



Neutral Citation Number: [2018] EWHC 3522 (Pat)

Claim Nos: HP-2017-000041  
HP-2017-000044

**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  
Fetter Lane  
London, EC4A 1NL

Date: Thursday, 13<sup>th</sup> December 2018

**Before:**

**MR. JUSTICE ARNOLD**

**Between:**

- (1) ELI LILLY AND COMPANY  
(2) LILLY FRANCE SAS  
(3) LILLY DEUTSCHLAND GMBH  
(4) ELI LILLY ITALIA SPA  
(5) ELI LILLY AND CO (IRELAND) LIMITED  
(6) ELI LILLY KINSALE LIMITED  
(7) LILLY SA  
(8) ELI LILLY AND COMPANY LIMITED

**Claimants**

**- and -**

**GENETECH, INC**

**Defendant**

**MR. ANDREW WAUGH Q.C. and MR. THOMAS MITCHESON Q.C.** (instructed by  
**Allen & Overy LLP**) for the **Claimants**

**DR. MICHAEL TAPPIN Q.C., DR. JUSTIN TURNER Q.C. and MR. WILLIAM  
DUNCAN** (instructed by **Marks and Clerk Solicitors LLP**) for the **Defendant**

**Approved Judgment**

Transcript of the Stenographic Notes of Marten Walsh Cherer Ltd.,  
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**MR. JUSTICE ARNOLD:**

1. In these proceedings the Claimants (“Lilly”) seek permission to rely upon experiments described in an experimental report by Max Woisetschlager of Novartis dated 11 November 2016. The experiments were conducted by Novartis for the purpose of Opposition proceedings against the patent in suit in the European Patent Office, and for that reason it is accepted by Lilly that they require the permission of the Court in order to rely upon those experiments.
2. It is important to note straightaway that it is not disputed that, because the experiments were carried out by Novartis using antibodies that Mr Woisetschlager said had been made by Novartis back in 2002/2003, Lilly have never been in a position to repeat the experiments for the purposes of an inspection by the Defendant (“Genentech”).
3. Genentech resists permission being granted to Lilly to rely upon these experiments on the simple ground that Lilly have failed to comply with the relevant procedure.
4. By an order of Birss J dated 1 February 2016, if either party desired to establish any fact by experimental proof, that party was required to serve an application for permission to do so by 14 June 2018.
5. On 2 March 2018 Lilly served a Notice to Admit Facts seeking admissions as to the EPO experiments. Genentech responded on 29 March 2018, saying:

"[These requests] represent illegitimate attempts to rely upon experiments conducted for the purposes of litigation without the permission of the Court, and are not suitable for requests for a Notice to Admit Facts. The Claimants do not have permission of the Court to serve notices of experiments."
6. The date of 14 June 2018 set out in Birss J's order was varied by consent. On 6 July 2018 Lilly provided Genentech with a draft Notice of Experiments. On 20 July 2018 Henry Carr J granted permission for Lilly to conduct those experiments and to serve a Notice of Experiments by 31 July 2018, which was duly done. Those experiments have subsequently been repeated and witnessed by Genentech.
7. No application was made by Lilly to Henry Carr J for permission to rely upon the experiments conducted by Novartis in the EPO. No application having been made to him, no permission was granted.
8. Notwithstanding that, reliance is placed upon the Novartis experiments in the expert report of Dr. John Tite served on behalf of Lilly on 7 November 2018. When Genentech received that report, it promptly objected to Lilly's attempt to rely upon the Novartis experiments without having obtained the permission of the Court or having complied with the normal procedure in that regard. That led to Lilly applying belatedly for permission now, at the Pre-Trial Review, with the trial being due to start on 16 January 2019 after two days' judicial pre-reading. In the meantime, evidence in reply has been exchanged.

9. Counsel for Genentech reminds me of what was said by Laddie J in a frequently cited passage in *Electrolux Northern v Black & Decker* [1996] FSR 595 at 610 as follows:

"That rule and the directions made in this action pursuant to it are intended to serve a purpose. Experience teaches that experiments are an expensive, time-consuming and frequently ineffective way of proving a technical issue. Furthermore, unless a party is given adequate warning of them and a proper opportunity to witness their repetition, they can result in litigation by ambush. Where a party intends to rely on experiments he must serve a notice as required by Ord. 104 r.12. The rule is mandatory not permissive. Such experiments will not be admissible in the absence of a notice unless, in the light of special circumstances, the court exercises its discretion to allow them in. If a party wants to have them admitted, in the absence of agreement from his opponent, he should normally make a formal application to the court to that effect. What he should not do is introduce them by way of the witness or expert statements or in counsel's skeleton arguments. That course is unfair to the other side. The latter may only realise at the trial what is being put forward and may thereby be deprived, in the absence of an adjournment of the trial, of the option of carrying out experiments in reply or of finding an expert who can answer the points to be made. Furthermore he will be deprived of the opportunity to have his experts witness the experiments."

10. Counsel for Genentech points out that the consequence of the course adopted by Lilly is that Genentech has been deprived of being forewarned of Lilly's intention to rely upon these experiments, of being properly notified of the facts that are sought to be proved by them, and of the opportunity to conduct experiments in reply. Counsel for Genentech accepted that Genentech would not have been in a position to insist on a repetition, given that Lilly is not able to do so. He submitted, however, that the other consequences amounted to significant prejudice to Genentech. He further submitted that there was really no excuse for Lilly's failure to follow the normal procedure in this regard.
11. Counsel for Lilly attempted to justify Lilly's late reliance on these experiments by saying that the issues had developed over time. I do not accept that contention. Lilly sought to rely upon the Novartis experiments in Dr. Tite's first report, which forms part of Lilly's evidence in chief. The evidence is not sought to be given in reply to any evidence from Genentech. Moreover, Genentech's position has been clear since 29 March.
12. Counsel for Lilly also submitted that it would have been disproportionate for Lilly to conduct experiments of this nature itself and that reliance upon the existing experiments carried out by Novartis for the purposes of the EPO proceedings was a way of saving money. That may have been a reasonable factor to put before the Court as justifying the admission of the experiments on 20 July. However, that does not justify Lilly's attempt to present Genentech and the Court with a *fait accompli* at this stage of the proceedings.

13. Counsel for Lilly further submitted that Genentech was not, in truth, prejudiced, because not only was it not possible for Lilly to carry out a repetition of the experiments, but moreover it would not have been possible for Genentech to carry out experiments in reply, given that the antibodies in question are said to have been created by Novartis back in 2002/2003.
14. I do not accept that that is necessarily the case. Even if it is correct that Genentech would not have been able to access those specific antibodies, and therefore could not have carried out any experiments with those antibodies, it does not follow that Genentech could not have carried out other experiments with different antibodies, which it might have wished to do had it known that Lilly was relying upon the Novartis experiments, and in particular had it known that the Court had given Lilly permission to do so.
15. In short, it seems to me that this is a case in which the submission made by counsel for Genentech in his skeleton argument, that Lilly have proceeded with "brazen disregard of the Court's orders and the well established practice for admission of experimental evidence", is fully justified. I see no reason why a party should be rewarded for such brazen disregard of the Court's orders and the well-known practice, and accordingly permission is refused.

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