or are held by a different corporate entity.

The Eakin Patent

50. Salts also relies on the Eakin Patent to submit that the Amended PPD is inaccurate. Salts submitted that the Eakin Patent describes the functionality of the waist and lobes as:
- (a) helping the collecting bag or lower edge thereof maintain its form and resist buckling;
 - (b) channelling the contents of the bag to the centre;
 - (c) maintaining the centre of mass of the load along the centreline;
 - (d) preventing uneven distribution of load across the mounting plate;
 - (e) causing the seam of the peripheral bonding region to kink forwardly; and
 - (f) preventing uncomfortable contact with the stiff seam.
51. Salts considers that there is no practical distinction between the functionality disclosed by the Eakin Patent and the inventive concept of the Patent on which Salts relies. Salts also says that the Eakin Patent is inconsistent with the Amended PPD.

The BJN Article

52. The BJN Article refers to the ModaVi Products. It is said to be promotional, but also deals with some technical aspects. Salts relies on the BJN Article for its description of the functionality of the lobe of the ModaVi Products – the BJN Article describes the lobe as preventing “the pouch from sagging at the bottom and the weight of this dragging it downwards”. The BJN Article, Salts says, specifically identifies the lobe as having been incorporated “to provide extra structure”, as a result of there being a perceived “opportunity in the ostomy market for a pouch that filled up evenly and did not bulge or sag and become noticeable under clothing.”
53. Whilst this is described by Pelican as “marketing spin”, I disagree, for the same reasons as I have set out above in relation to the Presentation. In my view, it would be an uncomfortable position for Pelican if it is saying publicly that the design of its bag helps prevent bulging and/or sagging, whilst at the same time denying in these proceedings that that is what the lobes do. Of course, it will be a matter for the trial judge what each of these documents can be understood to mean – but it is in my judgment at least open to Salts to argue the point.

Amendments to the PPD

54. Salts seeks a further amended PPD giving full particulars of the weld portions of the ModaVi Products. Salts’ counsel cited Pumfrey J (as he then was) in *Consafe v Emtunga* [1999] RPC 154 at [23]:

“...The purpose of this provision is to avoid, if possible, obliging the defendant to give extensive discovery much of which, experience has shown, is rarely if ever referred to. If this object is to be achieved, it is essential that parties and their advisers appreciate that the rule requires "full particulars of the product or process alleged to infringe" to be given. In this context, "full particulars" means particulars sufficient to enable all issues of infringement to be resolved. The description must be complete in all relevant areas. A description of the product either in general terms or including tendentious assertions is not acceptable...”

55. I respectfully agree. Pelican should provide full particulars of the weld portions and their effect on bulging, sagging and/or distribution. To assist in that, I set out some further guidance below, based on the submissions made before me.
56. I consider the use of “purpose” in the PPD to be infelicitous – the PPD should be amended accordingly.
57. I also consider that the PPD should be amended to avoid the “not understood” language it currently contains. If Pelican does not know one way or the other whether (for example) the lobes impact on bulging, sagging and/or distribution, then it should say so in terms. I understand from Pelican’s counsel’s submissions that that was what it had intended to convey, in which case such an amendment ought to be simple.
58. Where Pelican has used “the” to mean “the only”, then it would also assist for it to say so. If there are other known effects, they should be set out.
59. When dealing with each feature, Pelican’s advisors will also no doubt have firmly in focus the Presentation, the Eakin Patent and the BJN Article, and the claims they appear to make. Whilst it is a matter for Pelican, it may be best to deal now with the issues raised by Salts at the hearing before me, to put them to bed once and for all.
60. In any event, it is important that the PPD deals with the impact of each relevant feature on bulging, sagging and/or distribution. If there is no impact, then the PPD should say so.
61. I do not propose to make paragraph 2 of the draft order provided by Salts. It is set out at paragraph 34 above. It goes further by seeking to include matters that are not set out in the Patent nor Salts’ inventive concept: these are in proposed order 2(b), (c) and (d). The Court has already rejected Salts’ submission that “channelling” falls within the inventive concept. Salts submits that it has now been brought in by virtue of its Understanding of Terms document which was served following the hearing before Meade J. Salts’ position is that “channelling” as described in the Eakin Patent does fall within the inventive concept – even if this were true, this is, in effect, seeking disclosure of the Eakin Patent, which is unnecessary for the purposes of the PPD, and for which I reject further documentary disclosure below.

Documentary disclosure

62. Given what I have said above, it should be clear that I consider that those amendments ought to fix the current difficulties with the PPD. As Meade J held at the CMC, documentary disclosure in patent cases should be a last resort. When it is given, it will be targeted. Pelican’s counsel noted that they had been unable to find any example of Model D search-based disclosure having been ordered in similar circumstances. I set out my reasons below for rejecting the application for documentary disclosure.
63. The parties differ in their submissions on (a) how relevant and (b) how onerous documentary disclosure will be.
64. Dealing first with onerousness, Salts says that Pelican has already collected all the relevant documents, and so disclosing them would be less onerous than redrafting the PPD. That seems to me to be an adventurous submission, not based on evidence. On the other hand, Pelican’s evidence was that disclosure would be onerous, and if ordered at this stage, would risk the trial date. There are several repositories of documents which would need to be searched. Those contain several thousand documents, many of which are in different file formats. Reviewing the documents will be time-consuming, expensive and slow. I accept Pelican’s evidence on this point.
65. Experts’ reports are due in approximately five weeks, and it appears to me that, even with the best will in the world, Model D disclosure is likely to disrupt that timeline, with an obvious flow-on effect potentially jeopardising the trial.
66. The question is therefore whether the likely relevance of the disclosed documents warrants that potential impact on the trial date.

The Eakin Patent and the BJN Article

67. Salts says that the Eakin Patent and the BJN Article suggest that the PPD is inaccurate, because each of them claims functionality for the ModaVi Products in relation to bulging, sagging and/or distribution. As a result, Salts seeks Model D disclosure (requiring a search) of “documents in its possession, custody or control which relate to:
 - (a) ...
 - (b) the functionality of the equivalent weld portions found in the product shown at Figure 4 of the Eakin Patent insofar as it relates to the distribution of force acting on the appliance as a result of the waste and the channelling of the contents;
 - (c) the basis for the statements regarding the functionality of the equivalent weld portions set out at paragraphs [0057]-[0061] of the Eakin Patent; and

(d) the basis for the statements regarding the functionality of the “smart structure”, including the “smart lobe” at the bottom of the pouch in the ModaVi Products, set out in the BJN Article.”

68. I have set out above my decision that the Presentation is a known adverse document. To the extent any of the documents sought by Salts in the preceding paragraph are like the Presentation, they will also be known adverse documents and ought to be disclosed. But I do not consider it appropriate to order a Model D search on top of the existing obligation to disclose known adverse documents. To do so would require Pelican, at a challenging stage of the proceedings and heading into the summer vacation, to undertake (on the evidence) a significant search in circumstances where it seems to me that any relevant documents are likely already to be known to Pelican and its advisors. They can be assessed, on the basis of my ruling above, as to whether any of them is adverse. I consider on the basis of the evidence before me that a search is unlikely (perhaps even very unlikely) to turn up anything further that will shed light on the issues of bulging, sagging and/or distribution, in circumstances where the costs, delay and potential loss of the trial doubt mitigate against it.

Model D search for functionality

69. That leaves paragraph 3(a) of Salts’ proposed draft order, which seeks Model D disclosure not in relation to bulging and sagging, but in relation to distribution, as well as the three other matters which Meade J has already ruled do not fall within the inventive concept. The latter I can reject without further discussion for the reasons I have set out above at paragraph 61.

70. In relation to the former, I do not consider it proportionate or appropriate to order Model D disclosure in relation to the issue of distribution. Again, this would be onerous, and it is unlikely (perhaps even very unlikely) to turn up any documents which will not already have been considered (and potentially disclosed) as known adverse documents.

71. I therefore decline to make order 3 of Salts’ proposed order.

Costs

72. Each side claimed its costs, although oral submissions were brief because by that point, the hearing had long exceeded the time estimate, and the parties were not aware of my decision on each application. I therefore said I would make a provisional ruling on costs in my written judgment, and the parties could address me on it in brief written submissions if so advised.

73. My provision ruling was as follows. As counsel for Salts submitted, the hearing was all about case management. Whilst there were two separate applications, Pelican relied heavily on what had happened at the CMC, of which this hearing sometimes appeared to be an extension. Given that, it seems to me that this was a case management hearing, and that the appropriate order should be costs in the case.

74. If I am wrong in that, as can be seen from this judgment, Salts was successful on its (uncontested) application for permission to rely on its experiments, and Pelican was successful on its (contested) application to rely on its experiments. Salts did not achieve the disclosure it requested, but Pelican will have to make some further amendments to its PPD. It therefore seems to me that neither side has “won”, and an appropriate order would be costs in the case.
75. Having received this judgment in draft, both sides made costs submissions:
- i) Salts submitted that the appropriate order in relation to the two applications in relation to experiments should be costs in the case, but that its application for further disclosure was properly brought, and a win. Criticisms were made of Pelican’s costs schedule.
 - ii) Pelican submitted that neither side had won the disclosure application, but that it had won its experiments application and so it should have its costs summarily assessed at £7500.
 - iii) Salts’ submissions in reply took things no further.
76. I have read carefully the written submissions on costs. In the exercise of my discretion, I will make the order I proposed in my draft judgment – that is, that costs of all the applications be costs in the case, for the reasons I have set out above.
77. At the risk of sounding like a broken record, I would, as I did at the hearing, again urge the parties to focus on the main issues to be determined at the trial (which is listed for three hearing days) of this comparatively simple patent case and to co-operate as much as possible moving forward.