



Behind the Curtain: Disclosure in IP Litigation Today

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01 Introduction



Disclosure: England and Wales

- Derived from overriding objection in CPR 1.1, requiring cases to be dealt with justly and at proportionate cost.
- Court-controlled with cooperation expected from parties.
- Targeted at dealing with what is necessary for fair resolution of issues.
- Must ensure parties are on an equal footing.
- Strong privilege rules.

Disclosure: England and Wales

- CPR 31.2 - A party discloses a document by stating that the document exists or has existed.
- CPR 31.3 – Once disclosed, subject to limitations, the party to whom disclosure has been made has the right to inspect the document and produce it as evidence.
- CPR 31.3 – “Document” has a very broad meaning – anything in which information of any description is recorded.
- Practice Direction 57AD – Applicable rules for IP cases in the High Court.



Privilege as a Limitation on Disclosure (England & Wales)

- PD 57AD para 14 – Right of privilege to withhold production of documents
- Privilege is a fundamental right unless waived.
- Protects the integrity of the legal process by ensuring legal advice can be obtained freely and in confidence.
- Disclosure exercises involve identifying privileged material and withholding.



Disclosure/Discovery: EU (Mostly Civil Law)

- No general obligation.
- Where available, judge-led and document specific.
- Strong justification for requests and need for clear specificity on targeted documents.
- Privilege rules vary considerably by member state.

Discovery: US

- Extensive obligations to disclose non-privileged material.
- Largely party driven and adversarial.
- High cost and volume production; expected to include depositions and interrogatories.
- A recognition of privilege, but distinct from English law principles.

02 Applicable Forums for Disclosure

Disclosure Regimes

- UK IPO
- Intellectual Property Enterprise Court (“IPEC”) – Part 63; PD 63 & IPEC Guide
- Intellectual Property List in High Court – PD 57AD
- Shorter Trial Scheme (“STS”) - PD 57AB

UK IPO

- No formal regime - documents relied upon typically submitted during Evidence rounds
- UK IPO can intervene in rare cases
 - 62(1)(a) of The Trade Mark Rules 2008 - Requests for further information
“require a document, information or evidence to be filed within such period as the registrar may specify”
 - Cross-Examination
- “Disclosure”
 - Rare, typically in bad faith cases
 - Where the presence of a specific document is alleged to exist
 - Must first put it to other side before asking IPO to raise it in correspondence
 - Takes the form of an Order, disclosure to requesting party, who must admit it as evidence
 - Drawbacks for non-compliance? costs & negative inference

IPEC

- CPR 63.24 - Standard Disclosure does not apply
- Practice Direction 63:
 - 29.1 - Specific Disclosure
 - 29.2, only:
 - 1) in relation to **specific & identified issues**; and
 - 2) if the court is satisfied that the **benefit** of the further material in **t** terms of its value in resolving those issues appears likely to justify the **cost** of producing and dealing with it (i.e., **cost-benefit test**)
- IPEC Guide:
 - Importance of CMC - no material may be filed in the case by way of evidence, disclosure or written submissions unless permission is given by the judge

Shorter Trial Scheme (“STS”)

- Practice Direction 57AB
 - PD 57AB, 2.2: The STS will not be suitable for:
 - a) Cases including an allegation of **fraud** or **dishonesty**;
 - b) Cases which are likely to require **extensive disclosure** and/or reliance upon extensive witness or expert evidence
 - PD 57AB, 2.40: write to the other party requesting disclosure 14 days < CMC
 - Narrow and specific requests
 - Documents of significant probative value
 - Reasonableness and proportionality of any search required
 - Documents relied upon; documents requested (as agreed or ordered)

Intellectual Property List in High Court

- Practice Direction 57AD
- Full, Structured, Issue-Driven (and expensive!)
- Strategically significant in IP cases
- Internal docs on intent/knowledge/strategy could be key
- Remember:
 - IPEC = limited disclosure
 - STS = minimal disclosure
 - UKIPO = no formal disclosure regime
- Does the value & importance of the case justify the costs?

03 Practice Direction 57AD

Key points in the disclosure process under PD 57AD



PD 57AD

Model	Description
Model A	Disclosure confined to known adverse documents .
Model B	Limited Disclosure (of known adverse documents and key documents (a) on which they rely in their SOC and (b) to enable the other parties to understand the claim or defence to meet)
Model C	Disclosure of particular documents or narrow classes of documents . (Disclosure of (a) known adverse documents and (b) particular documents or narrow classes of documents relating to a particular Issue for Disclosure, by reference to requests in the Disclosure Review Document).
Model D	Narrow search-based disclosure, with or without Narrative Documents (Disclosure of (a) known adverse documents) and (b) documents which are likely to support or adversely affect its claim or defence, or that of another party, in relation to one or more of the disclosure issues. Reasonable and proportionate search required. The court may order the parties to include or exclude Narrative Documents (a document which is relevant only to the background or context of material facts or events, and not directly to the Issues for Disclosure). In the absence of an order, the parties are encouraged to take reasonable steps to exclude Narrative Documents.
Model E	Wide search-based disclosure (Model D plus disclosure of any documents which may lead to a train of inquiry which may then result in the identification of other documents for disclosure). Reasonable and proportionate search required. Only to be ordered in exceptional cases. Narrative Documents must also be searched for and disclosed (unless the court otherwise orders).

Document Preservation

- Get ahead of it early.
- Understand your document landscape.
- Scope it defensibly.
- Think about your Disclosure Review Document.

04 Privilege

What Is Privilege?

In Short:

Privilege can provide special protection for **confidential** communications:

- Between a lawyer (e.g., party's Legal or external counsel) and their client (i.e., individuals within the business); or
- Between a lawyer (e.g., party or external counsel) or client (i.e., individuals within the business) and a third party (e.g., external expert) where litigation is reasonably contemplated.

Why Is it Important?

- Provides the right to withhold certain documents from being disclosed to various third parties.
- If privilege is lost (even accidentally), documents containing sensitive information may be released.
- This could negatively impact party in many ways: risks of bad PR, documents could be used against the party in court, etc.

Applicable Rules of Privilege

- Whether a document is privileged is determined by the rule of *lex fori*.
- Even if the document in question was created abroad or under a contract governed by a foreign law, if the proceedings are before an English court, the English rules of privilege will apply.
- Important to understand distinction when dealing with documents or legal advice from other jurisdictions.

The Key Types of Legal Professional Privilege...



Inadvertent Disclosure/ Waiver of Privilege

- Inclusion of a privileged document in disclosure cannot be assumed as inadvertent – test is whether there has been an “obvious mistake”.
- Possible override for public interest when inadvertent disclosure is to a prosecuting authority.
- Reference to privileged materials in pleadings or a witness statement can result in waiver.
- Where documents are shared with another party, privilege is lost against that party – **except** common interest privilege.
- Waiver of privilege can be for a limited purpose.



Marking Documents as “Privileged and Confidential”

- Marking a communication as ‘privileged’ does not automatically make it privileged
- Not marking a communication as ‘privileged’ does not mean that it is not
- **Best practice** = mark privileged material as ‘legally privileged and confidential’ (though it is not determinative):
 - Easier to identify and segregate
 - Easier to protect confidentiality



05 Technology in Disclosure

Technology

- Generative AI and machine learning can assist with:
 - Document review
 - Privilege flagging
 - Redactions
 - Issue classification
- Keeping cost down vs. transparency and defensibility of the process.
- Use of these tools isn't yet expressly covered in the CPR – watch this space!

06 Practical Tips for Managing Disclosure in IP Litigation

Our Top Tips

Pre-action

- Know your forums & regimes
 - In light of budget, timeframe, key issues
- Timing is critical
 - Take steps as soon as litigation is contemplated
 - CPR obligations, Disclosure “pack”
- Disclosure in pre-action correspondence
- Align with counsel
- Consider your role & value add

Our Top Tips

Once Litigation Has Commenced

- **Project Management**
 - Scope early, consider staffing, capacity & internal v external vendors
- **Cost Budgeting**
 - Have contingencies & assumptions that support unpredictable outcomes
- **Know your documents**
 - Prepare a quality briefing document for e-discovery team
 - Consider early treatment of relevance, confidentiality & privilege

Our Top Tips

Don't Forget

- **Keep Decision Logs**
 - Defensibility; data protection; consistency; negotiations; risk exposure & future-proofing
- **Dealing with your Opponent**
 - Don't be afraid to explore sensible variations
 - Most things can be agreed (or ordered)
 - Consider non-lawyer discussions on technology
 - Explore use of AI
 - Be careful with deadline extensions
- **Settlement**