

# EIP



## Court refuses to close the stable door after the horse has bolted in patent dispute

### **Saint-Gobain Adfors S.A.S v 3M Innovative Properties Company [2023] EWHC 2769 (Pat)**

The High Court has rejected an application made by 3M to restrict Saint-Gobain's use of information disclosed by 3M to Saint-Gobain in a patent dispute 19 months after the information was referred to at trial in open court. The Judge's reasoning was that Saint-Gobain was free to use the information as it was referred to at a public hearing and Saint-Gobain was entitled to use it in legal proceedings elsewhere. The issues those legal proceedings caused for 3M were not a "very good" reason to place restrictions on the use of that information.

#### Background

Saint-Gobain had sued 3M in 2020 seeking to invalidate 3M's patent which related to abrasive materials used in industrial processes. In early 2022 the trial was heard and 3M's patent was invalidated. There was no appeal to that decision. In the proceedings 3M provided Saint-Gobain with particles produced by an employee of 3M called Rowenhorst in the 1990's. These particles were referred to as "**the Rowenhorst particles**". 3M did so on the basis that the Rowenhorst particles would be subject to the provision of CPR 31.22 which says that:

1. A party to whom a document has been disclosed may use the document only for the purpose of the proceedings in which it is disclosed, except where –
  1. the document has been read to or by the court, or referred to, at a hearing which has been held in public;

2. the court gives permission; or
  3. the party who disclosed the document and the person to whom the document belongs agree.
2. The court may make an order restricting or prohibiting the use of a document which has been disclosed, even where the document has been read to or by the court, or referred to, at a hearing which has been held in public.

3M had reserved the right to apply for an order prohibiting the use of a document made public under the provisions of 31.22(2). At the trial Saint-Gobain relied upon electric 3D computer tomography scans ("**CT Scan Files**") of the Rowenhorst particles, as well as 3D models and 2D images derived from the CT Scan Files. At the end of the trial 3M and Saint-Gobain agreed to an order under CPR 31.22(2) prohibiting use of confidential information disclosed by 3M. However, that order only covered extracts from other of 3M's technical documents and not the CT Scan Files or any documents derived from the CT Scan Files.

Following the trial Saint-Gobain took the view that it was free to use the CT Scan Files for any other purpose and so provided copies to its US lawyers and European patent attorneys. Saint-Gobain's European patent attorneys then used the CT Scan Files in publicly available submissions at the European Patent Office ("**EPO**") in other patent proceedings against 3M. The first submission by Saint-Gobain's European patent attorneys was in January 2023, with later submissions in March, July and August 2023. On 3 August 2023 3M wrote to Saint-Gobain to complain about the use of the CT Scan Files in the EPO proceedings. The dispute was not resolved and so Saint-Gobain issued an application seeking a declaration that the CT Scan Files were read by the Court or were referred to at trial and so Saint-Gobain were free to use the CT Scan Files as they wished. 3M responded seeking an order under 31.22(2) prohibiting Saint-Gobain from using the CT Scan Files.

## Decision

The first issue the Judge had to determine was whether the CT Scan Files were read to or by the court or referred to a public hearing. Saint-Gobain's position was that the CT Scan Files were referred to as they were referred to at trial relying on statements such as the following "What you have there is CT scans of two batches of Rowenhorst particles which are exhibited and the batch of Cubitron II particles, all of which is in the CONF bundle". 3M's position was that for a document to be referred to it "was necessary to paraphrase or allude to part of the contents of the document." The Judge rejected 3M's submissions and said it was unnecessary to add any further meaning to the words "referred to". As the CT Scan Files had been referred to, they were therefore documents referred to at a



public hearing, furthermore the Judge found that the totality of the references would allude to the contents of the CT Scan Files. This is as the references said what the scans were and what information a party could obtain from them. The Judge therefore found that CPR 31.22(1)(a) applied and Saint-Gobain, were absent a further order from the Court, free to use the CT Scan Files.

The Judge then turned to whether he should make an order restricting Saint-Gobain's use of the CT Scan Files under CPR 31.22(2). The Judge found that there was no time limit on 31.22(2) and a judge could in theory make an order multiple years after the documents were referred to at a public hearing. The Judge found that the correct test was that documents referred to at a public hearing should generally be free of restrictions on their use and it is for a party seeking to restrict their use to show "very good reasons" for that.

In applying that test the Judge accepted 3M's contention that the information in the CT Scan Files was information not otherwise publicly available. However, the Judge did not accept that the CT Scan Files would be very valuable to a competitor as they were scans of particles produced as part of an unsuccessful laboratory project 30 years ago. The Judge instead thought that 3M's real aim was to prevent Saint-Gobain from using the CT Scan Files in proceedings at the EPO. The Judge also criticized 3M's timing and that they should have made an application at the time of the trial and not waited so long to make an application. The Judge therefore refused to make an application under CPR 31.22(2) restricting Saint-Gobain's use of the CT Scan Files.

This means that Saint-Gobain are free to use the CT Scan Files in other legal proceedings, although Saint-Gobain have voluntarily given an undertaking to notify 3M if Saint-Gobain intended to use the CT Scan Files for anything other than legal proceedings.

#### Takeaway points

The default position is that documents referred to at a public hearing can be used for any other purpose. It is therefore important that any party that wishes to seek an order restricting the use of those document does so at that hearing, or as soon as possible if it transpires that those documents need to be kept away from public viewing. Additionally, a party seeking to protect their document must show a "very good" reason for that given the importance of transparency in the High Court's process. The High Court has further ruled that there is nothing inherently wrong with the receiving party using the information in other legal proceedings and that by itself would not be a "very good" reason to restrict the use of information referred to at a public hearing.

The decision can be found [here](#).